THE LAW

OF

PATENTS, TRADE-MARKS AND COPY-RIGHTS:

CONSISTING OF THE SECTIONS OF

THE REVISED STATUTES OF THE UNITED STATES,

WITH

NOTES UNDER EACH SECTION,

REFERRING TO THE

Decisions of the Courts and the Commissioner of Patents.

TOGETHER WITH THE

RULES OF THE PATENT OFFICE

AND

A SELECTION OF FORMS.

By

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PREFACE.

THIS work is prepared with the design of bringing all the law pertaining to patents, trade-marks and copy-rights, so far as they depend on statutes, within the compass of a single volume. The plan adopted for this purpose is to give the statutes in their order as they are in the Revised Statutes, and to place notes referring to the decisions under the section construed. For this purpose all the decisions of the courts and of the Commissioner of Patents have been examined. The notes referring to the decisions of the courts are distinguished from those referring to the decisions of the Commissioner by being placed in leaded or more open type. A table has also been prepared showing the time of the repeal of each act, and the place where any analogous provision in the Revised Statutes may now be found, and under each section a reference is given to the prior acts on the same subject. By this means a lawyer may readily ascertain whether a provision in a statute cited in a decision is still in force, or whether a statute has been so modified as to affect the application of a decision. The Rules of the Patent Office and a set of Forms have also been appended. It is believed that the work thus prepared brings within a narrow compass all that a lawyer may desire to know concerning the subject, or refers him to the original sources for further information.

ORLANDO F. BUMP.

BALTIMORE, October 1st, 1877.

ABBREVIATIONS.

A. L. J. ..... Albany Law Journal.
A. L. Reg. ..... American Law Register.
A. L. Rev. ..... American Law Review.
A. L. T. ..... American Law Times.
C. L. B. ..... Cincinnati Law Bulletin.
C. L. N. ..... Chicago Legal News.
Cent. L. J. ..... Central Law Journal.
Dec. Com. ..... Decisions of Commissioner.
I. R. R. ..... Internal Revenue Record.
Law Rep. ..... Law Reporter.
Leg. Int. ..... Legal Intelligencer.
Liv. L. J. ..... Livingston's Law Journal.
N. Y. Leg. Obs. ..... New York Legal Observer.
O. G. ..... Patent Office Gazette.
Pac. L. R. ..... Pacific Law Reporter.
Penn. L. J. ..... Pennsylvania Law Journal.
Pitts. L. J. ..... Pittsburgh Legal Journal.
West. L. J. ..... Western Law Journal.
W. N. ..... Weekly Notes.

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....	..	11	..	...	....	..	..	..	...	4934.
....	..	12	..	...	....	..	..	..	...	
June 7, 1794	58	1	..	393	....	..	..	..	...	
April 17, 1800	25	1	2	37	....	..	..	..	...	4886.
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April 29, 1802	36	1	..	171	Feb. 5, 1831	16	14	4	439	4962.
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July	8, 1832	162	1	..	559	....	....	..	..	..	....	494.
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....	....	..	2	..	....	....	....	..	..	..	....	4958.
July	4, 1836	357	1	5	117	....	....	..	..	..	....	475, 476, 477, 481.
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March	3, 1837	45	1	..	191	....	....	..	..	..	....	
....	....	..	2	..	....	....	....	..	..	..	....	892.
....	....	..	3	..	192	....	....	..	..	..	....	
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....	....	..	10	..	....	March 2, 1861		88	6	12	247	
....	....	..	11	..	....	July	8, 1870	230	111	16	216	476, 477.
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March	3, 1839	88	1	..	353	....	....	..	..	..	....	476, 477.
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....	..	5	..	....	....	..	..	..	....	4901.
....	..	6	..	....	March 2, 1861	88	13	12	249	4900.
Aug. 10, 1846	178	10	9	106	Feb. 5, 1859	22	6	11	380	4959.
May 27, 1848	47	1	..	231	July 8, 1870	230	111	16	216	476, 477, 4924, 4926.
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March 3, 1849	108	2	..	395	....	..	..	..	....	441.
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March 3, 1853	97	3	..	209	....	..	..	..	....	476.
April 22, 1854	52	1	..	276	....	..	..	..	....	476.
Aug. 18, 1856	129	9	11	91	....	..	..	..	....	476.
....	..	10	..	....	....	..	..	..	....	476.
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Feb. 5, 1859	22	6	..	380	....	..	..	..	....	
....	..	8	..	....	....	..	..	..	....	4948.
March 3, 1859	80	3	..	422	....	..	..	..	....	
Feb. 18, 1861	37	1	12	180	....	..	..	..	....	699.
March 2, 1861	88	1	..	246	....	..	..	..	....	4905, 4906, 4907, 4908.
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....	..	13	..	249	....	..	..	..	....	4900.
....	..	14	..	....	July 16, 1860	182	4	12	588	
....	..	15	..	....	July 8, 1870	230	111	16	216	892.
....	..	16	..	....	....	..	..	..	....	4884.
....	..	17	..	....	....	..	..	..	....	
July 16, 1862	182	4	..	582	....	..	..	..	....	
March 3, 1863	102	1	..	796	....	..	..	..	....	
....	..	2	..	....	....	..	..	..	....	477.
....	..	3	..	....	....	..	..	..	....	4885.
June 25, 1864	159	1	13	194	....	..	..	..	....	4897.
March 3, 1865	112	1	..	533	....	..	..	..	....	4897.
....	126	1	..	540	....	..	..	..	....	4952.
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PATENT LAWS AND DECISIONS.

CONSTITUTION.

ART. I, SEC. 8.

THE CONGRESS shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

The word "secure" does not mean the protection of an acknowledged legal right. Wheaton *v.* Peters, 8 Pet. 591.

No State can in any form interfere with the right of private persons under the copyright laws of the United States. Little *v.* Gould, 2 Blatch. 165, 362.

The Constitution does not authorize the protection of a dramatic composition which is grossly indecent and calculated to corrupt the morals of the people. Martinetti *v.* Maguire, 1 Deady, 216; S. C. 1 Abb. C. C. 356.

In the exercise of this power, Congress is limited to authors and inventors only. This clause, therefore, never can admit of so extensive a construction as to prohibit the respective States from exercising the power of securing to persons introducing useful inventions, without being the authors or inventors, the exclusive benefit of such inventions for a limited time. Livingston *v.* Van Ingen, 9 Johns. 507.

The power is general to grant to inventors, and it rests in the sound discretion of Congress to say when and for what length of time, and under what circumstances, the patent for an invention shall be granted. There is no restriction which limits the power of Congress to cases where the invention has not been known or used by the public. All that is required is that the patentee shall be the inventor. An act which gives a patent for an invention which was in public use and enjoyed by the community at the time of its passage, is not for that reason unconstitutional. Blanchard *v.* Sprague, 2 Story, 164; S. C. 3 Sum. 535; Evans *v.* Jordan, 1 Brock. 248; S. C. 9 Cranch, 199; Jordan *v.* Dobson, 4 Fish. 232; S. C. 7 Phila. 533.

The power thus granted is domestic in its character, and necessarily confined within the limits of the United States. Brown *v.* Duchesne, 19 How. 183.

This constitutional power might have been fully exercised by Congress in

making special grants of patents. Congress might have spent much time by such a course, and may not be the most competent body to investigate the facts and do equal justice to inventors, but this would be a question of expediency and not of constitutional power. Bloomer *v.* Stolley, 5 McLean, 158.

The machinery through which the right to a patent is ordinarily applied for and obtained, may be dispensed with, and the title may be conferred by a legislative grant, and this may be done in regard to the extension of an exclusive right the same as in originally granting it. No constitutional restriction appears to exist against the exercise of this power by Congress. Bloomer *v.* Stolley, 5 McLean, 158.

Congress has the power to confer a new and extended term upon the patentee, even after the expiration of the first. Jordan *v.* Dobson, 4 Fish. 232; s. c. 7 Phila. 533; Blanchard *v.* Haynes, 6 West. L. J. 82; Blanchard's Factory *v.* Warner, 1 Blatch. 258; Evans *v.* Robinson, 1 Car. L. Rep. 209.

The power of Congress to secure the rights and privileges of assignees upon extending a patent is incidental to the general power conferred by the Constitution on Congress to promote the progress of the useful arts by securing to inventors for limited times the exclusive right to their discoveries. The assignees of the original patentee are frequently most instrumental in putting the invention into general use and bringing it successfully before the public by the expenditure of their time and money. More than half, probably, of the useful patented inventions have been thus brought into general public use, the successful results operating directly or indirectly for the benefit and interest of the patentees. Although this would not authorize the renewal of a grant to assignees, as no such power exists in the Constitution, still in exercising the power in favor of the inventor, it would be going too far to say that Congress has no right to regard incidentally the interests of meritorious assignees. Blanchard's Factory *v.* Warner, 1 Blatch. 258.

It is not the province of the judiciary to inquire into the reasons which induced the passage of the law, with the view of testing its validity. If constitutional, it must be enforced without regard to the policy or justice which dictated it. No inquiry as to the expenses and labor need be made when a patent is extended by a special act of Congress. Bloomer *v.* Stolley, 5 McLean, 158.

It does not follow from this power that Congress may, from time to time, as they think proper, authorize an inventor to recall rights which he has granted to others, or reinvest in him rights of property which he has before conveyed for a fair and valuable consideration. Bloomer *v.* McQuewen, 14 How. 539.

Though changes in the patent laws may be retrospective in their operation, that is not a sound objection to their validity. The power of Congress to legislate upon the subject of patents is plenary, by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents. M'Clurg *v.* Kingsland, 1 How. 202.

The property in inventions exists by virtue of the laws of Congress, and no State has a right to interfere with its enjoyment, or to annex conditions to

the grant. If the patentee complies with the laws of Congress on the subject, he has a right to go into the open market anywhere within the United States, and sell his property. An act of a State legislature that attempts to direct the manner in which patent rights shall be sold in the State, is void. *Ex parte* Robinson, 4 Fish. 186; Hollida *v.* Hunt, 70 Ill. 109; Helm *v.* First National Bank, 43 Ind. 167; Crittenden *v.* White, 9 C. L. N. 110.

If a corporation is the owner of a patent, and its transactions in another State are connected with the sale, use or manufacture of the invention described in the patent, it is not subject to the provisions of the State laws relating to foreign corporations. Grover & Baker S. M. Co. *v.* Butler, 53 Ind. 454.

No State can require that the consideration of a note given for a patent shall be expressed on the face thereof, and make such note subject in the hands of third parties to all defenses which could have been made against the payee. Hollida *v.* Hunt, 70 Ill. 109.

A State law regulating the sale of an article manufactured in pursuance of a patented invention, because it is dangerous, is valid, for there is a manifest distinction between the right of property in the patent and the right to sell the property resulting from the invention or patent. Patterson *v.* Comm. 11 Bush, 311.

The end of the statute is to encourage useful inventions, and to hold forth the exclusive use of his invention for a limited period as an inducement to the inventor. The sole operation of the statute is to enable him to prevent others from using the products of his labor except with his consent. But his own right of using it is not enlarged or affected. There remains in him, as in every other citizen, the power to manage his property or give direction to his labor at his pleasure, subject only to the paramount claims of society which require that his enjoyment may be modified by the exigencies of the community to which he belongs, and regulated by laws which render it subservient to the general welfare if held subject to State control. An attempt by the legislature in good faith to regulate the conduct of a portion of its citizens in a matter strictly pertaining to its internal economy is a legitimate exercise of power, although the law may sometimes indirectly affect the enjoyment of rights flowing from the Federal Government. A patent for a medicine does not confer upon the patentee the right to prescribe it for the sick without complying with the State laws for licensing physicians. Jordan *v.* Dayton, 4 Ohio, 294; Thompson *v.* Staats, 15 Wend. 395.

A party who has a patent for a plan of constructing and drawing lotteries has no right to establish a lottery in a State whose laws prohibit lotteries, because they are pernicious and destructive to frugality and industry, and introductive of idleness and immorality, and against the common good and welfare. Vannini *v.* Paine, 1 Harring. 65.

PROVISIONS

FROM THE UNITED STATES REVISED STATUTES.

TITLE IV.

SEC. 178. In case of the death, resignation, absence, or sickness of the chief of any bureau, or of any officer thereof, whose appointment is not vested in the head of the department, the assistant or deputy of such chief or of such officer, or if there be none, then the chief clerk of such bureau, shall, unless otherwise directed by the President, as provided by section one hundred and seventy-nine, perform the duties of such chief or of such officer until a successor is appointed or such absence or sickness shall cease.

Statute Revised—July 23, 1868, ch. 227, § 2, 15 Stat. 168.
Prior Statute—July 4, 1836, ch. 357, § 2, 5 Stat. 118.

The actual incumbent of a public office is presumed to be in the lawful possession of it, and no affirmative proof of his title is required to support his official acts; therefore the contingency upon which the assistant commissioner is authorized to assume the duties of commissioner, is primarily to be taken to exist from his actual discharge of these duties. The burden of showing the non-existence of the prescribed contingency is upon the party who denies the validity of the ostensible officer's acts. Dorsey Co. *v.* Marsh, 6 Fish. 387; S. C. 9 Phila. 395; Smith *v.* Mercer, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49.

SEC. 179. In any of the cases mentioned in the two preceding sections, except the death, resignation, absence or sickness of the attorney general, the President may, in his discretion, authorize and direct the head of any other department or any other officer in either department whose appointment is vested in the President by and with the advice and consent of the Senate, to perform the duties of the vacant office until a successor is appointed, or the sickness or absence of the incumbent shall cease.

Statute Revised—June 22, 1870, ch. 150, § 2, 16 Stat. 162.
Prior Statute—July 23, 1868, ch. 227, § 3, 15 Stat. 168.

TITLE XI.

CHAPTER ONE.

SEC. 440. There shall also be in the department of the interior, * * * * * *

In the patent office:

One chief clerk, at a salary of two thousand five hundred dollars a year.

One examiner in charge of interferences, at a salary of two thousand five hundred dollars a year.

One examiner in charge of trade-marks, at a salary of two thousand five hundred dollars a year.

Twenty-four principal examiners, one of whom shall be librarian,* at a salary of two thousand five hundred dollars a year each.

Twenty-four first assistant examiners, at a salary of one thousand eight hundred dollars a year each.

Twenty-four second assistant examiners (two of whom may be women), at a salary of one thousand six hundred dollars a year each.

Twenty-four third assistant examiners, at a salary of one thousand four hundred dollars a year each.†

One librarian, at a salary of two thousand dollars a year.

One machinist, at a salary of one thousand six hundred dollars a year.

Three skilled draughtsmen, at a salary of one thousand two hundred dollars a year each.

Thirty-five copyists of drawings, at a salary of one thousand dollars a year each.

One messenger and purchasing clerk, at a salary of one thousand dollars a year.

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* So amended by act of March 3, 1875, ch. 129, 18 Stat. 365.

† By the act of March 3, 1875, ch. 129, 18 Stat. 365, the grade of third assistant examiner in the patent office was abolished, but appropriations are made for that class of officers in the act of August 15, 1876, ch. 287, 19 Stat. 164, and the act of March 3, 1877, ch. 102, 19 Stat. 314.

One skilled laborer, at a salary of one thousand two hundred dollars a year.

Eight attendants in the model-room, at a salary of one thousand dollars a year each.

Eight attendants in the model-room, at a salary of nine hundred dollars a year each.

* Five clerks of class four, one of whom shall receive two hundred dollars additional for services as financial clerk, and shall give bond in such amount as the Secretary of the Interior may determine.

Statute Revised—July 8, 1870, ch. 230, §§ 2, 3, 16 Stat. 198.

Prior Statutes—July 4, 1836, ch. 357, § 2, 5 Stat. 118.—March 3, 1837, ch. 45, § 10, 5 Stat. 194.—May 27, 1848, ch. 47, §§ 1, 3, 9 Stat. 231, 232.—March 3, 1853, ch. 97, § 3, 10 Stat. 209.—April 22, 1854, ch. 52, § 1, 10 Stat. 276.—August 18, 1856, ch. 129, §§ 9, 10, 11 Stat. 91.—March 2, 1861, ch. 88, §§ 4, 7, 12 Stat. 247.—March 3, 1863, ch. 102, § 2, 12 Stat. 796.—March 29, 1867, ch. 17, § 1, 15 Stat. 10.

CHAPTER TWO.

SEC. 441. The Secretary of the Interior is charged with the supervising of public business relating to the following subjects: * * * * *

Fifth. Patents for inventions.

Statute Revised—July 8, 1870, ch. 230, § 1, 16 Stat. 198.

Prior Statute—March 3, 1849, ch. 108, § 2, 9 Stat. 395.

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* So amended, act of March 3, 1877, ch. 102, § 1, 19 Stat. 294.

CHAPTER SIX.

THE PATENT OFFICE.

Sec.
475. Establishment of the patent office.
476. Officers and employees.
477. Salaries.
478. Seal.
479. Bonds of commissioner and chief clerk.
480. Restrictions upon officers and employees.
481. Duties of commissioner.
482. Duties of examiners-in-chief.
483. Establishment of regulations.
484. Arrangement and exhibition of models, &c.
485. Disposal of models on rejected applications.
486. Library.
487. Patent agents may be refused recognition.
488. Printing of papers filed.
489. Printing copies of claims, laws, decisions, &c.
490. Printing specifications and drawings.
491. Additional specifications and drawings.
492. Lithographing and engraving.
492A. Copies of specifications and drawings for executive department.
493. Price of copies of specifications and drawings.
494. Annual report of the commissioner.
495. Custody of collections of exploring expeditions.
496. Disbursements for patent office.

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

Statute Revised—July 8, 1870, ch. 230, § 1, 16 Stat. 198.
Prior Statute—July 4, 1836, ch. 357, § 1, 5 Stat. 117.

SEC. 476. There shall be in the patent office, a commissioner of patents, one assistant commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of the Interior, upon the nomination of the commissioner of patents.

Statute Revised—July 8, 1870, ch. 230, § 2, 16 Stat. 198.
Prior Statutes—July 4, 1836, ch. 357, § 1, 5 Stat. 117.—March 2, 1861, ch. 88, § 2, 12 Stat. 246.—March 3, 1869, ch. 121, § 1, 15 Stat. 294.

SEC. 477. The salaries of the officers mentioned in the preceding section shall be as follows:

The commissioner of patents, four thousand five hundred dollars a year.

The assistant commissioner of patents, three thousand dollars a year.

Three examiners-in-chief, three thousand dollars a year each.

Statute Revised—July 8, 1870, ch. 230, § 4, 16 Stat. 199.

Prior Statutes—July 4, 1836, ch. 357, § 1, 5 Stat. 117.—March 3, 1837, ch. 45, § 10, 5 Stat. 194.—March 2, 1861, ch. 88, §§ 2, 4, 12 Stat. 246.

SEC. 478. The seal heretofore provided for the patent office shall be the seal of the office, with which letters patent and papers issued from the office shall be authenticated.

Statute Revised—July 8, 1870, ch. 230, § 12, 16 Stat. 200.
Prior Statute—July 4, 1836, ch. 357, § 4, 5 Stat. 118.

SEC. 479. The commissioner of patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the treasury a true account of all money received by virtue of their offices.

Statute Revised—July 8, 1870, ch. 230, § 6, 16 Stat. 199.
Prior Statute—July 4, 1836, ch. 357, § 3, 5 Stat. 118.

SEC. 480. All officers and employees of the patent office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the office.

Statute Revised—July 8, 1870, ch. 230, § 16, 16 Stat. 200.
Prior Statute—July 4, 1836, ch. 357, § 2, 5 Stat. 118.

SEC. 481. The commissioner of patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines and other things belonging to the patent office.

Statute Revised—July 8, 1870, ch. 230, § 7, 16 Stat. 199.
Prior Statute—July 4, 1836, ch. 357, § 1, 5 Stat. 117

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

Statute Revised—July 8, 1870, ch. 230, § 10, 16 Stat. 199.
Prior Statute—March 2, 1861, ch. 88, § 2, 12 Stat. 246.

SEC. 483. The commissioner of patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the patent office.

Statute Revised—July 8, 1870, ch. 230, § 19, 16 Stat. 200.

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

Statute Revised—July 8, 1870, ch. 230, § 13, 16 Stat. 200.
Prior Statute—July 4, 1836, ch. 357, § 17, 5 Stat. 125.

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

Statute Revised—July 8, 1870, ch. 230, § 14, 16 Stat. 200.
Prior Statute—March 2, 1861, ch. 88, § 5, 12 Stat. 247.

SEC. 486. There shall be purchased for the use of the patent office a library of such scientific works and period-

icals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

Statute Revised—July 8, 1870, ch. 230, § 15, 16 Stat. 200.

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

Statute Revised—July 8, 1870, ch. 230, § 17, 16 Stat. 200.

SEC. 488. The commissioner of patents may require all papers filed in the patent office, if not correctly, legibly, clearly written, to be printed at the cost of the party filing them.

Statute Revised—July 8, 1870, ch. 230, § 18, 16 Stat. 200.
Prior Statute—March 2, 1861, ch. 88, § 8, 12 Stat. 247.

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

Statute Revised—July 8, 1870, ch. 230, § 20, 16 Stat. 200.

SEC. 490. The commissioner of patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or territorial capitols, and one in the library of Congress, which copies shall be certified under the hand of the commissioner and seal of the patent office, and shall not be taken from the depositories for any other purpose than to be used as evidence.

Statute Revised—January 11, 1871, Res. No. 5, 16 Stat. 590.

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

Statute Revised—January 11, 1871, Res. No. 5, 16 Stat. 590.

SEC. 492. The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the Government, due regard being paid to the execution of the work, after due advertising by the congressional printer under the direction of the joint committee on printing; but the joint committee on printing may empower the congressional printer to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award; or if, in the judgment of the joint committee on printing, the work can be performed under the direction of the commissioner of patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the joint committee on printing may from time to time prescribe.

Statutes Revised—January 11, 1871, Res. No. 5, 16 Stat. 590.—March 24, 1871, ch. 5, § 1, 17 Stat. 2.

SEC. 492 *a*. (Act of March 3, 1875, ch. 130, § 12, 18 Stat. 402.) That it shall be the duty of the commissioner of patents to furnish, free of cost, one copy of the bound volumes of specifications and drawings of patents published by the patent office, to each of the executive departments of Government, upon the request of the head thereof.

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

Statute Revised—March 24, 1871, ch. 5, § 2, 17 Stat. 3.

SEC. 494. The commissioner of patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the patent office as may be useful to Congress or the public.

Statute Revised—July 8, 1870, ch. 230, § 9, 16 Stat. 199.

Prior Statutes—July 3, 1832, ch. 162, § 1, 4 Stat. 559.—March 3, 1837, ch. 45, § 14, 5 Stat. 194.—July 20, 1868, ch. 177, § 7, 15 Stat. 119.

SEC. 495. The collections of the exploring expedition, now in the patent office, shall be under the care and management of the commissioner of patents.

Statute Revised—August 4, 1854, ch. 42, § 8, 10 Stat. 572.

SEC. 496. All disbursements for the patent office shall be made by the disbursing clerk of the Interior Department.

Statute Revised—July 8, 1870, ch. 230, § 69, 16 Stat. 209.

Prior Statute—March 3, 1837, ch. 45, § 14, 5 Stat. 194.—March 3, 1869, ch. 121, § 1, 15 Stat. 294.

TITLE XIII.

CHAPTER SEVEN.

SEC. 629. The circuit courts shall have original jurisdiction, as follows: * * * * * *

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States.

Statute Revised—July 8, 1870, ch. 230, §§ 55, 106, 16 Stat. 206, 215.

Prior Statute—February 21, 1793, ch. 11, § 5, 1 Stat. 322.—February 15, 1819, ch. 19, § 1, 3 Stat. 181.—July 4, 1836, ch. 357, § 14, 5 Stat. 123.

This section does not enlarge or alter the powers of the court over the subject-matter of the bill or the cause of action. It only extends its jurisdiction to parties not before falling within it. Before this provision was adopted, it had been held that a citizen of one State could not obtain an injunction in the circuit court for a violation of a patent right against a citizen of the same State, as no act of Congress authorized such suit. This section removed that objection and gave the jurisdiction, although the parties were citizens of the same State. But in the exercise of the jurisdiction in all cases of granting injunctions to prevent the violation of patent rights, the court is to proceed according to the course and principles of courts of equity in such cases. Sullivan *v.* Redfield, 1 Paine, 441; Evans *v.* Eaton, 3 Wheat. 454; S. C. Pet. C. C. 322; Day *v.* Newark Manuf. Co. 1 Blatch. 628.

The jurisdiction thus conferred upon the circuit courts in patent cases in equity exists independently of the local laws of the State, and is the same in its nature and extent as the equity jurisdiction in England, from which it was derived. Allen *v.* Blunt, 1 Blatch. 480.

There is a broad distinction between the jurisdictional right to take cognizance of a complaint and a denial of the relief which the complainant asks. Although the relief invoked may be refused, it does not follow that it is because the court can not inquire into the merits of the cause and adjudge it accordingly. Want of equity does not imply a defect of jurisdiction. But it is only when the court is without power to pass upon the subject-matter of the complaint, or to grant the relief sought, that its jurisdiction may be challenged. McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275.

A patentee is entitled to call upon an infringer for a discovery and an account of the particulars of the infringement, although the patent has expired. The circuit courts have plenary jurisdiction over all actions, suits, controver-

sies and cases in equity and at law arising under the patent laws. A suit demanding a discovery of the extent of an infringement of a patent right and an account of the profits realized from such infringement is manifestly a case arising under the patent law. Nevins *v.* Johnson, 3 Blatch. 80; Perry *v.* Corning, 6 Blatch. 134.

If the patent expires between the time of filing the bill and the hearing, an account can be ordered and other relief granted, although an injunction to restrain the further use can not issue on account of the expiration of the patent. Imlay *v.* Railroad Co. 1 Fish. 342, s. c. 4 Blatch. 227; Sickles *v.* Gloucester Manuf. Co. 1 Fish. 222; s. c. 3 Wall. Jr. 196; Howes *v.* Nute, 4 Fish. 263; Smith *v.* Baker, 31 Leg. Int. 126; s. c. 21 Pitts. L. J. 141; s. c. 19 I. R. R. 149; s. c. 5 O. G. 496; Wood Paper Co. *v.* Glens' Falls Co. 4 Fish. 561; s. c. 8 Blatch. 513; Jordan *v.* Wallace, 5 Fish. 185; s. c. 8 Phila. 165; Vaughan *v.* Railroad Co. 2 C. L. B. 39; s. c. 9 C. L. N. 255; s. c. 11 O. G. 789; McComb *v.* Beard, 6 Fish. 254; s. c. 10 Blatch. 350; s. c. 3 O. G. 33.

If the defendant dies while the action is pending, the complainant may revive it against the personal representative, in order to obtain an account of the profits. Smith *v.* Baker, 5 O. G. 496; s. c. 31 Leg. Int. 126; s. c. 21 Pitts. L. J. 141; s. c. 19 I. R. R. 149; *contra*, Draper *v.* Hudson, 6 Fish. 327; s. c. 1 Holmes, 208; s. c. 3 O. G. 354.

A suit for an account of profits is properly brought in equity. Dibble *v.* Augur, 7 Blatch. 86.

Where the complainant seeks for an account and discovery, a court of equity has jurisdiction of a bill to recover damages for breach of a contract relating to a patent. Magic Ruffle Co. *v.* Elm City Co. 13 Blatch. 151; s. c. 8 O. G. 773.

If a party is compelled to go into a court of equity to obtain a discovery in a case where the ascertainment of damages is complicated and intricate, and an action at law can not be adequately tried without great difficulty, owing to the nature of the account or other circumstances, the court, after a discovery, will proceed to a decree on the merits. Magic Ruffle Co. *v.* Elm City Co. 11 O. G. 501.

A party is at liberty to select his forum, although he seeks a recovery of money only, and neither seeks nor requires a discovery or other ancillary or further relief. No language could be employed to declare the jurisdiction of the courts at law and in equity more completely concurrent or which would more clearly indicate that the party aggrieved may resort to either. Perry *v.* Corning, 7 Blatch. 195; Anthony *v.* Carroll, 9 O. G. 199; *contra*, Sanders *v.* Logan, 2 Fish. 167.

A court of equity has jurisdiction of a bill to enjoin the use of a patented invention, and for an account of profits by the infringer, although an action at law may be maintained to recover damages. McMillin *v.* Barclay, 5 Fish. 189; s. c. 4 Brews. 275.

An action which raises a question of infringement is an action arising "under the law," and one who has a right to sue for the infringement may sue in the circuit court. Such a suit may involve the construction of a contract as well as the patent, but that will not oust the court of its jurisdiction. If the patent is involved, it carries with it the whole case. Littlefield *v.* Perry,

21 Wall. 205; s. c. 7 O. G. 964; Magic Ruffle Co. *v.* Elm City Co. 13 Blatch. 151; s. c. 8 O. G. 773.

Whenever a contract is made in relation to patent rights which is not provided for and regulated by an act of Congress, the court will not, under this section, have any jurisdiction over a dispute arising out of it. Goodyear *v.* Day, 1 Blatch. 565; Blanchard *v.* Sprague, 1 Cliff. 288; Wilson *v.* Sandford, 10 How. 99; Goodyear *v.* Union Rubber Co. 4 Blatch. 63; Magic Ruffle Co. *v.* Elm City Co. 13 Blatch. 151; s. c. 8 O. G. 773.

The jurisdiction of the circuit court under this section does not extend to a controversy which arises under a contract concerning a patent to be subsequently obtained, rather than under the patent law itself. Nesmith *v.* Calvert, 1 W. & M. 34; Brooks *v.* Stolley, 3 McLean, 523.

If an infringement is proved jurisdiction is conferred, and having power to protect the rights of a party under a patent, the court will take cognizance of other matters as incidental to the infringement. Hence the court has jurisdiction if the defendant has forfeited his right under a license. Bloomer *v.* Gilpin, 4 Fish. 50; Brooks *v.* Stolley, 3 McLean, 523.

A bill to determine the meaning of a license to the complainant, or to ascertain whether the defendant has done an act upon which the right to a reduction of the license fee arises, and thereupon to decree that the complainant is only bound to pay the reduced rent, can not be sustained. An apprehension that the defendant under a condition in the license will deny the right of the complainant to use the licensed invention, or that the defendant threatens to give notice of his election to terminate the license, will not justify an application to a court of equity. Florence Co. *v.* Singer Co. 4 Fish. 329; s. c. 8 Blatch. 113.

Jurisdiction is not controlled solely by the pleadings, but the case itself must be one within the cognizance of the court where the suit is brought. Where it appears at the trial that there is no question involved in the case which it is competent for the court to decide under the pleadings, the case will be dismissed, notwithstanding, the allegations of the bill may be sufficient to authorize the court to take cognizance of the suit. Blanchard *v.* Sprague, 1 Cliff. 288.

If a patentee sells the thing patented to a purchaser in violation of the license, the licensee can not maintain a bill in equity against the patentee and purchaser in the circuit court, without regard to the citizenship of the parties, for his rights arise under contract. Hill *v.* Whitcomb, 1 Holmes, 317; s. c. 5 O. G. 430.

If the parties are citizens of the same State, the circuit court has no jurisdiction over a bill to obtain the cancellation of a license on account of the invalidity of the patent. Merserole *v.* Union Collar Co. 3 Fish. 483; s. c. 6 Blatch. 356.

If the parties are citizens of the same State, the circuit court can not entertain a bill to compel the specific performance of a contract to assign a patent. Burr *v.* Gregory, 2 Paine, 426.

The mere fact that a bill prays for an account of the profits, in asking for a specific performance, will not give the court jurisdiction. Burr *v.* Gregory, 2 Paine, 426.

A junior patentee can not maintain an action against a prior patentee for the purpose of obtaining an adjudication that his patent does not conflict with the prior patent. Celluloid Manuf. Co. *v.* Goodyear, D. V. Co. 13 Blatch. 375; S. C. 10 O. G. 41.

The circuit court has no jurisdiction over any proceeding to vacate a patent and declare it null *ab initio*, upon the ground of false suggestion, or the ground that the government has undertaken to grant that which by law it can not grant. Att. General *v.* Rumford Works, 9 O. G. 1062.

The attorney general has no authority, as such and in his own name, to file an information or commence proceedings by bill in equity to annul a patent. Att. General *v.* Rumford Works, 9 O. G. 1062.

The circuit court may have jurisdiction over a controversy on account of the residence of the defendant, even if it has not on account of the subject. Nesmith *v.* Calvert, 1 W. & M. 34.

If the parties are citizens of different States, and the amount claimed and in controversy exceeds five hundred dollars, the court has jurisdiction over a claim arising from a contract. Bloomer *v.* Gilpin, 4 Fish. 50.

If the circuit court in a patent case has jurisdiction over the subject-matter and parties, the correctness of the decree can not be called in question collaterally. Allen *v.* Blunt, 1 Blatch. 480.

Copyright.

A court of equity has jurisdiction of a bill for an infringement of a copyright, although there is a remedy at law, for that is less appropriate, efficient and ample. Pierpont *v.* Fowle, 2 W. & M. 23.

The title of the complainant and the infringement may be adjudicated in a court of equity, without having been first determined at law. Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; S. C. 5 C. L. N. 1.

A court of equity has no jurisdiction to enforce penalties and forfeitures incurred under the statute relating to copyrights. Stevens *v.* Gladding, 17 How. 447; Stevens *v.* Cady, 2 Curt. 200.

If the controversy in regard to a copyright arises out of a contract, and not under the statute, the circuit court has no jurisdiction over it. Pulte *v.* Derby, 5 McLean, 328; Little *v.* Hall, 18 How. 165.

The circuit court has no jurisdiction of a bill in equity to protect the rights of an author at common law, where both parties are citizens of the same State. Boucicault *v.* Hart, 13 Blatch. 47.

CHAPTER ELEVEN.

SEC. 699. A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute.

First. Any final judgment at law or final decree in equity of any circuit court or of any district court acting

as a circuit court, or of the Supreme Court of the District of Columbia, or of any territory, in any case touching patent rights or copyrights.

Statute Revised—July 8, 1870, ch. 230, §§ 56, 107, 16 Stat. 207, 215.

Prior Statutes—Feb. 15, 1819, ch. 19, §§ 1, 3 Stat. 181.—July 4, 1836, ch. 357, § 16, 5 Stat. 123.—Feb. 18, 1861, ch. 37, § 1, 12 Stat. 130.

General Principles.

An appeal or writ of error is allowed to all parties, without regard to the sum in controversy. Philip *v.* Nock, 13 Wall. 185.

Whenever a contract is made in relation to patents, which is not provided for and regulated by Congress, the parties, if any dispute arises, stand upon the same ground with other litigants as to the right of appeal, and the decree can not be revised unless the matter in dispute exceeds five thousand dollars. Wilson *v.* Sandford, 10 How. 99.

Citation.

A citation signed by the clerk and not by the judge is irregular. Chaffee *v.* Hayward, 20 How. 208.

An appearance of the defendant in error without making a motion to dismiss during the first term is a waiver of any irregularity in the citation, and is an admission that he has received notice to appear to the writ of error. Chaffee *v.* Hayward, 20 How. 208.

The absence of counsel is no excuse for the omission to move to dismiss the writ of error. Chaffee *v.* Hayward, 20 How. 208.

If the defendant in error appears in the Supreme Court, and pleads to entitle him to appear by counsel and argue the cause, it is too late after the case has been remanded to the circuit court to raise the objection that no writ of error was sued out to remove the record into the Supreme Court, and that the judgment is, therefore, still in force and unreversed. It will be presumed that all formal objections, and particularly one to the want of a writ, were waived by consent of parties. Evans *v.* Eaton, 3 Wash. C. C. 443; S. C. 7 Wheat. 356.

If the defendant in error does not elect to have the writ of error dismissed on account of the failure of the plaintiff to appear, but files an argument, the court will decide the case. New York *v.* Ransom, 1 Fish. 252; S. C. 23 How. 487.

Bill of Exceptions.

The bill of exceptions affords the only means of ascertaining the precise state of facts on which an instruction was given. Whether the report of the evidence as set forth in the bill of exceptions may or may not be incomplete or imperfectly stated, can not be known in an appellate court. Bills of exception, when properly taken and duly allowed, become a part of the record, and as such can not be contradicted. Chaffee *v.* Boston Belting Co. 22 How. 217.

The Supreme Court can not notice the rules of the inferior courts, unless they are made a part of the bill of exceptions. Packet Co. *v.* Sickles, 19 Wall. 611.

Exceptions to Evidence.

If no exception is taken to the competency or sufficiency of evidence, either generally or for any particular purpose, there is no necessity for putting any portion of it in the bill of exceptions, when the opinion of the court presents a general principle of law. Pennock *v.* Dialogue, 2 Pet. 1; s. c. 4 Wash. C. C. 538.

If a witness is rejected as incompetent, and the facts which the witness offered to prove are not stated in the bill of exceptions, the exception can not be disregarded upon the idea that the testimony could not have been material or could not have changed the result of the verdict. Vance *v.* Campbell, 1 Fish. 483; s. c. 1 Black, 427.

Parties are not at liberty to desert the purpose stated by them, and to show the pertinency or relevancy of the evidence for any other purpose not then suggested to the court. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448.

It is incumbent on those who insist upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448; Blanchard *v.* Putnam, 3 Fish. 186; s. c. 8 Wall. 420; s. c. 2 Bond, 84.

It is incumbent on the party objecting to the ruling to show his right to introduce the rejected evidence. Silsby *v.* Foot, 14 How. 218; s. c. 1 Blatch. 445.

A party is not deprived of any right if a paper was not legal evidence upon the particular point for which alone it was offered, or if its reception, accompanied by proper instructions to the jury concerning its legal effect, must necessarily have assisted the opposite party. Silsby *v.* Foot, 14 How. 218; s. c. 1 Blatch. 445.

If a party is not deprived of any right by the rejection of evidence, it is not cause for reversing a judgment that an erroneous reason was assigned for rejecting it. Silsby *v.* Foote, 14 How. 218; s. c. 1 Blatch. 445.

Exceptions to Instructions.

The exceptions to the charge of the court should be to the points ruled by the court, and not to the charge as published at length. Stimpson *v.* West Chester R. R. Co. 4 How. 380.

An omission of the court to instruct the jury upon particular points is not a ground for a bill of exceptions. Allen *v.* Blunt, 2 W. & M. 121.

A direction to the jury to render a verdict in favor of the defendant is only proper where it is entirely clear that the plaintiff can not recover. Klein *v.* Russell, 19 Wall. 433.

It is no ground of reversal that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point. If he does not, it is a

waiver of it. The court can not be presumed to do more in ordinary cases than to express its opinion upon the questions which the parties themselves have raised at the trial. Pennock *v.* Dialogue, 2 Pet. 1; s. c. 4 Wash. C. C. 538.

The substance only of the charge is to be examined, and if it appears upon the whole that the law was justly expounded to the jury, general expressions which may need and would receive qualification if they were the direct point in judgment, are to be understood in such restricted sense. Evans *v.* Eaton, 7 Wheat. 356; s. c. 3 Wash. C. C. 443.

It is clearly error for the court in its instruction to the jury to assume a material fact as proved, of which there is no evidence in the case, and when the finding of the jury accords with the theory of the instruction thus assumed without evidence, the error is of a character to deserve correction. Chaffee *v.* Boston Belting Co. 22 How. 217.

It is unnecessary and inconvenient, to spread the charge *in extenso* upon the record. Evans *v.* Eaton, 7 Wheat. 356; s. c. 3 Wash. C. C. 443.

Practice.

The admission or rejection of evidence after a case has been closed, is a matter of discretion and practice, in respect to which the Supreme Court possesses no authority to revise the decision of the circuit court. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448.

It rests in the discretion of the court, when a juror is withdrawn on account of sickness before any evidence is given, whether such withdrawal shall be treated simply as occasioning a vacancy on a still existing panel, or as breaking up the panel altogether, and no error can be assigned upon it. Silsby *v.* Foot, 14 How. 218; s. c. 1 Blatch. 445.

On a writ of error, a point can not be considered which was not made in the court below. Klein *v.* Russell, 19 Wall. 433.

If the damages are too large, the fault lies with the jury, when they are properly instructed, and can not be corrected in the Supreme Court on a writ of error. Hogg *v.* Emerson, 11 How. 587; s. c. 2 Blatch. 1.

The Supreme Court may take cognizance of a case where judgment is entered upon an agreed statement of the parties, without any express or specific exceptions to the rulings of the circuit court. Stimpson *v.* Balt. & Sus. R. R. Co. 10 How. 329.

If the merits of the controversy have been determined in a previous case, the cause will be remanded without argument upon mere technical questions. However the points of special pleading may be ruled, they can have no material influence on the ultimate decision of the case, because if it is found that errors in pleading have been committed by either party injurious to his rights, an opportunity will be afforded him to correct them in some subsequent proceeding, so as to bring the real points in controversy fairly before the court. Smith *v.* Ely, 15 How. 137; s. c. 5 McLean, 76.

After a case has been carried to the Supreme Court, and decided, and a mandate issued to the court below, if a second writ of error is sued out, it brings up for revision nothing but the proceedings subsequent to the mandate.

None of the questions which were before the court on the first writ of error can be reheard or re-examined upon the second. Sizer *v.* Many, 16 How. 98.

If one party pays the counsel fees on both sides, both in the court below and on appeal, he will be deemed to have such control over both the preparation and argument of the cause as to make the suit collusive, and on motion a decree of affirmance may be rescinded, the mandate recalled, and the bill dismissed. Gardner *v.* Goodyear Dental Vulcanite Co. 6 Fish. 329; S. C. 3 O. G. 295.

If the complainant buys in the patent under which the suit is defended, and thus owns both sides of the litigation, the suit will be dismissed on the motion of a third party, whose rights would be seriously affected if the question of law were decided in the manner that both parties to the suit desire it to be. They have the same interests, and those interests are in conflict with the interest of such third party, and for that reason the case should not be heard. Wood Paper Co. *v.* Heft, 3 Fish. 316; S. C. 8 Wall. 333.

Appeal.

An appeal can only be taken from a final decree. A decree is not to be considered final for the purposes of appeal, until after the coming in of the master's report. Potter *v.* Mack, 3 Fish. 428.

A decree for a perpetual injunction, with a reference to a master to ascertain the damages by reason of the infringement, is not a final decree. Barnard *v.* Gibson, 7 How. 650.

A motion to file an answer after default is generally addressed to the discretion of the court, and is not subject to revision in the Supreme Court. Dean *v.* Mason, 20 How. 198.

A motion by a party to whom the complainant's title has been assigned since the commencement of the suit for leave to file a supplemental bill is in the discretion of the court, and not a subject of revision. Dean *v.* Mason, 20 How. 198.

The granting of permission to retract an admission made in the answer is a matter in the discretion of the circuit court, and will not be reviewed in the Supreme Court. Jones *v.* Morehead, 1 Wall. 155.

Costs and expenses are not matters positively limited by law, but are allowed in the exercise of a sound discretion. No appeal lies from a mere decree respecting costs and expenses. Canter *v.* Am. Ins. Co. 3 Pet. 307.

An objection to the misjoinder of parties complainant, taken for the first time in the Supreme Court in a case where the parties consented to a decree, come too late. Livingston *v.* Woodworth, 15 How. 546.

Exceptions taken to a master's report by a party who does not appeal can not be considered. Rubber Co. *v.* Goodyear, 9 Wall. 786; S. C. 2 Fish. 499; 2 Cliff. 351.

If the master's report is in any particular erroneous, it is incumbent on the party to point out the error by an exception filed pursuant to the rules on that subject. If no exception is filed, it is too late to object to the error in the Supreme Court for the first time. Kinsman *v.* Parkhurst, 18 How. 289; S. C. 1 Blatch. 488.

The appeal and bond given in pursuance thereof do not vacate or suspend the order of injunction. They affect only the amount adjudged as damages and costs. Mowry *v.* Whitney, 3 Fish. 157; S. C. 14 Wall. 620.

The defendant must procure sureties to sign the bond, although he is amply responsible for the whole decree. American Pavement Co. *v.* Elizabeth, 6 O. G. 772.

The practice of requiring bond in double the amount of the decree need not be always followed, for the law does not require that the security shall be in any fixed proportion to the decree. American Pavement Co. *v.* Elizabeth, 6 O. G. 772.

The taking of an appeal and the filing of an appeal bond will not prevent the enforcement of that part of the decree which provides for the payment to the master of the fees due him for services rendered for the defendant. Myers *v.* Dunbar, 8 O. G. 321.

CHAPTER TWELVE.

SEC. 711. The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned shall be exclusive of the courts of the several States. * * * * *

Fifth. Of all cases arising under the patent right or copyright laws of the United States.

The exclusive right of the inventor to make and vend his newly-discovered implement is wholly statutory. Where a statute confers a right and prescribes adequate means for protecting it, the proprietor is confined to the statutory remedy. A State court can not, therefore, entertain a bill in equity to enjoin an infringement. Dudley *v.* Mayhew, 3 N. Y. 9; Parkhurst *v.* Kinsman, 6 N. J. Eq. 600; Kempton *v.* Bray, 99 Mass. 350; Tomlinson *v.* Battel, 4 Abb. Pr. 266.

If two patents have been issued to different parties, the State courts have no jurisdiction to settle their conflicting claims, or to enjoin the subsequent patentee at the instance of the prior patentee. Gibson *v.* Woodworth, 8 Paige, 132.

A State court has no jurisdiction of an action brought by a patentee to restrain another from issuing circulars warning parties against purchasing a certain article, if the latter claims the right to do so under a patent. Hovey *v.* Rubber Tip Pencil Co. 33 N. Y. Sup. 522; S. C. 57 N. Y. 119.

The jurisdiction vested in the circuit courts is exclusive, and a State court has no jurisdiction over an action for an infringement of a patent. Parsons *v.* Ballard, 7 Johns. 144.

If a contract for a sale of a patent right is rescinded, and a note given for the return of the money paid thereon, the defendant in an action on the note

can not plead the damages sustained by the plaintiff's infringement after the rescission as a set-off to the note. Smith *v.* McClelland, 11 Bush, 523.

A State court has no jurisdiction over an action of assumpsit to recover upon a *quantum valebat* for the use of a patented invention. Batten *v.* Kear, 2 Phila. 301.

A State court has no jurisdiction of an action by an assignee to enjoin an infringer or recover damages. Stone *v.* Edwards, 35 Tex. 556.

A State court can not entertain a bill for discovery and an injunction against an execution issued upon a judgment for damages rendered in an action for the infringement of a patent. Kendall *v.* Winsor, 6 R. I. 453.

If a State court has jurisdiction over the rights of parties arising out of a contract relating to a patent, it may incidentally inquire into the validity of the patent. Burrall *v.* Jewett, 2 Paige, 134; Sherman *v.* Champlain Co. 31 Vt. 162; Lindsay *v.* Roraback, 4 Jones Eq. 124; Slemmer's Appeal, 58 Penn. 155; Parkhurst *v.* Kinsman, 6 N. J. Eq. 600; Rich *v.* Atwater, 16 Conn. 409; Middlebrook *v.* Broadbent, 47 N. Y. 443; Rice *v.* Garnhart, 34 Wis. 453; Saxton *v.* Dodge, 57 Barb. 84. *Contra*, Elmer *v.* Pennel, 40 Me. 430.

In an action in a State court to recover the price agreed to be paid for a patent right, the defendant, for the purpose of showing a want or failure of consideration, may prove that the patent is void for want of novelty or utility. Rice *v.* Garnhart, 34 Wis. 453, Street *v.* Silver, Brightly, 96.

A State court has jurisdiction over an action to recover damages for fraud in the sale of a patent right. Hunt *v.* Hoover, 24 Iowa, 231; Warren *v.* Cole, 15 Mich. 265.

If a party who has discovered a process without taking out a patent therefor, imparts the secret to another, under an agreement not to divulge it, he may maintain an action in a State court for an injunction and for damages for breach of the contract by the latter. Hammer *v.* Barnes, 26 How. Pr. 174.

If an inventor employs a mechanic to perfect his invention, under an agreement that the latter shall take out patents for the improvements, and assign them to the former, he may maintain an action in a State court to obtain an assignment, and recover the profits received in violation of the agreement. Binney *v.* Annan, 107 Mass. 94.

A State court has jurisdiction of an action to rescind a contract for a sale of an interest in a patent on the ground of fraud. Page *v.* Dickerson, 28 Wis. 694.

A State court has jurisdiction of an action by a manufacturer against a patentee, for falsely and intentionally advertising that his manufactures were an infringement of the patent. Snow *v.* Judson, 38 Barb. 210.

If a patentee in an assignment warrants the novelty of the invention, a State court has jurisdiction of an action for the breach of a warranty. Wright *v.* Wilson, 11 Rich. 144.

A State court has jurisdiction over a suit to rescind a contract for the sale of a patent right, on account of a fraud on the part of the patentee in the sale thereof. Lindsay *v.* Roraback, 4 Jones Eq. 124.

A State court has jurisdiction of an action by a patentee to recover damages for breach of an agreement not to use the thing patented. Billings *v.* Ames, 32 Mo. 265.

A State court has jurisdiction of an action by an inventor to recover the consideration stipulated to be paid to him by another for the privilege of taking out a patent therefor in his own name. Lockwood *v.* Lockwood, 33 Iowa, 509.

If a party agrees to improve machinery for a certain purpose, and the other party agrees to pay a certain price therefor, the defendant in an action on the contract for the stipulated price, may show that the alleged improvement for which the patent was granted is worthless. McDougall *v.* Fogg, 2 Bosw. 387.

The statute does not make the jurisdiction of the Federal courts over actions for the protection of the rights of authors at common law in their manuscripts exclusive, or deprive State courts of jurisdiction over such actions. At most it gives parties within its provisions, and not claiming the benefits of a copyright under the laws of the United States, a cumulative remedy and a choice of tribunals. The jurisdiction of the State courts in cases in which it had before been exercised, is not taken away or in any respect impaired. Palmer *v.* DeWitt, 47 N. Y. 532; S. C. 40 How. Pr. 293; S. C. 5 Abb. Pr. (N. S.) 13; S. C. 36 How. Pr. 22; S. C. Sweeny, 530; Woolsey *v.* Judd, 4 Duer, 379; Jones *v.* Thorne, 1 N. Y. Leg. Obs. 408.

CHAPTER SEVENTEEN.

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

Statute Revised—July 8, 1870, ch. 230, § 57, 16 Stat. 207.

Prior Statutes—Apr. 10, 1790, ch. 7, §§ 3, 6, 1 Stat. 111.—July 4, 1836, ch. 357, § 4, 5 Stat. 118.—March, 3, 1837, ch. 45, § 2, 5 Stat. 191.—March 2, 1861, ch. 88, § 15, 12 Stat. 249.

A certified copy of an assignment is *prima facie* evidence of the genuineness of the original, and is competent evidence, and absolute evidence of the correctness of the copies from the record. Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361; Parker *v.* Haworth, 4 McLean, 370; Brooks *v.* Jenkins, 3 McLean, 432.

A certified copy of a transfer of an interest in a patent which is not required by law to be recorded is not legal proof of such transfer. Sherman *v.* Champlain Co. 31 Vt. 162.

A copy of a specification alone is not competent evidence to prove what was contained in the patent, for it affords no proof of the granting, or of the

existence of a patent based upon the specification. Nor is the mere certificate of the commissioner, though authenticated by his official seal, that such patent was issued and remains in full force, competent evidence of the facts so certified. The proper evidence of the patent is a copy of the patent itself duly authenticated by the official seal and certificate of the commissioner. Davis *v.* Gray, 17 Ohio St. 330.

Patents are public records. All persons are bound to take notice of their contents, and consequently should have a right to obtain copies of them. These records being in the care and custody of the commissioner of patents, it is his duty to give authenticated copies to any person who shall demand the same, as soon as he conveniently can, on payment of the legal fees. Where there is a right on the one side and a corresponding duty on the other, a refusal to perform such duty on the reasonable request of the party entitled to demand it, will subject the officer to an action. But the party entitled to such services, must request in a proper manner. He has no right to accompany his demand with personal insult or vulgar abuse of the officer. Those to whom the people have committed high trusts are entitled at least to common courtesy, and are not bound to submit to the insolence or ill temper of those who disregard the decencies of social intercourse. A demand accompanied with rudeness and insult is not a legal demand. Boyden *v.* Burke, 14 How. 575.

The commissioner is in error in refusing to comply with a second demand on account of former misconduct, or to enforce an apology by withholding the party's rights. Ill manners or bad temper do not work a forfeiture of men's civil rights. While the want of an apology for previous rudeness and insult may well justify the commissioner in refusing all social intercourse with the party, yet it cannot release him from the obligations imposed upon him by his official station, or entitle him to disregard the rights guaranteed to others by the laws of the land. Boyden *v.* Burke, 14 How. 575.

A clerk whose employment consists chiefly in making examinations in relation to assignments and other papers recorded and filed in the office, is a competent witness to prove that no assignment has ever been recorded. Stone *v.* Palmer, 28 Mo. 539.

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

Statute Revised—July 8, 1870, ch. 230, § 57, 16 Stat. 207.

A certificate of the commissioner of the correctness of a translation of a foreign patent contained in a volume in the library of the patent office is not competent evidence. Gaylord *v.* Case, 1 C. L. B. 382.

SEC. 894. The printed copies of specifications and

drawings of patents, which the commissioner of patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerks' offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained.

Statute Revised—Jan. 11, 1871, Res. 5, 16 Stat. 590.

SEC. 972. In all recoveries under the copyright laws, either for damages, forfeitures, or penalties, full costs shall be allowed thereon.

Statute Revised—July 8, 1870, ch. 230, § 108, 16 Stat. 218.
Prior Statute—Feb. 3, 1831, ch. 16, § 12, 4 Stat. 438.

SEC. 973. When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the patent office before the suit was brought.

Statute Revised—July, 8, 1870, ch. 230, § 60, 16 Stat. 207.
Prior Statute—July 4, 1836, ch. 357, § 15, 5 Stat. 123.

If the verdict was rendered upon all the claims, affirming their validity and the novelty of the invention claimed in each, the mere fact that the plaintiff disclaimed one or more of the claims after the trial and verdict, does not deprive him of his right to costs. Peek *v.* Frames, 5 Fish. 211.

TITLE LX.

PATENTS, TRADE-MARKS, AND COPYRIGHTS.

CHAPTER ONE.

PATENTS.

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Sec. 4883. All patents shall be issued in the name of the United States of America, under the seal of the pat-

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Statute Revised—July 8, 1870, ch. 230, § 21, 16 Stat. 200.

Prior Statutes—April 10, 1790, ch. 7, § 1, 1 Stat. 109.—Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318.—July 4, 1836, ch. 357, § 5, 5 Stat. 118.

Principles of Construction.

Patent laws should be liberally construed to meet the wise and beneficent object of the legislature. Patentees are a meritorious class, and the courts will give them all the aid and protection which the law allows. Commissioner *v.* Whiteley, 4 Wall. 522; Brooks *v.* Jenkins, 3 McLean, 432; Grant *v.* Raymond, 6 Pet. 218.

The right of property which a patentee has in his invention, and his right to its exclusive use, are derived altogether from the statute. An inventor has no right of property in his invention upon which he can maintain suit, unless he obtains a patent for it according to the statute, and his rights are to be regulated and measured by its provisions, and can not go beyond them. Brown *v.* Duchesne, 19 How. 183; S. C. 2 Curt. 371.

When Congress are legislating to protect inventors, their attention is necessarily attracted to the authority under which they are acting, and it ought not lightly to be presumed that they intended to go beyond it, and exercise another and distinct power conferred on them for a different purpose. Brown *v.* Duchesne, 19 How. 183; S. C. 2 Curt. 371.

A special act extending a patent must be construed in connection with the statute. They are statutes *in pari materia*, and all relate to the same subject, and must be construed together. Bloomer *v.* McQuewen, 14 How. 539; Jordan *v.* Dobson, 4 Fish. 232; S. C. 7 Phila. 533; S. C. 2 Abb. U. S. 398.

A special act of Congress in favor of a patentee, extending the time beyond that originally limited, must be considered as engrafted on the general law. Bloomer *v.* McQuewen, 14 How. 539.

An act of Congress which gives a patent for an invention will, if it is ambiguous, be construed to give damages for the construction or use of the invention only after the grant of the patent, so that it may not be deemed to create rights retrospectively, or make men liable for damages for acts lawful at the time when they were done. Blanchard *v.* Sprague, 2 Story, 164; S. C. 3 Sumner, 535.

The courts can never presume that Congress intended to decide that an individual is an author or inventor in a general act, the words of which do not render such a construction unavoidable. Evans *v.* Eaton, 3 Wheat. 454; S. C. Pet. C. C. 322.

The grant of an exclusive privilege to an invention for a limited time does not imply a binding and irrevocable contract with the people that at the expiration of the period the invention shall become their property. Congress may renew the patent right at the end of the period or decline to do so. Evans *v.* Eaton, 3 Wheat. 454; S. C. Pet. C. C. 322.

Signature.

As the Secretary of the Interior must by law sign the patent, as well as the commissioner, should the patent be altered after he signs it, he must be made aware of any such subsequent alteration and sanction it before his signature can be regarded as verifying the amended patent. The entry of his sanction upon the letters patent themselves would be a convenient mode of perpetuating the evidence of it, but in principle nothing seems to be demanded beyond his assent or ratification. Woodworth *v.* Hall, 1 W. & M. 389.

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

Statute Revised—July 8, 1870, ch. 230, § 22, 16 Stat. 201.

Prior Statutes—April 10, 1790, ch. 7, § 1, 1 Stat. 109.—February 21, 1793, ch. 11, § 1, 1 Stat. 318.—July 4, 1836, ch. 357, § 5, 5 Stat. 118.—March 2, 1861, ch. 88, § 16, 12 Stat. 249.

Rules of Construction.

Patents for inventions under the fair application of the rule *ut res magis valeat quam pereat*, are, if practicable, to be so interpreted as to uphold and not to destroy the right of the inventor. Turrill *v.* Railroad Company, 1 Wall. 491; Stover *v.* Halstead, 13 Blatch. 95; S. C. 8 O. G. 558; Ryan *v.* Goodwin, 3 Sumner, 514; Russell *v.* Klein, 19 Wall. 433; Allen *v.* Hunter, 6 McLean, 303; Ingels *v.* Mast, 6 Fish. 415; Davoll *v.* Brown, 1 W. & M. 53; Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 4 O. G. 691; Rubber Co. *v.* Goodyear, 9 Wall. 788; S. C. 2 Fish. 499; S. C. 2 Cliff. 351; Goodyear *v.* Berry, 3 Fish. 439; S. C. 2 Bond, 189; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224; Brown *v.* Guild, 23 Wall. 181.

This principle is not to be carried so far as to exclude what is in it, or to interpolate anything which it does not contain. Rubber Co. *v.* Goodyear, 9 Wall. 788; S. C. 2 Fish. 499; S. C. 2 Cliff. 351.

The rights secured by a patent for an invention or discovery are as much property as anything else real or incorporeal. The titles by which they are held, like other titles, should not be overthrown upon doubts or objections capable of a reasonable and just solution in favor of their validity. Blandy *v.* Griffith, 3 Fish. 609.

Patents for inventions are treated as a just reward to ingenious men, and as highly beneficial to the public, not only by holding out suitable encouragement to genius, and talents, and enterprise, but as ultimately securing to the

whole community great advantages from the free communication of secrets and processes, and machinery, which may be most important to all the great interests of society, to agriculture, to commerce, and to manufactures, as well as to the cause of science and art. Specifications are therefore clearly entitled to a liberal construction, since they are granted not as restrictions upon the rights of the community, but "to promote science and useful arts." Blanchard *v.* Sprague, 2 Story, 164; S. C. 3 Sumner, 535; Bussey *v.* Wagoner, 9 O. G. 300; S. C. 23 Pitts. L. J. 131; Treadwell *v.* Parrott, 3 Fish. 124; S. C. 5 Blatch. 369; Dennis *v.* Cross, 6 Fish. 138; S. C. 3 Biss. 389; Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 238; Carew *v.* Boston Elastic Fabric Co. 5 Fish. 90; S. C. 1 Holmes, 45; S. C. 1 O. G. 91; Singer *v.* Walmsley, 1 Fish. 558; Birdsell *v.* McDonald, 6 O. G. 682; Corning *v.* Burden, 15 How. 252; Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356; Winans *v.* Denmead, 15 How. 330; 4 Am. L. J. 498; Allen *v.* Hunter, 6 McLean, 303; Parker *v.* Stiles, 5 McLean, 44; Ames *v.* Howard, 1 Sumner, 482; Lowell *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Bloomer *v.* Stolley, 5 McLean, 158; Parker *v.* Haworth, 4 McLean, 370; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43; Hogg *v.* Emerson, 6 How. 437; S. C. 2 Blatch. 1; Ames *v.* Howard, 1 Sumner, 482; Davoll *v.* Brown, 1 W. & M. 53; Seymour *v.* Osborne, 11 Wall. 516; S. C. 3 Fish. 555.

It is the duty of the court in construing a patent, to so construe it, if it can without doing violence to the language used, as not to defeat the claim of the patentee, but to give to the patentee what he has actually invented, and all that he has actually invented—in other words, to make the claim commensurate with the invention which has been actually made by the patentee. Ransom *v.* New York, 1 Fish. 252; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Parker *v.* Stiles, 5 McLean, 44; Coffin *v.* Ogden, 3 Fish. 640; S. C. 7 Blatch. 61; Union Sugar Refinery *v.* Mathiessen, 2 Fish. 600; Whipple *v.* Middlesex Co. 4 Fish. 41; Roots *v.* Hyndman, 6 Fish. 439; S. C. 4 O. G. 29; Rogers *v.* Sargent, 7 Blatch. 507; Hovey *v.* Stevens, 3 W. & M. 17; Andrews *v.* Carman, 13 Blatch. 307; S. C. 9 O. G. 1011; Estabrook *v.* Dunbar, 10 O. G. 909; Judson *v.* Moore, 1 Fish. 544; S. C. 1 Bond, 285; Johnson *v.* Linen Co. 33 Conn. 436; Smith *v.* Fay, 6 Fish. 446; Clark *v.* Kennedy Manuf. Co. 11 O. G. 68; Goodyear *v.* Providence Rubber Co. 2 Fish. 499; S. C. 9 Wall. 788; S. C. 2 Cliff. 35; Hamilton *v.* Ives, 6 Fish. 244; S. C. 3 O. G. 30; Francis *v.* Mellor, 5 Fish. 153; S. C. 8 Phila. 157; S. C. 5 A. L. T. (U. S.) 237; S. C. 1 O. G. 48; Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 4 O. G. 31.

A patent should be construed in such a way, if possible, as to conform to the actual invention. Hale *v.* Stimpson, 2 Fish. 565; Stimpson *v.* Woodman, 3 Fish. 98; S. C. 10 Wall. 317; Taylor *v.* Garretson, 5 Fish. 116; S. C. 9 Blatch. 156; Bussey *v.* Wagoner, 9 O. G. 300; S. C. 23 Pitts. L. J. 131; Barnes *v.* Straus, 5 Fish. 531; S. C. 9 Blatch. 553; S. C. 2 O. G. 62; Gallahue *v.* Butterfield, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645.

The patentee may so restrict his claim as to cover less than what he invented, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise. Winans *v.* Denmead, 15 How. 330; S. C. 4 Am. L. J. 498.

The intention of the inventor so as to effect the object designed, is to govern the construction of the language he employs. Inventors are not always educated or scientific men. Some most useful inventions have sprung from an illiterate source. Genius is not always blessed with the power of language. Courts look to the manifest design in order to remove any ambiguity arising from the terms employed; but this ambiguity must not be such as would perplex an ordinary mechanic in the art to which it applies. Page *v.* Ferry, 1 Fish. 298.

There may be a liberality of construction very injurious to the public, especially if it permits a patentee to couch his specification in such ambiguous terms that its claims may be contracted or expanded to suit the exigency. Parker *v.* Sears, 1 Fish. 93.

The same exact rule of interpretation is not to be applied at all times, but such in each case as will best enable the court to arrive at the meaning intended. Welling *v.* Rubber Co. 7 O. G. 606.

It is not necessary to classify a claim and to draw deductions from such classification. That is generally an unsafe mode of reasoning. Howe *v.* Morton, 1 Fish. 586.

What may be Referred to.

It is the duty of the patentee to sum up his invention in clear and determinate terms, and his summing up is conclusive upon his right and title. Wyeth *v.* Stone, 1 Story, 274; Dennis *v.* Cross, 3 Biss. 389; Hovey *v.* Stevens, 3 W. & M. 17; Wheeler *v.* McCormick, 6 Fish. 551; S. C. 11 Blatch. 334; 4 O. G. 692.

The patentee is restricted to his claim. It is true that the whole patent, including the specifications and the drawings, is to be taken into consideration, but the court looks at them only for the purpose of placing a proper construction on the claim. Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Blatch. 168; Johnson *v.* McCullough, 4 Fish. 170; Brooks *v.* Fisk, 15 How. 212; Rich *v.* Close, 4 Fish. 279; S. C. 8 Blatch. 1.

The claim is the attempt on the part of the inventor to describe the very thing which he supposes he has invented, and for which he asks the patent. Many *v.* Jagger, 1 Blatch. 372.

The claim must be construed as favorably to the patentee as the language of the claim, the state of the art, and the extent and character of his actual invention will allow. Burdin *v.* Corning, 2 Fish. 477.

The claim contained in a patent is to be construed with reference to the state of the art at the time of the invention. Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87; Tilghman *v.* Mitchell, 2 Fish. 518; Goodyear *v.* Wait, 3 Fish. 242; S. C. 5 Blatch. 468; Whipple *v.* Middlesex Co. 4 Fish. 41; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224; Rogers *v.* Sargent, 7 Blatch. 507.

In construing a patent, the courts, in the first place, generally look to the claim, which by law is required to be a summing up of the particulars of the invention for which the applicant desires a patent. If that claim is vague and uncertain, then reference is made to the specification and drawings, together with such other exhibits as may aid in giving a construction to the patent.

Haselden *v.* Ogden, 3 Fish. 378; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29; Whipple *v.* Middlesex Co. 4 Fish. 41; Johnson *v.* Root, 1 Fish. 351.

In order to determine what the patentee claims as his invention, the court must look to the specification annexed to the patent, which is made by law a portion of the patent. In determining the construction of the claim, it is proper that the court should refer to the whole specification, and consider the whole of it in connection. Ransom *v.* New York, 1 Fish. 252; Carter *v.* Messinger, 11 Blatch. 34; Hovey *v.* Stevens, 1 W. & M. 290; Hudson *v.* Draper, 4 Fish. 256; s. c. 4 Brews. 260; 1 O. G. 204; Page *v.* Ferry, 1 Fish. 298; Roberts *v.* Dickey, 4 Fish. 532; Judson *v.* Cope, 1 Fish. 615; s. c. 1 Bond, 327; Howe *v.* Morton, 1 Fish. 586; Rogers *v.* Sargent, 7 Blatch. 507; Vance *v.* Campbell, 1 Fish. 483; s. c. 1 Black, 427; Davoll *v.* Brown, 1 W. & M. 53; Carver *v.* Braintree Manuf. Co. 2 Story, 432; Seymour *v.* Osborne, 11 Wall. 516; s. c. 3 Blatch. 209; Coffin *v.* Ogden, 3 Fish. 640; s. c. 7 Blatch. 61; Francis *v.* Mellor, 5 Fish. 153; s. c. 8 Phila. 157; 1 O. G. 48; 5 A. L. T. 237; Suffolk Co. *v.* Hayden, 4 Fish. 86; s. c. 3 Wall. 315.

The patent, the specification, and the drawings may be referred to in ascertaining the extent of the patentee's claim. While it is true that the court is to look at the summing up to discover what parts of the machine he claims to have invented, still, if anything is needed to enable it to determine the proper meaning of the expressions used in the claim, it must refer to the previous portion of the specification for such explanations as may be necessary to understand the office and purpose of that which is claimed as new. Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Morris *v.* Barrett, 1 Fish. 461; s. c. 1 Bond, 254; Ingels *v.* Mast, 2 Cent. L. J. 349; s. c. 9 Pac. L. R. 189; Judson *v.* Moore, 1 Fish. 544; s. c. 1 Bond, 285; Turrill *v.* Railroad Company, 1 Wall. 491; Washburn *v.* Gould, 3 Story, 122; Pitts *v.* Edmonds, 2 Fish. 52; s. c. 1 Biss. 168; Union Sugar Refinery *v.* Mathiessen, 2 Fish. 600; Birdsall *v.* McDonald, 6 O. G. 682; Geir *v.* Goettinger, 7 O. G. 563; Earle *v.* Sawyer, 4 Mass. 1; Whitney *v.* Emmett, Bald. 303; Kittle *v.* Merriam, 2 Curt. 475; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224; Doughty *v.* Day, 5 Fish. 224; s. c. 9 Blatch. 262.

A petition is always required to be presented by an inventor. The specification is required to be prepared and filed before the patent issues. The specification is incorporated expressly and at length into the letters patent themselves, and must be regarded as a component part by the statute. Hogg *v.* Emerson, 6 How. 437; s. c. 2 Blatch. 1.

The specification and the claim emanate from the same pen—the one can not contradict the other. Page *v.* Ferry, 1 Fish. 298.

If the claim and specification do not altogether agree, the claim governs the patent. Haselden *v.* Ogden, 3 Fish. 378.

The different parts of the patent must be compared with each other, and the instrument considered as a whole. Union Sugar Refinery *v.* Mathiessen, 2 Fish. 600.

The drawings are to be deemed a part of the specification, and may be referred to for the purpose of adding anything to the specification or claim not specifically contained therein. Washburn *v.* Gould, 3 Story, 122.

The specification governs, and the drawings merely illustrate. Hogg *v.*

Emerson, 11 How. 587; S. C 2 Blatch. 1; Hamilton *v.* Ives, 6 Fish. 244; S C. 3 O. G. 30.

If the claim refers to other parts of the specification and drawings, those parts are to be examined in connection with it, in order to ascertain what is claimed in the summary as the new improvement. Hovey *v.* Stevens, 3 W. & M. 17; Heinrich *v.* Luther, 6 McLean, 345.

Mere matters of adjustment of the individual elements of a combination are not limited or controlled by the drawings, unless: 1. They are expressly so limited by the specifications as well; or, 2. Such limitation and control are necessary to maintain the integrity of the specifications taken as a whole, or of some essential part or parts thereof; or, 3. Such limitation and control are essential to produce the result claimed. Hamilton *v.* Ives, 6 Fish. 244; S. C. 3 O. G. 30.

The courts will look at the model, which is as much a part of the patent as the specification, and which the statute requires to be preserved, in order to illustrate anything that may be doubtful to the mechanic who undertakes to make the machine from the patent after the patent has expired. Hoffheins *v.* Brandt, 3 Fish. 218; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224.

Where the construction of the patent and specification as to the subject of the grant is doubtful, the affidavit, if more precise, may be resorted to in order to explain the ambiguity. Pettibone *v.* Derringer, 4 Wash. C. C. 215.

The patent must be construed without reference to the previous correspondence and previously rejected applications, especially if the patent issued correctly describes the invention. Piper *v.* Brown, 4 Fish. 175; Johnson *v.* Root, 1 Fish. 351; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224.

The construction of a patent must certainly depend on the words of the instrument, but where the words are ambiguous there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of the law permit courts to explore, are entitled to great consideration. The parties are the Government, acting by its agents, and the patentee. Evans *v.* Eaton, 3 Wheat. 454; S. C. Pet. C. C. 322.

Whether the specification is for a principle or not is to be decided in view of the art, the character of the machine, the entire specifications, drawings, and claims. Few cases constitute precedents for others. Because some tribunals in a particular case decided that certain words, when used in connection with their accompanying incidents, did import a claim for a result or principle, another tribunal should not treat these decisions as setting up a formula in all circumstances involving a similar meaning. They assert no such rule. All go upon a full critical review of the accompanying facts in reference to which they have been used, excluding the idea that other courts are not to perform the same duty. Words identical should be rendered as diversely as the conditions in which they are employed demand, in order not to defeat the fairly presumed intention of those who use them. Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 9 O. G. 691.

Whether the thing claimed to have been invented is sufficiently described in the patent is in its nature a question of law, for it depends upon the construction of a written instrument. If technical terms are used peculiar to

mechanics in describing the invention, evidence may be heard in explanation of those terms, and in such case a jury may be necessary. Unless the thing claimed to be invented is so described as to be known from every other thing, the patent is void, and this must be determined by the court. Brooks *v.* Jenkins, 3 McLean, 432; Davis *v.* Palmer, 2 Brock. 298; Washburn *v.* Gould, 3 Story, 122; Davoll *v.* Brown, 1 W. & M. 53.

The construction seldom rests on facts to be proved by parol, unless they are so referred to as to make a part of the description, and to govern it; and when it does at all depend on them, and they are proved or admitted, and are without dispute, it is the duty of the court on these facts to give the legal construction to the instrument. Davoll *v.* Brown, 1 W. & M. 53.

The description of the operation and effect of each separate element of a combination must be read and construed with reference to the entire combination and its results, and the effect which the operation of each element has upon that of each of the others. Hamilton *v.* Ives, 6 Fish. 244; S. C. 3 O. G. 30.

The description or title of the invention ought not to be repugnant to the specification, but provided it honestly sets forth, in few words, the "nature and design" of the patent, it is sufficient. The specification must be looked to for the full disclosure of the discovery, and the extent of the inventor's claims. While the specification is usually, and always ought to be, drawn with the assistance of learned and able counsel, the short description or title in the patent is usually suggested by the commissioner of patents. The extent of the patentee's rights must be judged from the whole instrument taken together, and not from any one sentence. Sickles *v.* Gloucester Manuf'g Co. 1 Fish. 222; S. C. 3 Wall. Jr. 196; Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356; Hogg *v.* Emerson, 6 How. 437; S. C. 11 How. 587; 2 Blatch. 1; Matthews *v.* Skates, 1 Fish. 602; Whittemore *v.* Cutter, 1 Gall. 429.

The patentee is not controlled by his title, but the patent, specifications and drawings are all to be examined, and are all to have a fair and liberal construction in determining the nature and extent of the invention. Bell *v.* Daniels, 1 Fish. 372; S C. 1 Bond, 212; Parker *v.* Stiles, 5 McLean, 44; Pitts *v.* Whitman, 2 Story, 609; Locomotive Co. *v.* Railway Co. 6 Fish. 187; S. C. 10 Blatch. 292; 3 O. G. 93.

The patent and specification are connected together and dependent on each other for support. The specification should maintain the title of the patent. The latter should not indicate one thing and the former describe another, as the subject of the grant. Sullivan *v.* Redfield, 1 Paine, 441.

Construction.

A patent can not be construed to cover parts which have been omitted, although such omission will not vitiate it, unless they were made with a view to deceive the public. Burden *v.* Corning, 2 Fish. 477.

The courts have no power to correct a mistake in letters patent. Their duty is to construe the specification and claim as they stand, and determine the legal effect of the claim. Kittle *v.* Merriam, 2 Curt. 475.

If enough is left after the rejection of an erroneous description to clearly

and certainly identify the mode of constructing the machine, the rule *error demonstrationis non nocet* applies. Kittle *v.* Merriam, 2 Curt. 475.

A defect should be clear and palpable to justify a court in saying that a patent is a nullity. It is subject to scrutiny before it passes into the hands of the patentee. The whole claim of the inventor is subjected to an officer who acts under oath, and who is usually a man well skilled in natural philosophy and mechanical science generally, and who would not be justified in granting a patent to any person unless, in his judgment, the specification was sufficiently clear. Judson *v.* Moore, 1 Fish. 544; S. C. 1 Bond, 285.

No court of justice is at liberty to strike out any words which are sensible in the place where they occur, and are capable of a distinct application. Effect is to be given, if practicable, to all the words as containing a distinct expression of the intention of the party. Ames *v.* Howard, 1 Sum. 482.

An error of expression apparent on the face both of the patent and specification, by which no person could be misled, will not invalidate the patent. Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9.

It is the province and duty of the court to settle the meaning of the patent, and if that can not be ascertained satisfactorily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented by the respective parties to support or defeat the patent are then to be examined and applied, as if the construction fixed by the court had been incorporated in the specification. Hogg *v.* Emerson, 2 Blatch. 1; S. C. 11 How. 587; 6 How. 437.

Although there is some ambiguity and uncertainty in a part of the specification, yet, if taking the whole together, the court can perceive the exact nature and extent of the claim made by the inventor, it is bound to adopt that interpretation, and to give it full effect. Ryan *v.* Goodwin, 3 Sum. 514; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Middletown Co. *v.* Judd, 3 Fish. 141.

Whether a claim is vague and uncertain, is a question of law to be determined by the rules of construction applied in the light of the state of the art. Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195.

A description, though in some respects obscure, imperfect, or not so intelligible as to fully answer all the objects of the law, is good if it enables the court to specify the improvement or invention patented from the face of the patent and accompanying papers. It is enough if there is a substantial description of the thing patented, though defective in form or mode of explanation. Whitney *v.* Emmett, Bald. 303: Judson *v.* Moore, 1 Fish. 544; S. C. 1 Bond, 285; Wane *v.* Holmes, 2 Fish. 20; Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195.

The patentee is not to be bound down to any precise form of words, and it is sufficient if the court can clearly ascertain by fair interpretation what he intends to claim, and what his language truly imports, even though the expressions are inaccurately or imperfectly drawn. Wyeth *v.* Stone, 1 Story, 273.

The meaning of letters patent, like other grants or written instruments, must be ascertained by the language employed as applied to the subject-matter. Goodyear Dental Co. *v.* Gardner, 4 Fish. 224.

Where the language employed is clear and unambiguous, it must speak its own construction in the specification of a patent, as well as in any other grant issued by public authority. Mitchell *v.* Tilghman, 4 Fish. 599; S. C. 19 Wall. 287: 5 O. G. 299.

Language invoked to support a particular theory must be such as is fit, when it is compared with the whole instrument, to express the imputed intention, else the theory can not be supported. Mitchell *v.* Tilghman, 4 Fish. 599: S. C. 19 Wall. 287: 5 O. G. 299.

Particular passages in the description must not be separated from what precedes or follows in the same connection, but one part of the instrument must be compared with another, and the whole considered together, in order to determine whether it is incomplete and ambiguous, or sufficient to uphold the claim of the patent. Howes *v.* Nut, 4 Fish. 263.

Whether a patent claims too much is a question of law to be determined by the rules of construction, applied in the light of the state of the art. Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195.

If a combination is expressly claimed in one claim by apt and appropriate language, it must be inferred that if it had been intended to claim a combination merely in another claim, appropriate language to indicate such intention would have been used. Burden *v.* Corning, 2 Fish. 477.

In construing a claim, the court can not look to a single phrase only, to the exclusion of all the residue of the writing. Kittle *v.* Merriam, 2 Curt. 475.

The disclaimer at the close of a specification estops the patentee from setting up any privilege to the part disclaimed, and the summary is equally binding on him as a limitation to the thing patented. Whitney *v.* Emmett, Bald. 303.

Where mere changes of form become patentable by reason of involving functional differences, the patent should be so construed as to allow subsequent inventors to devise other changes of form involving other functional changes, where the same result is not attained in substantially the same way. Swain Manuf. Co. *v.* Ladd, 11 O. G. 153.

Similar substance means a substance having the same property, and not a substance having the same chemical constituents. Roots *v.* Hyndman, 6 Fish. 439; S. C. 4 O. G. 29.

A literal construction is not to be adopted where it would be repugnant to the manifest sense and reason of the instrument. Brown *v.* Guild, 23 Wall. 181; S. C. 6 O. G. 392; 7 O. G. 739.

The patentee's rights depend on the claim in the patent according to its proper construction, and not upon what he may erroneously suppose it covers. If at one time he insists on too much, and at another time on too little, he does not thereby work any prejudice to the rights actually secured to him. Masury *v.* Anderson, 6 Fish. 457; S. C. 11 Blatch. 162; 4 O. G. 55.

The words of a specification are to be taken together, and they are to be so construed as to give effect to the meaning and intention of the person using them. Words are not to be distorted from their meaning so as to effect what may be supposed to have been the intention of the person using them; but they are to have a reasonable construction as connected with the sentence in

which they are used. Allen *v.* Hunter, 6 McLean, 303; Russell Manuf. Co. *v.* Mallory, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495.

It is material to ascertain what was in point of fact the invention, for there is a reasonable presumption that the intention of the inventor was to obtain, and of the Government to concede to him, the exclusive right to what he actually invented. Kittle *v.* Merriam, 2 Curt. 475.

The construction should not be broader than the whole subject-matter and description and nature of the case indicate as designed. It should not be fancied, but rather what is natural and clear considering what already exists on the subject. Smith *v.* Downing, 1 Fish. 64; Trader *v.* Messmore, 7 O. G. 385.

There is no artificial or universal rule of interpretation beyond that which common sense furnishes, which is to construe the instrument as a whole, and to extract from the descriptive words and the claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law. Carver *v.* Braintree Manuf. Co. 2 Story, 432.

An amended specification which is not completed may be considered as an explanation by the patentee of his intended meaning, and can be referred to in considering whether the words, as used in the original specification, carry out clearly or not what is said to have been intended. Hovey *v.* Stevens, 3 W. & M. 17.

Where the fair interpretation of the words employed to describe an invention includes matters not in the mind of the patentee at the time, he is as fully authorized to claim the unlooked for as the anticipated result. Welling *v.* Rubber Co. 7 O. G. 606.

The legal construction of every general claim is that the patentee means to limit the same to his described method or process; or, if it be a machine, to his described means of obtaining or accomplishing the described results. Usually the claim contains the words "as described," or "substantially as described," or words of like import, which are everywhere understood as referring back to the descriptive parts of the specification. Words of such import, if not expressed in the claim, must be implied. Mitchell *v.* Tilghman, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299.

The words "substantially as described and shown," relate only to material features of the combination specified, and these are to be ascertained by considering the object or purpose of the machine, and what are the elements of the combination which create its distinctive character, and are effective in producing the peculiar result for which the contrivance is made. Waterbury Brass Co. *v.* Miller, 15 Fish. 48; S. C. 9 Blatch. 77; Knox *v.* Murtha, 9 Blatch. 205.

The phrase "substantially the same," means the same in all important particulars. Adams *v.* Edwards, 1 Fish. 1.

On account of the great vagueness and indefiniteness of the language used in describing the various arts, machines, manufactures, and compositions of matter, it is almost impossible to describe the real nature of many discoveries or processes in language free from ambiguity or misconstruction. Different persons looking at it from different points of view, would describe it in differ-

ent terms. Still, if the patentee has fully set forth his invention, he has done all that the law requires, and is entitled to its protection. The patent should be carefully examined to find the thing discovered; and if it be clearly set forth, the patentee should not suffer for the imperfection or vagueness of the language used in describing its true extent and nature. Goodyear *v.* Central R. R. Co. 1 Fish. 626; s. c. 2 Wall. Jr. 356.

There are few things more difficult, even for well-educated and practiced lawyers, than to describe a new invention clearly, and point out the principle which distinguishes the subject of it from all things known before. As inventors are rarely experts either in philology or law, it has long been established as a rule that their writings are to be scanned with a good degree of charity. But it is easy to abuse this liberality to the purposes of fraud. The public has rights to be guarded also, and these exact that the patentee's specification shall set forth his invention so fully and definitely that it can not be readily misunderstood. French *v.* Rogers, 1 Fish. 133.

A patent for a gold pen can not be extended beyond the peculiar shape, form, or mode of construction which the patentee alleges he has invented. Rapp *v.* Bard, 1 Fish. 196.

What is the character of the grant made by the patent is a question of law, and must be determined by the court, and the jury must consider that the patent purports to grant that which the court shall determine it to grant. Serrell *v.* Collins, 1 Fish. 289; Buck *v.* Hermance, 1 Blatch. 398; Magic Ruffle Co. *v.* Douglass, 2 Fish. 330; Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Teese *v.* Phelps, 1 McA. 48; Clark Patent Co. *v.* Copeland, 2 Fish. 22[illegible]; Case *v.* Brown, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43; Winans *v.* Denmead, 15 How. 330; s. c. 4 Am. L. J. 498; Conover *v.* Roach, 4 Fish. 12; Cahoon *v.* Ring, 1 Fish 397; s. c. 1 Cliff. 592; Conover *v.* Rapp, 4 Fish. 57; Foss *v.* Herbert, 2 Fish. 31; s. c. 1 Biss. 121; Matthews *v.* Skates, 1 Fish. 602.

The interpretation of the specification is for the court. Experts are examined only to aid in interpreting the language of art, as other translators are. Batten *v.* Clayton, 2 Whart. Dig. 363.

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

Statute Revised—July 8, 1870, ch. 230, § 23, 16 Stat. 201.

Prior Statutes—July 4, 1836, ch. 357, § 8, 5 Stat. 120.—March 3, 1863, ch. 102, § 3, 12 Stat. 796.

SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improve-

ment thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

Statute Revised—July 8, 1870, ch. 230, § 24, 16 Stat. 201.

Prior Statutes—Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318.—April 17, 1800, ch. 25, § 1, 2 Stat. 37.—July 4, 1836, ch. 357, §§ 6, 7, 5 Stat. 119.

Invention.

Discovery is synonymous with invention. A discovery which merely consists in bringing to light that which existed before, but was not known, is not the subject of a patent. No discovery will entitle the discoverer to a patent which does not in effect amount to the contrivance or production of something which did not exist before. Ex parte John F. Kemper, Cranch Pat. Dec. 89.

Invention in the sense of the patent law is the finding out, contriving, devising, or creating something new and useful, which did not exist before, by an operation of the intellect. Ransom *v.* New York, 1 Fish. 252; Conover *v.* Roach, 4 Fish. 12; Potter *v.* Whitney, 3 Fish. 77; s. c. 1 Lowell, 87.

A subject-matter to be patentable must require invention, but is not necessarily the result of long and painful study, or embodied alone in complex mechanism. A single flash of thought may reveal to the mind of the inventor the new idea, and a frail and simple contrivance may embody it. Some inventions are the result of long and weary years of study and labor pursued in the face of abortive experiments and baffled attempts, and finally reached after the severest struggles, while others are the fruit of a single happy thought. Magic Ruffle Co. *v.* Douglass, 2 Fish. 330; Matthews *v.* Skates, 1 Fish. 602; Many *v.* Sizer, 1 Fish. 17; Furbush *v.* Cook, 2 Fish. 668; Carstaedt *v.* U. S. Corset Company, 13 Blatch. 371; s. c. 10 O. G. 3; Earle *v.* Sawyer, 4 Mason, 1; Blake *v.* Stafford, 3 Fish. 294; s. c. 6 Blatch. 195; Carr *v.* Rice, 1 Fish. 198; Middletown Co. *v.* Judd, 3 Fish. 141.

If with the knowledge that the public had at the time of the alleged discovery, it required no invention, but simply the ordinary skill and ingenuity of a mechanic to produce the invention—in other words, if the inventive faculty was not at work at all, and was not needed to produce the alleged invention, then the patent would be void because there would be no invention to be secured to the patentee. Carter *v.* Messinger, 11 Blatch. 34; Ransom *v.* New York, 1 Fish. 252; Kirby *v.* Beardsley, 3 Fish. 265; s. c. 5 Blatch. 418; Stimpson *v.* Woodman, 3 Fish. 98; s. c. 10 Wall. 117; Spaulding *v.* Tucker, Deady, 649; Larrabee *v.* Cortlan, 3 Fish. 5; s. c. Taney, 180; Knox *v.* Murtha, 5 Fish. 174; s. c. 9 Blatch. 205; Haselden *v.* Ogden, 3 Fish. 378; Day *v.* Telegraph Co. 5 Fish. 268; s. c. 9 Blatch. 345; 10 O. G. 551; Wood Paper Co. *v.* Heft, 3 Fish. 316; s. c. 8 Wall. 333; Dane *v.* Chicago Manuf.

Co. 6 Biss. 130; s. c. 3 Biss. 380; 2 O. G. 677; 7 O. G. 924; Dunbar *v.* Myers, 11 O. G. 35; Needham *v.* Washburn, 7 O. G. 648.

It is exceedingly difficult to draw a line between what may be regarded by the eye as a small improvement or invention, and one of magnitude. Oftentimes, improvements and discoveries the most important in their consequences and in their beneficial effects on the business interests of the community are among the simplest ideas of the mind. On the other hand, improvements of less magnitude in their consequences and beneficial effects, indicate a most laborious and complex action of the mind of the inventor. Seymour *v.* McCormick, 19 How. 96; s. c. 3 Blatch. 209.

The difficulty is in drawing the line between invention and mere construction. There are some things that everybody knows. The common uses of common materials are supposed to be known. If a man merely makes a machine out of iron that has been made out of wood, that is no invention, because every body knows that a constructor can make a machine of iron instead of wood. There may even be a discovery which is not an invention, as for instance, the application of a machine to a new use. The man who made the first invention made it for all the uses to which it is applicable. Stimpson *v.* Woodman, 3 Fish. 98; s. c. 10 Wall. 117; Kirby *v.* Beardsley, 3 Fish. 265; s. c. 5 Blatch. 438.

The difficulty of drawing the line of distinction between invention and mere obvious manual changes following the beaten track of mechanical experience, has inclined courts to give a liberal construction to the law so as to protect every contrivance that can be called new, which proves at all useful Care has been taken to give the benefit of doubt as to originality or creative thought to the inventor, so as to nourish inventive enterprise by lending encouragement to every degree of merit. Kirby *v.* Beardsley, 3 Fish. 265; s. c. 5 Blatch. 438; Tuck *v.* Bramhill, 3 Fish. 400; s. c. 6 Blatch. 95; Whipple *v.* Middlesex, Co. 4 Fish. 41; McMillin *v.* Barclay, 5 Fish. 189; s. c. 4 Brews. 275; Stanley Works *v.* Sargent, 4 Fish. 443; s. c. 8 Blatch. 344; Penn Salt Co. *v.* Thomas, 5 Fish. 148; s. c. 8 Phila. 144.

With regard to the degree of mental labor and inventive skill required in the work of invention, the law has no nice or rigid standard. There must be some inventive skill exercised, but the degree of that skill is not material. It not unfrequently happens in the progress of the mechanic arts, that the time arrives when the whole atmosphere of inventive thought is quickened with the life of an approaching discovery; that many lines of investigation and experiment converging for a long time toward the point, almost but not quite reach it, when at last some mind by a happy thought supplies some new element or instrument, or mode of organization, and instantly gives birth to the organized idea. Clark Patent Co. *v.* Copeland, 2 Fish. 221.

The simplicity of an invention, so far from being an objection to it, may constitute its great excellence and value. Indeed, to produce a great result by very simple means before unknown or unthought of, is not unfrequently the peculiar characteristic of the very highest class of minds. Ryan *v.* Goodwin, 3 Sum. 514; In re J. L. Pennock, 1 McArthur, 531; s. c. 5 O. G. 668; Lorillard Co. *v.* McDowell, 34 Leg. Int. 78; s. c. 24 Pitts. L. J. 119; 11 O. G. 640.

The superiority of an invention in utility and effect over what preceded it, is proof tending to establish the fact of novelty. Birdsell *v.* McDonald, 6 O. G. 682; S. & B. Manuf. Co. *v.* Coke Co. 7 O. G. 829.

If a novel and useful result has been obtained, neither the simplicity of the structure, nor the greater or less amount of invention or intellect employed as an element are of importance in determining the validity of the patent. The distinction is that where there is a mere application of an old thing to a new use, it is not patentable; but where there is exhibited an inventive faculty in the process, it is. Teese *v.* Phelps, 1 McA. 48; Barnes *v.* Straus, 5 Fish. 531; s. c. 9 Blatch. 553; 2 O. G. 62.

Unless more skill and ingenuity are required in the discovery than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor. Hotchkiss *v.* Greenwood, 11 How. 248; s. c. 4 McLean, 456; Teese *v.* Phelps, 1 McA. 48; Fisher *v.* Craig, 3 Saw. 69; Treadwell *v.* Parrott, 3 Fish. 124; s. c. 5 Blatch. 369; Reed *v.* Reed, 12 Blatch. 366; s. c. 8 O. G. 193.

The accidental making of an article, without any knowledge on the part of the producer of how to accomplish it, with utter inability on his part to produce another like it, is not invention. A single fortuitous success is not invention within the protection of the patent law. Pelton *v.* Waters, 21 I. R. R. 125; s. c. 7 O. G. 425; Monce *v.* Adams, 12 Blatch. 1; s. c. 7 O. G. 177.

The degree of labor and thought may be sometimes evidence upon the question of invention. Many *v.* Sizer, 1 Fish. 17.

The validity of a patent does not depend on an opinion formed after the event, respecting the ease or difficulty of attaining it. Furbush *v.* Cook, 2 Fish. 668.

An invention in mechanics consists not in the discovery of new principles, but in new combinations of old principles. Tyler *v.* Devel, 1 A. L. J. 248; Stainthorp *v.* Humiston, 1 Fish. 475.

If the new device has displaced other devices which had been used previously for analogous purposes, this fact may be considered, and when the other facts leave it doubtful whether the device involves a patentable invention, this is sufficient to turn the scale. Smith *v.* G. D. V. Co. 93 U. S. 486; s. c. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74; Weston *v.* Nash, 1 Holmes, 488; s. c. 7 O. G. 1096.

If the device produces a new result, this is evidence of invention. Smith *v.* G. D. V. Co. 93 U. S. 486; s. c. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74.

Whenever a change or device is new and accomplishes beneficial results, the courts look with favor upon it. The law in such cases has no nice standard by which to gauge the degree of mental power or inventive genius brought into play in originating the new device. Middletown Co. *v.* Judd, 3 Fish. 141; Jones *v.* Sewall, 6 Fish. 343; s. c. 3 O. G. 630; In re J. L. Pennock, 1 McArthur, 531; s. c. 5 O. G. 668; Potter *v.* Holland, 1 Fish. 382; s. c. 4 Blatch. 238.

The questions of invention, novelty, or prior use are all questions of official judgment, and are all settled by the judgment of the commissioner. His

judgment goes to the same extent on each question. He determines and decides for the purpose of issuing or refusing a patent. When the patent is sought to be enforced, the questions, and each of them, are open to judicial examination. Reckendorfer *v.* Faber, 92 U. S. 347; s. c. 12 Blatch. 68; 5 O. G. 697; 10 O. G. 71; Grant *v.* Raymond, 6 Pet. 218.

The result which has been produced may be considered in connection with the change, because the result, if greatly more beneficial than it was with the old contrivance, reflects back and tends to characterize in some degree the importance of the change. Hall *v.* Wiles, 2 Blatch. 194; Locomotive Truck Co. *v.* R. R. Co. 6 O. G. 927; s. c. 31 Leg. Int. 324; 1 W. N. 16; Stimpson *v.* Woodman, 3 Fish. 98; s. c. 10 Wall. 117.

When the patent is granted, it becomes, to a certain extent, a contract upon the part of the Government, with the party named in the patent, that it will through its courts and in the ordinary course of the administration of justice, protect him in the exercise of the exclusive privilege which his patent gives to him. There would be no justice in granting to a party an exclusive privilege to use what he did not invent, because he would pay no consideration for the grant if he did not by his invention add to the stock of useful knowledge which may be applied for the benefit of the citizen. Ransom *v.* New York, 1 Fish. 252.

A patentable invention is a mental result. Everything within the domain of the conception belongs to him who conceived it. Smith *v.* Nichols, 6 Fish. 61; s. c. 21 Wall. 112; 1 Holmes, 172; 2 O. G. 649.

A mere carrying forward or new or more extended application of the original thought, a change only in degree, doing substantially the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent. Smith *v.* Nichols, 6 Fish. 61; s. c. 21 Wall. 112; 1 Holmes, 172; 2 O. G. 649.

If a new idea is engrafted upon an old invention, and is distinct from the conception that preceded it, it is patentable. Rice *v.* Heald, 13 Pac. L. R. 33.

Invention in Reference to Change.

If the application of a method of corrugation to a new article, requires experiment and invention to determine whether it can be made usefully, and develops a new mode of operation, as well as a new effect, it is patentable. Grosjean *v.* Peck, 11 Blatch. 54.

The use of a well-known substance in a particular but well-known form, is not patentable, although the substance has never been used in that form before. Tarr *v.* Webb, 5 Fish. 593; s. c. 10 Blatch. 96; 2 O. G. 568.

If the principle is embodied in a machine used for a different purpose, the change from motion given by the hand to an automatic machine, makes no difference, and the party is not entitled to a patent. Singer *v.* Walmsley, 1 Fish. 558.

The mere reduction of an article of bulk to one of a smaller size, is not in general the subject of a patent as a new manufacture, unless the properties of the article are improved by the introduction of some new ingredient or by the subtraction of one or more of the ingredients of the original article, by which

the new product is improved or made more useful. M. & H. Glue Co. *v.* Upton, 6 O. G. 837.

Particular changes may be made in the construction and operation of an old machine so as to adapt it to a new and valuable use not known before, and to which the old machine had not been and could not be applied without those changes, and under those circumstances if the machine, as changed and modified, produces a new and useful result, it may be patented. Seymour *v.* Osborne, 3 Fish. 555; s. c. 11 Wall. 516.

The placing of two or more letters on each block is not a patentable improvement in spelling blocks, although the inventor was the first one to place them systematically with a view to enlarge the usefulness of the blocks. Hill *v.* Houghton, 6 O. G. 3.

A slight change sometimes of a known machine, or in some of its parts, will effect surprising results, and to protect a party who, by inventing such change, has produced a new and useful result, is one of the objects of the patent laws. Turrill *v.* Ill. Cent. R. R. Co. 3 Fish. 330; s. c. 3 Biss. 66.

An improvement in the mode of constructing a stone pavement is a patentable invention. Guidet *v.* Barber, 5 O. G. 149.

If the patentee is not the inventor of the material, he can not obtain a patent for an article made therefrom which is similar to those made from other materials. Collar Co. *v.* Van Deusen, 5 Fish. 597; s. c. 10 Blatch. 109; 2 O. G. 361; 23 Wall. 530; 7 O. G. 919.

If the patentee is the inventor of the back, he may take out a patent for a brush and a patent for a hand mirror, where the application of the back to each purpose involves invention. Clark *v.* Scott, 15 Fish. 245; s. c. 9 Blatch. 301; 1 O. G. 4.

If two inventions differ in principle, and there is a substantial difference in the product in which the invention is embodied and the purposes to which the product is to be applied, the latter invention is patentable. Jenkins *v.* Walker, 5 Fish. 347; s. c. 1 Holmes, 120; 1 O. G. 359.

The application of hollow legs to support portable furnaces, is not patentable. In re Dewitt C. Baxter, 1 McArthur, 520.

If the inventor invented the proper mode of enameling the proper quality of paper, the claim for a collar made from such enameled paper, as a new article of manufacture, is valid. Hoffman *v.* Stiefel, 3 Fish. 638; s. c. 7 Blatch. 58; Hoffman *v.* Aronson, 4 Fish. 456; s. c. 8 Blatch. 324; 4 A. L. T. (N. S.) 110.

The transfer of flanges from an iron hub to a wooden hub, would not be patentable unless it required some ingenuity or contrivance to adapt it to use in its new position. Sarven *v.* Hall, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437.

The discovery of an elastic erasive pencil head which consists merely of a piece of india rubber with a hole in it, can not be the subject of a patent. Rubber Pencil Co. *v.* Howard, 5 Fish. 377; s. c. 9 Blatch. 490; 20 Wall. 498; 1 O. G. 407; 9 O. G. 172.

A staple made in a certain shape by the action of dies is patentable. Rogers *v.* Sargent, 7 Blatch. 507.

Printing with copper plates on the reverse face of bank notes, is an art.

The patent is not for an effect but for the kind of printing by which the effect is produced. Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9.

An invention of a peculiar form of a last is patentable. Mabie *v.* Haskell, 2 Cliff. 507.

The mere substitution of an equivalent is not patentable. Cochrane *v.* Waterman, Cranch Pat. Dec. 121.

A contrivance which does not require the exercise of inventive power, is not patentable. Brown *v.* Guild, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739.

An improved paper bag, made by means of softening and rendering the upper portion of the bag flexible, is patentable. Arkell *v.* Paper Bag Co. 7 Blatch. 475.

The omission of an ingredient commonly supposed to be essential to a composition, may be patentable. Tarr *v.* Folsom, 1 Holmes, 312; s. c. 5 O. G. 92.

Quære. Is the making of the case which incloses the internal works of a lock with two faces just alike, and so well finished off in point of style that either side may be presented outwards, a matter which can be patented? Jones *v.* Morehead, 1 Wall. 155.

A mere change of form is not patentable, because it involves no invention. It is simply the device of a mechanic. Sangster *v.* Miller, 2 Fish. 563; s. c. 5 Blatch. 243; Wicks *v.* Stevens, 2 Woods, 310; Winans *v.* Denmead, 15 How. 330; s. c. 4 Am. L. J. 498; Evans *v.* Eaton, Pet. C. C. 323; s. c. 3 Wheat. 454; 3 Wash. C. C. 443; Delano *v.* Scott, Gilp. 489; Barrett *v.* Hall, 1 Mason, 447; Dixon *v.* Moyer, 4 Wash. C. C. 68; Smith *v.* Pearce, 2 McLean, 176; Pettibone *v.* Derringer, 4 Wash. C. C. 215; Flood *v.* Hicks, 4 Fish. 156; s. c. 2 Biss. 169; Brown *v.* Selby, 4 Fish. 363; s. c. 2 Biss. 457.

A formal change, such as a change in proportions, a mere change of form, or a different shape, is not a change within the meaning of the law. Hall *v.* Wiles, 2 Blatch. 194; Ex parte Lewis Cutting, 11 O. G. 110; Buck *v.* Hermance, 1 Blatch. 398; Woodcock *v.* Parker, 1 Gallis. 438; Day *v.* Telegraph Co. 5 Fish. 268; s. c. 9 Blatch. 345; 1 O. G. 551.

The safest guide to accuracy in making the distinction between what constitutes form and what principle, is first to ascertain what is the result to be obtained by the discovery, and whatever is essential to that object, independent of the mere form and proportions of the things used for the purpose, may generally, if not universally, be considered as the principles of the invention. Treadwell *v.* Bladen, 4 Wash. C. C. 703.

The enlargement of the organization of a machine does not afford any ground in the sense of the patent law, for a patent. This is done every day by the ordinary mechanic in making a working machine from the patent model. Phillips *v.* Page, 24 How. 164.

A structural change of form and proportion, although it improves the operation without changing the mode of operation, and produces a better result, but of the same kind, is not patentable. Greely *v.* Commissioner, 6 Fish. 575; s. c. 1 Holmes, 284; 4 O. G. 612.

If the change in form and location involves a functional difference beyond mere mechanical perfection and adjustment, and produces an improved product, it is patentable. Pearl *v.* Ocean Mills, 11 O. G. 2.

Sometimes form is of the very substance of an invention, and change of form is the invention itself. Dennis *v.* Eddy, 4 Fish. 423.

If by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion, but a change of principle also, and the invention is patentable. Davis *v.* Palmer, 2 Brock. 298; Aiken *v.* Dolan, 3 Fish. 197.

To change the form of an existing machine, and by means of such change to introduce and employ other mechanical principles or natural powers, or, as it is termed, a new mode of operation, and thus attain a new and useful result, is the subject of a patent. Winans *v.* Denmead, 15 How. 330; s. c. 4 Am. L. J. 498; Cahoon *v.* Ring, 1 Fish. 397; s. c. 1 Cliff. 593; Parham *v.* Sewing Machine Co. 4 Fish. 468.

The mere change of location of an old device is not patentable if the result is the same, and nothing new is required to adapt an apparatus in its new location. Marsh *v.* Dodge & Stevenson Manuf. Co. 6 Fish. 562; s. c. 5 O. G. 398.

Where change of location involves the employment of new devices to adapt an apparatus for use in the new position, and a beneficial result is produced, the location, in connection with such new devices, is patentable. Marsh *v.* Dodge & Stevenson Manuf. Co. 6 Fish. 562; s. c. 5 O. G. 398; G. & B. Manuf. Co. *v.* Tirrell, 12 Blatch. 144; s. c. 8 O. G. 2; Carstaedt *v.* U. S. Corset Co. 13 Blatch. 119; s. c. 9 O. G. 151; G. & B. Manuf. Co. *v.* Walworth, 9 O. G. 746.

The mere change of the location of the parts of a mechanism, so long as no different or additional function is performed, does not make the mechanism patentable. Dane *v.* Ill. Manuf. Co. 6 Fish. 124; s. c. 3 Biss. 374; 2 O. G. 680.

The substitution of one material for another is not invention if the result is only greater cheapness and durability of product. A machine made in whole or in part of materials better adapted to the purpose than the materials of which the old one is constructed, and for that reason better and cheaper, can not be distinguished from the old one, or entitle the manufacturer to a patent. The difference is formal and destitute of ingenuity or invention. It may afford evidence of judgment and skill in the selection and adaptation of the materials in the manufacture of the instrument for the purposes intended, but nothing more. Hotchkiss *v.* Greenwood, 11 How. 248; s. c. 4 McLean, 456; Hicks *v.* Kelsey, 18 Wall. 670; s. c. 5 O. G. 94; Holbrook *v.* Small, 10 O. G. 508; Smith *v.* G. D. V. Co. 93 U. S. 486; s. c. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74.

If the substitution of one material for another involves a new mode of construction, or develops new uses or properties of the article formed, it may amount to invention. The substitution may be something more than formal. It may require contrivance, in which case the mode of making it would be patentable, or the result may be the production of an analogous, but substantially different article. Smith *v.* G. D. V. Co. 93 U. S. 486; s. c. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74; Putnam *v.* Weatherbee, 8 O. G. 320; Putnam *v.* Yerrington, 9 O. G. 689; Dalton *v.* Nelson, 13 Blatch. 357; s. c. 9 O. G. 1112; Goodyear D. V. Co. *v.* Root, 6 O. G. 154; Goodyear D. V. Co. *v.* Willis, 7 O. G. 41.

The mere transfer of a mode of constructing wooden slides to metallic slides is not invention. Carter *v.* Messinger, 11 Blatch. 34.

The substitution of an india rubber covering for one of cloth may be an invention if it is important and valuable. Washing Machine Co. *v.* Lincoln, 4 Fish. 379.

A machine or apparatus, or other mechanical contrivance, in order to give the party a claim to a patent therefor, must in itself be substantially new. If it is old and well known, and applied only to a new purpose, that does not make it patentable. A coffee mill applied for the first time to grind oats or corn, or mustard, would not give a title to a patent for the machine. In short, the machine must be new, not merely the purpose to which it is applied. A purpose is not patentable; but the machinery only, if new, by which it is to be accomplished. In other words, the thing itself which is patented must be new, and not the mere application of it to a new purpose or object. Bean *v.* Smallwood, 2 Story, 408; Winans *v.* Bost. & Prov. R. R. Co. 2 Story, 412; Ames *v.* Howard, 1 Sum. 482; Phillips *v.* Page, 24 How. 164; Sawyer *v.* Bixby, 5 Fish. 283; s. c. 9 Blatch. 361; 1 O. G. 165; Tucker *v.* Spaulding, 5 Fish. 297; s. c. 13 Wall. 453; 1 O. G. 144; Smith *v.* Elliott, 5 Fish. 315; s. c 9 Blatch. 400; 1 O. G. 331; Brown *v.* Hall, 3 Fish. 531; s. c. 6 Blatch. 401; Gallahue *v.* Butterfield, 6 Fish. 203; s. c. 10 Blatch. 232; 2 O. G. 645; Roberts *v.* Ryer, 91 U. S. 150; s. c. 6 Fish. 293; 11 Blatch. 11; 3 O. G. 550; 10 O. G. 204; Ex parte Philip Hufeland, 1 O. G. 278; Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; s. c. 31 Leg. Int. 148; Consolidated Fruit Jar Co. *v.* Wright, 12 Blatch. 149; s. c. 6 O. G. 327; 9 C. L. N. 313; Rice *v.* Heald, 13 Pac. L. R. 33.

Invention or discovery is required as the proper foundation for a patent, and where both are wanting the applicant can not legally secure the privilege. Consequently where the claim rests merely upon the application of an old machine to a new use or to a new purpose, or upon the application of an old process to a new result, the patent can not be sustained because, under those circumstances, the patentee has not invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement, or any art, machine, manufacture, or composition of matter not known or used by others, for which alone a patent can be legally granted. Bray *v.* Hartshorn, 1 Cliff. 538; Conover *v.* Roach, 4 Fish. 12.

A mere new use or application of a material or composition previously known is not a new invention. Matthews *v.* Skates, 1 Fish 602.

The application of an old process to a new purpose is not patentable. Piper *v.* Moon, 6 Fish. 180; s. c. 10 Blatch. 264; 3 O. G. 4; Howe *v.* Abbott, 2 Story, 190; Meyer *v.* Pritchard, 12 Blatch. 101; s. c. 7 O. G. 1012.

The production of an old result by new means is patentable. Heinrich *v.* Luther, 6 McLean, 345.

There is scarcely a patent granted that does not involve the application of an old thing to a new use, and that does not, in one sense, fail to involve anything more. But the merit consists in being the first to make the application, and the first to show how it can be made, and the first to show that there is utility in making it. Strong *v.* Noble, 3 Fish. 586; s. c. 6 Blatch. 477.

Old instruments placed in a new and different organization, producing in such new organization different results, or the same results by a new and dif-

ferent mode of operation, do not prevent such newly organized mechanism from being patentable. Clark Patent Co. *v.* Copeland, 2 Fish. 221.

The application of an old process to a new subject without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original, is not patentable. Brown *v.* Piper, 91 U. S. 37; s. c. 1 Holmes, 20; 10 O. G. 417.

A discovery of a new mode of operating an old machine to produce a new result does not give the discoverer the right to a monopoly of the old machine, although he may be entitled to a patent for the process. Boston E. F. Co. *v.* Rubber Thread Co. 1 Holmes, 372; s. c. 5 O. G. 696.

A person who takes something old and applies it in a new way or a new form, so as to produce a particular result, can not be protected beyond the particular way, or form, or device, and the application which he has made. Fuller *v.* Yentzer, 6 Biss. 203; s. c. 11 O. G. 551.

The discovery of a new effect produced by old agents operating by old means upon old subjects, however novel and important, is not patentable. It is nothing more in the eye of the law than the application of a well known agent by well known means, to a new or more perfect use. Morton *v.* N. Y. Eye Infirmary, 2 Fish. 320; s. c. 5 Blatch. 116.

A party can not obtain a patent for a plan of packing ice by putting the blocks on the edge, although he was the first to discover the beneficial effects of that mode, for it is a mere discovery of a new effect of that which existed before. Ex parte John F. Kemper, Cranch Pat. Dec. 89.

A person who not merely supplies the public with a new article, but demonstrates unknown susceptibilities of the material out of which it is made, does something more than merely apply an old thing to a new purpose. He produces a new device by giving a new form to an old substance, and by suitable manipulation makes its peculiar properties available for a use to which it had not been before applied, thereby distinguishing it from all other fabrics of the class to which it belongs. Union Paper Collar Co. *v.* White, 32 Leg. Int. 143.

A new composition of matter to which an old contrivance has been applied, and which results in a new and useful article, is the proper subject of a patent. The novelty consists in the new composition made practically useful for the purposes of life by the means and contrivances mentioned. It would be a new manufacture, and none the less so within the meaning of the patent law, because the means employed to adapt the new composition to a useful purpose was old or well known. Hotchkiss *v.* Greenwood, 11 How. 248; s. c. 4 McLean, 456.

There is nothing new in the multiplication of parts. Wilbur *v.* Beecher, 2 Blatch. 132.

Duplication, producing a new and useful result, may be patentable. It is often the material part of a discovery, because it may be that which renders useful what was previously useless. A number of rollers acting in pairs may be patented, though a single pair could not be. Parker *v.* Hulme, 1 Fish. 44.

Suggestions.

Suggestions from another, in order that they may be sufficient to defeat a patent subsequently issued, must embrace the plan of the improvement, and

must furnish such information to the person to whom the communications are made, that they will enable an ordinary mechanic, without the exercise of any ingenuity and special skill on his part, to construct and put the improvement in successful operation. Agawam Co. *v.* Jordan, 7 Wall. 583; Slemmer's Appeal, 58 Penn. 155; Putnam *v.* Hickey, 5 Fish. 334; s. c. 3 Biss. 157; Matthews *v.* Skates, 1 Fish. 602; Alden *v.* Dewey, 1 Story, 336; Thomas *v.* Weeks, 2 Paine, 92; Pitts *v.* Hall, 2 Blatch. 229; Dixon *v.* Moyer, 4 Wash. C. C. 68.

Although the idea of the invention and hints concerning it came to the patentee from others, still, if he was the first who gave to that idea a useful and practical form, his rights are not to be defeated. Teese *v.* Phelps, 1 McA. 48; Bell *v.* Daniels, 1 Fish. 372; s. c. 1 Bond, 212; Matthews *v.* Skates, 1 Fish. 602; Roberts *v.* Dickey, 4 Fish. 532; s. c. 4 Brews. 260; 1 O. G. 4; Spaulding *v.* Tucker, Deady, 649; McMillin *v.* Barclay, 5 Fish. 189; s. c. 4 Brews. 275.

Neither the inquiries that may have been made, nor the information or advice that may have been received from men of science in the course of the patentee's researches, can impair his right to the character of an inventor. No invention can possibly be made consisting of a combination of different elements of power, without a thorough knowledge of the properties of each of them, and the mode in which they operate on each other. It can make no difference in this respect whether he derives his information from books or from conversation with men skilled in the science. If it were otherwise, no patent in which a combination of different elements is used could ever be obtained, for no man ever made such an invention without having first obtained this information, unless it was discovered by some fortunate accident. O'Reilly *v.* Morse, 15 How. 62; Hubbell *v.* U. S. 5 N. & H. 1.

If the suggestions simply aided the inventor in arriving at the useful result, but fell short of suggesting an arrangement that would constitute a complete machine, and if after all the suggestions there was something left for him to devise and work out by his own skill or ingenuity in order to complete the arrangement, then he is in contemplation of law to be regarded as the first and original discoverer. Pitts *v.* Hall, 2 Blatch. 229.

Although improvements in the form or proportions are adopted in consequence of the suggestions of others, before the invention is brought to perfection, they are not inventions or improvements for which a patent can be obtained, and can not invalidate the patent for the thing to which they are applied. Pennock *v.* Dialogue, 4 Wash. C. C. 538; s. c. 2 Pet. 1; Barker *v.* Woodruff, 1 O. G. 256.

It is not the man who may form an imperfect machine which may suggest to a higher and more practical order of mind valuable ideas, but the man who embodies those ideas in a practical and working form, whom the law protects. Pitts *v.* Edmonds, 2 Fish. 52; s. c. 1 Biss. 168.

If the whole or any of the essential parts and principles of the machine are invented by another, and introduced into the machine upon his suggestion, the whole patent is void. Watson *v.* Bladen, 4 Wash. C. C. 580; Pitts *v.* Hall, 2 Blatch. 229; Agawam Co. *v.* Jordan, 7 Wall. 583.

Where the suggestions of an employee go to make up a complete and per-

fect machine, embracing the substance of all that is embodied in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real invention or discovery belonged to another. Agawam Co. *v.* Jordan, 7 Wall. 583; Berdan F. A. Manuf. Co. *v.* Remington, 3 O. G. 688; Collar Co. *v.* Van Deusen, 23 Wall. 530; s. c. 10 Blatch. 109; 7 O. G. 919; 5 Fish. 597; 2 O. G. 361.

Where an employer has conceived the plan of an invention, and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement which in itself is a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement. Agawam Co. *v.* Jordan, 7 Wall. 583; Andrews *v.* Carman, 13 Blatch. 307; s. c. 9 O. G. 1011.

Where a person has discovered an improved principle in a machine, manufacture or composition of matter, and employs other persons to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent as a part of his invention. Agawam Co. *v.* Jordan, 7 Wall. 583; Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; s. c. 2 Cliff. 555; Blandy *v.* Griffith, 3 Fish. 609; Cogswell *v.* Burke, 1 O. G. 380.

If a workman merely suggests some alterations in the form or proportions of the machine as designed by the inventor, this will not be sufficient to deprive the inventor of the merit of the invention, or affect the validity of his patent. If a contrary doctrine were to be maintained, very few, if any, patents could be upheld, unless in those cases where the inventor is also the mechanic who constructs the machine. His genius may be equal to the task of conceiving all the principles as well as the general structure and form of the machine, but he may be unacquainted with the use of tools, and be quite unable to anticipate in what manner the contemplated form of any particular part of the machine should be made until the work is in progress, and the materiality of form can then be practically discerned. The workman is most likely to perceive the necessity of the alteration, and to suggest it, and such suggestions will not invalidate the patent. Watson *v.* Bladen, 4 Wash. C. C. 580.

Invention is the work of the brain, and not of the hand. If the conception is practically complete, the artisan who gives it reflex and embodiment in a machine is no more the inventor than the tools with which he works. Both are instruments in the hands of him who sets them in motion and prescribes the work to be done. Mere mechanical skill can never rise to the sphere of invention. The latter involves higher thought, and brings into activity a different faculty. Their domains are distinct. The line which separates them is sometimes difficult to trace; nevertheless in the eye of the law it always subsists. The mechanic may greatly aid the inventor, but can not usurp his place. Blandy *v.* Griffith, 3 Fish. 609; Warner *v.* Goodyear, Cranch Pat. Dec. 125.

A party who merely states that a certain article is wanted for a certain purpose, can not obtain a patent for the article if it is prepared by another. Collar Co. *v.* Van Deusen, 5 Fish. 597; s. c. 10 Blatch. 109; 2 O. G. 361; 23 Wall. 530; 7 O. G. 919.

The fact that others, by their zeal, public spirit and money, caused the discovery to be made, can not deprive the patentee of his rights as inventor, if in fact he is the inventor. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

If an officer in the military service, not specially employed to make experiments with a view to suggest improvements, devises a new and valuable improvement in arms, tents, or any other kind of war material, he is entitled to letters patent for the improvement equally with any other citizen not engaged in the service. U. S. *v.* Burns, 12 Wall. 246.

Joint Invention.

In a joint invention each party must invent or discover something essential to the whole result. Slemmer's Appeal, 58 Penn. 155.

A joint patent may well be granted upon a joint invention. There is no difficulty in supposing in point of fact, that a complicated invention may be the gradual result of the combined mental operations of two persons acting together *pari passu* in the invention. As neither of them could justly claim to be the sole inventor in such a case, it must follow that the invention is joint, and that they are jointly entitled to a patent. Barrett *v.* Hall, 1 Mason, 447; Stearns *v.* Barrett, 1 Mason, 153.

If the invention patented by persons as joint inventors is the sole invention of one of the patentees only, and not the joint invention of all, the patent is void. Ransom *v.* New York, 1 Fish. 252; Hotchkiss *v.* Greenwood, 4 McLean, 456; S. C. 11 How. 248; Barrett *v.* Hall, 1 Mason, 447; Slemmer's Appeal, 58 Penn. 155.

A joint patent for an invention is utterly inconsistent with several patents for the same invention by the same patentees, for it is impossible that any person can be at the same time the joint and sole inventor of the same invention. Barrett *v.* Hall, 1 Mason, 447.

A person who is a joint inventor, can not have a patent as sole inventor. Arnold *v.* Bishop, Cranch Pat. Dec. 103.

Novelty.

However new an invention may be, it can not be legally patented unless it is also useful; and however useful it may be, it can not be legally patented unless it is new. If it is either not new or not useful, the patent is void. Matthews *v.* Skates, 1 Fish. 602; Clark Patent Co. *v.* Copeland, 2 Fish. 221; Roberts *v.* Ward, 4 McLean, 565; Tillotson *v.* Munson, 5 Biss. 426.

There must be novelty in the invention created by the mind of the person claiming to be the inventor, and in connection with that species of novelty there must be utility. This novelty worked out by the mind of the inventor, connected with utility, constitutes the essence of a patentable subject under the law. Seymour *v.* McCormick, 19 How. 96; S. C. 3 Blatch. 209.

Articles of manufacture may be new in the commercial sense when they are not new in the sense of the patent law. New articles of commerce are

not patentable as new manufactures, unless it appears in the given case that the production of the new article involved the exercise of invention or discovery beyond what was necessary to construct the apparatus for its manufacture or production. Collar Co. *v.* Van Deusen, 23 Wall. 530; S. C. 10 Blatch. 119; 5 Fish. 597; 2 O. G. 361; 7 O. G. 919; Union Paper Collar Co. *v.* Leland, 1 Holmes, 427; S. C. 7 O. G. 221; M. & H. Glue Co. *v.* Upton, 6 O. G. 837.

To give an exclusive right, there must be what is called a new principle invented, not a new principle in an abstract sense, for none such is likely to be discovered, but a new combination or mode. If there is nothing different in the alleged discovery from a known mode, there can be no invention which gives a new right to the inventor. The ground on which a patent may be claimed is that something new and useful has been invented—a thing which did not exist before—a machine, for instance, differing from all other machines in its structure, movement or effect, by reason of the introduction of some new mechanical combination or principle. Hotchkiss *v.* Greenwood, 4 McLean, 456; S. C. 11 How. 248.

The principle or essential character of an invention involves two elements: 1st. The object obtained; 2d. The means by which it is obtained. If either of these is new, it may be the subject of a patent. Wilton *v.* R. R. Co. 2 Whart. Dig. 358; Batten *v.* Clayton, 2 Whart. Dig. 359.

The novelty required by the patent law does not refer to the materials out of which the article is made, or merely to the form or workmanship of the parts, or the use of one known equivalent for another. To be new in the sense of the patent law some new mode of operation must be introduced. Furbush *v.* Cook, 2 Fish. 668.

The novelty need not consist in the materials used, or the powers employed. But there must be a discovery of new principles, or the employment of old ones in a new proportion, or in a new process, or to a new purpose. Holden *v.* Curtis, 2 N. H. 61.

A new application of a principle by new mechanical contrivances and apparatus, by means of which a new and beneficial result is produced in the use of the article to which it has been thus applied, is patentable. Silsby *v.* Foote, 1 Blatch. 445; S. C. 14 How. 218; Mowry *v.* Whitney, 5 Fish. 515; S. C. 14 Wall. 620; 1 O. G. 499.

One invention may be better than the other, but that fact is not to be taken into account. The one that is alleged to be prior must, however, have been an apparatus of some practical utility; but whether it was superior or inferior in degree is not a question. Silsby *v.* Foote, 2 Blatch. 260; S. C. 20 How. 378; Smith *v.* Elliott, 5 Fish. 315; S. C. 9 Blatch. 400; 1 O. G. 331; Blandy *v.* Griffith, 3 Fish. 609; Fisher *v.* Craig, 3 Saw. 69.

If there is nothing new in the process, or the machinery for applying it, the result is not patentable. Collar Co. *v.* Van Deusen, 5 Fish. 597; S. C. 10 Blatch. 109; 2 O. G. 361; 23 Wall. 530; 5 O. G. 919.

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

The test of novelty as applied to a combination seems to be whether the

application of the powers of nature by such means and appliances as the patentee claims to have invented, had been before known. Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212.

Whether the one device is the same in substance or principle as another, depends on whether it is the same kind of instrument or not, and whether it acts in the same way in substance, and produces the same result in substance. Colt *v.* Mass. Arms Co. 1 Fish. 108; Platt *v.* Manufac. Co. 5 Fish. 265; S. C. 9 Blatch. 342; 1 O. G. 524: Rumford Works *v.* Lauer, 5 Fish. 615; S. C. 10 Blatch. 122; 3 O. G. 349; Singer *v.* Braunsdorf, 7 Blatch. 521; Wilcox *v.* Komp, 7 Blatch. 126; Springer *v.* Stanton, 2 O. G. 2.

The question of identity does not depend upon the appearance or form of the two structures claimed to be identical, but simply upon the question whether they are the same in their mode and principle of operation, and whether one is a mechanical equivalent for the other. Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29.

Change of form is not material when the form does not contribute towards the new result. When it does the forms must be alike in all important particulars. Adams *v.* Edwards, 1 Fish. 1.

In order to determine whether the mechanism of two machines is the same; an examination should be made not only of the mechanism itself, that is, the devices and their arrangement, but also of their mode of operation and their effects and results. Eames *v.* Cook, 2 Fish. 146; Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315; Stainthorp *v.* Humiston et al. 4 Fish. 107; Cook *v.* Ernest, 5 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 189; Waterbury Brass Co. *v.* Miller, 5 Fish. 48; S. C. 9 Blatch. 77.

The question is not whether the alleged prior machine was of the same kind as that of the patentee, but whether it was substantially the same. Washburn *v.* Gould, 3 Story, 122; Smith *v.* Higgins, 1 Fish. 537; Fisk *v.* Church, 5 Fish. 540; S. C. 1 O. G. 634; Bray *v.* Hartshorn, 1 Cliff. 538; Roberts *v.* Schuyler, 12 Blatch. 444; Robertson *v.* Blake, 11 O. G. 877; Butch *v.* Boyer, 8 Phila. 57; S. C. 28 Leg. Int. 396; Ex parte Samuel Van Syckel, 1 O. G. 330; Waterbury Brass Co. *v.* Miller, 5 Fish. 48; S. C. 9 Blatch. 77; Dalton *v.* Jennings, 93 U. S. 271; S. C. 12 Blatch. 96; 5 O. G. 15; 11 O. G. 111; Chase *v.* Sabin, 1 Holmes, 395; S. C. 6 O. G. 728; Dane *v.* Chicago Manuf. Co. 6 Fish. 130; S. C. 3 Biss. 380; 2 O. G. 677; 7 O. G. 924; Tufts *v.* Machine Co. 1 Holmes, 459; S. C. 8 O. G. 239; Decker *v.* Silverbrandt, 8 O. G. 944; G. & B. Manuf. Co. *v.* Walworth, 9 O. G. 746; Lyman V. & R. Co. *v.* Chamberlain, 10 O. G. 588; Boomer *v.* Power Co. 13 Blatch. 107; Fuller *v.* Yentzer, 11 O. G. 597; Plastic Slate Roofing Co. *v.* Moore, 1 Holmes, 167; U. S. Nickel Co. *v.* Keith, 1 Holmes, 328; S. C. 5 O. G. 272; Cochrane *v.* Waterman, Cranch Pat. Dec. 121; Cundell *v.* Parkhurst, Cranch Pat. Dec. 128; Warner *v.* Goodyear, Cranch Pat. Dec. 125.

There must be a substantial difference in the principle and the application of it to constitute such an improvement in a machine as the law will protect. The principle here spoken of is not a new mechanical power. No new power in mechanics has been discovered for centuries, but the powers known have been so modified and combined as to produce the most extraordinary results.

The principle consists in the mode of applying or combining mechanical powers to produce a certain result. Smith *v.* Pearce, 2 McLean, 176.

Strong resemblances in external appearances, similarity of products or operation, are not separately tests of the identity of the plan, construction or purpose of machines, nor is a superiority in products or in operation in one over the other, proof of an essential difference, because the slightest change of a machine which effects a real improvement in it may be patentable, while great apparent variations may be only disguises under which an older discovery is attempted to be employed and appropriated. Carr *v.* Rice, 1 Fish. 198; Howes *v.* Nutt, 4 Fish. 263.

An invention which is valuable for its simplicity and economy can not be antedated by more complex and expensive combinations. King *v.* Hammond, 4 Fish. 488.

The previous use of a structure bearing some resemblance in some respects to the invention of the patentee, and which might have been suggestive of ideas, or have led to experiments resulting in the discovery and completion of his invention, will not invalidate his claim under his patent. Parker *v.* Stiles, 5 McLean, 44; Livingston *v.* Jones, 1 Fish. 521.

Making a prior device which will serve the like useful purpose, is not necessarily anticipating an invention. Where the mechanical means employed are different, and the mechanical result is different, one does not anticipate the other. Buerk *v.* Valentine, 5 Fish. 366; S. C. 9 Blatch. 479; 2 O. G. 295.

A device for applying a mechanical force or power to a new purpose can not be avoided by proving that the mechanical force or power is old. The application of a special spring to operate a churn dash may be new, although the spring is old. Dunbar *v.* Marden, 13 N. H. 311.

If the mechanical combination of the members of two machines is such that the action and mode of operation differ in the two machines, then one is something more than a mere mechanical equivalent for the other, although each element of the combination in one may, under some circumstances, be regarded as the equivalent of the corresponding element in the other, when the elements are separately considered. Blake *v.* Rawson, 6 Fish. 74; S. C. 1 Holmes, 200; 3 O. G. 122.

Where two machines or things are made to operate substantially in the same way, so as to produce a similar result, they are the same in principle. Roberts *v.* Ward, 4 McLean, 565.

If the invention is substantially different from anything before known in its mode of operation, it is new. Lowell *v.* Lewis, 1 Mason, 182; Ex parte W. B. Barton, 1 O. G. 329; Parker *v.* Hatfield, 4 McLean, 61.

If the mechanism in two machines is substantially different, then they are not the same, although they may produce the same result, for the same end may be attained by different processes or instrumentalities. Eames *v.* Cook, 2 Fish 146.

If the mode of operation of two machines is different, it is evidence that the mechanism is different. Eames *v.* Cook, 2 Fish. 146; Ex parte A. F. Jones, 1 O. G. 329.

In a doubtful case, the fact that the defendant has obtained possession of one of the alleged prior machines, and has not produced it, can not but exer-

cise great influence on the determination. Washing Machine Co. *v.* Lincoln, 4 Fish. 379.

When a new invention is sought to be intercepted by a former one, the production of a former machine is of very great importance, showing that it does not rest merely in the recollection of witnesses that there was such a thing. Howe *v.* Underwood, 1 Fish. 160; Murphy *v.* Eastham, 5 Fish. 306; s. c. 1 Holmes, 113; 2 O. G. 61; Orr *v.* Badger, 7 Law Rep. 465; Chase *v.* Wesson, 6 Fish. 516; s. c. 1 Holmes, 274; 4 O. G. 475; Baldwin *v.* Schultz, 5 Fish. 75; s. c. 9 Blatch. 494; 2 O G. 315; Moody *v.* Taber, 1 Holmes, 325; s. c. 5 O. G. 273; Smith *v.* G. E. F. Co. 1 Holmes, 340; s. c. 5 O. G. 429; La Baw *v.* Hawkins, 6 O. G. 724; Hawes *v.* Antisdel, 8 O. G. 685.

The doctrine of equivalents should be critically scanned where there may be a difference in relation to two machines which in some respects operate by equivalent devices, and in other respects do not, to ascertain whether one has become a practical machine while the other is not. Sayles *v.* Railroad Co. 2 Fish. 523.

The results produced constitute a safe kind of evidence which may be relied upon with some degree of certainty in order to ascertain whether the same means are used. Like means, provided the machine is in perfect order, will in a measure produce like results. If like results can not be produced by two separate devices, it is good evidence to consider in determining whether the means are the same, because, as a general rule, like results are produced by like means, and if like results are not produced by two separate devices, it is fair to infer that the means may not be alike in kind or character. Waterbury Brass Co. *v.* New York Brass Co. 3 Fish. 43; Suffolk Co. *v.* Hayden, 4 Fish. 86; s. c. 3 Wall. 315.

It is decisive evidence, though not the only evidence, that a new mode of operation has been introduced if the practical effect of the invention is either a new effect or a materially better effect, or as good an effect more economically attained by means of the change made by the patentee. A new, or improved, or more economical effect attributable to the change made by the patentee in the mode of operation of existing machinery, proves that the change has introduced a new mode of operation which is the subject-matter of a patent. Furbush *v.* Cook, 2 Fish. 668.

If a materially different result is reached, it is evidence of some new cause or means, although the mechanism may apparently be substantially the same. Hence a greater degree of utility being achieved by one machine is evidence, and sometimes conclusive evidence, of novelty in the means or instrumentalities which are used. Eames *v.* Cook, 2 Fish. 146; Roberts *v.* Dickey, 4 Fish. 532; s. c. 4 Brews. 260; 1 O. G. 4.

If the patented invention produce a result decidedly and clearly different from any which has been produced by the action of any prior invention, and is decidedly superior to any other in its operation, it affords a ground for the presumption that the thing itself has not been known before. Judson *v.* Cope, 1 Fish. 615; s. c. 1 Bond, 327.

New capabilities important to the practical use of a machine, are some evidence that the subsequent invention is different from the prior one. Eames *v.* Cook, 2 Fish. 146; Masury *v.* Anderson, 6 Fish. 457; s. c. 11 Blatch. 162;

4 O. G. 55; Child *v.* Bost. & F. Iron Works Co. 6 Fish. 606; S. C. 1 Holmes, 303; 5 O. G. 61.

If the same effects are produced by two machines by the same mode of operation, the principles of each are the same. Whittemore *v.* Cutter, 1 Gallis. 478; Odiorne *v.* Winkley, 2 Gallis. 51.

If the same effects are produced, but by combinations of machinery operating substantially in a different manner, the principles are different. Whittemore *v.* Cutter, 1 Gallis. 478.

Novelty in Combinations.

When the patent is for a combination, it is immaterial whether the patentee is the inventor of any of the elements or ingredients. They may all be old, and yet if the patentee was the first to combine them for the particular purpose, he is entitled to be protected in that improvement. Silsby *v.* Foote, 20 How. 378; S. C. 2 Blatch. 260; Carr *v.* Rice, 1 Fish. 198; Hovey *v.* Stevens, 1 W. & M. 290; Carr *v.* Rice, 1 Fish. 325; S. C. 4 Blatch. 200; Buck *v.* Hermance, 1 Blatch. 398; Hovey *v.* Henry, 3 West. L. J. 153; Gray *v.* James, Pet. C. C. 394; Furbush *v.* Cook, 2 Fish. 668; Buck *v.* Gill, 4 McLean, 174; M'Cully *v.* Cunningham, 19 Pitts. L. J. 142; Ex parte James D. Sturgis, 10 O. G. 204; Evans *v.* Eaton, 3 Wheat. 454; S. C. Pet. C. C. 322; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Crosby *v.* Lapouraille, Taney, 374; Pitts *v.* Edmonds, 2 Fish. 52; S. C. 1 Biss. 168; Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195; Butch *v.* Boyer, 8 Phila. 57; S. C. 28 Leg. Int. 396; Rice *v.* Heald, 13 Pac. L. R. 33; Barrett *v.* Hall, 1 Mason, 447; Stimpson *v.* Woodman, 3 Fish. 98; S. C. 10 Wall. 117; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Roberts *v.* Harnden, 2 Cliff. 500; Connover *v.* Roach, 4 Fish. 12; Ingels *v.* Mast, 6 Fish. 415; Knight *v.* Railroad Co. 3 Fish. 1; S. C. Taney, 106; Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361; Winans *v.* Schenec. & Troy R. R. Co. 2 Blatch. 279; Locomotive Co. *v.* Railway Co. 6 Fish. 187; S. C. 10 Blatch. 292; 3 O. G. 93; Ex parte A. B. Smith, 1 O. G. 403.

A patent for a new combination or arrangement to produce a new result is valid although one of the parts is old. O'Reilly *v.* Morse, 15 How. 62; Hall *v.* Wiles, 2 Blatch. 194; Frink *v.* Petry, 11 Blatch. 422; S. C. 5 O. G. 201; Buck *v.* Hermance, 1 Blatch. 398; Furbush *v.* Cook, 2 Fish. 668; Watson *v.* Cunningham, 4 Fish. 528.

A patent for a combination can not be proved to be invalid by showing that one of the elements is found in some one prior machine and another in another prior machine, until it is shown that all the elements are old, because the theory of such a patent is that the elements are old, and the invention consists merely in the new combination. Union Sugar Refinery *v.* Matthiesson, 2 Fish. 600.

A patent for a combination cannot be supported by evidence of the novelty of one of its parts. Batten *v.* Clayton, 2 Whart. Dig. 363.

If old materials and old principles in mechanics or otherwise, are used in a state of combination so as to produce a new result, the inventor of the article so produced is entitled to apply for and may obtain a valid patent. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

If the combination is new it is patentable matter, although a part of the apparatus might have been applied to similar purposes in other and different machines. Under such circumstances, it would not be a mere application of an old apparatus to a new purpose, but a new combination of machinery incorporating in part an old apparatus for a new purpose. Pitts *v.* Whitman, 2 Story, 609.

If the patentee borrowed the idea of the different parts which go to constitute his invention, and for the first time brought them together into one whole, and that whole is materially different from any whole that existed before, then he is the original and first inventor, and is entitled to a patent therefor. Many *v.* Sizer, 1 Fish. 17.

If not only all the primary elements but all the subcombinations existed in different machines before, but were never brought together to constitute one machine and co-operating to produce one result, and the inventor brings them together by invention, producing a useful result, he is entitled to a patent for such combination and arrangement. Howe *v.* Morton, 1 Fish. 586.

If a device is a substitute for one element of an old combination, and not merely an improvement on it, then a machine containing this substitute and the other old elements, is a new and different machine from a machine containing the combination of old elements known before the invention, and not merely an improvement on such machine containing such combination of old elements. Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 206.

Although the ingredients in a combination of materials may have been in the most common and extensive use, yet, if they have never been combined together in the manner stated in the patent, the invention of the combination is patentable. Ryan *v.* Goodwin, 3 Sum. 514.

Priority.

No person who is not at once the first as well as the original inventor, by whom the invention has been perfected and put into actual use, is entitled to a patent. A subsequent inventor, although an original inventor, is not entitled to any patent. If the invention is perfected and put into actual use by the first and original inventor, it is of no consequence whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons or even to the first inventor himself. It is sufficient that he is the first inventor to entitle him to a patent, and no subsequent inventor has a right to deprive him of the right to use his own prior invention. Spring *v.* Packard, 7 O. G. 341; Burrows *v.* Lehigh Zinc Co. 31 Leg. Int. 332; Reed *v.* Cutter, 1 Story, 590; Watson *v.* Bladen, 4 Wash. C. C. 580; Stimpson *v.* Woodman, 3 Fish. 98; S. C. 10 Wall. 117; Sayles *v.* Hapgood, 3 Fish. 632; S. C. 2 Biss. 189; Carr *v.* Rice, 1 Fish. 198; Roberts *v.* Ward, 4 McLean, 565; Larabee *v.* Cortian, 3 Fish. 5; S. C. Taney, 180; Wing *v.* Schoomaker, 3 Fish. 607; Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315; Boston E. F. Co. *v.* Rubber Thread Co. 1 Holmes, 372; S. C. 5 O. G. 696; Bridge *v.* Brown, 1 Holmes, 13; Bedford *v.* Hunt, 1 Mason, 302; Darst *v.* Brockway, 11 Ohio, 462.

The patent law goes undoubtedly upon the ground that when a man, by his knowledge and skill, has made and perfected a machine, the public are

then put in possession of the invention, and have the benefit in some form of that knowledge and skill, and that the man who comes afterward can not deprive the public of that benefit, though he may be an original inventor of the machine. He has not given the consideration for an exclusive privilege, because the public had it before, and although he may have the merit of invention, he can not have the right to take from the community that which they possess by the invention of another. Howe *v.* Underwood, 1 Fish. 160.

If the prior inventor made the article, for whatever purpose, he has a right to say that no one else is entitled to a patent for it, although he did not perceive all its advantages. Richardson *v.* Lockwood, 6 Fish. 454; S. C. 4 O. G. 398.

The patentee is presumed in judgment of law to have had a knowledge of prior inventions, although the fact may have been otherwise. Silsby *v.* Foote, 2 Blatch. 260; S. C. 20 How. 378.

If the invention has been in use, or has been described in a public work anterior to the supposed discovery, the patent is void. It may be that the patentee had no knowledge of this previous use or previous description, still his patent is void. The law supposes he may have known it. Evans *v.* Eaton, 3 Wheat. 454; S. C. Pet. C. C. 322; Winans *v.* Schen. & Troy R. R. Co. 2 Blatch. 279; Evans *v.* Hettick, 3 Wash. C. C. 408; Sewall *v.* Jones, 7 Wheat. 453; S. C. 3 Wash. C. C. 408.

If the alleged prior machine is abandoned after experimental trials as useless, a presumption will arise that the alleged invention is not identical with one subsequently patented to another person, the merits and utility of which are proved by its general use and admitted superiority over all others. Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315; Parham *v.* Sewing Machine Co. 4 Fish. 468; Allen *v.* Blunt, 2 W. & M. 121; Blake *v.* Eagle Works Manuf. Co. 4 Fish. 591; S. C. 3 Biss. 77.

In order to entitle a person to a patent, he must be the original inventor, not only in relation to the United States, but to other parts of the world. Sewall *v.* Jones, 91 U. S. 171; S. C. 9 O. G. 47; 6 Fish. 343; 3 O. G. 630.

A patent can not be obtained for an invention known and practiced in a foreign country. A patentee must be an inventor, not an importer. Thompson *v.* Haight, 1 U. S. L. J. 582.

It is a presumption of law that when a patent has been obtained, and the specifications and drawings recorded in the patent office, every man who subsequently takes out a patent for a similar machine has a knowledge of the preceding patent. Odiorne *v.* Winkley, 2 Gallis. 51.

A subsequent inventor can not oust the first inventor of his right under his patent, although he may be a subsequent inventor without any knowledge of the prior existence of the machine, or communication with the first inventor. Woodcock *v.* Parker, 1 Gallis. 438.

If the original inventor chooses not to obtain a patent for his invention, it becomes public property by his abandonment, and no other person can obtain a patent for it. Evans *v.* Eaton, Pet. C. C. 323; S. C. 3 Wheat. 454; Colt *v.* Mass. Arms Co. 1 Fish. 108; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29.

Date of Invention.

The date of the invention as perfected and reduced to successful use is important, for, by the rules of law, when a dispute arises as to the priority of an invention, a patentee is allowed to show the real date of it. Parker *v.* Hulme, 1 Fish. 44; Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327.

The question of priority is not one of scientific precedence. It is purely a question of invention applied in a practical form to a specific use. French *v.* Rogers, 1 Fish. 133.

The mere speculation of a philosopher or a mechanician, which has never been tried by the test of experience, or put into practical operation, will not deprive a subsequent inventor, who has employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. Bedford *v.* Hunt, 1 Mason, 302.

The mere suggestion of the idea of an application of a principle to practical purposes will not defeat the claim of the patentee, if no such application was made before he made it, for the person who first reduces the idea to practical application and use is entitled to a patent. Silsby *v.* Foote, 1 Blatch. 445; S. C. 14 How. 218.

The mere conception of the invention, however perfect the idea may have been, and although the inventor actually described the plan to one person, is not sufficient, unless he completed the invention and reduced it to practice in the form of an operative machine. Original and first inventors are entitled to the benefits of their inventions, if they reduce them to practice and reasonably comply with the requirements of the patent law in procuring letters patent for the protection of their exclusive rights. While the suggested invention, however, rests merely in the mind of the originator of the idea, it is not completed within the meaning of the patent law. Mere discovery of an improvement does not constitute it the subject-matter of a patent, although the ideas which it involves may be new; but the new set of ideas, in order to become patentable, must be embodied into working machinery and adapted to practical use. White *v.* Allen, 2 Fish. 440; S. C. 2 Cliff. 224; Sickels *v.* Borden, 3 Blatch. 535; Smith *v.* O'Connor, 6 Fish. 469; S. C. 2 Saw. 461; 4 O. G. 633; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62; Putnam *v.* Hickey, 5 Fish. 334; S. C. 3 Biss. 157; Ellithorpe *v.* Robertson, 2 Fish. 83; S. C. 4 Blatch. 307; Masury *v.* Anderson, 6 Fish. 457; S. C. 11 Blatch. 162; 4 O. G. 55; Washburn *v.* Gould, 3 Story, 122; Henry *v.* Stove Co. 9 O. G. 408; Johnson *v.* Root, 2 Fish. 291; S. C. 2 Cliff. 108; Warner *v.* Anders, 11 O. G. 109; Agawam Co. *v.* Jordan, 7 Wall. 583; Winans *v.* N. Y. & Harlem R. R. Co. 4 Fish. 1; Wilton *v.* R. R. Co. 2 Whart. Dig. 360; Webb *v.* Quintard, 5 Fish. 276; S. C. 9 Blatch. 352; 1 O. G. 525.

The time of the invention is neither the date of the patent, nor the time when the idea was first conceived by the inventor. It is the time when the idea is not only distinct and complete in the mind of the inventor, but that idea is reduced to practice and embodied in some distinct form. This must necessarily be some time more or less before the date of the patent, and some time more or less after the first conception of the inventor. When the idea

first enters into the mind of the inventor, it is almost necessarily in a crude and imperfect state. His mind will naturally dwell and reflect upon it. It is not until his reflections, investigations, and experiments have reached such a point of maturity that he not only has a clear and definite idea of the principle and of the mode and manner in which it is to be practically applied to useful purposes, but has reduced his idea to practice, and embraced it in some distinct form, that it can be said he has achieved a new and useful invention. That is the real time of his invention, though it may be months or years before he obtains a patent for it. Matthews *v.* Skates, 1 Fish. 602; Brodie *v.* Ophir Mining Co. 4 Fish. 137.

He is the first inventor in the sense of the statute, and entitled to a patent for his invention, who has first perfected and adapted the same to use, and until the invention is so perfected and adapted to use, it is not patentable. An imperfect and incomplete invention resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not, and indeed can not be patentable, since it is utterly impossible under such circumstances to comply with the fundamental requisites of the statute. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form, would seem to be entitled to a priority of right to a patent therefor. Reed *v.* Cutter, 1 Story, 590; Kinsman *v.* Parkhurst, 1 Blatch. 488; S. C. 18 How. 289; Silsby *v.* Foote, 2 Blatch. 260; S. C. 20 How. 378; Rich *v.* Lippincott, 2 Fish. 1; S. C. 1 Pitts. L. J. 25; White *v.* Allen, 2 Fish. 440; S. C. 2 Cliff. 224; Ellithorpe *v.* Robertson, 2 Fish. 83; S. C. 4 Blatch. 307; Agawam Co. *v.* Jordan, 7 Wall. 583; Whiteley *v.* Swayne, 4 Fish. 117; S. C. 7 Wall. 685; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Hubbell *v.* U. S. 5 N. & H. 1.

How invariable is it that after a great invention has been brought before the world, has become known to the public, and been put in a form to be useful, that people start up in various places and declare that they invented the same thing long ago. These pretended prior inventors had thought of such a thing; had perhaps had a conception of such a thing, but had never carried it to the extent of making it of practical utility, so that the world could obtain possession of it. But when they find that another has completed that which they had begun, they are astonished that they did not see, think they must have seen all that is necessary, and claim that they have invented it. After having seen what has been done, the mind is very apt to blend the subsequent information with prior recollections, and confuse them together. Prophesy after the event is easy prophesy. Howe *v.* Underwood, 1 Fish. 100; Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

It is usually the case when any valuable discovery is made, or any new machine of great utility has been invented, that the attention of the public has been turned to that subject previously, and that many persons have been making researches and experiments. Philosophers and mechanicians may have in some measure anticipated in their speculation the possibility or probability of such discovery or invention; many experiments may have been unsuccessfully tried, coming very near, yet falling short of the desired result. The invention when perfected may truly be said to be the culminating point

of many experiments, not only by the inventor, but by many others. He may have profited indirectly by the unsuccessful experiments and failures of others, but that gives them no right to claim a share of the honor or profit of the successful inventor. It is when speculation has been reduced to practice, when experiment has resulted in discovery, and when that discovery has been perfected by patient and continued experiments—when some new compound, art, manufacture, or machine has been thus produced which is useful to the public, that the party making it becomes a public benefactor, and entitled to a patent. Goodyear *v.* Day, 2 Wall. Jr. 283; U. S. *v.* Hubbell, 5 N. & H. 1; Jones *v.* Vankirk, 2 Fish. 586; Pike *v.* P. & W. R. R. Co. 1 Holmes, 445; S. C. 6 O. G. 575; Reed *v.* Torpedo Co. 3 Fish. 629; Westinghouse *v.* G. & R. Brake Co. 9 O. G. 538; Wood *v.* Rolling Mill Co. 4 Fish. 550; Sayles *v.* C. & N. R. R. Co. 4 Fish. 484; S. C. 3 Biss. 52.

The date of the invention is the date of the discovery of the principle involved, and the attempt to embody that in some machine, not the date of the perfecting of the instrument. But the party can not get a patent till he perfects it in some sense of the word, that is, until he goes on and makes improvements to render it practical and useful. Colt *v.* Mass. Arms Co. 1 Fish. 108; National Oil Co. *v.* Arctic Oil Co 4 Fish. 514; S. C. 8 Blatch. 416; Clark *v.* Scott, 15 Fish. 245; S. C. 9 Blatch. 301; 1 O. G. 4.

The law means by invention not maturity. It must be the idea struck out, the brilliant thought obtained, the great improvement in embryo. The inventor must have that, but if he has that, he may be years in improving and maturing it. It may require half a life, but in that time he must have devoted himself to it as much as circumstances would allow. But the period when he strikes out the plan which he afterwards patents, that is the time of the invention—that is the time when the discovery occurs. Adams *v.* Edwards, 1 Fish. 1.

In order to determine the precise date of an invention, it must be determined at what time the patentee first perfected the intellectual production, or the idea or conception of the thing patented, so that without more inventive power or further trial or experiment, he could have successfully applied it in practice, and could at once have complied with that provision of the statute which requires that an inventor before he shall receive a patent for the invention or discovery, shall deliver to the patent office a written description of his invention, and explain the principles and several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions. And in order to determine whether any other person has invented the same thing patented by the patentee prior to the patentee's invention thereof, the same rule must be applied in determining the date of such alleged prior invention. Ransom *v.* New York, 1 Fish. 252; Stimpson *v.* Woodman, 3 Fish. 98; S. C. 10 Wall. 117.

It is only when some person by labor and perseverance has been successful in perfecting some valuable manufacture by ingenious improvements and labor-saving devices, that his patent is sought to be annulled by digging up some useless, rusty, forgotten contrivances of unsuccessful experimenters Adams *v.* Jones, 1 Fish. 527; Ex parte John C. Birdsell, 1 O. G. 465; Woodward *v.* Dinsmore, 4 Fish. 163; Wood *v.* Cleveland Rolling Mill. 4 Fish.

The alleged prior invention must have been a practical invention capable of performing the object of the maker. Case *v.* Brown, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Harwood *v.* Mill River Co. 3 Fish. 526.

Proof of Invention.

In most cases a sufficient use of the alleged prior invention must be shown to prove that it will accomplish what is claimed, otherwise it rests in the region of mere experiment. Sayles *v.* C. N. R. R. Co. 4 Fish. 584; S. C. 3 Biss. 52.

If the first inventor reduced his theory to practice, and put his machine or other invention into use, the law never would intend that the greater or less use in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the invention. Rich *v.* Lippincott, 2 Fish. 1; S. C. 1 Pitts. L. J. 25.

An experiment may be a trial either of an incomplete mechanical structure, to ascertain what changes or additions may be necessary to make it accomplish the design of its projector, or of a completed machine, to illustrate or test its practical efficiency. Obviously in the first case, the incompleteness of the inventor's efforts, if they are then abandoned, will have no effect upon the rights of a subsequent inventor. But if the experiment proves the capacity of the machine to effect what its inventor proposed, the law assigns to him the merit of having produced a complete invention. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

The fact of making or exhibiting an article never before seen or heard of by the witnesses who prove the fact, is at least *prima facie* evidence of invention, until other evidence is given to prove that the same article was invented, known, or in use at an antecedent period of time, and that the patentee had only embodied the conceptions and the discovery of some other person. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

The only question is whether the patentee is the original inventor of an art not known or used before; consequently it is clearly immaterial whether the first experiment of his invention is made by himself or by others. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

The alleged prior machine, must be a machine completed and reduced to practice, in contradistinction to an experimental machine, or a machine made by the supposed inventor in the prosecution of experiments and inquiries. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Murphy *v.* Eastham, 5 Fish. 306; S. C. 1 Holmes, 113; 2 O. G. 61; Stimpson *v.* Woodman, 3 Fish. 98; S. C. 10 Wall. 117; Eickemeyer Machine Co. *v.* Pearce, 6 Fish. 219; S. C. 10 Blatch. 403; 3 O. G. 150.

The phrase "reduced to practice," does not import the bringing of the invention into use. When applied to an invention, it generally means the reduction of it into such form that it may be used, so as not to be a mere theory.

Heath *v.* Hildreth, Cranch Pat. Dec. 96; Perry *v.* Cornell, Cranch Pet. Dec. 132.

In order to defeat a patent it is sufficient to show that the patentee was not the first and original inventor, without proving that the first inventor had put his invention into practice. Hildreth *v.* Heath, Cranch Pat. Dec. 96.

If a party discovers the practical mode and contrives the practical means of accomplishing a result, he is entitled to a patent for his invention although ignorant of the philosophical or abstract principle which is involved in it. Brown *v.* Piper, 4 Fish. 175; S. C. 1 Holmes, 20; 91 U. S. 37; Woodward *v.* Dinsmore, 4 Fish. 163.

If a patent is for a process, it is not sufficient to show that any prior apparatus could have been used to practice the process. It must appear affirmatively that it actually was put to such practical use. Brown *v.* Piper, 4 Fish. 175; S. C. 1 Holmes, 20; 91 U. S. 37.

The putting of an invention into use is generally strong evidence of a reduction of it to practice. But it may be a completed invention put into a a practical form ready for practical use, and reduced to practice without being put into use in the general acceptation of that word. If the adaptation to use, or even the use itself is merely experimental, the invention is not perfected. But use is not necessarily required in order to show perfection or completion. In respect to most inventions, use not merely experimental is one of the best proofs of the reduction of an invention to practice. But a peice of mechanism may be shown to have been completed and not to have rested in experiment, and to have been capable from its structure of working successfully, so as to deprive a subsequent independent invention of the same thing of the merit of novelty in the patent law, without its being shown that such piece of mechanism was actually used before the making of such subsequent invention. Coffin *v.* Ogden, 3 Fish. 640; S. C. 7 Blatch. 61.

It is not sufficient that some part incorporated into an invention, was perfected so that it did not require further alteration, unless that part could be a machine so as to be of some practical utility. It must have been embodied and connected with a machine which as a whole, taking that part, was of some practical utility, in order to prevent other people coming afterward, from having the benefit of an invention which embraces that, and perfects a machine that renders that part useful. Johnson *v.* Root, 1 Fish. 351.

In order to be perfected in the eye of the law, it is not necessary that the invention shall be carried to a point where there can not be any subsequent improvement, that it shall be made as good as it can possibly be made as a practical machine, but that the invention shall be completed so as to be of some practical utility. It need not be of any high degree if it is of any practical utility, although of a very low degree, and has been completed so as to be of practical utility and considered as completed, then it may be said to be perfected in the eye of the law. Johnson *v.* Root, 1 Fish. 351.

To constitute a prior invention, the party alleged to have made it must have proceeded so far as to have entitled himself to a patent in case he had made an application. Allen *v.* Hunter, 6 McLean, 303.

The making of drawings of conceived ideas, is not such an embodiment of conceived ideas into practical and useful form as will defeat a patent

which has been granted. Ellithorpe *v.* Robertson, 2 Fish. 83; S. C. 4 Blatch. 307.

When the inventor's idea is perfected by a practical adaptation of it in the form of mechanism, a rejected specification, with the drawings, is a valuable guide in ascertaining the date of the invention, the design of the inventor, and the principle, intended functions, and mode of operation of his mechanism, and must therefore, necessarily, be considered in connection with it. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

Although a *caveat* is understood to be filed in order to allow the party to perfect his machine, yet if, in point of fact, the invention had been perfected in the eye of the law, then it is to be deemed perfected, for it may happen that a person may choose to file a *caveat* while he is going on and making improvements upon an invention which he has already completed so as to be of practical utility. Johnson *v.* Root, 1 Fish. 351.

The invention will not date from the filing of the *caveat* unless the *caveat* and the patent are for the same invention. American Pavement Co. *v.* Elizabeth, 4 Fish. 189.

If only a model was made, yet unless a machine capable of being used was made prior to the invention set forth in the patent, then such alleged prior invention never was completed, and can not affect the validity of the patent, although the model was capable of operation for the purpose of experiments. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Stainthorp et al. *v.* Humiston, 4 Fish. 107; Lyman V. & R. Co. *v.* Lalor, 12 Blatch. 303; S. C. 6 O. G. 642; S. & B. Manuf. Co. *v.* Coke Co. 7 O. G. 829.

Witnesses who speak of circumstances occurring many years ago are liable to mistake the particular year, unless they have some evidence of a documentary character or otherwise, or some leading fact in relation to which there can be no error upon which they may rely to show the particular time, and this fact should be borne in mind in weighing their testimony. Sayles *v.* Railroad Company, 2 Fish. 523; S. C. 1 Biss. 468; Smith *v.* Fay, 6 Fish. 446; Parker *v.* Hulme, 1 Fish. 44; Blake *v.* Eagle Works Manuf. Co. 4 Fish. 591; S. C. 3 Biss. 77; Wing *v.* Richardson, 2 Fish. 535; S. C. 2 Cliff. 449; Hawes *v.* Antisdel, 8 O. G. 685; Ely *v.* Monson Manuf. Co. 4 Fish. 64; Baldwin *v.* Schultz, 5 Fish. 75; S. C. 9 Blatch. 494; 2 O. G. 315; Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315; Wood *v.* Rolling Mill Co. 4 Fish. 550.

Abandoned Experiments.

Cases undoubtedly occur where an individual employed in inventing or in making experiments in that behalf, feeling dissatisfied with the results of his efforts, becomes discouraged in prosecuting an investigation, and finally loses all confidence in the prospect of his ultimate success, and under the influence of such discouragements, or from a desire to engage in more profitable business, or to pursue a more pressing or favorite undertaking, decides to break up what he has accomplished, and lays the parts aside, not positively intending to abandon the subject, yet wholly uncertain whether he will ever resume it, or make any further use of the parts so laid aside. Such cases do not show an unconditional abandonment of the undertaking, but an indefinite suspen-

sion of the same, and an entire uncertainty during such suspension whether the interested party will ever furnish the invention to the public. Where an invention is thus voluntarily broken up and laid aside, without any controlling impediment in the way of an application for a patent, and under all the other conditions specified in the preceding proposition, and another in the mean time invents the same thing without any knowledge of that which is so suspended, and reduces the same to practice, applies for and takes out his patent and introduces the patented invention into public use, he must be regarded as the original and first inventor of the improvement. White *v.* Allen, 2 Fish. 440; S. C. 2 Cliff. 224.

It is not enough to defeat a patent already issued that another conceived the possibility of effecting what the patentee accomplished. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. Crude and imperfect experiments, equivocal in their results, and then given up for years, can not be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent. Kinsman *v.* Parkhurst, 1 Blatch. 489; S. C. 18 How. 289; Teese *v.* Phelps, 1 McA. 48; Allen *v.* Hunter, 6 McLean, 303; Webb *v.* Quintard, 5 Fish. 276; S. C. 9 Blatch. 352; 1 O. G. 525; Union Sugar Refinery *v.* Matthiesson, 2 Fish. 600; Whitely *v.* Swayne, 4 Fish. 117; S. C. 7 Wall. 685; Potter *v.* Wilson, 2 Fish. 102; Washburn *v.* Gould, 3 Story, 122.

An unsuccessful experiment abandoned, although involving the same idea or principle, will not invalidate a patent granted to a subsequent inventor who has reduced the invention to successful practice, and published it by obtaining letters patent. If a person has some vague idea of the application of the principle which another party has made available, if he makes numerous trials and long continued experiments, if those trials and experiments never result in such a knowledge upon his part as will enable him to put in successful practice the idea of which he has this vague and undefined notion, he has never become an inventor in the sense of the patent law; he has never embodied the principle so as to make it available for practical use, and the party who embodies the principle and makes it available for practical use is the party who is entitled to a patent and to protection under the patent law. U. S. Nickel Co. *v.* Authes, 5 Fish. 517; S. C. 1 Holmes, 135; 1 O. G. 578; Blake *v.* Rawson, 6 Fish. 74; S. C. 1 Holmes, 200; 3 O. G. 122; Ransom *v.* New York, 1 Fish. 252; Stainthorp *v.* Elkinton, 1 Fish. 349; Taylor *v.* Wood, 12 Blatch. 110; S. C. 8 O. G. 90; Singer *v.* Walmsley, 1 Fish. 558; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Hubbell *v.* U. S. 5 N. & H. 1; Sickles *v.* Borden, 3 Blatch. 535; Smith *v.* Allen, 2 Fish. 572; Roberts *v.* Dickey, 4 Fish. 532; S. C. 4 Brews. 260; 1 O. G. 4; Many *v.* Jagger, 1 Blatch. 372; Seymour *v.* McCormick, 19 How. 96; S. C. 3 Blatch. 209; Sayles *v.* Railroad Co. 2 Fish. 523; S. C. 1 Biss. 468; Whiteley *v.* Swayne, 7 Wall. 685; S. C. 4 Fish. 117; Smith *v.* G. E. F. Co. 1 Holmes, 340; S. C. 5 O. G. 429; Smith *v.* G. D. V. Co. 93 U. S. 487; S. C. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74; La Baw *v.* Hawkins, 6 O. G. 724; Many *v.* Sizer, 1 Fish. 17; Gold & Silver Ore Co. *v.* U. S. Ore Co. 3 Fish. 409; S. C. 6 Blatch. 307; Smith *v.* Fay, 6 Fish. 446; Aultman *v.* Holley, 6 Fish. 534; S. C. 11 Blatch. 304; 5 O. G. 3;

Ex parte Byron Boardman, 1 O. G. 304; Latta *v.* Shawk, 1 Fish. 465; S. C 1 Bond, 259; Winans *v.* N. Y. & Harlem R R. Co. 4 Fish. 1; Reeves *v.* Keystone Bridge Co. 5 Fish. 456; S. C. 9 Phila. 368; 1 O. G. 466; 5 A. L. T. 150; Nicholson *v.* Tremaine, 9 Blatch. 550; Matthews *v.* Skates, 1 Fish. 602; Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315; Doughty *v.* Day, 5 Fish. 224; S. C. 9 Blatch. 262; Gallahue *v.* Butterfield, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645; Decker *v.* Grote, 6 Fish. 143; S. C. 10 Blatch. 331; 3 O. G. 65; Ellithorpe *v.* Robertson, 2 Fish. 83; S. C. 4 Blatch. 307; Stainthorp et al. *v.* Humiston, 4 Fish. 107; Nat'l Spring Co. *v.* Union Car Spring Manuf. Co. 12 Blatch. 80; S. C. 6 O. G. 224; Robertson *v.* Secombe Co. 6 Fish. 268; S. C. 10 Blatch. 481; 3 O. G. 412; Waterman *v.* Thomson, 2 Fish. 461; Hoffman *v.* Aronson, 4 Fish. 456; S. C. 8 Blatch. 324; 4 A. L. T. (N. S.) 110; Singer *v.* Braunsdorf, 7 Blatch. 521; Ball *v.* Murry, 10 Penn. 111; Wilcox *v.* Komp, 7 Blatch. 126.

A machine, in order to anticipate any subsequent discovery, must be perfected, that is, made so as to be of practical utility, and not to be merely experimental, and to end in experiment. The terms "being an experiment" and "ending in experiment" are used in contradistinction to the term "being of practical utility." Until of practical utility, the public attention is not called to the invention. It does not give to the public that which the public lays hold of as beneficial. If it is an experiment only, and ends in experiment, and is laid aside as unsuccessful, however far it may have been advanced, however many ideas may have been combined in it, which subsequently taken up might, when perfected, make a good machine, still not being perfected it has not come before the public as a useful thing, and is therefore entirely inoperative as affecting the rights of those coming afterwards. Howe *v.* Underwood, 1 Fish. 160.

An imperfect embodiment of the idea will not deprive a subsequent inventor of his right to a patent. Richardson *v.* Noyes, 10 O. G. 507.

If the alleged prior machine was merely got up for the purpose of experiment, and not practically tested, it will not be regarded as a perfected invention. The mere knowledge by an individual of a prior mechanical structure similar to the one patented which has not been used practically, will not defeat the novelty of the later patent. Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115.

If it appears that the alleged prior invention or discovery was only an experiment, and was never perfected or brought into actual use, but was abandoned and never revived by the alleged inventor, the mere fact of having unsuccessfully applied for a patent therefor can not take the case out of the category of unsuccessful experiments. Brown *v.* Guild, 23 Wall. 181; S. C. 6 O. G. 392; 7 O. G. 739.

The devices contained in an abandoned experiment can not be used to defeat the patent of an independent and successful inventor. Aultman *v.* Holley, 6 Fish. 534; S. C. 11 Blatch. 304; 5 O. G. 3.

If a process is practiced once as an experiment, and then abandoned, this mere experiment will not be an obstacle to the right of a subsequent inventor. Brown *v.* Piper, 4 Fish. 175; S. C. 1 Holmes, 20; 91 U. S. 37.

The fact that the alleged prior machine was not actually put into practical

use affords grounds for presuming that it was a mere experiment. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592.

The desertion of an invention consisting of a machine never patented may be proved by showing that the inventor, after he had constructed it, and before he had reduced it to practice, broke it up as something requiring more thought and experiment, and laid the parts aside as incomplete, provided it appears that those acts were done without any definite intention of resuming his experiments and of restoring the machine. Seymour *v.* Osborne, 11 Wall. 516; S. C. 3 Fish. 555.

If the inventor produced a complete invention, but was repulsed by the patent office, and abandoned further efforts to secure the full benefit of the invention to himself and the public, such abandonment does not reduce his matured invention to the grade of a mere experiment. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

Use of Invention.

If the prior machine is perfect and capable of use, it is not necessary that it should be actually used, but it must have been capable of such use. Parker *v.* Ferguson, 1 Blatch. 407; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87.

It is not necessary that the prior inventor shall have worked the process with the same degree of skill and success as the patentee attains. It is sufficient if he did it with that degree of success which demonstrated its usefulness. Waterman *v.* Thomson, 2 Fish. 461; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87.

The mere fact that the prior inventor ceased to use his machine, because he had no occasion to do so, is of itself of no importance. Waterman *v.* Thomson, 2 Fish. 461.

If the invention was successful, and no change of mechanism was needed, its use may be altogether discontinued; but this will not give a subsequent inventor the right to take it up and appropriate it exclusively. Shoup *v.* Henrici, 9 O. G. 1162; S. C. 23 Pitts. L. J. 123; 22 I. R. R. 114.

Diligence in Perfecting Invention.

He who invents first has the prior right if he uses reasonable diligence in adapting and perfecting his invention. White *v.* Allen, 2 Fish. 440; S. C. 2 Cliff. 224; Reed *v.* Cutter, 1 Story, 590; Singer *v.* Walmsley, 1 Fish. 558.

It is the right and privilege of a party, when an idea enters his mind in the essential form of invention, to perfect by experiment and reasonable diligence his original idea, so as not to be deprived of the fruit of his skill and labor by a prior patent, if he is the first inventor; but there must be a reasonable diligence looking to all the facts of the case. Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Winans *v.* Schen. & Troy R. R. Co. 2 Blatch. 279; Whitney *v.* Emmett, Bald. 303; National Oil Co. *v.* Arctic Oil Co. 4 Fish. 514; S. C. 8 Blatch. 416.

If two parties are jointly experimenting and equally meritorious, a doubt should be solved in favor of him who first obtains a patent. Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362.

The relation borne to the public by inventors, and the obligations they are bound to fulfil in order to secure for the former protection and the right to remuneration, by no means forbid a delay requisite for completing an invention, or for a test of its value or success by a series of sufficient and practical experiments; nor do they forbid a discreet and reasonable forbearance to proclaim the theory or operation of a discovery during its progress to completion, and preceding an application for protection in that discovery. Kendall *v.* Winsor, 21 How. 322.

No delay in taking out a patent is fatal to the earliest or first inventor, unless he abandons his discovery to the public, or by his consent allows it to be put in public use or on sale for two years before taking out a patent. If there has been no such abandonment or public use, the earliest invention will prevail over a succeeding one, though the latter may be made and used before letters patent are taken out for the first. Allen *v.* Blunt, 2 W. & M. 121; Hildreth *v.* Heath, Cranch Pat. Dec. 96.

If the patentee was induced to believe that his invention had been anticipated, and decided to keep it a secret and practice it for his own benefit, but applied for a patent as soon as he discovered his mistake, he did use reasonable diligence. Ayling *v.* Hull, 2 Cliff. 494.

If the inventor, after he has perfected his invention, unreasonably delays his application for a patent, and other persons before such application is made actually perfect and apply the same invention to practical use, and give the knowledge thereof to the public, and the first inventor, after the knowledge of such subsequent invention or discovery, and its public use, fails to make objection and to apply without unreasonable delay for a patent for his invention, he can not sustain his patent, because he failed to give to the public that consideration for the grant of exclusive privileges upon which all valid patents must be based. Ransom *v.* New York, 1 Fish. 252.

If an inventor has not used reasonable diligence in perfecting and adapting his invention, he will not be protected against a subsequent inventor, although he had previously conceived the idea of the invention, and had sketched it on paper. Reeves *v.* Keystone Bridge Co. 5 Fish. 456; s. c. 9 Phila. 368; 1 O. G. 466; 5 A. L. T. 150; 29 Leg. Int. 124; Carleton *v.* Atwood, 2 A. L. T. R. 129; Kirby *v.* Johnson, 1 O. G. 405; Gates *v.* Benson, 3 A. L. T. (U. S.) 113; Agawam Co. *v.* Jordan, 7 Wall. 583.

Effect of Concealment.

If the first inventor makes the discovery in his closet, and confines the knowledge to himself, such knowledge will not invalidate a subsequent patent to another. Whitney *v.* Emmett, Bald. 303; Rowley *v.* Mason, 2 A. L. T. (U. S.) 106.

It would be strange, indeed, if, because the first inventor would not permit other persons to know his invention, or to use it, he should thereby be deprived of his right to obtain a patent, and it should devolve upon a subsequent inventor, merely from his ignorance of any prior invention or prior use, or that a subsequent inventor should be entitled to a patent, notwithstanding a prior knowledge or use of the invention by one person and yet should be deprived of it by a like knowledge or use of it by two persons. Reed *v.* Cutter, 1 Story, 590.

If the alleged first inventor did not make his discovery public, but used it simply for his own private purpose, and it was finally forgotten or abandoned, such discovery and use will not defeat the rights of a subsequent inventor, if he is an original, though not the first inventor. Gayler *v.* Wilder, 10 How. 477; Hall *v.* Bird, 3 Fish. 595; S. C. 6 Blatch. 438.

If only a single specimen of the alleged prior machine was made, whether capable of use, and whether actually used or not by the party making it for the purpose of testing its operation, it will not invalidate a patent by a subsequent inventor, if it was kept in the possession of the maker from the knowledge of the public, and subsequently broken up, and the essential parts of it did not exist at the time of the subsequent invention, so that the public could derive the knowledge of it from the machine itself, but merely from the memory of the maker. Cahoon *v.* Ring, 1 Fish. 397: S. C. 1 Cliff. 592; Sayles *v.* Railroad Company, 2 Fish. 523; S. C. 1 Biss. 468; Stainthorp et al. *v.* Humiston, 4 Fish. 107; Piper *v.* Brown, 4 Fish. 175.

An inventor who withholds his invention from the public designedly, and with the view of applying it indefinitely and exclusively for his own profit, does not come within the objects or policy of the Constitution or acts of Congress. He does not promote, and if aided in his design would impede, the progress of science and the useful arts. Hence if, during such a concealment, an invention similar to or identical with his own, should be made and patented, or brought into use without a patent, the latter could not be inhibited nor restricted, upon proof of its identity with a machine previously invented and withheld or concealed by the inventor from the public. Kendall *v.* Winsor, 21 How. 322.

If there has been, at any time, and under any circumstances, an accidental discovery similar in character to that which the patentee has patented, but the public obtained no knowledge of the invention, then the invention was not produced by the party who made such discovery. In other words, if the party did not comprehend the invention, he added nothing to his own stock of knowledge, and the fact, if observed by other men, added nothing to the knowledge of science upon that subject. Therefore, the invention was not made until the party contriving, or others observing, the invention, saw that it could be made available for the purpose of producing a result similar to the one which the patentee mentions in his specification. Ransom *v.* New York, 1 Fish. 252.

It is well known that centuries ago discoveries were made in certain arts, the fruits of which have come down, but the means by which the work was accomplished are at this day unknown: the knowledge has been lost for ages; yet, if any one now were to discover an art thus lost, and it were a useful improvement, he would be entitled to a patent. Yet he would not literally be the first and original inventor, but he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention. Gayler *v.* Wilder, 10 How. 477.

Utility.

An invention is not useful which will not enable the operator to accomplish the desired result. Mitchell *v.* Tilghman, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299; Hubbell *v.* U. S. 5 N. & H. 1.

It is not sufficient that the invention is useful for some purpose. If it is impracticable to be used for the purpose for which it was patented, the patent is void. Rowe *v.* Blanchard, 18 Wis. 441.

If no person can make use of the invention advantageously, the patent is void. Dickinson *v.* Hall, 31 Mass. 217; Ross *v.* Wolfinger, 5 O. G. 117; Bliss *v.* Brooklyn, 6 Fish. 289; S. C. 10 Blatch. 521; 3 O. G. 269.

The law does not look to the degree of utility. It simply requires that the invention shall be capable of use, and that the use be such as sound morals and policy do not discountenance. Bedford *v.* Hunt, 1 Mason, 302; Dunbar *v.* Marden, 13 N. H. 311.

The invention must be useful to an appreciable extent, although the measure of that usefulness is not material. Any degree of utility appreciable by a jury is sufficient. Conover *v.* Roach, 4 Fish. 12.

The court will not be very rigid as to the degree of utility. It will not inquire into the precise *quantum* of value, but if the invention is useful in any degree, and not absolutely worthless, the patent will be sustained. Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427; Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511; Ex parte Geo. Richardson, 2 O. G. 3.

The question is not whether the invention is useful beyond all other machines in use for effecting the object for which it was designed, but whether it is capable in some degree of beneficial use, or will in some degree subserve the purpose of its design, or whether on the contrary, it is merely mischievous and injurious, or pernicious, or frivolous and worthless. Dunbar *v.* Marden, 13 N. H. 311; Crouch *v.* Speer, 6 O. G. 187.

If the invention is useful, it is not necessary that the thing patented should be the best possible thing of the kind that could be made. Winans *v.* Schen. & Troy R. R. Co. 2 Blatch. 279; Wilbur *v.* Beecher, 2 Blatch. 132; Crompton *v.* Belknap Mills, 3 Fish. 536.

The law does not require the patentee to prove his discovery to be useful to any eminent or large degree. It is sufficient if it produces an improved article at less cost or with more expedition than other known methods. Carr *v.* Rice, 1 Fish. 193.

The question is not whether the patented machine does its work better or faster than any other machine in the same department of labor. If it is to a certain degree useful and is original with the patentee, it belongs to him alone, whether it does less or more work. Wilbur *v.* Beecher, 2 Blatch. 132.

To what extent an invention must be useful to render it the subject of a patent, will depend on the particular circumstances of each case, and for which no general rule can be given, but it must, in some small measure at least, be beneficial to the community. This utility is to be tested not merely by the benefits which the patentee may obtain, but by the advantages which the public are to derive from it. Langdon *v.* De Groot, 1 Paine, 203.

It is not necessary that the invention should be of general utility. The

word useful is incorporated into the statute in contradistinction to mischievous or immoral. For instance, a new invention to poison people or to promote debauchery, or to facilitate private assassination, is not a patentable invention. But if the invention steers wide of these objections, whether it be more or less useful is a circumstance very material to the patentee but of no importance to the public. All that the law requires is that the invention shall not be frivolous or injurious to the well-being, good policy, or sound morals of society. Lowell *v.* Lewis, 1 Mason, 182; Page *v.* Ferry, 1 Fish. 298; Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Wintermute *v.* Reddington, 1 Fish. 239; Adams *v.* Edwards, 1 Fish. 1; Smith *v.* O'Connor, 6 Fish. 469; S. C. 2 Saw. 461; 4 O. G. 633; Doherty *v.* Haines, 6 O. G. 118; Wilson *v.* Janes, 3 Blatch. 227; Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9; Whitney *v.* Emmett, Bald. 303.

An invention which is neither frivolous nor mischievous, if it be of any use, is embraced within the spirit of the law, whether it be more or less useful. Page *v.* Ferry, 1 Fish. 298; Cook *v.* Ernest, 5 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 89; Many *v.* Sizer, 1 Fish. 17; Westlake *v.* Cartter, 6 Fish. 519; S. C. 4 O. G. 636; Clark Patent Co. *v.* Copeland, 2 Fish. 221; Converse *v.* Cannon, 2 Woods. 7; S. C. 9 O. G. 105; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Winans *v.* Schen. & Troy R. R. Co. 2 Blatch. 279; Bedford *v.* Hunt, 1 Mason, 302; Hoffheins *v.* Brandt, 3 Fish. 218.

The beauty of an ornament is one great test of its utility. Magic Ruffle Co. *v.* Douglass, 2 Fish. 330.

The jury are not to conclude that there is no utility in an improvement from its apparent simplicity, nor from the fact that it may not be the best mode of effecting the result. This last consideration would affect the value of the patent but not its validity. Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212.

In the absence of proof that the thing patented is absolutely frivolous and worthless, the presumption of utility raised by the patent itself, would be sufficient, so far as the question of utility is concerned, to sustain the patent. Parker *v.* Stiles, 5 McLean, 44; Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361; Hays *v.* Sulsor, 1 Fish. 532; S. C. 1 Bond, 279; Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427; Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511; Mowry *v.* Whitney, 3 Fish. 157; S. C. 14 Wall. 620; 1 O. G. 499.

In ascertaining the usefulness of an invention, it is not important that it should be more valuable than other modes of accomplishing the same result, but it must be a practicable method of doing the thing designed, in which its utility will more or less consist. Roberts *v.* Ward, 4 McLean, 565; Winans *v.* Schen. & Troy R. R. Co. 2 Blatch. 279; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516.

The only legal quality or aid which an alleged invention can draw from the art with which it is connected in the specification, is that which relates to its utility. Morton *v.* N. Y. Eye Infirmary, 2 Fish. 320; S. C. 5 Blatch. 116.

Utility in most cases is a question of fact, as it usually depends upon the evidence resulting from actual experiment. Mitchell *v.* Tilghman, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299.

Any saving in labor or expense, is a proper subject to be considered in deciding the question of utility. Hays *v.* Sulsor, 1 Fish. 532; S. C. 1 Bond, 279; Gray *v.* James, Pet. C. C. 476; Simpson *v.* Mad River R. R. Co. 6 McLean, 603; Middletown Co. *v.* Judd, 3 Fish. 141; Watson *v.* Cunningham, 4 Fish. 528; S. C. 19 Pitts. L. J. 142.

That a machine, when first applied in practice, does not perfectly accomplish the work for which it was designed, or does not accomplish all that its inventor supposed it would, is not enough to secure its rejection as a patentable invention. Correction of defects arising from imperfect material, and not involving reorganization of the machine, will not change its fundamental character and subject it to condemnation as impracticable in its original condition. Taken as a whole in its construction and operation, if it is an advance upon the state of the art to which it appertains, furnishing a better though still imperfect method of performing a useful function than was before available, it is not to be discarded as destitute of patentable worth. Seymour *v.* Marsh, 6 Fish. 115; S. C. 9 Phila. 380; 2 O. G. 675.

If a machine can be applied to any beneficial purpose, it is useful. Dickinson *v.* Hall, 31 Mass. 217.

If a patent is not useful for some beneficial purpose, it is void. Lester *v.* Palmer, 86 Mass. 145.

Utility is not an infallible test of originality. The patent law requires a thing to be new as well as useful in order to entitle it to the protection of the statute. Stanley Works *v.* Sargent, 4 Fish. 443; S. C. 8 Blatch. 344.

The effect produced by a change is often an appropriate though not a controlling consideration in determining the character of the change itself. Stanley Works *v.* Sargent, 4 Fish. 443; S. C. 8 Blatch. 344; Monce *v.* Adams, 12 Blatch. 1; S. C. 7 O. G. 177.

If an article is so expensive that manufacturers would not be induced to make it, the fact may be a very important consideration, but is not necessarily conclusive. Many *v.* Sizer, 1 Fish. 17.

An improvement is not useful which, in effecting a subsidiary truth, as arresting the sparks of a locomotive, is destructive of the ends of the principal machine. Wilton *v.* R. R. Co. 2 Whart. Dig. 360.

An invention which constantly exposes the operator to the loss of his life, or to great bodily harm, can not be regarded as useful within the meaning of the patent law. Mitchell *v.* Tilghman, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299

An extensive use of the patented article raises a presumption of its utility. Adams *v.* Edwards, 1 Fish. 1; Rice *v.* Heald, 13 Pac. L. R. 33.

If the invention was useful at the time when it was discovered, the patent will be valid although it has been superseded by later inventions. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62.

The fact that other superior devices have been invented, and have driven it out of use, does not tend to prove that it lacks utility. Cook *v.* Ernest, 5 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 89.

If another person can superadd something which will remove all the defects of an invention, and render it useful, it immediately becomes valuable,

not on account of its own qualities, but because of its capacity to receive the improvement, and with its aid to become useful. Gray *v.* James, Pet. C. C. 476; Ex parte Hymen L. Lipman, 1 O. G. 304.

A patent is void if the machine will not answer the purpose for which it was intended, without some addition, adjustment, or alteration which the mechanic who is to construct it must introduce of his own invention. Burrall *v.* Jewett, 2 Paige, 134.

A machine can not be pronounced useless or impracticable because it is susceptible of improvement which will obviate or prevent embarrassment to its more perfect operation. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

The comparative value of the thing invented is not material so far as the exclusive right is concerned, beyond the fact that the article is useful or of some value. An article made according to a known method may be better than other articles made in the same manner, on account of its superior mechanism, but this is no foundation of an exclusive right. Hotchkiss *v.* Greenwood, 4 McLean, 456; S. C. 11 How. 248; Many *v.* Jagger, 1 Blatch. 372.

The objection that the invention is not useful generally comes with bad grace from a person charged with an infringement, because if the invention is of no utility, then he ought not to use it, and the very fact of his using it shows that his practice and his professions as regards the utility of the invention are very much at variance. Many *v.* Jagger, 1 Blatch. 372; Turrill *v.* Ill. Cent. R. R. Co. 3 Fish. 330; S. C. 2 Biss. 66; Gray *v.* James, Pet. C. C. 394; S. C. Pet. C. C. 476; Robertson *v.* Garrett, 6 Fish. 278; S. C. 10 Blatch. 490; Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361; Rice *v.* Heald, 13 Pac. L. R. 33; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62; Winans *v.* N. Y. & Erie R. R. Co. 1 Fish. 213; S. C. 21 How. 88; Simpson *v.* Mad River R. R. Co. 6 McLean, 603; Middletown Co. *v.* Judd, 3 Fish. 141.

If the defendant has used the invention itself, or something substantially like it, he is estopped from denying its utility, for use implies utility, and it would be fair to presume that the party would not use it if he thought it of no utility. Hays *v.* Sulsor, 1 Fish. 532; S. C. 1 Bond, 279; Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427; Smith *v.* O'Connor, 6 Fish. 469; S. C. 2 Saw. 461; 4 O. G. 633.

What is Patentable.

At common law an inventor has no exclusive right to his invention or discovery. That exclusive right is the creature of the statute, and to that the courts must look to see if the right claimed in a given case is within its terms. The true field of inquiry is to ascertain whether or not the alleged invention set forth in the specification is embraced within the scope of the statute. Morton *v.* N. Y. Eye Infirmary, 2 Fish. 320; S. C. 5 Blatch. 116; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259.

Whatever may be the extent of the terms of the grant under the Constitution, the only power that Congress has exercised is the power to give a patent for a "new and useful art, machine, manufacture, or composition of matter." Singer *v.* Walmsley, 1 Fish. 558.

Principle.

A machine is a concrete thing consisting of parts, or of certain devices and combinations of devices. The principle of a machine is properly defined to be its mode of operation, or that peculiar combination of devices which distinguish it from other machines. A machine is not a principle or an idea. Because the law requires a patentee to explain the mode of operation of his peculiar machine which distinguishes it from others, it does not authorize a patent for a mode of operation as exhibited in a machine. There is no authority in the statute to grant a patent for a principle, or a mode of operation, or an idea or any other abstraction. Burr *v.* Duryee, 2 Fish. 275; S. C. 1 Wall. 531; Stone *v.* Sprague, 1 Story, 270; Case *v.* Brown, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; Sullivan *v.* Redfield, 1 Paine, 441; Barrett *v.* Hall, 1 Mason, 447.

In its naked ordinary sense, a discovery is not patentable. A discovery of a new principle, force, or law operating, or which can be made to operate on matter, will not entitle the discoverer to a patent. It is only where the explorer has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law and connected it with some particular medium or mechanical contrivance by which or through which it acts on the material world, that he can secure the exclusive control of it under the patent laws. He then controls his discovery through the means by which he has brought it into practical action, or their equivalent, and only through them. It is then an invention, although it embraces a discovery. Sever the force or principle discovered from the means or mechanism through which he has brought it into the domain of invention, and it immediately falls out of that domain, and eludes his grasp. It is then a naked discovery, and not an invention. Every invention may, in a certain sense, embrace more or less of discovery, for it must always include something that is new; but it by no means follows that every discovery is an invention. It may be the soul of an invention, but it can not be the subject of the exclusive control of the patentee or the patent law until it inhabits a body, no more than can a disembodied spirit be subjected to the control of human laws. Morton *v.* N. Y. Eye Infirmary, 2 Fish. 320; S. C. 5 Blatch. 116.

The intellectual conception of a possible process, without a potential working of it out, is not patentable. If an inventor merely conceives a mechanical process in his mind, and then sets to work to construct a machine to work that process, and works it out in no other way, and the machine fails to work successfully, then his claim as the inventor of a process is as groundless as his claim as the inventor of a machine. Union Manuf. Co. *v.* Lounsbury, 2 Fish. 389.

The beneficent and imposing character of a discovery can not change the legal principles upon which the law of patents is founded, nor abrogate the rules by which judicial construction must be governed. These principles and rules are fixed and uninfluenced by shades and degrees of comparative merit. They secure to the inventor a monopoly in the manufacture, use, and sale of very humble contrivances of limited usefulness, the fruits of indifferent skill

and trifling ingenuity, as well as those grander products of his genius which confer renown on himself, and extensive and lasting benefits on society. But they are inadequate to the protection of every discovery by securing its exclusive control to the explorer to whose eye it may be first disclosed. A discovery may be brilliant and useful, and not patentable. Morton *v.* N. Y. Eye Infirmary, 2 Fish. 320; S. C. 5 Blatch. 116.

A principle may be embodied and applied so as to afford some result of practical utility in the arts and manufactures, and under such circumstances a principle may be the subject of a patent. It is, however, the embodiment and application of the principle which constitute the grant of the patent. The principle so embodied and applied, and the principle of such embodiment and application, are essentially distinct, the former being a truth of exact science or a law of natural science, or a rule of practice; the latter a practice founded on such truth, law, or rule. Wintermute *v.* Redington, 1 Fish. 239; Wing *v.* Richardson, 2 Fish. 535; S. C. 2 Cliff. 449; Blanchard *v.* Eldridge, 2 Whart. Dig. 358; McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117; Singer *v.* Walmsley, 1 Fish. 558; Sickles *v.* Borden, 3 Blatch. 535.

The distinction between a patent for a principle and a patent which can be supported is, that there must be an embodiment of the principle in some practical mode described in the specification for carrying it into actual effect; and then a patent may be taken out, not for the principle, but for the mode of carrying the principle into effect. However brilliant the discovery of the new principle may be, to make it useful it must be applied to some practical purpose. Short of this no patent can be granted. Le Roy *v.* Tatham, 22 How. 132.

A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever. Le Roy *v.* Tatham, 14 How. 156; S. C. 2 Blatch. 474; Sangster *v.* Miller, 2 Fish. 563; S. C. 5 Blatch. 243; Ex parte B. J. Hobson, 1 O. G. 141; Carr *v.* Rice, 1 Fish. 325; S. C. 4 Blatch. 200; Sickles *v.* Falls Co. 2 Fish. 202; S. C. 4 Blatch. 508; Whittemore *v.* Cutter, 1 Gallis. 478; Brown *v.* Selby, 4 Fish. 363; S. C. 2 Biss. 457; Shaw *v.* Lovejoy, 7 Blatch. 232.

It is not purpose or results that are the subject of patent, but the instrumentality, contrivance or machinery, through the agency of which results are effected. If two inventions are the same in fact, whatever may be claimed by either party in effect, they are one as a necessary legal consequence. Ex parte Rufus S. Merrill, 1 McArthur, 301; S. C. 5 O. G. 120.

A claim for a thing fabricated in a given form, for a specific purpose, and out of materials so united that the combined fabric is impressed with the peculiar qualities which belong to each of its constitutents, is not a claim for a mere abstract result. Union Paper Collar Co. *v.* White, 32 Leg. Int. 143.

Art.

The word "art" in the patent laws, as well as in the Constitution, means a useful art, or a manufacture which is beneficial, and which is required to be described with exactness in its mode of operation, and of course can be protected only in the mode and to the extent thus described. Smith *v.* Downing, 1 Fish. 64.

A patent may be for a new and useful art, but it must be practical; it must be applicable and referrible to something which may prove it to be useful. A mere abstract principle is unsusceptible of appropriation by patent. Evans *v.* Eaton, Pet. C. C. 323; S. C. 3 Wheat. 454.

An art as such may be made the subject of a patent. The constitutional provision under which the patent laws are framed looks to the promotion of "useful arts." The act places "a new and useful art" among the discoveries it proposes to protect, and assigns to it the first place on the list. There is no reason of policy which should deny protection to an art while extending it to the machinery or processes which the art teaches, employs and makes useful. French *v.* Rogers, 1 Fish. 133.

A combination of arrangements and processes to work out a new and useful result, is a new and useful art. A novel process or method of operation that amounts to a successful application of known things to a practical use, is patentable as an art. Roberts *v.* Dickey, 4 Fish. 532; S. C. 4 Brews. 260; 1 O. G. 4.

If the invention is not a machine, manufacture or composition of matter, it must be an art in order to be patentable. Jacobs *v.* Baker, 7 Wall. 295.

Process.

A process *eo nomine* is not made the subject of a patent in any act of Congress. It is included under the general term "useful art." An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device, or combination of mechanical powers and devices, to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes or methods or operations are called processes. A new process is usually the result of discovery; a machine, of invention. It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself. It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations. But the term process is often used in a more vague sense, in which it can not be the subject of a patent. Thus it is said that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means or the use of a machine, as distinguished from a process. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man can not have a patent for the function or abstract effect of a machine, but only for the machine which produces it. Corning *v.* Burden, 15 How. 252; Cochran *v.* Deiner, 11 O. G. 637; S. C. 4 W. L. R. 99; Wood Paper Co. *v.* Fibre Co. 3 Fish. 362; S. C. 6 Blatch. 27; Brown *v.* Piper, 4 Fish. 175; S. C. 91 U. S. 37;

1 Holmes, 20; Smith *v.* Frazer, 5 Fish. 543; S. C. 2 O. G. 175; Tilghman *v.* Morse, 5 Fish. 323; S. C. 9 Blatch. 421; 1 O. G. 574.

"Process," or "method," when used to represent the means of producing a beneficial result, are, in law, synonymous with art, provided the means are not effected by mechanism or mechanical combinations. Brown *v.* Piper, 4 Fish. 175; S. C. 91 U. S. 37; 1 Holmes, 20.

The word principle is used by elementary writers on patent subjects, and sometimes in adjudications of courts, with such a want of precision in its application as to mislead. It is admitted that a principle is not patentable. A principle in the abstract is a fundamental truth, an original cause, a motive; these can not be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new power, should one be discovered in addition to those already known. Through the agency of machinery a new steam power may be said to have been generated. But no one can appropriate this power exclusively to himself under the patent laws. The same may be said of electricity, and of any other power in nature which is alike open to all, and may be applied to useful purposes by the use of machinery. In all such cases the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. Le Roy *v.* Tatham, 14 How. 156; S. C. 2 Blatch. 474; 22 How. 132; Ransom *v.* New York, 1 Fish. 252; Wyeth *v.* Stone, 1 Story, 273; O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Whitney *v.* Emmett, Bald. 303; Lowell *v.* Lewis, 1 Mason, 182; Buchanan *v.* Howland, 2 Fish. 341; S. C. 5 Blatch. 151; Silsby *v.* Foote, 2 Blatch. 260; S. C. 20 How. 378; Poillon *v.* Schmidt, 3 Fish. 476; S. C. 6 Blatch. 299; Smith *v.* Ely, 5 McLean, 76; S. C. 15 How. 137; Hitchcock *v.* Tremaine, 4 Fish. 508; S. C. 8 Blatch. 440; Detmold *v.* Reeves, 1 Fish. 127; Roberts *v.* Dickey, 4 Fish. 532; S. C. 4 Brews. 240; 1 O. G. 4; Blanchard *v.* Eldridge, 2 Whart. Dig. 358; Smith *v.* Downing, 1 Fish. 64; Wood *v.* Cleveland Rolling Mill, 4 Fish. 550; Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212; Shaw *v.* Lovejoy, 7 Blatch. 232.

Where a party has discovered a new application of some property in nature never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying the new property in nature, and hence the inventor has the right to use any means, old or new, in the application of the new property to produce the new and useful result to the exclusion of all other means. Otherwise a patent would afford no protection to an inventor in cases of this description, because if the means used by him for applying his new idea must necessarily be new, then in all such cases the novelty of the arrangement used for the purpose of effecting the application would be involved in every instance of infringement, and the patentee would be bound to make out, not only the novelty in the new application, but also the novelty in the machinery employed by him in making the application. Silsby *v.* Foote, 2 Blatch. 260; S. C. 20 How. 378.

A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts to be performed on the subject-matter

to be transformed and reduced to a different state or thing. Cochrane *v.* Deener, 11 O. G. 637; s. c. 4 Wash. L. R. 99.

The machinery pointed out as suitable to perform a process may or may not be new or patentable, while the process itself may be altogether new, and produce an entirely new result. The process may be patentable irrespective of the particular form of the instrumentalities used. Cochrane *v.* Deener, 11 O. G. 637; s. c. 4 Wash. L. R. 99.

A claim for a process carried into effect by an apparatus is valid. Black *v.* Thorne, 5 Fish. 550; s. c. 10 Blatch. 66; 2 O. G. 388.

He who first utilizes and applies a peculiar property of a material is entitled to a patent for such application, whether he was the first person to discover the peculiarity or not. Mulford *v.* Pearce, 13 Blatch. 173; s. c. 9 O. G. 204.

A new mode or manner of producing a motion may be patentable. Hovey *v.* Stevens, 3 W. & M. 17.

The idea of forcing water from the earth into a well-pit by the use of artificial power when made available by a method whereby it is put to practical use, is patentable as a process. Andrews *v.* Carman, 13 Blatch. 307; s. c. 9 O. G. 1011.

The elements of the process may be old, but when combined for the purpose of putting a new idea to practical use, they constitute a new and useful process. Andrews *v.* Carman, 13 Blatch. 307; s. c. 9 O. G. 1011.

Machine.

Patentable inventions pertaining to machines may be divided into four classes: 1st, entire machines; 2d, separate devices of a machine; 3d, new devices of a machine in combination with old elements, all embraced in one claim, or with separate claims for what is new, together with a claim for the new combination of all the elements; 4th, devices or elements of a machine in combination where all the devices or elements are old. Sanford *v.* Hat Co. 10 O. G. 466.

All machines may be regarded as merely devices by the instrumentality of which the laws of nature are made applicable and operative to the production of a particular result. He who first discovers that a law of nature can be so applied, and having devised machinery to make it operative, introduces it in a practical form to the knowledge of his fellow men, is a discoverer and inventor of the highest grade, not merely of the mechanism, the combination of iron, brass and wood in the form of levers, screws or pulleys, but the force which operates through the mechanical medium, the principle; and this title as a discoverer he may lawfully assert and secure to himself by letters patent, thus establishing his property not only in the formal device, but in the essential principle which his machine was the first to embody, to exemplify, to illustrate, to make operative and to announce to mankind. Parker *v.* Hulme, 1 Fish. 44.

If a party claims a whole machine, it must in substance be a new machine, that is, it must be a new mode, method or application of mechanism to produce some new effect, or to produce an old effect in a new way. Woodcock *v.* Parker, 1 Gallis. 438.

If the patentee is the inventor of a mode of making a machine in a dif-

ferent manner from any ever before made, and it thereby produces a new and useful result by a new combination of old materials, he may claim the whole machine. When there is an addition to an old machine, or part of an old machine, or a mere alteration of some of its subordinate parts, the claim can only be for an improvement; but where the whole mode of forming the thing and its effect is new, it may be claimed as new. Geiger *v.* Cook, 3 W. & S. 266.

A patent may be obtained for a function as embodied in a particular machine, whose mode of operation and general structure are pointed out. Blanchard *v.* Sprague, 2 Story, 164; Parham *v.* Sewing Machine Co. 4 Fish. 468.

A patent for an arrangement to produce a given mechanical result is not a patent for a function, but a patent for the means when especially arranged to produce the result. Renwick *v.* Pond, 5 Fish. 569; S. C. 10 Blatch. 39; 2 O. G. 392.

If the patentee is the inventor of both the apparatus and the process, he may claim the apparatus when employed to work the process. Black *v.* Thorne, 5 Fish. 550; S. C. 10 Blatch. 66; 2 O. G. 388.

A device may be patentable, although it has not in itself, apart from any connection with or application to other known devices or instrumentalities, capacity to produce practically useful results. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

A hotel register constructed to receive advertisements about its margin is patentable as a structure. Hawes *v.* Washburne, 5 O. G. 491; Hawes *v.* Cook, 5 O. G. 493.

A discovery that the attachment of an advertisement permanently to a balloon is a good mode of advertising is not patentable as an apparatus. Gould *v.* Commissioner, 1 McArthur, 410; S. C. 5 O. G. 121.

Combinations.

The word "machine" in the statute includes new combinations as well as new organizations of mechanism, and hence there may be a patent for new combinations of machinery to produce certain effects, whether the machines constituting the combination be new or old. Wintermute *v.* Redington, 1 Fish. 239.

In order to render a combination patentable, the results must be a product of the combination and not a mere aggregate of several results, each the complete product of one of the combined elements. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention. Hailes *v.* Van Wormer, 20 Wall. 353; S. C. 7 Blatch. 443; Booth *v.* Parks, 6 C. L. N. 407; Sarven *v.* Hall, 5 Fish. 415; S. C. 9 Blatch. 524; 1 O. G. 437; Ross *v.* Wolfinger, 5 O. G. 117; Sawyer *v.* Bixby, 9 Blatch. 361.

All the parts or devices of the combination claimed must co-act to produce a given result, in order to form a legitimate combination; and if one part does not co-act with the others, the patent is void for want of unity and co-operation of its several parts. Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115.

A combination to be patentable must produce a different force or effect or result in the combined forces or processes from that given by their separate parts. There must be a new result produced by their union; if not, it is only an aggregation of separate elements. Reckendorfer *v.* Faber, 92 U. S. 347; S. C. 12 Blatch. 68; 5 O. G. 697; 10 O. G. 71.

Either the instrumentalities employed, or the effect caused by their operation must be new to constitute a patentable combination. If substantially the same devices have been used before for a like purpose, or, if they are applied merely to effectuate a method known and practiced before, such employment of them will not be protected by a patent. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

A combination in mechanism must consist of distinct mechanical parts having some relation to each other, and each having some function in the organism. Gale Manuf. Co. *v.* North, 3 Fish. 279; S. C. 5 Blatch. 455.

Where one or more of the parts are new, and the combination is for that reason made to produce a new result, there is something more than a mere aggregation. Gallahue *v.* Butterfield, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645.

If one device performs a different function from that for which it is substituted, it may be patentable in combination with other devices. Irwin *v.* Dane, 9 O. G. 642.

If the arrangement produces a new result, it is patentable as a combination and not a mere aggregation. S. & B. Manuf. Co. *v.* Coke Co. 7 O. G 829.

Such things are patentable as the discoverer undertakes to apply in combination or separately so as to produce new and beneficial results. It need not be a new material. It need not be an entirely new machine. It need not be wholly or throughout a new application. When it is a combination, it must bring some new features into the combination and produce new and beneficial results. It it does that, it is of no matter how slight is the change. Adams *v.* Edwards, 1 Fish. 1.

To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If those elementary parts are so arranged that the successive action of each contributes to produce some one practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts viewed as one entire whole, a valid claim for thus combining those elementary parts may be made. Furbush *v.* Cook, 2 Fish. 668; Birdsell *v.* McDonald, 6 O. G. 682.

If the patentee is the inventor of a new device, he may restrict his claim to the device when used in some special connection. Russell Manuf. Co. *v.* Mallory, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495.

A combination is an entirety. If one of the elements is given up as immaterial and useless, the thing claimed disappears. Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427.

If a combination requires new devices to make it operative, and the several parts, when combined, produce a new result, it is patentable. Buerk *v.* Imhausen, 5 O. G. 752.

If the idea of a combination is a meritorious invention, it will be deemed new, although a competent mechanic could easily adapt the parts. Brown *v.* Whittemore, 5 Fish. 524; S. C. 2 O. G. 248.

A combination which consists only of the application of a piece of rubber to one end of the same piece of wood which makes a lead pencil, is not patentable, for a handle in common does not create a new or combined operation. Reckendorfer *v.* Faber, 92 U. S. 347; S. C. 12 Blatch. 68; 5 O. G. 697; 10 O. G. 71.

In a just sense that is a combination which requires different things, or different contrivances, or different arrangements to be brought together to accomplish the given end. Carver *v.* Braintree Manuf. Co. 2 Story, 432.

An added element which increases the efficiency of a combination of itself effective, is of the nature of an improvement, but when the added element is essential to the production of any useful result, such addition is not an improvement, but its use gives birth to the only patentable, because the first useful combination. Bliss *v.* Brooklyn, 6 Fish. 289; S. C. 10 Blatch. 521; 3 O. G. 269.

A patent for a combination is not a patent for all and each of the parts. Treadwell *v.* Bladen, 4 Wash. C. C. 703.

If a new combination produces a new result, it is patentable. Hawes *v.* Washburne, 5 O. G. 491.

If the different effects produced by a combination were all produced by the same application of machinery in separate parts, and the patentee merely combined them together or added a new effect, such combination would not sustain a claim for the whole machine. Whittemore *v.* Cutter, 1 Gallis 478.

If one element of a proposed combination is covered by a subsisting patent held by another, the patent office can not grant a patent for the whole combined machine, for it can not grant any right in an invention which is the property of another. Larabee *v.* Cortlan, 3 Fish. 5; S. C. Taney, 180.

Manufacture.

A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable, and the latter not. The machine may be substantially old, and the product new. In that event the latter, and not the former would be patentable. Both may be new, or both may be old. In the former case both would be patentable, in the latter neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty or the opposite. The patentability, or the issuing of a patent as to one, in no wise affects the rights of the inventor or discoverer as to the other. They are wholly disconnected and independent facts. Rubber Co. *v.* Goodyear, 2. Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

There is not only a distinction, but a wide difference, between one who merely invents a new method or process by which a well-known fabric, product or manufacture is produced in a cheaper or better way, and the discoverer of a new compound substance or manufacture having qualities never found to exist together in any other material. In the first case the inventor can patent

nothing but his process, and not his composition of matter. In the latter, both are new and original, and both patentable—not severally, but as one discovery or invention. Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356; Goodyear *v.* Wait, 3 Fish. 242; S. C. 5 Blatch. 468; Waterbury Brass Co. *v.* Miller, 5 Fish. 48; S. C. 9 Blatch. 77; Merrill *v.* Yeomans, 1 Holmes, 331; S. C. 5 O. G. 267.

A manufacture or a product of a process may be no novelty, while at the same time the process or agency by which it is produced may be both new and useful. American Wood Paper Co. *v.* Fibre Disintegrating Co. 23 Wall. 566.

A process to obtain an extract from a subject from which it has never been taken may be the creature of invention, but the thing itself, when obtained, can not be called a new manufacture. American Wood Paper Co. *v.* Fibre Disintegrating Co. 23 Wall 566.

An article in common use can not be patented as a new article merely because it is fabricated by the use of new and improved machinery. Draper *v.* Hudson, 6 Fish. 327; S. C. 1 Holmes, 208; 3 O. G. 354; Wooster *v.* Calhoun, 6 Fish. 514; S. C. 11 Blatch. 215.

A product is not patentable on the mere ground that a machine makes it more perfectly than it can be made without a machine, for improvements in degree or quality are not the subject of a patent. Wooster *v.* Calhoun, 6 Fish. 514; S. C. 11 Blatch. 215.

Improvements.

An improvement has essential reference to a subject-matter to be improved. It is not an original, but embraces, and either adds to or alters the original. Page *v.* Ferry, 1 Fish. 298.

An improvement upon an old contrivance, in order to be of sufficient importance to be the subject of a patent, must embody some originality and something substantial in the change, producing a more useful effect and operation. Hall *v.* Wiles, 2 Blatch. 194; Buck *v.* Hermance, 1 Blatch. 398; Smith *v.* Pearce, 2 McLean, 176.

It is not necessary, in any improvement, that the application to the new and useful purpose should be made by the very best apparatus that can be devised. The question does not depend on the degree of usefulness. If the application that was made of the principle operated successfully, so as to be practically useful, although it might not have been the very best, yet it was not a failure. Silsby *v.* Foote, 2 Blatch. 260; S. C. 20 How. 378; Many *v.* Jagger, 1 Blatch. 372.

Particular changes may be made in the construction and operation of an old machine, so as to adapt it to a new and valuable use not known before, and to which the old machine had not been and could not be applied without these changes, and under these circumstances and conditions, if the machine, as changed and modified, produces a new and useful result, it may be patented. Such change in an old machine may consist alone of a new and useful combination of the several parts of which it is composed, or it may consist of a ma-

terial alteration or modification of one or more of the several devices which enter into its construction, or it may consist in adding new devices. Bray *v.* Hartshorn, 1 Cliff. 538; Turrill *v.* Illinois Cent. R. R. Co. 3 Fish. 330; S. C. 3 Biss. 66.

A new device is not in law an improvement upon the machine which it supersedes. It is an improvement on the old machine only in that sense that any new and useful mechanical device to accomplish a given object is an improvement on all other known mechanical devices to accomplish the same object. It is not something in aid of the old mode, and to make the old mode better. It dispenses with and discards the old modes, and substitutes in their place other means to accomplish a useful result. It is not an addition to any old mode, to be used in conjunction with such old mode, and to make such old mode better and more effectual. Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 206.

Any person may make an improvement upon a patent, but all that he can patent is his own invention, that is, the improvement. Colt *v.* Mass. Arms Co. 1 Fish. 108; Larabee *v.* Cortlan, 3 Fish. 5; S. C. 1 Taney, 180; Cochrane *v.* Deener, 11 O. G. 637; S. C. 4 W. L. R. 99; Conover *v.* Roach, 4 Fish. 12.

There is nothing in the statute that forbids an inventor to take out a patent for an improvement upon his invention. Any other inventor may do so, and there can be no reason in justice or in policy for refusing the like privilege to him. When there is no positive law to the contrary, he must stand on the same footing with any other inventor of an improvement upon a previous discovery. Nor is he bound in his new patent to refer specially to his former one. All that the law requires of him is that he shall not claim as new what is covered by a former invention, whether made by himself or any other person. O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Smith *v.* Ely, 5 McLean, 76; S. C. 15 How. 137.

Knowledge and Use.

The words "by others" were added to remove the doubt formerly entertained whether a use by the patentee himself, before his application for a patent, would not deprive him of his right to a patent. They are not designed to denote a plurality of persons by whom the use should be, but to show that the use should be by some other person or persons than the patentee. Reed *v.* Cutter, 1 Story, 590; Wyeth *v.* Stone, 1 Story, 273.

By knowledge and use Congress meant knowledge and use existing in a manner accessible to the public. Gayler *v.* Wilder, 10 How. 477; Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592.

The true meaning of this clause is that the invention must not have been known or used by the public. If it were necessary to employ others to assist in the original structure or use by the inventor himself, or if his invention should be pirated by another, or used without his consent, it can scarcely be supposed that the legislature had within its contemplation such knowledge or use. Pennock *v.* Dialogue, 2 Pet. 1; S. C. 4 Wash. C. C. 538; Ryan *v.* Goodwin, 3 Sum. 514; Shaw *v.* Cooper, 7 Pet. 292; Morris *v.* Huntington, 1 Paine, 348; Jones *v.* Sewall, 6 Fish. 343; S. C. 3 O. G. 630; Treadwell *v.* Bladen, 4 Wash. C. C. 703; Whitney *v.* Emmett, Bald. 303.

Public use is opposed to private use. If a man has an invention and uses it privately, and nobody knows of it, then the use of it can not debar another person from inventing or patenting it. The evidence of a public use as opposed to a private use need not be a general use by the community, but it must be an open use, however, so that the structure and *modus operandi* are apparent. One evidence of public use is the manufacture of an article publicly and openly for sale; not universally but still publicly; not by one person alone, and for his own private use, but the manufacture of it publicly, the offering of it for sale publicly. A man is not to lie by and let the public—several persons—use his invention without objection, because he thus misleads them. He is not to lie by and let it be sold in public stores. Adams *v.* Edwards, 1 Fish. 1.

The first inventor has a right to a patent, though there may have been a knowledge and use of the thing invented by others, before his application for a patent, if such knowledge or use was not anterior to his discovery. Mellus *v.* Silsbee, 4 Mason, 108.

It is not enough to show that a machine like the one described in the patent was made, but there must be proof that it was used prior to the patentee's invention. This is the test of what is required to defeat the title of a patentee of an improved machine. Parker *v.* Hulme, 1 Fish. 44; Pennock *v.* Dialogue, 4 Wash. C. C. 538; s. c. 2 Pet. 1.

A mere application for a patent is not a bar to the granting of a patent to another. It can only have a bearing on the question of prior invention or discovery. Brown *v.* Guild, 23 Wall. 181; s c. 6 O. G. 392; 7 O. G. 739.

The prior use of an alleged invention must be a public use, and not a private use. If an invention is made and used in a private way, and then thrown aside and not given to the public, a patent granted to a subsequent inventor would be a valid patent. Haselden *v.* Ogden, 3 Fish. 378; Cahoon *v.* Ring, 1 Fish. 397; s. c. 1 Cliff. 592.

The greater or less use in which the prior invention may have been, or the more or less widely the knowledge of its existence may have circulated, does not constitute the criterion by which to decide upon the validity of any subsequent patent. Any patent may therefore be defeated by showing that the thing secured by the patent had been discovered and put into actual use prior to the discovery of the patentee, however limited the use or knowledge of the prior discovery may have been. Bedford *v.* Hunt, 1 Mason, 302.

The prior knowledge and use by a single person is sufficient. The number is immaterial. Coffin *v.* Ogden, 18 Wall. 120; s. c. 5 O. G. 270.

Whether the machine was in fact operated for a greater or less time, is of no importance, except so far as that may tend to show that it was or was not a mere experiment; in that view the fact is of some consequence. But if the machine was capable of doing work, then the fact that it was operated but a short time, and abandoned for other reasons than because it failed as a machine, is of no consequence. Stimpson *v.* Woodman, 3 Fish. 98; s. c. 10 Wall. 117.

If a machine has been in public use, whether it fell into disuse or not, a subsequent inventor can not obtain a patent for it so as to exclude others from

using it if they choose to do so. Evans *v.* Hettick, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

It is sufficient to show that the invention was "known or used" by others before the patentee discovered or invented the article or improvement patented, without showing a general use thereof, in order to defeat the patent for want of novelty. Rice *v.* Garnhart, 34 Wis. 453.

An experiment is such a use as the statute contemplates. If the machine is perfected so as to accomplish the function claimed for it, then it would be a use within the meaning of the patent law. Singer *v.* Walmsley, 1 Fish. 558; Rice *v.* Garnhart, 34 Wis. 453.

An experiment with a machine amounts to a using of it within the meaning of the act, although it is found not to answer as well as expected, and is thrown aside. Watson *v.* Bladen, 4 Wash. C. C. 580.

The imparting of a knowledge of the construction of the mechanism to persons connected with the business to which it appertains, who saw it and understood its arrangement, is the giving to the public of such a knowledge of it as a completed invention as will deprive a subsequent inventor of the right to be considered in law as the first inventor thereof. Coffin *v.* Ogden, 3 Fish. 640; s. c. 7 Blatch. 61.

Patent.

A patent should not be granted when the right to it is doubtful. Ex parte John F. Kemper, Cranch Pat. Dec. 89.

There seems to have been no good reason at first, unless it were a fiscal one, on the part of the Government when issuing patents why more than one invention in favor of the same inventor should not be embraced in one instrument, like more than one tract of land in one deed or patent for land. Each could be set out in separate articles or paragraphs as different counts for different matters in libels in admiralty, or declarations at common law, and the specifications could be made distinct for each and equally clear. But to obtain revenue, the public officers have generally declined to issue letters for more than one patent described in them. The courts have been disposed to acquiesce in the practice as conducive to clearness and certainty, and if letters issue otherwise inadvertently, to hold them, as a general rule, null. Hogg *v.* Emerson, 6 How. 437; s. c. 2 Blatch. 1.

If two machines are patented by the same patent which are wholly independent of each other, and distinct inventions for unconnected objects, the patent is void. The same rule applies to a patent for several distinct improvements upon different machines having no common object or connected operation. For if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might choose at his own mere pleasure in one patent, which seems to be inconsistent with the language of the statute, which speaks of the thing patented and not of the things patented, and of a patent for an invention, and not of a patent for inventions. Wyeth *v.* Stone, 1 Story, 273; Evans *v.* Eaton, 3 Wheat. 454; s. c. Pet. C. C. 322; Moody *v.* Fiske, 2 Mason, 112.

A patent in which *ex majore cautela*, the improvement has been unnecessarily split into three distinct patents, may be treated as one patent with three distinct claims. Pennsylvania Salt Manuf. Co. *v.* Guggenheim, 3 Fish. 423.

It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvement shall be embraced in one, two, or more patents. Some discretion must necessarily be left to the commissioner. It is often a nice and perplexing question. Bennett *v.* Fowler, 8 Wall. 445; Goodyear *v.* Wait, 3 Fish. 242; S. C. 5 Blatch. 468.

A patent may be taken out for several machines, if it is a patent for each machine as a distinct and independent invention, but for the same common purpose and auxiliary to the same common end. The patentee may lawfully unite in one patent all the modes in which he contemplates the application of his invention, and all the different sorts of machinery or modifications of machinery by which or to which it may be applied, and if each is new there is no just ground of objection to his patent reaching them all. *A fortiori*, this rule is applicable where each of the machines is but an improvement or invention conducing to the accomplishment of one and the same general end. Wyeth *v.* Stone, 1 Story, 273; Hogg *v.* Emerson, 6 How. 437; S. C. 2 Blatch. 1; 11 How. 587; Densmore *v.* Schofield, 4 Fish. 148; McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117.

The same patent may embrace a combination and the elements which make up the combination. Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Jacques *v.* Wells, 5 O. G. 364; Root *v.* Ball, 4 McLean, 177.

If the patentee has invented certain improved machines which are capable of a distinct operation, and has also invented a combination of those machines to produce a connected result, the same patent can not be at once for the combination and for each of the improved machines, for the inventions are as distinct as if the subjects were entirely different. Barrett *v.* Hall, 1 Mason, 447.

There may be a patent for a combination of many parts, and at the same time for an arrangement of some of the parts constituting another combination, but still a part of the larger. Yet if there is no patent for the constituents they are open to the public for use in combination, provided all the elements of the patented combination are not employed. Garratt *v.* Seibert, 7 Pac. L. R. 116; S. C. 22 Pitts. L. J. 18.

It is no objection to the validity of a patent that it contains a claim for a machine combining several distinct improvements, each of which is the invention of the patentee, and claims for each of these several and distinct improvements. In other words the patentee may, in such a case, take out a valid patent for the combination, and also include therein a right to each distinct improvement severally contained in the same machine. Pitts *v.* Whitman, 2 Story, 609.

The patentee may embrace two improvements on the same machine in the same patent. Morris *v.* Barrett, 1 Fish. 461; S. C. 1 Bond, 254; Moody *v.* Fiske, 2 Mason, 112.

Although an improvement is practically useful and operative only when taken in connection with other mechanical devices, yet it may be the subject of a separate claim. Jacques *v.* Wells, 5 O. G. 364.

If an inventor has invented a new process producing a new product, he may take a separate patent for each. Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; 91 U. S. 171; 9 O. G. 47.

When an inventor gets all that he has invented or discovered in one claim, it is better that he should not be permitted to set up and embarrass the public

with another claim which gives no additional security or protection to his invention. Putnam *v.* Yerringer, 9 O. G. 689.

The fact that a single invention is made the subject of two distinct claims in the same specification—in other words is claimed twice—will not render the patent void. The blemish is mere tautology which, while it may make the instrument less clear and exact, will not impair its validity. Tompkins *v.* Gage, 2 Fish. 577; S. C. 5 Blatch. 268.

Where a specification, by ambiguity and a needless multiplication of nebulous claims, is calculated to mislead and deceive the public, the patent is void. Carlton *v.* Bokee, 6 Fish. 40; S. C. 17 Wall. 463; 2 O. G. 520.

One void claim does not vitiate the entire patent, if made by mistake or inadvertence, and without any willful default or intent to defraud or mislead the public. Carlton *v.* Bokee, 6 Fish. 40; S. C. 17 Wall. 463; 2 O. G. 520.

If two separate patents are issued at the same time for the same invention, they are both void. Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; 91 U. S. 171; 9 O. G. 47.

A grant of a subsequent patent for an invention is an estoppel to the patentee to set up any prior grant for the same invention which is inconsistent with the terms of the last grant. Barrett *v.* Hall, 1 Mason, 447.

An inventor can have but a single valid patent for his invention. The first he obtains, while it remains unrepealed, is an estoppel to any future patent for the same invention. The public by the first patent acquire an inchoate interest which can not be defeated by any merely ministerial acts of the officers of the Government. Odiorne *v.* Amesbury Nail Factory, 2 Mason, 28; Morris *v.* Huntington, 1 Paine, 348; Treadwell *v.* Bladen, 4 Wash. C. C. 708; Sickels *v.* Falls Co. 2 Fish. 202; S. C. 4 Blatch. 508.

If two patents are obtained for the same invention, the last and not the first is void. Suffolk Co. *v.* Hayden, 3 Wall. 315; Morris *v.* Huntington, 1 Paine, 348; Johnson *v.* Fassman, 5 Fish. 471; S. C. 1 Woods, 138; 2 O. G. 94.

The patentee can not in a court of law show that the first patent is void. It being issued on his own representation, and according to his own specification as to the extent of the right claimed, he is estopped by his own act. Morris *v.* Huntington, 1 Paine, 348.

No subsequent patent can take away rights secured by a prior patent. Sickels *v.* Tileston, 4 Blatch. 109; Stuart *v.* Shantz, 6 Fish. 35; S. C. 9 Phila. 376; 2 O. G. 524.

A patent is not necessarily void by reason of an error in the christian name of the grantee, where it supplies on its face an added description by which the patentee may be certainly identified. Extrinsic proof is admissible to identify the patentee, and if he is thus identified, effect will be given to the grant accordingly. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

Invention.

An article to be patentable must not only differ from others, but must also indicate, at least in some degree, an exercise of inventive genius Levi C. Coodale, 2 O. G. 589; Watts Cooke, 1 Dec. Com. 6; E. R. Fenno, 1 Dec. Com. 9; James Murphy, 1 Dec. Com. 24; Lewis Abraham, 1 Dec. Com. 59; Stevens & Powers, 1 Dec. Com. 63; P. W. Dean, 1 Dec. Com. 77; R. M. Thompson, 1 Dec. Com. 81; H. M. Biedler, 1 Dec. Com. 91; Thomas M. Taylor, 1 Dec. Com. 3; J. C. Gaston, 2 Dec. Com. 12; Samuel Sharrock, 2 Dec. Com. 46; Abner H. Love, 2 Dec. Com. 79; G. W. Schermerhorn, 2 Dec. Com. 122; P. Millspaugh, 2 Dec. Com. 134; Moule & Bannehr, 2 Dec. Com. 87; Jonathan Dennis, Jr. 3 Dec. Com. 107; Milligan & Higgins, 3 Dec. Com. 215; James McColgan, 6 O. G. 327; George W. Lavees et al. 9 O. G. 921; Julius Gerson, 11 O. G. 244; Wm. S. Hicks, 10 O. G. 112; Bates *v.* Geeger, 2 O. G. 492; A. N. Towne, 1 Dec. Com. 39; J. H. Sherwood, 6 O. G. 361; M. G. Slemmons, 6 O. G. 604; Charles H. Ackerson, 1 Dec. Com. 74; A. T. Barnes, 1 Dec. Com. 81; B. E. Hale, 2 Dec. Com. 14; Alanson Cary, 2 Dec. Com. 38; Robert Price, 2 Dec. Com. 48; Samuel Blue, 2 Dec. Com. 89; Henry Heath, 3 Dec. Com. 212; W. B. G. Taylor, 3 Dec. Com. 309; George Petry, 3 Dec. Com. 325; Henry W. Gould, 4 O. G. 611.

A distinction must be drawn and maintained between invention and skill or good judgment. D. E. Aiken, 2 O. G. 274; Hall & Hall, 2 O. G. 589, Stout, T. B 1 Dec. Com. 4; Powers & Stevens, 1 Dec. Com. 45; Waldemar Petersen, 1 Dec. Com. 47; J. A. Smith, 1 Dec. Com. 83; J. W. Sheppard, 3 Dec. Com. 59; Samuel Thacker, 3 Dec. Com. 84; William H. Foye, 3 Dec. Com. 188; Lewis J. Atwood, 6 O. G. 223; McLaren & Coventry, 10 O. G. 335; Chambers *v.* Tucker, 11 O. G. 1009.

The first inventor of a new and useful device is entitled to a patent, even if its production was accidental and not appreciated at the time. Garratt *v.* Siebert, 2 O. G. 469.

The mere knowledge that certain things might be done, and would be valuable, does not amount to the conception of an invention. Wicks *v.* Dubois, 11 O. G. 244.

There is no novelty in practicing on a small scale what has been practiced on a large one before, or in practicing it for a different purpose. Woodward *v.* Reist, 1 Dec. Com. 34.

A conception may of itself require invention, and be novel and patentable, though it requires no ingenuity to put it in practice. Henry Waterman, 1 Dec. Com. 51.

An improvement of an existing device rendering its parts more adjustable in a manner well known, and by the exercise of mechanical skill and judgment alone, is not patentable. Henry Gross, 11 O. G. 739.

An incomplete conception of a device does not constitute invention as defined either by the courts or the office. Gordon *v.* Withington, 9 O. G. 1009.

An objection to an application may concede that the article is new, but deny that any invention was involved in its production, and no reference is required to establish this ground of rejection. W. H. Wilkinson, 2 Dec. Com. 22; G. Hibbard, 4 O. G. 54.

If novelty or usefulness is established, invention must be presumed. Morse *v.* Clark, 1 O. G. 275.

Perfected conception is invention. It is sufficient to describe it so accurately, even orally, as to enable an expert to make the thing conceived. Woodbury *v.* Wilcox, 2 A. L. T. R. 129.

When doubt exists as to the applicant's right to a patent, the fact that the granting thereof can do no harm to the public has some weight in determining the action of the office. Charles P. Mixer, 1 O. G. 48.

Doubts as to patentability, in cases when a really new thing is produced, ought to be resolved in favor of the inventor; and where he presents a new combination, he is entitled to a liberal consideration of it. Thomas Bond, 2 Dec. Com. 2.

If an instrument is the first which has accomplished the desired object, it should receive a patent, although the improvement upon what was known before seems to be such as an ordinary mechanic could have produced. Jeremiah Kenney, 1 Dec. Com. 95; J. J. Urmston, 2 Dec. Com. 13; James R. Hyde, 3 Dec. Com. 109.

Where parts are dispensed with, and other devices employed in their places, rendering certain additions necessary, there is presumptive evidence of invention as distinguished from mere skill. J. G. & J. S. Armstrong, 2 O. G. 704; David F. Fetter, 2 Dec. Com. 175; Geo. W. Nesmith, 3 O. G. 268; Charles Frazier, 6 O. G. 681.

Liberal encouragement should be given to the authors of inventions, yet no needless restraint should be placed upon citizens in the exercise of their judgment and skill. Amos M. Smith, 2 O. G. 674; Geo. W. Blake, 1 Dec. Com. 9; Joseph Thorne, 1 Dec. Com. 76.

Inventions in Change.

The mere application of an old device to an old purpose is not patentable. David H. Morrison, 2 Dec. Com. 50; John Underwood, 2 Dec. Com. 52; J. R. Bugbee, 2 Dec. Com. 63; Nathan Martz, 2 Dec. Com. 18; Streeter *v.* Stoddard, 2 Dec. Com. 91; Daniel Hallady, 3 Dec. Com. 302; James F. Garratt, 5 O. G. 148; G. T. Smith, 6 O. G. 470.

A patent will be refused where the new application of an old process is but a double use of it. E. C. Little, 1 Dec. Com. 25; H. M. Carter, 1 Dec. Com. 96; William Thie, 2 Dec. Com. 61; Osborne & Dayton, 2 Dec. Com. 149; Jas. T. Cree, 3 Dec. Com. 83; Hall & Averill, 3 Dec. Com. 194; James Arkell, 3 Dec. Com. 257; John Stephenson, 5 O. G. 363; Bloomfield Brower, 7 O. G. 40.

The mere application of an old article to a new use does not involve invention. Dewitt C. Baxter, 2 O. G. 470; E. J. Webster, 1 Dec. Com. 9; Charles H. Ackerson, 1 Dec. Com. 74; Wm. Linden, 1 Dec. Com. 108; Ira D. Warner, 1 Dec. Com. 109; Adams Glasgow, 2 Dec. Com. 40; D. N. B. Coffin, Jr., 2 Dec. Com. 62; A. J. Dexter, 2 Dec. Com. 90; Benjamin Greeley, 2 Dec. Com. 106; Franklin H. Webb, 1 Dec. Com. 78; Kuder Seiple, et al. 2 Dec. Com. 117; Charles Powell, 2 Dec. Com. 134; Milton G. Wood, 2 Dec. Com. 180; Hermann A. Gunther, 3 Dec. Com. 199; Holmes & Gilmore, 3 Dec. Com. 204; E. S. Renwick, 3 Dec. Com. 214; John E. Atwood, 3 Dec. Com. 216; J. B. Slawson, 3 Dec. Com. 281; J. C. Cooke, 3 Dec. Com. 294; William Molseworth, 3 Dec. Com. 308; L. C. Clark, 3 O. G. 239; B. B. Keyes, 3 O. G. 268; Joseph H. Sperry, 3 O. G. 467; Ellicott D. Averill, 8 O. G. 400; M. E. Berolzheimer, 2 Dec. Com. 33; J. G. G. Ganet, 2 Dec. Com. 48; H. J. Wickham, 2 Dec. Com. 61; Charles H. Toll, 4 O. G. 500; Josiah Holmes, 8 O. G. 1.

When adaptation is required to secure a new result by applying an old device to a new use, invention is presumed, and the new organization may be patentable. Levi Stevens, 1 O. G. 223.

The application of an old deviee to a different and not analogous purpose may be patentable. Murdick Lytle, 1 O. G. 359.

The employment of an old device in a new or modified way to produce a new and useful result is patentable. John Burnham, 1 O. G. 164.

The mere exchange of a feature of a device for a different but not novel one of the same kind, to be used in the same way, does not indicate invention. Lloyd *v.* Engeman, 2 O. G. 674; R. A. Leeds, 1 Dec. Com. 13; Sherrell & Warner, 1 Dec. Com. 15; Louis S. Robbins, 1 Dec. Com. 84; George

Schoenberg, 2 Dec. Com. 36; R. J. Gatling, 2 Dec. Com. 92; Samuel S. McNaughton, 4 O. G. 525; R. D. Young, 6 O. G. 361.

The mere substitution of one material for another does not produce invention. J. P. Chattillon, 2 O. G. 115; Philip C. Schuyler, 2 O. G. 174; P. A. Sabatton, 2 O. G. 703; P. Y. Brown, 1 Dec. Com. 18; Dimond & Doolittle, 1 Dec. Com. 64; L. B. Hamilton, 2 Dec. Com. 14; A. H. Baldwin, 2 Dec. Com. 50; John Farrel, 2 Dec. Com. 105; R. R. Miller, 2 Dec. Com. 114; L. E. Truesdell, 2 Dec. Com. 123; M. Landenberger, 3 Dec. Com. 179; J. W. Wattles, 3 O. G. 291; P. M. J. Chamblant, 4 O. G. 106.

The substitution of one mechanical equivalent for another is not patentable. John D. Wilber, 1 O. G. 379.

A patent may be granted where a different method of operation is produced, and an improvement made by the substitution of one old device for another. John K. Bigelow, 2 O. G. 273; J. J. Munger, 1 Dec. Com. 3; Samuel Sykes, 1 Dec. Com. 9; G. W. Adwen, 1 Dec. Com. 23; J. P. Tuttle, 2 Dec. Com. 3; Jason A. Bidwell, 3 Dec. Com. 59.

Omission followed by reorganization may constitute patentable novelty, but mere omission does not. George McRoy, 1 Dec. Com. 58.

Where redeemable tickets have been used, a plan to redeem a portion only is not patentable. W. W. Bierce, 11 O. G. 1108.

The mere duplication of another's patent is not invention, and can not be patented. G. C. Perkins, 2 O. G. 469; B. F. Peaslee, 2 O. G. 543; Charles Lawrence, 1 Dec. Com. 83; Eccleston & Coville, 2 Dec. Com. 51; Eaton, Hitchcock & Wells, 2 Dec. Com. 51; T. E. Jones, 2 Dec. Com. 87; John Ellerby, 2 Dec. Com. 100; F. M. Shepard, 2 Dec. Com. 104; Chambers *v.* Tucker, 11 O. G. 1009.

If a peculiar situation is discovered, not necessarily obvious before from its nature, in which to apply an old process to produce a useful result, it is patentable, being more than applying an old device to a new use. W. W. Leggett, 2 O. G. 199.

If a new and better result is accomplished by a change in the position of old elements, and in the formation of some of them, a patent will be issued. Eloi Bouscay, Jr. 9 O. G. 743.

If the change is not fundamental, but merely in the degree of the capacity for use, it is not patentable. Millers Falls Manuf. Co. 1 O. G. 47.

If a change produces a difference in degree only, and not a difference in substance, it is not patentable. B. J. Hobson, 1 O. G. 141.

If a change of form modifies the principle of operation, and produces a superior article of manufacture, it is patentable. Chas. P. Mixer, 1 O. G. 48.

A change of form which renders an instrument more useful is patentable. although the change is simple. Ira D. Warner, 1 Dec. Com. 41; Vosburgh & Ludden, Assignors, 1 Dec. Com. 80; King & Rowland, 2 Dec. Com. 136; J. H. McWilliams, 3 Dec. Com. 177; John & James Dobson, 4 O. G. 499; William Wachs, 8 O. G. 907.

Suggestions.

Where one communicates the details of an invention to a workman who has never heard of the principle before, he may be presumed to have originated it, if reduced to practice by the latter at his request. Wilcox *v.* Woodbury, 1 Dec. Com. 17; Foster & Townsend *v.* Fowle, 1 Dec. Com. 35; Spofford *v.* Moore, 2 Dec. Com. 6; Hale *v.* Field, 2 Dec. Com. 12; T. Hall *v.* T. S. Hall, 2 Dec. Com. 25; Duckworth *v.* Crompton, 2 Dec. Com. 43; Hopkins *v.* Hardick, 2 Dec. Com. 141; Spencer & Saylor *v.* Trafford, 3 Dec. Com. 119; Russell & Scow, 5 O. G. 149; Gilbert et al. 5 O. G. 428; Chase *v.* Witter, 9 O. G. 593.

Where one of two who are claiming an invention communicates his ideas to the other who embodies them, there may be good ground for holding the

man who makes the suggestions to be the inventor. Riley *v.* Baumann, 3 Dec. Com. 101; Hamilton *v.* Foster, 1 Dec. Com. 30; Bates *v.* Marsh, 3 Dec. Com. 253.

An inventor may adopt minor improvements in his invention, which are suggested by another, and the latter does not thereby acquire any interest in the invention. Yost *v.* Heston, 3 Dec. Com. 226.

An operative having first constructed and put into actual use an apparatus embodying the invention is the prior inventor as against the employer, he being skilled in the art while his employer was not, and the evidence being contradictory on other points. Edwards *v.* Requa, 1 Dec. Com. 28; Johnston *v* Pimlott, 2 Dec. Com. 44; Mallett *v.* Crosby, 2 Dec. Com. 56; Coburn *v.* Smith, 3 Dec. Com. 290; Walter De Sano *v.* C. F. Ritchel, 9 O. G. 792.

If one suggests an idea in a general way, and the other falls in with it, and by his aid develops it and gives it practical embodiment, the two may be considered joint inventors. Chase & White *v.* Chase, 4 O. G. 4.

No presumption arises against a workman that an improvement which he makes belongs to his employer, when he is employed to make a specified article, not to labor generally nor to embody an invention of his employer. Holman *v.* Foley, 2 Dec. Com. 97.

When the presumption of a joint invention has been created by the filing of a joint application for a patent, it can be overthrown only by evidence of the most unequivocal character. Wheeler *v.* Russell, 1 O. G. 183.

In a joint invention, the result of mutual suggestions, counsel, and effort, all the parties are entitled to share, and the invention will not be divided. Shaw *v.* Keith et al. 9 O. G. 641; Joseph Barsaloux, 9 O. G. 883.

Novelty.

It is not enough that an article of manufacture is new, in the ordinary sense, to render it patentable, but it must possess novelty, as the word is understood in the statute, and give evidence of inventive genius. Charles A. Moore, 3 Dec. Com. 249; Horace Beach, 3 O. G. 607; William L. Smith, 4 O. G. 349; Judd M. Cobb, 5 O. G. 751; John W. Orr, 6 O. G. 77; Crouch *v.* Roemer, 11 O. G. 1112.

Where the invention differs substantially, and not merely colorably, from some prior patent, there is patentable merit. Springer *v.* Stanton, 2 O. G. 2; B. P. Corban, 2 O. G. 30; Rowley *v.* Mason, 1 Dec. Com. 4; Geo. Schneider, 1 Dec. Com. 24; Charles Robinson, 1 Dec. Com. 44; P. J. Dwyer, 1 Dec. Com. 57; M. H. Collins, 1 Dec. Com. 82; B. F. Woodside, 2 Dec. Com. 1; George F. Pinkham, 2 Dec. Com. 34; L. F. Follansbee, 2 Dec. Com. 127; J. B. Slawson, 2 Dec. Com. 177; J. A. & T. Wood, 3 Dec. Com. 56; James Duthie, 3 Dec. Com. 85; Case & Baillie, 3 Dec. Com. 307; Thomas Slaight, 4 O. G. 82; James D. Culp, 5 O. G. 427; Joseph B. Sprague, 6 O. G. 469.

A machine designed to accomplish a certain object is not anticipated by one accomplishing the same object only occasionally, and without its having been extended. Geo. H. Brown, 1 Dec. Com. 10.

Where the improvement is not shown in the references, and is not of so obvious a character that it would have been suggested by any of the prior contrivances, a patent may issue. Charles Moseley, 2 Dec. Com. 53; G. C. Stillman, 3 Dec. Com. 173; Arnold *v.* Wilcox, 7 O. G. 558; J. S. McIntire, 9 O. G. 300; C. H. Davis, 9 O. G. 537.

The first inventor is he who makes the article, not he who finds a use for it. Cheesebrough *v.* Toppan, 1 O. G. 464.

If an applicant avails himself of a portion of a plan used to make one article, and supplies everything necessary to constitute a complete and novel process for making another article, a patent should be granted. Louis McMurray, 8 O. G. 473.

If a device secures different results by different means from those employed by prior inventors, it is patentable. J. C. White, 1 O. G. 163.

If the two machines are different in operation and construction, the later is patentable. B. P. Corbin, 2 O. G. 30.

If the application of the article be new and useful, it can not be said to be anticipated by the prior use of any other, which lacks the quality that gives it utility, no matter how striking the resemblance. Geo. E. Deering, 1 Dec. Com. 26; A. C. Platt, 1 Dec. Com. 42; Hopson & Brooks, 3 Dec. Com. 153; R. C. Phillips, 3 Dec. Com. 273; W. W. Goodwin, 3 O. G. 347.

A patentable difference exists between two processes, when by one a solution could only be forced into a body, and by the other through it. Ransome *v.* Norris, 2 O. G. 295.

An incomplete and practically inoperative device is not sufficient ground for rejecting the product of an operative one, though the two devices may be alike in some respects. J. L. Mason, 2 O. G. 644.

An invention will be considered novel, although counterparts of it are referred to of an earlier date than the application, if they do not antedate a previous application to which it relates back. J. R. McClintock, 3 Dec. Com. 325.

Where neither of the references upon which an application is rejected is so analagous to the invention presented as to suggest it, the application will be allowed. A. G. Lesner, 3 Dec. Com. 204; Charles A. Moore, 3 Dec. Com. 249; Geo. W. Hawes, 3 Dec. Com. 255; David H. Morrison, 3 Dec. Com. 327; Henry Reynolds, 6 O. G. 295.

An invention can not be presumed to have been made before the filing of the application, when it was founded on theory alone, and had not been practiced. Reed *v.* Roberts, 1 Dec. Com. 88; De La Mar *v.* Gurens & Behrens, 1 Dec. Com. 94.

If an inventor has devised new means to accomplish a certain result, it is not enough to refer him to devices wherein it is evident that a like intention exists. Willard Twitchell, 6 O. G. 506.

A party can not claim what was discovered by a prior inventor, although his improvement has made the article commercially valuable. Sargent *v.* Burge, 11 O. G. 1055.

If two inventors are on equal terms in respect to the invention, and both contribute to its essential parts, the patent would be invalid if issued to one of them. Carter et al. *v.* Perry et al. 8 O. G. 518.

A joint invention can not be carried back to a date earlier than that at which the subject-matter was first discussed by the parties. Dwyer & Carter *v.* Dick & Perry, 10 O. G. 585.

In whatever field of art a new and useful invention appears, a patent for it, duly applied for, can not lawfully be refused. William Ward, 4 O. G. 350.

The mere fact of the first inventor having lost his right to a patent does not entitle a junior inventor to step forward and obtain one. Collins *v.* England et al. 1 Dec. Com. 66.

If the invention, covered by a given claim, be novel, the combination of the elements of said claim, with other devices, is allowable in another claim, if legitimate. M. Smith, 2 O. G. 117; Minar, Stevens et al. 2 Dec. Com. 47.

The oath of the applicant is sufficient to avoid an objection on account of the granting of an English patent to him and another jointly. C. W. Siemens, 11 O. G. 1107.

Reducing to Practice.

Priority of conception, coupled with due diligence in reducing to practice, constitutes priority of invention. Wheeler *v.* Russell, 1 O. G. 183.

The merits of an improvement belong to the one who first conceived and

gave practical form and effect to it. Walter De Sano *v.* C. F. Ritchel, 9 O. G. 792.

As between two independent inventors, he who first perfects the invention is entitled to the patent, and it can not avail the other to refer back to crude experiments. Browne *v.* Ludlow, 2 Dec. Com. 16; Duchemin *v.* Richardson & Stein, 2 Dec. Com. 31; Bingham *v.* Watkins, 2 Dec. Com. 42; Crowell *v.* Sim, 2 Dec. Com. 72; Richardson *v.* Denza, 2 Dec. Com. 156; Knight *v.* Annan, 3 Dec. Com. 34; Davis, Edson et. al. 4 O. G. 500; Stanton & Perley, 4 O. G. 500; Clark & Osborn, 5 O. G. 667; Macdonald *v.* Chase, 6 O. G. 359; Rees *v.* Richards et al. 7 O. G. 36.

The first of two competitors who reduces the invention to practice is entitled to the patent, although another may have first conceived it. Hoeltge *v.* Hoeller, 3 Dec. Com. 309; Jones *v.* Pendleton & Boardman, 3 Dec. Com. 314; Smith *v.* Barter, 7 O. G. 1; Ware *v.* Bullock, 7 O. G. 39; Arnold *v.* Wilcox, 7 O. G. 558; Oliver *v.* Zeller, 10 O. G. 416.

If an applicant for a patent was the first to clearly originate the invention, and diligent in reducing it to practice, he will be considered the prior inventor, as against a patentee. Withington *v.* Locke, 11 O. G. 417.

The party who originates a device and puts it into general use, is the prior inventor, although his competitor had previously made successful experiments, but had abandoned them. Merrill & Carlton *v.* Atwood, 1 Dec. Com. 6; Chipman *v.* Fales, 1 Dec. Com. 44; Coles *v.* Loud, 2 Dec. Com. 4; Lamson *v.* Wardwell, 2 Dec. Com. 33; Dimond *v.* Hayden, 2 Dec. Com. 34; Bovey *v.* Graham, 2 Dec. Com. 129; Frevert *v.* Gahr, 3 O. G. 660; Lagowitz *v.* Topham, 9 O. G. 742; Gross *v.* Sargent, 11 O. G. 788.

He who first reduces an invention to a practical form, is entitled to the patent, though another conceived it before him, and explained it to others. Lyon *v.* Altmaeir, 1 Dec. Com. 15; Jennings *v.* Winter, 1 Dec. Com. 38.

If the one who first conceives a device exercises reasonable diligence in reducing it to practice, he will be considered the prior inventor, although another has succeeded before him in perfecting it and reducing it to practice. William S. Carr, 5 O. G. 30; Proctor & Lindsay *v.* Ackroyd, 6 O. G. 603; Freeborne *v.* Foye, 9 O. G. 884.

The one who first conceives the invention, and completes a model that operates perfectly before his competitor, and carries it to the greatest degree of perfection, is entitled to priority. Withington & West *v.* Whitney, 3 Dec. Com. 310; Smith *v.* Edson, 7 O. G. 827; Baldwin *v.* Bigelow, 7 O. G. 1011.

If a patentee is first to conceive an invention, first to make a model, the first to apply for a patent, and the first to obtain the grant, he is not required to have put his invention to practical use before obtaining a patent. Busha *v.* Phelps, 9 O. G. 1010.

The one who first reduces an invention to a practical form by embodying it in a machine in use, is entitled to a patent, unless a prior inventor is at the time using due diligence in adapting and perfecting the same invention. Crane *v.* Whitehead & Atherton, 7 O. G. 219.

Where an invention is voluntarily laid aside, without anything being done in the way of an application for a patent, and another, in the mean time, without any knowledge of this fact, invents and reduces the same thing to practice, after applying for and taking out a patent, he must be regarded as the original and first inventor. Edson *v.* Coffin, 1 Dec. Com. 58; Reed *v.* Roberts, 1 Dec. Com. 88; Erbe *v.* Hill, 1 Dec. Com. 29; Wheeler *v.* Chenoweth, 1 Dec. Com. 43; Doty *v.* Osborne, 1 Dec. Com. 77; McClure *v.* Miller & Mason, 2 Dec. Com. 122; Wheeler *v.* Peters, 2 Dec. Com. 141; Gray *v.* Hale, 3 Dec. Com. 129; Willcox *v.* Duncan, 3 Dec. Com. 195; Hanvey *v.* Willard, 3 Dec. Com. 297; Hoeltge *v.* Hoeller, 3 Dec. Com. 309; Pattee *v.* Russell, 3 O. G. 181; Vinton *v.* Pierce, 3 O. G. 629; Hyatt & French, 4 O. G. 609; Bradford *v.* Corbin, 6 O. G. 223; Hart *v.* Little, 7 O. G. 962; Lay *v.* Wiard, 9 O. G. 349; Gross *v.* Sargent, 11 O. G. 787.

It is only in those cases in which actual use is necessarily demanded to establish the date of the completion of an invention that it becomes important in determining the question of priority. Little *v.* Stephenson, 3 O. G. 379.

If an inventor has used due diligence throughout, he may date his invention back to the time when he made the drawings for the foreign machine, and will be awarded priority over one who invented afterward. Lay *v.* Ballard, 3 O. G. 687.

A drawing alone is not sufficient to show that the inventor reduced his invention to practice. Millward *v.* Barnes, 11 O. G. 1060.

To prove priority of invention, it is not enough to show that the applicant was engaged upon one of the same character, without proof of its identity. Black *v.* Locke, 1 Dec. Com. 13.

If the invention is simple and single, the one who first discovers it can not be superseded as inventor without proof of laches or abandonment, there being nothing left of its construction for experiment to develop. Smith, Jordan & Coffin, 5 O. G. 89.

The inventor of an apparatus who has reduced it to actual practice and then left it, can not claim improvements upon it, although he may have contemplated them, if he never reduced them to form. Trotter *v.* Bartlett, 7 O. G. 3.

The question of priority will be decided in favor of the party who, before the other made the invention, had produced specimens shown to be like exhibits on file and embodying it. Clark *v.* Fletcher, 1 Dec. Com. 21; Logan *v.* Holdiman, 2 Dec. Com. 45.

The one who first reduces the invention to practice is entitled to the patent if his competitor rests his claim in suggestions, verbal descriptions and lost sketches, though they were made before. John W. Cochran, 1 Dec. Com. 30; Edson *v.* Coffin, 1 Dec. Com. 58; Wood *v.* Crowell, 1 Dec. Com. 107; Hart *v.* Little, 7 O. G. 962; Dana *v.* Greenleaf & Adams, 9 O. G. 198.

An experimental use of an invention, though continued for three days, and though it worked satisfactorily, is not a reduction of it to practice, if no further use was made of the invention, and it was afterwards lost. Stoddard and Perry, 6 O. G. 33.

An imperfect and incomplete invention resting in mere theory, or in uncertain experiments, and not actually reduced to practice, and embodied in some machinery, is not patentable. Lay *v.* Wiard, 9 O. G. 349.

Reduction to practice can only be effected by the material embodiment of the invention in the form in which it is designed for use. Stephenson *v.* Goodell, 9 O. G. 1195.

If an adaptation to use, or even use itself, is merely experimental, the invention is not perfected. Lagowitz *v.* Topham, 9 O. G. 742.

In order to defeat a patent, an alleged prior machine must be shown to be practically, and not merely experimentally useful. Sargent *v.* Burge, 11 O. G. 1055.

If the principle of an invention is shown to be practicable in a machine, it is entitled to protection, though the machine is rude and imperfect. Knight *v.* Annan, 3 Dec. Com. 34.

The true date of invention is at the point where the work of the inventor ceases and the work of the mechanic begins. Cameron *v.* Brick, 3 Dec. Com. 89.

An invention which consists of a combination of elements is not complete until all the elements are combined. Samuel C. Moore, 7 O. G. 697.

A person may prove priority of invention by establishing that he was the first to conceive the idea of the invention, and the mode of putting it into practice, and used due diligence in adapting and perfecting it. Chapman *v.* Candee, 2 O. G. 245; Reisinger *v.* Clark, 2 O. G. 339; Mayhew *v.* Wardwell, 1

Dec. Com. 5; Mowbray *v.* Shaffner, 2 Dec. Com. 35; Eames *v.* Gill, 2 Dec. Com. 42; Leonard *v.* Runyon, 2 Dec. Com. 56; Kissam *v.* Collins, 2 Dec. Com. 127; Jenkins & Norton *v.* Putman, 2 Dec. Com. 156; Edison *v.* Foote & Randall, 3 Dec. Com. 80; Corsett & Lowe *v.* White, 3 Dec. Com. 154; Disston *v.* Emerson, 3 Dec. Com. 162; Ives *v.* Swan, 3 Dec. Com. 167; Smith *v.* Hopkins, 3 O. G. 347; Rice *v.* Winchester, 3 O. G. 348; Hollingsworth *v.* Burleigh, 3 O. G. 583; Perley and Orr, 5 O. G. 457; Hammond *v.* Laird, 7 O. G. 170; McBride *v.* Henderson, 7 O. G. 300.

The party who first makes a model and applies for a patent with due diligence is the first inventor, although another made the first machine, for the law rewards the first inventor rather than the first maker. Morse *v.* Clark, 1 O. G. 274.

Diligence.

As between applicants, the question of reasonable diligence only arises where one conceives the idea of the invention first, and the other is first to perfect and reduce it to practice. Allen *v.* Gilman, 2 O. G. 293; Erbe *v.* Hill, 1 Dec. Com. 29; Hunt *v.* Woods, 1 Dec. Com. 34; Freeland & Ward *v.* Trent, 1 Dec. Com. 93; Duchemin *v.* Richardson & Stein, 2 Dec. Com. 31; Bradley *v.* Rafael, 2 Dec. Com. 50; Hosea Ball, 2 Dec. Com. 97.

Where one is the first to conceive an invention, and the other was the first to reduce it to practice, the claim of the latter is founded upon the reduction to practice, and derives no aid from his previous efforts; but the former must show that he was reasonably diligent from the time of the conception of the invention to its completion. His diligence is not to be compared with that of his competitor, but must stand as an independent fact. Millward *v.* Barnes, 11 O. G. 1060.

An inventor, in order to preserve his rights, is not required to devote all his energies to the development of his invention, to the exclusion of all other matters. The law only demands reasonable diligence. Munger *v.* Connell, 1 O. G. 491.

The party who first made the invention should prevail if he never intended to abandon it, though he did not apply for a patent until his opponent had applied several years afterward. Rowley *v.* Mason, 1 Dec. Com. 4.

An inventor is not prejudiced in his right to a patent by any delay between the making of his invention and the filing of his application, unless meanwhile the invention has gone into public use. Israel Townsend, 3 Dec. Com. 60.

To constitute complete invention it must be shown that the device has been used, or that reasonable diligence has been employed in applying it to this last and surest test. Hanscom *v.* Latham, 9 O. G. 1157; Palm *v.* Behel, 10 O. G. 701; Stephenson *v.* Goodell, 9 O. G. 1195.

A prior inventor has lost his right to an invention if he has delayed applying for a patent for an unreasonable time after his competitor obtained one, although he had a caveat pending when the application of the latter was filed. Kenyon *v.* Wesson, 3 Dec. Com. 10; S. C. 3 Dec. Com. 91.

An inventor has not forfeited his invention by delay, who has obtained a patent for it before his competitor applied for one. Bingham *v.* Watkins, 2 Dec. Com. 42, 186.

If a party has forfeited his right to a patent by want of diligence, he is not the prior inventor, and cannot, therefore, have abandoned his invention to the public. Jenkins *v.* Barney & Berry, 3 O. G. 119.

Although others have applied for a patent to which that sought by the applicant would be subordinate, that furnishes no excuse for his neglecting to make his application for several years. Wright *v.* Clay & Ely, 2 Dec. Com. 11.

If an inventor has fully worked out the idea, and shows that he intends to pursue it to a practical use, he is entitled to a reasonable time to perfect and test. Tingley & Carpenter, 3 Dec. Com. 236.

Mere delay in applying for a patent after the invention has been perfected, will not warrant a judgment of priority in favor of a subsequent inventor. Traut *v.* Hawley, 10 O. G. 979.

If nothing is shown in the evidence to account for an inventor's delay in reducing his invention to practice, he must be held chargeable with want of diligence. Hovey & Hufeland, 6 O. G. 31.

If an inventor employs an attorney to file his application for a patent, and is deceived by false representations that it was done, the delay thus fraudulently caused is not unreasonable or such as to work abandonment. Case *v.* Hastings, 7 O. G. 557.

If an inventor, after perfecting his invention, keeps it secret, and withholds it from public use, until another invents the same thing and applies for a patent therefor, he loses his right to a patent. Monce *v.* Adams, 1 O. G. 1.

If the delay consists merely in forbearing to apply for a patent, the first inventor is entitled to a patent, although he files the application after the application of a subsequent inventor. Freund *v.* King, 11 O. G. 2.

Utility.

Any invention, however simple, saving time and labor, and not before anticipated, may be awarded a patent. Geo. Richardson, 2 O. G. 3; Samuel Toomey, 1 Dec. Com. 109; John R. Harrington, 2 Dec. Com. 37; William Brown, 1 Dec. Com. 45; W. E. Phelps, 2 Dec. Com. 48; A. S. Collins, 2 Dec. Com. 57; Arthur Harris, 2 Dec. Com. 62; Rutger B. Miller, 3 Dec. Com. 85; L. E. Love, 3 Dec. Com. 276; Orison Underwood, 4 O. G. 449.

The utility of an article of manufacture is tested by the advantage gained in its use, and the saving effected in its production. W. Butterfield, 2 O. G. 88.

Cheapness alone will not confer patentability upon a machine that possesses no other merit. McLaren & Coventry, 10 O. G. 335.

If the simpler means consist in the substitution of one mechanical equivalent for another, the difference is not patentable. Eloi Bouscay, Jr. 9 O. G. 743.

What is Patentable.

A party who has devised a mode of doing a particular thing so as to dispense with an instrument formerly used, is entitled to a patent for that mode, but not for every mode of doing it without the use of the instrument. J. Arkell, 1 O. G. 28.

A patent will not be allowed for a process which is really intended for the adulteration of an article of food. Morris & Watson, 2 Dec. Com. 71; Peter W. Weida, 6 O. G. 681.

A claim for a result or effect, and not for the result as produced is bad. N. J. Simonds, 2 Dec. Com. 23.

A functional claim is one that has for its subject the performance of an act merely, and not the means by which that act is executed. Ignatius Hahn, 8 O. G. 597.

An improved system of irrigation, constituting an improvement in the art, may be the subject of a patent. James Y. Carmichael, 10 O. G. 864.

The products of a new process can not be monopolized unless they can be distinguished from the products of other processes. Henry Loewenberg, 1 Dec. Com. 92.

The term manufacture seems to distinguish the thing made from the process or machine by which it is made. Charles H. Ackerson, 1 Dec. Com.

74; William R. Blanchard, 2 Dec. Com. 59; L. E. Truesdell, 2 Dec. Com. 123.

An applicant can not describe a machine which will perform a certain function, and then claim the function itself and all other machines that may be invented for the same purpose. G. L. Harrison, Jr. 10 O. G. 373.

An article of manufacture is patentable only when it is a complete device, ready for use or for sale in the market. Peter Campbell, 2 O. G. 644; Samuel B. Jerome, 3 O. G. 64; Augustus Adams, 3 O. G. 150.

The product of an invention must be regarded as an entirety, and, if new, applicant is entitled to all the characteristics which it may now be known or may hereafter be discovered to possess. Herbert W. C. Tweddle, 10 O. G. 747.

A single device may contain subject-matter for a design patent, and one for a structure patent, that for one being a particular ornamentation, that for the other the structure of the device, involving its mechanical uses. H. W. Collender, 2 O. G. 360.

The process by which an article is constructed is a matter altogether distinct from the article itself, so far as its patentability is concerned. Geo. H. Sellers, 2 O. G. 246; W. E. Bond, 1 Dec. Com. 17; Robert A. Cheesebrough, 1 Dec. Com. 18.

An article of peculiar shape, intended to serve a useful purpose, may be the subject of a patent. T. D. Doolittle, 2 O. G. 275.

Combinations.

A patentable combination must consist of something more than mere assemblages or arrangement of parts. The parts must act upon each other either mediately or intermediately, so that the action or character of one is affected, influenced or produced by the action or character of the other. Chas. Van Waggenen, 1 O. G. 89; John Burnham, 1 O. G. 164; Lewis Miller, 1 O. G. 431; Phillip E. Ackert, 1 O. G. 253; L. B. Prindle, 1 O. G. 404; Daniel J. La Duc, 1 O. G. 549; Thomas Kerr, 1 Dec. Com. 16; Jones & Boyce, 1 Dec. Com. 16; Joseph Thorne, 1 Dec. Com. 76; John Stephenson, 5 O. G. 363; Clymer & Riley, 6 O. G. 505.

The mere assembling of an aggregation of old devices, each separately performing its own function, into immediate proximity with each other, does not make a combination in a patentable sense. George B. Clarke, 3 Dec. Com. 178; McCormick & Baker, 3 Dec. Com. 246; John H. Coes, 6 O. G. 1; Henry Hooper, 6 O. G. 360; Patrick Fitzgibbons, 10 O. G. 375.

Separate devices or combinations of devices, that have no community of operation in effecting a common result, should not be incorporated in the same application. C. O. Sobinski, 10 O. G. 3; A. L. Bogart, 10 O. G. 113; C. F. Dietrich, 11 O. G. 195.

If the aggregation of the different parts produces a new result, this is decisive of the fact that there has been invention, and that the combination is patentable. J. B. Slawson, 1 O. G. 254.

In order that a combination may be rendered patentable, there must be a novel assemblage of parts exhibiting invention. Lynch *v.* Dryden, 3 O. G. 407; B. S. Baker, 4 O. G. 156.

If the substitution of one material for another, in a combination, produces a new and useful article of manufacture, it is patentable. W. S. Cottrell, 1 O. G. 436.

A combination should be regarded as an entirety, and it can not be said that some of its features have been used to perform their separate functions in other positions and arrangements. Jesse Reynolds, 9 O. G. 744.

Where neither of several parts of a structure affects or influences the action

of the other, no legitimate combination exists between them. Thomas J. Flagg, 2 Dec. Com. 104; Benjamin Morse, 3 O. G. 467.

A claim will be refused although the combinations specified embrace a device for which a claim has already been allowed, if the latter ought to have been rejected. Amos Rank, 3 Dec. Com. 235.

It is necessary that a combination should contain all the essential elements to secure some distinct and definable result in the operation of a machine. A. A. Rheutan, 5 O. G. 521; George M. Holmes, 6 O. G. 360.

If a new combination produces an old effect more economically, or a new, or a better effect, and all the elements co-operate in producing it, the combination is patentable. David Eynon, 3 Dec. Com. 239; E. Sampson, 3 Dec. Com. 277; Henry Hooper, 6 O. G. 360; Seeley M. Sherman, 7 O. G. 1054.

It is not every change in the arrangement of the elements of a combination which may form the foundation of a legitimate claim, but only such as are necessary to constitute a valid combination of the same parts. Streeter *v.* Stoddard, 2 Dec. Com. 91.

If devices are in their operation especially adapted to each other, belonging to the same class of inventions, and are used in connection to subserve a common end, they constitute a legitimate combination. Warren Noyes, 8 O. G. 818.

If the combination is new and produces new and useful results, the application for a patent can not be refused. Maurice Fitzgibbons, 3 Dec. Com. 77; Fisk, Clark & Flagg, 3 Dec. Com. 172; James P. Hilliard, 3 Dec. Com. 179; J. M. Stone, 4 O. G. 54; T. N. Foster, 4 O. G. 377; George N. Palmer, 6 O. G. 506; Jas. S. Ray, 7 O. G. 40.

If a new ingredient is added to an existing composition of matter, and it is thereby materially changed in form and quality, it is patentable. James & William Horlick, 7 O. G. 828.

A mere transfer of a combination of elements to a new structure, where it operates in the same way to produce the same result, is not patentable. Jacob Dunton et al. 10 O. G. 243.

The new grouping of devices must be accompanied by evidence of invention, and must produce a new result. Horace Holt, 5 O. G. 148; George W. Morse, 6 O. G. 763; John C. Richards, 9 O. G. 1062.

Where the elements of the combination are old, but the combination itself is new, and all the parts of it co-act to produce the result, there is patentable merit. S. C. Forsaith, 1 Dec. Com. 111; T. N. Foster, 4 O. G. 377; John H. Coes, 6 O. G. 1; Hosea Ball, 2 Dec. Com. 110.

A novel arrangement of well-known parts which are specially adapted to co-operate in producing an improved result, shows invention, and is patentable. Jno. Farrel, 2 O. G. 340; Julius King, 2 O. G. 618.

A device, which is already patented, does not thereby render a combination embracing it patentable, if it is not improved, and performs no unexpected function. C. Rubens & Co. 2 Dec. Com. 49; George Petry, 2 Dec. Com. 105.

If an applicant does not present a combination essentially different from a prior one, a patent will be refused. George Crompton, 4 O. G. 82.

A compound consisting of old ingredients arranged in a new manner, and possessing superior qualities, is patentable. Heide & Wirtz, 8 O. G. 817.

An assemblage of distinctive individual parts, which is less than a combination of them, falls short of invention. Benjamin S. Castle, 4 O. G. 179.

Abandonment.

Abandonment can only be established by positive proof, and not by mere presumption or inference. Russell & Scow, 5 O. G. 149; Stephen Hull, 9 O. G. 1; Cushman *v.* Parham, 9 O. G. 1108.

The law permits such use of an invention before applying for a patent as will fully demonstrate whether it is or not useful and practical. Channing & Farmer, 3 Dec. Com. 114; Baldwin *v.* Bigelow, 7 O. G. 1011.

It is not necessary that the use should have been a continuing use, extending over more than two years prior to the application, to render a patent void; it is sufficient if it be a public use or sale. Young *v.* Hoard, 2 Dec. Com. 59; Charles W. Jenkins, 4 O. G. 351.

If an inventor, by express acts, has raised a strong presumption that he intended to abandon his invention, in order to revive his right he must file a new application. Timothy Gordon, 6 O. G. 543.

If a model is destroyed, and the inventor perfects other devices for producing the same results, it affords strong presumptive evidence of an abandonment of the invention shown in such model. Barnes *v.* Clinton, 9 O. G. 1158.

Parties acting as principal and agent in the sale of an article more than two years before filing their application, are equally prevented from obtaining a patent, without regard to which may be the actual inventor. Keller et al. *v.* Felder, 10 O. G. 944.

A public use of an invention must always be distinguished from a merely experimental one, and any use which can reasonably be regarded as experimental should be so held. Charles W. Jenkins, 4 O. G. 351.

The mere fact that a patent was granted to another more than two years before the application of the real inventor, is not fatal to his claim. Page *v.* Bowers, 1 O. G. 521.

The abandonment of an invention by sale for more than two years prior to the filing of an application is not established by inferences in the absence of clear proof as to dates. Massey *v.* Sawyer, 8 O. G. 557.

An invention which has been completed and in use seven years before the original application was filed, but not claimed in the patent sought to be reissued, and which has been embodied meanwhile in other patents, has been abandoned. Doty *v.* Osborne & Ballard, 1 Dec. Com. 77.

Abandonment will not arise from mere lapse of time, and will not be presumed where the invention is not in public use, and the applicant is the first inventor. Woerd *v.* Bacon, 1 Dec. Com. 16; Gillet *v.* Gillis, 1 Dec. Com. 68.

Description.

A published description of an invention is sufficient, notwithstanding the testimony of experts that a mechanic could not construct the instrument from it. Taylor & Banks, 2 O. G. 519.

A pattern book, without any descriptive matter contained in it, can not be regarded as a printed publication, such as is contemplated as being a bar to the issue of a patent. T. B. Atterbury, 9 O. G. 640.

An invention can not be held to antedate patents granted before the application, on the ground that it was described in a still earlier application, if it was there described as connected with an essential device which is now omitted. James R. McClintock, 2 Dec. Com. 64.

A rejected application will not be considered a bar to a new application for a patent for the same invention by another party. Rouse & Stoddard, 7 O. G. 169; Brown *v.* Guild, 6 O. G. 392; Crane *v.* Whitehead & Atherton, 7 O. G. 219; S. B. Sexton, 9 O. G. 251.

A subsequent inventor can not be allowed to patent a device clearly shown in any part of the application for a prior patent. Edward Strain, 2 Dec. Com. 150; Thos. J. Magruder, 3 Dec. Com. 104; E. Wheeler, 4 O. G. 3.

A description in a reissued patent is sufficient, although the matter was improperly introduced on the reissue. George Richardson, 7 O. G. 1053.

SEC. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented, or caused to be patented, in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

Statute Revised—July 8, 1870, ch. 270, § 25, 16 Stat. 201.
Prior Statutes—July 4, 1836, ch. 357, § 8, 5 Stat. 120.—March 3, 1839, ch. 88, § 6, 5 Stat. 354.

The provisions of this section relate to patents which are applied for here after the issue of a foreign patent. French *v.* Rogers, 1 Fish. 133; American Leather Co. *v.* American Tool Co. 4 Fish. 284.

A patent is not void because it runs for a period of seventeen years instead of seventeen years from the date of the foreign patent. O'Reilly *v.* Morse, 15 How. 62; *contra*, Smith *v.* Ely, 5 McLean, 76; S. C. 15 How. 137.

The American patent will expire at the same time with the foreign patent, but can not exceed the term of seventeen years. Weston *v.* White, 13 Blatch. 364; S. C. 9 O. G. 1196.

The provisions of this section evidently refer to the fact that the invention has been patented by the inventor himself. Kendrick *v.* Emmons, 9 O. G. 201.

If a person surreptitiously, without the knowledge or authority of the inventor, takes out letters patent in a foreign country, he can not thereby deprive the inventor of any of his rights. Kendrick *v.* Emmon, 9 O. G. 201.

The mere fact that a patent has been issued does not of itself prove the introduction into common use without the necessity of other testimony. Weston *v.* White, 13 Blatch. 364; S. C. 9 O. G. 1196.

The date upon which the completed specifications were filed and patent sealed will be considered the date of a foreign patent. Chambers et al. *v.* Duncan et al. 9 O. G. 741; Chambers et al. *v.* Duncan et al. 10 O. G. 787; James Cochrane, 1 Dec. Com. 60; Edward Maynard, 1 Dec. Com. 54.

Where an applicant seeks letters patent for an invention already patented abroad, his American patent, if issued, will be limited to seventeen years from the date of the grant of the foreign patent. Herman *v.* Gilmore, 1 Dec. Com. 23; Eades *v.* Jewsbury, 1 Dec. Com. 90.

If an application is not made here within six months after the invention was patented abroad, the term of the patent should be the usual time from the date of the foreign patent. James Cochrane, 1 Dec. Com. 60.

An American patent is not limited in its duration by the life of a foreign

patent for the same invention; it may be issued after the foreign patent has expired, if the term to which the patentee is entitled has not expired. Eades Jewsbury, 1 Dec. Com. 90; Robert Mushet, 2 Dec. Com. 106.

If a patent is made up of separate and distinct inventions, each of which is the subject of a foreign patent, and the foreign patent for one part either expires or is forfeited for non-payment of a tax thereon, the patentee may either obtain a reissue or file a disclaimer, and thus abandon the claim to such part. I. L. Pulvermacher, 10 O. G. 2.

Where an applicant seeks letters patent for an invention already patented by him abroad, and there is a single well-authenticated instance of a use in public, it constitutes a legal "public" use, and the application will be refused. Hermann *v.* Gilmore, 1 Dec. Com. 23.

The American patent need not be confined to the precise matter covered by the foreign patent. C. W. Siemens, 11 O. G. 969.

If new features are added to those of the foreign patent, and in combination therewith, a limitation of the grant can not be made, but in such case specific mention should be made of the part patented abroad by particular reference to the date and number of the foreign patent, if the matter is separately claimed. C. W. Siemens, 11 O. G. 979.

If the application includes the same subject-matter as the foreign patent, with immaterial variations, the patent should be limited to expire at the same time with the foreign patent. C. W. Siemens, 11 O. G. 969.

In all practicable cases, the limitation should appear on the face of the patent. C. W. Siemens, 11 O. G. 979.

If the proper restriction in the grant can be accomplished by a division of an application, such division should be required. C. W. Siemens, 11 O. G. 979.

Upon the allowance of a patent, the examiner should enter on the file wrapper the fact that a foreign patent has been granted and the date of the same, or, if more than one, the date of the earliest to expire. C. W. Siemens, 11 O. G. 979.

A reissue should state the date and number of the foreign patent the same as an original patent. C. W. Siemens, 11 O. G. 1107.

SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the commissioner of patents, and shall file in the patent office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination

which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

Statute Revised—July 8, 1870, ch. 230, § 26, 16 Stat. 201.
Prior Statutes—April 10, 1790, ch. 7, § 2, 1 Stat. 110.—February, 21, 1793, ch. 11, § 1, 1 Stat. 318.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.

Character of Proceeding.

The authority of the commissioner to issue grants is not in the nature of jurisdiction in its common and technical acceptation. He issues the grant when he has evidence satisfactory to his own mind that the claimant is entitled to receive it. But that adjudges nothing as to the real right. That question is unaffected, and remains to be examined and decided between parties contesting it without prejudice or advantage from the letters patent. Wilder *v.* McCormick, 2 Blatch. 31; Potter *v.* Stevens, 2 Fish. 163.

All the proceedings in the patent office on the subject of patents are *ex parte*, except in the case of interfering applications. The department acts rather ministerially than judicially, and upon the representation of the applicant, without entering into an examination of the question of right. Morris *v.* Huntington, 1 Paine, 348; Potter *v.* Stevens, 2 Fish. 163.

The commissioner in issuing patents may be considered as a ministerial officer. If the prerequisites of the law are complied with, he can exercise no judgment on the question whether the patent shall be issued. Grant *v.* Raymond, 6 Pet. 218.

Clearness.

It is not necessary that an inventor shall reduce his invention to practical use before the patent is obtained. No such condition is required by the statute. It is enough that the inventor has perfected his invention, and is able to furnish to the patent office such specifications and model as the law requires. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

The requirements of this section are prerequisites to the granting of the patent, and unless the prerequisites are complied with, a party sued for the infringement of a patent may show that they have not been complied with, and in that way defeat the patent. The are conditions precedent to the right of the commissioner to grant the patent. Ransom *v.* New York, 1 Fish. 252; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Grant *v.* Raymond, 6 Pet. 218.

The specification has two objects: One is to make known the manner of constructing the machine, if the invention is of a machine, so as to enable artisans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. The other is to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. Evans *v.* Eaton, 7 Wheat.

356; s. c. 2 Wash. C. C. 443; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Mabie *v.* Haskell, 2 Cliff. 507; Conover *v.* Roach, 4 Fish. 12.

It makes no difference whether the effect is produced by mechanical principles, or by chemical agency, or by the application of discoveries in natural science, as in either case the requirement of the statute is imperative that the patentee must describe the method, process, or means he employs in full, clear, and exact terms, and the end which the invention accomplishes. Mitchell *v.* Tilghman, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299.

The specification must be perfect of itself, and can not be aided by reference to other matters. Head *v.* Stevens, 19 Wend. 411.

The law confers an exclusive patent right on the inventor of anything new and useful, as an encouragement and reward for his ingenuity, and for the expense and labor attending the invention. But this monopoly is granted for a limited term only, at the expiration of which the invention becomes the property of the public. Unless, therefore, such a specification were made as would at all events enable other persons of competent skill to construct similar machines, the advantages to the public which the statute contemplates would be defeated. It is not necessary, however, that the specification should contain an explanation level with the capacities of every person; but it should be expressed in such full, clear, and exact terms, that a person skilled in the art or science of which it is a branch, would be enabled to construct the patented invention. Lovell *v.* Lewis, 1 Mason, 182; Wintermute *v.* Redington, 1 Fish. 239; Brooks *v.* Jenkins, 3 McLean, 432; Page *v.* Ferry, 1 Fish. 298; Seymour *v* Osborne, 3 Fish. 555; s. c. 11 Wall. 516; Teese *v.* Phelps, 1 McA. 48; Westlake *v.* Cartter, 6 Fish. 519; s. c. 4 O. G. 636.

The skill and knowledge deemed competent is that which is addressed to the subject-matter, and is not the highest skill or the greatest knowledge, but that of practical workmen of ordinary skill in the particular business. Page *v.* Ferry, 1 Fish. 298; Smith *v.* O'Connor, 6 Fish. 469; s. c. 2 Saw. 461; 4 O. G. 633; Mabie *v.* Haskell, 2 Cliff. 507; Lippincott *v.* Kelly, 1 West. L. J. 513.

The description need not be so clear as to be understood by an individual wholly unskilled in the structure of machines. Brooks *v.* Bicknell, 3 McLean, 250; Many *v.* Sizer, 1 Fish. 17; Mowry *v.* Whitney, 3 Fish. 157; s. c. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; Forbes *v.* Barstow Stove Co. 2 Cliff. 379.

Unless on the mere description of the thing itself, its utility and the manner of its use are obvious, the patentee should always describe the manner of its employment to make it useful, so that a mechanic of proper skill can not only construct the thing itself, but can give it practical application to the purpose for which it is useful. Dennis *v.* Eddy, 4 Fish. 423.

In determining whether the specification is sufficiently full, clear and exact to enable any person skilled in the art to construct the machine, the jury are to look at the models and drawings as well as the specification, and also to the state of the art at the time of the invention. Singer *v.* Walmsley, 1 Fish. 558; Earle *v.* Sawyer, 4 Mason, 1; Hogg *v.* Emerson, 6 How. 437; s. c. 2 Blatch. 1; 11 How. 587; Burrall *v.* Jewett, 2 Paige, 134.

If, from the specification and the drawings taken together, any person skilled in the art could construct and use the device therein described without

invention of his own, which would attain the result claimed for it in the patent, then the patent is good, although there may be a mistake in describing the action of some part of the device, but which mistake could be easily discovered by the mechanic when he came to examine the same. Singer *v.* Walmsley, 1 Fish. 558.

A patentee has the right to assume that those who desire to understand all the conditions under which the invention can be operated, are acquainted with the preceding state of the art immediately connected with this particular subject. Tompkins *v.* Gage, 2 Fish. 577; S. C. 5 Blatch. 268.

An intelligent mechanic is chargeable with a knowledge of the state of the art in relation to the subject upon which he is called to exercise his skill. Treadwell *v.* Parrott, 3 Fish. 124; S. C. 5 Blatch. 369.

The specification need not describe that which is within the ordinary knowledge of any workman who may be employed to put up the apparatus or construct the machine. Such a workman, however, must have a competent knowledge of the work; that is, technically, be what the law calls an expert. Page *v.* Ferry, 1 Fish. 298; Monce *v.* Adams, 12 Blatch. 1; S. C. 7 O. G. 177; Mulford *v.* Pearce, 13 Blatch. 173; S. C. 9 O. G. 204; Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9.

The utmost precision in the description of a machine is not to be expected, nor is it essential. Parts of machinery and processes generally known, need not be described. A wedge, pulleys, rollers, rack and pinion, and other things known to all mechanics, will be supplied by the mechanic without stating their size or structure. Nor is it essential to state the proportionate parts of a machine, nor the velocity of its operation. These are matters of adjustment for the eye and judgment of the constructor. Whether a machine be large in its parts or small, its motion slow or quick, makes no difference in the principle of it. By a detailed description of things generally known, and not essential to the invention, the statement is rendered more prolix and less perspicuous. Brooks *v.* Jenkins, 3 McLean, 432.

Absolute precision as to details is not required in the specification. It is only intended as a guide, but it is not the sole instructor. The special skill of the mechanic, derived from familiarity with the art, may be applied in aid of the instruction given by the specification, and this skill may be exerted to modify any direction in the specification as to the matters of mere adjustment or adaptation of the invention to its intended use. Dorsey Co. *v.* Marsh, 30 Leg. Int. 169.

The definiteness of a specification must vary with the nature of its subject. Addressed, as it is, to those skilled in the art, it may leave something to their skill in applying the invention, but it must not mislead them. Mowry *v.* Whitney, 5 Fish. 513; S. C. 14 Wall. 620; 1 O. G. 499.

The statute must have a fair and reasonable construction. If the invention can be constructed by the exercise of skill and judgment on the part of a mechanic, the specification is sufficient. In carrying out any invention, the exercise of some skill and judgment on the part of the mechanic called to construct it, will always be required. Something must necessarily be left to him. If with the exercise of ordinary intelligence and skill, the invention can be constructed from the information given by the patent, the specification answers

the requisite of the statute. Judson *v.* Moore, 1 Fish. 544; S. C. 1 Bond, 285; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Mowry *v.* Whitney, 5 Fish. 513; S. C. 14 Wall. 620; 1 O. G. 499.

If a part is omitted which is so common and obvious as to suggest itself to any competent mechanic, this omission will not vitiate the patent. Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 4 O. G. 31; S. & B. Manuf. Co. *v.* Coke Co. 7 O. G. 829.

It is not essential that the inventor shall be sufficiently learned to thoroughly understand or accurately state the philosophy of a process which he has invented and reduced to practical use. Cahill *v.* Beckford, 1 Holmes, 48.

If eulogiums on the invention are fraudulently inserted to mislead, and operate to deceive others in regard to the actual construction of the thing claimed and the mode of applying it to use, they may render the patent void, but where the thing is correctly described, notwithstanding such exaggerations, they are immaterial. Aultman *v.* Holley, 6 Fish. 534; S. C. 11 Blatch. 304; 5 O. G. 3.

The patentee is not confined to technical words, but should rather employ those in popular use and better understood by all. The fewer technical terms are used the better, if the subject is intelligible without them. Hovey *v.* Stevens, 3 W. & M. 17.

The specification must be complete in its description of the invention. No defects can be obviated by extraneous evidence at the trial. Brooks *v.* Jenkins, 3 McLean, 432; Dixon *v.* Moyer, 4 Wash. C. C. 68.

Where a useful result is produced by the use of certain means for which the inventor or discoverer obtains a patent, the means described must be the essential and absolutely necessary means, and not mere adjuncts which may be used or abandoned at pleasure. Russell *v.* Dodge, 93 U. S. 460; S. C. 11 O. G. 151.

If the patentee has discovered much and discloses little, he patents no more than he claims. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, either by expanding into a general expression what was limited before in a particular form, or by tracing the line that leads back from consequences to remote causes, to infer the radical mystery of his invention, and then argue that he had described it by implication from the first, and so claim ownership of it in his patent. Detmold *v.* Reeves, 1 Fish. 127.

Against the practical demonstration of the sufficiency of the specification afforded by the actual construction of the machine, argumentative speculation, reinforced though it may be by the untested opinions of experts, will be of little avail. Dorsey Co. *v.* Marsh, 6 Fish. 387; S. C. 9 Phila. 395.

A reference to the specification as embodying the substantial form of the invention is proper, if it does not introduce confusion and uncertainty, and is often necessary for restraining the too great generality or enlarging the literal narrowness of the claim. Brown *v.* Guild, 23 Wall. 181; S. C. 6 O. G. 392; 7 O. G. 739.

A specification is not defective for want of certainty and clearness, if a fixed rule is given, although it declares that the rule may to some extent be safely departed from. Tilghman *v.* Work, 2 Fish. 229; S. C. 1 Bond, 511.

One patent can not derive any aid or support from a subsequent patent to the same inventor. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

A remote and extreme defect will not be seized hold of for the purpose of destroying an ingenious and useful invention. Blanchard's Factory *v.* Warner, 1 Blatch. 258.

Mode of Construction.

The inventor is bound so to describe his invention that the article can be made by one skilled in the art, and it is his duty to describe the best mode which he knows. Magic Ruffle Co. *v.* Douglass, 2 Fish. 330; Page *v.* Ferry, 1 Fish. 298.

It is not incumbent upon the patentee to suggest all the possible modes by which his design can be carried out. It is sufficient for him to state the modes which he contemplates to be best, and to add that other mere formal variations from these modes he does not deem to be unprotected by his patent. Carver *v.* Braintree Manuf. Co. 2 Story, 432; Dibble *v.* Augur, 7 Blatch. 86; Blanchard *v.* Eldridge, 2 Whart. Dig. 358.

If the inventor describes his invention so that a person skilled in the art can make it, and attempts *bona fide* to describe the best mode to make it, and fails, this does not avoid his patent. Magic Ruffle Co. *v.* Douglass, 2 Fish. 330.

The patentee need not specify the kind of power to be employed, or the method of applying it in working the machine. Carr *v.* Rice, 1 Fish. 198; Lippincott *v.* Kelly, 1 West. L. J. 513.

If no particular mechanical means are claimed for the mode of applying power in working the machine, the patentee is at liberty to use any known to mechanics skilled in machinery of that particular kind, and not requiring invention to prepare or apply it. Carr *v.* Rice, 1 Fish. 198; Waterbury Brass Co. *v.* Miller, 5 Fish. 48; S. C. 9 Blatch. 77.

It is not essential that the patentee should state of what material every part of the machine should be made. The principle is the same whether such part be composed of wood or metal. Brooks *v.* Bicknell, 3 McLean, 250.

A specification which extends to the material is ill-advised unless it adds, as is usual, that it claims the invention if made of any other material in the form described. Aiken *v.* Bemis, 3 W. & M 348.

In patents for machines, it is usual to say that the parts may be made of any suitable materials, and that means known materials. But even if it does not, a person who should afterwards discover a new material, would have no right to make the machine; and the inventor is protected against a machine when made of any such material, though the second inventor should have the exclusive right to the new material. In patents for machines, the patentee by such a phrase intends to point out that the arrangement or combination does not depend on the use of the precise material, where others may serve the purpose. Washing Machine Co. *v.* Lincoln, 4 Fish. 379.

If an invention is both new and useful, it can not be impeached because it does not accomplish all that a sanguine inventor has claimed for it. Eames *v.* Cook, 2 Fish. 146.

Claim.

The statute requires that the invention shall be particularly specified for the purpose of warning an innocent purchaser or other person using the machine of his infringement, and at the same time of taking from the inventor the means of practicing upon the credulity or fears of other persons, by pretending that his invention was different from its ostensible objects. Brooks *v.* Fisk, 15 How. 212; Merrill *v.* Yeomans, 11 O. G. 970; S. C. 1 Holmes, 231.

The magnitude and variety of interests involved in patents require accuracy, precision, and care in the preparation of all the papers on which the patent is founded. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. Merrill *v.* Yeomans, 1 Holmes, 331; S. C. 11 O. G. 970; 5 O. G. 267; Hovey *v.* Stevens, 3 W. & M. 17.

It is the duty of the inventor to describe each modification of his invention in the specification. Sargent *v.* Carter, 1 Fish. 277.

The specification must distinctly indicate the parts or features of a machine which are essential to the production of the proposed result. If they are not described, whether they relate to the construction or the mere adjustment of a machine, their use by others is not unlawful. Barry *v.* Gugenheim, 5 Fish. 452; S. C. 1 O. G. 382.

Where a patentee, in his specification, states and sums up the particulars of his invention, he is confined to such summary, and can not afterwards be permitted to sustain his patent by showing that some part which he claims in his summing up as his invention, though not his invention, is of slight value or importance in his patent. Moody *v.* Fiske, 2 Mason, 112.

In anomalous cases, as, for instance, when a new product has been discovered, and the process of compounding it or obtaining it is disclosed, the patentee, by stating his discovery and revealing his process, does all that he is required to do or can do. The careful separation of new from old, the limitation of claims to particular parts or combinations can not be required as a substantial part of the specification. If a specification sets forth a discovery, a new composition of matter, and the process for compounding it, that should be taken as the extent of his claim and the measure of his franchise. Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356.

The nature of the invention must be considered, to see whether its form and its substance are separable. If they are separable, then the inventor, unless he disclaims other forms, is deemed to claim every form in which his invention may be copied. Murphy *v.* Eastham, 5 Fish. 306; S. C. 1 Holmes. 113; 2 O. G. 61.

Composition.

A patent for a new composition of matter should state the component parts of the invention claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out by experiment. Tyler *v.* Boston, 7 Wall. 327; Jenkins *v.* Walker, 5 Fish. 347; S. C. 1 Holmes, 120; 1 O. G. 359.

If a general rule for the proportions in which the ingredients are to be used is given, it is sufficient. In most compositions of matter some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be, in some degree, superior or inferior to those most commonly used. Wood *v.* Underhill, 5 How. 1; Goodyear *v.* Wait, 3 Fish. 242; S. C. 5 Blatch. 468; Francis *v.* Mellor, 5 Fish. 153; S. C. 8 Phila. 157; 1 O. G. 48; 5 A. L. T. 237.

When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, and states the relative proportions vaguely or ambiguously, the patent is void. Jenkins *v.* Walker, 5 Fish. 347; S. C. 1 Holmes, 120; 1 O. G. 359.

If the invention can not be used with advantage in any case without first ascertaining by experiment the proportion of the ingredients to be employed, it is not patentable, because by the terms of the statute the inventor is not entitled to a patent unless his description is so full, clear, and exact as to enable any one skilled in the art to compound and use it. If from the nature and character of the ingredients to be used they are not susceptible of such exact description, the inventor is not entitled to a patent. Wood *v.* Underhill, 5 How. 1.

When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, it is the duty of the court to declare the patent to be void. The same rule prevails where it is apparent that the proportions are stated ambiguously and vaguely. In such cases it is evident on the face of the specification that no one can use the invention without first ascertaining by experiment the exact proportion of the different ingredients required to produce the result intended to be obtained. Wood *v.* Underhill, 5 How. 1.

If a man makes a new compound, he is not limited to the use of the same precise ingredients in making that compound. If the same purpose can be accomplished by him by the substitution in part of other ingredients in the composition, he may extend his patent so as to embrace them also. Ryan *v.* Goodwin, 3 Sum. 514.

If the patent merely suggests a substitute for one of the ingredients, it contemplates the same proportions of the two ingredients. Tyler *v.* Boston, 7 Wall. 327.

Improvements.

The patentee is bound to describe in full and exact terms in what his invention consists, and if it be an improvement only upon an existing machine, he should distinguish what is new and what is old in his specification, so that it may clearly appear for what the patent is granted. The reason of this principle of law will be manifest upon the slightest examination. A patent is grantable only for a new and useful invention, and unless it be distinctly stated in what that invention specifically consists, it is impossible to say whether it ought to be patented or not; and it is equally difficult to know whether the public infringe upon or violate the exclusive right secured by the patent. The patentee is clearly not entitled to include in his patent the exclusive use of any machine already known, and if he does, his patent will be broader than his

invention, and consequently void. If therefore the description in the patent mixes up the old and the new, and does not distinctly ascertain for which in particular the patent is claimed, it is void; since if it covers the whole, it covers too much, and if not intended to cover the whole, it is impossible for the court to say what in particular is covered as a new invention. Lowell *v.* Lewis, 1 Mason, 182; Langdon *v.* De Groot, 1 Paine, 203; Sullivan *v.* Redfield, 1 Paine, 441; Evans *v.* Hettick, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; Smith *v.* Downing, 1 Fish. 64; Allen *v.* Hunter, 6 McLean, 303; Wayne *v.* Holmes, 2 Fish. 20; s. c. 1 Bond, 27; Wintermute *v.* Redington, 1 Fish. 239; Evans *v.* Eaton, 7 Wheat. 356; s. c. 3 Wash. C. C. 443; Phillips *v.* Page, 24 How. 164; Seymour *v.* Osborne, 3 Fish. 555; s. c. 11 Wall. 516; Bray *v.* Hartshorn, 1 Cliff. 538; Blake *v.* Sperry, 2 N. Y. Leg. Obs. 251; Hovey *v.* Stevens, 1 W. & M. 290; Brown *v.* Lilly, 4 Fish. 363; s. c. 2 Biss. 457; Cross *v.* Huntley, 13 Wend. 385; Davis *v.* Bell, 8 N. H. 500; Head *v.* Stevens, 19 Wend. 411; Turner *v.* Johns, 2 Cranch C. C. 287; Brooks *v.* Jenkins, 3 McLean, 432; Barrett *v.* Hall, 1 Mason, 447; Dixon *v.* Moyer, 4 Wash. C. C. 68; McClure *v.* Jeffrey, 8 Ind. 79.

If a patent is for an improvement of a machine, the specification must state in what the improvement specifically consists, and it must be limited to such improvement. If therefore the terms are so obscure or doubtful that the court can not say what is the particular improvement which the patentee claims, and to what it is limited, the patent is void for ambiguity. Barrett *v.* Hall, 1 Mason, 447; Woodcock *v.* Parker, 1 Gallis. 438; Dixon *v.* Moyer, 4 Wash. C. C. 68.

There is no distinction between an improvement on a machine patented, and one not so. In both cases the improvement must be described, but with this difference that in the former case it may be sufficient to refer to the patent and the specification for a description of the original machine, and then to state in what the improvements on such original machine consist, whereas in the latter case it will be necessary to describe the original machine and also the improvement. Evans *v.* Eaton, 3 Wash. C. C. 443; s. c. 7 Wheat. 356; Isaacs *v.* Cooper, 4 Wash. C. C. 259.

The old instrument or thing on which the improvement is made need not be described where there is a reference to it in general terms, for this affords all the information which is necessary to a person skilled in that department. Many *v.* Jagger, 1 Blatch. 372; Davis *v.* Palmer, 2 Brock. 298; Winans *v.* N. Y. & Erie R. R. Co. 1 Fish. 213; s. c. 21 How. 88.

There is a class of cases to which these stringent rules do not apply, although the discovery is in the nature of an improvement on what is old. Where any new contrivances, combinations or arrangements are made use of in machinery, although the chief agents are well known, those contrivances, combinations or arrangements may constitute a new principle, and then the application or practice will necessarily be new also. In such a case the new and improved method of producing a useful result or effect is as much the subject of a patent as an entire new machine. Wintermute *v.* Redington, 1 Fish. 239.

When the invention consists of an improvement on an old machine, it may be taken for granted that a practical mechanic is acquainted with the con-

struction of the machine on which the improvement is made. Ives *v.* Hamilton, 92 U. S. R. 426; S. C. 6 Fish. 244; 1 O. G. 336.

In describing the improvement of a machine in use and well known, it is not necessary to state in detail the structure of the entire and improved machine. It is only necessary to describe the improvement by showing the parts of which it consists, and the effects which it produces. Such a description in reference to the machine improved is sufficient. Brooks *v.* Bicknell, 3 McLean, 250; Brooks *v.* Jenkins, 3 McLean, 432.

In the description of an improvement and the directions for constructing the improved machine, it is not necessary to state those matters which, it is apparent, would be proper or indispensable in its structure. Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond. 27.

There is nothing in the patent law which in terms requires the patentee to state what is new and what is old. If the patentee by his specification, including the summary claim at its close, points out and distinguishes what he claims as his own invention, it is all that is required. It implies that all the rest is old, or, if not old, that the applicant does not claim it so far as that patent is concerned. No particular form of words is necessary if the meaning is clear. This applies equally to patents for combinations and patents for improvements. Brown *v.* Guild, 23 Wall. 181; S. C. 6 O. G. 392; 7 O. G. 739.

If the specification contains a description of what is old and known, as well as what is new, what is claimed as new must be distinguished. In specifying an improvement in a machine, however, it may be necessary and, when so, it is proper to describe the whole machine as it operates with the improvement, in order to make the description understood by a person of the trade to which it belongs, and if the patentee fails to do this, his patent fails for obscurity. The simple purpose of the law in requiring the patentee to distinguish new from old is that it may distinctly appear what his invention is. Wintermute *v.* Redington, 1 Fish. 239.

It is difficult to define the exact cases when the whole machine may be deemed a new invention, and when only an improvement of an old machine. The cases often approach very near to each other. Where a specific machine already exists producing certain effects, if a mere addition is made to such machine to produce the same effect in a better manner, a patent can not be taken for the whole machine, but only for the improvement. In like manner if to an old machine some new combination be added to produce new effects, the right to a patent is limited to the new combination. On the other hand, if well-known effects are produced by machinery in all its combinations entirely new, a patent may be claimed for the whole machine. So if the principles of the machine are new, either to produce a new or old effect, the inventor may well entitle himself to the exclusive right of the whole machine. Whittemore *v.* Cutter, 1 Gallis. 478; Odiorne *v.* Winkley, 2 Gallis. 51.

The patentee need not describe particularly and disclaim all the old parts, and the more especially is this unnecessary when such disclaimer is manifestly in substance the result of his claiming as new only the portions which he does describe specially. Hogg *v.* Emerson, 6 How. 437; S. C. 2 Blatch. 1; Evans *v.* Eaton, 7 Wheat. 356; S. C. 3 Wash. C. C. 443.

Every mechanical part, principle or combination which is mentioned in the

specification, but which is not included in the invention as claimed and limited, must by necessary implication be considered as admitted to be old or in use before, and the patent is not invalid because it has not in express words particularly stated them to be old. Winans *v.* N. Y. & Erie R. R. Co. 1 Fish. 213; S. C. 21 How. 88.

For the purpose of enabling artisans to construct the machine, it may be necessary for the inventor of an improvement to state so much of the old machine as will make his specification of the structure intelligible. Evans *v.* Eaton, 7 Wheat. 356; S. C. 3 Wash. C. C. 443.

A description of the original machine is only necessary when there is no other way in which it can be ascertained with reasonable certainty in what the improvement consists and how it is to be applied. If the patent is for an improvement in a machine already in use and well known to those skilled in the art, there is no need to describe it. Harmon *v.* Bird, 22 Wend. 113.

If the patentee particularly describes and specifies what he claims as new and as his invention, the patent is not void because in the description of the whole machine, including the element that he says is his invention, he includes elements which are old, but which he claims to be newly combined with new elements. Rheem *v.* Holliday, 16 Penn. 547: Holliday *v.* Rheem, 18 Penn. 465.

Combination.

A combination is sufficiently described if the ingredients of which it is composed are named, their mode of operation given, and the new and useful result to be accomplished pointed out so that those skilled in the art and the public may know the extent and nature of the claim, and what the parts are which co-operate to produce the described new and useful result. Seymour *v.* Osborne, 3 Fish. 555, 11 Wall. 516.

If the description of a combination clearly indicates the method of its use and its relation to the other mechanical elements operating with it, a claim for a combination of part of them is good, although it may not embrace some that are essential to the operative efficiency of the combination. A combination to be valid must have the attribute of practical utility; but this is not to be determined by a reference to the abstract practicability of the elements claimed to compose it. Resort must be had to the whole specification, and if it is therein properly described, its relations to co-operative mechanism indicated and explained, and the method of its use in connection therewith directed, it is a good combination, and will support a restricted claim for it if it is practically operative. Parham *v.* Sewing Machine Co. 4 Fish. 468; Furbush *v.* Cook, 2 Fish. 668.

It is not requisite to include in the claim for a combination as elements thereof all parts of the machine which are necessary to its action, save as they may be understood as entering into the mode of combining and arranging the elements of the combination. Furbush *v.* Cook, 2 Fish. 668.

Defects that render Patent Void.

If anything material in respect to the construction or working of the machine is omitted in the specification, the patentee loses all claim to the exclusive use of his discovery. Carr *v.* Rice, 1 Fish. 198.

If the actual invention is not a material and substantial part of the thing patented, and definitely distinguishable from the other parts claimed, the patent is void. Hotchkiss *v.* Oliver, 5 Denio, 314.

If the allegations and suggestions of the petition are not substantially recited in the patent, the patent will be void. Evans *v.* Chambers, 2 Wash. 125.

If the specification is not in such full, clear, and exact terms as to enable any one skilled in the art to construct the invention therein described without experiments of his own, then the patent is void. Singer *v.* Walmsley, 1 Fish. 558; Hovey *v.* Stevens, 3 W. & M. 17; Gray *v.* James, Pet. C. C. 394; Judson *v.* Moore, 1 Fish. 544; S. C. 1 Bond, 285; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Winans *v.* Schen. & Troy R. R. Co. 2 Blatch. 279; Grant *v.* Raymond, 6 Pet. 218; *contra*, Whittemore *v.* Cutter, 1 Gallis. 429.

A claim broader than the actual invention of the patentee is, for that very reason, upon the principles of common law, utterly void, and the patent is a nullity. Wyeth *v.* Stone, 1 Story, 273; Parker *v.* Stiles, 5 McLean, 44; Tyler *v.* Devel, 1 Am. L. J. 248; Barrett *v.* Hall, 1 Mason, 447; Moody *v.* Fisk, 2 Mason, 112; Hovey *v.* Stevens, 3 W. & M. 17; Parker *v.* Sears, 1 Fish. 93. *Vide* Whitney *v.* Emmett, Bald. 303; Gray *v.* James, Pet. C. C. 394; Park *v.* Little, 3 Wash. C. C. 196; Lowell *v.* Lewis, 1 Mason, 182; Whittemore *v.* Cutter, 1 Gallis. 429.

A claim in the alternative is void for uncertainty, for nothing is claimed absolutely. Carr *v.* Rice, 1 Fish. 325; S. C. 4 Blatch. 200.

An alternative claim is invalid only in those cases where it claims positively neither of several subjects, but is good if all of many which are mentioned are claimed as one or the other is employed by an infringer. If it is said that A. or B. is claimed, this asserts a right to neither; but to claim the one or the other as they are used with an assertion that it has been discovered that both are interchangeably available for specified purposes, is not an alternative claim. Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 4 O. G. 31.

If the patent is for the whole of a machine, and the discovery is only for an improvement, the patent is void. Evans *v.* Eaton, Pet. C. C. 322; S. C. 3 Wheat. 454; 7 Wheat. 356; Whittemore *v.* Cutter, 1 Gallis. 478; Odiorne *v.* Winkley, 2 Gallis. 51; Winans *v.* N. Y. & Erie R. R. Co. 1 Fish. 213; S. C. 21 How. 88; Aiken *v.* Dolan, 3 Fish. 197; Holliday *v.* Rheem, 16 Penn. 465; Darst *v.* Brockway, 11 Ohio, 462; *contra*, Goodyear *v.* Matthews, 1 Paine, 300.

Unless the vagueness or ambiguity is very clear and unmistakable, the patent will not be declared void on that ground. Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115.

A specification void in part is void *in toto*. Head *v.* Stevens, 19 Wend. 411.

Specification.

The public has a right to know the exact limitations of a patentee's monopoly, and for that reason the law requires distinct, exact, and sharply defined claims. John M. Cornell, 1 O. G. 573; T. C. Hopper, 2 O. G. 4; Perry & Law, 1 Dec. Com. 3; J. C. Cooke, 3 Dec. Com. 312; Fairbanks &

Robinson, 3 O. G. 65; Fredereick W. Dahne, 7 O. G. 1095; J. C. Gould, 10 O. G. 203; Charles E. Williams, 10 O. G. 748.

Ambiguous phrases should not be employed in granting letters patent, to make a claim good which, without them, would be bad and unpatentable. C. Rubens & Co. 1 Dec. Com. 107; H. Waterman, 1 Dec. Com. 70; James Arkell, 3 Dec. Com. 263; J. C. Gould, 10 O. G. 203.

Ambiguous words in a claim, such as "substantially as and for the purpose set forth," used as a limiting clause, are insufficient, unless so placed as to be specially significant. John Sperry, 2 O. G. 387; The Collins Co. 2 O. G. 617; Orrin Rice, 5 O. G. 522.

The words, "or equivalent devices, as described," may be used in a claim. W. R. Walton, 10 O. G. 165.

Whenever the words "equivalent" or "equivalents" occur in a claim, in such a connection as to have an equivocal signification, their use in that connection must be inhibited. Daniel F. Haasz, 4 O. G. 610.

Every new device described in an application should be patented under it, or under a division of it. Lewis J. Atwood, 1 Dec. Com. 98; James R. Hyde, 3 Dec. Com. 109.

A specification should be descriptive, and not discuss the merits or demerits of other patents or inventions. Wm. L. Williams, 1 O. G. 225.

Parts which may be rendered unnecessary by a ready substitute need not be explicitly cited in a combination claim. O. E. McMurray, 8 O. G. 943.

The interpretation of the language of a patent must have regard to the objects of the invention, and harmonize therewith. The signification of terms at the date of a patent must govern, and not those acquired afterwards. McDougal *v.* Eames & Seely, 2 O. G. 86.

Claims which recite definitely the article invented, and contain in addition matter descriptive of the functions of certain parts, are not objectionable. J. J. Gray, 11 O. G. 229.

Ambiguous claims should not be allowed on the ground that the courts would sustain them, if they can do so only upon a forced construction. Joseph Thorne, 1 Dec. Com. 76.

So much of the drawings and specification as repeats the description of the patented machine should be stricken out before the case can be examined on its merits. D. M. Smith, 2 Dec. Com. 69.

Applicants must confine their specifications to the matter sought to be claimed by their patent. D. M. Smith, 3 Dec. Com. 84.

Specific reference to devices by letter in a claim is a restriction upon the devices described in the specification. C. W. Marsh, 2 O. G. 197.

The description of an old improvement, even though not claimed, should be eliminated from the specification. James A. Woodbury, 1 Dec. Com. 86.

A reference to a caveat concerns the history, and not the description, of an invention, and should not be cited in a specification in an application for a patent. Thomas J. Chubb, 2 O. G. 519.

It is not required that all the elements entering into the construction of a device be mentioned, unless its novelty demands it; but only such as will constitute it an operative whole need be named. James Farrow, 2 O. G. 57.

The parts of a combination must be specified only up to that point beyond which the presence of the parts not named will be presumed from the known state of the art or the necessities of the case. Moses G. Wilder, 3 Dec. Com. 125; H. J. Kent, 3 Dec. Com. 301.

Where a part of a combination is capable of useful operation by itself, the inventor may embrace a claim for the combination and for such part in one patent. James D. Sturges, 1 O. G. 204.

Where a combination has no function, except in connection with some element not mentioned, the latter is inferentially included, and its introduction into the claim produces no real change. William F. West, 2 O. G. 30.

The introduction of dead elements into a claim of several combinations does not change the nature of it; but were a new element is introduced, modifying the operation of the former combination, the claim is not identical with the first. William F. West, 2 O. G. 30.

A claim for a combination which is distinguishable from others only by a single element should specify it. Charles Rubens & Co., Assignees, 1 Dec. Com. 107; Henry Waterman, 2 Dec. Com. 70.

Where the scope of the invention extends only to the specific devices presented, a broad claim will be refused. Joseph L. Pennock, 2 O. G. 590.

A feature essential to the operation of a device should be included in the claim therefor. Farnsworth *v.* Andrews, 9 O. G. 195.

Every claim should be so drawn as to plainly indicate the nature of the invention sought to be covered by it. Thomas J. Mayall, 4 O. G. 210.

Nothing should be embraced in a claim which has not been previously set forth. Owen Dorsey, 2 Dec. Com. 17; J. W. Wattles, 3 O. G. 291.

Division.

Under no circumstances can the same inventor become entitled to receive from the government more than one patent for the same invention and covering the same ground. John C. Duckworth, 2 Dec. Com. 151; C. B. Cottrell, 9 O. G. 495; Luther O. Crocker, 1 Dec. Com. 6.

A claim for a machine, and a claim for the product of the machine, will not be allowed in the same application. Murray & Wuterich, 3 O. G. 659.

It is not the design of the patent law to grant a separate patent to every possible application of a process. W. H. Howell, 9 O. G. 921.

If one has invented a process or a machine, by which he turns out a new and improved manufacture, he is entitled to a patent for the article as well as the process or machine. George Lupton, 5 O. G. 489.

A patent will not be granted for a product to one who already has one for the process which describes it. McCracken *v.* Russel, 1 Dec. Com. 35.

A patent will not be granted to the same person for an apparatus, and also for the principle upon which it operates. William Lowe, 2 Dec. Com. 39.

If an article is not necessarily the result of the action of a machine, the applications for patents for the article and machine should be separate. 11 O. G. 110.

Where an apparatus is used in a process to produce a new article, the applicant may claim the apparatus, the process and the article, in one patent. A. D. Elbers, 12 O. G. 2.

An inventor can not be allowed to go back and obtain a second patent for the same invention upon the earlier form of the application. James R. Hyde, 3 Dec. Com. 109.

If two or more distinct inventions are united in one application, that are capable of division, and which belong to different classes, or involve a double labor of examination, or have no community of operation, the commissioner should require the application to be divided. Linus Yale, Jr., 1 Dec. Com. 110; E. R. Sumner, 3 Dec. Com. 180; Abel Combs, 3 Dec. Com. 209; Henry M. Stow, 3 O. G. 322; John F. Shepard, 3 O. G. 522; Lones, Vernon & Holden, 4 O. G. 582; Henry Birun, 5 O. G. 521; Wm. Tucker, 6 O. G. 470; John Gillies, 10 O. G. 415; Sol Kuh, 10 O. G. 587; A. D. Elbers, 12 O. G. 2.

Where the improvements have nothing to do with the combination, but are of general application, the applicant is entitled to no more favor than if he attempted to patent improvements upon two independent machines under one grant. Leopold Lehmann, 2 Dec. Com. 70; J. T. Cree, 2 Dec. Com. 78.

If devices constitute necessary elements in the production of the result they need not be the subjects of separate applications. Jesse Jopling, 8 O. G. 1032; Clinton & Knowlton, 9 O. G. 249.

In requiring the division of an application, the nature and extent of the division should be clearly indicated. Kernard Knott, 8 O. G. 238.

The requirement of a division of an application presupposes that matter exists which might constitute the subjects of two or more patents. Richard Pintsch, 11 O. G. 597.

If one ingredient of the composition is omitted in one of the claims, the composition is so changed as to become the subject of a separate application. G. & I. Loeser, 9 O. G. 837.

If joint inventors file an application for a patent for a design, and then subsequently conclude to divide the claim and apply for two patents, the second application for a part of the invention must be sworn to. Tieman, 11 O. G. 1.

One need not divide his application, and apply for a separate patent for each form which he shows by way of illustration in his specification. Barak T. Nichols, 4 O. G. 105.

An application for a patent need not be divided if all the elements of the apparatus are to be used conjointly for a definite and single purpose. Westenhaven & Adair, 5 O. G. 695.

Two distinct species can not be embraced in one patent, though belonging to one genus of inventions. Robert N. Eagle, 2 Dec. Com. 137.

It is admissible, under proper restrictions, for parties to put their claims in different forms to prevent misconstruction. Perry & Law, 1 Dec. Com. 3; Evans W. Shippen, 8 O. G. 727.

Every claim in an application, in order to be valid, must, in one sense, cover an independent invention, yet all the claims must pertain to one common device or subject of invention. Robert M. Franklin, 4 O. G. 105.

Two claims in an application should be more clearly distinguished than by omitting from one of them a feature specified in the other, and which is usual and indispensable to those that are mentioned. George Richardson, 3 Dec. Com. 303.

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

Statute Revised—July 8, 1870, ch. 230, § 27, 16 Stat. 201.

Prior Statutes—Feb. 21, 1793, ch. 11, § 3, 1 Stat. 321.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.—March 3, 1837, ch. 45, § 6, 5 Stat. 193.

The requirement that the applicant shall furnish drawings, though directory in its terms, is not a condition, and it has obvious reference in point of time to the issuing of the patent, and not to the filing of the petition for it. French *v.* Rogers, 1 Fish. 133.

The drawing becomes a part of the patent, and may be referred to to help out the description. Hogg *v.* Emerson, 2 Blatch. 1; S. C. 6 How. 437.

The drawings are to be treated as part of the written specification, and

may be referred to to show the nature and character, and extent of the claim, as well as to compose a part of the description. Washburn *v.* Gould, 3 Story, 122.

It is not necessary, in order to make a patent valid, that the patentee should so make the drawings in his patent that they can be used as working drawings, or that a machine made in accordance with the exact scale of the drawings which accompany the patent in the patent office, should be an operative machine. All that is necessary, is that the patentee shall so describe his invention that a mechanic skilled in the art to which that invention relates, will be able, by the aid of the description and drawings of the patent, to embody that invention in a practical, operative, efficient and effectual form. American Leather Co. *v.* American Tool Co. 4 Fish. 284.

The express terms of the clause no more require that the written references shall be incorporated in the specification than that the drawings shall be. If the references required are written on the drawings, the terms of the statute are satisfied. Hogg *v.* Emerson, 2 Blatch. 1; S. C. 6 How. 437; 11 How. 587.

Unless references are necessary to an understanding of the invention, their omission cannot vitiate the patent. The description of the machine, accompanied by a drawing, may be in many cases understood without references. Brooks *v.* Bicknell, 3 McLean, 250; Washburn *v.* Gould, 3 Story, 122.

It is not necessary to use letters of reference to the drawing, in order to render a claim more definite. E. L. Parker, 3 Dec. Com. 293.

An applicant for a patent need not furnish a model and drawing of the whole of the machine which he claims to have improved, provided the machine is well known to the public, or a description of it readily accessible. Christopher C. Tracy, 8 O. G. 144.

An application will be refused where the combination claimed is not shown either in drawings or models. Rulof Dodge, 2 Dec. Com. 149.

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

Statute Revised—July 8, 1870, ch. 230, § 28, 16 Stat. 201.

Prior Statutes—Feb. 21, 1793, ch. 11, § 3, 1 Stat. 321.—July 4, 1836, ch. 357, § 6 5 Stat. 119.

If the specification for a composition clearly describes the composition and all the ingredients and proportions in language perfectly intelligible to those skilled in the art, the patent will not be invalidated by a failure to deposit in the patent office a sample of one of the ingredients. This requirement, like some others, is made obligatory before the granting of the patent. It is for the commissioner to decide before granting the patent, whether it has been complied with. If he does so decide and grants the patent, that can not be subsequently impeached by evidence tending to show want of compliance with

the law as to giving notice or paying fees or performing the other acts required to be done before the patent is granted, and the performance of which is to be proved to the satisfaction of the commissioner whose decision on these questions is final where he has jurisdiction. Tarr *v.* Folsom, 1 Holmes, 312; s. c. 5 O. G. 92.

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

Statute Revised—July 8, 1870, ch. 230, § 29, 16 Stat. 201.

Prior Statutes—April 10, 1790, ch. 7, § 2, 1 Stat. 110.—February 21, 1793, ch. 11, § 3, 1 Stat. 321.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.

A model will be required in every case when the nature of the invention admits of such illustration, except the applications upon designs. John Murdock, 6 O. G. 506.

SEC. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States, authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be.

Statute Revised—July 8, 1870, ch. 230, § 30, 16 Stat. 202.

Prior Statutes—February 21, 1793, ch. 11, § 3, 1 Stat. 321.—July 4, 1836, ch. 357, § 6, 5 Stat. 119.—August 29, 1842, ch. 263, § 4, 5 Stat. 544.

The taking of the oath that the patentee is the true inventor or discoverer of the art, machine, or improvement, is but a prerequisite to the granting of the patent, and in no degree essential to its validity. It is not a condition precedent without which the patent fails. Whittemore *v.* Cutter, 1 Gallis. 429; Crompton *v.* Belknap Mills, 3 Fish. 536; Dyer *v.* Rich, 42 Mass. 180; *contra*, Child *v.* Adams, 1 Fish. 189; s. c. 3 Wall. Jr. 20.

The mere presence of a blank form of the oath, with the jurat not signed by any magistrate, on file in the case in the Patent Office, can not overcome

the direct recital of the letters patent that the oath was taken. Crompton *v.* Belknap Mills, 3 Fish. 536.

The recital in the patent that the required oath was taken before the same was granted is, in the absence of fraud, conclusive evidence that the necessary oaths were so taken. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516.

The oath may be taken elsewhere than before the commissioner. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516.

There is no provision which requires that the jurat to the application shall be dated, and consequently the omission of the date of the day or month does not affect the validity of the patent. French *v.* Rogers, 1 Fish. 133.

The oath of an applicant is not a mere formal matter, but is required by act of Congress, because it goes to assure the novelty and utility of the invention. Eaton, Blodgett & Mills, 4 O. G. 525.

The objection that a specification was made out on papers signed and sworn to in blank, will be waived if a specification properly described and sworn to is substituted. De La Mar *v.* Gurens & Behrens, 1 Dec. Com. 94.

A new oath must accompany the divisional portion of an application the same as if it were an original application. James Heginbotham, 8 O. G. 237.

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

Statute Revised—July 8, 1870, ch. 230, § 31, 16 Stat. 202.

Prior Statutes—April 10, 1790, ch. 7, § 1, 1 Stat. 109.—July 4, 1836, ch. 357, § 7, 5 Stat. 119.

The commissioner is required to cause an examination to be made of the alleged invention or discovery, but he is not specifically told by what particular officers he is to have the examination made. Hull *v.* Commissioner, 7 O. G. 559; S. C. 8 O. G. 46.

The commissioner is not bound to issue the patent, although the examiners in chief decide in favor of the applicant; but he may examine the evidence, and withhold the patent. Hull *v.* Commissioner, 7 O. G. 559; S. C. 8 O. G. 46.

The issuing of all patents is at the control of the commissioner, and he may stop any one for good cause, although the examiners in chief have decided on appeal that it ought to issue. Stephen Hull, 1 Dec. Com. 68; Moody & Hudson, 1 Dec. Com. 108; Morris *v.* Watson, 2 Dec. Com. 71.

The commissioner will not arrest the issue of a patent allowed by the examiners in chief, except in cases in which it is beyond question that their judgment is erroneous or opposed to the general policy of the patent office. Disston *v.* Traut, 1 O. G. 305.

The commissioner can not ignore an objection to patentability whenever his attention is called to it by the examiner in chief or the primary examiner, although the objection may be made in an irregular manner. William S. Smoot, 11 O. G. 1010.

SEC. 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the commissioner of patents that such delay was unavoidable.

Statute Revised—July 8, 1870, ch. 230, § 32, 16 Stat. 202.
Prior Statute—March 2, 1861, ch. 88, § 12, 12 Stat. 248.

The statute does not interpose an absolute bar to the granting of a patent where the application has not been completed and prepared for examination within two years. The delay may be condoned by proof that it was unavoidable. The decision of the fact is committed to the commissioner. If it is shown to his satisfaction that the delay was unavoidable, the application is not to be regarded as abandoned. He is invested with power to grant the patent, and he may exercise it subject to the duty of determining that the preparation of the application for examination was not unnecessarily delayed after two years. The sufficiency of the evidence is for him. He is the only judge to be satisfied, and his judgment is conclusive. McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275.

If an applicant neglects to prosecute his application for two years after the office have rejected it, it will be held to be abandoned, unless it be shown that such delay was unavoidable. W. D. Leavitt, 3 O. G. 212; *vide* Weitling et al. *v.* Cabell et al. 2 O. G. 223.

This section comprehends the abandonment of applications only, which is a different thing from the abandonment of an invention to the public. William H. Golding, 8 O. G. 141.

If after an application is withdrawn, another is not filed in two years, it may reasonably be presumed that the applicant has no intention of renewing it. Hamilton *v.* Foster, 1 Dec. Com. 30; John W. Orr, 1 Dec. Com. 33; Edsall *v.* Coffin, 1 Dec. Com. 65; Benson *v.* Bennett, 2 Dec. Com. 26; Gates et al. *v.* Benson, 2 Dec. Com. 65; Wm. W. Williams, adm'r, 2 Dec. Com. 109; Hiram H. Marsh, 2 Dec. Com. 151.

If a second application is filed within two years of the date of the withdrawal, this renewal may be regarded as establishing a continuity of application, which makes it necessary that a public use, such as will operate as a bar to the grant of a patent, shall have taken place two years before the filing of the first application. S. Howes, 1 O. G. 227.

Delay in the prosecution of an application may be excused by satisfactory proof. Alfred Shol, 3 Dec. Com. 62; R. A. Stewart, 4 O. G. 665; S. C. 5 O. G. 1; Stephen Hull, 9 O. G. 1.

Delay in prosecuting an application is not excused because the applicant is too deeply engaged in other pursuits; nor by anything short of such embarrassments as unavoidably prevent him. Gray *v.* Hale, 3 Dec. Com. 129.

If no steps are taken towards prosecuting an application for two years after notice of the last action of the office upon it, except to enter a formal abandonment and request a return of the model, it must be considered abandoned. Frecham Graham, 3 O. G. 211; Lee & Smith, 5 O. G. 58.

The apparent date of a paper requesting further action may or may not be correct. It may be wholly deceptive and intended to mislead. The only date that can be regarded as entirely reliable is that of filing as indicated by the official stamp on the paper. Henry H. Blake, 3 O. G. 2.

A prior rejected or withdrawn application can not be held as a bar to the issue of a patent under a subsequent application. G. B. Sexton, 9 O. G. 251.

Neglecting to take any steps in prosecuting an application for a reissue for two years after the last action of the office upon it does not work an abandonment of it. N. H. Galusha, 3 O. G. 321.

SEC. 4895. Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the patent office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy.

Statute Revised—July 8, 1870, ch. 230, § 33, 16 Stat. 202.
Prior Statute—March 3, 1837, ch. 45, § 6, 5 Stat. 193.

A patent can not be granted to an assignee where the inventor himself would not be entitled to a patent. Tatham *v.* Loring, 5 N. Y. Leg. Obs. 207.

If assignments have been made, the commissioner of patents must be governed by the record in determining to whom a patent shall issue. Thomas A. Edison, 7 O. G. 423.

SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of ing for and obtaining the patent shall devolve on ecutor or administrator, in trust for the heirs at law

of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

Statute Revised—July 8, 1870, ch. 230, § 34, 16 Stat. 202.

Prior Statutes—April 17, 1800, ch. 25, § 2, 2 Stat. 38.—July 4, 1836, ch. 357, § 10, 5 Stat. 121.

A patent issued to an executor will be valid, although the trust is not expressed on the face thereof, for the law creates the trust. Stimpson *v.* Rogers, 4 Blatch. 333; Northwestern Co. *v.* Philadelphia, 6 O. G. 34; s. c. 31 Leg. Int. 148.

The import of this provision is that while the legal title to the invention is devolved upon the administrator, he must take and hold it subject to any equities existing as against the inventor in his lifetime. Where the inventor parted with the equitable title, the administrator holds it under exactly the same conditions, and subject to the same limitations of his interest in it Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; s. c. 31 Leg. Int. 148.

An administrator with relation to letters patent is substantially a trustee for the heirs of the inventor, but in order to act he must make proof of his representative character. Foreign letters of administration are not good evidence of it. Robert Ransome's Ex'rs, 2 Dec. Com. 143.

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

of renewed applications preferred under this section, abandonment shall be considered as a question of fact.

Statute Revised—July 8, 1870, ch. 230, § 35, 16 Stat. 202.

Prior Statutes—June 25, 1864, ch. 159, § 1, 13 Stat. 194—March 3, 1865, ch 112, § 1, 13 Stat. 533.

The decision of the commissioner in regard to abandonment upon a renewed application is not conclusive, and all the defenses which can be made to a patent granted upon an original application may be made to a patent granted upon a renewed application. U. S. Rifle Co. *v.* Whitney Arms Co. 11 O. G. 373; Marsh *v.* Commissioner, 5 Fish. 610; s. c. 3 Biss. 321; 2 O. G. 340.

If applicants file new applications, such as have been before filed by them and abandoned, the proper action is not to reject them on reference to the former application, but to refuse to consider them, because the right to file them did not exist. Andrew Mills, 7 O. G. 961; George Crompton, 9 O. G. 5; Alfred Shoe, 3 Dec. Com. 62; Robert McCully, 6 O. G. 153; Timothy Gordon, 6 O. G. 543; Davies *v.* Hartman, 9 O. G. 351.

The filing of a naked petition for the renewal of a rejected application does not of itself renew the case, but the petition must be accompanied by a demand for the action appropriate to the next stage of proceeding. P. Millspaugh, 2 Dec. Com. 112.

If an application is made for an article and a process, and the claim for the article is rejected, such claim can only be renewed by an application for a reissue of the patent for the process. James Arkell, 11 O. G. 1111; C. B. Cottrell, 9 O. G. 495.

SEC. 4898. Every patent, or any interest therein, shall be assignable in law by an instrument in writing; and the patentee, or his assigns or legal representatives, may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance, shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the patent office within three months from the date thereof.

Statute Revised—July 8, 1870, ch. 230, § 36, 16 Stat. 203.

Prior Statutes—February 21, 1793, ch. 11, § 4, 1 Stat. 322.—July 4, 1836, ch. 357, § 11, 5 Stat. 121.

Mode of Assigning.

The monopoly granted to the patentee is for one entire thing. It is the exclusive right of making, using, and vending to others to be used, the improvement he has invented, and for which the patent is granted. The monopoly did not exist at common law, and the rights therefore which may be exercised under it, can not be regulated by the rules of the common law. It

is created by the act of Congress, and no rights can be acquired in it unless authorized by statute, and in the manner the statute prescribes. Gaylor *v.* Wilder, 10 How. 477.

There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are an assignee, a grantee of an exclusive sectional right, and a licensee. An assignee is one who has had transferred to him in writing the whole interest of the original patent, or any undivided part of such whole interest, in every portion of the United States; and no one, unless he has had such an interest transferred to him, is an assignee. A grantee is one who has had transferred to him in writing the exclusive right under the patent to make and use, and to grant to others to make and use, the thing patented within and throughout some specified part or portion of the United States. Such right must be an exclusive sectional right, excluding the patentee therefrom. A licensee is one who has had transferred to him in writing or orally a less or different interest than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. Potter *v.* Holland, 1 Fish. 327; S. C. 4 Blatch. 206; Hill *v.* Whitcomb, 1 Holmes, 317; S. C. 5 O. G. 430; Gaylor *v.* Wilder, 10 How. 477; Blanchard *v.* Eldridge, 1 Wall. Jr. 337; Pitts *v.* Jameson, 15 Barb. 310; Bussey *v.* Putney, 38 N. H. 44.

As the grants of the crown were at common law construed with the greatest strictness, the privileges granted by a patent for a monopoly would probably not have been treated as capable of assignment, unless made so by the letter of the grant. Patents are now granted to the inventor, his executor, administrator, and assigns. They are, therefore, assignable as other personal chattels by force of the grant which creates them. Blanchard *v.* Eldridge, 1 Wall. Jr. 337.

A patent, privilege, or monopoly, could not be assigned at common law, except by deed, for the reason that, being a franchise and part of the royal prerogative, it could only subsist by grant. As a general rule, an assignment of an interest in a patent must be in writing, for the reason that such transactions are required to be recorded, and in fact and reality are not authorized to be made in any other way. Baldwin *v.* Sibley, 1 Cliff. 150; Jordan *v.* Dobson, 4 Fish. 232; S. C. 2 Abb. U. S. 398; 7 Phila. 533.

An assignment is a grant in writing of the whole or a part of the exclusive right vested in the patentee by the letters patent, and it makes no difference whether such part be designated as an undivided part of the whole patent, or as the grant of the exclusive right of the patentee within a particular district. Baldwin *v.* Sibley, 1 Cliff. 150; Farrington *v.* Gregory, 4 Fish. 221.

It was obviously not the intention of Congress to permit several monopolies to be made out of one and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement and would subject a party who, under a mistake as to his rights, used the invention without authority, to be harassed by a multiplicity of suits instead of one, and to successive recoveries of damages by different persons holding different portions of the patent right in the same place. Gayler *v.* Wilder, 10 How. 477; Suydam *v.* Day, 2 Blatch. 20.

Construction.

There is no magic in particular words, and they should be construed as they stand, and are used in the particular instrument, and in searching for the true interpretation, the courts will look to all the provisions of the instrument, and give such effect to it as its obvious object and design require. The words license and empower may be construed to mean grant, if that will effectuate the true intent and apparent object of the parties. Washburn *v.* Gould, 3 Story, 122.

Contracts are usually made with reference to the established law of the land, and should be so understood and construed unless otherwise clearly indicated by the terms of the agreement. Wilson *v.* Rousseau, 4 How. 646; S. C. 1 Blatch. 3.

The exclusive rights of a patentee are specially guarded from intrusion, but the contracts which he makes to share them with third persons are interpreted and enforced just as other legal engagements. Morse *v.* O'Reilly, 6 Penn. L. J. 501.

Reference may be made to the circumstances under which a contract was made, as affording the means of applying the language employed in the instrument to the subject-matter of the agreement. Read *v.* Bowman, 2 Wall. 591.

A reference to the specifications renders it allowable to examine those documents in connection with the assignment as means of ascertaining the true intent and meaning of the parties. Read *v.* Bowman, 2 Wall. 591.

General words in an agreement should be restrained by the particular occasion of using them. Troy Factory *v.* Corning, 14 How. 193; S. C. 1 Blatch. 467.

If an assignment recites the letters patent, giving their date and the name of the patentee, it is sufficient to pass the title to the invention patented, although the invention is misnamed. Harmon *v.* Bird, 22 Wend. 113.

If there is any doubt in the construction of an assignment, it should be resolved against the grantor, for he is chargeable with any obscurity in this respect. Smith *v.* Selden, 1 Blatch. 475; May *v.* Chaffee, 5 Fish. 160; S. C. 2 Dillon, 385.

Where there is doubt as to the proper construction of an instrument, a subsequent confirmatory instrument is entitled to great consideration; but where its meaning is clear in the eye of the law, the error of the parties can not control its effect. Railroad Co. *v.* Trimble, 10 Wall. 367.

The date of a deed may always be controlled by evidence of the actual delivery. If an agreement recites the deed and states that it was then made, this is conclusive that the deed was then made, and the date is immaterial. Dyer *v.* Rich, 42 Mass. 180.

The interpretation of a contract is to be determined by the sense in which the parties intended to use the terms employed to express it. Wetherill *v.* Zinc Co. 6 Fish. 50; S. C. 9 Phila. 385; 2 O. G. 471.

The sense in which the parties intended to use the terms employed in a contract, must be gathered from the instrument itself, irrespective of declarations written or oral by either party, as to his understanding of its meaning or

as to his motives in making it. Wetherill *v.* Zinc Co. 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

In aid of the interpretation of a contract, it is proper to consider facts cognate to the subject of the contract and within the knowledge of the parties to which it may therefore be presumed that the stipulations of the contract were intended to be applied, and by which their effect and meaning were to be governed. Wetherill *v.* Zinc Co. 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

Each case must be judged of as well by the terms of the grant of privilege as also by the situation of the parties or the circumstances under which they act. Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; s. c. 10 Blatch. 1.

An assignment of an interest in an invention secured by letters patent is a contract, and, like all other contracts, is to be construed so as to carry out the intention of the parties. Nicolson Co. *v.* Jenkins, 14 Wall. 452; s. c. 4 Fish. 201; 5 Fish. 491; 1 Abb. U. S. 567; 1 O. G. 465; 3 A. L. T. (U. S.) 177.

Where certain terms are used in a grant which have a well known general meaning, then in the interpretation of such grant such well known general meaning must be given to the terms used, unless it appears that some other or different meaning was intended by them. Goodyear *v.* Cary, 4 Blatch. 271.

No court is at liberty to add to the terms used any meaning beyond their ordinary import, unless there are some supplementary expressions to justify such a construction. Woodworth *v.* Sherman, 3 Story, 171.

It is not to be presumed that a grantor intends to grant more than he has a right to grant, or that a grantee intends to receive by way of grant that to which he has a full right without a grant. Goodyear *v.* Cary, 4 Blatch. 271.

Every part of a deed should be examined in order to ascertain whether the interpretation to be given to a particular clause is the true one. Goodyear *v.* Cary, 4 Blatch. 271: Baldwin *v.* Sibley, 1 Cliff. 150.

Courts of equity do not regard the forms of instruments, but look to the intent, and give to the acts of the parties the construction which that intent justifies and requires, so far as it can be done consistently with general principles. Hall *v.* Speer, 6 Pitts. L. J. 403; Perry *v.* Corning, 7 Blatch. 195.

A limitation to patents which the party holds in his own right, applies to patents of which he is the apparent but not real owner, but does not exclude patents of which his tenure is not exclusive. Wetherill *v.* Zinc Co. 6 Fish. 50; s. c. 9 Phila. 385; 2 O. G. 471.

If the grantee is unable to make the stipulated payments, and the transfer is treated as a nullity by both parties, it will not be regarded as in force. Railroad Co. *v.* Trimble, 10 Wall. 367.

If the payment of an annuity is not a condition to the vesting of an interest in the patent, an omission or refusal to pay will not give the patentee a right to rescind the contract, or have the effect to remit him to his interest in the patent as patentee. The right to the annuity rests in covenant. Hartshorn *v.* Day, 3 Fish. 32; s. c. 19 How. 211; Day *v.* Union Rubber Co. 20 How. 216; s. c. 3 Blatch. 488; Day *v.* Candee, 3 Fish. 9; Goodyear *v.* Union Rubber Co. 4 Blatch. 63; Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; s. c. 10 Blatch. 1.

If a party, in consideration of an assignment of a patent, agrees to give the patentee a certain percentage of the profits arising from the sale of the patented article, and of the right to manufacture it, this contains an implied contract that the business shall be carried on if profitable. Wilson *v.* Marlow, 66 Ill. 385.

A deed conveys a title, although it may have covenants in it which have not been performed. There are things which rest in grant, and things which rest in covenant. If the covenant fails by the *laches* of the grantor, the grant nevertheless stands. The covenant does not affect the grant; the grant passes the title and operates *in præsenti*. Day *v.* Stellman, 1 Fish. 487.

Assignment.

The consideration expressed in an assignment is not conclusive upon the parties. The assignee, in an action by the assignor for the price, may prove that the assignor for the amount named therein also agreed to give him the benefit of additional improvements, and had not done so. Wheeler *v.* Billings, 38 N. Y. 263.

If an instrument is in words and effect no more than an appointment of a party as the patentee's sole agent, in terms irrevocable, yet giving him only an interest by way of commissions in the proceeds of the sale of the articles manufactured and sold by him in the execution of his agency, the patentee may make an assignment of the same territory to another. Kempton *v.* Bray, 99 Mass. 350.

If an assignment containing a provision for its cancellation on six months' notice, provides that the assignor shall receive a certain sum for each year during the term of the agreement, from the premiums, and the assignee elects to cancel the assignment before the termination of a year, the assignor may recover a proportionate sum for the time that the assignee actually enjoyed the benefit of the contract. Gale *v.* Nourse, 81 Mass. 300.

A mere assignment under a State insolvent law does not pass the debtor's interest in a patent, for the statute contemplates a written instrument signed by the owner of the patent, and duly recorded in the patent office, as necessary to vest the legal title in the purchaser. Ashcroft *v.* Walworth, 5 Fish. 528; s. c. 1 Holmes, 152; 2 O. G. 546.

A judgment debtor may be compelled, on proceedings supplemental to an execution, to execute and deliver an assignment of his interest in a patent to a receiver. Clan Ranald *v.* Wyckoff, 41 N. Y. Supr. 527; Barnes *v.* Morgan, 6 T. & C. 105; s. c. 10 N. Y. Supr. 703.

The thing to be assigned is not the mere parchment on which the grant is written, but the monopoly which the grant confers, the right of property which it creates. Railroad Co. *v.* Trimble, 10 Wall. 367.

If an agent employed to sell a patent right secretly purchases it from the principal without disclosing the fact that he is a purchaser, and then sells parts thereof to others, he can not, upon being called upon to account for the profits, repurchase such parts and tender them to the principal. Jeffries *v.* Wiester, 2 Saw. 135.

An interest in the net proceeds of collections under a patent, does not nec-

cessarily amount to legal ownership of the patent itself. Jordan *v.* Dobson, 4 Fish. 232; s. c. 7 Phila. 533; 2 Abb. U. S. 398.

An assignment by a patentee in such general terms as are usual in speaking of the thing to which the patented part is attached, conveys the right to make and use the thing actually patented. Myers *v.* Turner, 17 Ill. 179; Hill *v.* Thuermer, 13 Ind. 351.

If an assignment is a grant upon a condition precedent, an offer on the part of the grantee to perform the condition does not give effect to the grant so as to vest the title in the grantee. Pitts et al. *v.* Hall, 3 Blatch. 201.

If the purchaser, in consideration of an assignment, agrees to pay a certain sum within a certain time, or reassign the interest so received, and fails to pay within the time, the patentee acquires the right to demand a reassignment, and if not reassigned he can recover the value. All that the purchaser is bound to do is to offer to reassign the interest. Manvel *v.* Holdredge, 45 N. Y. 151.

Limitations in respect to territorial limits, extent of use, and the like, may be, and in general are, provided by express terms or stipulations. Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; s. c. 10 Blatch. 1.

The assignment of an exclusive right to make and use, and to vend to others the patented machine within a certain territory, authorizes the assignee to vend the products of the machine elsewhere. The restriction in the assignment is to be construed as applying solely to the using of the machine. There is no restriction as to place of the sale of the product. Simpson *v.* Wilson, 4 How. 709.

A special grant of the right of vending, over and above that of making and using, in an assignment, is wholly unnecessary where the assignment contemplates the exclusive right within a certain district, so as to give the assignee the whole interest. The exclusive right of fabricating and using necessarily comprises the whole beneficial interest, and the right of parting with it, or any part of it, is incident to the right of property. The latter was specially secured by the statute *ex majori cautela* to obviate all difficulty on the subject. Bellas *v.* Hays, 5 S. & R. 427.

An assignee can not assign the entire right for a particular territory, and then sell single machines to be used in the same territory after the expiration of the patent. Union Paper Bag Co. *v.* Nixon, 9 O. G. 691; s. c. 3 Cent. L. J. 223.

A covenant that the covenantee shall enjoy the exclusive use of the patent within a certain territory, such use being limited to a certain number of machines, passes the entire interest of the patentee in the thing patented for the territory, and vests it in the covenantee. Ritter *v.* Serrell, 2 Blatch. 379.

This section refers to the grant of an exclusive right in a patent, and the term exclusive comprehends not only an exclusive right to the whole patent, but an exclusive right to the patent in a particular section of the country. A limitation of the number of the machines to be manufactured by the grantee, or a reservation of a right by the patentee to construct machines within the territory, does not destroy the exclusive character of a grant. Washburn *v.* Gould, 3 Story, 122.

The assignment of a patent does not carry with it a transfer of the right

to damages for an infringement committed before such assignment. Moore *v.* Marsh, 7 Wall. 515.

A claim for damages arising from an infringement may be assigned. The profits are not regarded in the light of unliquidated damages. The right to recover rests upon the principle that the party complained of has unlawfully appropriated to himself the benefits of an improvement or discovery which belongs to another, and that so far as he has made profit by such appropriation, he is liable to the party injured. This profit is ascertainable by evidence, and does not, like the claim for damages in an action for a tort, rest in the mere discretion of a court or jury. Jenkins *v.* Grunwald, 2 Fish. 37; S. C. 1 Bond, 126.

The right to the damages which accrued in the lifetime of the patent is a mere chose in action after the expiration of the patent, and not assignable. Bell *v.* McCullough, 1 Fish. 380; S. C. 1 Bond, 194.

Agent.

An agency is revocable, but an agency coupled with an interest is not revocable. Burdell *v.* Denig, 2 Fish. 588; S. C. 92 U. S. 716.

Where an assignment is executed by an agent, there must be proof of the agent's authority. Stone *v.* Palmer, 28 Mo. 539.

An agent can not execute an assignment under seal unless he has authority under seal. Bellas *v.* Hays, 5 S. & R. 427.

The execution of an assignment by affixing the name and seal of the agent, and not the name and seal of the principal, is not a good execution of the authority. Bellas *v.* Hays, 5 S. & R. 427.

No confirmation of an assignment defectively executed in the name of an agent, can make it the deed of the principal short of affixing the name and seal of the principal. Bellas *v.* Hays, 5 S. & R. 427.

Corporation.

A certificate of an interest in a patent, purporting to be signed by the secretary of a corporation to be subsequently organized, is not such an assignment as the statute requires. Hope Iron Works *v.* Holden, 58 Me. 146.

A contract will bind a corporation, although its officer uses his private seal instead of the corporate seal, if he was duly authorized to make it, or his act was subsequently ratified. Eureka Co. *v.* Bailey Co. 11 Wall. 488.

An assignment to an incorporated company not at the time organized, will inure to its use when organized, at least by way of estoppel, and be good against the grantor, whether it took effect on its delivery to pass any property or not. Dyer *v.* Rich, 42 Mass. 180.

Personal Representatives.

If the court which pronounced a judgment has jurisdiction over the subject-matter, a proper case for its exercise will be presumed to have been sufficiently presented, and the adjudication to be right. The granting of letters of administration to a party, by a court of competent jurisdiction, is conclusive

of his legal right to the grant of them. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; s. c. 31 Leg. Int. 148.

The right of an executor or administrator of the patentee will be determined according to the law of the patentee's domicile at the time of his decease. Rubber Co. *v.* Goodyear, 2 Fish. 499; s. c. 9 Wall. 788; s. c. 2 Cliff. 351.

The right of an administrator in a patent is not acquired, and can not be assigned, under State laws. The act of Congress directs the mode in which an assignment shall be made, and where it shall be recorded. The administrator may sell the patent the same as any other personal property of the estate, and there is no reason why the right may not be conveyed in parts so as to suit purchasers. Brooks *v.* Jenkins, 3 McLean, 432.

Administrators of an estate are not, properly speaking, trustees in whom is vested the legal title. The law clothes them with certain powers, by which they are enabled to transmit the legal title of property. Acts done by one of them, which relate to the delivery, gift, sale, or release of the decedent's goods or personal property are deemed the acts of all. An assignment by one administrator will therefore pass the whole interest in the patent. Wintermute *v.* Redington, 1 Fish. 239.

The purchaser of personal property from an administrator need not show that the formality required by the law has been complied with, for he can hold it unless the transaction is fraudulent. Brooks *v.* Jenkins, 3 McLean, 432.

An assignment by a person as administrator will pass the right held by the person as executor. Newell *v.* West, 13 Blatch. 114; s. c. 8 O. G. 598; s. c. 9 O. G. 1110.

Estoppel.

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time either actually or potentially. His grant or assignment is therefore by its natural interpretation limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*. Woodworth *v.* Sherman, 3 Story, 171.

If a party making an assignment at a time when he has no title, subsequently acquires title, and then testifies in an action brought by the assignee, that the assignee became the owner under such assignment, he will be estopped from setting up a title against the respondent. Littlefield *v.* Perry, 21 Wall. 205; s. c. 7 O. G. 964; Sherman *v.* Champlain Co. 31 Vt. 162.

An assignment made by one who has no title, with the written assent of the party in whom the title is vested, is effective as a transfer of the title. Sherman *v.* Champlain Co. 31 Vt. 162.

A mere assignment of the right, title and interest of the assignor, without anything more, will not operate as an estoppel to pass a title subsequently acquired by the assignor. Perry *v.* Corning, 7 Blatch. 195.

Assignment before Patent.

The discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires. An assignment of his whole interest, whether before or after the patent is issued, is equally within the provisions of the act. If it is made before the issuing of the patent, no new assignment need be made, although the patent is issued to the discoverer. When the patent issues, the legal right to the monopoly and property it creates, is by operation of the assignment vested in the assignee. Gayler *v.* Wilder, 10 How. 477; Rathbone *v.* Orr, 5 McLean, 131; Rich *v.* Lippincott, 2 Fish. 1; Herbert *v.* Adams, 4 Mason, 15; Rathbone *v.* Orr, 5 McLean, 131; Hammond *v.* M. & H. Organ Co. 1 Holmes, 296; S. C. 92 U. S. 724.

Whether the machine is perfected or not at the time of the sale is immaterial, if the inventor agrees to make it perfect and procure a patent. Rathbone *v.* Orr, 5 McLean, 131.

An assignment is valid, although it is made after the rejection of the application of the inventor by the commissioner, and an appeal from that decision. Gay *v.* Cornell, 1 Blatch. 506.

An assignment of an imperfect invention, with all improvements upon it that the inventor may make, is equivalent in equity to an assignment of the perfected results, and the patentee takes the patent for an improvement in trust for the assignee. Littlefield *v.* Perry, 21 Wall. 205; S. C. 7 O. G. 964.

A contract to assign all improvements in a certain machine, may cover everything then in embryo in the mind of the inventor, though not yet matured. An intent to cover all improvements ever made at any future time, would be likely to be expressed in explicit language to that effect. Nesmith *v.* Calvert, 1 W. & M. 34.

If an inventor who has covenanted to take out letters patent for another at his request and cost, takes them out without an advance of the costs or authority from the covenantee, he will be deemed to hold them in trust for the covenantee. Emmons *v.* Sladdin, 9 O. G. 352.

If a covenant to execute deeds of conveyance of the part sold, as soon as may be after letters patent shall have issued, does not give the grantee a legal title, a *jus in re*, it clearly confers on him a *jus ad rem*, an equitable right to the thing itself, and is not a mere executory contract to account for the proceeds. Clum *v.* Brewer, 2 Curt. 506.

A party who engages an inventor to make inventions and improvements for his benefit, has no legal or equitable title to an invention made after the contract was terminated. Appleton *v.* Bacon, 2 Black, 699.

If an inventor who is employed to make improvements takes the patent in his own name, he must put the other party in some default before he can claim the exclusive ownership of the improvements. Continental Co . Empire Co. 4 Fish. 428; S. C. 8 Blatch. 295.

A contract by an inventor to allow another to take out a pa for the invention in his own name may be proved by parol. Lockwood *v.* Lockwood, 33 Iowa, 509.

If an assignment of an interest in one patent does not purport to give rights

in another invention, it can not operate by way of estoppel to give the assignee an interest in a subsequent patent therefor. Warren *v.* Cole, 15 Mich. 265.

If a party invents or discovers and keeps secret a process of manufacture, whether a proper subject for a patent or not, he has not indeed an exclusive right to it as against the public or against those who in good faith acquire knowledge of it, but he has a property in it which a court of chancery will protect against one who, in violation of contract and breach of confidence, undertakes to apply it for his own use, or to disclose it to third persons. Peabody *v.* Norfolk, 98 Mass. 452.

Extension.

An inventor has not only an inchoate right to obtain letters patent securing to him the exclusive right to his invention for the original term, but also a further inchoate right to have the term extended, provided he shall fail without fault to obtain a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into public use. This title of an inventor to obtain an extension may be the subject of a contract of sale. There is nothing in the nature or incidents of such a right to distinguish it as a subject of sale from the inchoate right to obtain the original patent. Each appertains to the inventor by reason of his invention. Each is incomplete, and its completion depends upon the compliance by the inventor with conditions, and the performance by public officers of certain acts prescribed by law. It is true the title of an inventor to an extension is still further qualified by a further condition of his failure to obtain remuneration from the enjoyment of the exclusive right for the first term of fourteen years. But though this is an additional condition which may render parties less willing to contract, its existence does not change the nature of the right, and it no more prevents it from being the subject of a contract of sale than any other condition which is attached to it. Clum *v.* Brewer, 2 Curt. 506; Newell *v.* West, 13 Blatch. 114; s. c. 8 O. G. 598; 9 O. G. 1110; Railroad Co. *v.* Trimble, 10 Wall. 367; Hammond *v.* M. & H. Organ Co. 1 Holmes, 296; s. c. 92 U. S. 724; Hoffheins *v.* Brandt, 3 Fish. 218.

The franchise which the patent grants consists altogether in the right to exclude every one from making, using or vending the thing patented without the permission of the patentee. This is all that he obtains by the patent. When he sells the exclusive privilege of making or vending it for use in a particular place, the purchaser buys a portion of the franchise which the patent confers. He obtains a share in the monopoly, and that monopoly is derived from and exercised under the protection of the United States. The interest he acquires necessarily terminates at the time limited for its continuance by the law which created it. The patentee can not sell it for a longer time. The purchaser buys with reference to that period, the time for which the exclusive privilege is to endure being one of the chief elements of its value. He therefore has no just claim to share in a further monopoly subsequently acquired by the patentee. He does not purchase or pay for it. Bloomer *v.* McQuewan, 14 How. 539.

A sale of the invention before letters patent are obtained does not neces-

sarily carry with it the exclusive right for the extended term, because this right is not a mere incident of the invention. Its existence is made to depend not only on matter which is subsequent to the invention, but exclusively personal to the inventor himself, and only he or his personal representatives can obtain it. But where an inventor has in terms sold to another person a part of his invention, he has done that which is quite consistent with the intent to have that other person participate in all the rights which he as an inventor can acquire by law, and where the invention is the subject sold, it would be natural to expect to find in the instrument of sale something showing an intention that the purchaser should be interested not merely in the original letters patent, but in any extension thereof, securing the exclusive right to the same invention which was the subject of sale. Clum *v.* Brewer, 2 Curt. 506.

An ordinary assignment of the right in the patentee will not convey any right in an extension of the patent. The intention to assign such an interest must be expressed. Case *v.* Redfield, 4 McLean, 526; Gear *v.* Grosvenor, 6 Fish. 314; S. C. 1 Holmes, 215; 3 O. G. 380; Woodworth *v.* Sherman, 3 Story, 171; Brooks *v.* Bicknell, 4 McLean, 64; Hodge *v.* Railroad Co. 3 Fish. 410; S. C. 6 Blatch. 85, 165; Goodyear *v.* Hulliher, 3 Fish. 251; Wetherill *v.* Zinc Co. 6 Fish. 50; S. C. 9 Phila. 385; 2 O. G. 471.

The right to an extension is contingent and personal to the inventor, and does not pass as an incident to a grant of the invention and appurtenant thereto. Mowry *v.* Railroad Co. 10 Blatch. 89; Clum *v.* Brewer, 2 Curt. 506.

The phrase "to the full end of the term for which letters patent are or may be granted," will convey a right to an extension. Railroad Co. *v.* Trimble, 10 Wall. 367; Ruggles *v.* Eddy, 5 Fish. 581; S. C. 10 Blatch. 52; Nicolson Co. *v.* Jenkins, 14 Wall. 452; S. C. 4 Fish. 201; 5 Fish. 491; 1 Abb. U. S. 567; 1 O. G. 465; 3 A. L. T. (N. S.) 177; Thayer *v.* Wales, 5 Fish. 448; Phelps *v.* Comstock, 4 McLean, 353; Gear *v.* Grosvenor, 6 Fish. 314; S. C. 1 Holmes, 215; 3 O. G. 380; Case *v.* Redfield, 4 McLean, 526; Gear *v.* Holmes, 6 Fish. 595; Emmons *v.* Sladdin, 9 O. G. 352; *vide* Hodge *v.* Railroad Co. 3 Fish. 410; S. C. 6 Blatch. 85.

The term "renewal" is a proper and apt word to confer an interest in the extension of a patent. Pitts et al. *v.* Hall, 3 Blatch. 201; Goodyear *v.* Cary, 4 Blatch. 271; Chase *v.* Walker, 3 Fish. 120.

The terms "rights and property that I may have from any letters patent for the same," are broad enough to include the extended letters patent. Clum *v.* Brewer, 2 Curt. 506.

An assignment of the invention after the patent has been issued, without any other language to indicate the intention of the parties, does not import a conveyance of the right to an extended term. Waterman *v.* Wallace, 13 Blatch. 128.

A licensee's or assignee's right is necessarily bounded by the same limits as that of the licensor or patentee, that is to say, to the original term granted by the patent to the licensor or patentee. If afterwards the patent is renewed, it is a new grant independent of the old, and the patentee is entitled to the sole and exclusive benefit thereof, unless the licensees or assignees under them have, by their original contract, secured to themselves by express covenant or

grant, a right to the benefit of the renewed patent. Washburn *v.* Gould, 3 Story, 122.

The right of the patentee to an extension will not pass to his trustee in insolvency appointed prior to the expiration of the original patent. Schaum *v.* Baker, 2 A. L. T. (N. S.) 15.

Unless there is an express stipulation in a grant or assignment looking to an extension of the patent by a special act of Congress, the court is bound to construe the instrument and each and all of its provisions as relating to the existing right in respect to which the parties were contracting with each other. Gibson *v.* Cook, 2 Blatch. 144.

An interest in a future extension of a patent by a special act of Congress is not the subject of assignment or grant at common law, or within the sense of this section. Gibson *v.* Cook, 2 Blatch. 144.

Recording.

Three cases only of the recording of assignments are provided for in this section: 1st. An assignment of the whole patent. 2d. An assignment of any undivided part thereof. 3d. A grant or conveyance of the exclusive right under the patent within any specified part or portion of the United States. Brooks *v.* Byam, 2 Story, 525; Blanchard *v.* Eldridge, 1 Wall. Jr. 337; Stevens *v.* Head, 9 Vt. 174.

A license is not required by law to be recorded in the patent office in order to give effect and validity to it. Brooks *v.* Byam, 2 Story, 525; Chambers *v.* Smith, 5 Fish. 12: S. C. 7 Phila. 575; Farrington *v.* Gregory, 4 Fish. 221; Bussey *v.* Putney, 38 N. H. 44.

The provision as to recording assignments is merely directory for the protection of *bona fide* purchasers without notice. Even though they are not recorded within the prescribed time, they are valid against a mere wrong-doer piratically invading the patent right. Pitts *v.* Whitman, 2 Story, 609; Stone *v.* Palmer, 28 Mo. 539; Hall *v.* Speer, 6 Pitts. L. J. 403; Olcott *v.* Hawkins, 2 Am. L. J. 317; Brooks *v.* Byam, 2 Story, 525; Boyd *v.* McAlpin, 3 McLean, 427; Case *v.* Redfield, 4 McLean, 526; McKernan *v.* Hite, 6 Ind. 428.

It seems a necessary, or at least a just inference, from this language, that until the assignee has so recorded the assignment, he is not substituted to the right and responsibility of the patentee, so as to maintain any suit at law or in equity founded thereon. Wyeth *v.* Stone, 1 Story, 273.

It is immaterial that an assignment is not recorded until after the suit is brought. It is like the common case of a deed required by law to be registered where it is sufficient if it be registered before the trial, although after the suit is brought, for it is still admissible in evidence as a deed duly registered. Pitts *v.* Whitman, 2 Story, 609.

An unrecorded assignment is valid between the parties thereto. Holden *v.* Curtis, 2 N. H. 61; Black *v.* Stone, 33 Ala. 327; Moore *v.* Bare, 11 Iowa, 198; *vide* Higgins *v.* Strong, 4 Blackf. 182; Mullikin *v.* Latchem, 7 Blackf. 136.

In order to guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the patent office. Gibson *v.* Cook, 2 Blatch. 144.

Within the period of three months a purchaser must protect himself in the best way that he can, as an unrecorded prior assignment will prevail. Gibson *v.* Cook, 2 Blatch. 144.

The unrecorded assignment to prevail over a subsequent assignment must be in writing, so that it may be recorded within the time limited. Gibson *v.* Cook, 2 Blatch. 144.

A party claiming under a subsequent assignment does not hold a good title as against the prior unrecorded assignment, unless he paid a valuable consideration therefor. Saxton *v.* Aultman, 15 Ohio St. 471.

Where the assignment merely purports to transfer the right and title of the assignor, it will not cut off an unrecorded assignment, if there is anything upon which the second assignment can operate, although it is recorded first. No inference can be drawn from such language in the absence of any proof upon the subject that the assignor intended a fraud upon the first assignee. Turnbull *v.* Plow Co. 6 Biss. 225; S. C. 7 O. G. 173; Ashcroft *v.* Walworth, 5 Fish. 528; S. C. 1 Holmes, 152; 2 O. G. 546.

If the means of knowledge are at hand, a purchaser will be presumed to know the facts to which an inquiry would lead him. Mitchell *v.* Hawley, 4 Fish. 388; S. C. 6 Fish. 331; 16 Wall. 544; 3 O. G. 241; 10 O. G. 306.

An unrecorded assignment will prevail over the rights of a subsequent purchaser who takes with notice of the prior assignment. Continental Co. *v.* Empire Co. 4 Fish. 428; S. C. 8 Blatch. 295; Peck *v.* Bacon, 18 Conn. 377.

If the assignee is a corporation of which the patentee is a director and manager, it has notice through him of all prior unrecorded assignments. Continental Co. *v.* Empire Co. 4 Fish. 428; S. C. 8 Blatch. 295; Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; S. C. 10 Blatch. 1.

If there is no evidence that there is any purchaser who has a claim paramount to an unrecorded assignment, and the contract has been partially performed, the only remedy of a purchaser from the assignee is in damages for a breach of the contract. Moore *v.* Bare, 11 Iowa, 198.

If there is an omission or misdescription in the assignment, the assignee is not entitled to have the instrument reformed, and the true description inserted, to the prejudice of a subsequent *bona fide* purchaser for a valuable consideration, who took the title after the lapse of more than three months. Gibson *v.* Cook, 2 Blatch. 144; Woodworth *v.* Cook, 2 Blatch. 151.

The record of an assignment by a person purporting to be an administrator is notice of a sale by the same party as executor. Newell *v.* West, 13 Blatch. 114; S. C. 8 O. G. 598; 11 O. G. 1110.

The recording of a license does not affect the rights of any one. Chambers *v.* Smith, 5 Fish. 12; S. C. 7 Phila. 575.

A license to use a machine will prevail over a subsequent assignment. Continental Co. *v.* Empire Co. 4 Fish. 428; S. C. 8 Blatch. 295.

The right of a *bona fide* purchaser for a valuable consideration of an interest, whereof an assignment is not required to be recorded, will prevail over the right of a person holding a contract therefor. Gibson *v.* Cook, 2 Blatch. 144.

License.

A license is an authority coupled with an interest in its execution. It is not so much a property or interest *in rem*, as a right of user for the benefit of the licensee. Brooks *v.* Byam, 2 Story. 525.

Licenses to make and use, when derived from the patentee, or from one holding a territorial right, by virtue of a valid conveyance from him, are not required to be recorded, and consequently need not be in writing. Baldwin *v.* Sibley, 1 Cliff. 150.

A patent right ought not to be deemed an entirety, but to be divisible so as to permit a grant of the exclusive right to construct to one person, to use to another, and to vend to another. Adams *v.* Burke, 17 Wall. 453; S. C. 1 Holmes, 40; 4 Fish. 392; Washburn *v.* Gould, 3 Story, 122; Jenkins *v.* Greenwald, 2 Fish. 37; S. C. 1 Bond, 126; Steam Cutter Co. *v.* Sheldon, 5 Fish. 475. S. C. 10 Blatch. 1.

A patentee may so convey the right to make as to involve or include the right either to sell or use what the grantee makes. He may also so convey the right to use as to imply the right to sell within the same limits, as well as to make the thing patented, within them. The circumstances, nature, and words of each grant must decide the construction which is just and legal. Woodworth *v.* Curtis, 2 W. & M. 524; Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; S. C. 10 Blatch. 1.

The right to make carries with it the right to sell, but does not necessarily imply the right to use the machine when made and sold. Jenkins *v.* Greenwald, 2 Fish. 37; S. C. 1 Bond, 126; Bicknell *v.* Todd, 5 McLean, 236.

The grant of a right to use and sell the thing patented confers the power to dispose of the right to use to others, because the purchase of a patented thing always carries with it the right to use the thing purchased by implication. Farrington *v.* Gregory, 4 Fish. 221.

The right to use a machine necessarily implies the right to purchase. Bicknell *v.* Todd, 5 McLean, 236.

A patentee may confer upon others such qualified privilege, whether of making, selling to others, or using, as he sees fit, whether within specified limits, or under limitations of quantity or number or restricted use. Dorsey R. H. Rake Co. *v.* Bradley Manuf. Co. 12 Blatch. 202.

A patentee may grant the exclusive right to make and sell the patented invention within specified territory, and yet limit the use of the thing so made and sold within specified limits. Dorsey R. H. Rake Co. *v.* Bradley Manuf. Co. 12 Blatch. 202.

There is a distinction between the grant of the right to make and vend a patented machine, and the grant of the right to use it. Purchasers of the exclusive privilege of making or vending the patented machine, in a specified place, hold a portion of the franchise which the patent confers, and the interest which they acquire terminates at the time limited for its continuance by the law which created it, unless it is expressly stipulated to the contrary. Bloomer *v.* Millinger, 1 Wall. 340; Blanchard *v.* Whitney, 3 Blatch. 307; Mitchell *v.* Hawley, 4 Fish. 599; S. C. 16 Wall. 544; 5 O. G. 299.

A license or contract for the use of an invention, is subject to the same rules of construction as apply to any other contract. Wetherill *v.* Zinc Co. 6 Fish. 50; S. C. 9 Phila. 385; 3 O. G. 471.

If an employee makes an invention and permits his employer to use it prior to the application for a patent, there may be an inference of a license. M'Clurg *v.* Kingsland, 1 How. 202; Slemmer's Appeal, 58 Penn. 155; Chabot *v.* Button Hole Co. 9 Phila. 378; s. c. 5 C. L. N. 75.

If a party is allowed to use the invention prior to the application for a patent, without any notice of a claim to an exclusive right, a license or grant from the inventor may be presumed. M'Clurg *v.* Kingsland, 1 How. 202.

A patentee is not estopped by his silence in omitting to assert his claim to an invention, unless it has misled another to his hurt, and that is not done where a patent is obtained before any expenditure is made. Railroad Co. *v.* Dubois, 12 Wall. 47.

An estoppel must necessarily grow out of some declaration or act of the inventor, by which the party was induced to believe that he might rightfully or innocently use the invention. If he appropriated it without consulting the inventor, and the latter was passive when he knew it, because he was powerless to prevent it, he is not estopped from asserting his right when he is in a condition to enforce it. McMillin *v.* Barclay, 5 Fish. 189; s. c. 4 Brews. 275; Russell Manuf. Co. *v.* Mallory, 5 Fish. 632; s. c. 10 Blatch. 140; 2 O. G. 495.

A grant to use and sell the thing patented is not an assignment, but a license. Farrington *v.* Gregory, 4 Fish. 221.

A conveyance of the exclusive right, within a certain specified territory, to use and vend the patented invention, but reserving to the grantor the right to make it, is a license. Sanford *v.* Messer, 5 Fish. 411; s. c. 1 Holmes, 149; 2 O. G. 470.

A contract for a purchase of a portion of a patent right may be good between the parties as a license, and enforced as such in courts of justice, but the legal title to the monopoly remains in the patentee. Sanford *v.* Messer, 5 Fish. 411; s. c. 1 Holmes, 149; 2 O. G. 470.

Construction.

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

Where the preliminary arrangement for a license was that the license should be in writing, there is no contract between the parties until it is delivered to and accepted by the licensee, and if he refuses to accept such a license, there is no license. Tilghman *v.* Hartel, 9 O. G. 886; s. c. 33 Leg. Int. 149.

A license to use a machine at one place will not authorize its use at another place. Wicke *v.* Kleinknecht, 7 O. G. 1098.

If a license stipulates that the royalty shall be reduced as soon as a license is granted to another at a lower rate, the licensee is entitled to the reduction upon the granting of a license to manufacture a certain number of machines at a certain price. Florence S. M. Co. *v.* G. & B. S. M. Co. 110 Mass. 70.

If a party takes a license to use certain patented articles for a certain term

and no longer, this is a waiver of any prior permission, although it was taken under a mistake of law. Wooster *v.* Taylor, 12 Blatch. 384; s. c. 8 O. G. 644.

The reasonable construction of a license to a corporation, is that it extends no further than the authority conferred upon it by its charter at the time the license was given. Emigh *v.* Chicago B. & I. R. R. Co. 2 Fish. 387; s. c. 1 Biss. 400.

If a man owns two rights to manufacture goods by patents of different dates, and sells to A. his right under one specifically, and to B. the right to manufacture the goods generally, the fair construction of the latter grant will be held to be a conveyance of the right to manufacture under both patents, because in the first grant, when he intends to limit it to one, he so recites on the face of the grant, and in the second he does not. Day *v.* Stellman, 1 Fish. 487.

Where one having a right for a valuable consideration paid, agrees with another that the latter shall have the enjoyment of that right, and gives a power of attorney to enable him to possess and enforce that right, he is not by law permitted to revoke that power so as to deprive the other party of the right. In such a case the power of attorney is a power coupled with an interest not merely in the execution of the power, not merely an interest in that which is produced by the power, but in the thing itself. Day *v.* Candee, 3 Fish. 9.

If a patentee covenants not to grant licenses to others, an agreement not to make any claim on another for any alleged infringement, is essentially a license, and a breach of the covenant. Jackson *v.* Allen, 120 Mass. 64.

If the license contains no express covenant that the patent is valid, it does not amount to a warranty that the licensee shall enjoy the privilege against persons not claiming under the licensor. Jackson *v.* Allen, 120 Mass. 64.

If a license contains no warranty or covenant that the patentee is the inventor of the improvement, he is not estopped from proving the invalidity of the patent to affect the amount of damages for violating a stipulation to sue infringers. Jackson *v.* Allen, 120 Mass. 64.

Whether an order upon a licensee and a note payable out of the royalty due from him, are taken in full satisfaction of a debt, or only as a method of collecting it, is a question of fact. Taylor *v.* Collins, 102 Mass. 248.

A patentee in granting to another the right to make and sell the patented invention, may retain to himself the exclusive right to make and sell for export or use in other countries. Dorsey R. H. Rake Co. *v.* Bradley Manuf. Co. 12 Blatch. 202.

A licensee, unless restrained by contract, is at liberty to manufacture and sell as many articles as he pleases either by the old method or by any new machine which may be invented. Burr *v.* Duryee, 2 Fish. 275; s. c. 1 Wall. 531.

A license to the licensee and his assigns, to employ six persons in the manufacture of the thing patented, is an entirety, and incapable of division, or of being broken up into fragments in the possession of different persons. If it is assignable, the assignment must be of the entirety of the license to the assignee, and it can not be apportioned among different persons in sev-

eralty. Whoever is to be employed is to be employed by the licensee and his assigns. All must be employed by one and the same party. The language ought to be exceedingly clear that should lead a court to construe an instrument of this sort granting a single right or privilege to a particular person or his assigns, as also granting a right or license to split the same right into fragments among many persons in severalty, and thus make it apportionable as well as transmissible. Brooks *v.* Byam, 2 Story, 525.

A license to use one machine will always be construed to be an authority to use a machine, unless in express terms it be limited to the identical machine referred to. Wilson *v.* Stolley, 4 McLean, 275.

If the license merely authorizes the licensee to use two machines constructed according to the patent, he may use two at all times, whether constructed by himself or another. If he constructs machines and sells them to others to be used, he is an infringer of the patent and liable to an action. If he uses but two, he is within the letter and spirit of his contract. If he should construct a dozen, yet if he use but two, he does not break his contract. Burr *v.* Duryee, 2 Fish. 275; S. C. 1 Wall. 531.

If a license to use one machine covers the whole term, and is not limited to any particular machine, it confers the right to repair or change machines, but only one machine in number can be used at one time. Woodworth *v.* Curtis, 2 W. & M. 524; Wilson *v.* Stolley, 4 McLean, 275; Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; S. C. 10 Blatch. 1.

A licensee of a right to use, may repair his machine, but he can not construct one. Bicknell *v.* Todd, 5 McLean, 236; Woodworth *v.* Curtis, 2 W. & M. 524.

If the contract provides that the proceeds of all suits for violations of the patent shall be divided equally between the patentee and the licensee, but that the licensee shall not institute a suit without the consent of the patentee, the licensee may terminate a suit, or make a settlement which will be binding without the institution of a suit. Burdell *v.* Denig, 2 Fish. 588; S. C. 92 U. S. 716.

A licensee holding under a license which only applies to machines that are both made and sold by him, or used and sold by him, and made without authority from the patentee, is not liable for a royalty upon machines purchased by him from another licensee, if they are purchased before the expiration of the quarter at the end of which the license of the vendor by its terms would be forfeited. Howe *v.* Wooldredge, 94 Mass. 18.

If the license contains a provision that if the licensee ceases to use the machine for a certain time, such neglect shall be considered as an abandonment of the license on his part. A formal notice by the patentee that he considers the neglect an abandonment is not necessary. A refusal to receive the royalty would be sufficient. Wilson *v.* Stolly, 5 McLean, 1.

Assignment of License.

Whether a license is [illegible]t assignable is to be determined not merely by the term "license," [illegible]nquiry into the fair meaning and intention of the parties, and it may b[illegible]ed not merely by the words of license, but by the nature of the tran[illegible]e consideration paid, and other circumstances

showing that an assignable right was conferred. Dorsey R. H. Rake Co. *v.* Bradley Manuf. Co. 12 Blatch. 202.

A mere license to a party, without having his assigns, or equivalent words to them, showing that it was meant to be assignable, is only the grant of a personal power to the licensee, and is not transferable by him to another. Troy Factory *v.* Corning, 14 How. 193: s. c. 1 Blatch. 467; Rubber Co. *v.* Goodyear, 2 Fish. 499; s. c. 9 Wall. 788: 2 Cliff. 351; Baldwin *v.* Sibley, 1 Cliff. 150; Bull *v.* Pratt, 1 Conn. 342.

A license to a licensee and his assigns to use one machine is assignable. A machine, and the right to use it, is personal property rather than a mere patent right, and has all the incidents of personal property, and is thus subject to pass by sale. Woodworth *v.* Curtis, 2 W. & M. 524: Wilson *v.* Stolley, 4 McLean, 275; Wilson *v.* Stolly, 5 McLean, 1.

If a license is personal, the licensee cannot arrange with others to manufacture the patented article for him. Houghton *v.* Rowley, 30 Leg. Int. 60; Rubber Co. *v.* Goodyear, 9 Wall. 788; s. c. 2 Fish. 499; 2 Cliff. 351.

The receipt of the royalty from the party to whom a licensee has transferred his license will be deemed a waiver of a requirement that such transfer shall not be made without the written consent of the licensor. Bloomer *v.* Gilpin, 4 Fish. 50.

A mere license is not apportionable, so as to permit the licensee to grant to others separate rights to use or work the patent by subdividing the rights which have been granted to him. Consolidated Fruit Jar Co. *v.* Whitney, 31 Leg. Int. 229.

If a licensee assigns his contract, the question whether the licensor and assignee agreed that the latter should become a party to the contract, is a question of fact, although the licensor received money as royalty from such assignee. Gaylord *v.* Case, 1 C. L. B. 382.

A party who has taken an assignment of a license obtained by fraud is not entitled to be permitted to complete contracts entered into after notice of the fraud. Consolidated Fruit Jar Co. *v.* Whitney, 31 Leg. Int. 229.

If two corporations, each having a license to use the thing patented, are consolidated, the new corporation will also have the right to use it. Leightner *v.* Railroad Co. Lowell, 338.

A transfer of the rolling stock of a railroad, to which the thing patented is attached, to a creditor with the right to receive the revenues until his debt is paid, constitutes him merely an agent or trustee of the corporation, and his use of the thing patented is covered by a license to the corporation, and he is not an infringer. Emigh *v.* Chamberlain, 2 Fish. 192; s. c. 1 Biss. 367.

If the licensees form a corporation, and then transfer the patented articles to it, with the intent that it shall have the right to sell them without being liable to the patentee, this constitutes such a sale as to render them liable for the royalty. Marsh *v.* Dodge, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278.

If a licensee takes a partner in the business of manufacturing the thing patented, a sale to his partner of his interest in the firm is such a sale as to render him liable for the royalty. Wilder *v.* Stearns, 48 N. Y. 656.

If a license is made to a firm, one partner may, upon the dissolution of the

firm, purchase the interest of his copartner, and continue to use the thing patented. Belding *v.* Turner, 4 Fish. 446; s. c. 8 Blatch. 321.

The patentee is not required to give notice of any restriction to a voluntary purchaser of a licensee's right to enable him to hold such purchaser to the restricted use and enjoyment of the invention stipulated in the license. It is the duty of the purchaser to inform himself of the nature of the licensee's ownership and the extent of his right. Chambers *v.* Smith, 5 Fish. 12; s. c. 7 Phila. 575.

A purchaser of a licensee's interest at a judicial sale acquires only the licensee's title in the thing sold. Chambers *v.* Smith, 5 Fish. 12; s. c. 7 Phila. 575.

If a license which is granted in consideration of a royalty is assigned, the assignee takes it with the incumbrance attached to it, and a duty and obligation rest upon him to pay the royalty. Goodyear *v.* Congress Rubber Co. 3 Blatch. 449.

In the absence of an express stipulation, a patentee has no lien upon a license to secure the royalty due under it when it is assigned to another. Goodyear *v.* Congress Rubber Co. 3 Blatch. 449.

Purchase of Patented Article.

A purchaser, in using a patented implement or machine, exercises no rights created by the act of Congress, nor does he derive title to it by virtue of the franchise or exclusive privilege granted to the patentee. The inventor might lawfully sell it to him, whether he had a patent or not, if no other patentee stood in his way. When the machine passes to the hands of the purchaser, it is no longer within the limits of the monopoly. It passes outside of it, and is no longer under the protection of the act of Congress. If his right to the implement or machine is infringed, he must seek redress in the courts of the State, according to the laws of the State, and not in the courts of the United States, nor under the law of Congress granting the patent. The implement or machine becomes his private individual property, not protected by the laws of the United States, but by the laws of the State in which it is situated. Contracts in relation to it are regulated by the laws of the State, and are subject to State jurisdiction. Bloomer *v.* McQuewen, 14 How. 539; Chaffee *v.* Boston Belting Co. 22 How. 217; Mitchell *v.* Hawley, 4 Fish. 388; s. c. 6 Fish. 331; 16 Wall. 544; 3 O. G. 241; 10 O. G. 306.

The patentee may make any covenant he pleases with his licensees, but he can not compel the public to notice or regard such agreements, or the right conferred or reserved by them. Such covenants do not run with the product like a covenant on land. If his licensees do not perform their agreements, his remedy is by an action against them on the covenants, and not by a recourse to a chancellor to restrain third persons who have purchased from his licensees. Washing Machine Co. *v.* Earle, 2 Fish. 203; s. c. 3 Wall. Jr. 320.

A patent for a process does not give the patentee the power to control the use which persons who purchase may make of the product. A covenant restricting such use to certain articles binds only the parties to it. If a stranger purchase the product from one licensed to use the process, he need look no

further, and may use it for his own purposes without inquiring for or regarding any private agreement of licensees. Washing Machine Co. *v.* Earle, 2 Fish. 203; s. c. 3 Wall. Jr. 320.

If a party makes a contract for the thing patented, and the patentee grants a license to the contractor with a reservation of a right to obtain a royalty from such party, which reservation is unknown to him, the reservation is inconsistent with the license. The license to the contractor relieves the party from responsibility. The relieving of the parties primarily liable by a universal rule of law as well as of justice, relieves those who are only secondarily responsible. Bigelow *v.* Louisville, 3 Fish. 602.

The sale of a machine does not necessarily give an implied right to use it, where the sale is made by a person who has no exclusive right, but a license merely of use. The extent of the transfer must therefore depend on the facts and circumstances of the case. Wilson *v.* Stolley, 4 McLean, 275; Mitchell *v.* Hawley, 16 Wall. 544; s. c. 4 Fish. 388; 6 Fish. 331; 3 O. G. 241; 10 O. G. 306.

The purchase of a patented article lawfully manufactured and sold, without condition or restriction, by a territorial grantee within the territory, gives the purchaser the right to use or sell the article in another territory for which another person has taken a grant under the patent. If this were not so, the purchaser of a manufactured patent article of wearing apparel might be liable for the use of the patented article in every town and city through which he might travel. By the sale the article ceases to be within the monopoly. Adams *v.* Burke, 4 Fish. 392; s. c. 1 Holmes, 40; 17 Wall. 453; 1 O. G. 282; McKay *v.* Wooster, 6 Fish. 375; s. c. 2 Saw. 373; 3 O. G. 44; 6 A. L. T. 169; May *v.* Chaffee, 5 Fish. 160; s. c. 2 Dillon, 385.

The patentee himself can not, by a subsequent assignment of his patent, limit the right of the purchaser already vested. McKay *v.* Wooster, 6 Fish. 375; s. c. 2 Saw. 373; 3 O. G. 44; 6 A. L. T. 169.

If a person legally acquires title to that which is the subject of letters patent, he may continue to use it until it is worn out, or he may repair it or improve upon it as he pleases, in the same manner as if dealing with property of any other kind. Chaffee *v.* Boston Belting Co. 22 How. 217.

Like other individual property, the patented machine or implement in the hands of a purchaser is subject to State taxation. Bloomer *v.* McQuewen, 14 How. 539.

If a municipal charter requires that work shall be let by contract to the lowest bidder, the city can not contract for the use of a patented article which is owned by one firm. Dean *v.* Charlton, 23 Wis 590.

If a statute authorizes a public officer to use a patented article, a provision that the contract must be awarded to the lowest bidder must be so construed as not to defeat the authority. Greaton *v.* Griffin, 4 Abb. Pr. N. S. 310.

When Licensee Estopped.

A licensee who manufactures articles similar to the thing patented is estopped to deny that they are made under the license, so long as he retains it. Marsh *v.* Dodge, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278.

If a licensee continues to use the thing patented after a reissue, and to account for the royalty, he can not escape his obligation on account of such reissue. Gaylord *v.* Case, 1 C. L. B. 382.

If a licensee, after full opportunity of judging of the character of the thing patented, and of the value of the privilege, enters into a compromise with the licensor, and fully enjoys everything for which he stipulates in such compromise without interruption, he is estopped to deny a consideration for a note given on such compromise. Davis *v.* Gray, 17 Ohio St. 330.

If the defendant has actually received profits from sales of the patented machine, under an agreement with the patentee, and the profits are not in any way liable to be affected by the invalidity of the patent, its validity is immaterial. Moreover the defendant is estopped from alleging that invalidity. If he has sold the machines under the patentee's title and for his account, he can no more be allowed to deny that title and retain the profits to his own use, than an agent who has collected a debt for his principal can insist on keeping the money upon an allegation that the debt was not justly due. The invalidity of the patent does not render the sales of the machine illegal so as to taint with illegality the obligation of the defendant to account. It is simply a question of failure of title, and when that does not appear in any manner to have affected the profits which the defendant received, there can be no ground to allow it to be shown in defense. Kinsman *v.* Parkhurst, 18 How. 289; s. c. 1 Blatch. 488.

A party who holds a license to use a patented machine can not repudiate the contract while continuing to use the machine. The contract can not be terminated unless the licensee ceases to use the machine. Sherman *v.* Champlain Co. 31 Vt. 162.

If a licensee avails himself of the invention so as to earn the royalty without offering to surrender his license, he is estopped to impeach the validity of the patent. Gaylord *v.* Case, 1 C. L. B. 382; Magic Ruffle Co. *v.* Elm City Co. 13 Blatch. 151; s. c. 8 O. G. 773; Birdsall *v.* Perego, 5 Blatch. 251; Marsh *v.* Dodge, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278.

If the complainant seeks to nullify a contract on account of a breach of its terms, the defendant will not be estopped by its recitals from denying the validity of the patent. Burr *v.* Duryee, 2 Fish. 275; s. c. 1 Wall. 531; *contra*, Brooks *v.* Stolley, 3 McLean, 523.

The acceptance of a license for a certain term is not an acknowledgment of the right of the licensor beyond the termination of the license. Rich *v.* Atwater, 16 Conn. 409.

In an action of covenant to recover the royalty for machines actually sold thereunder, the covenantee can not set up the defense of the invalidity of the patent. Such a defense is not consistent with the relation of the defendant to the plaintiff. Wilder *v.* Adams, 2 W. & M. 329; Sargent *v.* Larned, 2 Curt. 340; Marsh *v.* Dodge, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278.

If a licensee does all that lies in his power to restore the patentee to the same condition he was in before the contract, he may cease to act under the contract, and take issue with the patentee as to the validity of the exclusive right which he claims by virtue of his patent. Sherman *v.* Champlain Co. 31 Vt. 162.

Forfeiture of License.

Where the grant of a license is absolute, a violation of the patent outside of the license does not work a forfeiture of the right conveyed. Wood *v.* Wells, 6 Fish. 382.

If a contract is partly executed, a failure on the part of the licensee to fulfil it will not of itself operate to annul and cancel the agreement. Gibson *v.* Barnard, 1 Blatch. 388.

If the terms of the license make the performance of its stipulations by the licensee a condition to his continued use of the thing patented, he forfeits his rights by a breach of the stipulations. Brooks *v.* Stolley, 3 McLean, 523; Woodworth *v.* Cook, 2 Blatch. 151.

If a license has been forfeited by a failure to comply with the conditions upon which it was granted, the licensee, by acquiescing in a claim of forfeiture, will be deemed to abandon the license. Kittle *v.* Frost, 5 Fish. 213; S. C. 9 Blatch. 214.

If a contract is forfeited by a breach of a condition, the licensee is remitted to his original position and rights, as the contract must be avoided altogether if at all. It can not be obligatory upon the one party and not upon the other. Woodworth *v.* Cook, 2 Blatch. 151.

If a licensee neglects to pay his license price for a long time, and finally, when prosecuted, abandons his license, or, while relying upon it, defends also upon other grounds, the license will be forfeited and he will be liable as an infringer. Bell *v.* McCullough, 1 Fish. 380; S. C. 1 Bond, 194.

A notice alleging a breach of a license, and forbidding the licensee to use or exercise the right granted by the license for any purpose whatever, does not *ipso facto* annul the license, and the licensor may recover his royalty if the licensee still continues the use. Union Manuf. Co. *v.* Lounsbury, 42 Barb. 125; S. C. 41 N. Y. 363.

Joint Owners.

It is competent for two persons, being joint owners of letters patent, whether valid or invalid, to enter into a copartnership for the manufacture and sale of the invention, and to stipulate that one of them alone shall conduct the business. This is a provision for the prosecution of the business in a particular mode, and not for its restraint. Kinsman *v.* Parkhurst, 18 How. 289; S. C. 1 Blatch. 488.

Where no agreement of copartnership exists, the relation of copartners does not result from a connection as joint patentees. The grant is to the patentees jointly, and not to either severally. Pitts *v.* Hall, 3 Blatch. 201.

Joint owners of a patent right, in the absence of express covenants, have interests which are distinct and separate in their nature, though they are derived from the same contract. Each party is at liberty to use his moiety as he may think fit, in the territory covered by the assignment, and will not incur any obligation to the other either for profits or losses. Vose *v.* Singer, 86 Mass. 226; De Witt *v.* Elmira Nobles Manuf. Co. 12 N. Y. Supr. 301; *vide* Parkhurst *v.* Kinsman, 6 N. J. Eq. 600.

Where there are several patentees, they are tenants in common. One of

them has no superiority of right over another. One of them can manufacture and use the article patented without the consent of the others. Dunham *v.* Ind. & St. Louis R. R. Co. 9 C. L. N. 50.

One of two joint owners can legally grant, assign, license or sell his own share or right in the patent. May *v.* Chaffee, 5 Fish. 160; S. C. 2 Dillon, 385.

One joint owner can legally grant, assign, license or sell only in respect to his own share or right. He can not sell and give a good title to his co-owner's right, for the same reason that one joint owner of a chattel can not transfer the share of his co-proprietor. Pitts et al. *v.* Hall, 3 Blatch. 201.

Where there are several patentees, and one of them grants a license to use the invention, the licensee is not liable to the other patentees. Dunham *v.* Ind. & St. Louis R. R. Co. 9 C. L. N. 50.

If a power of attorney recites the separate interests of the principals, and confers on the attorney authority to act for each of them severally or jointly, an assignment conveying the interest of one alone need only be executed in the name of the party whose interest is so assigned. May *v.* Chaffee, 5 Fish. 160; S. C. 2 Dillon, 385.

If one owner in common of a patent right agrees in consideration of a license fee, that the others shall have the exclusive right to manufacture the thing patented, they may set up the invalidity of the patent as a defense to an action to recover the fee. Marston *v.* Sweet, 6 T. & C. 534; S. C. 11 N. Y. Supr. 153

If parties unite in obtaining a joint patent, neither of them, as against the other, can set up a prior patent to himself for the same invention. Stearns *v.* Barrett, 18 Mass. 443.

If a declaration avers that the plaintiff and the defendant were joint inventors, a plea that neither the plaintiff nor the defendant was the first inventor is immaterial. Stearns *v.* Barrett, 18 Mass. 443.

If parties obtain separate patents for the same invention, neither is estopped from asserting that the invention was joint. Stearns *v.* Barrett, 18 Mass. 443.

Defense to Action on Contract.

A void patent is not a good consideration for a promissory note. Dickinson *v.* Hall, 31 Mass. 217; Bliss *v.* Negus, 8 Mass. 46; Cross *v.* Huntley, 13 Wend. 385; Geiger *v.* Cook, 3 W. & S. 266; Kernodle *v.* Hunt, 4 Blackf. 57; Higgins *v.* Strong, 4 Blackf. 182; Head *v.* Stevens, 19 Wend. 411; McClure *v.* Jeffrey, 8 Ind. 79; Bierce *v.* Stocking, 77 Mass. 174; Rowe *v.* Blanchard, 18 Wis. 441; National Bank *v.* Peck, 8 Kans. 660; Bellas *v.* Hayes, 5 S. & R. 427; Turner *v.* Johns, 2 Cranch C. C. 287; Nye *v.* Raymond, 16 Ill. 153; Joliffe *v.* Collins, 21 Mo. 338; *vide* Elmer *v.* Pennel, 40 Me. 430.

If no evidence is offered to impeach the novelty or utility of the invention, there is no proof to support an allegation of a failure of consideration, however worthless the patent may be. Case *v.* Morey, 1 N. H. 347; Myers *v.* Turner, 17 Ill. 179; Hardesty *v.* Smith, 3 Ind. 39.

The mere fact that an invention lacks novelty or utility in its application to any one of the several objects for which it is patented, will not prevent a recovery upon a note given for an interest therein. Midkiff *v.* Boggess, 15 Ind. 210.

A mere claim by others that the thing patented is an infringement of a prior patent is no defense to an action on a note given by a licensee under the terms of his license. Davis *v.* Gray, 17 Ohio St. 330.

If the invention is not useful, the vendor can not recover upon a promissory note given therefor, although he supposed the patent a valid one, and was wholly innocent of any fraud. Lester *v.* Palmer, 86 Mass. 145.

In an action upon a note given for a thing patented, the defendant may prove that the patent is void, and that the consideration has thus partially failed, although no special value was placed on the patent. Nye *v.* Raymond, 16 Ill. 153.

A purchaser in defense to an action upon a contract, may show that the vendor has no patent such as is described in the contract. M'Dowell *v.* Meredith, 4 Whart. 311; Nye *v.* Raymond, 16 Ill. 153.

If a patent right is sold with a warranty, and the process can not produce the result warranted, there is an entire failure of consideration, and no recovery can be had on a note given therefor. Hawes *v.* Twogood, 12 Iowa, 582.

Before a party can recover the consideration named in a contract for purchase of an interest in a patent right, he must show that he has title in himself to convey according to his contract, and tender an assignment thereof, unless such tender is dispensed with by the terms of the contract. Edwards *v.* Richards, Wright, 596; Bellas *v.* Hays, 5 S. & R. 427.

If joint payees of a note indorse it to one of them, the defense that it was given for a license to use a patent that is void, is good. Saxton *v.* Dodge, 57 Barb. 84.

The detriment which the purchaser may suffer on account of the patent being broader than the invention may affect the amount to be recovered, but not the right of recovery. Hotchkiss *v.* Oliver, 5 Denio, 314.

If a note is given for a patent right, and the invention is worthless because the machine can not be made to work, the note is void for want of consideration. Clough *v.* Patrick, 37 Vt. 421; Cragin *v.* Fowler, 34 Vt. 326; Williams *v.* Hicks, 2 Vt. 36; Scott *v.* Sweet, 2 G. Greene (Iowa), 224.

If a patent for a seed-sower, to be operated by horse power, is worthless, the patentee can not sustain the consideration of a note given therefor by proof that it may be modified to a hand-machine, especially when such modification required invention. Cragin *v.* Fowler, 34 Vt. 326.

If a note is given for a patented machine, and the exclusive right to use the same for a certain territory, the patentee is not entitled to anything beyond the value of the machine if the patent is void. Earl *v.* Page, 6 N. H. 477.

If the invention was useful and valuable at the time of the sale, the consideration of the note given therefor will not be impeached by showing that subsequent improvements have rendered the invention useless. The purchaser, when he bought, took the risk of a new discovery which should destroy the value of his property. Harmon *v.* Bird, 22 Wend. 113.

If the purchaser has assigned his interest in the patent to another, he can not, in an action by the patentee upon his note given for the right thus sold, set up a defense of a failure of consideration. Thomas *v.* Quintard, 5 Duer, 80.

If the samples and instruction furnished to the purchaser were not in any

degree valuable or useful to him, but as subservient to the art which was pretended to be conveyed by the assignment, the patentee will not be entitled to recover the value thereof. Bliss *v.* Negus, 8 Mass. 46; Bierce *v.* Stocking, 77 Mass. 174.

If the patentee has not been guilty of any fraud, and the purchaser has received what he contracted for, he can not reduce the amount of the stipulated price by proving that the thing patented is of little or no value, unless there is a warranty and a breach of it. Vaughan *v.* Porter, 16 Vt. 266.

If the assignment of three patents is in the nature of a mere quit-claim deed of whatever right, title or interest the patentee has or may acquire in the patents specified, and creates no warranty of title, the patentee is entitled to recover the full amount of the note given therefor, although one of the patents is void. Gilmore *v.* Aiken, 118 Mass. 94.

If an assignment contains no warranty, the vendee can not set up a warranty of the validity of the patent. Joliffe *v.* Collins, 21 Mo. 338; Van Ostrand *v.* Reed, 1 Wend. 424.

A stipulation against defects will be referred to defects in the patent, and not to deficiencies in the thing patented. Vaughan *v.* Porter, 16 Vt. 266.

If the contract shows that the parties mutually contemplated the possibility, if not the probability, that the patent was invalid, and provided by the form of the instrument and its stipulations for the contingency, there is no ground on which the vendee can be permitted to set up a failure of consideration, so long as he is not disturbed in the use of the invention, although the patent is void. Johnson *v.* Linen Co. 33 Conn. 436.

A covenant of title will not constitute a good consideration for a promissory note if the patent is void. Dickinson *v.* Hall, 31 Mass. 217; Bliss *v.* Negus, 8 Mass. 46.

If a note is given in consideration of a reassignment of an interest in an invention, so that a patent may issue in the name of the inventor, the fact that the payee took out a patent for an alleged portion of the theory of the invention after the reassignment is no defense to an action on the note. Clark *v.* Smith, 21 Minn. 539.

If the payment of the purchase money in an instrument under seal is entirely dependent on the conveyance of the right, and the instrument is so improperly executed as not to convey the right, the patentee can not recover the consideration in an action on the instrument. Bellas *v.* Hays, 5 S. & R. 427.

If the action is in covenant on a sealed instrument, a good consideration is implied from the solemn form of the promise in writing and under seal, and the invalidity of the patent can not be set up as a defense. Wilder *v.* Adams, 2 W. & M. 329.

In an assignment there is an implied covenant of the validity of the patent, and the purchaser, as a general principle and in ordinary cases, can not resort to such a defense as a want of consideration, or a failure of consideration, when an action is brought upon a sealed instrument executed in consequence of and founded on another covenant made by the patentee to him. Wilder *v.* Adams, 2 W. & M. 329.

A covenant for the enjoyment of the exclusive use of a patented machine insures to the covenantee an indemnity for a use of the patented machine by

others, under and by virtue of the letters patent, but does not secure him against the unlawful and unauthorized acts of wrong-doers. Baker *v.* Mason, 3 R. I. 45.

The violation of the contract by the patentee is available by way of recoupment of damages only, and not in bar of the action. Pitts *v.* Jameson, 15 Barb. 310.

A purchaser can not set up the defense of the invalidity of the patent in an action to recover the purchase money if the contract contains a stipulation that the question shall only be tried in another suit involving the very point, and such is the effect of a provision that the contract shall only be void when some person establishes the invalidity of the patent. Ball *v.* Murry, 10 Penn. 111.

If a contract merely assigns the interest of a party in an invention owned by him and another as partners, the purchaser, in an action for the purchase money, is not entitled to a reduction for the money expended by him in procuring a patent, or in obtaining an assignment of an interest from the co-partner who was the real inventor. Vetter *v.* Lentzinger, 31 Iowa, 182.

If an assignee grants his right to another, and obtains an assignment of a patent from the true inventor, he may, in an action by his assignor to recover a stipulated royalty, plead a decree adjudging the patent void for want of novelty rendered in the Circuit Court of the United States, wherein both were parties, as a bar to the right to recover. Hawks *v.* Swett, 6 T. & C. 529; S. C. 11 N. Y. Supr. 146; Marston *v.* Swett, 6 T. & C. 534; S. C. 11 N. Y. Supr. 153.

When a party claims to establish his right merely by estoppel, the instrument by which the estoppel is supported must be precise, clear and unequivocal. Rich *v.* Atwater, 16 Conn. 409.

If a covenant is entered into under a mistake in regard to the validity of the patent, the recital will not operate as an estoppel in a court of equity. Rich *v* Atwater, 16 Conn. 409.

Where an agreement is restricted to the original patent, it can not operate to estop a party who subsequently obtains a reissue. Pickering *v.* Phillips, 10 O. G. 420.

If the purchaser, in an action for the purchase money, alleges that the vendor had no title, the burden of proof rests on him to show it. Bussey *v.* Putney, 38 N. H. 44; Holden *v.* Curtis, 2 N. H. 61.

Where an alleged warranty is not contained in a written contract, it can not be proved by parol evidence, unless in addition to the averment that there was such warranty, there be an allegation that it was false or fraudulent, and that thereby the purchaser was deceived. McClure *v.* Jeffrey, 8 Ind. 79.

If a purchaser alleges that the party who assumed to sell an interest in the patent to him had no assignment from the patentee, the burden of proof is on him to establish the fact. Stevens *v.* Head, 9 Vt. 174.

If the purchaser of an article takes a covenant of warranty, he may, upon demand, yield to the right of the patentee, and pay the sum required by him; but in a suit against the covenantor he must assume the burden of proof to show the validity of the patentee's claim. Orr *v.* Burwell, 15 Ala. 378.

In an action to recover a royalty from a manufacturer who has covenanted

to keep and render an account of sales, evidence that machines have been made and sent away from the licensee's factory, establishes a *prima facie* case and calls for an explanation. Marsh *v.* Dodge, 5 Lans. 541.

Recovery of Purchase Money.

If a purchaser pays the consideration stipulated for an assignment of a patent for a certain article, and the vendor sends him an assignment of a patent for a different thing, he may return the assignment and recover the consideration. Foss *v.* Richardson, 81 Mass. 303; McDowell *v.* Meredith, 4 Whart. 311.

If there has been no misrepresentation or concealment of any material fact by the patentee, the purchaser can not recover the money which has been paid, although the patent is void, for the payment is voluntary with a full knowledge or means of knowledge of all the facts in relation to the transaction. Stevens *v.* Head, 9 Vt. 174; *vide* Darst *v.* Brockway, 11 Ohio, 462.

If the assignor agrees to refund the consideration if the assignee can not realize that amount from sales within a certain period, the assignee, if the instrument is silent as to his efforts, is bound to make reasonable efforts to realize from sales, taking into consideration his ability and pecuniary means. Berger *v.* Peterson, 78 Ill. 633.

A patent right is not a corporeal thing either real or personal, but something intangible and incorporeal, resting wholly in grant. In contracts for the assignment of such interests, if there be no fraud, the purchaser must depend wholly upon his covenants in case they prove of no value. He has no remedy for his money if there is a failure of title. Hiatt *v.* Twomey, 1 Dev. & Bat. Eq. 315; Canster *v.* Eaton, 2 Jones Eq. 499.

If a judgment has been rendered against the purchaser upon the note given for the patent, he can not recover the money paid thereon, although the patent is void. Holden *v.* Curtis, 2 N. H. 61.

If the purchaser derives any benefit from the use of the patent, he can not recover the consideration paid, although the patent is void. Holden *v.* Curtis, 2 N. H. 61.

If an assignee takes an assignment, not merely for the purpose of examination, but as a deed vesting the property in him, and reads it, or has opportunity to read it, retains it, acts under it and makes payment on account of it, he can not, in the absence of fraud, recover back the consideration for which the deed stipulated, merely because there has been a misunderstanding as to the meaning of the deed and the extent of the rights which it confers. Foss *v.* Richardson, 81 Mass. 303.

Fraud.

A purchaser who has repudiated a contract to purchase a patent right for fraud may sue for redress if he has suffered damages from it. Warren *v.* Cole, 15 Mich. 265.

In order to make a representation a ground for an action of deceit or fraud, it must be shown that the representation was known to be false, and that it was made with an intent to deceive. Joliffe *v.* Collins, 21 Mo. 338.

A misrepresentation in regard to the value of the thing patented, is ground

for rescinding a contract. Newell *v.* Gatling, 7 Ind. 147; Gatling *v.* Newell, 9 Ind. 572.

A mere representation by the vendor that the patentee's machine is useful and valuable, will not avoid the note if the patent is valid. Kernodle *v.* Hunt, 4 Blackf. 57.

A misrepresentation in regard to the utility of the thing patented may be available in mitigation of damages, but will not constitute a defense to a suit upon a covenant or note given by the purchaser. A plea in bar should, in addition to the misrepresentations, state that the property was of no value, or that it has been returned or tendered to the vendor. Mullikin *v.* Latchem, 7 Blatch. 136; Hardesty *v.* Smith, 3 Ind. 39.

A purchaser who is sued upon his promissory note given for an interest in a patent, may set up as a defense that he was induced to purchase by means of false and fraudulent representations on the part of the vendor, as to the qualities, capabilities and usefulness of the invention, without returning or offering to reassign the patent. Groff *v.* Hansel, 33 Md. 161.

If a party falsely represents that he has a valid patent right, and thereby induces another to purchase it, when he knows that he has no such patent right, this is a fraud for which an action will lie. Bull *v.* Pratt, 1 Conn. 342.

A purchaser has a right to rely upon a representation made by the vendor as to what is covered by the patent, and if that is false he may rescind the sale. Rose *v.* Hurley, 39 Ind. 77.

A representation in regard to the durability, salability and cost of articles manufactured according to a patented design, is a mere matter of opinion, and will not vitiate a sale, even though it is false. Miller *v.* Young, 33 Ill. 354.

If the success of an invention is uncertain, and depends on future experiment, it is the subject of a chancing bargain, and the excess of the price over the value of the invention is no ground for rescinding the contract. West *v.* Morrison, 2 Bibb, 376.

If a purchaser, by false and fraudulent representations of the vendor in matters not known to him, and which are peculiarly within the knowledge of the vendor, is induced to make the purchase and give his note therefor, and would not have entered into the contract of purchase if it had not been for such representations, he may set up the defense of fraud to an action on the note. Bierce *v.* Stocking, 77 Mass. 174.

A defrauded vendee who has rendered perfect his right to claim a rescission in a court of equity, by a timely offer of rescission and tender back of the thing received by him under his purchase can not lose that right by mere declarations as to the value of the thing he had bought, nor by unavailing efforts to dispose of it, if such declarations and efforts did not in any way mislead or injure the vendor. Pierce *v.* Wilson, 34 Ala. 596.

A declaration of the price at which the patentee is in the habit of selling the machine is not such as will constitute fraud, although it is false. Williams *v.* Hicks, 2 Vt. 36.

If a party sells a thing as patented, when he has no patent, this is such fraud as will render void a bond given therefor. Brown *v.* Wright, 17 Ark. 9.

Although a purchaser knows that some of the vendor's representations are false, yet if he does not know that they are all false, he has not such full

knowledge of the fraud as will make an act amount to a ratification. Pierce *v.* Wilson, 34 Ala. 596.

If the purchaser was induced to take an assignment by the fraudulent misrepresentations of the patentee in regard to the subject of the sale, he is entitled to a rescission of the sale. Pierce *v.* Wilson, 34 Ala. 596; Hall *v.* Orvis, 35 Iowa, 366; Page *v.* Dickerson, 28 Wis. 694.

If the patentee correctly described and explained a prior invention, but drew from thence an incorrect inference in regard to the principles and similitude of the two inventions, a purchaser can not rely on this erroneous inference from premises correctly given as a ground for rescinding the contract. West *v.* Morrison, 2 Bibb, 376.

What constitutes a reasonable time within which a purchaser must elect to disaffirm a sale on account of fraud after the discovery thereof, must be determined from the circumstances of each particular case. Pierce *v.* Wilson, 34 Ala. 596.

A purchaser from an assignee can not have the assignment to his vendor rescinded for fraud because he was no party to that contract. Edmunds *v.* Hildreth, 16 Ill. 214.

The right to set aside an assignment for fraud belongs to the assignor alone, and can not be set up by third persons. Hoffheins *v.* Brandt, 3 Fish. 218.

A plea alleging a misrepresentation, which does not aver that the defendant relied upon it and entered into the contract believing it to be true, is bad. Saxton *v.* Dodge, 57 Barb. 84.

Fraud in obtaining a license may be set up in an action at law. Day *v.* New England Car Spring Co. 3 Liv. Law Mag. 44.

An assignee of the licensor may impeach a license on the ground that it was obtained by fraud. Day *v.* New England Car Spring Co. 3 Liv. Law Mag. 44.

Evidence of fraud in obtaining a license is competent against a party who purchases from the licensee. Day *v.* New England Car Spring Co. 3 Liv. Law Mag. 44.

Relief in Equity.

If a party purchases a patent right under the belief that it covers a certain machine when it does not, he may obtain a cancellation of the contract in a court of equity on the ground of the mistake. Burrall *v.* Jewett, 2 Paige, 134; *vide* Foss *v.* Richardson, 81 Mass. 303.

If there is no fraud in the sale of a patent, a court of equity will not interfere to relieve a party from liability upon his bond given therefor, although the patent is void. Cansler *v.* Eaton, 2 Jones Eq. 499.

If the patent is void, a court of equity will entertain a bill to compel the surrender and cancellation of a negotiable note given therefor. Darst *v.* Brockway, 11 Ohio, 462; Bellas *v.* Hays, 5 S. & R. 427.

If there is a mistake in an assignment, a bill in equity must aver that the assignee made a request for its correction, or a reason for its omission. Black *v.* Stone, 33 Ala. 327.

If the assignment is by mistake a mere blank deed, a court of equity will

not enjoin the collection of the notes given therefor unless the bill avers the insolvency of the assignor. Black *v.* Stone, 33 Ala. 327.

Where the assignee has sold a part of the territory, he can not have the contract rescinded in equity unless he tenders a return of what remains unsold and the value of that which has been sold. Edmunds *v.* Myers, 16 Ill. 207; Edmunds *v.* Hildreth, 16 Ill. 214.

An attorney appointed under an irrevocable power, coupled with an interest, and authorizing him to sell an invention in his discretion, is not a purchaser, but an agent. Calista E. Cox, 2 O. G. 491.

If a power of attorney authorizing the agent to assign the patent is general, he may assign it before the patent issues, if there is at that time no revocation thereof. G. Eveleigh, 1 O. G. 303.

The assignment of the invention or improvements does not convey the extended term, something more definite being necessary to indicate the intention of the parties to transfer the interest in the extension. Holmes & Spaulding, 6 O. G. 581.

If an instrument purports to convey inventions not yet in existence, it is not an assignment, but only an executory contract. Thomas Edison, 7 O. G. 423.

If an assignee owns the right to an extension, an assignment of all his right, title and interest will convey his right to the extension. John L. Mason, 1 O. G. 357.

An assignment by a corporation will pass a right that may be enforced in equity although its seal was omitted. John L. Mason, 1 O. G. 357.

SEC. 4899. Every person who purchases of the inventor, or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

Statute Revised—July 8, 1870, ch. 230, § 37, 16 Stat. 203.
Prior Statute—March 3, 1839, ch. 88, § 7, 5 Stat. 354.

The object of this provision is evidently twofold: 1st, to protect the person who has used the thing patented by having purchased, constructed or made the machine, &c., to which the invention is applied, from any liability to the patentee or his assignee; 2d, to protect the rights granted to the patentee against any infringement by any other persons. This relieved him from the effects of former laws and their construction, unless in case of an abandonment of the invention or a continued use for more than two years before the application for a patent, while it puts the person who has had such prior use on the same footing as if he had had a special license from the inventor to use

his invention, which, if given before the application for a patent, would justify the continued use after it issued without liability. M'Clurg *v.* Kingsland, 1 How. 202.

The words "machine or other patentable article" and "such invention," mean the "invention patented," and the words "specific thing" refer to "the thing as originally invented," whereof the right is secured by patent, but not to any newly invented improvement on a thing once patented. The use of the invention before an application for a patent, must be the specific improvement then invented and used by the person who had purchased, constructed or used the machine to which the invention is applied. M'Clurg *v.* Kingsland, 1 How. 202.

This section applies to an invention which consists in a new mode or manner of operating an old machine, or any of its parts, as well as to a specific machine. M'Clurg *v.* Kingsland, 1 How. 202.

If parties construct a machine before the application of the patentee for letters patent, under the belief authorized by him that he consents and allows them so to do, then they may lawfully continue to use the same after the date of the letters patent. Kendall *v.* Winsor, 21 How. 322.

The purchaser here spoken of is a purchaser not from a mere wrong-doer, but from the first and true inventor before he obtained his patent. Pierson *v.* Eagle Screw Co. 3 Story, 402; Hovey *v.* Stevens, 1 W. & M. 290; *vide* Troy Factory *v.* Odiorne, 17 How. 72.

A use by fraud and a piracy on the inventor, is not contemplated or protected under this section. Hovey *v.* Stevens, 1 W. & M. 290.

The Constitution and law taken together give to the inventor, from the moment of invention, an inchoate property therein, which is completed by suing out a patent. This inchoate right is exclusive. It can be invaded or impaired by no person. No person can, without the consent of the inventor, acquire a property in the invention. Whenever any person, previous to a patent, constructs a machine discovered by another, he constructs it subject to the rights of that other. Evans *v.* Jordan, 1 Brock. 248; S. C. 9 Cranch, 199.

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

notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

Statute Revised—July 8, 1870, ch. 230, § 38, 16 Stat. 203.
Prior Statutes—Aug. 29, 1842, ch. 263, § 6, 5 Stat. 544.—March 2, 1861, ch. 88, § 13, 12 Stat. 249.

The penalty imposed by the statute for a failure to mark patented articles is only the taking away of the right to recover damages in the suit. It does not affect the right to an injunction, either perpetual or provisional, as a remedy. Goodyear *v.* Allyn, 3 Fish. 374; S. C. 6 Blatch. 33.

It is for the defendant to show a failure by the complainant to mark the articles made or vended as required, and then the burden of proof is on the complainant to show that, before suit was brought, the defendant was duly notified that he was infringing the patent, and that he continued, after such notice, to make or vend the article patented. Goodyear *v.* Allyn, 3 Fish. 374; S. C. 6 Blatch. 33; *contra*, McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117.

If the complainant does not sell the patented articles, the objection that articles sold by others were not properly marked will be of no avail. Goodyear *v.* Allyn, 3 Fish. 374; S. C. 6 Blatch. 33.

SEC. 4901. Every person who, in any manner, marks upon anything made, used, or sold by him, for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

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

Statute Revised—July 8, 1870, ch. 230, § 39, 16 Stat. 203.
Prior Statute—Aug. 29, 1842, ch. 263, § 5, 5 Stat. 544.

The statute must be construed to mean that the article to which the word "patent" was affixed, if not patented, was patentable. As the statute is highly penal, it must receive a strict construction, and can not be held to embrace any act which, though within the strictness of its letter, is against reason and common sense. It would be doing injustice to the framers of the law to suppose they intended to include in its prohibitions, and to visit with a penalty, the mere act of putting the word "patent" on an article neither patented nor patentable. Novelty and utility are essential elements of every valid patent issued under the laws of the United States. It is clear that to justify a judgment for a penalty for putting the word "patent" on an article, the declaration must allege, and there must be proof on the trial, that it was legally the subject of a patent. U. S. *v.* Morris, 3 Fish. 72; S. C. 2 Bond, 23.

The plaintiff must prove beyond a reasonable doubt: 1st. That the defendant affixed the word upon the article; 2d. That the defendant has no patent; 3d. That the defendant affixed the word with the intent to deceive the public. Nichols *v.* Newell, 1 Fish. 647.

The statute forbids the affixing the word upon any article for the purpose of deceiving the public. The offense is committed by affixing the word for that purpose. If it is affixed to an article for that purpose, then the offense is complete, whatever disposition of the article may subsequently be made. On the other hand, if, when the word is affixed, it is with an innocent purpose, the offense is not committed, whatever new purpose the defendant may have at a subsequent period. Nichols *v.* Newell, 1 Fish. 647.

The simple act of marking the article indicating that it was patented when it was not, is not sufficient to constitute the offense. The marking must not only give the public to understand the fact of a patent, but the act must be done *malo animo* with an intent to deceive; and this ingredient of the offense which is essential to make it complete must be left to and found by the jury. Walker *v.* Hawxhurst, 5 Blatch. 494.

If the defendant gave instructions to his workmen to manufacture articles, and put on the word for the purpose of deceiving the public, and subsequently changed his views or wishes, but did not communicate this change to the workmen, this uncommunicated purpose or wish or intent will have no operation to prevent the affixing of the word by the workmen from being an affixing with the intent to deceive the public. Nichols *v.* Newell, 1 Fish. 647.

The conduct of a person when intent is to be ascertained, both before and after the act which is to be accomplished by it, may be gone into to determine what was his intent at the time of the act. Nichols *v.* Newell, 1 Fish. 647.

A man is to be held to intend that which is the necessary consequence of his acts, or what he infers will be the consequence of his acts. Nichols *v.* Newell, 1 Fish. 647.

The burden of proof is upon the plaintiff to establish beyond a reasonable doubt such facts as are necessary to constitute the offense. Nichols *v.* Newell, 1 Fish. 647.

The question of fraud or deceit, as a matter of fact presented in a case, involves an inquiry of much latitude and scope on the trial, and must generally be directed by the good sense of the judge in respect to the bearing of the

facts and circumstances relied on, and concerning which it is oftentimes difficult to apply any fixed rules. Very considerable indulgence is therefore allowed by the appellate court in revising these questions. The error must not only be striking, but must necessarily have been calculated to mislead the minds of the jury, before the verdict will be interfered with. Walker *v.* Hawxhurst, 5 Blatch. 494.

If the word "patent" is put on in any way, it answers the description. Nichols *v.* Newell, 1 Fish. 647.

The marks are just as much upon the article when put upon one part of it as upon another. Nicholls *v.* Newell, 1 Fish. 647.

The action can not be prosecuted in the name of the United States alone. It should be prosecuted by an informer; or if the name of the United States can be properly used, it must be in connection with a person to be named as informer, who shall be responsible, in case the action is not sustained, for costs or other consequences resulting from its failure. U. S. *v.* Morris, 3 Fish. 72: s. c. 2 Bond, 23.

This section authorizes the infliction of a penalty of just one hundred dollars, and such penalty may be recovered in an action of debt. Stimpson *v.* Pond, 2 Curt. 502.

The action may be brought at any time within five years after the commission of the offense. Stimpson *v.* Pond, 2 Curt. 502.

SEC. 4902. Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the patent office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the no-

tice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

Statute Revised—July 8, 1870, ch. 230, § 40, 16 Stat. 203.
Prior Statutes—July 4, 1836, ch. 357, § 12, 5 Stat. 121.—March 2, 1861, ch. 88, § 9, 12 Stat. 247.

A caveat is intended to answer a double purpose; 1st, to give notice of the caveator's claim as inventor; 2d, to prevent a patent issuing to another for the same thing. Allen *v.* Hunter, 6 McLean, 303; American Pavement Co. *v.* Elizabeth, 6 Fish. 424; S. C. 3 O. G. 522.

This section was introduced for the benefit of the inventor, but is not necessary to the preservation of his right. It only enables him to have notice of any interfering application. Heath *v.* Hildreth, Cranch Pat. Dec. 96.

The effect of the caveat is to protect the claim of an inventor from all interfering applications made within one year after its filing, by requiring the office to notify him of such application, that he may resist the interference, if he chooses. Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212.

If, during the time which elapses between the filing of his caveat and his application, the inventor allows his invention to go into public use, his caveat will not protect him. Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212.

The purpose of the caveat is to save the discoverer from the effect of the rule of law which gives to the inventor that first adapts his invention to practical use the right to the grant of the patent. Phelps *v.* Brown, 1 Fish. 479; S. C. 4 Blatch. 362.

If the inventor has not perfected his invention, and does not use due diligence to carry it into effect, and, in the mean time, before he gets his patent, somebody else invents and uses the invention, and incorporates it into a practical, useful machine, then he can not, by a subsequent patent, appropriate to himself what has thus been embraced in a machine between his caveat and the obtaining of his patent. Johnson *v.* Root, 1 Fish. 351.

In considering the question of reasonable diligence, it is not sufficient to answer that the patentee used diligence in relation to some other invention or machine. The question is, Did he use diligence in perfecting the invention mentioned in the caveat? Johnson *v.* Root, 1 Fish. 351.

The question of diligence is not an absolute but relative one, and must be considered in reference to the subject-matter of the experiments. American Pavement Co. *v.* Elizabeth, 6 Fish. 424; S. C. 3 O. G. 522.

The granting of a patent while a caveat is pending and in force does not render the patent void. Cochrane *v.* Waterman, Cranch Pat. Dec. 121.

If the commissioner accidentally overlooks a caveat filed before the application by another party, he may issue a patent to the caveator even after the granting of a patent to such other party, in order to give him an opportunity to correct the error. He should not be prejudiced by the accidental omission to give him notice. Phelps *v.* Brown, 1 Fish. 479; S. C. 4 Blatch. 362.

A caveat is not conclusive evidence that the invention was not perfected, for it may happen that a person may choose to file a caveat while he is going on and making improvements upon an invention which he has already completed, so as to be of practical utility. Johnson *v.* Root, 1 Fish. 351.

The granting of a patent being a public act, the caveator is bound to take notice of it, and to file his application within a reasonable time thereafter. Lewis Hillebrand, 2 Dec. Com. 145.

No inference can be drawn from a caveat as to the date of an invention, unless the caveat describes it. Wheeler *v.* Peters, 2 Dec. Com. 141.

If a caveat and an application for a patent are filed upon the same day, and for the same invention, it will be presumed they were filed simultaneously, and the caveator will be notified. J. Essex, 9 O. G. 497.

If a conflicting caveat is in force when an application is filed, though the application is rejected, and the rejection is not set aside until after the caveat has expired, yet the caveator is then entitled to be notified. J. Kenny, Sr. 1 Dec. Com. 97.

A caveator who has been notified of an application claiming the same invention, is entitled to no special indulgence on that account, if he neglects to apply for a patent for ten months after one has issued to the other party. Wheeler *v.* Rank, 2 Dec. Com. 119.

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

Statute Revised—July 8, 1870, ch. 230, § 41, 16 Stat. 204.
Prior Statute—July 4, 1836, ch. 357, § 7, 5 Stat. 119.

The specification is always open to amendment of its description and claims, and to the addition of new matters of description and new claims where the drawings and model exhibit the matters involved in the amendments and additions, and this privilege continues until the matter of the application is finally disposed of by the granting of a patent or otherwise. Singer *v.* Braunsdorf, 7 Blatch. 521.

The right to change the specification exists, and may be exercised independently of the suggestions of the commissioner at any time before the commissioner has given his formal judgment upon the application. Godfrey *v.* Eames, 1 Wall. 317.

If an application is pending for a patent for several improvements, a new application may be made for a patent for one of them, for it simplifies the application and disembarrasses it from its connection with other improvements claimed. Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315.

After a first rejection the applicant may insist upon his claim as presented. If the examiner reaffirms his former decision, without supporting it with fresh references, the rejection is final, and there is no remedy but appeal. But if the examiner gives new references, the applicant has a right to reply to them, or to amend his specifications. Alice Appleton, 1 Dec. Com. 8.

After an application has been finally rejected on an appeal to the court, it is within the discretion of the commissioner whether any amendment of it shall be allowed. Whiteley & Gage, 1 Dec. Com. 53.

If an inventor files an application as a substitute for one previously appealed to the examiners in chief, and by them rejected, the primary examiner should examine it on its merits, and not reject it merely because he deems it identical with the one rejected by the examiners in chief. W. H. Le Van, 1 O. G. 226.

References, as affording grounds for rejecting a claim, should be cited on demand, in preference to offering a mere legal opinion. Fairbanks & Robinson, 3 O. G. 65; Albert D. Davis, 6 O. G. 297.

The rejection of an application having been affirmed upon a former occasion in consequence of misapprehending the construction of the machine under consideration, the case was reconsidered upon the error being corrected. Powers & Stevens, 1 Dec. Com. 81.

No amendment should be allowed in original applications which change the character of the invention essentially; but amendments may be made, although more than two years have elapsed after the application was filed. Wm. C. Dodge, 3 O. G. 179.

It is only those changes that affect the substance or materiality of an invention that are objectionable as new matter. William B. Carlock, 8 O. G. 191.

In amending original applications it will not be considered as the introduction of new matter, if the subject is embraced either in the model, drawing, or specification. J. F. W. Dorman, 9 O. G. 1061.

After an application has been filed it can not be amended by inserting the description of a modification of the combination claimed which is not shown in the original model or drawings. L. J. Knowles, 2 Dec. Com. 161.

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

Statute Revised—July 8, 1870, ch. 230, § 42, 16 Stat. 204.

Prior Statutes—Feb. 21, 1793, ch. 11, § 9, 1 Stat. 322.—July 4, 1836, ch. 357, § 8, 5 Stat. 120.

How the commissioner is to obtain information of the interfering patent is not provided for in the statute, and hence the matter is necessarily left to his discretion to obtain it in the best way that he can. If the party interested may know of the application, he can bring the interference to the notice of the commissioner, or if the commissioner happens to recollect the issuing or existence of the previous patent, he may act upon that information. It would be very unreasonable to require him to recollect all the previous patents at the time that might interfere with the one applied for, or to require the party interested to know that an application was pending in the office for a patent interfering with his. Potter *v.* Dixon, 2 Fish. 381; S. C. 5 Blatch. 160.

A man may have letters patent issue to him individually, for that which he has claimed as a joint invention with another, and he is not estopped by such joint patent from claiming an interference. Crocker's Case, 2 A. L. T. 129.

A reissue can not be withheld on the ground that an interfering application was filed after the granting of the original patent. Thomas J. Mayall, 11 O. G. 1107.

Priority of invention is the only question that can be heard or determined on an interference. United States *v.* Commissioner, 7 O. G. 603.

When the application is for a combination, form and structure become substance, and an admission that one is different in its form and structure from another, is an admission of a fact which is *prima facie* evidence that there is no interference between the two. Bain *v.* Morse, 6 West. L. J. 372.

The decision of the patent office, after an interference has been declared between an application and a prior patent is not conclusive or final. Union Paper Bag Co. *v.* Crane, 1 Holmes, 420; S. C. 6 O. G. 801.

A statement made by an inventor to the patent office as to the date of his invention does not estop him from setting up a prior date in an action under this section. Union Paper Bag Co. *v.* Crane, 1 Holmes, 420; S. C. 6 O. G. 801.

If an interference is declared, and the examiner in chief on appeal suspects from the evidence that the applicant has abandoned his invention to the public, and that question is referred to an examiner, the owner of the prior patent can not appeal from the decision of the examiner on that point. United States *v.* Commissioner, 7 O. G. 603.

A notice to produce the deposition before a commissioner for inspection is not a waiver of a want of notice, although the opposite party offers to produce the witnesses for cross-examination. Perry *v.* Cornell, Cranch Pat. Dec. 130.

If there is an informality in the transmission of the deposition, the commissioner may postpone the hearing in order to enable the party to cure the defect. Smith *v.* Flickenger, Cranch Pat. Dec. 116.

An objection to the insufficiency of the time between the notice and the taking of the deposition, can not be considered unless it is taken at the hearing. Smith *v.* Flickenger, Cranch Pat. Dec. 116.

If the person who takes the deposition omits to state that it was sealed up by him, it can not be used. Arnold *v.* Bishop, Cranch Pat. Dec. 103.

The rules, so long as they remain unabrogated, are as binding on the commissioner as the law itself. Arnold *v.* Bishop, Cranch Pat. Dec. 103.

A party who appears and cross-examines a witness, can not object to the shortness of the notice of the time of taking the evidence. Arnold *v.* Bishop, Cranch Pat. Dec. 103.

Interference.

If one party claims a process and the other the product thereof, the claims interfere, for either by amendment or reissue may insert the claim of the other. Finley *v.* Chapman, 1 O. G. 277.

The descriptive phrases "interlaced ruled lines" and "any of the known means of pen-ruling" are co-extensive. Duthie *v.* Casilear, 1 O. G. 255.

Although a patent has been issued to another for substantially the same thing during the pendency of the application, yet the applicant is not entitled to a patent without being required to prove priority of invention in an interference with the existing patent. William Price, 1 O. G. 574.

If the final fee has been paid and nothing remains to be done but issue the patent, it will not be withheld for the purpose of declaring an interference with another application filed subsequent to the rendition of the judgment. Wright et al. *v.* Reese, 11 O. G. 329.

An interference is properly declared where no claim can be made upon the device of the party first in the office, which would not be embraced in that of the other party. Bacheller *v.* Porter & Bancroft, 1 Dec. Com. 64.

There can be no conflict between devices intended as improvements upon an original device, but not upon each other, where they perform the same result, but differ in their method of performing it, which is their principal operation, as much as they differ from the original. Barton *v.* Babcock et al. 1 Dec. Com. 67; Fletcher *v.* Abraham, 2 Dec. Com. 26.

If an application is filed for a mechanical patent for a construction, and if a design for which a patent has been granted can be produced only by that construction, an interference should be declared. Collender *v.* Griffith, 3 O. G. 91; S. C. 3 O. G. 267.

A patent will be issued without giving notice to parties whose applications for a similar invention have been previously rejected. Casilear & McIntire, 8 O. G. 474; *contra*, Rouse & Stoddard, 7 O. G. 169.

It is not necessary to an interference that the combination of each party should consist of elements identically the same in form, so long as the combinations are equivalents in arrangement and operation. Withington *v.* Locke, 11 O. G. 417.

The question of novelty should be settled in all cases before an interference is declared, but if it is made an issue subsequently, it can not be ignored. Wood *v.* Morris, 3 O. G. 239.

An interference should be declared where a device claimed in an application is shown in a patent though not claimed. E. S. Wright, 2 Dec. Com. 60.

If an application is found to conflict with two or more patents, an interference should be declared, including all the parties, and not a separate interference with each patent. Wilson et al. *v.* Yakel et al. 10 O. G. 944.

Where one party claims broadly an element when used in any composition of a certain class, and another claims the same element when used in a particular composition of that class, an interference must be declared. Boon *v.* Hinman, 2 Dec. Com. 7.

An interference will not be declared between a pending application and an application which has been forfeited, and upon reference to which it has been rejected. James Spear, 5 O. G. 201.

If claims are introduced into an application for a reissue, which are in conflict with a patent granted upon an application filed after the other patent

issued, an interference will be declared. Mayall *v.* Murphy & Schenck, 5 O. G. 339.

An interference should be declared where reference is made to a rejected joint application, and the question decided according to the rules. John B. Welpton, 3 O. G. 440.

An application for reissue can be put in interference with a patent granted prior to the filing of the original application. Carroll *v.* Morse, 9 O. G. 453.

An interference can not be declared between a reissue application and an application filed after the granting of the original patent. Becker *v.* Throop, 8 O. G. 1; Paris *v.* Busey, 8 O. G. 859; *contra*, Sargent & Burge, 10 O. G. 285.

Failure to make objections before the expiration of the time for filing preliminary statements will be considered as a waiver thereof and consent to the interference. Anson *v.* Woodbury, 11 O. G. 243.

Preliminary Statement.

Neither the name of an applicant nor any particulars of his invention will be communicated to a patentee with whom he has been placed in interference until the patentee files his preliminary statement. Spalding & Aldrich *v.* Winchester, 3 Dec. Com. 94.

The office is responsible if a defective preliminary statement is received as sufficient; but if the adverse party takes no exception to it the defect is cured. White & Farmer, 5 O. G. 338.

Since parties are allowed in their preliminary statements to fix the date of their invention, it is proper they should be restricted to a substantial adherence thereto in an interference proceeding. Walpuski *v.* Jacobsen & Faber, 9 O. G. 964.

A preliminary statement can not be amended to change the date of the invention after the party has closed his testimony. Guest *v.* Finch, 10 O. G. 165; Cheesebrough *v.* Tappan, 1 O. G. 464.

Amendments of preliminary statements are allowed only before the statement of the opposite party is disclosed to the one making the amendment, or upon requirement of the commissioner, when the same are indefinite, before testimony is taken. Guest *v.* Finch, 10 O. G 165.

An amendment of a preliminary statement in respect to essential matter can not be allowed after testimony has been taken, or after each has learned the other's dates. Oliver *v.* Qeller, 10 O. G. 416.

An amendment to a preliminary statement, setting up an earlier date than that originally established will not be regarded. Cutting *v.* Kaylor, 2 O. G. 704.

If one is proved not to have been of sound mind when making the preliminary statement, it may be amended or disregarded as equity may seem to warrant. W. D. Brooks, 6 O. G. 296.

Examiner of Interferences.

It is a matter wholly within the discretion of the commissioner what questions arising out of interference cases shall be decided by the examiner of interferences or some primary examiner. Weitling et al. *v.* S. G. Cabell et al. 2 O. G. 223.

The interference must be heard, in the first place, by the examiner of interferences, whether the issue is made up by the principal examiner or commissioner. Farnsworth *v.* Andrews, 9 O. G. 195.

The law does not make the examiner of interferences a judge of the

novelty of devices before him in interference; but it is made his duty to suspend an interference whenever it appears to him that an insufficient examination has been made, or a new reference has been discovered. Neubocker *v.* Schafhaus, 4 O. G. 319; Little *v.* Lillie, 10 O. G. 543; Anson *v.* Woodbury, 11 O. G. 243.

Evidence.

The only matters at issue in an interference is priority of invention to which the question of originality as between the parties is sometimes germane. Miller *v.* Miles, 11 O. G. 197.

An inventor who has taken out a patent in good faith, should not have his invention crippled by additional patents for improvements which naturally suggest themselves to every mechanic who is employed to manufacture them. Earles & Hoyt *v.* Dunderdale, 3 Dec. Com. 174.

In an interference between a patent and a subsequent application, the patent affords a *prima facie* presumption of priority of invention in favor of the patentee. Paul & Dorland, 4 O. G. 552; Busha *v.* Phelps et al. 9 O. G. 1010; Palm *v.* Behel, 10 O. G. 701: Cushman *v.* Parham, 9 O. G. 1108; Sargent *v.* Burge, 11 O. G. 1055.

Where it appears in an interference between an application and a patent, that the patent had been granted during the pendency of the application without an interference, the parties should be treated as if both were applicants. Goodman *v.* Scribner, 2 O. G. 673; Smith *v.* Barter, 7 O. G. 1.

If two conflicting applications are pending in the office at the same time, and a patent is issued upon one of them by mistake, without declaring an interference, the rights of the parties will be determined as if both were applicants. Brookfied & Hemingray *v.* Brooke, 4 O. G. 81; Smith *v.* Barter, 7 O. G. 1.

The rights of a prior applicant will not be prejudiced by reason of a patent being issued inadvertently to a subsequent applicant, and the burden of proof rests upon the latter in trial of interference. Gordon *v.* Withington, 9 O. G. 1010.

The *prima facie* case made by a patent having been overcome by evidence of prior invention by the applicant, the burden of proof shifts, and the patentee is required to prove an earlier date in order to establish priority. Hazelip *v.* Richardson, 10 O. G. 747.

If the contest is one of originality, the burden of proof is upon the one charging fraud. Perrine *v.* Goldsworthy, 10 O. G. 980.

If testimony taken upon an interference tends to set up an earlier date for the invention than was claimed in the preliminary statement of the same party, it must at least be viewed with grave suspicion. Tegmeyer *v.* Bell, 3 Dec. Com. 285.

There is nothing in the character of the rights to be determined that precludes the application of the well-established doctrine of estoppel. Berry *v.* Stockwell, 9 O. G. 404.

Testimony taken by parties to an interference, simply to destroy the right of either party to a patent, is not taken in accordance with any provision of law. Smith *v.* Perry et al. 9 O. G. 688.

A patent should not be granted which would be in conflict with one already issued, unless upon such proof that the applicant is the prior inventor as would defeat an action at law for an infringement of the patent before granted. Gray *v.* Hale, 3 Dec. Com. 129.

In an interference, the party upon whom the burden of proof rests must show that he had reduced his invention to a complete form prior to the invention of the same by the patentee. McKnight *v.* Van Wagenen, 9 O. G. 1161; Cooke *v.* Chamberlain et al. 10 O. G. 825.

Drawings prepared for the hearing of the interference are of little weight, though accompanied with proof that they represent such as existed before. Purdy *v.* White, 1 Dec. Com. 22.

The claim of an applicant for a device which has been previously patented to another should be allowed only when the proof absolutely requires it. John W. Cochran. 1 Dec. Com. 30; Wheeler *v.* Chenoweth, 1 Dec. Com. 43; Gates et al. *v.* Benson, 2 Dec. Com. 65.

The acknowledgment of one inventor that the right to a patent is in another, is not, after its grant to him, a bar to a subsequent grant of a patent for the same thing to the inventor. Allen *v.* Gilman, 1 O. G. 293.

Merely oral testimony advanced after an opponent has successfully made the invention, and introduced it into practice, is not sufficient to establish priority, unless of the most undoubted character. Lagowitz *v.* Topham, 9 O. G. 742.

In an interference, the claim of a draughtsman to an invention which he has been employed to put into shape is to be viewed with suspicion. Doughty *v.* Clark, 1 Dec. Com. 14; Spofford *v.* Moore, 2 Dec. Com. 6.

The deliberate admission of one party that the invention was another's, for which he was entitled to receive a patent, is conclusive, and can not be avoided in an interference. Jeffers *v.* Duchemin, 2 Dec. Com. 93; Hewins *v.* Spooner 2 Dec. Com. 94; J. W. Cochran, 3 Dec. Com. 78; Hawkins *v.* Lambert, 3 Dec. Com. 273; Harlow *v.* Guernsey, 7 O. G. 513.

The ordinary rules of evidence in the United States courts will be followed and adopted in interference cases. Berry *v.* Stockwell, 9 O. G. 404.

There is a presumption in favor of a patentee upon an interference with an applicant that is not overcome by testimony which only raises a doubt in favor of the latter. Smith *v.* Burlew, 2 Dec. Com. 41; Stoddard & Perry, 6 O. G. 33.

A preliminary statement is competent evidence against the party who filed it. Anson *v.* Woodbury, 12 O. G. 1.

Ex parte affidavits taken by an adverse party can not be used to affect the rights of an applicant. Anson *v.* Woodbury, 12 O. G. 1.

The commissioner, without proof, will take notice of matters of public notoriety. Anson *v.* Woodbury, 12 O. G. 1.

An exhibit relied upon by one party to prove that an invention was made at a certain previous time, must show the feature of the invention as described in the claims of the litigant parties. Kendall & Trested *v.* Scrymgeour, 2 O. G. 705.

The admissions of a party may be received in evidence against him, but in such case the whole statement containing such admissions is to be taken together. Hussey *v.* Van Wagenen, 10 O. G. 942.

The parties in their proofs are confined to the dates set up in their preliminary statements. Merrill *v.* Glidden, 11 O. G. 196.

Evidence which has reference to the acts or proceedings of third parties in regard to inventions not those of the parties to the controversy are irrelevant and immaterial. Miller *v.* Miles, 11 O. G. 197.

An allegation that the model has been changed since it was originally filed must be strictly proved. Merrill *v.* Glidden, 11 O. G. 196.

The question which of the parties on the record is the first inventor, is the only one to be tried upon an interference. Pugh *v.* Hamilton, John, et al. 2 Dec. Com. 153; Crane & Rogers, 3 Dec. Com. 230; Dana *v.* Greenleaf & Adams, 9 O. G. 198; Smith *v.* Perry et al. 9 O. G. 688.

If a public use is proved in the first interference, occurring more than two years prior to the filing of the new application, it affords good ground for rejecting the latter. Ritchel *v.* De Ganno, 10 O. G. 941.

The date of filing an application is not conclusive of the date of invention, but may be disproved by testimony introduced in rebuttal. Chapman *v.* Candee, 2 O. G. 245.

Testimony taken in rebuttal to show use of the invention at another place than at the establishment during the time mentioned is properly rebutting and not direct evidence. Chapman et al. *v.* Morison, 8 O. G. 1031.

Where one party to an interference took no evidence upon the question of priority in opening his case, he will not be allowed to use any taken in rebutting. Neal & Adams *v.* Daniels, 3 Dec. Com. 156.

The evidence by which a party to an interference establishes his case when taking his rebutting testimony is admissible, the other party making no objection, but admitting the same facts upon cross-examination. Michael *v.* Kenney, 2 Dec. Com. 140.

Dissolution.

Where the proof shows that neither party made the invention, the question of priority is at an end, and there can be no further interference. Weston *v.* Hunt & Turner, 3 Dec. Com. 68; Pugh *v.* Hamilton, 3 Dec. Com. 116; Waters et al. *v.* Yost et al. 8 O. G. 517.

An interference will be dissolved where the inventions are shown to be radically different, and designed for different purposes. Jackson *v.* Nichols, 3 Dec. Com. 278; J. W. Evans et al. 3 O. G. 180; Sherwood *v.* Searles, 1 Dec. Com. 112; Stearns *v.* Wingfield, 3 Dec. Com. 67; Pearl & Sawyer, 5 O. G. 694.

An interference will not be dissolved upon *ex parte* affidavits showing a public use and sale for more than two years prior to the application. Wyman *v.* Knowles, 11 O. G. 196.

An interference will be dissolved if it appears that the claim of one of the parties put in issue was not shown or described in the other application. Dodd *v.* Cobb, 10 O. G. 826.

An interference will be dissolved when it is discovered the invention in controversy is not patentable. Lynch & Raff *v.* Dryden & Underwood, 3 O. G. 407; Dunton, Young & McFerran, 10 O. G. 243.

When it appears from the preliminary statement that the party making it has abandoned his invention, or is not entitled to a patent for any other reason, the interference will be dissolved, and his application will be rejected. Schenck *v.* Rider, 2 Dec. Com. 135.

Where all the parties claim nothing but what is shown to be old, the interference will be dissolved, although some of them show novel features in their arrangements. Kafer & Gould *v.* Dennison, 1 Dec. Com. 14.

When, in the judgment of the examiner of interferences, the interference has been improperly declared, and the case has passed beyond the jurisdiction of the primary examiner, it may be referred to the commissioner in person. Lloyd *v.* Engeman, 2 O. G. 674.

An interference between an applicant for a patent on one hand, and two joint applicants on the other, will be dissolved, if it proves that one alone of the joint applicants made the invention before the adverse party. Weston *v.* Hunt & Turner, 3 Dec. Com. 68; Pugh *v.* Hamilton, 3 Dec. Com. 116; Crane & Rogers, 3 Dec. Com. 230.

A party to a pending interference can withdraw only such claims as cover devices not involved in the interference, so that, if he obtains a patent for them on a separate application, it shall not prejudice the interests of the other party. Hermance *v.* Bussey, 3 Dec. Com. 216.

If an interference is dissolved upon the withdrawal of his application by

one of the parties, this does not entitle the other to a decision in his favor on the question of priority. Eames *v.* McDougall, 3 Dec. Com. 206.

After the declaration of an interference it can not be dissolved, except by the order of the examiner in charge of interferences, or the commissioner, or by the board of examiners in chief or commissioner on appeal. Traut *v.* Disston, 2 Dec. Com. 99.

A motion to dissolve an interference on the ground that the applicant's invention is not patentable, may be made before the examiner of interferences after the testimony has been taken. Lynch *v.* Dryden, 3 O. G. 407.

During an interference, the primary examiner may request its suspension for the purpose of considering new references. Anson *v.* Woodbury, 11 O. G. 243.

If the claim in interference is broader in scope than the special devices shown by any of the parties, the subject-matter involved can not be limited to just what is shown by either of said parties. Lacroix & Welch, 4 O. G. 526.

Rehearing.

A motion to open an interference for a rehearing, after a decision, will be refused where there is gross negligence in preparing for it. Covel *v.* Maxim & Radley, 1 Dec. Com. 78; Aldrich & Spalding *v.* Bingham, 3 Dec. Com. 90; Hamilton *v.* Fisher, 3 Dec. Com. 271.

A motion to open an interference for a rehearing will be granted when new evidence has been found which is material to the issue. Disston *v.* Emerson, 2 Dec. Com. 84.

To entitle a party to a reopening of his case, on the ground of newly discovered evidence, it must be shown that it was either discovered since the case was decided, or could not have been earlier obtained. Merrill & Merrill *v.* Glidden, 10 O. G. 862.

If it appears that the testimony was not newly discovered, but was in the possession of the party from the beginning of the proceedings, an interference will not be reopened. William S. Gillen, 11 O. G. 419.

A rehearing in an interference case can only be granted on a showing of such merits as would entitle a mover to a new trial in a suit at law. L. C. Pattee, 2 O. G. 618; Marsh *v.* Dodge, 2 O. G. 643; Dod *v.* Cobb, 10 O. G. 462; Merrill & Merrill *v.* Glidden, 10 O. G. 863.

A case will not be reopened merely to oblige a party who has purchased an interest in an invention which was, unknown to the party, in interference. Mason, Imlay & Co. 2 O. G. 274.

Decision.

Where one of two, who have taken out a joint patent as joint inventors, files an application claiming the same invention as made by himself alone, the patent will not be disturbed if the facts are disputed. De Lill *v.* Avery, 2 Dec. Com. 128; Joseph Barsaloux, 9 O. G. 883.

Judgment of priority is conclusive not only on interfering matters which were claimed, but on all which might have been claimed. Harlow *v.* Guernsey, 7 O. G. 513; Whiteley *v.* McCormick, 10 O. G. 826.

Where each applicant claims to have made the invention several years previous to their applications, and one has been steadily making and selling the article, no patent will be issued to either. Love *v.* Howe, 1 Dec. Com. 66.

Where there is a doubt whether the only invention to which the successful party in an interference is found to be entitled is new, his application should be referred back to the examiner to investigate the question. Hovey *v.* Hufeland et al. 2 O. G. 493; Wood *v.* Morris, 4 O. G. 131.

After the determination of an interference a new one should not be declared without the order of the commissioner. Hovey *v.* Muller, 3 O. G. 149.

Whether the party to whom priority of invention is awarded shall receive a patent is not to be decided by the interference proceeding, but as an *ex parte* matter. Little *v.* Lillie, 10 O. G. 543.

The decision upon an interference does not establish the rights of the parties, so as to preclude the office from examining into them again on new grounds, while their applications are still pending. Abraham *v.* Fletcher, 1 Dec. Com. 50.

The commissioner may declare more than one interference, and a hearing and decision between the applicant for a patent and A., whether in favor of one or the other, forms no rule for a decision between the applicant and B. in the case of an interference declared. The proceedings are independent and *inter alios*. Potter *v.* Dixon, 2 Fish. 381.

If the examiners in chief discover a reason not given by the primary examiner why a patent should not issue, they should not remand the case to him, but should make a statement to the commissioner. William S. Smoot, 11 O. G. 1010.

SEC. 4905. The commissioner of patents may establish rules for taking affidavits and depositions required in cases pending in the patent office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

Statute Revised—July 8, 1870, ch. 230, § 43, 16 Stat. 204.
Prior Statutes—March 3, 1839, ch. 88, § 12, 5 Stat. 355.—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

SEC. 4906. The clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the patent office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such district or territory, commanding him to appear and testify before any officer in such district or territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him.

Statute Revised—July 8, 1870, ch. 230, §§ 44, 45, 16 Stat. 204.
Prior Statute—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

SEC. 4907. Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

Statute Revised—July 8, 1870, ch. 230, § 45, 16 Stat. 204.
Prior Statute—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

SEC. 4908. Whenever any witness, after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna, may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpœna, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpœna; nor for refusing to disclose any secret invention or discovery made or owned by himself.

Statute Revised—July 8, 1870, ch. 230, §§ 44, 45, 16 Stat. 204.
Prior Statute—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief; having once paid the fee for such appeal.

Statute Revised—July 8, 1870, ch. 230, § 46, 16 Stat. 204.
Prior Statutes—March 2, 1861, ch. 88, §§ 2, 3, 12 Stat. 247.—June 27, 1866, ch. 143, § 1, 14 Stat. 76.

If the examiners in chief decide that the applicant was the prior inventor, and then remand the case to the primary examiner to inquire whether he has abandoned his invention, the other party can not appeal from the latter decision. Bigelow *v.* Thatcher, 2 McArthur, 24.

When the applicant appeals, the case is closed before the primary examiner, unless it is regularly remanded with leave to amend, or with directions for a further examination. If it is so remanded, the case is reopened below, and can not return to the appellate court until the applicant has responded to the new examination, either by amendment or fresh appeal. Alice Appleton, 1 Dec. Com. 8.

When a case is appealed to the examiners in chief, the primary examiner loses jurisdiction over it, except to enter such amendment of the specification as may be required by the board, and pass the case for issue, and can not require any other amendment. H. J. Brunner, 1 O. G. 303.

The applicant, in taking an appeal from the primary examiner, can not add amendments to the claim which were not considered by him. H. Hammond, 2 O. G. 57; Barker & Mack, 4 O. G. 155.

An appeal to the examiners in chief lies only from such action of the primary examiner, as is judicial in its nature, that is, such as respects the patent-

ability, novelty, or utility of an invention. John A. Krake, 1 Dec. Com. 100; Richard L. Morton, 3 Dec. Com. 169.

The appeal to the examiners in chief, is to be taken from the decision or judgment of the principal examiner, not from the reasons he assigns for it. A. C. Rockwell, 2 Dec. Com. 111.

The board of examiners in chief, is the judge of the sufficiency of the reasons of appeal. Charles L. Young, 8 O. G. 643.

The board is limited in its revision of cases appealed from the decisions of the primary examiners to the record presented by the appeal. John T. Jones, 5 O. G. 58.

If it is denied that any improvement has been made in an invention, the the objection goes to the merits, and an appeal may be taken to the examiners in chief. Henry C. Sergeant, 9 O. G. 963.

Where the examiner alleges that a device is in common use, the applicant may ask for more specific references; but if he does not, he admits the allegations to be true. Ellis & Albertson, 1 Dec. Com. 8.

No case should be appealed until it is in such condition that a patent may at once issue if the examiner be reversed. H. Mewes, 2 O. G. 617.

Objections should be specific and accompanied with the grounds for them, so that amendments can be made and appeals taken upon definite points. H. H. Evarts, 5 O. G. 429.

If an examiner finds that the claims in an application are the same as those which have been condemned in a former case by the examiners in chief, he should reject it on the authority of their decision; he should not refuse to examine it. D. M. Nichols, 2 Dec. Com. 71; Duthie *v.* Casilear, 2 Dec. Com. 99.

All special amendments approved for examination by the board or commissioner, are subject to revision or restriction by the principal examiner in the same manner as original amendments. Duncan S. Farquharson, 10 O. G. 702.

If a case is remanded to the examiner for further consideration, he should consider and report upon the specific points raised by the board only. D. M. Kirkbride, 9 O. G. 1109.

Cases which have been heard and decided by the examiners in chief will not be reheard by them, except upon the order of the commissioner. Edwin Strain, 2 Dec. Com. 75.

If the rejection of the application is on the ground that it does not present the proper subject-matter for a patent, the appeal should be to the board of examiners, and not to the commissioner. Otto Pressprich, 11 O. G. 195; Henry M. Underwood, 1 O. G. 551.

If the primary examiner rejects an application for a patent for a combination, because the arrangement is not patentable as a combination, no references should be cited until the question of form is settled, and an appeal lies to the commissioner although they are. Daniel J. La Duc, 1 O. G. 549; L. L. Ellis, 9 O. G. 1110.

The reasons given by the examiner that go to the merits of the case for his rejection, can not be brought before the commissioner of patents on interlocutory appeal. David Edwards, 9 O. G. 793.

Objections as to new matter in a reissue, and to the character of a combination, relate to the merits, and are not proper subjects of an interlocutory appeal. Jeremiah Keith, 9 O. G. 744.

Only such matters as affect office practice, and are interlocutory in their nature, are appealable direct to the commissioner. D. L. Proudfit, 10 O. G. 585.

If a claim is rejected for want of clearness in not defining any invention whatever, an appeal lies to the commissioner. A. Godillot, 6 O. G. 641.

An appeal from the decision of a principal examiner, requiring the division

of an application, must be taken to the commissioner in person. Linus Yale, Jr. 1 Dec. Com. 110; Leopold Lehman, 2 Dec. Com. 70.

If the question decided by the examiner, is that the claim is for a function merely, an interlocutory appeal will lie to the commissioner of patents. Jeremiah Keith, 9 O. G. 793.

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

Statute Revised—July 8, 1870, ch. 230, § 47, 16 Stat. 205.
Prior Statute—March 2, 1861, ch. 88, § 2, 12 Stat. 247.

If the applicant has made an assignment which leaves him merely an equitable interest, he can not take an appeal. Martin *v.* Olney, 9 O. G. 1107.

Where the commissioner has been counsel in a case, no examination of the merits will be entered into, but the decision of the examiners in chief will be affirmed, *pro forma*. Waters *v.* Taylor, 1 Dec. Com. 21; Fortin & Drake, 1 Dec. Com. 26.

In an interference, the question of novelty should first be disposed of, and when that question is raised it controls the matter of jurisdiction of the commissioner in deciding upon the rights of the parties. Bennage *v.* Phillippi, 9 O. G. 1159.

Upon a question of fact arisiug in an interference, the conclusions of the principal examiner, and of the examiner in chief are entitled to consideration, and the benefit of a doubt will be given to their finding. Fawcett *v.* Graham, 1 Dec. Com. 113.

Cases will not be taken up out of their turn, upon appeals to the commissioner, even where inventors come in person to attend to their applications. Hewins *v.* Spooner, 2 Dec. Com. 94.

It is a rule of long standing that a case deliberately decided by one commissioner will not be disturbed by his successor. John L. Mason, 2 Dec. Com. 20.

Upon appeals to the commissioner, additional evidence may be introduced sustaining the right to an extension. Samuel G. Lewis, Ex'r, 2 Dec. Com. 181.

The duty of the commissioner in cases involving only questions of fact, is discharged when he has so far examined the case as to find that the decision of the board is not against the manifest weight of the evidence. Blanchard *v.* Strain, 2 Dec. Com. 54; Fawcett *v.* Graham, 1 Dec. Com. 113; White *v.* Purdy, 2 Dec. Com. 115.

The concurrent decisions of lower tribunals upon questions of fact, will not be set aside upon appeal, except for manifest error. Hazelip *v.* Richardson, 10 O. G. 747.

A case will be remanded to the primary examiner, at his request, for the purpose of giving further references to the applicant. Israel Townsend, 2 Dec. Com. 97.

SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the commis-

sioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

Statute Revised—July 8, 1870, ch. 230, § 48, 16 Stat. 205.

Prior Statutes—July 4, 1836, ch. 357, § 7, 5 Stat. 119.—March 3, 1839, ch. 88, § 11, 5 Stat. 354.—August 30, 1852, ch. 107, § 1, 10 Stat. 75.

The only appeal is from a refusal to grant a patent. Pomeroy *v.* Connison, Cranch Pat. Dec. 112.

If the commissioner holds that a party applying for a patent "is not the original and first inventor," and decides against him upon that ground, the applicant can take an appeal from his decision. The commissioner, having reached this conclusion, is under no obligation to go further and examine any other question arising in the case, and it is not necessary to the right of appeal that he should do so. Commissioner *v.* Whiteley, 4 Wall. 522.

If the commissioner decides that the applicant is not such a person as is entitled by law to a reissue, the applicant has a right under the statute to appeal from this decision, whether right or wrong. This preliminary question is as much within the scope of his authority as any other which can arise, and having resolved it in the negative, there is no necessity for him to look further into the case. Commissioner *v.* Whiteley, 4 Wall. 522.

The jurisdiction of the appellate court is limited upon appeals from the commissioner of patents, and it has no authority to order a reissued patent to be antedated to the time when the application for reissue was filed. Whiteley & Gage, 1 Dec. Com. 53: Andrew Whiteley, 1 Dec. Com. 70.

The only question intended to be cut off from appeal beyond the commissioner in a case of interference is the question of priority of invention. W. Weitling et al. *v.* S. G. Cabell et al. 2 O. G. 223; *vide* Bain *v.* Morse, 6 West. L. J. 372.

No appeal lies from the refusal of the commissioner to issue a patent to an assignee whose assignment was not recorded until a patent had issued to his assignor, and a mandate from an appellate judge requiring it will not be regarded. Andrew Whiteley, Assignee, 1 Dec. Com. 79.

The appellate court can not declare an amended specification entitled to a patent which has never been received or examined at the office. Whiteley & Gage, 1 Dec. Com. 53.

Where it is conceded the facts are in substance the same as in a case in which the supreme court has rendered a decision, it is the duty of the commissioner to apply such decision without regard to his individual opinion of the law. Mason *v.* Doellbor & Houghton, 1 Dec. Com. 26; Shaw & Leavitt *v.* Sedgebeer, 2 Dec. Com. 5.

In the absence of positive expression of opinion on the part of the appellate judge upon a given point, and of information as to the nature or scope of the discussion before him, a *pro forma* rejection will be given, in order that an appeal may be taken. John L. Mason, 2 Dec. Com. 35; Timothy Gordon, 2 O. G. 29.

SEC. 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent office, within such time as the commissioner shall

appoint, his reasons of appeal, specifically set forth in writing.

Statute Revised—July 8, 1870, ch. 230, § 49, 16 Stat. 205.

SEC. 4913. The court shall, before hearing such appeal, give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

Statute Revised—July 8, 1870, ch. 230, § 51.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the patent office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Statute Revised—July 8, 1870, ch. 230, § 50, 16 Stat. 205.

The supreme court is limited to the reasons of appeal, for the appeal is only an appeal from so much of the decision as is affected by the reason. Arnold *v.* Bishop, Cranch Pat. Dec. 109; Smith *v.* Flickenger, Cranch Pat. Dec. 116.

The supreme court can only examine into the reasons of appeal, and the record and proceedings as far as they apply thereto, for the purpose of ascer-

taining whether the commissioner has made an erroneous decision, and can not revise the decision on any other ground than that upon which the application was rejected. In re E. S. Conklin, 1 McArthur, 375; S. C. 5 O. G. 235.

An officer or counsel of the patent office may appear and argue the questions involved in the appeal. Perry *v.* Cornell, Cranch Pat. Dec. 130.

SEC. 4915. Whenever a patent on application is refused, either by the commissioner of patents or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

Statute Revised—July 8, 1870, ch. 230, § 52, 16 Stat. 205.
Prior Statute—March 3, 1839, ch. 88, § 10, 5 Stat. 354.

If the application is not brought before the commissioner by an appeal from an adverse decision of the examiners, but simply comes before him with a report of the examiners, and he withholds the patent in virtue of his general supervisory authority, the remedy is not by an appeal to the supreme court, but by a bill in equity under this section. Hull *v.* Commissioner, 7 O. G. 559; S. C. 8 O. G. 46; S. C. 2 McArthur, 90, 125.

For practice under this section, see Greeley *v.* Commissioner, 6 Fish. 675; S. C. 1 Holmes, 284; 4 O. G. 612; Prentiss *v.* Ellworth, 2 Whart. Dig. 365.

SEC. 4916. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law,

cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

Revised Statute—July 8, 1870, ch. 230, § 53, 16 Stat. 205.

Prior Statutes—July 3, 1832, ch. 162, § 3, 4 Stat. 559.—July 4, 1836, ch. 357, § 13, 5 Stat. 122.—March 3, 1837, ch. 45, §§ 5, 8, 5 Stat. 192, 193.

When Surrender Allowed.

As the commissioner is an officer of special and limited power, his action in granting a reissue must be restricted to the particular cases mentioned in the statute. In re E. S. Conklin, 1 McArthur, 375; S. C. 5 O. G. 235; Child *v.* Adams, 1 Fish. 189; S. C. 3 Wall. Jr. 20.

The statute embraces only the right to a reissue where, from an unintentional error in the description of the invention, the patent is wholly "inoperative or invalid." It is not enough that the applicant for the reissue shall state that the patent is not fully valid and available to him. This does not meet the clear and explicit requirement of the statute. Whitely *v.* Swayne, 4 Fish. 117; S. C. 7 Wall. 685.

If the original patent is neither inoperative nor invalid, and if no error has

been occasioned by accident or mistake, the presumption is that the patentee abandoned to the use of the public everything which he may have invented, but did not include in his claim or specification. In re E. S. Conklin, 1 McArthur, 375; S. C. 5 O. G. 235.

Inventors are not usually sufficiently skilled in the art of nice composition to enable them to accurately draft their own specifications. They must therefore resort to others, and it not infrequently happens that the draftsman employed to describe a particular invention, either through want of skill, or haste, or ignorance of the state of the art, gives in the specification a very imperfect description of the thing invented. He sometimes narrows the scope of the inventor's ideas and combinations, and at other times expands them over instruments and devices which are not the product of his original thought. He may fail to set forth some feature of the invention which at the time is deemed unimportant, and which subsequently may be proved to be vital, or at least of great value. If the invention is of considerable pecuniary consideration, the public examine it with scrutinizing eyes, and if an inch of ground within the true scope of the discovery is unoccupied by the specification, it is at once seized upon by parties to whose business the new improvement has a near relation. If a fatal or damaging error has crept into the description, that fact is soon ascertained by those who desire to avail themselves of whatever improvement has been discovered. The privilege of surrender and reissue is, therefore, invaluable to inventors, for without it they would often lose that protection for the offspring of their skill and labor, which it is the immediate object of all patent laws to afford. Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195.

It not infrequently happens, that a judicial interpretation of the specification or claim of a patent, or both, discloses to the inventor and patentee for the first time the defects in the instrument, and shows him that he has unwittingly restricted his rights within narrower limits than his discovery, or so inartificially described his invention, that he has failed to secure any substantial advantage by it. Such a disclosure furnishes a proper occasion for a surrender and reissue when the error was inadvertent and is clearly within the beneficent design of the statute. Poppenhusen *v.* Falke, 2 Fish. 213; Doughty *v.* West, 3 Fish. 580; S. C. 6 Blatch. 429; Bliss *v.* Gaylord Manuf. Co. 6 Blatch. 179.

It matters not how or when the patentee discovered the mistake, provided it was a mistake. The real question is, whether or not the invention described in the new specification is a part of the original invention. Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493.

If the specification is defective or doubtful in some particulars, the patent may be surrendered for the purpose of making the description more clear, although it is not void. Woodworth *v.* Hall, 1 M. & W. 248; Parham *v.* Sewing Machine Co. 4 Fish. 468.

The provision allowing a surrender may perhaps be regarded more justly as affirming the propriety of the usage which had obtained under the former laws and had been repeatedly recognized by the courts, and as prescribing in addition the conditions and incidents which should attach to it thereafter. It is hardly to be supposed that the merely clerical error of an engrossing

subordinate, or the accidental inadvertence of the commissioner himself, is not capable of being rectified or supplied now, just as it was before the adoption of this provision. French *v.* Rogers, 1 Fish. 133; Morris *v.* Huntington, 1 Paine, 348; Grant *v.* Raymond, 6 Pet. 218.

An error in the date from which the patent for an invention which has been patented in a foreign country begins to run, may be corrected by a reissue. Buerk *v.* Valentine, 5 Fish. 366; S. C. 9 Blatch. 479; 2 O. G. 295.

It is the duty of the commissioner to correct errors in the letters patent when applied to, and to minute the correction on or in them, as these matters are between him, representing the government, and the patentee. He need not resign or reseal the letters, for he adopts them as his own acts by redelivering the patent after it is amended, as much as he adopts the writing of it on the paper or parchment. The record or enrollment must be made to correspond with the letters as amended. Woodworth *v.* Hall, 1 W. & M. 248, 349; Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555.

A patent which has been extended, may be surrendered and a reissue granted. Gibson *v.* Harris, 1 Blatch. 167; Wilson *v.* Rosseau, 4 How. 646; S. C. 1 Blatch. 3.

The new patent is substituted for the old one, with just the same effect and operation in law, as if the specification had been filed first in the form which it takes in the reissue. This substitute, having all the legal attributes of the original, may therefore be amended also. The surrender and reissue may follow each other just as often as the patentee is content to be more specific or more modest in his claims. French *v.* Rogers, 1 Fish. 133; Morse *v.* Bain, 9 West. L. J. 106.

A reissue has been upheld when the surrender was made more than sixteen years after the first patent was issued. It has also been said, that a patent which had been extended to twenty-one years under the general law, and afterward extended to twenty-eight years by special act of Congress, might be surrendered and reissued after the term of twenty-one years had expired. Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134.

The surrender and the reissue, no matter how often they recur, are reciprocal, each in consideration of the other, and forming together but a single act between the parties. It would be unconscientious to retain the consideration while denying the validity of the grant. If the reissue is invalid for want of authority to make it, the surrender is ineffective for want of authority to accept it, and so the patent stands as if there had been no surrender. French *v.* Rogers, 1 Fish. 133; Woodworth *v.* Hall, 1 W. & M. 389; Woodworth *v.* Edwards, 3 W. & M. 120.

Practice.

The statute does not in terms require that a surrender shall be in writing. Patents may doubtless be surrendered on petition or by delivery, as the rules of the patent office may prescribe. Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555.

An applicant for a reissue who has filed his application with the acting commissioner, and paid the requisite amount of fees, has done all in his

power to make his application effectual, and has a right to consider it properly before the commissioner. Commissioner *v.* Whiteley, 4 Wall. 522.

It is the first duty of the commissioner to receive the application, whatever he may do subsequently. Without this initial step there can be no examination, and indeed no rightful knowledge of the subject on his part. Commissioner *v.* Whiteley, 4 Wall. 522.

If no oath is made to the specification, the reissue is void. Whiteley *v.* Swayne, 4 Fish. 117; S. C. 7 Wall. 685.

The application for a reissue may be withdrawn under leave of the commissioner, at any time before the proceedings are fully completed and duly recorded. The reissued letters patent, as a general rule, have the effect to supersede the original patent, but a pending application for that purpose can not receive any such construction, no matter how nearly the proceedings may have approached to a consummation, so long as they are not finally completed. Prior to the issuing of the new patent, what is called a surrender in the case, is, in general, nothing more than a preliminary offer to that effect as the necessary means of obtaining a reissue, and even when not so intended in the outset, it may be subsequently so treated by the commissioner, at the request of the party applying for the reissue. Where bad faith is shown as an element of the case, a different conclusion would doubtless follow; but the withdrawal of the application may be allowed by the commissioner for any reasonable cause, where there is no fraud practiced to procure it, and where there is no prejudicial interference with the rights of third persons. Forbes *v.* Barstow Stove Co. 2 Cliff. 379.

The issuing of one set of new letters patent for the three different terms before existing, when the old specification is sought to be corrected, is open to some questions concerning its legality. The most obvious mode would be to renew each separately, or renew only the old letters and their specification, and let the others be cured or aided by relation back to the original one. Woodworth *v.* Hall, 1 W. & M. 248, 389.

If the reissue states that the original patent was surrendered and canceled, the presumption of law in the absence of any proof to the contrary, is that the statement is correct, and that the surrender was made according to law and the rules of the patent office. An erroneous description of the patent in the application will not affect the reissue, if there is no error in the records of the patent office. Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555.

The new patent, in case of reissue, should be granted for the unexpired term only. Woodworth *v.* Stone, 3 Story, 749.

A reissue is made to cover the unexpired period of the original patent, and is therefore antedated. Whitely *v.* Fisher, 4 Fish. 248.

It is questionable whether any evidence is competent or admissible in an action between third persons involving the validity of the patent, to show that the officer who signed it was not legally appointed, the power of the officer himself not being put directly in issue in a proceeding where he is a party. Woodworth *v.* Hall, 1 Wood. & M. 389.

The signature of a person as acting commissioner, carries as much verity and legality on the face of a certificate to a patent, as that of the commis-

sioner himself, until it be shown, if it can be properly, that the acting appointment was not in truth made in the manner authorized by law. Woodworth *v.* Hall, 1 Wood. & M. 248, 389.

It would seem to be necessary to have the Secretary of the Interior sign anew or assent to an amendment of an error in a patent, as he is a distinct officer. and without signing anew or assenting would not authenticate the letters as amended. Woodworth *v.* Hall, 1 Wood. & M. 248, 389.

The commissioner has no authority to grant a reissued patent. That belongs to the Secretary of the Interior; consequently the commissioner is not liable for refusing to make the grant. If the Secretary of the Interior executes the patent, and it awaits the counter-signature of the commissioner and the seal of the office, and the commissioner maliciously refuses to countersign and affix the seal of the office, he will be liable. Whitely *v.* Fisher, 4 Fish. 248.

If an attorney, employed to obtain a reissue, discovers in the course of his investigations for that purpose, that one claim is in conflict with a prior patent, which he thereupon purchases, such purchase will not inure to the benefit of his client. Hoffheins *v.* Brandt, 3 Fish. 218.

Parties to Surrender.

The sole right to surrender is given (1) to the patentee, if he is alive and has made no assignment of the original patent; (2) to the executor or administrator of the patentee after his decease, when there has been no such assignment; (3) to the assignee when there has been an assignment of the original patent. The right to surrender is given to no one else. Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 206; Smith *v.* Mercer, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49.

It is not in the power of the patentee, by the surrender of his patent, to affect without their consent, the rights of third persons to whom he has previously passed his interest in the whole or a part of the patent. This consent may be manifested either by joining in the surrender with the patentee, or by previously authorizing it, or by subsequently ratifying or approving it. To take advantage and benefit of it would be a ratification. When such consent is given, the right of the party so consenting in and to the old patent are forever gone. It may, too, be considered as a sound and settled principle, that a person to whom the patentee has passed his interest in part of the old patent, is entitled, upon a surrender of the same by the patentee, and the obtaining of a reissued patent, to the same right under the reissued patent that he had to the old one. The patentee can not, by taking a reissue, deprive him of the same right to it that he had to the old one, if he wishes to take the benefit of such right. But when he does take advantage and benefit of the reissued patent, he consents to give up, and does give up, the right which he had under the old one. It does not follow from this, however, that because a third person to whom a patentee has passed his interest in a part of the patent, is entitled to the same right to a reissued patent that he had to the old one, he is compelled to take under the reissued one, and thereby compelled to give up the right which he had under the old one. If he were, his rights might be injuriously

affected without his consent. If he were so compelled, an assignee under the old patent of an exclusive territorial right would be forced, without his consent, to give up damages which he might be entitled to under the old patent for a violation of rights secured to him by that patent. And it might so happen that the old patent surrendered was a valid one, and that the reissued one was invalid, or that the rights secured by the former were important, while the rights secured by the latter were of little consequence. Third persons can, therefore, hold under the old patent notwithstanding the surrender and reissue. Potter *v.* Holland, 4 Blatch. 206; Smith *v.* Mercer, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49; Woodworth *v.* Stone, 3 Story, 749; Washburn *v.* Gould, 3 Story, 122; McBurney *v.* Goodyear, 11 Cush. 569.

Where there has been an assignment of an undivided part of the whole original patent, the assignee of such part and the patèntee become joint owners of the patent, and should join in the surrender, and if they do not, it will be invalid unless the part owner not joining shall ratify it. Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 206.

There is no provision requiring that the original patentee, after an assignment of his interest, shall assent to the reissue. And a reissue, without such concurrence, is valid. Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115.

If a reissue is granted to the patentee after the execution of an assignment, but before it is placed on record in the patent office, the assignee has no right to demand that a reissue shall be granted to himself, and if he does, and is refused, the action of the commissioner in so refusing, is not the subject of an appeal to a judge. It raises merely an issue between the office and the assignee with regard to an existing patent, and not an issue over the merits of the patent. The law providing an appeal to the appellate judge, has reference to the contents of a patent, and not to a controversy between parties as to who owns it, where the patent has been granted. Whitely *v.* Fisher, 4 Fish. 248.

New letters, with an amended specification, is the same invention as that covered by the original patent, and a conveyance of it once, therefore, for a specified term, is good for the term, whether an amended specification is filed or not before the term closes. Woodworth *v.* Hall, 1 Wood. & M. 248, 389.

There is nothing in the terms of the statute which limits the right of reissue to the patentee or first assignee. A reissue to subsequent assignees is valid. Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115.

If the reissue recites a prior assignment of the patent, it is *prima facie* evidence thereof. Middletown Co. *v.* Judd, 3 Fish. 141.

If the reissue recites that the original patent had been assigned to the party to whom the reissue is granted, it is conclusive. Hoffheins *v.* Brandt, 3 Fish. 218.

If a patentee who has parted with his title, makes a surrender at the request of the owner, and after obtaining a reissue assigns that to the real owner, the reissue will be deemed valid as against an infringer. Wing *v.* Warren, 5 Fish. 548; S. C. 2 O. G. 342.

Where an assignment covers the whole interest of an inventor, present and prospective, it is more regular that the application for a surrender should be made by the assignee, but even in that case the reissue will not be void, if the

assignment is duly recorded in the patent office, and the application for the surrender and reissue is made with the consent of the assignee. If the reissue is correct in form, and there is no proof of fraud, intentional error, or concealment, a mere wrong-doer can not defend himself against the charge of infringement by proving that the proceedings which led to the reissue were irregular, unless it is shown that the proceedings were contrary to law, or that the patent was granted to the wrong party. Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555; Woodworth *v.* Stone, 3 Story, 749; Meyer *v.* Bailey, 8 O. G. 437.

If the assignee adopts a surrender applied for by the patentee, and accepts the new patent, he is estopped to deny either the authority of the applicant or that of the commissioner. The patentee can not complain, because it was his own act. The government can not complain, because there is but one patent for the invention. Third parties can not, therefore, raise any objection. Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555.

There is nothing in the statute which restricts the right of a patentee to make a surrender, because he has previously made special or limited grants. Smith *v.* Mercer, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49.

A grantee of an exclusive territorial right need not unite in the application for a reissue. Meyer *v.* Bailey, 8 O. G. 437; Commissioner *v.* Whiteley, 4 Wall. 522.

A mere license having no legal right in the patent need not join in the surrender. Potter *v.* Holland, 1 Fish. 327; S. C. 4 Blatch. 206; Forbes *v.* Barstow Stove Co. 2 Cliff. 379.

The reissue may be made in the name of the administrator of the patentee, for an invention is personal property, and possesses value beyond the first patent on it, being valuable for purposes abroad as the ground for a patent there, and also for a renewal at home. Woodworth *v.* Hall, 1 Wood & M. 248, 389.

Where a reissue is granted to an administrator, it will be taken for granted that the person in whose name the patent was issued established his legal right to it before the commissioner, and the court can not go behind the grant to ascertain whether this was so or not. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148; Woodworth *v.* Hall, 1 Wood & M. 248, 389; Goodyear *v.* Hullioen, 3 Fish. 251.

A grant in case of a reissue in trust for the heirs-of-law of the patentee, their heirs, administrators or assigns, is at most a mere verbal error, if the trust has any validity whatever, for the new patent will, by operation of law, enure to the sole benefit of the parties in whose favor the law designed it should operate, and not otherwise. Woodworth *v.* Stone, 3 Story, 749.

An executor of the patentee may surrender the patent and obtain a reissue. Carew *v.* Boston Elastic Fabric Co. 5 Fish. 90; S. C. 1 Holmes, 45; 1 O. G. 91.

If one of several executors surrenders a patent, and takes a reissue to himself as executor, the grant vests the legal title in him exclusively. The suffix of executor signifies the trustee character in which he assumed to act, and in which he was recognized and dealt with by the commissioner. The designation and trust which it implies does not prevent the passage of the legal

title, or qualify the estate which accompanies it. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

When Decision of Commissioner Conclusive.

The specification may be defective or insufficient either by a mistake of law as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact in omitting things which are indispensable to the completeness and exactness of the invention, or of the mode of constructing or making or using the same. Whether the invention claimed in the original patent and that claimed in the new amended patent, is substantially the same, is and must be in many cases a matter of great nicety and difficulty to decide. It may involve considerations of fact as well as of law. Who is to decide the question? The true answer is, the commissioner of patents; for the law intrusts him with the authority not only to accept the surrender, but to grant the new amended patent. He is bound, therefore, by the very nature of his duties, to inquire into and ascertain whether the specification is definite or insufficient in point of law or fact, and whether the inventor has claimed more than he invented, and in each case, whether the error has arisen from inadvertency, accident or mistake, or with a fraudulent or deceptive intention. No one can well doubt that in the first instance, therefore, he is bound to decide the whole law and facts arising under the application for the new patent. *Prima facie*, therefore, it must be presumed that the new amended patent has been rightfully granted by him. Allen *v.* Blunt, 3 Story, 742; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 576; Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448.

It is not necessary for the reissued patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 576.

The power of accepting the surrender of the original patent, and of granting a reissue of it, is confided exclusively to the commissioner, and is to be exercised judicially by him. The presumption is that he has exercised it lawfully, and that the reasons for which alone its exercise could be invoked have been sufficiently shown to exist. His decision is final, and is to be treated as foreclosing all inquiry into the existence or sufficiency of the facts which are prescribed as necessary to authorize him to grant a reissue. Parham *v.* Sewing Machine Co. 4 Fish. 468.

All matters of fact involved in the hearing of an application to reissue a patent, and in granting it, are conclusively settled by the decision of the commissioner granting the application. Matters of construction arising on the face of the instrument are still open, but all matters of fact connected with the surrender and reissue are closed in a suit for an infringement by the decision of the commissioner. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Jordan *v.* Dobson, 4 Fish. 232; S. C. 7 Phila. 533; 2 Abb. U. S. 398; Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195; La Baw *v.* Hawkins, 6 O. G. 724; Colt *v.* Young, 2 Blatch. 471; Stimpson *v.* Westchester R. R. Co. 4 How. 380; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Forbes *v.* Bar-

stow Stove Co. 2 Cliff. 379; Allen *v.* Blunt, 3 Story, 742; Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493; Woodworth *v.* Stone, 3 Story, 749; French *v.* Rogers, 1 Fish. 133; Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 238.

The presumption is that, in granting the reissue, the commissioner discharged his duty faithfully and correctly. This involves the idea that he granted it on account of mistake or inadvertence in the description or specification of the invention attached to the first letters; and therefore that he issued the new one as a matter of course, with a different amended description or specification, but for the same invention. Allen *v.* Blunt, 2 W. & M. 121; Smith *v.* Mercer, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49; Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134; Crompton *v.* Belknap Mills, 3 Fish. 536; Birdsell *v.* McDonald, 6 O. G. 682; Bantz *v.* Elsas, 6 O. G. 117; Doherty *v.* Haynes, 6 O. G. 118; Woodworth *v.* Edwards, 3 W. & M. 120; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Woodward *v.* Densmore, 4 Fish. 163; American Pavement Co. *v.* Elizabeth, 6 Fish. 424; S. C. 3 O. G. 522; Aultman *v.* Holley, 6 Fish. 534; S. C. 11 Blatch. 304; 5 O. G. 3: Hussey *v.* McCormick, 1 Fish. 509; S. C. 1 Biss. 300; Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195; Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134; Morris *v.* Roger, 3 Fish. 176; S. C. 2 Bond, 66; Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493; O'Reilly *v.* Morse, 15 How. 62; Jordan *v.* Dobson, 4 Fish. 232; S. C. 2 Abb. U. S. 398; 7 Phila. 533; Middletown Co. *v.* Judd, 3 Fish. 141; Goodyear *v.* Berry, 3 Fish. 439; S. C. 2 Bond, 189; Knight *v.* Railroad Co. 3 Fish. 1; S. C. Taney, 106.

The *prima facie* inference or presumption in respect to the identity of the invention is open to be contradicted by proper evidence. Allen *v.* Blunt, 2 W. & M. 121; Goodyear *v.* Berry, 3 Fish. 439; S. C. 2 Bond, 189.

Where the commissioner accepts a surrender of an original patent, and grants a new patent, his decision in the premises in a suit for an infringement is final and conclusive, and is not re-examinable in such suit, unless it is apparent upon the face of the patent that he has exceeded his authority—that there is such a repugnancy between the old and the new patent, that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Graham *v.* Mason, 5 Fish. 1; La Baw *v.* Hawkins, 6 O. G. 724; M. & H. Glue Co. *v.* Upton, 6 O. G. 837; Collar Co. *v.* Van Dusen, 23 Wall. 530; S. C. 10 Blatch. 119; 7 O. G. 919; Wells *v.* Gill, 6 Fish. 89; S. C. 2 O. G. 590; Metropolitan Co. *v.* Tool Co. 1 Holmes, 161.

Identity of Original and Reissue.

The reissue must, by the express words of the section, be for the same invention, and consequently, where it appears on a comparison of the two instruments as matter of law, that the reissued patent is not for the same invention as that embraced and secured in the original patent, the reissue is invalid, as that state of fact shows that the commissioner, in granting the new patent, exceeded his jurisdiction. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Sickles *v.* Evans, 2 Fish. 417; S. C. 2 Cliff. 203; Battin *v.* Taggart, 1

Fish. 139; Carhart *v.* Austin, 2 Fish. 543; S. C. 2 Cliff. 528; Burt *v.* Duryee, 2 Fish. 275; S. C. 1 Wall. 531; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Sickles *v.* Falls Co. 2 Fish. 202; S. C. 4 Blatch. 508; Goodyear *v.* Berry, 3 Fish. 439; S. C. 2 Bond, 189; Wood Paper Co. *v.* Fibre Co. 3 Fish. 362; S. C. 6 Blatch. 27; Wood Paper Co. *v.* Heft. 3 Fish. 316; S. C. 8 Wall. 333; Whitely *v.* Swayne, 4 Fish. 117; S. C. 7 Wall. 685; Vogle *v.* Semple, 11 O. G. 923; S. C. 9 C. L. N. 217; Collar Co. *v.* Van Dusen, 23 Wall. 530; S. C. 10 Blatch. 119; 7 O. G. 919; Russell *v.* Dodge, 93 U. S. 460; S. C. 11 O. G. 151; American Wood Paper Co. *v.* Fibre Disintegrating Co. 23 Wall. 566; Wicks *v.* Stevens, 2 Woods, 310; Hall *v.* Withington, 6 O. G. 933; Johnson *v.* Beard, 8 O. G. 435.

Power is conferred upon the commissioner to allow the specification to be amended if the patent is inoperative or invalid, and, in that event, to issue the patent in proper form. And he may, under that authority, allow the patentee to redescribe his invention, and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specifications, model, or drawings which properly belong to the invention as actually made and perfected. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Morris *v.* Roger, 3 Fish. 176; S. C. 2 Bond. 66; Parham *v.* Sewing Machine Co. 4 Fish. 468; Decker *v.* Grote, 6 Fish. 143; S. C. 10 Blatch. 331; 3 O. G. 65; Dorsey Co. *v.* Marsh, 6 Fish. 387; S. C. 9 Phila. 395; Black *v.* Thorne, 5 Fish. 550; S. C. 10 Blatch. 66; 2 O. G. 388; Westinghouse *v.* G. & R. Brake Co. 9 O. G. 538; Woodward *v.* Dinsmore, 4 Fish. 163; Sarven *v.* Hall, 5 Blatch. 415; S. C. 9 Blatch. 524; 1 O. G. 437; Washing Machine Co. *v.* Lincoln, 4 Fish. 379; Bliss *v.* Gaylord Manuf. Co. 7 Blatch. 279; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Wells *v.* Jacques, 5 O. G. 364; Morris *v.* Roger, 3 Fish. 176; S. C. 2 Bond, 66; Nat'l Spring Co. *v.* Union Car Spring Manuf. Co. 12 Blatch. 180; S. C. 2 O. G. 224; Chicago Co. *v.* Busch, 4 Fish. 395; S. C. 2 Biss. 472; Bantz *v.* Elsas, 6 O. G. 117; Penn Salt Co. *v.* Thomas, 5 Fish. 148; S. C. 8 Phila. 144; Union Paper Collar Co. *v.* Leland, 1 Holmes, 427; S. C. 7 O. G. 221.

It is not the meaning of the law that the patentee who applies for a reissue must at his peril describe and claim in his new specification, either in words or idea, just what was described and claimed in his old one. His new specification must be of the same invention, and his claim can not embrace a different subject-matter from that which he sought to patent originally. But unless the correction which the statute contemplates is narrowed down till it becomes a mere disclaimer, it is not possible in any case to frame a correct specification which shall not be broader than the one originally filed. To supply a defect, to repair an insufficiency, is to add, either directly or by modifying or striking out a limitation; in either form the effect is to amplify the proposition. In the case of a specification under the patent laws, it is to amplify the description and enlarge the claim. French *v.* Rogers, 1 Fish. 133.

A reissue will not be declared void on the ground that it is not for the same invention as the original patent, if such a result can be avoided by a liberal application of the maxim that letters patent are to receive a liberal construc-

tion, and, if practicable, to be so interpreted as to uphold, and not destroy the right of the inventor. M. & H. Glue Co. *v.* Upton, 6 O. G. 837.

Mere verbal discrepancies are entitled to but little consideration, especially where there is substantial accordance between the original and reissued patents. Dorsey Co. *v.* Marsh, 6 Fish. 387; S. C. 9 Phila. 395; Tarr *v.* Folsom, 1 Holmes, 312; S. C. 5 O. G. 92; Jordan *v.* Dobson, 4 Fish. 232; S. C. 2 Abb. U. S. 398; 7 Phila. 533; Welis *v.* Jacques, 5 O. G. 364; Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555.

Variations from the description given in the former specification do not necessarily imply that it is for a different discovery. The right to surrender the old patent and receive another in its place was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. It necessarily, therefore, varies from it. La Baw *v.* Hawkins, 6 O. G. 724; O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Smith *v.* G. D. & Co. 93 U. S. 486; S. C. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; Allen *v.* Blunt, 2 W. & M. 121; Parham *v.* Sewing Machine Co. 4 Fish. 468; Hussey *v.* McCormick, 1 Fish. 509; S. C. 1 Biss. 300; Carew *v.* Boston Elastic Fabric Co. 5 Fish. 90; S. C. 1 Holmes, 45; 1 O. G. 91; Poppenhusen *v.* Falke, 2 Fish. 213; Aultman *v.* Holley, 6 Fish. 534; S. C. 11 Blatch. 304; 5 O. G. 3; Crompton *v.* Belknap Mills, 3 Fish. 536; Pearl *v.* Ocean Mills, 11 O. G. 2; Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195; Wells *v.* Jacques, 5 O. G. 364; Tucker *v.* Tucker Manuf. Co. 10 O. G. 464; Morse *v.* Bain, 19 West. L. J. 106; M. & H. Glue Co. *v.* Upton, 6 O. G. 837; Putnam *v.* Yerringer, 9 O. G. 689; Stevens *v.* Pritchard, 10 O. G. 505; Lorillard Co. *v.* McDowell, 11 O. G. 640; S. C. 34 Leg. Int. 78; 4 Pitts. L. J. 119; Bridge *v.* Brown, 1 Holmes, 53.

It is the right of the patentee and his representative to enlarge or restrict his claim, so as to give validity to the patent and secure the invention. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; Morey *v.* Lockwood, 8 Wall. 230.

New matter must not be introduced in a reissue. By new matter is not meant merely the introduction of a new ingredient in a patented composition, but any change in the original specification and claim, whereby a new and substantially different composition and results are secured. U. S. Felting Co. *v.* Haven, 3 Dillon, 131; S. C. 9 O. G. 253.

The fact that the specification gives less prominence to some terms of description and more to others than the first one, is not objectionable, provided that it is *bona fide*. The very object of the surrender is always to correct the specification, to make it clearer, fuller, and more exact. Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493; Robertson *v.* Secombe Co. 6 Fish. 268; S. C. 10 Blatch, 481; 3 O. G. 412.

A specification may be defective, not only in omitting to give a full description of the mode of constructing a machine, but also in omitting to describe fully in the claim, the nature, extent and character of the invention, and the latter defect may be amended as well as the former. Carver *v.* Braintree Manuf. Co. 2 Story, 432.

If there is any doubt as to the construction of the language in a reissued

patent, the construction may be aided by reference to the original patent. Ely *v.* Monson Manuf. Co. 4 Fish. 64.

The patent covers equivalent although formally different mechanical devices which operate in the same way and to the same end. Hence, it is legitimate in an amended patent to modify the specification so as to secure protection broadly to the real invention of the patentee against any form of infringement. Dorsey Co. *v.* Marsh, 6 Fish. 387; s. c. 9 Phila. 395; Poppenhusen *v.* Falke, 2 Fish. 213.

Invention may be as necessary to reform or adapt an existing machine to the performance of work which it would not, as originally constructed, perform, as it is to make a new machine, and whether this is done by removing a device or by adding one, by removing a bolt or by inserting a bolt, by making an apparently great mechanical change, or a small one, the principle is the same. The change being a substantial one and producing a different result, may, if it be new, be the subject of a new patent, but can not be covered by the reissue of an old one. Kirby *v.* Dodge Manuf. Co. 6 Fish. 156; s. c. 10 Blatch. 307; 3 O. G. 181.

Where the commissioner has caused the patentee to make his claim narrower than his invention, he has the power, and it is his duty to accept a surrender and grant a reissue broad enough to cover the invention. Morey *v.* Lockwood, 8 Wall. 230.

An examination of the original specification and claims is not for the purpose of testing their sufficiency and validity. If insufficient or defective, their defects or insufficiencies might be cured by the reissue. The examination is for the single purpose of seeing what inventions or devices are found therein. Sarven *v.* Hall, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437.

If a bolt in the machine described in the original patent, is a mechanical device performing a precise and defined mechanical office, removing it to produce a different result, is tantamount to adding another device to the same end. The reissue can not embrace such an alteration. Kirby *v.* Dodge Manuf. Co. 6 Fish. 156; s. c. 10 Blatch. 307; 3 O. G. 181.

Whether the defect vitiated the original patent is immaterial, for it does not affect the rights under the new patent, even if the first patent were void. Stimpson *v.* Westchester R. R. Co. 4 How. 380.

The patentee can not embrace in his reissued patent, any patentable improvements not described, suggested or indicated in the application, or model, or specification, or drawings. Such additions made to the specifications are interpolations and not amendments, and consequently the commissioner has no authority to allow them to be made. Although the invention as originally made did as a matter of fact embrace those devices, yet they can not be added. The commissioner has no authority except in certain special cases to hear parol proof as to what the invention was, and allow the applicant to amend his specification and claim so as to include them, and if he does, his decision will not be conclusive, for the decision of the commissioner is not conclusive as to his own jurisdiction. Sickles *v.* Evans, 2 Fish. 417; s. c. 2 Cliff. 203; Seymour *v.* Osborne, 5 Fish. 555; s. c. 11 Wall. 516; Carhart *v.* Austin, 2 Fish. 543; s. c. 2 Cliff. 528; Knight *v.* Railroad Co. 2 Fish. 1; s. c. Taney, 106; Hoffheims *v.* Brandt, 3 Fish. 218; Sarven *v.* Hall, 5 Fish.

415; S. C. 9 Blatch. 524; 1 O. G. 437; Kirby *v.* Dodge Manuf. Co. 6 Fish. 156; S. C. 10 Blatch. 307; 3 O. G. 181; Adjustable Window Screen Co. *v.* Boughton, 31 Leg. Int. 254; Gill *v.* Wells, 22 Wall. 1; S. C. 6 O. G. 881; 2 A. L. T. (N. S.) 181; *vide* Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134; Allen *v.* Blunt, 3 Story, 742.

A patentee may state new results in the reissue without subjecting himself to the imputation of incorporating new matter, for he is entitled to all the uses to which his patent may be applied, and to all the beneficial results which legitimately follow the use of his instrumentalities. Putnam *v.* Yerringer, 9 O. G. 689.

Whether the defect be in the specification or in the claim, the patentee may surrender his patent, and by an amended specification or claim, cure the defect. Batten *v.* Taggert, 17 How. 74; S. C. 2 Wall, Jr. 101; Crompton *v.* Belknap Mills, 3 Fish. 536.

A reissue may claim a feature shown in the original model, though not specifically claimed in the specification. Calkins *v.* Bertrand, 8 C. L. N. 114.

The description and drawings of an original patent may be looked to to disclose the real invention of a patentee when the original claims are defective or the reissue claim obscure. Bussey *v.* Wagoner, 9 O. G. 300; S. C. 23 Pitts. L. J. 131.

The language of the claim may be changed if the change conforms to the drawing in the original patent. Booth *v.* Parks, 6 C. L. N. 407.

Even a statement in an original patent that a part is old, or a disclaimer of a part does not necessarily prevent such part from being claimed in a reissued patent, though it would have that effect if made advisedly and not by inadvertence, accident, or mistake. Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134; Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493.

It is necessary to the validity of the reissue of a chemical patent, that the subject-matter be found described in the original patent. Tarr *v.* Webb, 5 Fish. 593; S. C. 10 Blatch. 96; 2 O. G. 568.

If the claim of the reissue is broader than the invention, the reissue is void because it is not for the same invention as the patent which was surrendered as the foundation of the reissue. Goodyear *v.* Providence Rubber Co. 2 Fish. 449; S. C. 9 Wall. 788; 2 Cliff. 351; Carhart *v.* Austin, 2 Fish. 543; S. C. 2 Cliff. 528.

A part of the original invention may be omitted in the reissued patent, for there is nothing in the policy or terms of the patent act which forbids it. Dorsey Co. *v.* Marsh, 6 Fish. 387; S. C. 9 Phila. 395; Carver *v.* Braintree Manuf. Co. 2 Story, 432; Boomer *v.* Power Co. 13 Blatch. 107; Knight *v.* Railroad Co. 3 Fish. 1; S. C. Taney, 106; Chicago Co. *v.* Busch, 4 Fish. 395; S. C. 2 Biss. 472; Parham *v.* Sewing Machine Co. 4 Fish. 468.

A certified copy of the model does not conclude the defendant, but he may show that the model has been changed. Johnson *v.* Beard, 8 O. G. 435.

A drawing which was clearly indicated in the original specification may be added in the reissue. Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 4 O. G. 31; Hank's Case, 2 A. L. T. 129.

If the invention might be claimed either as a machine or a process, the

reissue may claim a process although the original patent claimed a machine. Clark *v.* Kennedy Manuf. Co. 11 O. G. 68.

If the original patent was for a process, a reissue may embrace the process and the product. Merrill *v.* Yeomans, 1 Holmes, 331; S. C. 5 O. G. 267; 11 O. G. 970.

A patentee who has a patent for an aggregate of several devices may surrender his patent and receive new letters patent for the several devices included in it. Wheeler *v.* McCormick, 6 Fish. 551; S. C. 11 Blatch. 334; 4 O. G. 692.

If the patentee was the inventor of the elements of a combination, but only claimed the combination, he may surrender the patent and take a reissue claiming the elements also. Batten *v.* Taggert, 17 How. 74; S. C. 2 Wall. Jr. 101; Gallahue *v.* Butterfield, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645; Jordan *v.* Dobson, 4 Fish. 232; S. C. 2 Abb. U. S. 398; 7 Phila. 533.

If the original patent describes a part, but claims it in combination, the reissue may claim the part and omit the claim for the combination. Chicago Co. *v.* Busch, 4 Fish. 395; S. C. 2 Biss. 472.

An inventor who has omitted to claim separate new devices or severable and distinct combinations in the original patent, may make a surrender and take a reissue for the distinct combinations or separate devices. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442; Cochrane *v.* Deener, 11 O. G. 637; 4 W. L. R. 99.

Although the invention, as described in the original patent, was not capable of reduction to practical use, yet the patent may be surrendered and a reissue taken for the separate devices contained therein. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

If the original patent claims a combination, it may be surrendered and a reissue taken, claiming only one part of the machine. The patentee has a right to restrict or enlarge his claim so as to give it validity and effectuate his invention. The description of the part in the original patent, without claiming it, will not constitute an abandonment of it to the public so as to prevent him from claiming it in the reissue. Batten *v.* Taggert, 17 How. 74; S. C. 2 Wall. Jr. 101.

When the inventor in the specification of the original patent, describes a new and useful combination of a number of elements performing in combination certain functions less than he has claimed, he may, in the reissue claim such combination of the less number which he has described, suggested, or substantially indicated as his invention, but failed to include in his claims. Pearl *v.* Ocean Mills, 11 O. G. 2.

If a patentee who has taken out a patent merely for a combination of all the elements of the machine, without any suggestion, indication or intimation that any other invention of any kind has been made, subsequently discovers that he can accomplish a new and useful result by a combination embracing less than the whole number of the elements included in his patent, he can not secure his right to this subsequent invention by a surrender of the first patent, and a reissue which includes the second combination as well as the first. Gill *v.* Wells, 22 Wall. 1; S. C. 6 O. G. 881; 2 A. L. T. (N S.) 101.

A patentee can not surrender a patent for an invention consisting of a

combination of old elements, and amend the descriptive parts of the specification by striking out the entire description of one of the elements of the combination and inserting in lieu thereof a full description of several other devices without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever showing the reason why the change was made. Gill *v.* Wells, 22 Wall. 1; S. C. 6 O. G. 881; 2 A. L. T. (N. S.) 101.

A patentee, when he surrenders an original patent, can not amend the specification by striking out from the original the correct description of one of the ingredients of the patented combination, and substituting in its place the description of other devices not well known at the date of the original patent as a proper substitute for the ingredient whose description is stricken out. Gill *v.* Wells, 22 Wall. 1; S. C. 6 O. G. 881; 2 A. L. T. (N. S.) 101.

If the claims are for separate and distinct improvements, separate patents may be granted upon the reissue. Bennett *v.* Fowler, 8 Wall. 445.

A new product or manufacture, and a new process or method of producing the new article, are the proper subjects of separate and distinct claims in an original patent, and if the claims are not so made, the patentee upon a return of the patent for correction and reissue, may have several patents for the distinct and separate parts of his invention. Goodyear *v.* Providence Rubber Co. 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; Goodyear *v.* Wait, 3 Fish. 242; S. C. 5 Blatch. 468; Goodyear *v.* Honsinger, 3 Fish. 147; S. C. 2 Biss. 1; Penn Salt Co. *v.* Thomas, 5 Fish. 148; S. C. 8 Phila. 144.

If the patent does not relate to a machine, the specification may be made more definite and certain so as to embrace the claim made, or the claim may be so modified as to correspond with the specification, but this is the extent to which modifications can be made. Giant Powder Co. *v.* California Powder Works, 3 Saw. 448.

If the original invention was for a process in the use of an article, a reissue for a compound of the article with other substances is void. Giant Powder Co. *v.* California Powder Works, 3 Saw. 448.

When a patent is granted, certain exclusive rights are secured or purported to be secured to the inventor. The object of the reissue is to secure greater rights than were actually secured by the first patent. The subject of both patents is the same invention, and the object of both is to secure rights in the same. This is the only object in both. A less right to the invention may be secured by the first patent. A greater right to the same invention may be secured by the reissued patent. The object of a patent is to secure rights to an invention throughout the whole of the United States. There is no good reason why a portion or the whole of the invention for a particular portion of the United States may not be secured by one patent, and the remaining portion of the invention for the residue of the United States be secured by another patent. These two patents would in effect constitute together but one patent for the whole invention for the whole United States. Two patents for separate parts, the separate parts together comprehending only the whole, would in effect be but one patent for the whole, as two separate deeds for two separate sections of one whole lot of land, would not be in effect more than one deed for the whole lot. No more would be secured by the two patents

than is authorized by law to be secured, or than could be secured by one. The two in effect would constitute but one. Potter *v.* Holland, 1 Fish. 327; S. C. 4 Blatch. 206.

Persons owning reissued letters patent, and seeking redress from those who have invaded their exclusive rights, are not obliged to introduce in evidence the surrendered patent. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516.

If the original patent is not introduced in evidence, the question whether the reissued patent is for the same invention as the original patent, can not be raised. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Doherty *v.* Haynes, 6 O. G. 118; Eureka *v.* Bailey Co. 11 Wall. 488; Reedy *v.* Scott, 23 Wall. 352; S. C. 7 O. G. 463.

Whether a reissued patent is for the same invention as that embodied in the original patent, or for a different one, is a question for the court in an equity suit, to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of experts, as it may or may not appear that one or both may contain technical terms, or terms of art requiring such assistance in ascertaining the true meaning of the language employed. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Woodward *v.* Dinsmore, 4 Fish. 163.

Matters of fact are not open in a suit for an infringement, as to whether the reissue is for the same invention as the original patent. The conclusion must always be in favor of the reissue, unless it appears upon a comparison of the two instruments, that the reissue as a matter of legal construction is not for the same invention as the original. Stevens *v.* Pritchard, 10 O. G. 505.

Whether the new patent granted upon the surrender of the old one is substantially for a different invention from the first one, is a question for the jury on the evidence. Stimpson *v.* Westchester R. R. Co. 4 How. 380; Batten *v.* Taggert, 17 How. 7; 4 S. C. 2 Wall. Jr. 101; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Morris *v.* Royer, 3 Fish. 176; S. C. 2 Bond, 66.

The defense that a reissued patent was issued unintentionally through the blunder of a subordinate in the patent office, can not be availed of in a suit brought on the patent. The only remedy is a direct proceeding by the United States to vacate the patent. Doughty *v.* West, 3 Fish. 580; S. C. 6 Blatch. 429.

Fraud.

The patent will be invalid if there has been fraud in the procurement of the reissue. The fraud may be either actual or constructive. The statute refers specially to cases of collusion—fraudulent, corrupt collusion between the applicant and the commissioner. If it is apparent that there has been any improper collusion between them, and that the patent has been granted corruptly, that is an act of positive fraud which will invalidate any patent to which it applies. Swift *v.* Whisen, 3 Fish. 343; S. C. 1 Bond, 115; House *v.* Young, 3 Fish. 335.

Very clear and decisive evidence is required in order to invalidate a patent upon an allegation of fraud in the reissue. Swift *v.* Whisen, 3 Fish. 343;

s. c. 1 Bond, 115; Jordan *v.* Dobson, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533.

The question of fraud in obtaining a reissue, is settled by the decision of the commissioner. Brown *v.* Guild, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739.

The reissue can not be abrogated by an infringer in a suit against him for infringements upon the ground that the letters patent were procured by fraud in preventing the application for the same before the commissioner. Seymour *v.* Osborne, 3 Fish. 555; s. c. 11 Wall. 516; Doughty *v.* West, 3 Fish. 580; s. c. 6 Blatch. 429.

Effect of Reissue.

The reissue must be considered as a continuation of the original patent, and the rights of the patentee are to be determined by the state of things as they existed at the time of the original application. The new patent and the proceedings on which it issues have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application, and if the new patent is valid the law must be considered as satisfied, if the machine was not known or used before that application. Grant *v.* Raymond, 6 Pet. 218; Shaw *v.* Cooper, 7 Pet. 292; Read *v.* Bowman, 2 Wall. 591; Crompton *v.* Belknap Mills, 3 Fish. 536.

When a patent is surrendered, and new letters are taken out with an amended specification, the patent is considered to operate from the commencement of the original term, except as to suits for violations committed before the amendment. The amendment is not because the former patent or specification was utterly void, but because it was defective or doubtful in some particular which it was expedient to make more clear. But it is still a patent for the same invention. It can by law include no new one, and it covers only the same term of time which the former patent and its extensions did. The new letters relate back to the commencement of the original term, and for many purposes operate from that time. This is in strict analogy to amended writs and amended judgments, which for most purposes have the same effect as if the amended matter was in them originally. Woodworth *v.* Hall, 1 Wood & M. 248, 389; Grant *v.* Raymond, 6 Pet. 218; Stanley *v.* Whipple, 2 McLean, 35; Smith *v.* Pearce, 2 McLean, 176; House *v.* Young, 3 Fish. 335.

In law, a reissued patent is generally considered, except in respect to infringements prior to its issue, as if granted at the date of the original patent, and the corrected patent, in respect to all subsequent infringements, is made to take effect as though it had been so issued originally, even though the original patent was invalid. Hussey *v.* Bradley, 2 Fish. 362; s. c. 5 Blatch. 134; Stanley *v.* Whipple, 2 McLean, 35; Grant *v.* Raymond, 6 Pet. 218.

Clerical amendments of letters patent relate back to the date of the letters patent, as much as any like clerical amendments of declarations, or pleas or judgments. Woodworth *v.* Hall, 1 Wood & M. 389.

No prior use under the defective patent can authorize the use of the invention after the issuing of the renewed patent. Any person using an invention

protected by a renewed patent is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent. Stimpson *v.* Westchester R. R. Co. 4 How. 380; Carr *v.* Rice, 1 Fish. 198; Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134; Bliss *v.* Brooklyn, 4 Fish. 596; S. C. 8 Blatch. 533; Howe *v.* Williams, 2 Fish. 395; S. C. 2 Cliff. 245; Grant *v.* Raymond, 6 Pet. 218; Bloomer *v.* Stolley, 5 McLean, 158; Agawam Co. *v.* Jordan, 7 Wall. 583.

The prior use of an invention under a defective patent can not take away the right to surrender such patent and take out a new and amended one. Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134; Buerk *v.* Valentine, 5 Fish. 366; S. C. 9 Blatch. 479; 2 O. G. 295.

When letters patent are amended in a material mistake, they can only operate as to third persons for causes accruing after the correction. It may be different if the mistake is entirely clerical. Woodworth *v.* Hall, 1 Wood. & M. 248, 389; Brown *v.* Hinkley, 6 Fish. 370; S. C. 3 O. G. 384.

A surrender of the patent to the commissioner within the sense of the provision means an act which in judgment of law extinguishes the patent. It is a legal cancellation of it, and hence it can no more be the foundation for the assertion of a right after the surrender, than an act of Congress which has been repealed. The antecedent suits depend upon the patent existing at the time they were commenced, and unless it exists and is in force at the time of trial and judgment, the suits fall. Moffitt *v.* Gaar, 1 Fish. 610; S. C. 1 Black. 273; 1 Bond, 315; Dennis *v.* Eddy, 4 Fish. 423.

A surrender after a final judgment or decree does not affect such judgment or decree. Mers *v.* Conover, 11 O. G. 1111.

Moneys recovered on judgments in suits, or voluntary payments under the first patent, can not be recovered back upon the surrender. The title to these moneys does not depend upon the patent, but upon the voluntary payment or the judgment of the court. Moffitt *v.* Gaar, 1 Fish. 610; S. C. 1 Black, 273; 1 Bond. 315.

A reissued patent may be issued to the assignee of the original, when he requests it and makes the application, although he has made an assignment of it which is on record. Havemeyer et al. Assignees, 2 Dec. Com. 5.

A reissued patent must be granted in the name of the patentee, or, in case of his death, or of an assignment of the whole or of an undivided part of the original patent, then to his executors, administrators, or assigns. James D. Wright, 10 O. G. 587; N. B. Fassett, 11 O. G. 420.

A patent having been reissued to the inventor will not be reissued also to his assignee whose assignment was not recorded before the reissue to the inventor. Andrew Whiteley, Assignee, 1 Dec. Com. 79.

A clerical error in a patent will be corrected without fees, if it occurred through the fault of the office; but if through the fault of the patentee, it will be corrected only by a reissue on the usual terms. James Cochrane, 1 Dec. Com. 60.

A reissued patent will not be antedated to the time when the application for it was made. Andrew Whiteley, 1 Dec. Com. 72.

In applications for reissue, the proof there required should be submitted to the commissioner in person, and if the proof is satisfactory, the amendment will then be examined in the usual manner. Isaac Winslow, 9 O. G. 795.

An applicant for reissue will not be allowed to establish priority as against a patentee whose patent has expired. J. L. Mason, 9 O. G. 1196.

A reissued patent will not be granted after the term of the original has expired, since no right of action could accrue under it, even if it were antedated. Andrew Whiteley, 1 Dec. Com. 70.

No one is liable upon a reissued patent for alleged infringements which took place before it issued, but after its date. Andrew Whiteley, 1 Dec. Com. 72.

Any claims may be justly embodied in a reissue which could have been allowed in the original application, although it enables the patentee to control devices which, though different in construction, are substantially the equivalents of the patented invention. Bissell & Moore Manufacturing Co. 2 Dec. Com. 157.

After one patent has issued, upon an application for a reissue the original patent is annulled, and no new division of the reissue will be received. Andrew Whiteley, 1 Dec. Com. 70.

A model might be a basis for reissue, although forming no part of the patent. C. W. Baldwin, 9 O. G. 639.

An application for reissue should not be examined in the light of the state of the art as it existed subsequent to the filing of the original application. Carroll *v.* Morse, 9 O. G. 453.

An application for reissue will be granted, if it appears the new matter was omitted through inadvertency or mistake in the original application. Elias Ingraham, 3 Dec. Com. 164.

A participal claim to "arranging" devices, instead of to the devices themselves, having been granted under a lax practice, should be made to conform to the present practice in revising the application for reissue. Calista E. Cox, 3 O. G. 2.

An applicant for reissue is entitled to make the corrections which he might properly have made after filing his original application. C. W. Baldwin, 9 O. G. 639.

No patent should be allowed to issue upon an application for a reissue until all the rights of the applicant are settled. Doty *v.* Osborne & Ballard, 1 Dec. Com. 77.

Nothing but what was shown in the original specification, drawings, or model, can be introduced into a reissue. W. C. Dodge, 1 Dec. Com. 27; Joseph Ridge, Assignor, 1 Dec. Com. 46; Willis Humiston, 1 Dec. Com. 47; Aberdeen Keith, 2 Dec. Com. 69; Galen Orr, 2 Dec. Com. 113; Wm. A. Lewis, 3 Dec. Com. 82; George E. Waring, Jr. 3 Dec. Com. 228; Elisha Waters, 8 O. G. 399; Nehemiah T. Folsom, 2 Dec. Com. 170.

The specification may be amended in a reissue by the model originally filed, and the model or drawings may be amended by each other, but not by the specification. W. C. Dodge, 1 Dec. Com. 27; Elizabeth Hawkes, 1 Dec. Com. 37.

The same rule governs in cases of reissue as adopted by the courts, and it is for the office to determine, by comparison of the patent and the application, whether the scope of the original invention is enlarged. Aldrich & Evans, 9 O. G. 407.

An amendment may be introduced into a reissue, if it only explains the manner in which the device is to be operated. N. J. Donaldson, 4 O. G. 4.

An inventor is entitled to all the benefits of his improvement, and is entitled to a reissue, although he may not have fully anticipated its value. Samuel F. Day, 1 Dec. Com. 4.

It cannot be objected to a claim in an application for reissue for the first time, that the specified invention has been abandoned since the date of the

original patent, because not urged before, and having gone into extensive use. Conklin & Stafford, 2 O. G. 543.

A disclaimer contained in a patent, and which has no reference to the invention described, may be omitted in a reissue without rendering it liable to the objection of new matter. Hermann & Taylor, 10 O. G. 865.

If the patentee finds himself hindered in his rights to any extent by reason of an error in the specification, the defect may be cured by a reissue. Mathew Andrew, 2 Dec. Com. 75; C. B. Cottrell, 9 O. G. 495.

Although estoppel might operate as between the parties, the grant of the reissued patent, upon proof of priority of invention, was not barred. David E. Roe, 5 O. G. 397.

In an application for reissue, the words "or their equivalents," referring to a definite device, add nothing that the applicant would not be entitled to without them. W. H. McLellan, 2 O. G. 89; Continental Windmill Co. 2 Dec. Com. 74.

If one is entitled, upon his invention, to more than is secured to him by the patent already granted, the safe and proper remedy is by reissue. Paul & W. C. Bramwell, 2 Dec. Com. 76.

A patentee should be held rigidly to the language adopted in his patent, unless good reason appears for departing from it. If new terms or new descriptive matter is introduced, the patentee must show good cause for its introduction, or it will be stricken out. Henry M. Underwood, 1 O. G. 549.

A reissue will not be granted for matter embraced in a prior foreign patent to the inventor which has expired. C. W. Siemens, 11 O. G. 1107.

An inventor can not insert a claim for a feature in a reissue which is not shown in the original specifications, drawings or model, although it was contained in the machine made before the filing of the application. J. S. Warren, 10 O. G. 1.

If, in view of the state of the art as exhibited by the references cited, the applicant presents only a colorable variation or equivalent construction, a reissue will not be granted. T. Plumleigh, 3 O. G. 29.

Where a patent has issued in one division of an application for a reissue, the original patent is dead, and no new division can be entertained. Whiteley & Gage, 1 Dec. Com. 53.

If an applicant would not have been allowed, in his original patent, the claim set up, he cannot have it by reissue. John E. Wooten, 3 O. G. 521.

It is new matter to describe in the reissue application various other uses to which the invention could be applied. Robert Bragg, 8 O. G. 985.

A use of the invention being suggested in a reissued patent not mentioned in the original application for a patent, such suggestion of new matter ought not to be allowed in the reissue, without disclaimer of such new matter. Horatio Allen, 2 O. G. 89.

Several parts of a patented machine which will together constitute a new invention not mentioned in the original, can not be claimed by themselves on a reissue. Wheeler & Wheeler, 4 O. G. 5; Aldrich & Evans, 9 O. G. 407.

If an application is forfeited through neglect to pay the final fee, the applicant is not entitled to have the same invention embraced in the reissue of a previous patent on the ground that it was afterwards patented to another. Nehemiah T. Folsom, 2 Dec. Com. 170.

Where the ambiguity is explained in a manner not inconsistent with the original invention, an amendment may be allowed upon sworn statements showing that the matter so introduced was a part of the original invention. Peter R. Gollstein, 11 O. G. 1061.

SEC. 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the patent office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

Statute Revised—July 8, 1870, ch. 230, § 54, 16 Stat. 206.
Prior Statute—March 3, 1837, ch. 45, §§ 7, 9, 5 Stat. 193.

When Patent Valid.

This section is intended to cover inadvertencies and mistakes of the law, as well as inadvertencies and mistakes of fact. Wyeth *v.* Stone, 1 Story, 273.

This provision applies to patents granted prior to its adoption. Hotchkiss *v.* Oliver, 5 Denio, 314.

The patentee can not maintain an action unless the part invented can be clearly distinguished from that claimed but not invented. Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black. 427; Rumford Works *v.* Lauer, 5 Fish. 615; S. C. 10 Blatch. 122; 3 O. G. 349; Rice *v.* Garnhart, 34 Wis. 453.

If the claim is for the whole machine, and the invention consists in an improvement, the invention will be good so far as it extends. Peterson *v.* Wooden, 3 McLean, 248; Hotchkiss *v.* Oliver, 5 Denio, 314.

The provision requiring a disclaimer applies only in the case where the part claimed by the patentee, of which he is not the inventor, is a material and substantial part of the thing patented. A disclaimer is necessary, therefore, only where the thing claimed without right is a material and substantial part of the thing invented. The question as to the disclaimer is of no importance unless the part claimed is a material and essential part, or unless it was introduced into the description through the willful default of the patentee, or with intent to defraud or mislead the public. Hall *v.* Wiles, 2 Blatch. 194.

If a patentee makes a claim which is not well founded in the same patent with other claims which are well founded, he may disclaim within a reasonable time that which he had no right to claim, and then his patent will be good as to the residue, as good as if it had issued originally only for the claims which are valid. Seymour *v.* McCormick, 3 Blatch. 209; S. C. 19 How. 96; Tuck *v.* Bramhill, 3 Fish. 400; S. C. 6 Blatch. 95; Taylor *v.* Archer, 4 Fish. 449; S. C. 8 Blatch. 315.

If the patentee omits to make a disclaimer, but brings a suit for a violation of his patent, and it satisfactorily appears upon the trial that he is entitled to be protected in a portion of the claims set up in his patent, but that he is not entitled to be protected in respect to another portion, he is still entitled to damages for the violation of the valid portion of his claims, the same as if all the claims were valid so far as regards the mere right of recovery, but he gets no costs. Seymour *v.* McCormick, 3 Blatch. 209; S. C. 19 How. 96; *vide* Heinrich *v.* Luther, 6 McLean, 345.

A disclaimer can not be filed where the patent is for a combination. Batten *v.* Clayton, 2 Whart. Dig. 363; Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427.

There is no distinction between an invalid claim for something of which the patentee was the discoverer, and a claim for something which was known before, and of which he was not the first discoverer. A patent for such a claim is as strongly forbidden by the statute as if some other person had made the invention before him. The law which requires and permits him to disclaim is not penal, but remedial. It is intended for the protection of the patentee as well as the public, and ought not therefore to receive a construction that would restrict its operation within narrower limits than its words fairly import. Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim in order to save the portion to which he is entitled; and he is allowed to do so when the error was committed by mistake. O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102.

After a disclaimer has been properly filed, the construction of the patent must be the same as it would be if the matter so disclaimed had never been included in the description of the invention or the claims of the specification. Dunbar *v.* Myers, 11 O. G. 35.

A new specification which is not completed by a surrender of the old one, can not be considered as a disclaimer. Hovey *v.* Stevens, 3 W. & M. 17.

When Filed.

A disclaimer may be filed as well after as before the commencement of a suit. Smith *v.* Nichols, 6 Fish. 61; S. C. 21 Wall. 112; 1 Holmes, 72; 2 O. G. 649; O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Hall *v.* Wiles, 2 Blatch. 194; Silsby *v.* Foote, 20 How. 378; S. C. 2 Blatch. 260; Seymour *v.* McCormick, 19 How. 96; S. C. 3 Blatch. 209; Sanger *v.* Walmsley, 1 Fish. 558; Tuck *v.* Bramhill, 3 Fish. 400; S. C. 6 Blatch. 95; Wyeth *v.* Stone, 1 Story, 273; Brooks *v.* Jenkins, 3 McLean, 432; *vide* Reed *v.* Cutter, 1 Story, 590; Parker *v.* Stiles, 5 McLean, 44.

This provision means that a suit pending when the disclaimer is filed, is not to be affected by such filing so as to prevent the plaintiff from recovering in it, unless it appears that he unreasonably neglected or delayed to file the disclaimer. Tuck *v.* Bramhill, 3 Fish. 400; s. c. 6 Blatch. 95.

A court of equity ought not to interfere to grant a perpetual injunction, whatever may be the right and remedy at law, unless a disclaimer has been in fact filed at the patent office before the suit is brought. The granting of such an injunction is a matter resting in the sound discretion of the court, and if the court should grant a perpetual injunction before any disclaimer is filed, it may be that the patentee may never afterwards, within a reasonable time, file any disclaimer. Wyeth *v.* Stone, 1 Story, 273.

There may be a decree for a perpetual injunction, each party to pay his own costs, without any actual previous disclaimer of record in the patent office. But the circuit courts will not make any decree beyond the perpetual injunction without an actual disclaimer previously recorded in the patent office. Aiken *v.* Dolan, 3 Fish. 197; Myers *v.* Frame, 4 Fish. 493; s. c. 8 Blatch. 446.

Who may File.

If an assignee does not join with the patentee in a disclaimer, the disclaimer can not operate in favor of the assignee in any suit either at law or in equity. Wyeth *v.* Stone, 1 Story, 273; Myers *v.* Frame, 4 Fish. 493; s. c. 8 Blatch. 446.

If a patent is issued jointly to the inventor and another as assignee of an interest in the invention, the former must offer to unite with the inventor in a disclaimer, before he can assert that some validity might thereby be imparted to the patent. Rice *v.* Garnhart, 34 Wis. 453.

If the disclaimer is filed by the patentee, it need not expressly declare that he has parted with no interest, for the fair implication from the averment that he is the patentee is that he still owns the whole. Silsby *v.* Foote, 14 How. 218; s. c. 1 Blatch. 445.

If an administrator, in whose name a patent has been extended, expressly states that he is the patentee, and refers to the patent as showing his interest, this is a sufficient statement of his interest. Brooks *v.* Jenkins, 3 McLean, 432.

Delay.

The time in reference to the question of delay commences when the knowledge is brought home to the patentee that he was not the first inventor, or when it is declared by a court of competent jurisdiction to settle the question that he is not the first inventor, then it is that the time commences to run, and not till then. Singer *v.* Walmsley, 1 Fish. 558.

When the objectionable claim has been sanctioned by the commissioner of patents, and held to be valid by a circuit court, the patentee has a right to insist upon it, and not disclaim it until the highest court to which it can be carried has pronounced its judgment. Such delay is not unreasonable, and will not render the patent altogether void. O'Reilly *v.* Morse, 15 How. 62;

S. C. 6 West. L. J. 102; Seymour *v.* McCormick, 19 How. 96; S. C. 3 Blatch. 209; Potter *v.* Whitney, 3 Fish. 77; S. C. 1 Lowell, 87.

An unreasonable neglect or delay to enter a disclaimer cuts off the patentee from all the benefits of the section. He not only can not recover costs, but he can have no right of action. Brooks *v.* Jenkins, 3 McLean, 432; Hall *v.* Wiles, 2 Blatch. 194; Winans *v.* N. Y. & Erie R. R. Co. 1 Fish. 213; S. C. 21 How. 88.

What is unreasonable delay is a question to be settled by the court, and not for the jury. Singer *v.* Walmsley, 1 Fish. 558; Seymour *v.* McCormick, 19 How. 96; S. C. 3 Blatch. 209.

Whether the neglect or delay to enter a disclaimer is unreasonable is a mixed question of law and fact, and must be decided by the jury under the instructions of the court. Brooks *v.* Jenkins, 3 McLean, 432; Washburn *v.* Gould, 3 Story, 122; Lippincott *v.* Kelly, 1 West. L. J. 513.

SEC. 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person, except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Statute Revised—July 8, 1870, ch. 230, § 58, 16 Stat. 207.
Prior Statute—July 4, 1836, ch. 357, § 16, 5 Stat. 123.

The circuit court has no jurisdiction to enjoin a patentee, or declare the patent a nullity upon the application of a party who alleges that he is the first and original inventor of the thing patented for which the patentee surreptitiously and fraudulently obtained a patent, if the complainant has not obtained a patent. Hoeltge *v.* Hoelter, 2 Bond, 386; Mason *v.* Rowley, 3 A. L. T. (N. S.) 8.

If the party who gets the later patent is the real inventor, he may have the prior patent canceled. Sturges *v.* Van Hagen, 6 Fish. 572.

The assignee of an invention may file a bill in his own name to obtain the cancellation of letters patent which have been improperly granted to another. Gay *v.* Cornell, 1 Blatch. 506; Gold & Silver Ore Co. *v.* U. S. Ore Co. 3 Fish. 489; S C. 6 Blatch. 307.

Two patents interfere within the meaning of this section when they claim the same invention in whole or in part. Gold & Silver Ore Co. *v.* U. S. Ore Co. 3 Fish. 489; s. c. 6 Blatch. 307; Gilmore *v* Golay, 3 Fish. 522.

A party is not entitled to any benefit under this section, unless the patents are for the same invention. An averment that the defendant claims an interference and denial of such claim does not authorize a suit as for an interference. Celluloid Manuf. Co. *v.* Goodyear D. V. Co. 13 Blatch. 375; s. c. 10 O. G. 41.

The power of the circuit court in a case of interfering patents, is not confined to the specific remedy pointed out by this section, but authorizes the granting of an injunction. The power conferred on the circuit courts to entertain bills in equity in controversies arising under the patent act, is a general equity power, and carries with it all the incidents belonging to that species of jurisdiction. The power conferred, not only enables the court to decree a final remedy, but to take care that the subject of the controversy shall not be rendered valueless pending the litigation. Potter *v.* Dixon, 2 Fish. 381; s. c. 5 Blatch. 160.

Where both patents are void for want of novelty, the court may enter a decree declaring both patents void. Foster *v.* Lindsay, 3 Dillon, 126; s. c. 7 O. G. 514; 8 O. G. 1032.

A judgment or decree can not be accepted as determining the question of the interference of two patents, unless it be direct and affirmative in terms and in the words of the statute. The court must adjudge and declare the patent void in whole or in part, or in operation, and invalid in some particular part of the United States. A decree dismissing a bill seeking that relief, does not imply such positive judgment, but on the contrary indicates that the court on the proof before it, was unable to render that specific judgment. Tyler *v.* Hyde, 2 Blatch. 308.

SEC. 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

Statute Revised—July 8, 1870, ch. 230, § 59. 16 Stat. 207.

Prior Statutes—April 10, 1790, ch. 7, § 4, 1 Stat. 111.—Feb. 21, 1793. ch. 11, § 5, 1 Stat. 322.—April 17, 1800, ch. 25, § 3, 2 Stat. 38.—July 4, 1836, ch. 357, § 14, 5 Stat. 123.

Parties.

A right of action is only given to such party as possesses the whole interest. Suydam *v.* Day, 2 Blatch. 20.

The patentee is entitled to recover at law, no matter what private agreement subsists between him and any other person or persons, unless he has made a legal assignment and transfer of his interest in the invention. Park *v.* Little, 3 Wash. C. C. 196; Blanchard *v.* Eldridge, 1 Wall. Jr. 337.

A licensee can not maintain an action in his own name. Suydam *v.* Day, 2 Blatch. 201; Gayler *v.* Wilder, 10 How. 477.

An action at law to protect the interests of a licensee, may be brought in the name of the patentee for the benefit of the licensee. Goodyear *v.* McBurney, 3 Blatch. 32; Goodyear *v.* Bishop, 2 Fish. 96; S. C. 4 Blatch. 438.

If a patentee executes a release under seal to another, neither he nor his licensee can sue that party for an infringement. Jackson *v.* Allen, 120 Mass. 64.

If the licensee brings a suit in the name of the patentee, the latter may claim indemnity against costs, which will be provided for by the court on a proper application. Goodyear *v.* Bishop, 2 Fish. 96; S. C. 4 Blatch. 438.

A suit brought in the name of the patentee for the benefit of the licensee, can not be dismissed on a motion made by the defendant, although the nominal plaintiff consents to such dismissal. Goodyear *v.* Bishop, 2 Fish. 96; S. C. 4 Blatch. 438.

A stipulation by the patentee to sue infringers, does not necessarily take from the licensee his remedy, which the law has provided for him by proceeding directly against the wrong-doer. Goodyear *v.* Bishop, 2 Fish. 96; S. C. 4 Blatch. 438.

An assignee acquires his title to a patent with a right of action in his own name only by force of the statute. Such exclusive right of action exists in favor of a sole assignee only in two cases, namely: where he acquires by assignment the whole interest in a patent or a grant, or conveyance of the whole interest within some particular district or territory. Suydam *v.* Day, 2 Blatch. 20; Tyler *v.* Tuel, 6 Cranch, 324.

The assignees of separate, undivided interests in the patent for a certain territory may join in an action for an infringement. Stern *v.* Goddard, 1 McA. 82.

The grantee of the exclusive right to construct and use, and vend to others to be used, two patented machines within a certain town, can maintain an action for an infringement. Although limited to the use of two machines within the town, the right to use them is exclusive. No other party, not even the patentee, can use a right under the patent within the territory, without infringing the grant. Wilson *v.* Rousseau, 4 How 646; S. C. 1 Blatch. 3.

A suit for an infringement committed after the assignment was made and recorded must be in the name of the assignee. Herbert *v.* Adams, 4 Mason, 15.

The correct interpretation of the words "person or persons interested" is, that the words mean the person or persons interested in the patent at the time when the infringement was committed which is the cause of action for which the damages may be recovered. A subsequent sale and transfer of the exclusive right are no bar to an action to recover damages for an infringement committed before such sale and transfer. The reason for the rule is, that the assignee or grantee is not interested in the damages for any infringement com-

mitted before such sale and transfer. The patentee may therefore sue for such damages in his own name. Moore *v.* Marsh, 7 Wall. 515.

The patentee and an assignee of a moiety may join in an action for an infringement. Whittemore *v.* Cutter, 1 Gallis. 429.

The joint owner of a patent can sustain an action for an infringement against his co-owner, and recover his actual damages, according to his interest in the patent. If such co-owner appropriates any portion of the exclusive right or common property to his separate use or benefit, by either the use or the sale of the patented machine, he does what is in principle the same as the conversion by destruction or sale of the joint property by a tenant in common, which authorizes his co-tenant to maintain trover. Pitts et al. *v.* Hall, 3 Blatch. 201.

Infringement.

The statute does not, and was not intended to operate beyond the limits of the United States, and as the patentee's right of property and exclusive use is derived from it, they can not extend beyond the limits to which the law itself is confined. The use of the invention outside of the jurisdiction of the United States is not an infringement of his rights. The rights of property and exclusive use granted to a patentee do not extend to a foreign vessel entering one of our ports, and the use of the improvement in the construction, fitting out, or equipment of such vessel while she is coming into or going out of a port of the United States, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs. Brown *v.* Duchesne, 19 How. 183; S. C. 2 Curt. 371.

The jurisdiction of the United States extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country; and the use of a thing patented on such vessels is an infringement. Gardiner *v.* Howe, 2 Cliff. 462.

An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters patent. The statute confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the patented article. It is therefore an infringement to make or manufacture a patented article, though it is never used by the maker. It is likewise an infringement to use a patented article, though made by another. It is also an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do one or all of them is an infringement. Haselden *v.* Ogden, 3 Fish. 378.

It is not necessary that the defendant's machine should be an exact copy of the patentee's machine. All that is required is that the defendant's machine should be substantially like the patentee's machine. Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43.

It is a familiar rule that to copy the principle or mode of operation described in the patent is an infringement, although such copy should be totally unlike the original in form or proportions. If it were not so, no question of infringement could arise. If the machine complained of were a copy

in form of the machine described in the specification, it would be at once seen to be an infringement. It could be nothing else. It is only ingenious diversities of form and proportion, presenting the appearance of something unlike the thing patented which give rise to questions. Winans *v.* Denmead, 15 How. 330.

So long as the patentee's ideas are found in the construction and arrangement, no matter what may be its form, or shape, or appearance, the party using it is appropriating his invention, and must be held to be an infringer. Potter *v.* Wilson, 2 Fish. 102; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512; Decker *v.* Grote, 6 Fish. 143; S. C. 10 Blatch. 331; 3 O. G. 65; Decker *v.* Griffith, 10 Blatch. 343, note.

Patents are not monopolies, because a monopoly is that which segregates what was common before, and gives it to one person or class for use or profit. A patent is that which brings out from the realm of mind something that never existed before, and gives it to the country. Probably of all species of property the property in patent rights should be most carefully guarded and protected, because it is so easily assailed. The most difficult thing in the world is to prove an invasion of property of this character. Singer *v.* Walmsley, 1 Fish. 558; Parker *v.* Stiles, 5 McLean, 44; Imlay *v.* Railroad Co. 1 Fish. 340; S. C. 4 Blatch. 227.

An infringement takes place whenever a party avails himself of the invention of the patentee without such variation as will constitute a new discovery. An infringement involves substantial identity. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512; Rich *v.* Lippincott, 2 Fish. 1; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121.

The word "substantial," as applied in actions for an infringement is not susceptible of an exact definition. The law looks more to the substance of things than their forms. Brooks *v.* Bicknell, 3 McLean, 250.

No certain, definite rule, can be stated by which to determine unerringly in every case what will amount to substantial identity. Each case must be determined upon its own circumstances. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

The question of infringement is one irrespective of motive. The defendant may have infringed without intending, or even knowing it, but he is not, on that account, the less an infringer. Parker *v.* Hulme, 1 Fish. 44.

The making of a machine fit for use, and with a design to use it for profit, is an infringement of the patent right. Whittemore *v.* Cutter, 1 Gallis. 429; Bloomer *v.* Gilpin, 4 Fish. 50.

The word "making" is equaily as applicable to machines as to compositions of matter, and there is no difficulty in holding that the using or vending of a patented composition is a violation of the right of the proprietor. Whittemore *v.* Cutter, 1 Gallis. 429.

An imperfect infringement, because the machine is imperfect, is still an infringement. Union Paper Bag Co. *v.* Binney, 5 Fish. 166.

The patent law was intended to secure to an inventor his whole invention or discovery, but not unless he claimed to be secured in the whole. If he claims only a part, or some particular form, such part or particular form only is secured to him. Hawes *v.* Gage, 5 O. G. 494; Boston E. F. Co. *v.* Rubber

Thread Co. 1 Holmes, 372; s. c. 5 O. G. 696; American Pin Co. *v.* Oakville Co 3 Blatch. 190; Bliss *v.* Haight, 3 Fish. 621; s. c. 7 Blatch. 7; Sickles *v.* Gloucester Manuf. Co. 1 Fish. 222; s. c. 3 Wall. Jr. 196; Rich *v.* Close, 4 Fish. 279; s. c. 8 Blatch. 41; Many *v.* Sizer, 1 Fish. 31; Waterbury Brass Co. *v.* Miller, 5 Fish. 48; s. c. 9 Blatch. 77; Howe *v.* Williams, 2 Fish. 395; s. c. 2 Cliff. 245; Meissner *v.* Devoe Manuf. Co. 5 Fish. 285; s. c. 9 Blatch. 363; 2 O. G. 245; Poppenhusen *v.* N. Y. G. P. Co. 4 Blatch. 253; Smith *v.* Elliott, 5 Fish. 315; s. c. 9 Blatch. 400; 1 O. G. 331; Doughty *v.* West, 2 Fish. 553; Evarts *v.* Ford, 6 Fish. 587; s. c. 5 O. G. 58; Fuzzard Manuf. Co. *v.* Dickenson, 3 Fish. 289; s. c. 6 Blatch. 80; Consolidated Fruit Jar Co. *v.* Wright, 12 Blatch. 149; s. c. 6 O. G. 327; 9 C. L. N. 313; Welling *v.* Rubber Co. 7 O. G. 608.

An infringement will not take place unless the invention can be practiced completely by following the specifications. An infringement is a copy made after and agreeing with the principle laid down in the patent, and if the patent does not fully describe everything essential to the making of the thing patented, there will be no infringement by the fresh invention of processes which the patentee has withheld from the public. Page *v.* Ferry, 1 Fish. 298.

It is not necessary to constitute an infringement that a man should work by the specification contained in the patent. He might not even know there was such a patent, and yet infringe it. Matthews *v.* Skates, 1 Fish. 602; Parker *v.* Haworth, 4 McLean, 370.

If the peculiar invention of the patentee is embodied in the defendant's machinery, however it may be combined with other machinery, it is appropriated the same as if it were used alone and separate from those connections. Sickels *v.* Borden, 3 Blatch. 535; Johnson *v.* Root, 1 Fish. 351; Poppenhusen *v.* Falke, 2 Fish. 181; s. c. 4 Blatch. 493; Foster *v.* Moore, 1 Curt. 279; Pitts *v.* Wemple, 6 McLean, 558; Hoffheins *v.* Brandt, 3 Fish. 218; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43; Howes *v.* Nute, 4 Fish. 263; Mallory *v.* White, 4 Fish. 628; s. c. 8 Blatch. 552; Doughty *v.* Day, 5 Fish. 224; s. c. 9 Blatch. 262.

An evasion of a patent by splitting the invention in two, and making two operations where only one is necessary, is an infringement. Baldwin *v.* Bernard, 5 Fish. 75; s. c. 9 Blatch. 509, *n.*; 2 O. G. 315.

Whoever erects or uses a patented machine does it at his peril. He takes upon himself all the chances of its being originally valid, or of its being afterwards made so by a surrender of it and the grant of a new patent which may cure any defects. Ames *v.* Howard, 1 Sum. 482.

Infringement as Affected by Result.

Where the machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same. The same result must be understood to mean the same kind of result, though there may be a difference in extent. The result is the same according to this definition whether one produces more than another or not, if the operation is to make the same article. Gray *v.* James, Pet. C. C. 394; Imlay *v.* Railroad Co. 1 Fish. 340; s. c. 4 Blatch. 227.

If the result is the same in kind it is not necessary that it shall be the same in degree. Whipple *v.* Middlesex Co. 4 Fish. 41.

That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other. Burr *v.* Duryee, 2 Fish. 275; S. C. 1 Wall. 531.

The identity or the difference between two machines is sought, in the first place, by a comparison of them, either in their elements or as a system. Wilson *v.* Barnum, 2 Fish. 635, S. C. 1 Wall. Jr. 347; 8 How. 258.

Similarity in the structure, appearance and effect of two things, is presumptive evidence of their being made in the same way. Matthews *v.* Skates, 1 Fish. 602.

It is of no consequence, in respect to the question of infringement, whether one machine is like or unlike the other in respect to its cost, adjustability, or other peculiarity of construction, provided that notwithstanding such difference the one is, in its mechanical action, operation and effect, the same as the other. Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121.

Slight differences in degree can not be regarded as of weight in determining a question of substantial similarity or substantial difference. One thing may be a little longer or a little shorter than another, or it may work a little better or a little worse, and yet the two may be substantially the same. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592.

Similarities or differences are not to be judged by the name of things, but the machines, or their several devices or elements, must be examined in the light of what they do, or what office or function they perform, and how they perform it. One thing is substantially the same as another if it perform substantially the same function or office in the same way to attain the same result, and things are substantially different when they perform different duties, or in a different way, or produce a different result. For the same reason similarities or differences are not determined by the mere fact that things are apparently the same, or of a different shape or form, but the true test of similarity or difference is the same in regard to shape or form as in regard to names. In both cases regard must be paid to the mode of operation, or the way the parts work, and the result as well as the means by which the result is attained. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

One machine is the same in substance as another, if the principle be the same in both, although the forms may be different. Sickels *v.* Borden, 3 Blatch. 535.

By the principles of a machine is not meant the original elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar device or manner of producing any given effect. Whittemore *v.* Cutter, 1 Gallis. 478.

The principle of a machine means the peculiar mode, manner, or device, by which the proposed result or effect is produced. Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87; Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259.

The word principle, as applied to the structure of a machine, means the

operative cause by which a certain effect is produced. The combination of powers is called the principle of the machine. Brooks *v.* Jenkins, 3 McLean, 432; Parker *v.* Stiles, 5 McLean, 44; Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond. 327.

Whatever is essential to produce the appropriate result of a machine independently of its mere form, is a matter of principle. Olcott *v.* Hawkins, 2 Am. L. J. 317.

The question is not which is best or is most perfect, but whether the one mode is an infringement of the rights secured by the other. Howe *v.* Abbott, 2 Story, 190; Sickles *v.* Gloucester Manuf. Co. 1 Fish. 222; S. C. 3 Wall. Jr. 196; Colt *v.* Mass. Arms Co. 1 Fish. 108; Blanchard *v.* Beers, 2 Blatch. 411; Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87; Yale Manuf. Co. *v.* North, 3 Fish. 279; S. C. 5 Blatch. 455; Alden *v.* Dewey, 1 Story, 336; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512; McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117; Imlay *v.* Railroad Co. 1 Fish. 340; S. C. 4 Blatch. 227; Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442; Adams *v.* Joliet Manuf. Co. 12 O. G. 93.

It is no defense that the machine is not as good as that of the patentee. The rights of an inventor are oftentimes affected as injuriously by the sale of poor machines in the market as by those made more strictly in conformity to his patent. Roberts *v.* Harnden, 2 Cliff. 500; Waterbury Brass Co. *v.* Miller, 5 Fish. 48; S. C. 9 Blatch. 77; Chicago Co. *v.* Busch, 4 Fish. 395; S. C. 2 Biss. 472.

It is no defense that the result is not as good, if it is substantially the same in kind, and is produced substantially by the same means. Roberts *v.* Harnden, 2 Cliff. 510.

The superiority of the defendant's machine over that of the patentee is immaterial, except so far as it goes to show a substantial difference between them. Alden *v.* Dewey, 1 Story, 336.

Two things are not the same when one is in practice substantially better than the other, if the second improvement is not gained by the use of the same means or known mechanical equivalents. Mitchell *v.* Tilghman, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299.

If the result of the mechanism used by the defendant is greatly superior to that described and claimed in the plaintiff's patent, this fact may be considered by the jury as tending to prove that the mechanism or device used by the defendant is a new invention substantially different from that described in the plaintiff's patent, to be considered, however, in connection with all the other evidence upon the subject of infringement. Singer *v.* Walmsley, 1 Fish. 558; Smith *v.* Woodruff, 6 Fish. 476; S. C. 1 McArthur, 459; 4 O. G. 635; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

The superior utility of the defendant's machine is not of itself a certain test, because it might contain the whole substance of the patentee's invention and something in addition, and the addition would not prevent it from being an infringement. Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87.

The difference of result is sometimes coupled with mechanical differences. The mechanical differences may be sufficient to show that the two machines

are not substantially the same. The differences of result and utility may be so great as to be satisfactory proof of the same fact. It may, however, be that neither of these alone would be satisfactory, yet the mechanical difference and the difference of utility, taken together, may be sufficient to satisfy the mind. Johnson *v.* Root, 1 Fish. 351.

The greater utility, which may be regarded as evidence tending to show that some new principle or mechanical power or mode of operation producing a new kind of result has been introduced, must be derived from the changes introduced, and not from the use of better material or greater skill or care in the manufacture. Many *v.* Sizer, 1 Fish. 17; Trader *v.* Messmore, 7 O. G. 385.

If the practical operation and effect of two machines is essentially different, the law looks more to the result of the mechanical arrangement than to the arrangement itself. The new and different effect in the operation of the machine reflects back upon the mechanical arrangement and construction, and characterizes the change, and may authorize an inference of a substantial change which the arrangement disconnected from the new and different effect would not. Without connecting the new effect with the change, the change might be only formal and unsubstantial. It must be borne in mind, however, that the new effect which is to give such materiality and importance to the apparently formal change, must not be looked for in the simple increase of the producing capacity of the machine, or in the reduction of the amount of power required to operate it. All this may depend upon other considerations, as upon superior mechanical skill in the construction and arrangement of the machinery. But the new effect must be of a different kind. The new result must be a result derived from a different mechanical operation and effect, and not from the same operation and effect. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Eames *v.* Cook, 2 Fish. 146.

If one machine, which is alleged to be an infringement of another, produces a different result, or, in other words, is of greater utility than the preceding machine, it may be some evidence of a difference, a substantial difference, between them, and the utility of one over the other may be so great as to be satisfactory evidence that some new principle is involved, and that it is not substantially the same. Johnson *v.* Root, 1 Fish. 351; Eames *v.* Cook, 2 Fish. 146; Many *v.* Sizer, 1 Fish. 17; Blanchard *v.* Beers, 2 Blatch. 411.

If two things perform different work or in a way substantially different, or do not accomplish substantially the same result, then they are substantially different. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592.

If the patent embraces one or more elements of a machine, but not the entire machine, any person may make, use or vend all other parts of the machine, and may employ an element analogous to that which is patented, provided it is substantially different. Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

Formal Change.

A patentee is not confined to the precise arrangement in the construction of his machine which he has described in his patent. Formal changes are nothing; mere mechanical changes are nothing; all these may be made out-

side of the description to be found in the patent, and yet the machine after it has been thus changed in its construction is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Sargent *v.* Larned, 2 Curt. 340; Brooks *v.* Jenkins, 3 McLean, 432; Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Taylor *v.* Archer, 4 Fish. 449; S. C. 8 Blatch. 315; Blanchard's Factory *v.* Warner, 1 Blatch. 258; Stanley *v.* Whipple, 2 McLean, 35; Jurgensen *v.* Magnin, 5 Fish. 237; S. C. 9 Blatch. 294; Buck *v.* Hermance, 1 Blatch. 398; Bantz *v.* Elsas, 6 O. G. 117; Odiorne *v.* Winkley, 2 Gallis. 51; Imlay *v.* Railroad Co. 1 Fish. 340; S. C. 4 Blatch. 227; Mowry *v.* Whitney, 3 Fish. 157; S. C. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond. 45; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224; Cook *v.* Howard, 4 Fish. 269; Wood Paper Co. *v.* Glens Falls Co. 4 Fish. 324; S. C. 8 Blatch. 573; Dennis *v.* Eddy, 4 Fish. 423; Hoffman *v.* Aronson, 4 Fish. 456; S. C. 8 Blatch. 324; 4 A. L. T. (N. S.) 110.

A change in form from the construction of an existing machine is not a substantial change in the eye of the patent law, nor is a change in proportions. These changes require no great ingenuity; at all events, they do not call for the exercise of the inventive faculties. They are simply the work of a mechanic of ordinary skill, and are entitled to no particular consideration on an inquiry into the question of identity between the construction of two machines. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Many *v.* Jagger, 1 Blatch. 372; O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Gray *v.* James, Pet. C. C. 394; Case *v.* Brown, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; Lowell *v.* Lewis, 1 Mason, 182; Singer *v.* Walmsley, 1 Fish. 558; Myers *v.* Frame, 4 Fish. 493; S. C. 8 Blatch. 446; Smith *v.* Downing, 1 Fish. 64; Park *v.* Little, 3 Wash. C. C. 196; Reutgen *v.* Kanowrs, 1 Wash. C. C. 168; Dixon *v.* Moyer, 4 Wash. C. C. 68; Brooks *v.* Bicknell, 3 McLean, 250; Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327; Brooks *v.* Jenkins, 3 McLean, 432; Wilbur *v.* Beecher, 2 Blatch. 132; Parker *v.* Stiles, 5 McLean, 44; Gibson *v.* Harris, 1 Blatch. 167; Davis *v.* Palmer, 2 Brock. 298; Hussey *v.* McCormick, 1 Fish. 509; S. C. 1 Biss. 300; Johnson *v.* Root, 1 Fish. 351; Morey *v.* Lockwood, 8 Wall. 230; Whiteley *v.* Kirby, 11 Wall. 678; Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Aiken *v.* Dolan, 3 Fish. 197; Many *v.* Sizer, 1 Fish. 17; Roberts *v.* Harnden, 2 Cliff. 500; Potter *v.* Wilson, 2 Fish. 102; Conover *v.* Dohrman, 3 Fish. 382; S. C. 6 Blatch. 60; Colt *v.* Mass. Arms Co. 1 Fish. 108; Teese *v.* Phelps, 1 McA. 48; Clark Patent Co. *v.* Copeland, 2 Fish. 221; Blake *v.* Eagle Works Manuf. Co. 4 Fish. 591; S. C. 3 Biss. 77; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 168; Jackson *v.* Allen, 120 Mass. 64.

The new form of the machinery embodying the new ideas, is not a material part of the patentee's invention, for the reason that the embodiment of his ideas into working machinery, is rather the work of the skillful mechanic than that of the inventor. Many inventors of improvements in machinery, not being mechanics themselves, are obliged to obtain the aid of skillful mechanics in embodying their ideas in practical working machinery. Different mechanics would perhaps embody them by different arrangements of machin-

ery—all conforming, however. to the principles and ideas of the inventor. Hence, the mere form of the defendant's machinery must be disregarded, and the substance of its arrangement and its method of working must be examined for the purpose of seeing whether the ideas of the inventor are incorporated in it. Sickles *v.* Borden, 3 Blatch. 535; Treadwell *v.* Parrott, 3 Fish. 124; S. C. 5 Blatch. 369; Gibson *v.* Harris, 1 Blatch. 167.

A difference in the mechanical arrangement and construction of two machines, is not necessarily a test by which to determine that the two are not identical. They may be apparently very different externally, and still embrace the same substantial identity in principle or mode of operation. So, on the other hand, the converse of the proposition is equally true. The two may apparently be very similar externally, and still in principle and mode of operation be very different. There is no better mode of examining a question of this kind, than to inquire whether the mechanical arrangement and construction of the two embrace the same set of ideas, the same leading features or ideas, which in practical operation produce the useful result. In other words, whether the arrangement and combination of the parts of machinery found in each are substantially the same, and operate in substantially the same way in producing the result. Hence, the real question as it respects the identity of the two machines, looks simply to their mechanical arrangement and construction as to whether or not the defendant's incorporates in its structure and operation the spirit and substance of the plaintiff's improvement, that is, uses the arrangement and mechanism of the plaintiff's, to perform the same function or produce the same effect in the same way or substantially the same way. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Smith *v.* Higgins, 1 Fish. 537; Sickles *v.* Borden, 3 Blatch. 535; Florence S. & M. Co. *v.* G. & B. S. M. Co. 110 Mass. 70; Morris *v.* Barrett, 1 Fish. 461; S. C. 1 Bond. 254; Birdsell *v.* McDonald, 6 O. G 682; Blanchard *v.* Beers, 2 Blatch. 411; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29.

If the substance and form of the inventions are separable, and the substance of the invention which the patent is designed to secure, is to be found in the manufacture of the respondent's, although copied and embodied in a form not described, or differing from the form described and specifically claimed in the patent, there is an infringement. Murphy *v.* Eastham, 5 Fish. 306; S. C. 1 Holmes, 113; 2 O. G. 61.

Where form and substance are inseparable, it is enough to look at the form only. Where they are separable, where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure. Where that is found there is an infringement, and it is not a defense that it is embodied in a form not described and in terms claimed by the patentee. Winans *v.* Denmead, 15 How. 330; Many *v.* Jagger, 1 Blatch. 372: Sargent *v.* Larned, 2 Curt. 340.

Equivalents.

When, in mechanics, one device does a particular thing or accomplishes a particular result, every other device known or used in mechanics, which

skillful and experienced workmen know will produce the same result or do the same particular thing, is a known mechanical substitute for the first device. It is sufficient to constitute known mechanical substitutes, that when a skillful mechanic sees one device doing one particular thing, that he knows the other devices whose use he is acquainted with will do the same thing. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

An equivalent means something that does substantially the same thing in substantially the same way. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Conover *v.* Rapp, 4 Fish. 57.

By equivalents in machinery, is usually meant the substitution of merely one mechanical power for another, or one obvious and customary mode for another of effecting a like result. Smith *v.* Downing, 1 Fish. 64.

The substantial equivalent of a thing is the same as the thing itself. If two machines do the same work in substantially the same way and accomplish substantially the same result, they are the same. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Waterman *v.* Thomson, 2 Fish. 461; White *v.* Boker, 3 Fish. 66.

The term equivalent has two meanings; the one relates to the results that are produced, and the other, to the mechanism by which those results are produced. Two things may be equivalent, that is, the one equivalent to the other as producing the same result when they are not the same mechanical means. Mechanical equivalents are spoken of as different from equivalents that merely produce the same result. A mechanical equivalent as generally understood, is where the one may be adopted instead of the other by a person skilled in the art from his knowledge of the art. But there may be equivalents in producing the same result, each of which is an independent matter of invention, and in that sense they are not mechanical equivalents. Johnson *v.* Root, 1 Fish. 351; Burden *v.* Corning, 2 Fish. 477.

The substitution of a mechanical equivalent as it is termed, in the construction of a machine, is not a substantial change. There are very many devices in construction that can be made by a skillful mechanic, differing very much from each other in appearance, but which in the eye of the patent law are regarded as identical. For instance, an inventor in the construction of his machine, desires a given power in order to give practical operation and effect to his discovery. One mechanic may furnish the power by means of a lever; another by means of a screw—two very different instruments; yet so far as the use of the instruments, and so far as their purpose to furnish the power is concerned, they are regarded simply as mechanical equivalents, and the use of one in one machine, does not distinguish that machine from a machine in which the other is found. So, too, a given power may be obtained by a spring, or by a weight, or by a pulley—appparently very different devices, yet as they are used for the same purpose and to accomplish the same end in machinery, they are regarded as substantially identical. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How 156; Page *v.* Ferry, 1 Fish. 298; O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Lond, 259; Case *v.* Brown, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; Colt *v.* Mass. Arms Co. 1 Fish. 108; Smith *v.* Downing, 1 Fish. 64; Gallahue *v.*

Butterfield, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645; Singer *v.* Walmsley, 1 Fish. 558; Roots *v.* Hyndman, 6 Fish. 439; S. C. 4 O. G. 29; Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Ives *v.* Hamilton, 6 Fish. 244; S. C. 92 U. S. 426; 10 O. G. 336; Pitts *v.* Edmonds, 2 Fish. 52; S. C. 1 Biss. 168; Sarven *v.* Hall, 6 Fish. 495; S. C. 11 Blatch. 295; 4 O. G. 666.

The doctrine respecting the use of mechanical equivalents, is not confined by the patent law to those elements which are strictly known as such in the science of mechanics. In the present advanced stage of that science, there are different well known devices, any one of which may be adopted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another can not be treated as an invention. It does not belong to the subject of invention, but of construction. The substance of the invention does not consist in the identical devices used, but in a practical and described mode of effecting certain operations, and when the patentee has described what those operations are, and one practicable mode of effecting them, he has enabled constructors to effect these operations, not only by the identical devices he employed, but by all other known substitutes. Foster *v.* Moore, 1 Curt. 279.

Alternative but different mechanisms which produce in whole or in part the same or similar useful effects are not mechanical equivalents in that sense in which their use constitutes an infringement. Wells *v.* Hagaman, 29 Leg. Int. 405.

In order to constitute one mechanical device the equivalent of another, it is not sufficient that it accomplishes the same result or produces the same effect, unless that effect is produced by substantially the same mode of operation. Conover *v.* Roach, 4 Fish. 12; Merriam *v.* Drake, 5 Fish. 259; S. C. 9 Blatch. 336.

Although a handle is not in general the equivalent of a lever, yet if it is used to perform the same functions in substantially the same way, it may be an equivalent. Brown *v.* Guild, 23 Wall. 181; S. C. 6 O. G. 292; 7 O. G. 739.

A device which has apparently different mechanical adaptabilities can not be considered a mechanical equivalent. Mechanical equivalents are not those merely which produce the same result. Smith *v.* Marshall, 10 O. G. 375.

If a party is not the original inventor of the principle as well as of the machine, he has no right to invoke the doctrine of equivalents, for it does not belong to him; but if he is the inventor of the principle which he embodies in his machine, as well as the first inventor of the machine which carries it out, he has a right to invoke the doctrine of equivalents. Singer *v.* Walmsley, 1 Fish. 558.

If the change constitutes a mechanical equivalent in reference to the means used by the patentee, and if, besides being an equivalent, it accomplishes some other advantage beyond the effect or purpose accomplished by the patentee, it will still be an infringement as respects what is covered by the patent, although the further advantage may be a patentable subject as an improvement on the former invention. Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Converse *v.* Cannon, 2 Woods, 7; S. C. 9 O. G. 105; Carstaedt *v.* U.

S. Corset Co. 13 Blatch. 371; 10 O. G. 3; Sarven *v.* Hall, 5 Fish. 415; S. C. 9 Blatch. 524; 1 O. G. 437.

Although the commissioner required the patentee to disclaim a claim in specific terms for an equivalent, yet he may treat a person who uses it as an infringer. Union M. C. Co. *v.* U. S. C. Co. 11 O. G. 1113.

The patentee of a composition may, if he choose, confine himself to the specific ingredients mentioned, and expressly exclude all others, or he may expressly exclude some or one other. If he does so, it can not be maintained that what he has expressly disclaimed is in point of law claimed although it is an equivalent for one of the elements claimed. Byam *v.* Farr, 1 Curt. 260.

The term equivalent, when used in regard to the chemical action of such fluids as can be discovered only by experiment, only means equally good. Tyler *v.* Boston, 7 Wall. 327.

Where a patent is granted for a composition made of several ingredients, it covers and embraces known equivalents of each of the ingredients. Matthews *v.* Skates, 1 Fish. 602; Woodward *v.* Morrison, 5 Fish. 357; S. C. 1 Holmes, 124; 2 O. G. 120; Byam *v.* Eddy, 2 Blatch. 521; U. S. Felting Co. *v.* Manuf. Co. 9 O. G. 202; Allen *v.* Hunter, 6 McLean, 303; Poppenhusen *v.* Falke, 2 Fish. 213; Byam *v.* Eddy, 24 Vt. 666.

An equivalent of any substance is another substance having similar properties and producing substantially the same effect. Matthews *v.* Skates, 1 Fish. 602.

Where water is used in a process merely as a fluid, the use of benzine or any other substance possessing that property of water which is made available in the process, is within the scope of the patent as a manifest equivalent. Roberts *v.* Roter, 5 Fish. 295.

Whether one thing is a mechanical equivalent for another is a question of fact, and is to be determined from all the circumstances of the case by attending to the consideration whether the one contrivance is used for the same purpose, performs the same duties, or is applicable to the same object as the other. Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Howe *v.* Williams, 2 Fish. 395; S. C. 2 Cliff. 245.

Mere formal alterations of a combination in letters patent do not constitute any defense to the charge of infringement, as the inventor of a combination is as much entitled to suppress every other combination of the same ingredients to produce the same result, not substantially different from what he has invented and caused to be patented as the inventor of any other patented improvement. Such inventors may claim equivalents as well as any other class of inventors, and they have the same right to suppress every other subsequent improvement not substantially different from what they have invented and secured by letters patent. The withdrawal of one ingredient in a patented combination and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination, and if the ingredient substituted performs substantially the same function as the one withdrawn, such substitution of one ingredient for another will not avoid the charge of infringement. Storrs *v.* Howe, 10 O. G. 421; Vogle *v.* Semple, 11 O. G. 923; S. C. 9 C. L. N. 217; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Taylor *v.* Garretson, 5 Fish. 116; S. C. 9 Blatch.

156; Gould *v.* Rees, 6 Fish. 106; S. C. 15 Wall. 187; 2 O. G. 624; Gill *v.* Wells, 22 Wall. 1; S. C. 6 O. G. 881; 2 A. L. T. (N. S.) 101; Conover *v.* Roach, 4 Fish. 12; Blake *v.* Robertson, 6 Fish. 509; S. C. 11 Blatch. 237; 6 O. G. 297; Conover *v.* Rapp, 4 Fish. 57; Webster *v.* Carpet Co. 5 O. G. 522; Sayles *v.* C. & N. R. Co. 4 Fish. 584; S. C. 3 Biss. 52; Rice *v.* Heald, 13 Pac. L. R. 33; Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Washing Machine Co. *v.* Lincoln, 4 Fish. 379; Graham *v.* Mason, 5 Fish. 1; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512; King *v.* Louisville Cement Co. 6 Fish. 336; S. C. 4 O. G. 181; Gorham *v.* Mixter, 1 Am. L. J. 539; Cochrane *v.* Deener, 11 O. G. 637; S. C. 4 W. L. R. 99.

Mere Mechanical Skill.

In order to determine whether the change in the arrangement and construction of an existing machine is to be considered as a substantial change or not, it must be ascertained and determined whether the change is the result of mechanical skill worked out by mechanical devices—of a knowledge that belongs to that department of labor, or whether the change is the result of mind, of genius, of invention in which there is something more than mere mechanical skill and ingenuity. A change in the arrangement and construction is not substantial unless there is embodied in it, over and beyond the skill of the mechanic, that inventive element of the mind which is to be found in every machine or improvement that is the proper subject of a patent. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Case *v.* Brown, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; Gibson *v.* Harris, 1 Blatch. 117; Hamilton *v.* Ives, 6 Fish. 244; S. C. 3 O. G. 30; Blanchard *v.* Beers, 2 Blatch. 411; Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 4 O. G. 31; Gibson *v.* Van Dresar, 1 Blatch. 532; Birdsell *v.* McDonald, 6 O. G. 682; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Coffin *v.* Ogden, 3 Fish. 640; S. C. 7 Blatch. 61; Goodyear *v.* Honsinger, 3 Fish. 147; S. C. 2 Biss. 1; Goodyear *v.* Schenck, 3 Fish. 82; Thayer *v.* Wales, 5 Fish. 130; S. C. 9 Blatch. 170; Renwick *v.* Pond, 5 Fish. 569; S. C. 10 Blatch. 39; 2 O. G. 392.

If a person has an invention, and another person looking at the description of it, can, from his knowledge of the subject, pass to the other thing that is used without any invention, then the one is substantially the same as the other. It is not necessary that every unskilled person shall see how he passes; but if a person skilled and competent in the art is able, by looking at the description with care to see that the result may be attained in a different mode or in a different manner, and it is done in that different mode or in that different manner by the use of the knowledge which he has in the art, that would not be a new invention or substantially different from the original. Johnson *v.* Root, 1 Fish. 351.

The patentee is protected from obvious modes readily adopted without invention for accomplishing the same end. Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; S. C. 4 O. G. 31.

The mere exercise of skill, ingenuity, thought, and experiment in the production of an article is not sufficient to obviate the charge of infringement.

for it may be that they would produce an article substantially the same, though formally different, or might be employed to prevent a similitude in form, although the principle be the same, and so evade the patent. Many *v.* Sizer, 1 Fish. 17.

Practice and experience in the working of a machine may lead to highly beneficial modifications of the form. This is the natural and usual result in the operation of machinery newly invented and constructed. It requires time and experience to bring it to perfection. But the right of the inventor does not depend upon the questions, whether the machine is more or less perfect, or whether slight modifications in the arrangement of the machinery, or in the finish of the parts composing it, may or may not better accomplish the end sought to be attained; but upon the question whether the machinery constructed as described in the patent will or will not accomplish the end practically and usefully in the way pointed out. If it will, the inventor is entitled to the protection which the government has granted him; and any one using the principle thus embodied is guilty of an infringement, however he may have perfected the machinery by superior skill in the mechanical arrangement and construction of the parts. Such perfecting is but the skill of the mechanic, not the genius of the inventor. Kinsman *v.* Parkhurst, 1 Blatch. 488; S. C. 18 How. 289; Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Tracy *v.* Torrey, 2 Blatch. 275; Wilbur *v.* Beecher, 2 Blatch. 132.

A patentee is entitled to use all modifications resulting from experience in the use of his invention which do not involve any new or further invention. Decker *v.* Grote, 6 Fish. 143; S. C. 10 Blatch. 331; 3 O. G. 65.

The patentee is entitled to the exclusive use of the mechanical organization, device, or means for all the uses and purposes to which it can be applied —to every function, power, and capacity of his patented machine or device— without regard to which he supposed originally it was most applicable. McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117.

When an Infringement.

The inquiry is not whether the principle of the two articles is the same. If the principle is the same, and the effect is similar in both, in contemplation of law they are identical. Buerk *v.* Imhausen, 5 O. G. 752; Hike *v.* P. & W. R. R. Co. 6 O. G. 575; Kursheedt *v.* Werner, 12 Blatch. 530; S. C. 8 O. G. 146; Wicks *v.* Stevens, 2 Woods, 310; G. & B. Manuf. Co. *v.* Tirrell, 12 Blatch. 144; S. C. 8 O. G. 2; King *v.* Werner, 12 Blatch. 270; S. C. 8 O. G. 361; R. & E. Manuf. Co. *v.* P. & F. C. Manuf. Co. 12 Blatch. 36; S. C. 7 O. G. 383; Union Paper Bag Co. *v.* Newell, 6 Fish. 582; S. C. 11 Blatch. 379; 5 O. G. 459; Aultman *v.* Holley, 6 Fish. 534; S. C. 11 Blatch. 304; 5 O. G. 3; Bigelow *v.* Matthews, 7 Blatch. 77; McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275; McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O G. 117; Brooks *v.* Bicknell, 3 McLean. 250; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Doubleday *v.* Sherman, 3 Fish. 369; Stuart *v.* Shantz, 6 Fish 35; S. C. 2 O. G. 524; 9 Phila. 376; Buerk *v.* Valentine, 5 Fish. 366; S. C. 9 Blatch. 479; 2 O. G. 295; Jenkins *v.* Johnson, 6 Fish. 433; S. C. 9 Blatch. 516; Seymour *v.*

Marsh, 6 Fish. 115; S. C. 2 O. G. 675; 9 Phila. 380; Baldwin *v.* Schultz, 5 Fish. 75; S. C. 9 Blatch. 494; 2 O. G. 315; Parker *v.* Haworth, 4 McLean, 370; Potter *v.* Davis Sewing Machine Co. 3 Fish. 472; Smith *v.* Pearce, 2 McLean, 176; Harwood *v.* Mill River Co. 3 Fish. 526; McComb *v.* Beard, 6 Fish. 254; S. C. 10 Blatch. 350; 3 O. G. 33; Sarven *v.* Hall, 6 Fish. 495; S. C. 11 Blatch. 295; 4 O. G. 666; Barclay *v.* Thayer, 12 Blatch. 109; S. C. 6 O. G. 20; Woolcocks *v.* Many, 5 Fish. 72; S. C. 9 Blatch. 139; Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 42; Black *v.* Thorne, 5 Fish. 550; S. C. 10 Blatch. 66; 2 O. G. 388; Sloat *v.* Patton, 1 Fish. 154; Ormsbee *v.* Wood, 3 Fish. 372; Kidd *v.* Spence, 4 Fish. 37; Hawes *v.* Washburne, 5 O. G. 491; King *v.* Mandelbaum, 4 Fish. 577; S. C. 8 Blatch. 468; Hitchcock *v.* Tremaine, 4 Fish. 508; S. C. 8 Blatch. 440; Corliss *v.* W. & W. Manuf. Co. 2 Fish. 199; Doubleday *v.* Sherman, 3 Fish. 371; Kendricks *v.* Emmons, 6 Fish. 462; S. C. 1 Holmes, 334; 4 O. G. 398; Westlake *v.* Cartter, 6 Fish. 519; S. C. 4 O. G. 636; Seymour *v.* McCormick, 3 Blatch. 209; S. C. 19 How. 96; La Baw *v.* Hawkins, 6 O. G. 724; Knox *v.* Loweree, 6 O. G. 802; Welling *v.* Rubber Co. 7 O. G. 606; Weston *v.* Nash, 1 Holmes, 488; S. C. 7 O. G. 1096; Hartshorne *v.* Almy, 1 Holmes, 493; S. C. 8 O. G. 94; Stover *v.* Halsted, 13 Blatch. 95; S. C. 8 O. G. 558; Magic Ruffle Co. *v.* Elm City Co. 13 Blatch. 151; S. C. 8 O. G. 773; Schillinger *v.* Gunther, 11 O. G. 831; N. Y. Rubber Co. *v.* Chaskel, 9 O. G. 923; Earle *v.* Harlow, 9 O. G. 1018; Dalton *v.* Nelson, 13 Blatch. 357; S. C. 9 O G. 1112; Pickering *v.* Phillips, 10 O. G. 420; Tucker *v.* Tucker Manuf. Co. 10 O. G. 464; Collender *v.* Canieo, 10 O. G. 467; Stevens *v.* Pritchard, 10 O. G. 505; Holbrook *v.* Small, 10 O. G. 508; Robertson *v.* Blake, 11 O. G. 877; Olcott *v.* Hawkins, 2 Am. L. J. 317; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29; Whipple *v.* Middlesex Co. 4 Fish. 41; Carter *v.* Baker, 4 Fish. 404; S C. 1 Saw. 512; Parham *v.* Sewing Machine Co. 4 Fish. 468; Henderson *v.* Cleveland Stove Co. 12 O. G. 4; Adams *v.* Joliet Manuf. Co. 12 O. G. 93.

The inventor usually sets forth what he conceives to be the best form or mode under which his machine may be used to produce the required result. In order to ascertain the true nature and value of his invention, the substance and principle of it must be separated from its accidents; its essence from its modes. A mere change in the latter while the former are retained will not acquit the party making it from the charge or guilt of pirating the invention. Blanchard *v.* Reeves, 1 Fish. 103.

Where the patent prescribes a use of water to a certain extent, and the effect can be produced by using less, he is an infringer who produces the result contemplated by the patentee by such use only of the described means as is essential to that end. Roberts *v.* Roter, 5 Fish. 295.

It is essential to the validity of a patent for a process to show how it may be adapted to practical use. In showing this the inventor may describe mechanical means of applying, or peculiarly shaped vessels for containing, any of the ingredients used in his process or art. But they constitute no part of his invention. Another person may discover new and useful means of applying or using the inventor's process, and be entitled to a patent for that improvement without the right to use the process. Piper *v.* Brown, 4 Fish. 175; S. C. 1 Holmes, 20; 91 U. S. 37.

A patent for a device can not be avoided by dividing it into two parts which, when combined, produce the same result in substantially the same way. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

If the invention consists in the discovery of a principle in science which is made practically useful by the patented process, any one who adopts that principle to an available or practical extent so far invades the exclusive right of the patentee. If he adopts the patentee's invention in part only, and uses an agency in his process which is not a part of the patentee's invention, he is an infringer. Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511.

Although there may be two things which differ from the patent in something beyond mechanical equivalents or form or proportion, and therefore are not to be treated as violations; yet if there is a third thing introduced in the defendant's machine which is covered by the patent, the party is liable for that third, although not for the other two. Colt *v.* Mass. Arms Co. 1 Fish. 108.

A piece in a machine may perform two functions. If all the parts are virtually used, it is no excuse to say one part is not nominally retained, but its office is performed by something else under a different name. Brooks *v.* Norcross. 2 Fish. 661.

If the plan of the defendant's machine is in substance and effect a colorable evasion of the patentee's contrivances, it is an infringement. If the defendant takes the same general plan and applies it for the same purpose, although he may have varied the mode of construction, it will be substantially and in the eye of the patent law the same thing. Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Johnson *v.* McCullough, 4 Fish. 170; Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87; Blandy *v* Griffith, 3 Fish. 609; Gallahue *v.* Butterfield, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645.

The right to make such changes in an ingredient as it necessarily undergoes in any mere process of manufacturing the composition is inseparable from the right to use the thing itself. Byam *v.* Farr, 1 Curt. 260.

The right to use an article as an ingredient in a composition is a right to use it in the state in which it is ordinarily bought and used. Byam *v.* Farr, 1 Curt. 260.

Where a slight change is made in a machine by which a new result is brought about, the invention is not extended beyond the change; but where something elementary is discovered, and fairly constitutes a part of the invention, no other person is permitted to use that elementary part without paying tribute to the patentee. Cornell *v.* D. & B. Brewing Co. 11 O. G. 331; S. C. 9 C. L. N. 142.

If a claim embraces only the entire and complete mode described, the use of only a part of the mode is not an infringement. Byam *v.* Farr, 1 Curt. 260.

Where the invention embraces the entire machine, any person is an infringer who, without license, makes or uses any portion of the machine. Under such a patent the patentee holds the exclusive right to make and use, and vend to others to be used, the entire machine; and if another, without license, makes, uses or vends any portion of it, he invades the rights of the patentee.

Union Sugar Refinery *v.* Mathewson, 2 Fish. 600; Mabie *v.* Haskell, 2 Cliff. 507; Moody *v.* Fiske, 2 Mason, 112.

When a device is capable of being used in another mode, and all its benefits are fully secured if it is so used, a change in the mode will be deemed an infringement. Union Paper Bag Co. *v.* Nixon, 9 O. G. 691; S. C. 3 Cent. L. J. 223.

Mere contrivances to produce power, such as any mechanic can supply, are no part of the invention. Blanchard's Factory *v.* Warner, 1 Blatch. 258.

The fact that another may dispense with a part of the machine described by the patentee, and use the invention, will not give him a right to use that invention. Ely *v.* Monson Manuf. Co. 4 Fish. 64.

In a certain sense nearly all new machines are but combinations of old devices, that is to say, they do or may combine frames, bolts, screws, nuts, rods, pulleys, cranks, wheels, levers, pins, nails, and boards, and, as the case may be, various other and more complicated devices, none of which, regarded singly or separately, are new, and yet the machine formed by the combination is new as a structure, new in its operation, and new in the effect produced. The patent in such case is not for a mere combination, and another machine, having the like construction, operation and effect, in all that constitutes the principle of the machine and the efficient means of its operation, is an infringement of the patent, notwithstanding it may be moved by a less number of wheels, or be held together by a less number of clamps, screws, nails, bolts, or keys, and notwithstanding drum and pulley may be substituted for cog-wheels, or other gear or bolts for screws or nuts, or like changes be made in other devices employed to construct the machine. Waterbury Brass Co. *v.* Miller, 5 Fish. 48; S. C. 9 Blatch. 77.

If two patents conflict, the more recent must give way to the elder, because the one who patents an invention first is entitled to the protection of the principle in it over everybody else who patents it afterwards. Colt *v.* Mass. Arms Co. 1 Fish. 108; Westlake *v.* Cartter, 6 Fish. 519; S. C. 4 O. G. 636.

If there is more than one claim in a patent, it is not necessary to prove that the defendant has infringed all the claims, but it is sufficient if any one of such claims has been infringed. Singer *v.* Walmsley, 1 Fish. 558; McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117; Wyeth *v.* Stone, 1 Story, 273; Cook *v.* Ernest, 5 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 89; Morris *v.* Barrett, 1 Fish. 461; S. C. 1 Bond, 254; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Pitts *v.* Whitman, 2 Story, 609; Moody *v.* Fiske, 2 Mason, 112; Colt *v.* Mass. Arms Co. 1 Fish. 108; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87.

An improvement will not justify the use of the prior patent without the consent of the first patentee. O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Alden *v.* Dewey, 1 Story, 336; Gray *v.* James, Pet. C. C. 394; Hays *v.* Sulsor, 1 Fish. 532; S. C. 1 Bond. 279; Johnson *v.* Root, 1 Fish. 351; Howe *v.* Morton, 1 Fish. 586; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511; Pitts *v.* Edmonds, 2 Fish. 52; S. C. 1 Biss. 168; Imlay *v.* Railroad Co. 1 Fish. 340; S. C. 4 Blatch. 227; Carr *v.* Rice, 1 Fish. 198; Woodworth *v.* Rogers, 3 W. & M. 135; Conover *v.* Roach, 4 Fish. 12; Foster

v. Moore, 1 Curt. 279; Blake *v.* Stafford, 3 Fish. 294; S. C. 6 Blatch. 195; Brooks *v.* Bicknell, 4 McLean, 70; Middletown Co. *v.* Judd, 3 Fish. 141; Pitts *v.* Wemple, 6 McLean, 558; Goodyear *v.* Berry, 3 Fish. 439; S. C. 2 Bond, 189; Goodyear *v.* Muller, 3 Fish. 420; Colt *v.* Mass. Arms Co. 1 Fish. 108; Goodyear Dental Co. *v.* Evans, 3 Fish. 390; S. C. 6 Blatch. 121; Washburn *v.* Gould. 3 Story, 122; Winans *v.* N. Y. & Harlem R. R. Co. 4 Fish. 1; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29; Cook *v.* Howard, 4 Fish. 269; Whipple *v.* Middlesex Co. 4 Fish. 41; Cowing *v.* Rumsey, 4 Fish. 275; S. C. 8 Blatch. 36; Conover *v.* Rapp, 4 Fish. 57; Eickemeyer Machine Co. *v.* Pearce, 6 Fish. 219; S. C. 10 Blatch. 403; 3 O. G. 150; Chicago Co. *v.* Busch, 4 Fish. 395; S. C. 2 Biss. 472; Fales *v.* Wentworth, 5 Fish. 302; S. C. 1 Holmes, 96; 2 O. G. 58; Burrall *v.* Jewett, 2 Paige, 134; Jenkins *v.* Walker, 5 Fish. 347; S. C. 1 Holmes, 120; 1 O. G. 359; Johnson *v.* Linen Co. 33 Conn. 436; American Pavement Co. *v.* Elizabeth, 6 Fish. 424; S. C. 3 Q. G. 522; Waterbury Brass Co. *v.* Miller, 5 Fish. 48; S. C. 9 Blatch. 77; Wells *v.* Gill, 6 Fish. 574: S. C. 4 O. G. 669; Westinghouse *v.* G. & R. Brake Co. 9 O. G. 538; Hartshorn *v.* Shorey, 9 O. G. 595; Morse *v.* Bain, 9 West. L. J. 106; Robertson *v.* Blake, 11 O. G. 877; Kittle *v.* Frost, 5 Fish. 213; S. C. 9 Blatch. 214; Pearl *v.* Ocean Mills, 11 O. G. 2; Murphy *v.* Kissling, 1 Holmes, 432; S. C. 7 O. G. 302; Arkell *v.* Paper Bag Co. 7 Blatch. 475; Batchelder *v.* Moulton, 6 Fish. 488; S. C. 11 Blatch. 303; 4 O. G. 501.

If the modification is merely an improvement, it is an infringement; if it displaces and supersedes the patented invention, it is not. Whipple *v.* Middlesex Co. 4 Fish. 41.

If a patent is granted for an improvement upon an invention covered by a prior patent, such improvement can not be used if by its use the prior patent is infringed. Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43; Jackson *v.* Allen, 120 Mass. 64.

The original patentee can not use an improvement upon his patent without a license from the inventor. Pitts *v.* Wemple, 6 McLean, 558; Conover *v.* Roach, 4 Fish. 12; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29; Spaulding *v.* Tucker, 1 Deady, 649; Reutgen *v.* Kanowrs, 1 Wash. C. C. 168.

When a person has invented some mode of carrying into effect a law of natural science or a rule of practice, he is entitled to protect himself from all other modes of making the same application. The substantial identity, therefore, that is to be looked to respects that which constitutes the essence of the invention, namely, the application of the principle. If the mode of carrying the same principle into effect adopted by the defendant still shows that the principle admits of the same application in a variety of forms or by a variety of apparatus, such mode is a piracy of the invention. But if the defendant has adopted variations which show that the application of the principle is varied, that some other law of science, or rule of practice, is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement. Wintermute *v.* Redington, 1 Fish. 239; Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511.

It would seem that where a patent is obtained without a claim to the invention of the machinery through which a valuable result is produced, a precise specification is required, and the test of infringement is whether the

defendant has used substantially the same process to produce the same result. Le Roy *v.* Tatham, 14 How. 156; S. C. 2 Blatch. 474.

When no Infringement.

If the defendant's invention is a substitution for the original invention, then it is not substantially the same. Johnson *v.* Root, 1 Fish. 351.

If the patent is for an old instrument used to accomplish a new result, there is no infringement unless the defendant uses substantially the same instrument in substantially the same manner as that set forth in the patent. Johnson *v.* Root, 1 Fish. 351.

When a patentee covers with his patent the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one which he himself, after repeated experiments, had rejected. Aiken *v.* Bemis, 3 W. & M. 348.

If a person of competent skill could not, from the description given by the patentee, make a machine like the defendant's, then there is no infringement. If he could not make one substantially like the defendant's, it would follow either that the thing patented could not, from the description given by the patentee, be made by a person of competent skill, or that, when made, i would be substantially different from the defendant's. This, however, merely involves the question of substantial identity. Many *v.* Sizer, 1 Fish. 17.

If the devices used hy the defendant are old, there is no infringement, although they are equivalents for the patentee's devices. Dennis *v.* Cross, 6 Fish. 138; S. C. 3 Biss. 389.

That is a substantial identity which comprehends the application of the principle of the invention. If a party adopts a different mode of carrying the same principle into effect, and the principle admits a variety of forms, there is an identity of principle, though not an identity of mode. Page *v.* Ferry, 1 Fish. 298.

If no part of the patent which is valid has been used by the defendant, he can not be made an infringer by an argument which mingles the valid and invalid parts, and calls it a unit, and then claims that the defendant is an infringer because he has used one part of this unit, although it was a part as to which the patent is void. Jones *v.* Morehead, 1 Wall. 155.

After a patent has been obtained for a particular thing by one person, another person, without appropriating that patent, may invent a new mode of accomplishing the same or a similar object, and the latter will be entitled to a patent for his discovery. He must, however, invent something material and new that is essential to the subject-matter of the invention. If he introduces a new element or principle into the subject-matter of the invention, there is no infringement. Pitts *v.* Wemple, 2 Fish. 10: S. C. 1 Biss. 87.

If a mechanical element is materially different in its form and principle, and the effect produced by it, from the same as used in the patented machine, there is no infi ingement. Pitts *v.* Wemple, 6 McLean, 558.

If the invention claimed be itself but an improvement on a known machine, by a mere change of form or combination of parts, the patentee can not treat another as an infringer who has improved the original machine by

use of a different form or combination performing the same functions. The inventor of the first improvement can not invoke the doctrine of equivalents to suppress all other improvements which are not colorable invasions of the first. Burr *v.* Duryee, 2 Fish. 275; S. C. 1 Wall. 531; McCormick *v.* Talcot, 20 How. 402; S. C. 6 McLean, 539; Union Sugar Refinery *v.* Matthiesson, 2 Fish. 600; Taylor *v.* Garretson, 5 Fish. 116; S. C. 9 Blatch. 156.

An evasion of a patent which is not an invasion of it is *damnum absque injuria*. Every man has a right to make an improvement in a machine and evade a previous patent, provided he does not invade the rights of the patentee. Burr *v.* Duryee, 2 Fish. 275; S. C. 1 Wall. 531; Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9.

An improvement in the principle of a machine is no invasion of the patentee's privilege. Park *v.* Little, 3 Wash. C. C. 196.

If a party, by changes of form or arrangement, introduces any new principle or mechanical power, or a new mode of operation producing a new kind of result, he does not infringe the patent. Many *v.* Sizer, 1 Fish. 17.

If the defendant's apparatus is different in its mechanical action, producing its results in a different way from the patentee's, that is a difference in principle. Silsby *v.* Foote, 1 Blatch. 445; S. C. 14 How. 218.

If the original structure was in fact and in truth no infringement, neither accident nor usage could make it so. Mind must be associated with matter in the commission of the trespass. It is the intention which gives the guilty hue to the act. Page *v.* Ferry, 1 Fish. 298.

A difference in use which is merely a difference in extent is not a different use. Johnson *v.* Linen Co. 33 Conn. 436.

The patentee can not claim the result or effect. He can only claim the mode which he devised for attaining the result. Any one can produce the same result by other and different modes, and still not violate the patentee's claim. Results are not patented, but only means used to produce results. In order to constitute a violation, there must be a use of the same methods substantially as those adopted by the patentee. Case *v.* Brown, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; Carver *v.* Hyde, 16 Pet. 513; Smith *v.* Higgins, 2 Fish. 97; Burr *v.* Cowperthwait, 4 Blatch. 163; Evarts *v.* Ford, 6 Fish. 587; S. C. 5 O. G. 58; Brooks *v.* Jenkins, 3 McLean, 432; Wheeler *v.* Simpson, 6 O. G. 435; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Burden *v.* Corning, 2 Fish. 477; Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361; American Pin Co. *v.* Oakville Co. 3 Blatch. 190.

The general object of all rival inventions is the same, but this does not necessarily make all new inventions or patents for a like object an encroachment on all previous ones. Smith *v.* Downing, 1 Fish. 64.

One machine or manufacture is not a violation of another, within the purview of the patent law, unless it is substantially the same. It need not be identical, but it must be similar in the principle or mode of operation. Ashcroft *v.* B. & L. R. R. Co. 1 Holmes, 366; S. C. 5 O. G. 725; Wheeler *v.* Simpson, 6 O. G. 435; Monroe *v.* Dover Stamping Co. 1 Holmes, 413; S. C. 6 O. G. 685; Merrill *v.* Yeomans, 1 Holmes, 331; S. C. 5 O. G. 267; 11 O. G. 970; U. S. Steam Gage Co. *v.* Am. Steam Gage Co. 1 Holmes, 309; S. C. 5 O. G. 208; Cammeyer *v.* Newton, 12 Blatch. 122; S. C. 5 O. G. 753; 11 O.

G. 287; Sweetster *v.* Helms, 10 O. G. 4; Mann *v.* Bayliss, 10 O. G. 113, 789; Smith *v.* Downing, 1 Fish. 64; Alden *v.* Dewey, 1 Story, 336; Forsyth *v.* Clapp, 6 Fish. 528; S. C. 1 Holmes, 278; 4 O. G. 527; Potter *v.* Thayer, 6 Fish. 603; S. C. 1 Holmes, 293; 5 O. G. 32; Dalton *v.* Jennings, 93 U. S. 271; S. C. 12 Blatch. 96; 5 O. G. 15; 11 O. G. 11; Page *v.* Ferry, 1 Fish. 298; West *v.* Silver Wire Skirt, 3 Fish. 306; S. C. 5 Blatch. 477; Kirby *v.* Dodge Manuf. Co. 6 Fish. 156; S. C. 10 Blatch. 307; 3 O. G. 181; Lake *v.* Fitzgerald, 6 Fish. 420; Meissner *v.* Devoe Manuf. Co. 5 Fish. 285; S. C. 9 Blatch. 363; 2 O. G. 545; Doubleday *v.* Bracheo, 2 Fish. 560; Dyson *v.* Danforth, 4 Fish. 133; Dibble *v.* Augur, 7 Blatch. 86; Dibble *v.* Sibbley, 7 Blatch. 209; Hailes *v.* Van Wormer. 7 Blatch. 443; Bliss *v.* Haight, 3 Fish. 621; S. C. 7 Blatch. 7; Hudson *v.* Draper, 4 Fish. 256; Crosby *v.* Lapouraille, Taney, 374; Price *v.* Kelley, 11 O. G. 639; Florence Manuf. Co. *v.* B. D. Co. 1 Holmes, 415; S. C. 6 O. G. 728; Jones *v.* Merrill, 8 O. G. 401; Trader *v.* Messmore, 7 O. G. 385; Tufts *v.* Machine Co. 1 Holmes, 459; S. C. 8 O. G. 239; Goodyear D. V. Co. *v.* Flagg, 9 O. G. 153; Ashcroft *v.* Hollings, 11 O. G. 879; Scaife *v.* Fulton, 9 O. G. 1164; Estabrook *v.* Dunbar, 10 O. G. 909; Smith *v.* Clark, 3 Am. L. J. 155.

Experiment.

It was not the intention of Congress to punish a man who constructed a machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce the described effects. Whittemore *v.* Cutter, 1 Gallis. 429; Rumford Works *v.* Lauer, 5 Fish. 615; S. C. 10 Blatch. 122; 3 O. G. 349.

Although the party may call the manufacture an experiment, yet if it is a matter of business, and the article is thrown into the market for the purpose of being sold, and is sold with his other products, that is such a use as will make the party liable. Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62.

It can hardly be necessary for a person to experiment with the patentee's invention, in order to perfect his own, especially when he is already familiar with the former. Such experiments by rivals, are not within that class of experiments protected by law. Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 193.

Combination.

To constitute an infringement of a combination, the whole combination must be used, because the patentee claims not the various parts, but the whole combination together. Case *v.* Brown, 2 Wall. 320; S. C. 2 Fish. 268; 1 Biss. 382; Barrett *v.* Hall, 1 Mason, 447; Smith *v.* Downing, 1 Fish. 64; Carr *v.* Rice, 1 Fish. 198; Carr *v.* Rice, 1 Fish. 325; S. C. 4 Blatch. 200; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Singer *v.* Walmsley, 1 Fish. 558; Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361; Bean *v.* Smallwood, 2 Story, 408; Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427; Silsby *v.* Foote, 1 Blatch. 445; S. C. 14 How. 218; Howe *v.* Abbott, 2 Story, 190; McCormick *v.* Talcott, 20 How. 402; S. C. 6

McLean, 539; Evans *v.* Eaton, Pet. C. C. 322; S. C. 3 Wheat. 454; Brooks *v.* Bicknell, 4 McLean, 70; Brooks *v.* Jenkins, 3 McLean, 432; Parker *v.* Haworth, 4 McLean, 370; Foss *v.* Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Pitts *v.* Wemple, 6 McLean, 558; Hale *v.* Stimpson, 2 Fish. 565; Many *v.* Sizer, 1 Fish. 17; Dodge *v.* Card, 2 Fish. 116; S. C. 1 Bond, 393; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87; Crompton *v.* Belknap Mills, 3 Fish. 536; Fisher *v.* Craig, 3 Saw. 69; Haselden *v.* Ogden, 3 Fish. 378; Washing Machine Co. *v.* Tool Co. 20 Wall. 342; S. C. 1 Holmes, 161; Roberts *v.* Harnden, 2 Cliff. 500; Bridge *v.* Brown, 6 Fish. 236; S. C. 1 Holmes, 205; 3 O. G. 121; Nicholson Co. *v.* Hatch, 3 Fish. 432; Brown *v.* Hinkley, 6 Fish. 370; S. C. 3 O. G. 384; Wood Paper Co. *v.* Fibre Co. 3 Fish. 362; S. C. 6 Blatch. 27; Cammeyer *v.* Newton, 12 Blatch. 122; S. C. 5 O. G. 753; 11 O. G 287; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84; Dunbar *v.* Myers, 11 O. G. 35; Fuzzard Manuf. Co. *v.* Dickinson, 3 Fish. 289; S. C. 6 Blatch. 80; Densmore *v.* Schofield, 4 Fish. 148; Rice *v.* Heald, 13 Pac. L. R. 33; Rich *v.* Close, 4 Fish. 279; S. C. 8 Blatch. 41; Reedy *v.* Scott, 23 Wall. 352; S. C. 7 O. G. 463; Cooledge *v.* McCone, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214; Sanford *v.* Hat Co. 10 O. G. 466; Craig *v.* Smith, 2 Cent. L. J. 256.

If a combination has three different known parts, and the result is proposed to be accomplished by the union of all the parts arranged with reference to each other, the use of two of these parts only combined with a third which is substantially different in the manner of its arrangement and connection with the others, is not an infringement. Brooks *v.* Fiske, 15 How. 212; Wilcox *v.* Komp, 7 Blatch. 126.

A patentee can not repudiate one of the parts of his combination after another inventor has taught him how to dispense with it. Hale *v.* Stimpson, 2 Fish. 565; Cooledge *v.* McCone, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214.

If a part is not an essential or material element of the invention, a party can not evade the patent by not using it, although the patent is for a combination. Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259.

If the invention consists not only in the combination but in the improvement of several of the parts of which that combination is composed, the violation of one of them is an infringement. Parker *v.* Haworth, 4 McLean, 370; Pitts *v.* Wemple, 6 McLean, 558; Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

No one can by combining several devices, each of which is old, thereby deprive others of the right to use them separately, or of the right to use them in new combinations, or of the right to use some of them in combination, omitting others. Hailes *v.* Van Wormer, 7 Blatch. 443.

If the elements of the combinations are not connected and arranged in the same manner, there is no infringement. Singer *v.* Walmsley, 1 Fish. 558.

If the principle of the patentee's combination is embodied in the defendant's machine, there is an infringement, although it has been so constructed as to perform but one of the functions of the combination. Blanchard *v.* Beers, 2 Blatch. 411.

If the defendant has merely substituted an equivalent for one of the ele-

ments of the patented combination, he infringes it, although his combination includes other functions and produces other effects not attainable by the patented combination. Sarven *v.* Hall, 5 Fish. 415; S. C. 9 Blatch. 524: 1 O. G. 437; Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

If a party uses all the parts of a combination but one, and for that substitutes another mechanical structure substantially different in its construction and operation, he is not guilty of an infringement. It is not the same combination if it substantially differs from it in any of its parts. Eames *v.* Godfrey, 1 Wall. 78; Merriam *v.* Drake, 5 Fish. 259; S. C. 9 Blatch. 336; Prouty *v.* Ruggles, 16 Pet. 336; S. C. 1 Story, 568; Knox *v.* Murtha, 5 Fish. 174; S. C. 9 Blatch. 205; Stimpson *v.* Balt. & Sus. R. R. Co. 10 How. 329; Dennis *v.* Eddy, 4 Fish. 423; Smith *v.* Marshall, 10 O. G. 375; Densmore *v.* Schofield, 4 Fish. 148; American Pavement Co. *v.* Elizabeth, 4 Fish. 189.

The improvement of one element of a combination does not give the right to use or appropriate the original combination. Stainthorp et al. *v.* Humiston, 4 Fish. 107; Converse *v.* Cannon, 2 Woods, 7; S. C. 9 O. G. 105.

A subordinate device is not an element within the rule which requires the use of all the elements of a combination. Smith *v.* Fay, 6 Fish. 446.

There are cases in which a change of form destroys the combination. They are those in which form is necessary to secure the beneficial result, and when, of course, a change of form of one or more of the things combined works a different result. American Pavement Co. *v.* Elizabeth, 4 Fish. 189.

The essential character of a machine is not varied by a mutual interchange of form and direction between the two elements of which it is a combination, while both object and effect remain as before. Wilson *v* Barnum, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

Although the patentee is the inventor of one part of a combination, still if it is only claimed in combination with the other parts, a party does not infringe the patent unless he uses the whole combination. Foster *v.* Moore, 1 Curt. 279.

A change of location of a part in a combination will not evade a patent if no new function is performed by the changed member in its new location. Adams *v.* Joliet Manuf. Co. 12 O. G. 93.

If the defendant has a patent for a combination which contains as one of its elements the principle embodied in the complainant's patent, it is an infringement. Cleveland *v.* Towle, 3 Fish. 525.

If the subsequent combination is new, or if the ingredient substituted for the one withdrawn is a newly discovered one, or even an old one performing some new function, and was not known at the date of the patent as a proper substitute for the ingredient withdrawn, there is no infringement, for a new combination or a newly discovered ingredient substituted for the one omitted, or even an old one performing a new function not known at the date of the patent as a proper substitute for the one withdrawn, is not an equivalent for the ingredient omitted, within the meaning of the patent law. Gould *v.* Rees, 6 Fish. 106; S. C. 15 Wall. 187; 2 O. G. 624; Crompton *v.* Belknap Mills, 3 Fish. 536; Fuller *v.* Yentzer, 11 O. G. 597; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516.

Neither a slight or immaterial change in the ingredients of a compound or

the manner of preparing them, will relieve the party from the charge of infringing. If, for example, a man were to use the ingredients specified in the patent, and were to add a small portion of some other article, or were to vary the proportions so that the result would not be materially changed, it would be an infringement. Matthews *v.* Skates, 1 Fish. 602; Woodward *v.* Morrison. 5 Fish. 357; S. C. 1 Holmes, 124; 2 O. G. 120; Ryan *v.* Goodwin, 3 Sum. 514; Goodyear *v.* Gutta Percha Co. 2 Fish. 312; Wood Paper Co. *v.* Fibre Co. 3 Fish. 362; S. C. 6 Blatch. 27.

If the defendant uses an article that was not known as an equivalent at the date of the patent in substitution for another in a compound, there is no infringement, although the article contains the chemical elements which constitute the other in a new chemical combination. Wonson *v.* Gilman, 11 O. G. 1011.

Licensee.

If a licensee is limited to the use of one machine, he can not use two, although both are never in operation at the same time. Bloomer *v.* Gilpin, 4 Fish. 50.

If a licensee has a right to use one machine within certain territorial limits, he is liable as an infringer for any use of it outside of those limits, although such use is without his actual consent. Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; S. C. 10 Blatch. 1.

If the right to use a machine is conditional upon the payment of the consideration, and the licensee uses a machine without making such payment, he can not defeat his liability as an infringer by tendering a performance of the condition. Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; 10 Blatch. 1.

If the right of a licensee is conditional upon the payment of the consideration, and he combines with an infringer to use a machine without complying with his contract, he will be deemed to have abandoned his contract. Steam Cutter Co. *v.* Sheldon, 5 Fish. 475; S. C. 10 Blatch. 1.

If contiguous lines are not prohibited from carrying messages by reason of their contiguity to the complainant's lines, there is no infringement of the rights of an assignee to a line between certain points when such contiguous lines transmit messages between those points by a circuitous route. West. Tel. Co. *v.* Mag. Tel. Co. 21 How. 456; West. Tel. Co. *v.* Penniman, 21 How. 460.

Purchasers.

The sale or use of the product of a patented machine is no violation of the exclusive right to use, construct, or sell the machine itself; and the patent for a new and improved process by which any product or manufacture before known in commerce may be made in a cheaper and better manner, grants nothing but the exclusive right to use the particular process. Where a known manufacture or process is in the market, purchasers are not bound to inquire whether it was made on a patented machine or by a patented process. Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356; Boyd *v.* McAlpin, 3 McLean, 427; Pitcher *v.* U. S. 1 N. & H. 7; Boyd *v.* Brown, 3 McLean, 295.

If the patent is for a process, a sale of the product is no infringement. Merrill *v.* Yeomans, 11 O. G. 970.

If the patentee is the discoverer or inventor of a new manufacture or composition of matter, it is clear that his franchise or sole right to use, and vend to others to be used, is the new composition or substance itself. The product and the process constitute one discovery. In such a case the use of the product is an infringement of the patent. Goodyear *v.* Central R. R. Co. 1 Fish. 626.

Whether the inventor in any given case has a patent for the article manufactured, or only for the product or material of which it is composed, the unconditional sale of the manufactured article carries with it the absolute dominion over the material as well as over the manufactured article. Having manufactured the material, and sold it for a satisfactory compensation, whether as material or in the form of a manufactured article, the patentee, so far as that quantity of the product of his invention is concerned, has enjoyed all the rights secured to him by his letters patent, and the manufactured article, and the material of which it is composed, go to the purchaser for a valuable consideration, discharged of all the rights of the patentee previously attached to it, or impressed upon it by the statute under which the patent is granted. Goodyear *v.* Beverly Rubber Co. 1 Cliff. 348.

The original patentee, in selling rights for counties or States may, by a special covenant, prohibit the assignee from vending the product beyond the limits of his own exclusive right, but in such a case the remedy would be on the contract and not under the patent law, for the law protects the thing patented and not the product. Boyd *v.* Brown, 3 McLean, 295.

Although a licensee is restricted to the manufacture of the product for one particular purpose, yet when he sells his manufactures, the material of which they are composed passes to the purchaser discharged of the peculiar privileges secured by the patent. Absolute dominion over the material passes to the purchaser when the sale is made, and he is not obliged to keep the manufactures as waste articles, or throw them away when they cease to be of value as manufactures, but may use the material for any other lawful purpose to which it can be applied. Goodyear *v.* Beverly Rubber Co. 1 Cliff. 348.

The grant of a machine is in law a grant of the use of it. If a party has the right to a machine and to the use of it, he may work it himself or by his agents, or lease it out to any other person. Reutgen *v.* Kanowrs, 1 Wash. C. C. 168.

If one element of a combination is worn out, the machine is gone. A party who takes the remaining elements and uses them in a new machine, is guilty of an infringement. Craig *v.* Fisher, 5 Pac. L. R. 52.

Second purchasers acquire the same rights as their vendor had, and may do with the article or its materials whatever the first purchaser could have lawfully done if he had not parted with the title. Goodyear *v.* Beverly Rubber Co. 1 Cliff. 348.

A purchaser acquires an absolute, unconditional title to that which is the subject of a patent, and may continue to use it until it is worn out, or repair

it, or improve upon it as he pleases, in the same manner as if dealing with any other kind of property. Goodyear *v.* Beverly Rubber Co. 1 Cliff. 348; Union M. C. Co. *v.* U. S. C. Co. 11 O. G. 1113.

Infringers.

A sheriff who merely sells the materials of which a patented machine is composed, under an execution against the patentee, is not liable for an infringement. The purchaser merely buys the materials with the right to apply them in such manner as the law allows, and acts at his peril. Sawin *v.* Guild, 1 Gallis. 485.

A party who uses a patented hotel register containing advertisements is an infringer, and not merely the advertisers. Hawes *v.* Washburne, 5 O. G. 491; Hawes *v.* Gage, 5 O. G. 494.

A party who buys and sells the product of a patented machine under a real contract with the manufacturer, is not liable for an infringement. Keplinger *v.* De Young, 10 Wheat. 358.

If the contract is not a real one, or does not constitute the sole connection between the parties, or the transaction is merely colorable, with a view to evade the law, the purchaser of the products will be liable. Keplinger *v.* De Young, 10 Wheat. 358.

The statute does not embrace every workman who may be employed in making parts of a patented machine, or one who may sell them as the shopman or clerk of another. The maker and seller intended by the statute is the principal who employs these subordinate agents, the person for whom, by whose direction and on whose account the machines are made and sold, the person who receives the profits of the sale, he is the seller and the maker. It is he who claims title and property in the thing, and who undertakes to transfer it to the purchaser. The workmen employed by him for stipulated wages have nothing to do with his right or with his invasion of the rights of another. They work under his direction and sell on his account. Delano *v.* Scott, Gilp. 489.

The agent of a transit company, for making contracts for freight is not liable to an action at law for the use of a patented article upon the cars used in carrying the freight, if he has no authority to direct whether the patented article shall be used on the cars or not. Lightner *v.* Kimball, Lowell, 211.

A party who sells the thing patented as agent for another is an infringer. Morse *v.* Davis, 5 Blatch. 40; Potter *v.* Crowell, 3 Fish. 112; S. C. 1 Abb. U. S. 89.

A party who constructs a patented machine is liable for an infringement, although he was employed by another. Bryce *v.* Dorr, 3 McLean, 582.

When one in the employ of a corporation, does an act in the business of his employment for the benefit of the corporation, which it adopts and approves and takes advantage of, it will be deemed to have authorized the act, and will be as much bound by it as though expressly authorized. Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62.

Where a corporation acting in that character, directs an act to be done which infringes the rights of a patentee, it may be sued in an action on the case. Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9.

If the liability of a municipal corporation to suit, is limited to cases of contract, it can not be sued for an infringement. Jacobs *v.* Commissioners, 4 Fish. 81; s. c. 1 Bond, 500; Allen *v.* Brooklyn, 4 Fish. 598; s. c. 8 Blatch. 535.

If the machine used by the fire department is obtained at the expense of the municipal corporation, the corporation is liable for the infringement, although the fire department may be for certain purposes a distinct corporation, and possibly, to some extent, independent of the action of the corporation of the city in its entire corporate capacity. Ransom *v.* New York, 1 Fish. 252; Bliss *v.* Brooklyn, 4 Fish. 596; s. c. 8 Blatch. 533.

Where parties contract for implements, machines, or structures to contain a patented article, without any knowledge that the contractor is an infringer, or intends to use the thing patented without authority, it is not the just and legal implication from the contract, that the party ordering the article contemplates that the contractor will violate the rights of the patentee, or that he thereby commands or directs an infringement. An agent of a corporation, who merely makes a contract for the construction of cars containing the thing patented, is not liable as an infringer. Lightner *v.* Brooks, 2 Cliff. 287.

If a contractor violates the patent right of another, he is answerable for the infringement. He can not defend himself against the claim, by asserting that he committed the wrong under a contract. Jacobs *v.* Commissioners, 4 Fish. 81; s. c. 1 Bond, 500.

All the parties guilty of a tort are deemed principals. Baldwin *v.* Sibley, 1 Cliff. 150.

The general rule of the common law is *volenti non fit injuria*, and in accordance with this maxim no one can maintain an action for a wrong, where he has consented or contributed to the act of which he complains. It is true that in general the law imports damage from the violation of a right, but damage has never been presumed by law, from an act in which the plaintiff co-operated. Byam *v.* Bullard, 1 Curt. 100.

No sale is an infringement within the meaning of the statute, except one which is within the terms of the grant contained in the letters patent, which is a grant of an exclusive right to make, use, and vend to others to be used. A sale to the patentee's agent is a sale to him, and such a sale is not *per se* an infringement. Byam *v.* Bullard, 1 Curt. 100.

If the patentee's agent purchased the patented article at a shop where it and similar articles may be expected to be found for sale, and if it was sold to him in the usual course of the trade there, and if he saw others exposed for sale, it would be a natural inference that this was not the only article sold. Byam *v.* Bullard, 1 Curt. 100.

The workmen and employees of the government who do work for it in a specific form by the orders of the government, can not be held liable for infringing a patent in doing such work. Heaton *v.* Quintard, 1 Blatch. 73.

The government can not make use of a patented improvement any more than a private individual without a license of the inventor or making compensation to him. U. S. *v.* Burns, 12 Wall. 246; Cammeyer *v.* Newton, 12 Blatch. 122; s. c. 5 O. G. 753; 11 O. G. 287.

A contractor who has agreed to furnish articles to the goverment, can not

use a patented invention without license of the inventor. Brady *v.* Atlantic Works, 10 O. G. 702; Cammeyer *v.* Newton, 12 Blatch. 122; S. C. 5 O. G. 753; 11 O. G. 287.

It is no infringement to make or fashion the articles which are to form a patented armor, for they do not become armor until they are put on the vessel. Heaton *v.* Quintard, 7 Blatch. 73.

The mere manufacture of a separate element of a patented combination is not in and of itself an infringement, unless it is conducted with the intent of aiding an infringement. Saxe *v.* Hammond, 1 Holmes, 456; S. C. 7 O. G. 781.

If one person manufacturing one part of a combination, acts in concert with another who manufactures the other part, they will be deemed joint infringers. Wallace *v.* Holmes, 5 Fish. 37; S. C. 9 Blatch. 65; 1 O. G. 117; Cooledge *v.* McCone, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214.

If a party manufactures one important part of a combination, without any actual prearrangement with another to manufacture the other part, each sale is a proposal to the purchaser to supply the other part, and renders the manufacturer an infringer. Turrell *v.* Spaeth, 8 O. G. 986; Wallace *v.* Holmes, 5 Fish. 37; S. C. 9 Blatch. 65; 1 O. G. 117; Renwick *v.* Pond, 5 Fish. 569; S. C. 10 Blatch. 39; 2 O. G. 392; Richardson *v.* Noyes, 10 O. G. 507.

If the patent is limited to the use of an article in a certain connection, a party who manufactures the article is not an infringer, although others do so use it. Keystone Bridge Co. *v.* Iron Co. 5 Fish. 468; S. C. 1 O. G. 471; 9 Phila. 374.

If a part of a combination is susceptible of use in other ways, a party who manufactures it is not, in the absence of proof of a conspiracy, liable as an infringer. Cooledge *v.* McCone, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214.

If the patent is for the use of a certain compound, as a substitute for leaven in the preparation of farinaceous food, a person who prepares and sells self-raising flour containing the ingredients, with the intent and purpose of enabling the buyer to turn the compound into bread by the use of water and heat, is an infringer. Rumford Chemical Works *v.* Hecker, 10 O. G. 289.

No Fixed Measure of Damages.

A patentee whose rights are infringed has his election of remedies. He may treat the infringer who illegally appropriates the invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. On the other hand, the patentee may sue at law for the damages which he has sustained, and those damages he is entitled to recover, whether the defendant has made any profits or not. In such an action it is precisely what is lost to the patentee, and not what the defendant has gained, which is the legal measure of damages to be awarded. Cowing *v.* Rumsey, 4 Fish. 275; S. C. 8 Blatch. 36.

It must be apparent that there can not be any one rule of damages which will equally apply to all cases. The mode of ascertaining actual damages must necessarily depend on the peculiar nature of the monopoly granted. An

inventor may find his profit to consist in a close monopoly, forbidding any one to compete with him in the market, the patentee being himself able to supply the whole demand at his own price. If any person could use the invention or discovery by paying what a jury might suppose to be the fair value of a license, it is plain that competition would destroy the whole value of the monopoly. In such a case the profit of the infringer may be the only criterion of the actual damage of the patentee. But one who invents some improvement in the machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement. Where the profits of the patentee consist neither in the exclusive use of the thing invented or discovered, nor in the monopoly of making it for others to use, it is evident that this rule could not apply. The only actual damage which the patentee suffers in such a case is the non-payment of the price which he puts on his license, with interest, and no more. There may be cases, as where the thing has been used but for a short time, in which the jury should find less than that sum, and there may be cases where, from some peculiar circumstances the patentee may show actual damages to a larger amount. Of this a jury must judge from the evidence, under instructions from the court, that they can find only such damages as have actually been proved to have been sustained. Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage when his invention has been used without his license. If he claims anything above that amount, he is bound to substantiate his claim by clear and distinct evidence. It is only where from the peculiar circum.. ances of the case, no other rule can be found, that the defendant's profits become the criterion of the patentee's loss. Actual damages must be actually proved, and can not be assumed as a legal inference from any facts which amount not to actual proof of the fact. What a patentee would have made if the infringer had not interfered with his rights is a question of fact and not a judgment of law. The question is not what speculatively he may have lost, but what actually he did lose. The rule of damages must not be such as would be better entitled to the epithet of "speculative," "imaginary," or "fanciful," than that of "actual." Seymour *v.* McCormick, 16 How. 480; S. C. 2 Blatch. 240.

The jury are to give the actual damages which the patentee has sustained, not vindictive or speculative damages, but such damages as the patentee by his proofs shows that he has actually sustained by the infringement of his patent. Ransom *v.* New York, 1 Fish. 252; Wilbur *v.* Beecher, 2 Blatch. 132; Teese *v.* Phelps, 1 McA. 48; Haselden *v.* Ogden, 3 Fish. 378; Parker *v.* Hulme, 1 Fish. 44; Russell *v.* Place. 5 Fish. 134; S. C. 9 Blatch. 173; Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9; Hall *v.* Wiles, 2 Blatch. 194; Whittemore *v.* Cutter, 1 Gallis, 478.

The true course is to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. The price of the machine, the nature, actual state and extent of the use of the patentee's invention, and the particular losses to which he may have been subjected by the piracy, are all proper ingredients to be weighed by the jury in estimating the damages. Earle *v.* Sawyer, 4 Mason, 1; Carr *v.* Rice, 1 Fish. 198; Hubbell *v.* U. S. 5 N. & H. 1.

Defendant's Profits.

The damages sustained by the patentee, and not another's gain, is made the rule, but the profit made by the defendant is a fair and legal subject for the calculation and judgment of the jury. Although the profit is not the amount to be recovered as damages, yet it is that from which a calculation or estimate of that damage may be rightfully made. Whitney *v.* Emmett, Bald. 303; Parker *v.* Banker, 6 McLean, 631; Cowing *v.* Rumsey, 4 Fish. 275; S. C. 8 Blatch. 36; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

There is no unbending or unyielding rule of damages, though that usually recognized as the true rule has been to give to the patentee as damages the amount of profits which the defendant has derived from the use of the invention, not the amount which he might have realized, or which he made from the use of improvements other than those of the patentee, but what he actually did make by the use of the invention as patented. Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Wintermute *v.* Redington, 1 Fish. 239; Matthews *v.* Skates, 1 Fish. 602; Case *v.* Brown, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; Hall *v.* Wiles, 2 Blatch. 194; Sickels *v.* Borden, 3 Blatch. 535; Buck *v.* Hermance, 1 Blatch. 398; Pitts *v.* Edmonds, 2 Fish. 52; S. C. 1 Biss. 168; Page *v.* Ferry, 1 Fish. 298.

The rule of damages is the profits which have been derived to the defendant by means of the invention over any other mode which the defendant had a right to adopt. Serrell *v.* Collins, 1 Fish. 289; Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Wilbur *v.* Beecher, 2 Blatch. 132; Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511; Smith *v.* Pearce, 2 McLean, 174.

The true criterion is the advantage which the defendant obtained or might by skill have obtained by using the patented device over the use of the old device, and the value of this advantage in money. Campbell *v.* Barclay, 5 Biss. 179.

If the patentee has taken certain elements before known, and combined them, and applied them to other parts of a machine constructed after his own fashion, and made the machine in question as a whole, he is entitled to recover the profits made upon the entire machine. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

If any portion of the profits are properly to be credited to an improvement made by the defendant, the burden rests upon him to show affirmatively that fact, and how much of the profits ought to be credited to the improvement and deducted from the profits of the sale of the whole machine as improved, for he has caused the confusion of rights. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

If any of the profits arose from an improvement made by the defendant, they do not belong to the patentee. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

The profit made by the defendant, and that lost by the patentee, are among the elements which the jury may consider. Philp *v.* Nock, 17 Wall. 460.

The extent of the benefits accruing directly to the defendant should undoubtedly form an element for consideration when the question of damages is

considered. If the invention is valuable, and the defendant, by its use, has diminished his expenses, the jury are at liberty to infer that if he had admitted the patentee's rights he would have paid the amount thus saved, or a large portion of it, as the consideration for a license to use the invention, rather than abandon its use, and that the patentee has therefore lost by the infringement what the defendant would have so paid to secure such license. It is for this reason that the benefits received by the defendant from the use of the invention in the consequent reduction of his expenses, are proper subjects for consideration in determining the patentee's damages. Ransom *v.* New York, 1 Fish. 252.

The profits realized by the defendant are proper to be taken into consideration, but are not conclusive as to the extent of the injury, which may be either greater or less. A patentee may be manufacturing his patented article himself, and making it to a profit, while another man may make it to a disadvantage, and yet the spurious article carried into the market may displace the original. In such case the injury to the patentee would be greater than any profit upon the spurious production. On the other hand a defendant's article may not displace the original, and in that case the injury would be less. It may be that a patentee may derive a profit from licensing other parties to construct his invention, and any piracy upon it by depriving him of any portion of the profits of such licenses, would be an injury to be taken into account. A party concerned in infringing a patent stands in a different position from the patentee, not having been previously subjected to the expense and labor to which the latter is frequently exposed, and in the process of invention and experiment. Hence the person who enters upon the business without previous expense may very well afford to sell machines at less profit than the patentee. The latter must have his profit not only for the expense of putting in operation the improvement, but by way of indemnity for the previous time, labor and money which he has been obliged to bestow on the invention. He must, therefore, charge a higher price to cover these greater expenses. Pitts *v.* Hall, 2 Blatch. 229; Campbell *v.* Barclay, 5 Biss. 179; Many *v.* Sizer, 1 Fish. 17.

If the patentee claims the privilege of selling at a higher rate, the probabilities of his having been able to sell as many machines at a higher price, or as many at any price, as were sold by him and the defendant together, should be taken into consideration. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

If the patentee has sustained other damages beyond the profits actually received by the defendant, he is entitled to recover them. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

Plaintiff's Loss.

In an action at law, the profit which the plaintiff might have made is not the primary or controlling measure of damages. Burdell *v.* Denig, 92 U. S. 716.

Where profits are the proper measure of damages, it is the profit which the infringer makes or ought to make, and not the profit which the plaintiff can show that he might have made, that governs the measure of damages. Burdell *v.* Denig, 92 U. S. 716.

The rule is to give the actual damage or loss incurred by reason of the infringement, and that is the profits which the patentee would have made if he had not been embarrassed by the interference of the defendant's machine, because the law presumes that the patentee would have had the patronage which was diverted by the defendant. The profits which the patentee has lost in consequence of the infringement afford, therefore, a criterion by which to determine the amount of damages he has sustained. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Pitts *v.* Hall, 2 Blatch. 229; Wintermute *v.* Redington, 1 Fish. 239; McComb *v.* Brodie, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117; Morris *v.* Barrett, 1 Fish. 461; S. C. 1 Bond, 254; Rice *v.* Heald, 13 Pac. L. R. 33; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27.

The profits which the patentee might have made if he had made and sold the articles which the defendant manufactured and sold, are not conclusive evidence of the actual damages, for there must also be proof that the patentee was prepared to supply the articles, and was prevented from doing so by the competition of the defendant, and was thus limited, hindered, checked, or interfered with in his business, or otherwise actually damaged to that amount. Goodyear *v.* Bishop, 2 Fish. 154; Hawes *v.* Washburne, 5 O. G. 491; Magic Ruffle Co. *v.* Douglass, 2 Fish. 330; Teese *v.* Phelps, 1 McA. 48.

The profits lost to the patentee must be the direct and legitimate fruits of the patent. He may have sustained damages from his inability to sell other articles, but they are too remote. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

If the patent is for an entire machine, the patentee is entitled as damages to the profits he could have made in constructing and vending his machine, over and above the mere profits arising out of its manufacture, that is, the mere profits of its mechanical construction, and not the profits that grow out of the exclusive right to manufacture the invention under the patent. The latter belong to the patentee, while the former, the mere mechanical profits, are excluded from the damages. Seymour *v.* McCormick, 3 Blatch. 209; S. C. 19 How. 96.

If the right of a grantee is the mere right to construct the machine within certain limits, implying a right to sell outside of such limits, but without any right to use or authorize others to use the machine, the injury sustained by the grantee as the result of an infringement of his exclusive right is to be measured by the profit which he realized as a manufacturer from making it. Jenkins *v.* Greenwald, 2 Fish. 37; S. C. 1 Bond, 126.

If the patentee prefers to sell the thing patented in one locality, he is entitled to the profits he might have made were it not for the infringement, although he accepted a royalty in another locality. Rice *v.* Heald, 13 Pac. L. R. 33.

License Fee.

Profits are not the primary or true criterion of damages for infringement in an action at law. That rule applies eminently and mainly to cases in equity On the other hand, a sale of licenses, or a royalty, constitute the primary and true criterion of damages in an action at law. In the absence of satisfactory evidence of either class in the forum to which it is most appropriate, the other

may be resorted to as one of the elements on which the damages may be ascertained. Burdell *v.* Denig, 92 U. S. 716; Sickels *v.* Borden, 3 Blatch. 535; Hogg *v.* Emerson, 11 How. 437; s. c. 2 Blatch. 1: Colt *v.* Mass. Arms Co. 1 Fish. 108; Goodyear *v.* Bishop, 7 Fish. 154; Philp *v.* Nock, 17 Wall. 460; Packet Co. *v.* Sickles, 19 Wall. 611; Seymour *v.* McCormick, 16 How. 480; s. c. 2 Blatch. 240; Burdell *v.* Denig, 2 Fish. 588: Seymour *v.* McCormick, 3 Blatch. 209; s. c. 19 How. 96.

If the test of the license fee can not be applied, the patentee is entitled to an amount which will compensate him for the injury to which he has been subjected by the piracy. Philp *v.* Nock, 17 Wall. 460.

Where the patented improvement has been used only to a limited extent and for a short time, the amount should be less than the license fee. Birdsall *v.* Coolidge, 93 U. S. 64; s. c. 10 O. G. 748.

The price for which the plaintiff has sold his rights to certain territory is no criterion by which to determine the amount of the damage sustained by an infringement in other territory. Campbell *v.* Barclay, 5 Biss. 179.

There are, no doubt, cases in which the license price may be a criterion, but there are few instances in which the patentee ought to be concluded by a former offer to sell. Bell *v.* Daniels, 1 Fish. 372: s. c. 1 Bond, 212; Parker *v.* Hulme, 1 Fish. 44.

It is incumbent on the patentee to prove the amount of the license fee. Burdell *v.* Denig, 2 Fish. 588.

Divers Items.

If the patentee has sustained damages beyond those arising from the actual interference of the defendant in making and putting into market similar machines, he may recover them. The question of damage is very much at large, and rests in the sound discretion of the jury. Seymour *v.* McCormick, 2 Blatch. 240; s. c. 16 How. 480.

It is the making and selling to be used, and not the selling or buying, or making alone, for which full damages are usually given. Hogg *v.* Emerson, 11 How. 587; s. c. 2 Blatch. 1.

If a use of the machine is actually proved, the rule of damages should be the value of the use of such a machine during the time of the illegal use. Whittemore *v.* Cutter, 1 Gallis. 478.

If the article made according to the patentee's invention is more valuable than when made according to the prior mode, this difference of value may be considered in estimating the damages. Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43.

Where the counsel on both sides are content with a measure of damages prescribed by themselves, it is not usual or necessary for the court to interfere at all. Earle *v.* Sawyer, 4 Mason, 1.

If the patentee has been compelled to carry his stock over from one season to another, the value of the use of his capital may be taken into consideration. Carter *v.* Baker, 4 Fish. 404; s. c. 1 Saw. 512.

If the plaintiff has two patents, and sues only for an infringement of one, his recovery must be limited to the damages arising from the infringement of

that patent alone, and the part of the price for which he could have sold the thing patented due to that patent alone is all that can be taken into consideration. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

Evidence of the utility and advantage of the invention over the old modes and devices that had been used for working out similar results, is appropriate to aid in estimating the amount of damages. Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315; Smith *v.* Higgins, 1 Fish. 537; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43.

The character or condition of the parties to the suit can not be taken into account in estimating the damages. Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315.

Where an inventor has invented only an improvement, and there is a violation of his right under his patent to use that improvement in connection with the invention of others, or in connection with a machine previously known and used, his damages must be limited to the value of his improvement in connection with the other elements of the machine. That is a subject in regard to which it may be difficult to give definite proof, but the difficulty does not change the legal principle which applies. Seymour *v.* McCormick, 16 How. 480; S. C. 2 Blatch. 240; Burdell *v.* Denig, 2 Fish. 588; Seymour *v.* McCormick, 3 Blatch. 209; S. C. 19 How. 96.

Unless the jury is satisfied that the patentee has abandoned the privileges secured to him, his failure to bring suit against others infringing such patent should have no effect in reference to the question of damages. In other words, if he has dedicated his rights to the public, he can not recover at all; but if he has not, although he has failed to bring suits for the purpose of enforcing his rights, the jury can not reduce the damages which he has actually sustained, because the statute gives him his actual damages. Ransom *v.* New York, 1 Fish. 252.

Ignorance of the existence of the patent right does not furnish a reason for allowing no damages. Hogg *v.* Emerson, 11 How. 587; S. C. 2 Blatch. 1.

The intent not to injure never exonerates the party from all damages for the actual injury or encroachment, though it may mitigate them. Hogg *v.* Emerson, 11 How. 587; S. C. 2 Blatch. 1; Parker *v.* Corbin, 4 McLean, 462.

The jury, in estimating the damages, may take into account the interest, if they choose, and give it by way of damages. Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; *vide* Silsby *v.* Foote, 20 How. 378; S. C. 2 Blatch. 260.

The damages are not to be estimated for the whole term of the patent, but only for the period of the infringement, where the license fee is not taken as the measure of the damages. Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315.

Where the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It can not be as if the entire thing were covered by the patent, or where that is the case, as if the infringement were as large as the monopoly. Philp *v.* Nock, 17 Wall. 460.

A patentee is not able to give the exact amount of damages that he has sustained with the utmost accuracy. It is not in his power. He does the best he can. If he is wrong in his calculation, the defendant can put him

right. The defendant knows the profit he has made. Conover *v.* Rapp, 4 Fish. 57.

Neither expenses nor counsel fees incurred in the vindication of his rights can be allowed to the patentee as damages. Blanchard's Factory *v.* Warner, 1 Blatch. 258; Whittemore *v.* Cutter, 1 Gallis. 429; Philp *v.* Nock, 17 Wall. 460; Teese *v.* Huntingdon, 23 How. 2; Parker *v.* Hulme, 1 Fish. 44; Stimpson *v.* Railroads, 1 Wall. Jr. 164; Simpson *v.* Leiper, 2 Whart. Dig. 363; *contra*, Pierson *v.* Eagle Screw Co. 3 Story, 402; Parker *v.* Corbin, 4 McLean, 462; Boston Manuf. Co. *v.* Fiske, 2 Mason, 119; Adams *v.* Edwards, 1 Fish. 1; Allen *v.* Blunt, 2 W. & M. 121; Alden *v.* Dewey, 1 Story, 336; Washburn *v.* Gould, 3 Story, 122; Hays *v.* Sulsor, 1 Fish. 532; S. C. 1 Bond, 279.

The patentee can not claim damages for the use of an improvement upon his invention. Sayles *v.* Railroad Company, 2 Fish. 523; S. C. 1 Biss. 468.

No damages can be allowed except for the use prior to the date of the writ. Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315.

There is no reason for granting a new trial on account of damages given according to a rate admitted by the party himself to be a proper one in his own case. Earle *v.* Sawyer, 4 Mason, 1.

If the damages are excessive, the plaintiff may remit the excess. Russell *v.* Place, 5 Fish. 134; S. C. 9 Blatch. 173.

The damages can not exceed the amount claimed in the declaration. Spaulding *v.* Tucker, Deady, 649; Wynans *v.* N. Y. & Harlem R. R. Co. 4 Fish. 1.

Reissue.

If a patent has been surrendered, the damages should be limited to such as accrued by the use of the machine after the new patent was granted. Arnes *v.* Howard, 1 Sum. 482; Agawam Co. *v.* Jordan, 7 Wall. 583.

If the patent is surrendered for defects in the specification, and a reissue granted, the defendant is liable for damages for any unlicensed use of the machine after the granting of the reissue, although his machine was put up before that time. A person purchasing property against the right of another, when the owner is without evidence of his title, can not hold or use it after the evidence of his superior right is acquired by the real owner. Carr *v.* Rice, 1 Fish. 198.

Nominal Damages.

The damages must not rest in conjecture, but must be susceptible of proof and be actually proved. Whitney *v.* Emmett, Bald. 303; Philp *v.* Nock, 17 Wall. 460; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512; Spaulding *v.* Tucker, Deady, 649.

The burden of showing the extent of the damages rests upon the patentee. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

If the patentee rests his case after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more. He can not call on a jury to guess out his case without evidence. Actual damages must be calculated, not imagined; and an arithmetical calculation can not be made without certain data on which to make it. Burdell *v.* Denig, 2 Fish. 588; New

York *v.* Ransom, 1 Fish. 252; S. C. 23 How. 487; Hall *v.* Bird, 3 Fish. 595; S. C. 6 Blatch. 438; Campbell *v.* Barclay, 5 Biss. 179.

Where the law has given a right, and a remedy for the violation of it, such violation of itself imports damage; and in the absence of all other evidence, the law presumes a nominal damage to the party. Whittemore *v.* Cutter, 1 Gallis. 429, 478; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62.

It is competent for the jury to give nominal damages, if they think that the patentee has acted in such a manner that the defendant has been misled. Adams *v.* Edwards, 1 Fish. 1; Washburn *v.* Gould, 3 Story, 122.

For the mere making of a machine, without selling or using it, the damages would be nominal. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

If the defendant has constructed but few machines after he knew of the existence of the patent, nominal damages merely may be recovered. Bryce *v.* Dorr, 3 McLean, 582.

Increase of Damages.

The jury should estimate the single damages, and the court, if it sees proper, will treble the damages found by the jury in awarding the proper judgment. Whittemore *v.* Cutter, 1 Gallis. 478; Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453; Motte *v.* Bennett, 2 Fish. 642; Livingston *v.* Jones, 2 Fish. 207; S. C. 3 Wall. Jr. 330.

The trebling of the damages is a matter that rests in the discretion of the court. Stimpson *v.* Railroads, 1 Wall. Jr. 164.

The object of this provision is to remunerate patentees who are compelled to sustain their patents against wanton and persevering infringers. The spirit of the act does not include suits brought upon an expired patent which are merely cases of collection, the sole object being the recovery of damages. Bell *v.* McCullough, 1 Fish. 380; S. C. 1 Bond, 194; Brodie *v.* Ophir Mining Co. 4 Fish. 137.

If the infringement is deliberate and intentional, the court will increase the damages. It is not reasonable that an inventor should be compelled to spend his means in protecting himself without indemnity, and so practically lose the benefit of the invention which the law designed to secure him. Russell *v.* Place, 5 Fish. 134; S. C 9 Blatch. 173; Peek *v.* Frame, 5 Fish. 113; S. C. 9 Blatch. 194.

The omission to file a disclaimer before the commencement of the suit affords ground for the consideration of the court in the exercise of its discretion on an application for an increase of the damages. The party infringing the patent may have been misled by the specification, and may have honestly supposed that it was void and afforded no protection to the patentee. The actual damages for the infringement would, therefore, seem as a general rule to be all that can be reasonably claimed. Guyon *v.* Serrell, 1 Blatch. 244.

Even where the disclaimer was not filed till after the commencement of the suit, there may be exceptions to the general rule. Cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement in which the power to increase the verdict should be exercised. Each case must depend on its own circumstances. Guyon *v.* Serrell, 1 Blatch. 244.

The law will not in general give treble damages to an assignee. Schwartzel *v.* Holenshade, 3 Fish. 116; S. C. 2 Bond, 29.

The words "with costs" were probably added from abundant caution to exclude any inference of an intention to limit the amount of the judgment to the precise sum as increased, which would have excluded costs. When costs can not be recovered, because a disclaimer was not filed till after the commencement of the suit, the rights of the plaintiff and the power of the court in respect to damages remain the same as if costs were allowed, and the court may, if it sees proper, increase them. Guyon *v.* Serrell, 1 Blatch. 244.

Transfer by Judgment.

A recovery where no license fee has been established will not vest the infringer with the right to continue the use. Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315.

If the patent fee is adopted as the measure of damages, the right to the further use of the invention passes to the defendant. Sickels *v.* Borden, 3 Blatch. 535.

If a patentee does not use the patented machine himself, nor establish a patent fee, but manufactures the patented articles and sells them at fixed prices, seeking his compensation in the profits of the manufacture and sale at such fixed prices, and another party infringes the patent by making and selling the patented article, and the patentee sues the party so infringing, and claims to recover, and does recover, the full amount of profits which he himself would have obtained on the article, had he manufactured and sold it at the ordinary price, by such claim and recovery he adopts the sale made by the party infringing, and the right to use the specific article so sold, and for which the recovery has been had, vests in the purchaser. Spaulding *v.* Page, 4 Fish. 641; S. C. 1 Saw. 702; 4 A. L. T. (N. S.) 166; Perrigo *v.* Spaulding, 13 Blatch. 389.

The price of the invented machine is not the proper measure of damages, because the verdict would not entitle the defendant to use the machine subsequently. The statute gives to the inventor the exclusive right of making and using his invention, and the court can not compel the defendant to purchase, or the patentee to sell this right. Earle *v.* Sawyer, 4 Mason, 1; Whittemore *v.* Cutter, 1 Gallis. 478.

SEC. 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. That, for the purpose of deceiving the public, the description and specification filed by the patentee in the patent office was made to contain less than the whole truth relative to his invention or discovery; or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of [illegible]ention, knowledge, or use of the thing pate[illegible]endant shall state the names of patentees and [illegible] of their patents, and when granted, and the name[illegible] residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against the alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

Statute Revised—July 8, 1870, ch. 230, § 61, 16 Stat. 208.

Prior Statutes—April 10, 1790, ch. 7, § 6, 1 Stat. 111.—February 21, 1793, ch. 11, § 6, 1 Stat. 322.—July 4, 1836, ch. 357, § 15, 5 Stat. 123.

Declaration.

The infringement of a patent is a *tort*, but as the wrongful act is not committed with direct force, and the injury is the indirect effect of the wrongful act, the form of action is that description of *tort* called trespass on the case. Stein *v.* Goddard, 1 McA. 82.

There is no solid foundation on which to rest the right of a patentee to support an action on the case for the violation of his exclusive right, except that settled and reasonable common-law basis of all such actions: injury and damage -injury by a violation of the incorporeal right, and damage, at least nominal, presumed by the law to arise from such violation. Byam *v.* Bullard, 1 Curt. 100.

A declaration ought always to show a title in the plaintiff, and that with convenient certainty. It ought to state all matters that are of the essence of

the action, without which the plaintiff fails to show a right in point of law to ask for the judgment of the court in his favor. If his title depends upon the performance of certain acts, he must aver the performance of those acts. Gray *v.* James, Pet. C. C. 476.

The declaration must aver that the patent was issued and delivered to the patentee. An allegation that the patent was made out is not sufficient. Cutting *v.* Myers, 4 Wash. 220.

As the patentee's title rests upon a patent from the United States, the form of which is prescribed by the act of Congress, the declaration must show that the patent is such as the law requires. Cutting *v.* Myers, 4 Wash. 220.

It is not necessary that the patentee in his pleading shall specify all the acts done by him to obtain a patent in order that it may appear upon the face of the declaration that the mode of proceeding pointed out by the statute has been pursued. It is sufficient to set forth the grant in substance. The court will presume in favor of the grant that everything was rightly and solemnly done which the law requires, in order to authorize the issuing of the patent. Wilder *v.* McCormick, 2 Blatch. 31; Cutting *v.* Myers, 4 Wash. 220.

It is sufficient to state the substance of the grant, but if the specification professes to set forth the grant according to its tenor, the slightest variance is fatal. Tryon *v.* White, Pet. C. C. 96.

A general averment of an extension in due form of law, before the expiration of the term for which the original patent was granted, is sufficient. Phelps *v.* Comstock, 4 McLean, 353.

It would be more formal to annex a copy of the letters patent and specification to the declaration and to refer thereto in the declaration, but the common practice is to simply make profert of the letters patent, and there seems to be no substantial objection to it. Pitts *v.* Whitman, 2 Story, 609.

The profert of the letters patent makes the letters patent, when produced, a part of the declaration, and so gives all the certainty as to the invention and improvement patented, which is required by law. Pitts *v.* Whitman, 2 Story, 609.

The words "as by the said letters patent and specification, all in due form of law ready in court to be produced, will fully appear," is equivalent to profert in the most formal and ample terms. They tender the entire grant to the inspection of the court and party. Wilder *v.* McCormick, 2 Blatch. 31.

The declaration need not aver at what time the invention patented was made. The patent law nowhere requires the patentee to allege or prove the specific time of his invention. Wilder *v.* McCormick, 2 Blatch. 31.

If the declaration does not set out the nature of the invention, it is demurrable. Peterson *v.* Wooden, 3 McLean, 248.

A breach which is as broad as the right set forth in the declaration and granted by the patent, is not only sufficient, but that is the most correct manner of pleading. Cutting *v.* Myers, 4 Wash. 220.

The declaration must tender an issue upon the novelty and utility of the discovery patented, these being essential to the enforcement of any exclusive privilege under the patent, but the question of the regularity of the proceedings in petitioning for and obtaining the patent and that of the correctness of

the judgment of the commissioner in awarding it are not material and can not be inquired into. Wilder *v.* McCormick, 2 Blatch. 31.

If the declaration embodies all that is essential to enable the plaintiff to give evidence of his right and of its violation by the defendant, and affords to the defendant the opportunity to interpose every defense allowed him by the law, the court will not encourage objections merely critical, and will seek to sustain pleadings substantially sufficient, and will thus avoid useless delays and expense. Wilder *v.* McCormick, 2 Blatch. 31.

The plaintiff is confined to giving evidence of infringements during the period which he specifies in his declaration. If it were otherwise, the recovery in the suit would be no bar to another action for any anterior breach, since it could not judicially appear that any damages had been recovered for any such anterior breach, and the form of the declaration itself specifying the term, would repel any presumption to the contrary. Eastman *v.* Bodfish, 1 Story, 528.

If the case stated in the declaration is precisely within the statute, an averment that the act complained of is against the form of the statute is mere matter of form, the want of which will be cured by a verdict, hence the omission of it is not a ground for a nonsuit. Tryon *v.* White, Pet. C. C. 96.

Where the original patent and a patent for an improvement on it, are united in the same person, they constitute an entire right, and must be asserted as such in an action for an infringement. The wrong complained of is for a violation of the entire right united in the plaintiff by the different patents and assignments. The right set up is an entirety, and being united in the same individual, is not susceptible of a division. As well might different actions be brought for trespass upon a close, on the ground that the land was held under distinct titles. Case *v.* Redfield, 4 McLean, 526.

Distinct causes of action may be set forth in the same count. A reiteration of infringements of a patent may be sued for and recompensed in one action. There is no known doctrine of the law that requires a plaintiff to split up into separate actions grievances of that character. Wilder *v.* McCormick, 2 Blatch. 31.

If a patent is extended by a special act of Congress, and the plaintiff wishes to recover for infringements under both the original and extended patent, he must file distinct and independent counts for each patent. Eastman *v.* Bodfish, 1 Story, 528.

Where a matter is so essentially necessary to be proved to establish the plaintiff's right to recovery that the jury could not be presumed to have found a verdict for him unless it had been proved at the trial, the omission to state that matter in express terms in the declaration, is cured by the verdict. The mere omission to aver that the assignment under which the plaintiff claims was recorded, will not be deemed fatal on a motion in arrest of judgment, for it is a case of a good title defectively stated. Dobson *v.* Campbell, 1 Sum. 319.

If enough is stated in the declaration to show title in the plaintiff, and with sufficient certainty to enable the court to give judgment, but with less certainty than the case admitted of, and which, for the purpose of notice to the adverse party or otherwise, ought to have been stated, the defect is cured by

the verdict. The court will presume that all such omissions were supplied and obscurities explained at the trial by the evidence given to the jury. Gray *v.* James, Pet. C. C. 476.

If the declaration contains all the necessary allegations to show that the patent was regularly granted, and designates the patent by the terms used in the patent itself, it will be sufficient on a demurrer or motion in arrest of judgment. Gray *v.* James, Pet. C. C. 476; Cutting *v.* Myers, 4 Wash. 220.

Although a breach is too general in not stating the number of machines used by the defendant, yet it is cured by a verdict, since it is fairly to be presumed that proof of that fact was given to the jury. Gray *v.* James, Pet. C. C. 476.

Plea.

This section appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading when it allows him to give in evidence matter which does not affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of this privilege. The notice is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. Evans *v.* Eaton, 3 Wheat. 454; s. c. Pet. C. C. 323; Grant *v.* Raymond, 6 Pet. 218; Read *v.* Miller, 3 Fish. 310; Phillips *v.* Comstock, 4 McLean, 525; Day *v.* New Eng. Car Co. 3 Blatch. 179; *contra*, Wilder *v.* Gayler, 1 Blatch. 597.

If the notice and the plea contain the same defense, the defendant must elect on which he will rely and abandon the other, or the court will on motion strike out the plea. Latta *v.* Shawk, 1 Fish. 465; s. c. 1 Bond, 259; Wilder *v.* Gayler, 1 Blatch. 597; Read *v.* Miller, 3 Fish. 310; s. c. 2 Biss. 12.

If the defendant pleads instead of giving notice, and the plea is not put in thirty days before the term, the plaintiff is entitled to a continuance. Phillips *v.* Comstock, 4 McLean, 525; Latta *v.* Shawk, 1 Fish. 465; s. c. 1 Bond, 259.

A plea which claims a right in the defendant to continue in the use of the patented discovery, from the fact of a title to such use derived by him through the patentee, or seeks to avoid the title of the plaintiff acquired by direct assignment from the patentee, by alleging matters outside of that assignment which prevent its passing any title to him, either because of the incapacity of the grantee in that respect to make such grant, or because of an outstanding paramount right in others, does not amount to the general issue and may be pleaded. The implied admission of the right of the patentee through whom the plaintiff makes title is sufficient in law to afford color for the avoidance. Day *v.* New Eng. Car Co. 3 Blatch. 179.

Recoupment is a matter which is never pleaded in bar. Birdsall *v.* Perego, 5 Blatch. 251.

If a plea in avoidance contains no denial of matters alleged in the dec-

laration, they must be considered as admitted, unless the matters alleged in the plea are a sufficient answer to the action. Moore *v.* Marsh, 7 Wall. 515.

A plea in avoidance which is hypothetical and does not admit the cause of action is bad. Morse *v.* Davis, 5 Blatch. 40.

A plea in bar must contain a full defense against the right of the plaintiff, and if it fall short of this, it is bad on demurrer. If the truth of the plea may be admitted, and the action is still maintainable, the plea is essentially defective. Smith *v.* Ely, 5 McLean, 76; s. c. 15 How. 137.

Oyer of letters patent is not demandable as of a deed, but being a matter of record, it is accessible to the defendant, and should be stated in the plea, as it is not necessarily a part of the declaration, so as to enable the court to act upon the face of the plea. Smith *v.* Ely, 5 McLean, 76; s. c. 15 How. 137.

A plea of an abandonment should state the facts on which the pleader relies as showing an abandonment. Root *v.* Ball, 4 McLean, 177.

A plea that the defendant was acting as the agent of another is bad if it does not disclose the name of the principal. Morse *v.* Davis, 5 Blatch. 40.

If no fraud appears on the face of the patent, the defendant is not at liberty to set up that the patent has been fraudulently obtained. Railroad Co. *v.* Dubois, 12 Wall. 47.

The plea of not guilty puts in issue the novelty of the invention as well as the charge of infringement. Blanchard *v.* Putnam, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond, 84; *vide* Evans *v.* Hettick, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; Gray *v.* James, Pet. C C. 394.

A State statute can not limit the time within which actions for infringements for patents may be brought in the federal courts. Anthony *v.* Carroll, 9 O. G. 199; s. c. 23 Pitts. L. J. 23; Collins *v.* Peebles, 2 Fish. 541; Parker *v.* Hallock, 2 Fish. 543; Read *v.* Miller, 3 Fish. 310; s. c. 2 Biss. 12; Wood *v.* Cleveland Rolling Mill, 4 Fish. 550; *contra*, Parker *v.* Hawk, 2 Fish. 58; Howes *v.* Nute, 4 Fish. 263; Rich *v.* Ricketts, 7 Blatch. 230.

The inferior courts may prescribe rules to regulate the time and manner of filing pleas. Packet Co. *v.* Sickles, 19 Wall. 611.

The right to plead the statute of limitations does not depend on the pleasure or discretion of the court. Packet Co. *v.* Sickles, 19 Wall. 611.

Notice.

It is very clear that this section does not enumerate all the defenses of which the defendant may legally avail himself, for he may clearly give, in evidence, that he never did the act attributed to him, or that he has a license or authority from the patentee. Whittemore *v.* Cutter, 1 Gallis. 429.

There are defenses of which a party may avail himself under the general issue, without giving notice to the patentee, because no such notice is required by the statute, as, for instance, that there is no specification, or that the specification is altogether ambiguous and unintelligible, or that the patent is broader than the discovery, or that it is for an improvement which the specification does not so particularly describe as to distinguish it from the original

invention, and perhaps others similar in principle. Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9; Grant *v.* Raymond, 6 Pet. 218.

Most of the matters required by this section to be set forth in a notice could be given in evidence under the general issue, without notice, were it not for the section; or, to speak more accurately, are involved in the general issue. They are affirmative facts which the plaintiff would be bound to maintain as essential to the validity of his patent. Wilder *v.* Gayler, 1 Blatch. 597.

The object of this most salutary provision is to prevent patentees being surprised at the trial of the cause by evidence of a nature which they could not be presumed to know, or be prepared to meet, and thereby to subject them either to most expensive delays, or to a loss of their cause. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448; Teese *v.* Huntingdon, 23 How. 2; Wilder *v.* Gayler, 1 Blatch. 597.

All that the act requires is that notice of the special matter to be offered in evidence at the trial shall be in writing, and be given to the plaintiff or his attorney more than thirty days before the trial. By the plain terms of the law it is a right conferred upon the defendant, and of course he may exercise it in the manner and upon the conditions therein pointed out, without any leave or order from the court. When the notice is properly drawn, and duly and seasonably served and filed in court as a part of the pleadings, nothing further is required to give the defendant the full and unrestricted benefit of the provision. Teese *v.* Huntingdon, 23 How. 2.

The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement is that the notice should be so full and particular as to answer the end in view. This end was not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable him to fix, with precision, upon what is relied on by the defendant, and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure exacted from the defendant of all those particulars which he must be presumed to know, and which he may safely be required to state without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and therefore would not be such a notice as the act must be presumed to have intended. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

If the defendant discovers that the first notice is defective, or not sufficiently comprehensive to admit his defense, he may give another to remedy the defect or supply the deficiency, subject to the same condition, that it must be in writing and be served more than thirty days before the trial. Teese *v.* Huntingdon, 23 How. 2.

Where the first day of the term is the day of trial, the notice must be served on the plaintiff's counsel thirty days before the first day of the term. Westlake *v.* Cartter, 6 Fish. 518; S. C. 4 O. G. 636.

A plea which has been stricken out by the court on motion of the plaintiff is not a sufficient legal notice. Foote *v.* Silsby, 1 Blatch. 445; S. C. 14 How. 218.

If the defendant has given the notice required by the act, he may proceed to prove the facts therein set forth by any legal and competent testimony.

For that purpose he may call and examine witnesses upon the stand, or he may introduce any deposition which has been legally taken in the cause. Under those circumstances depositions taken before the notice was served, as well as those taken afterward, are generally admissible. Teese *v.* Huntingdon, 23 How. 2.

No evidence under the general issue can be given upon any of the points of which the statute requires that notice shall be given to the patentee, unless such notice has been duly given. Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9; *vide* Gray *v.* James, Pet. C. C. 394.

If the notice states that the evidence is to be used for one purpose, it can not be used for another. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

No notice is necessary in order to justify the admission of evidence for the purpose of showing the state of the art at the date of the patentee's invention. Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427; Brown *v.* Piper, 91 U. S. 37; S. C. 1 Holmes, 20; 10 O. G. 417; Westlake *v.* Cartter, 6 Fish. 519; S. C. 4 O. G. 636.

No notice is necessary to authorize the inquiry whether the machine used by the defendant is like the model exhibited in court. Evans *v.* Hettick, 7 Wheat. 453; S. C. 3 Wash. C. C. 408.

It is incumbent on the defendant to show his right to introduce the evidence. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84.

Demurrer.

Variances between the declaration and the writ can not be taken advantage of on general demurrer. Wilder *v.* McCormick, 2 Blatch. 31.

Defects of form can not suspend the action of the court unless they are made the ground of a special demurrer. Teese *v.* Phelps, 1 McA. 17.

Concealment.

If the specification embraces too much, the patentee is not bound to prove affirmatively that this occurred by accident or mistake, and not from an intention to deceive or defraud the public. The law presumes no one to have acted illegally or fraudulently. Hotchkiss *v.* Oliver, 5 Denio, 314.

The thing for which the patent is granted should be truly and fully described in the specification, but if this is done, so as clearly to distinguish it from all other things before known, and so as to enable any person skilled in the art of which it is a branch, or with which it is most nearly connected, to make and use the same, it is sufficient. The matters not disclosed must appear to have been concealed for the purpose of deceiving the public to invalidate the patent. Park *v.* Little, 3 Wash. C. C. 196; Gray *v.* James, Pet. C. C. 394; Burden *v.* Corning, 2 Fish. 477; Whittemore *v.* Cutter, 1 Gallis. 429.

What degree of evidence ought to be required to prove such fraudulent intention must rest with the jury to decide. Positive evidence can seldom be

expected, nor is it necessary. The law, it is true, requires that such intention should fully appear, but still it may be presumed from circumstances entirely to the satisfaction of the jury. Gray *v.* James, Pet. C. C. 394; Dyson *v.* Danforth. 4 Fish. 133.

If the specification and drawings are materially defective, they afford a presumption of a designed concealment. Whittemore *v.* Cutter, 1 Gallis. 429.

If the parts concealed are so essential and so obviously necessary to be disclosed that no mechanic skilled in the art could reasonably be expected to understand the subject so as, from the description given, to make the machine, it would be difficult to impute the omission of the patentee to a fair motive. Gray *v.* James, Pet. C. C. 394; Reutgen *v.* Kanowrs, 1 Wash. C. C. 168.

Surreptitious Obtaining of Patent.

An allegation that the original patentee fraudulently and surreptitiously obtained the patent for that which he well knew was invented by another, is not sufficient to defeat the patent, unless it is accompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting the invention. Agawam Co. *v.* Jordan, 7 Wall. 583; Reed *v.* Cutter, 1 Story, 590; Singer *v.* Walmsley, 1 Fish. 558.

If the defendant was the first inventor of the thing patented, and was using reasonable diligence to adapt and perfect the same, and did perfect it, and the patent to the patentee was issued while the *caveat* of the defendant was on file in the patent office, without any notice being given to the defendant by the commissioner, then the patent was unjustly obtained. Phelps *v.* Brown, 1 Fish. 479; S. C. 4 Blatch. 362.

Description.

This provision requires: 1st. a description of the alleged invention; 2d. that it shall be contained in a work of a public character; 3d. that this work was made accessible to the public by publication before the discovery of the invention by the patentee. Reeves *v.* Keystone Bridge Co. 5 Fish. 456; S. C. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

If the alleged prior description laid before a mechanic skilled in building machines would not enable him, without invention, to build a machine substantially like the patentee's, it will not amount to that kind of public notice or knowledge which can interfere with a subsequent patent. Carr *v.* Rice, 1 Fish. 198; Reeves *v.* Keystone Bridge Co. 5 Fish. 456; S. C. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150; Roberts *v.* Dickey, 4 Fish. 532; S. C. 4 Brews. 260; 1 O. G. 4; Buerk *v.* Valentine, 5 Fish. 366; S. C. 9 Blatch. 479; 2 O. G. 295; McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275; Baldwin *v.* Schultz, 5 Fish. 75; S. C. 9 Blatch. 494; 2 O. G. 315; Tilghman *v.* Morse, 5 Fish. 323; S. C. 9 Blatch. 421; 10 O. G. 574; Renwick *v.* Cooper, 6 Fish. 31; S. C. 10 Blatch. 201; Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87; Parker *v.* Stiles, 5 McLean, 44; Washburn *v.* Gould, 3 Story, 122; Stimpson *v.* Woodman, 3 Fish. 98; S. C. 10 Wall. 117.

If the prior publication describes the article that will defeat a patent for a manufacture, although it does not teach a manufacturer how to make it.

Cohn *v.* U. S. Corset Co. 93 U. S. 366; S. C. 12 Blatch. 225; 6 O. G. 259; 11 O. G. 457; Ex parte John McClosky, 9 C. L. N. 313.

It must be directly proved that the work was published before the date of the patentee's invention. This is not deducible from the imprint of the title page. That the work was then printed may be inferred from the imprint, but when it was put in circulation and offered to the public is a distinct fact which must be proved independently. The intended circulation of a book of a public nature may be presumed from its being put into print, but it does not follow that the work was made accessible to the public as soon as it was printed. Reeves *v.* Keystone Bridge Co. 5 Fish. 456; S. C. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

A written description of a machine, although illustrated by drawings, which has not been given to the public, does not constitute an invention within the meaning of the patent law. It may be so full and precise as to enable any one skilled in the art to which it appertains to construct the machine described, but until it has been embodied in a form capable of useful operation, it has not attained the proportion or character of a complete invention. However suggestive and valuable it may be as an untried theory, it is ineffective against the practical and useful product of inventive skill. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148; Lyman V. & R. Co. *v.* Lalor, 12 Blatch. 303; S. C. 6 O. G. 642.

A mere reference to a volume of thirteen hundred pages is not sufficient notice. The defendant should indicate in his notice what particular things described in the printed publication he intends to aver are substantially the same as the thing patented. This he may do either by reference to pages or titles, and perhaps in other ways, for the particular manner in which the things referred to are referred to, must depend much upon the contents of the volume and their arrangement. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

A book of which no notice has been given, can not be used as evidence to prove a prior invention. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1; Lippincott *v.* Kelly, 1 West. L. J. 513.

A volume produced in pursuance of a notice to establish a prior description of the machine, is not evidence of the fact that the machine was partially successful, although it so states. Seymour *v.* McCormick, 19 How. 96; S. C. 3 Blatch. 209.

A prior description of a part can not invalidate a patent for the whole. Westinghouse *v.* G. & R. Brake Co. 9 O. G. 538.

The description of the invention in books must be before the discovery, and not before the application. Adams *v.* Edwards, 1 Fish. 1.

If the books do not describe the invention in all its material combinations, they are no bar to the validity of the invention. Adams *v.* Edwards, 1 Fish. 1.

It is no objection to a patent that the improvement is embraced in a claim in a prior patent which is void because it is a claim for a principle. O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102.

A rejected specification, with drawings, can not be treated as a publication, because it lacks the essential quality of a publication in that it is not designed

for general circulation, nor is it made accessible to the public generally. It is placed in the custody of the commissioner, not that it may thereby become known to the public, but for the special purpose of being examined and passed upon by him. Although it may incidentally become known to any one whose researches in the patent office may disclose its existence, it is not therefore published within the meaning of the statute. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

The deposit of a written description of an invention in the patent office, is not a publication of it within the meaning of the statute, for the description is not designed for general circulation, nor is it made accessible to the public generally. Lyman V. & R. Co. *v.* Lalor, 12 Blatch. 303; S. C. 6 O. G. 642.

A reissue of one patent subsequent in date to another patent, can not affect the novelty or validity of the latter if there is nothing in the specifications or drawing of the original patent which affects it. Hitchcock *v.* Tremaine, 5 Fish. 537; S. C. 9 Blatch. 550; 1 O. G. 633.

When a patentee describes an alternate mode of effecting an object, it is a good ground for refusing a subsequent patent for either of them to another person. Ex parte John McClosky, 9 C. L. N. 313.

A mere drawing unaccompanied by any description whatever, is not admissible under a notice of a description in a printed publication. Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327.

An illustration by a drawing is not such a description as the statute contemplates. Reeves *v.* Keystone Bridge Co. 5 Fish. 456; S. C. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

Novelty.

The patentee's suit is founded on his patent, and unless he is himself the original inventor he can not recover. Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

The defendant can not be allowed to surprise the patentee by evidence of a prior invention of which no notice was given to him. O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Parker *v.* Haworth, 4 McLean, 370; Westlake *v.* Cartter, 6 Fish. 519; S. C. 4 O. G. 636; Root *v.* Ball, 4 McLean, 177; Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84.

Evidence in regard to the state of the art, is proper to be considered by the court in construing the patent and determining what invention is claimed, but has no legitimate bearing upon the question whether the patentee was the first inventor, unless notice has been duly given that it will be used for that purpose. Railroad Co. *v.* DuBois, 12 Wall. 47.

When the novelty of the invention is not open to inquiry by the pleadings, the defendant can not put in evidence a patent granted to another, for such evidence is immaterial. The only question is, whether the defendant's machine infringes the patentee's invention. Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84.

Prior Use.

A change in the specification as filed in the first instance, or the subsequent filing of a new one whereby a patent is still sought for the substance of the invention as originally claimed, or a part of it, can not in anywise affect the sufficiency of the original application or the legal consequences flowing from it. To produce that result, the new or amended specification must be intended to serve as the basis of a patent for a distinct and different invention, and one not contemplated by the specification as submitted at the outset. Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; Godfrey *v.* Eames, 1 Wall. 317; Blandy *v.* Griffith, 3 Fish. 609; Rich *v.* Lippincott, 2 Fish. 1; Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555; Singer *v.* Braunsdorf, 7 Blatch. 521; Smith *v.* O'Connor, 6 Fish. 469; S. C. 2 Saw. 461; Smith *v.* G. D. V. Co. 93 U. S. 486; S. C. 1 Holmes, 354; 11 O. G. 246; 5 O. G. 585; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212; Singer *v.* Walmsley, 1 Fish. 558.

If a party chooses to withdraw his application for a patent and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application within the meaning of the law. Godfrey *v.* Eames, 1 Wall. 317; Howe *v.* Newton, 2 Fish. 531.

The filing of a second application may be considered as in the nature of a petition for a review of the previous rulings, and relates back to the prior application. Blandy *v.* Griffith, 3 Fish. 609.

The filing of a second application after the rejection of the first, will be deemed to be a mere continuance of the prior application. Smith *v.* G. D. V. Co. 93 U. S. 486; S. C. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74; Goodyear D. V. Co. *v.* Willis, 7 O. G. 41; Henry *v.* Stove Co. 9 O. G. 408; Weston *v.* White, 13 Blatch. 447.

Whether a new application is a continuance of a prior one, is a question of fact. Bevin *v.* East Hampton Bell Co. 5 Fish. 23; S. C. 9 Blatch. 50; Godfrey *v.* Eames, 1 Wall. 317; Weston *v.* White, 13 Blatch. 447; Rich *v.* Lippincott, 2 Fish. 1.

If a party withdraws his application upon its rejection by the patent office, without any intent to file a new petition, and acquiesces in the decision, this is an abandonment so that there will be no continuity between it and a subsequent application. United States Rifle Co. *v.* Whitney Arms Co. 11 O. G. 373.

If the second application is not for the same invention as the first, and the invention has been in public use for more than two years prior to the time of making the second, the patent will be void. Rich *v.* Lippincott, 2 Fish. 1.

If the inventor amends his application so as to exclude a certain device, and immediately applies for a patent for that device, the patent will only relate back to the last application. Pelton *v.* Waters, 7 O. G. 425; S. C. 21 I. R. R. 125.

The statute does not prescribe the time within which a patent shall be applied for after the invention is perfected. Where it has not been abandoned to the public, and has not been in public use or on sale with the consent and

allowance of the inventor, no lapse of time, however protracted, bars an application for a patent, or affects its validity after it has been granted. Wood *v.* Cleveland Rolling Mill, 4 Fish. 550; Allen *v.* Blunt, 2 W. & M. 121; Russell Manuf. Co. *v.* Mallory, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495.

The provision allowing two years' use to the inventor, applies to previous cases as well as to subsequent cases. Adams *v.* Edwards, 1 Fish. 1.

If the inventor, after his invention is perfected, knowingly allows it to be used in public for more than two years before he applies for letters patent, it is conclusive evidence of a dedication of such invention to the public, and the patent is void. Ransom *v.* New York, 1 Fish. 252; Pitts *v.* Hall, 2 Blatch. 229; Rich *v.* Lippincott, 2 Fish. 1; Consolidated Fruit Jar Co. *v.* Wright, 12 Blatch. 149; S. C. 6 O. G. 327; 9 C. L. N. 313; Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; Sanders *v.* Logan, 2 Fish. 167; Dunlap *v.* Minetree, 1 O. G. 463; Tappan *v.* Nat. Bank Note Co. 2 Fish. 195; S. C. 4 Blatch. 509; Cleveland *v.* Towle, 3 Fish. 525; American Leather Co. *v.* American Tool Co. 4 Fish. 284; Sisson *v.* Gilbert, 5 Fish. 199; S. C. 9 Blatch. 185.

The use of the invention by individuals, even with the permission of the patentee, will not invalidate the patent, unless it continues for more than two years prior to the filing of the application for a patent therefor in the patent office. Teese *v.* Phelps, 1 McA. 48; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; Smith *v.* Ely, 5 McLean, 76; S. C. 15 How. 137; Andrews *v.* Carman, 13 Blatch. 307; S. C. 9 O. G. 101; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212; Wyeth *v.* Stone, 1 Story, 273; Root *v.* Ball, 4 McLean, 177; Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; Goodyear *v.* Matthews, 1 Paine, 300; Heinrich *v.* Luther, 6 McLean, 345; Sickels *v.* Mitchell, 3 Blatch. 548; Agawam Co. *v.* Jordan, 7 Wall. 583.

The right to the future use is lost by a public use for more than two years prior to the application, however great the hindrances to such application, and whether caused by the want of pecuniary means or other misfortune. Sisson *v.* Gilbert, 5 Fish. 109; S. C. 9 Blatch. 185.

By public use is meant a use in public; that is to say, if the inventor himself makes and sells the thing to be used by others, or if it is made by one other person only, with his knowledge and without objection, before his application for a patent, *a fortiori*, if he suffers it to get into general use, it will have been in public use. Rich *v.* Lippincott, 2 Fish. 1.

There is an obvious distinction between a public use or a use by the public and an experimental use in public. Many inventions can only be tested in that way. Locomotive Truck Co. *v.* Railroad Co. 6 O. G. 924; S. C. 31 Leg. Int. 324; 1 W. N. 16.

If the use prior to the period of two years before the application for the patent was by way of trial, and resulted in a change in the construction of the machine, it will not work a forfeiture of the right of the patentee. Pitts *v.* Hall, 2 Blatch. 229; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; Winans *v.* Schen. & Troy R. R. Co. 2 Blatch. 279; Page *v.* Bowers, 1 O. G. 521; Winans *v.* N. Y. & Harlem R. R. Co. 4 Fish. 1; Birdsell *v.* McDonald, 6 O. G. 682; American Leather Co. *v.* American Tool Co. 4 Fish. 284; Henry *v.* Stove Co. 9 O. G. 408; Andrews *v.* Carman, 13 Blatch. 307; S. C. 9 O. G.

1011; U. S. Rifle Co. *v.* Whitney Arms Co. 11 O. G. 373; Locomotive Truck Co. *v.* Railroad Co. 6 O. G. 924; S. C. 31 Leg. Int. 324; 1 W. N. 16.

Consent and allowance may be inferred from acquiescence. Sisson *v.* Gilbert, 5 Fish. 109; S. C. 9 Blatch. 185.

If the patentee uses the thing patented himself, for more than two years prior to the time of applying for a patent, the patent will be void. McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275.

If the prior use relied on is a use by the inventor or by persons with his consent and allowance, it is not necessary to notify him of the names of the persons using the invention, or of the place where used. American Leather Co. *v.* American Tool Co. 4 Fish. 284.

A single instance of sale, purchase or use under the circumstances specified in the section, will render the patent void. Consolidated Fruit Jar Co. *v.* Wright. 12 Blatch. 149; S. C. 6 O. G. 327; 9 C. L. N. 313.

Forfeiture by prior use is not favored in law, but is regarded as being somewhat harsh in its operation on individual rights. Pitts *v.* Hall, 2 Blatch. 229; Henry *v.* Stove Co. 9 O. G. 408; Page *v.* Bowers, 1 O. G. 521.

An inventor may stipulate for a sale of his invention before it is completed without vitiating his claim. Sparkman *v.* Higgins, 1 Blatch. 205.

Use and sale with the consent of the inventor, means use and sale of the perfected invention, and not of the invention in an imperfect, inchoate and experimental condition. But the distinction between the invention and the machine which embodies it must be observed. The invention may be perfect, and the machine which embodies that invention may be an imperfect machine. American Leather Co. *v.* American Tool Co. 4 Fish. 284.

The question is whether the machine, at the time of the sale, was perfect in the sense that it embodied a completed invention, and not whether it was perfect in mechanical execution. A perfect machine, in the sense of the word perfect, means a perfected invention, not a perfectly constructed machine, but a machine so constructed as to embody all the essential elements of the invention in a form that would make them practical and operative so as to accomplish the result. But it is not necessary that it should accomplish the result in the most perfect manner, and be in a condition where it was not susceptible of a higher degree of perfection in its mere mechanical construction. American Leather Co. *v.* American Tool Co. 4 Fish. 284; Sisson *v.* Gilbert. 5 Fish. 109; S. C. 9 Blatch. 185.

An agreement for the transfer of the invention for the joint benefit of the inventor and those who will advance money for the manufacture of the machines invented, not carried into execution and unaccompanied by any public use of the machine, but being prospective in its character, not consummated until within two years before the application for the patent, does not affect its validity. Elm City Co. *v.* Wooster, 6 Fish. 452; S. C. 4 O. G. 53.

If a design is worked upon the face of a button, it may perhaps be said to be sold with the button. In this view a sale of the button would be a sale of the design, and not simply of the product of the invention. Booth *v.* Garelly, 1 Blatch. 247.

The burden of proof to show a public use for more than two years before the application for the patent, is on the defendant. Hovey *v.* Henry, 3 West. L. J. 153; Brown *v.* Guild, 23 Wall. 181; S. C. 6 O. G. 392; 7 O. G. 739.

Abandonment.

Abandonment means a general abandonment to the public. It is a dedication to the public, a giving up of the claim to a monopoly in the invention. American Leather Co. *v.* American Tool Co. 4 Fish. 284.

Abandonment must result from the intention of the patentee expressly declared or indicated by his acts. McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275.

At common law, the right of property of an inventor to his invention or discovery passed from him as soon as it went into public use with his consent. It was then regarded as having been dedicated to the public as common property, and subject to the common use and enjoyment of all. Wilson *v.* Rousseau, 4 How. 646; S. C. 1 Blatch. 3; American Leather Co. *v.* American Tool Co. 4 Fish. 284; Dudley *v.* Mayhew, 3 N. Y. 9.

It is competent for a patentee at any time by overt acts or by express dedication, to abandon or surrender to the public for their use, all the rights secured by his patent, if such is his pleasure clearly and deliberately expressed. So if for, a series of years the patentee acquiesces without objection in the known public use by others, of his invention, or stands by and encourages such use, such conduct will afford a very strong presumption of such an actual abandonment or surrender. *A fortiori*, the doctrine will apply to a case where the patentee has openly encouraged or silently acquiesced in such use by the very parties whom he afterwards seeks to prohibit by injunction from any further use, for in this way he may not only mislead them into expenses or acts or contracts against which they might otherwise have guarded themselves, but his conduct operates as a surprise, if not as a fraud upon them. Wyeth *v.* Stone, 1 Story, 273; Consolidated Fruit Jar Co. *v.* Wright, 12 Blatch. 149; S. C. 6 O. G. 327; 9 C. L. N. 313; Gray *v.* James, Pet. C. C. 394.

It makes no difference in the principle that the article so publicly used and afterwards patented, was made by a particular individual who did so by the private permission of the inventor. M'Clurg *v.* Kingsland, 1 How. 202; Pennock *v.* Dialogue, 2 Pet. 1; S. C. 4 Wash. C. C. 598.

If the inventor, after his invention is perfected, acquiesces in its use in public for a less term than two years, without applying for a patent, and by such acquiescence abandons his invention, concluding not to patent it, but to dedicate it to the public use, he can not recall such dedication or defeat such abandonment by a subsequent application for a patent, and the patent is therefore void. Ransom *v.* New York, 1 Fish. 252; Teese *v.* Phelps, 1 McA. 48; Consolidated Fruit Jar Co. *v.* Wright, 12 Blatch. 149; S. C. 6 O. G. 327; 9 C. L. N. 313; Bell *v.* Daniel, 1 Fish. 372; S. C. 1 Bond, 212; M'Clurg *v.* Kingsland, 1 How. 202; American Leather Co. *v.* American Tool Co. 4 Fish. 284; Earl *v.* Page, 6 N. H. 477; Pennock *v.* Dialogue, 2 Pet. 1; S. C. 4 Wash. C. C. 538.

The acquiescence of an inventor in the public use of his invention can in no case be presumed where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. Shaw *v.* Cooper, 7 Pet. 292.

Those who rely upon the ground that a party has by abandonment for-

feited a legal right secured to him in due form of law for the purpose of defeating his enjoyment of that right, must make out the point clearly and satisfactorily beyond any reasonable doubt or hesitation, because the law does not favor an abandonment, and throws upon the party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; Pitts *v.* Hall, 2 Blatch. 229; Wyeth *v.* Stone, 1 Story, 273; American Leather Co. *v.* American Tool Co. 4 Fish. 284; McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; Birdsell *v.* McDonald, 6 O. G. 682; Hovey *v.* Henry, 3 West. L. J. 153.

An inventor may abandon his invention and surrender or dedicate it to the public. The inchoate right thus once gone, can not afterwards be resumed at his pleasure; for where gifts are once made to the public in this way, they become absolute. The question which generally arises at trials is a question of fact, rather than of law, whether the acts or acquiescence of the party furnish in the given case satisfactory proof of an abandonment or dedication of the invention to the public. Pennock *v.* Dialogue, 2 Pet. 1; S. C. 4 Wash. C. C. 538; Sanders *v.* Logan, 2 Fish. 167; Marsh *v.* Sayles, 7 A. L. Rev. 355; S. C. 4 C. L. N. 461; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Mellus *v.* Silsbee, 4 Mason, 108; Whittemore *v.* Cutter, 1 Gallis. 478; Kendall *v.* Winsor, 21 How. 322; Morris *v.* Huntington, 1 Paine, 348; Shaw *v.* Cooper, 7 Pet. 292; Booth *v.* Garelly, 1 Blatch. 247; Consolidated Fruit Jar Co. *v.* Wright, 12 Blatch. 149; S. C. 6 O. G. 327; 9 C. L. N. 313.

Lapse of time does not *per se* constitute abandonment. It may be a circumstance to be considered. The circumstances of the case other than mere lapse of time almost always give complexion to the delay, and either excuse it or give it conclusive effect. The statute has made contemporaneous public use with the consent and allowance of the inventor a bar when it exceeds two years. But in the absence of that and any other colorable circumstances, there is no mere period of delay which ought *per se* to deprive an inventor of his patent. Andrews *v.* Carman, 13 Blatch. 307; S. C. 9 O. G. 1011; Russell Manuf. Co. *v.* Mallory, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495; Freund *v.* King, 11 O. G. 2; Page *v.* Bowers, 1 O. G. 521; Birdsell *v.* McDonald, 6 O. G. 682.

No man is to be permitted to lie by for years and then take out a patent. If he has been practicing his invention with a view of improving it, and thereby rendering it a greater benefit to the public before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury what was the intention of the delay, and whether the allowing the invention to be used without a patent should not be considered an abandonment or present of it to the public. Morris *v.* Huntington, 1 Paine, 348; Shaw *v.* Cooper, 7 Pet. 292; Treadwell *v.* Bladen, 4 Wash. C. C. 703; Goodyear *v.* Matthews, 1 Paine, 300.

The mere fact of making or selling an improvement or invention, or of putting it into public use at any time within two years before the application for a patent, is not of itself an abandonment of the invention to the public. Something more must be done within the two years. There must be some acts of the inventor indicating an intention on his part to devote his improve-

ment to the public in general, in order to authorize the conclusion that he has so abandoned it. There must be a design to devote the invention to the public at large as a gratuity, and without receiving a consideration for its bestowal. Seymour *v.* McCormick, 2 Blatch. 240; S. C. 16 How. 480; Pitts *v.* Hall, 2 Blatch. 229.

If the inventor did not intend to take a patent, and manifested that intent by his declarations or conduct, and thereupon it was copied, and so went into use, he can not afterwards take a valid patent. Kendall *v.* Winsor, 21 How. 322.

A declaration of an intention to abandon the invention to the public does not bind the inventor, for he is entitled to the *locus pœnitentiæ*. There must be something more than mere words to fasten on him the intention which, in judgment of law, will work an abandonment of his invention. There must be acts. The mere declaration of an intention to dedicate the invention to the public can not be regarded as equivalent to an actual dedication. Pitts *v.* Hall, 2 Blatch. 229; Page *v.* Bowers, 1 O. G. 521.

It is the acquiescence in the known user by the public, without objection or qualification, and not the extent of the actual user, which constitutes the ground for inferring abandonment or surrender of the patent. If the patentee means to surrender his exclusive right in a qualified manner, or for a qualified trade, he should at the very time give public notice of the nature and extent of his allowance of the public use, so that all persons may be put upon their guard, and not expose themselves to losses or perils which they have no means of knowing or averting during his general silence or acquiescence. Wyeth *v.* Stone, 1 Story, 273.

If the invention was publicly used for a long period by the inventor himself, not in the way of experiment, but for gain, the patent is void. Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212.

The jury has a right to infer an abandonment from the patentee's acquiescence in the use of the invention by others, his neglect to assert his claims by suit or otherwise, his omission to sell licenses to use such invention, his neglect to make efforts to realize any personal advantage from his patent, and similar circumstances. Ransom *v.* New York, 1 Fish. 252.

If the knowledge of the invention is surreptitiously obtained and communicated to the public, it will not affect the right of the inventor. Under such circumstances no presumption can arise in favor of an abandonment of the right of the inventor to the public, though an acquiescence on his part will lay the foundation for such a presumption. Kendall *v.* Winsor, 21 How. 322; Shaw *v.* Cooper, 7 Pet. 292; Page *v.* Bowers, 1 O. G. 521.

If the invention, through fraudulent means, is made known to the public, the inventor should assert his right immediately, and take the necessary steps to legalize it. No matter by what means an invention may be communicated to the public, any acquiescence in the public use by the inventor will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time would give validity to it, but the public stand in an entirely different relation to the inventor. Shaw *v.* Cooper, 7 Pet. 292.

The use of an invention by the special permission of the patentee, under a

license limited to one or two persons, is not a use of it by the public, and does not constitute an abandonment. McCay *v.* Burr, 6 Penn. 147.

A patent for a combination which does not specify that the patentee has invented any of the parts, is a dedication of such parts to the public. Batten *v.* Taggert, 2 Wall. Jr. 101; S. C. 17 How. 74.

If the inventor makes a mistake as to one of the improvements claimed, but is clearly entitled to a patent as to the other, he can not be justly said to have abandoned either during a litigation as to his right to both. Adams *v.* Jones, 1 Fish. 527.

The putting of a device intended to perfect the working of a patented machine upon such machine when sold, will not necessarily imply that the patentee intended to abandon it to the public, or put it in public use, or on sale. That is a question of fact purely. Whether the inventor put it on merely for the purpose of experiment, or put it on and sold it with the rest of the machine for gain and profit, and let it go into public use, is a question of fact. American Leather Co. *v.* American Tool Co. 4 Fish. 284.

Where the jury are satisfied that the patentee has not abandoned his invention and privileges granted by the letters patent, his neglect to prosecute parties infringing such patent, will not bar his right to recover such damages as he has actually sustained by the defendant's infringement. Ransom *v.* New York, 1 Fish. 252.

The inventor will not be deemed to have abandoned his invention by licensing a few persons to use his invention to ascertain its utility, or by any such acts of peculiar indulgence and use as may fairly consist with the clear intention to hold the exclusive privilege. Mellus *v.* Silsbee, 4 Mason, 108; American Leather Co. *v.* American Tool Co. 4 Fish. 284.

Mere delay in applying for a patent will not vitiate it if it is not unreasonable. Webster *v.* Carpet Co. 5 O. G. 522.

Mere forbearance to apply for a patent during the progress of experiments, and until the party has perfected his invention and tested its value by actual practice, affords no just grounds for any presumption of an abandonment. Agawam Co. *v.* Jordan, 7 Wall. 583; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; Locomotive Truck Co. *v.* R. R. Co. 6 O. G. 927; S. C. 31 Leg. Int. 324; 1 W. N. 16.

A sale or use of the invention, with the knowledge or consent of the patentee in the intermediate time between the application for a patent and a grant thereof, furnishes no foundation to presume that the inventor means to abandon his invention to the public. Ryan *v.* Goodwin, 3 Sumn. 514; Howe *v.* Newton, 2 Fish. 531.

By the application filed in the patent office the inventor makes a full disclosure of his invention, and gives public notice of his claim for a patent. It is conclusive evidence that the inventor does not intend to abandon it to the public. The delay afterwards interposed, either by the mistakes of the public officers or the delays of courts, where gross laches can not be imputed to the applicant, can not affect his rights. The statute forfeits the right of an inventor to a patent only where the invention has been in public use more than two years before the application. A man might justly be treated as having abandoned his application if it be not prosecuted with reasonable diligence.

But involuntary delays not caused by the laches of the applicant, will not work a forfeiture of his right. Henry *v.* Stove Co. 9 O. G. 408; Adams *v.* Jones, 1 Fish. 527; Howard *v.* Christy, 10 O. G. 981; Johnson *v.* Fassman, 5 Fish. 471; S. C. 1 Woods, 138; 2 O. G. 84; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; Blandy *v.* Griffith, 3 Fish. 609; Clark *v.* Scott, 15 Fish. 245; S. C. 9 Blatch. 301; 1 O. G. 4; Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555; Goodyear D. & V. Co. *v.* Willis, 7 O. G. 41; Goodyear *v.* Hills, 3 Fish. 134.

The pendency of an application for a patent for an invention repels any inference of abandonment or dedication from the omission to again claim it, though described in a patent granted upon a subsequent application for a patent for another invention. Suffolk Co. *v.* Hayden, 3 Wall. 315; Singer *v.* Braunsdorf, 7 Blatch. 521.

The pendency of an application for a patent for an invention repels any inference of an abandonment or dedication from the omission to claim it in another application where it is described. Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315.

The proof of an abandonment of an application depends upon two circumstances: whether the inventor meant to give it up, or whether, being needy, he gave up, during a short time, for want of funds. A man of genius, who has made a discovery, should not be deprived of it in consequence of a want of means to prosecute his labors to their final consummation, if he intended to persevere. Even if the application was withdrawn, his claim will be valid if he kept it up in his own mind, and meant to keep it up before the patent office, and did not abandon it, but merely suspended operations till he could get the means. Adams *v.* Edwards, 1 Fish. 1.

A party can not be held accountable for delays in the patent office, and an abandonment will not be inferred therefrom. The law looks with indulgence upon the delays which arise from the circumstances of the party who may make an invention, and it is only when the invention is intentionally abandoned or neglected, or the party shows by his acts that he has not done all that he could have done, that the law declares that he shall not be protected in his invention. Sayles *v.* Railroad Company, 2 Fish. 523; S. C. 1 Biss. 468; Ryan *v.* Goodwin, 3 Sumn. 514; Root *v.* Ball, 4 McLean, 177; Rich *v.* Lippincott, 2 Fish. 1; McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275.

If a party, upon the rejection of his application, withdraws all the papers except a drawing, and then permits his invention to go into notorious public use for a long time, the application will be deemed to be abandoned. Bevin *v.* East Hampton Bell Co. 5 Fish. 23; S. C. 9 Blatch. 50.

If an inventor does not prosecute his application with reasonable diligence, but withdraws the papers from the patent office and abandons the invention to the public, a subsequent patent therefor will be void. Bevin *v.* East Hampton Bell Co. 5 Fish. 23; S. C. 9 Blatch. 50.

If the application is rejected, the applicant is obliged, within a reasonable time, to take some action on the subject, either by an appeal from the commissioner, or by a bill in equity in the proper court. If he does not, there is a presumption of an abandonment which can not be rebutted by a mere denial of

an intention to abandon. Marsh *v.* Commissioner, 5 Fish. 610; S. C. 3 Biss. 321; 2 O. G. 340.

If the patentee, subsequent to the date of his letters patent, abandons his invention to the public, and waives and abandons the exclusive privileges intended to be secured by such patent, he can not recover. Ransom *v.* New York, 1 Fish. 252; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212.

After the issue of letters patent, the abandonment must be shown to be positive, actual and intentional by some act or declaration of the inventor, or by such gross laches as indicates unmistakably an intention to abandon the invention to the public. Johnson *v.* Fassman, 5 Fish. 471; S. C. 1 Woods, 138; 2 O. G. 94; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212.

A party may obtain a patent for an invention and let it lie in the patent office without use, and no one else would have the right to use such invention because it is his property, Pitts *v.* Wemple, 2 Fish. 10; S. C. 1 Biss. 87.

A patentee who is prevented by poverty from making machines or selling rights under his patent, will not be deemed to have abandoned it. Hoffheins *v.* Brandt, 3 Fish. 213; Gray *v.* James, Pet. C. C. 394.

If the patent is valid, the inventor is not bound by law to construct his invention in order to preserve his patent. Wheeler *v.* Clipper Co. 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

The burden of proof to show an abandonment is on the defendant. Hoffheins *v.* Brandt, 3 Fish. 218.

Notice of Previous Knowledge.

The party giving notice is not bound to be so specific as to relieve the other from all inquiry or effort to investigate the facts. If he fairly puts his adversary in the way that he may ascertain all that is necessary to his defense, it is all that can be required, and he is not bound by his notice to impose an unnecessary and embarrassing restriction upon his own right of producing proof of what he asserts. When in addition to the town or city in which a large machine is used, the name and residence of the witness by whom that use is to be proved, is also given, there is sufficient precision and certainty in the notice. Wise *v.* Allis, 9 Wall. 737; Smith *v.* Frazer, 5 Fish. 543; S. C. 2 O. G. 175.

The statute requires nothing more than the names and residences of the persons who possessed the prior knowledge of the thing patented, and the name of the place at which it has been used. It does not require that the names and residences of the witnesses shall be given. Wilton *v.* Railroads, 1 Wall. Jr. 192.

The statute requires that the notice should set forth the name of the person who had knowledge of the use and the place where it was used. A witness whose name is not so given, can not testify in regard to such prior use. Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327.

A witness can not testify unless the notice also states "where the same was used." Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

Notice of the time when the person possessed the knowledge or use of the invention, is not required by the statute. The name of the person and of his

place of residence, and the place where it has been used, are sufficient. If, therefore, the notice mentions the time, the defendant is not limited to the time mentioned, but may give evidence of its use at other times. Phillips *v.* Page, 24 How. 164; Evans *v.* Kremer, Pet. C. C. 215.

If the notice merely alleges a use within the United States, evidence can not be given of a use in England. Dixon *v.* Moyer, 4 Wash. C. C. 68.

A notice which refers merely to the county in which the alleged prior invention was used, is defective. This reference is not sufficiently definite and explicit as to the place to file the requirements of the spirit of the act. Hays *v.* Sulsor, 1 Fish. 532; S. C. 1 Bond, 279.

Burden of Proof.

Upon the plea of not guilty, it is incumbent on the plaintiff to prove not merely that the defendant had made, used or sold a machine, but that it substantially resembles the one for which the plaintiff has obtained his patent. Dixon *v.* Moyer, 4 Wash. C. C. 68.

The plaintiff charges an infringement, which is a wrongful act in the nature of a trespass, and inasmuch as no one is presumed to do wrong, the rule is, that he who alleges that another has committed a wrongful act, must prove it. Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Brooks *v.* Jenkins, 3 McLean, 432; Hudson *v.* Draper, 4 Fish. 256; Parker *v.* Stiles, 5 McLean, 44; Francis *v.* Mellor, 5 A. L. T. 237; S. C. 5 Fish. 153; 1 O. G. 48; 8 Phila. 157; Johnson *v.* Root, 1 Fish. 351; Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Many *v.* Sizer, 1 Fish. 17; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Matthews *v.* Skates, 1 Fish. 602; Washburn *v.* Gould, 3 Story, 122; Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115.

Doubts as to whether there has been an infringement or not, must inure in favor of the defendant, as he is not to be deprived of a right which is common to every citizen, unless it shall clearly appear that his machine is substantially like the one claimed by the patentee. Brooks *v.* Jenkins, 3 McLean, 432.

The expressions in the specifications are those of the patentee, and the burden of proof rests on him to explain and to clear them of ambiguity. Kneass *v.* Schuylkill Bank, 4 Wash. C. C. 9.

The burden of proof is on the defendant, to show that the patentee was not the first inventor. Brooks *v.* Jenkins, 4 McLean, 432; Ashcroft *v.* Cutter, 6 Blatch. 511; Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Parham *v.* Sewing Machine Co. 4 Fish. 468; Earle *v.* Sawyer, 4 Mason, 1; Winans *v.* N. Y. & Harlem R. R. Co. 4 Fish. 1; Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259; Brodie *v.* Ophir Mining Co. 4 Fish. 137; Waterman *v.* Thomson, 2 Fish. 461; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224; Whitney *v.* Emmett, Bald. 303; Masury *v.* Tiemann, 4 Fish. 524; S. C. 8 Blatch. 426; Pitt *v.* Hall, 2 Blatch. 229; Dixon *v.* Moyer, 4 Wash. C. C. 68; Tompkins *v.* Gage, 2 Fish. 577; S. C. 5 Blatch. 268; Agawam Co. *v.* Jordan, 7 Wall. 583; Forbes *v.* Barstow Stove Co. 2 Cliff. 379.

It is not enough that he raise a doubt in their minds on that point, he must satisfy them of the fact. Magic Ruffle Co. *v.* Douglass, 2 Fish. 330;

Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630; Tompkins *v.* Gage, 2 Fish. 577; S. C. 5 Blatch. 268; Crouch *v.* Speer, 6 O. G. 187; Jordan *v.* Dobson, 4 Fish. 232; S. C. 2 Abb. N. S 398; 7 Phila. 533; Mowry *v.* Whitney, 3 Fish. 157; S. C. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; Hawes *v.* Antisdel, 8 O. G. 685; Taylor *v.* Wood, 12 Blatch. 110; 8 O. G. 90.

The proof must be clear that the prior invention is the same in principle as that of the patentee. Doubts on this point must inure in favor of the patent. Brooks *v.* Jenkins, 3 McLean, 432; Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Washburn *v.* Gould, 3 Story, 122; Parham *v.* Sewing Machine Co. 4 Fish. 468; Roberts *v.* Dickey, 4 Fish. 532; S. C. 4 Brews. 260; 1 O. G. 4; McMillin *v.* Barclay, 5 Fish. 189; S. C. 4 Brews. 275; Clark *v.* Scott, 5 Fish. 245; S. C. 9 Blatch. 301; 1 O. G. 4.

Where the patent has been acquiesced in for a long time, the proof of a prior invention must be established by a clear preponderance of evidence. Gear *v.* Grosvenor, 6 Fish. 314; S. C. 1 Holmes, 215; 3 O. G. 380; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84.

The burden of proof is on the defendant, to prove that the specification is so defective as not to enable a skillful mechanic to construct the machine claimed. Brooks *v.* Jenkins, 3 McLean, 432.

Presumption from Patent.

No patent is issued without an examination at the patent office by persons skilled in the subject, into the specification and the subject and extent of the claims. The commissioner is intrusted by law with the power and duty of granting patents for new and useful inventions. He is authorized to grant a patent only for a new and useful invention or improvement, and it is to be presumed that he has performed his duty. Under these circumstances, the patent when issued affords *prima facie* evidence of the novelty and utility of the invention patented, which *prima facie* evidence is sufficient to establish such novelty and utility, unless it is rebutted by countervailing testimony. Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 206; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84; Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134; Ransom *v.* New York, 1 Fish. 252; Magic Ruffle Co. *v.* Douglass, 2 Fish. 330; Matthews *v.* Skates, 1 Fish. 602; Teese *v.* Phelps, 1 McA. 48; Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Lowell *v.* Lewis 1 Mason, 182; Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Adams *v.* Edwards, 1 Fish. 1; Wintermute *v.* Redington, 1 Fish. 239; Clark Patent Co. *v.* Copeland, 2 Fish. 221; Bell *v.* Daniels, 1 Fish. 372; S. C. 1 Bond, 212; White *v.* Allen, 2 Fish. 440; S. C. 2 Cliff. 224; Rich *v.* Lippincott, 2 Fish. 1; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62; Parker *v.* Hulme, 1 Fish. 44; Waterman *v.* Thomson, 2 Fish. 461; Corning *v.* Burden, 15 How. 252; Allen *v.* Hunter, 6 McLean, 303; Alden *v.* Dewey, 1 Story, 336; Brooks *v.* Jenkins, 3 McLean, 432; Heinrich *v.* Luther, 6 McLean, 345; Johnson *v.* Root, 1 Fish. 351; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Crompton *v.* Belknap Mills, 3 Fish. 536; Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Woodworth *v.* Rogers, 3 W. & M. 135; Haselden *v.* Ogden, 3 Fish. 378; Pitts *v.* Edmonds, 2 Fish. 52; S. C. 1 Biss. 168; Blanchard *v.* Putnam, 3 Fish.

186; S. C. 8 Wall. 420; 2 Bond, 84; Hudson *v.* Draper, 4 Fish. 253; Many *v.* Sizer, 1 Fish. 17; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43; Mitchell *v.* Tilghman, 19 Wall. 287; S. C. 4 Fish. 599; 5 O. G. 299.

The patent when produced in evidence, whether it be an original or a re-issued one, is *prima facie* evidence that the thing granted required invention, and that the patentee was the inventor or discoverer thereof. Serrell *v.* Collins, 1 Fish. 289; Conover *v.* Rapp, 4 Fish. 57; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Suffolk Co. *v.* Hayden, 4 Fish. 86; S. C. 3 Wall. 315; Roberts *v.* Harnden, 2 Cliff. 500; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224; Dental Vulcanite Co. *v.* Whetherbee, 3 Fish. 87; S. C. 2 Cliff. 555; Cook *v.* Howard, 4 Fish. 269; Knight *v.* Railroad Co. 3 Fish. 1; S. C. Taney, 106; Sherman *v.* Champlain Co. 31 Vt. 162; Ayling *v.* Hull, 2 Cliff. 494; Mitchell *v.* Tilghman, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299; Hoffheins *v.* Brandt, 3 Fish. 218; Potter v. Holland, 1 Fish. 382; S. C. 4 Blatch. 206; Winans *v.* N. Y. & Harlem R. R. Co. 4 Fish. 1; Spaulding *v.* Tucker, Deady, 649; Whipple *v.* Baldwin, Manuf. Co. 4 Fish. 29.

The patent is not conclusive evidence that the invention is novel or useful. Wright *v.* Wilson, 11 Rich. 144; Bierce *v.* Stocking, 77 Mass. 174.

The presumption of utility and novelty arising from the grant of a patent is strengthened by its extension. Mowry *v.* Whitney, 3 Fish. 157; S. C. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond. 45; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115; Cook *v.* Ernest, 5 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 89.

The presumption of utility arising from the grant of the patent, can only be repelled by clear proof that it is utterly worthless. Tilghman *v.* Werk, 2 Fish. 229; S. C. 1 Bond, 511.

A patent to parties as joint inventors, is *prima facie* evidence that the invention was joint. Hotchkiss *v.* Greenwood, 4 McLean, 456; S. C. 11 How. 248.

A patent relates back where the question of novelty is in issue to the date of the invention, and not to the time of the application for issue. Klein *v.* Russell, 19 Wall. 433; Dixon *v.* Moyer, 4 Wash. C. C. 68; *contra* Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Wing *v.* Richardson, 2 Fish. 535; S. C. 2 Cliff. 449; White *v.* Allen, 2 Fish. 440; S. C. 2 Cliff. 224; Johnson *v.* Root, 2 Fish. 291; S. C. 2 Cliff. 108; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630.

The patent is *prima facie* evidence that, in the specification there is contained a description in such full clear and exact terms as will enable any one skilled in the art to which it appertains to put it in practice. Poppenhusen *v.* Gutta Percha Comb. Co. 2 Fish. 62.

If the defendant has a patent for his invention, he may give it in evidence, for he is entitled to the benefit of the presumption in his favor arising from an investigation of the originality of his invention, and the judgment of the public officers, that his machine is new and not an infringement of the patent previously granted. If the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat.* The parties should

contend on an equal field and be allowed to use the same weapons. Corning *v.* Burden, 15 How. 252; American Pin Co. *v.* Oakvill Co. 3 Blatch. 130; Brown *v.* Selby, 4 Fish. 363; S. C. 2 Biss. 457; Stearns *v.* Barrett, 1 Mason, 153; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224.

The granting of a subsequent patent is *prima facie* evidence that the use of the devices thus patented does not infringe a prior patent. Corning *v.* Burden, 15 How. 252; Smith *v.* Woodruff, 6 Fish. 476; S. C. 1 McA. 459; 4 O. G. 635; Burden *v.* Corning, 2 Fish. 477; Westlake *v.* Carter, 6 Fish. 519; S. C. 4 O. G. 636; Many *v.* Sizer, 1 Fish. 17; Trader *v.* Messmore, 7 O. G. 385; N. Y. Rubber Co. *v.* Chaskel, 9 O. G. 923.

A patent subsequent in date can not have the effect as evidence, to overcome the *prima facie* presumption otherwise afforded by the introduction of one of prior date, that the patentee was the original and first inventor of what is therein described as his improvement. Goodyear Dental Co. *v.* Gardner, 4 Fish. 224.

Evidence.

The oath recited in the patent is evidence, and the jury are entitled to judge of its force. Alden *v.* Dewey, 1 Story, 336; Woodworth *v.* Rogers, 3 W. & M. 135.

Parol evidence is not admissible to show the time when the application for a patent was made. Wayne *v.* Winter, 6 McLean, 344.

The letters of the patentee to the commissioner, containing applications for a patent, are admissible. Pettibone *v.* Derringer, 4 Wash. C. C. 215.

If the signature of a letter acknowledging the receipt of an application for a patent is proved, the letter is competent as an official act and document of a public officer in relation to such a subject, and a part of the transaction. Being made at the time and in relation to the subject, it is a competent declaration as a part of the *res gestæ*, and explanatory of what took place. Allen *v.* Blunt, 2 W. & M. 121; Pike *v.* Potter, 3 Fish. 55.

A certified copy of a patent cancelled on account of a defective specification, is competent evidence to prove a prior invention. Delano *v.* Scott, Gilp. 489.

If there are any inaccuracies in a certified copy of a patent, they may be shown by other certified copies. A former and defective transcript will not affect a full and corrected copy. Brooks *v.* Jenkins, 3 McLean, 432.

The plaintiff can not give in evidence an exemplification of a patent differing in date, and in the name or style of the improvement patented from the patent set forth in his replication, to a plea alleging the invalidity of the patent. Bellas *v.* Hays, 5 S. & R. 427.

Neither the report of the examiner nor the decision of the commissioner, upon the question of the extension of a patent, is competent evidence to establish the invalidity of the original patent in an action for the recovery of the amount stipulated to be paid for an assignment thereof, although the extension is refused on the ground of the invalidity of the original patent. McMahon *v.* Tyng, 96 Mass. 167.

If the minutes of a corporation of which the patentee was a member, are read to prove the want of novelty, the patentee can not read other portions of the minute book to prove that the corporation acknowledged him to be the inventor, unless they are necessary to explain the parts which have been read. If part of a statement be read by one side, the other side may insist upon having the whole read, but a subsequent declaration or statement by the corporation does not come within this exception. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

The minute book of a corporation can not be used as evidence to prove a prior invention, because it is a private and not a public work. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

The minute book of a corporation of which the patentee was a member, and to which he furnished minutes, may be used as evidence to prove a prior invention. Pennock *v.* Dialogue, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

A receipt which gives a right to use certain machines, may be used to reduce the amount of the recovery and not as a complete bar, and for this purpose is admissible under the general issue. Burdell *v.* Denig, 92 U. S. 716.

The patentee can not prove that one part of a combination claimed in the patent, is immaterial and useless. Vance *v.* Campbell, 1 Fish. 483; S. C. 1 Black, 427.

The affirmative statement of a witness as to what he saw and heard, is entitled to more credit than the negative statement of another witness that he did not see or hear the same thing. Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

A mistake as to date is a frequent occurrence even with honest witnesses, and where it satisfactorily appears that it was but an unintentional error, the fact that such a mistake was made is not entitled to much weight as affecting the credit of the witness. Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

No comparison can be instituted between the defendant's machine and an alleged prior invention. Prior inventions can only be compared with the patented invention upon the issue of novelty. The defendant's machine can only be compared with the patentee's upon the issue of infringement. Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327.

If Congress passes an act for the relief of a patentee by extending his patent, relying upon his representations, equity and good conscience demand that he shall be held to them. Union Manuf. Co. *v.* Lounsbury, 2 Fish. 389.

Evidence that a compromise made by another was not founded on any admission of the patentee's right in the invention is irrelevant and inadmissible. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448.

In case of either a latent or a patent ambiguity, collateral facts and the circumstances in which the parties were placed when the agreement was made may be given in evidence; in the first case, to ascertain something extrinsic or matter out of the instrument where there is no ambiguity from the language of it, and in the other when from defective terms the intention of the parties can not be collected from them. Troy Factory *v.* Corning, 14 How. 193; S. C. 1 Blatch. 467.

If the novelty of the invention is impeached, the patentee may give evidence to prove that the working of his machine is different and decidedly

superior in its results to the alleged prior invention. Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327.

The declaration of third parties as to the name and reputation of the machine used by the defendant, are inadmissible. The persons from whom the witness received information on this subject, ought to be called on to give it on oath, and in the regular way. Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

The fact that a person is subject to fits of derangement, is no objection either to his competency or credibility, if he is sane at the time of giving his testimony. Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

The patentee can not be asked whether he has ascertained that a statement made by him that the patent had been tested in court, is untrue, in an action instituted by him to recover the amount due under a contract upon the sale thereof where the defense is that the representation was false and fraudulent, for the question implies that the information has been obtained since the making of the representation. McMahon *v.* Tyng, 96 Mass. 167.

Evidence that the persons, of whose prior use of the invention the defendant has given testimony, have paid the plaintiff for licenses to use it since his patent, is entitled to but very little weight, but ought not to be absolutely rejected. Connected with other testimony, and under some circumstances even the opinion of a party may be worth something. Evans *v.* Eaton, 3 Wheat. 454; S. C. Pet. C. C. 322; Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

The defendant, upon an examination in chief, may ask his witness if his machine is like the model of the patentee's machine. Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

In an action for fraud in the sale of a patent right, a remark of the vendor in the course of a conversation about the sale, that the best way to sell patent rights is to take notes and indorse them, so that no question can be made about the patent, is relevant. Peck *v.* Bacon, 18 Conn. 377.

If a party does not have a machine of any kind, a witness can not be asked whether such party offered to take a license from the patentee. It is an act among strangers which ought not to prejudice the defendant. Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

In an action at law upon a sealed instrument, failure of consideration or fraud in the consideration, is not admissible for the purpose of avoiding the obligation. Hartshorn *v.* Day, 3 Fish. 32; S. C. 19 How. 211.

The patentee is not barred by any admission as to the validity of his patent. Adams *v.* Edwards, 1 Fish. 1.

An inquiry into what the patentee invented is proper, because it may aid in giving a construction to his patent, but his legal right is that which is secured to him by his patent, and if he has invented anything else meritorious or otherwise, still, if it is not embraced in the patent, then he can maintain no suit upon it. He is necessarily confined to that which is granted to him by the deed from the government, which is called a patent. Johnson *v.* Root, 1 Fish. 351.

A contract made by the defendant with the plaintiff for the right to use the

machine, is admissible as evidence of the utility of the invention. Lee *v.* Blandy, 2 Fish. 89; S. C. 1 Bond, 361.

Whenever a witness is called to impeach the credit of another, he must know what is generally said of the witness whose credit is impeached by those among whom the last-named witness resides, in order that he may be able to answer the inquiry either as to his general character in the broader sense, or as to his general reputation for truth and veracity. He is not required to speak from his own knowledge of the acts and transactions from which the character and reputation of the witness has been derived, nor, indeed, is he allowed to do so, but he must speak from his own knowledge of what is generally said of him by those among whom he resides and with whom he is chiefly conversant, and any question that does not call for such knowledge, is an improper one, and ought to be rejected. Teese *v.* Huntingdon, 23 How. 2.

An inquiry into the principles and mode of operation of the machine of a third person, merely to test the knowledge and correctness of a witness, is irrelevant, for a witness can not be examined as to a mere collateral fact, having no relevancy to the issue, in order to draw from him an answer which may, by other evidence, be shown incorrect, and thereby discredit him. Such an inquiry, moreover, would embarrass the jury by drawing their attention to the principles of a machine not in controversy. Odiorne *v.* Winkley, 2 Gallis. 51.

Testimony in regard to the reputation of a witness may properly be excluded by the court when it applies to a period of time so remote from the transaction involved in the controversy as thereby to become entirely unsatisfactory and immaterial, and as the law can not fix that period of limitation, it must necessarily be left to the discretion of the court. Teese *v.* Huntingdon, 23 How. 2.

The plaintiff, in the cross-examination of a witness produced to repel the rebutting evidence, can not ask him whether one of the defendant's witnesses is not subject to fits of mental derangement, for the testimony might have been obtained on the primary examination of the witnesses. Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

Every circumstance which can affect the veracity of a witness, whether it concerns his moral character or arises from some interest which he may have in the question, or from feelings and wishes favorable to one or the other of the parties, should be taken into consideration. Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453; Spaulding *v.* Tucker, 1 Deady, 649.

A party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him as to other matters, he must do so by making the witness his own, and calling him as such in the subsequent progress of the cause. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448.

The court will judicially take notice of matters of science which are in common knowledge and use. Brown *v.* Piper, 91 U. S. 37; S. C. 1 Holmes, 20; 10 O. G. 417.

The invention is an intellectual process or operation, and, like all other expressions of thought can, in many cases, scarcely be made known except by speech. The invention may be consummated and perfect, and may be sus-

ceptible of complete description in words, a month or even a year before it can be embodied in any visible form, machine or composition of matter. The conversations and declarations of a patentee stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right at that time as an inventor to the extent of the facts and details which he then makes known, although not of their existence at an antecedent time. Such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him, and thus its origin may be fixed at least as early as that period. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448; Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are properly matters belonging to the practice of the circuit courts. Probably the practice in no two States of the Union is the same, and therefore in each State the circuit courts must necessarily be vested with a large discretion in the regulation of their practice. If every party had a right to introduce evidence at any time, at his own election, without reference to the stage of the trial in which it is offered, it is obvious that the proceedings of the court would often be greatly embarrassed, the purposes of justice obstructed, and the parties themselves surprised by evidence destructive of their rights, which they could not have foreseen, or in any manner have guarded against. All courts are, therefore, vested with a large measure of discretion on this subject, to prevent the most mischievous consequences in the administration of justice to suitors, and the circuit courts possess this discretion in as ample a manner as other judicial tribunals. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448.

Evidence to prove that there are material differences between the original patent and the reissue, can not be admitted after the defendant's counsel has stated in open court that he has closed his case, and after the plaintiff, in consequence of that declaration, has discharged his own witnesses. Phila. & Trenton R. R. Co. *v* Stimpson, 14 Pet. 448.

The representations of the specifications may be such as to afford satisfactory proof that the alleged invention is neither new nor useful. Collar Co. *v.* Van Dusen, 23 Wall. 530; S. C. 10 Blatch. 119; 7 O. G. 919.

Parol Evidence.

Parol evidence, bearing upon written contracts and papers, ought not to be admitted without the production of such written contracts and papers, so as to enable both the court and the jury to see whether or not the admission of the parol evidence, in any manner, will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers. Phila. & Trenton R. R. Co. *v.* Stimpson, 14 Pet. 448.

Parol, or secondary evidence of the contents of a written instrument, is inadmissible without previous proof of the loss of the original, or of its being in the actual possession of the adverse party, and notice given to produce it. Allen *v.* Blunt, 2 W. & M. 121.

Before a party is allowed to give secondary or parol evidence of the contents of a written instrument supposed to be in the possession of the opposite party, he must first prove the possession of it as well as the notice. Allen *v.* Blunt, 2 W. & M. 121.

If the written instrument was sent by private hand, then the person carrying it can testify whether he delivered it. Allen *v.* Blunt, 2 W. & M. 121.

If a written instrument is sent by mail, then, where notice is to be brought home to the correspondent, the letter must be shown to have been received. The law does not presume that it was received. Allen *v.* Blunt, 2 W. & M. 121.

Proof that a written instrument is in the possession of the adverse party may be by the affidavit of the party, and be disproved by the affidavits of his opponent, and interrogatories be put in the discretion of the court to each by the other. Allen *v.* Blunt, 2 W. & M. 121.

The evidence to prove that a written instrument is in the possession of the opposite party, is weighed under liberal views, rather than technical scruples, and in connection with all the other evidence and circumstances bearing on the point. Allen *v.* Blunt, 2 W. & M. 121.

The evidence to justify the admission of parol or secondary evidence of the contents of a written instrument must be offered to the court. Allen *v.* Blunt, 2 W. & M. 121.

It is not permitted to a party to control a written agreement by parol testimony of declarations or conversations at the time it was completed, or before, which would contradict, add to or alter the written agreement, either in the case of a latent or patent ambiguity. Troy Factory *v.* Corning, 14 How. 193; S. C. 1 Blatch. 467; Ruggles *v.* Eddy, 5 Fish. 581; S. C. 10 Blatch. 52.

Experts.

There are various classes of cases which depend upon the knowledge of a peculiar art or science for their solution, of a particular business requiring a peculiar knowledge in order to form a satisfactory judgment of the question involved. In such cases, the law allows testimony to be given by those skillful in the particular art, science, or profession, and permits them to give their opnions as results which they arrive at from an examination of the questions of fact that are before the jury. Johnson *v.* Root, 1 Fish. 351; Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Many *v.* Sizer, 1 Fish. 17.

The opinion of skillful witnesses, whether the principles of two machines are the same, is competent evidence to be introduced in a patent cause, but care should be taken to distinguish what is meant by a principle. The true legal meaning of the principle of a machine, with reference to the patent act, is the peculiar structure or constituent parts of such machine. In this view, the question may be very properly asked in cases of doubt or complexity, of skillful persons, whether the principles of two machines be the same or different. Barrett *v.* Hall, 1 Mason, 447; Conover *v.* Rapp, 4 Fish. 57.

An expert can not be asked whether he has ascertained from investigations in scientific works or otherwise, that the invention was not novel, for the question seeks to establish an historical fact under the guise of a scientific opinion. McMahon *v.* Tyng, 96 Mass. 167.

The opinion of a witness in regard to what a prior invention might have been applied to, is not admissible, for it is a mere matter of speculation. The speculative opinions of a witness can not be given in evidence. Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327.

It is competent for an expert to testify, that the practical manner of giving effect to the principle embodied in the machine used by the defendant, is entirely different from the practical manner of giving effect to the principle embodied in the patentee's machine, and that the principles of the two machines, as well as the practical manner of carrying out those principles, are different. Corning *v.* Burden, 15 How. 252.

It is competent for an expert to testify that the machine used by the defendant differs in point of mechanical structure and mechanical action from the machine described in the patent. Corning *v.* Burden, 15 How. 252.

Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum*, but not as to the construction of written instruments. They are not, therefore, competent to give an opinion as to the construction of the patent. Corning *v.* Burden, 15 How. 252; Jackson *v.* Allen, 120 Mass. 64; Winans *v.* N. Y. & Erie R. R. Co. 1 Fish. 213; S. C. 21 How. 88; Day *v.* Stellman, 1 Fish. 487; Ely *v.* Monson Manuf. Co. 4 Fish. 64.

Great respect is due to the views and opinions of scientific individuals and practical mechanics on the question of identity of different mechanical structures. From their acquaintance with the elements of mechanical science, they are enabled satisfactorily to decide the question, while to others it might seem involved in obscurity and doubt. Parker *v.* Stiles, 5 McLean, 44; Potter *v.* Muller, 2 Fish. 465; French *v.* Rogers, 1 Fish. 133.

Experience has shown that opposite opinions of persons professing to be experts may be obtained to any amount, and it often occurs, that not only many days, but even weeks are consumed in cross-examinations to test the skill or knowledge of such witnesses, and the correctness of their opinions, wasting the time and wearying the patience of both court and jury, and perplexing instead of elucidating the questions involved in the issue. Winans *v.* N. Y. & Erie R. R. Co. 1 Fish. 213; S. C. 21 How. 88; Conover *v.* Rapp, 4 Fish. 57; *Mitchell v. Tilghman*, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299; King *v.* Louisville Cement Co. 6 Fish. 336; S. C. 4 O. G. 181.

Widely as experts differ in opinion in the trial of patent causes, those differences are almost always traceable to the assumption of different postulates. Their opinions differ because they are given on substantially different cases. When their minds can be drawn to the same point, and they use the same words in the same sense, they rarely differ. Sargent *v.* Carter, 1 Fish. 277.

The mere opinion of experts, when not sustained by pointing out clearly the particulars of difference or coincidence between pieces of machinery constructed to produce the same results, and working out those results by means so nearly identical as to create a strong presumption of a common origin, can not afford proof very satisfactory to the mind, that the judgment of the witnesses ought to be adopted. U. S. Annunciator Co. *v.* Sanderson, 3 Blatch. 184.

It is unsafe in many particulars to rely on the opinion of witnesses as to

the identity of two machines, for the reason that they may not have a clear perception in what the identity consists, and in that case, their opinions, whether they are identical or not identical, should have no weight with the jury. Conover *v.* Rapp, 4 Fish. 57.

An examination should be made to see whether the opinions of experts embrace in them any question of law. When a question of law is involved in the opinion of experts, that is not to be left to a jury. Ely *v.* Monson Manuf. Co. 4 Fish. 64.

When the opinions of experts are expressed in *ex parte* affidavits, and there is no opportunity for the court to ascertain in what sense they use important words, or what facts they take into view, or what standards of comparison they assume, their opinions are of comparatively little use in guiding the court to a safe conclusion. Sargent *v.* Carter, 1 Fish. 277.

In passing upon the identity or diversity of machines in principle, it is more satisfactory to ascertain the precise differences and agreements, than to take the mere opinions of witnesses, and when such differences and agreements can be subjected to the eyes, they almost supersede all the evidence of mere opinion. Barrett *v.* Hall, 1 Mason, 447; Livingston *v.* Jones, 1 Fish. 521; Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516.

Ocular demonstration is better than the opinions of experts. Adams *v.* Jones, 1 Fish. 527; Hoffheins *v.* Brandt, 3 Fish. 218; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84.

The statement of a fact by one who has seen a machine work, is better, if reliable, than the mere opinion of ever so scientific an expert. Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362.

The jury are not bound by the opinions of experts. They are introduced only to aid the jury, and the jury may rely upon them so far as they shall think proper. The jury in forming a judgment upon such testimony, may take into view their ability, their knowledge of the art or profession in which they are engaged, the fairness with which they express an opinion, the impartiality of that opinion, the reasons that may be assigned for that opinion, and all those considerations which go to create a confidence or a distrust of the opinions which are given. Bierce *v.* Stocking, 77 Mass. 174; Johnson *v.* Root, 1 Fish. 351; Many *v.* Sizer, 1 Fish. 17; Hudson *v.* Draper, 4 Fish. 256; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512; Spaulding *v.* Tucker, 1 Deady, 649; Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592; Cox *v.* Griggs, 2 Fish. 174; S. C. 1 Biss. 362; Conover *v.* Roach, 4 Fish. 12; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29; Conover *v.* Rapp, 4 Fish. 57; Page *v.* Ferry, 1 Fish. 298; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43.

Estoppel.

The defendant is not estopped by any prior offer made by him to take a license from the patentee. If the offer amounted to an acknowledgment that the patentee was the original inventor, this may be used as evidence of that fact, but it would not entitle the patentee to a verdict if the fact is proved to be otherwise. Evans *v.* Eaton, Pet. C. C. 322; S. C. 3 Wheat. 454.

If an expression in a patent is withdrawn by a surrender and reissue, the

patentee is not estopped from disputing its truth. Allen *v.* Blunt, 2 W. & M. 121.

If several patents are taken out by several patentees for a several invention, and the same patentees afterwards take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. The reason of this doctrine is not that estoppels are odious in law, but that a party may innocently make a mistake as to the extent of his own invention. A party may suppose that he has invented what in truth has been partly suggested by another mind. Barrett *v.* Hall, 1 Mason, 447.

The dismissal of a proceeding in chancery is usually pleaded in bar to a subsequent proceeding, and averments are made that the dismissal was on the merits. But if it is not so pleaded and averred, and is only offered in evidence, then the evidence *dehors* the record, if not in it, should accompany the record and prove all which is proper to show that the dismissal was the result of a judicial inquiry, and disposed of the rights of the parties involved in the proceedings. Allen *v.* Blunt, 2 W. & M. 121.

If the same merits or points are not again agitated in the second suit, then the first decision, being on different matters, can not bind or control the second suit. Allen *v.* Blunt, 2 W. & M. 121.

A verdict rendered on an issue sent to be tried at law is not admissible as evidence in another suit between the same parties, if the complainant dismissed the bill without any judgment on the merits. A mere verdict in any suit does not, as a matter of course, settle the rights of the parties. It is open to numerous exceptions growing out of rulings on evidence that was offered, and opinions or principles involved in the merits, and may be set aside for various errors in them, or for misbehavior of the jury. Allen *v.* Blunt, 2 W. & M. 121; S. C. 3 Story, 742.

A judgment in an action where the novelty and originality of the invention were put in issue by the pleadings precludes the defendant from raising the same questions in a subsequent action, although he endeavors to sustain it by additional evidence. Dubois *v.* P. W. & B. R. R. Co. 5 Fish. 208.

Province of Jury.

The question in respect to an assertion or surrender of the rights of an inventor, whether it be sought in his declarations or acts, or in forbearance or neglect to speak or act, is an inquiry or conclusion of fact, and peculiarly within the province of a jury guided by legal evidence submitted to them at the trial. Kendall *v.* Winsor, 21 How. 322; Batten *v.* Taggert, 17 How. 74; S. C. 2 Wall. Jr. 101; American Leather Co. *v.* American Tool Co. 4 Fish. 284.

When a claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result, and to this extent, not the construction of the

claim strictly speaking, but the application of the claim, should be left to the jury. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

A question of infringement is one of fact which it is the province of a jury to decide. Rich *v.* Lippincott, 2 Fish. 1; Case *v.* Brown, 2 Fish. 268; S C. 2 Wall. 320; 1 Biss. 382; Brooks *v.* Jenkins, 3 McLean, 432; Batten *v.* Taggert, 17 How. 74; S. C. 2 Wall. Jr. 101; Blanchard *v.* Putnam, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84; Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512; Orr *v.* Burwell, 15 Ala. 378.

It is for the court to say what is identity in point of law. Latta *v.* Shawk, 1 Fish. 465; S. C. 1 Bond, 259.

Whether two machines are the same in substance or not is a question of fact for the jury. Carver *v.* Hyde, 16 Pet. 513; Le Roy *v.* Tatham, 2 Blatch. 474; S. C. 14 How. 156; Many *v.* Jagger. 1 Blatch. 372; Colt *v.* Mass. Arms Co. 1 Fish. 108; Blanchard's Factory *v.* Warner, 1 Blatch. 258; Kidd *v.* Spence, 4 Fish. 37.

Whether one compound of given proportions is substantially the same as another compound varying in the proportions, is a question of fact. Tyler *v.* Boston, 7 Wall. 327.

Whether a given improvement is a patentable invention is a mixed question of law and fact, and should not in ordinary cases be disposed of on demurrer and without the intervention of a jury. Teese *v.* Phelps, 1 McA. 17.

Whether the description is so particular as to enable a mechanic to construct the machine is a question for the jury. Brooks *v.* Jenkins, 3 McLean, 432; Goodyear *v.* Wait, 3 Fish. 242; S. C. 5 Blatch. 468; Parker *v.* Stiles, 5 McLean, 44; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Davis *v.* Palmer, 2 Brock. 298; Page *v.* Ferry, 1 Fish. 298; Hogg *v.* Emerson, 2 Blatch. 1; S. C. 6 How. 437; 11 How. 587; Judson *v.* Moore, 1 Fish. 544; S. C. 1 Bond, 285; Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27; Evans *v.* Eaton, 7 Wheat. 356; S. C. 3 Wash. C. C. 443; Carver *v.* Braintree Manuf. Co. 2 Story, 432; Batten *v.* Taggert, 17 How. 74; S. C. 2 Wall. Jr. 101.

If the identity of the inventions described in two patents does not appear upon their face without the assistance of experts, the question should be submitted to the jury. Hawkes *v.* Remington, 111 Mass. 171.

It is the province of the court to decide what constitutes novelty of invention. Parker *v.* Stiles, 5 McLean, 44.

Whether an invention is novel is a question of fact for the jury to determine. Sickels *v.* Borden, 3 Blatch. 535; Turrill *v.* Railroad Company, 1 Wall. 491; Many *v.* Jagger, 1 Blatch. 372; Serrell *v.* Collins, 1 Fish. 289; Parker *v.* Stiles, 5 McLean, 44; Batten *v.* Taggert, 17 How. 74; S. C. 2 Wall. Jr. 101; Swift *v.* Whisen, 3 Fish. 343; S. C. 2 Bond, 115.

It is the duty of the court to construe the patent and specifications for the purpose of determining what the claim of the discovery or invention is, and it is the province of the jury under the instructions of the court, as to what the invention is, to determine whether such invention is new and useful. Wintermute *v.* Redington, 1 Fish. 239; Parker *v.* Hulme, 1 Fish. 44; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62.

When it becomes a matter of inquiry whether the benefits of a patent are

of sufficient consequence to be protected by the arm of the government, the question should be left to the jury. Langdon *v.* De Groot, 1 Paine, 203.

Whether an invention of a composition can be used in any case with advantage without first ascertaining, by experiment, the proportion to be employed, is a question to be decided by a jury, upon the evidence of persons skilled in the art to which the patent appertains. Wood *v.* Underhill, 5 How. 1.

Whether the invention itself be thus specifically described with reasonable certainty is a question of law upon the construction of the terms of the patent. Lowell *v.* Lewis, 1 Mason, 187; Wintermute *v.* Redington, 1 Fish. 239; Wilton *v.* Railroad Co. 2 Whart. Dig. 359.

Whether the specification is sufficiently clear and certain in its description of the invention involves a question of law only in part, or so far as regards the construction of the written words used. Hogg *v.* Emerson, 6 How. 437; S. C. 2 Blatch. 1; Forbes *v.* Barstow Stove Co. 2 Cliff. 379; Howes *v.* Nute, 4 Fish. 263.

Whether the specification is uncertain and insufficient, is a question of law for the court. Wayne *v.* Holmes, 2 Fish. 20; S. C. 1 Bond, 27.

In questions of identity or diversity, it is not the construction of written instruments, but the character of the invention that is sought, and this is a question of fact. In case of a conflict between a prior and a subsequent patent, the question of identity is a question of fact for the jury and not a question of law for the court. Bischoff *v.* Wethered, 9 Wall. 812; Stevens *v.* Pierpont, 42 Conn. 360; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43; Jackson *v.* Allen, 120 Mass. 64; Tucker *v.* Spalding, 5 Fish. 297; S. C. 13 Wall. 453; 1 O. G. 144.

Trial by jury, though an inestimable right, is not a trial without a court, and it is not so regarded either by the Constitution or the laws of Congress. It is as much the duty of the court to determine the questions raised as to the admissibility of evidence, as it is that of the jury to determine its weight after it is received. It is the imperative duty of the court to rule out testimony which in law is not admissible. Cahoon *v.* Ring, 1 Fish. 397; S. C. 1 Cliff. 592.

All questions of the force and effect of the testimony, of the credit which shall be given to witnesses, of the facts which shall be considered to be established, of inferences to be drawn from them, are matters for the jury alone. Johnson *v.* Root, 1 Fish. 351.

If the jury find that a witness has willfully sworn falsely to a fact material to the issue, they are at liberty, if they deem it proper to do so, to disbelieve everything he has stated in the case. Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

The jury are to judge of the credibility of witnesses under the instructions of the court. Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

The determination of the court upon questions of law is conclusive upon the parties and upon the jury. Conover *v.* Roach, 4 Fish. 12.

Practice.

All torts are joint as well as several, and the patentee may recover a verdict against one though the other defendant is acquitted. Reutgen *v.* Kanowrs. 1 Wash. C. C. 168.

The court, though reasonably requested, is not bound to instruct the jury on points not arising in the case, or on abstract and irrelevant propositions. Allen *v.* Blunt, 2 W. & M. 121.

The court is never bound to give an instruction to a jury upon a point of law, even when pertinent and relevant to the facts of the case, precisely in the form and manner in which it is put by counsel, for that may sometimes have a tendency to mislead the jury and withdraw their attention from the merits of the case. All that it is the duty of the court to do, is to give such instructions to the jury in point of law, as clearly arise upon the evidence, and are proper for the consideration of the jury upon the issues before them in such terms and in such a manner as shall comport with the real merits and justice of the case, and enable the jury to give a proper verdict in point of law. Pitts *v.* Whitman, 2 Story, 609.

A motion for leave to amend by adding the name of a party who, at the time of the infringement, had the exclusive right under the patent, will not be granted, for it will amount to the institution of a new suit materially different both as to plaintiff and rights of action. Goodyear *v.* Bowen, 3 Blatch. 266.

If the patentee has obtained a patent in his own name in fraud of the rights of another who is a joint inventor, he is in equity a trustee for the other, and though possibly at law a verdict must be rendered for the patentee against such joint inventor, still the jury may give merely nominal damages. Reutgen *v.* Kanowrs, 1 Wash. C. C. 168.

An infringement, by a patentee, of the exclusive right conferred upon a grantee, is no defense to an action by the patentee to recover the license fee which the grantee stipulated to pay for each machine sold by him. Birdsall *v.* Perego, 5 Blatch. 251.

Courts are called upon only to decide questions that are before them. A judge, sometimes, in giving an opinion, uses language which, although it is always entitled to consideration and respect, yet, in reference to questions that were not before the court, and the decision of which was not necessary to the decision of the questions before it, is not of binding authority. Day *v.* Stillman, 1 Fish. 487.

The judges of the circuit courts ought not to hold themselves bound and the rights of parties concluded by the language of a judge of the Supreme Court, unless such language was strictly applicable to the case then before the court. Day *v.* Union Rubber Co. 20 How. 216; S. C. 3 Blatch. 488.

So far as principles involving the validity of a patent have been settled by the decisions upon it in other courts, they will be regarded as final and authoritative. Goodyear *v.* Berry, 3 Fish. 439; S. C. 2 Bond. 189.

A defective notice does not afford a foundation for a motion by the defendant for the withdrawal of a juror on the ground of surprise arising out of the ruling of the court in respect to the notice and the evidence offered under it,

and, under any circumstances, it is a matter resting altogether in the discretion of the court. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

The court has no power to order a peremptory nonsuit against the will of the plaintiff. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

If a juror becomes ill after the plaintiff's counsel begins his opening address, before any evidence is given, he may be discharged from the panel, and the court may treat such discharge as simply creating a vacancy on the panel, and may proceed to fill it in the usual way by having a twelfth juror drawn and sworn. This practice must be confined to cases where it is apparent that the party objecting receives no injury. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

If the jury disagree and are discharged, the case can not be tried again at the same term by a new jury selected from the residue of the panel, but must go over to await another venire. Wilson *v.* Barnum, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

A special verdict is sufficient if the court can collect the point in issue out of it, although it does not in terms find the issue joined by the parties. Stearns *v.* Barrett, 1 Mason, 153.

Where a verdict is not expressed substantially in the terms of the issue, the case ought to be extremely clear, that should induce a court to make it the ground of a final judgment. Stearns *v.* Barrett, 1 Mason, 153.

Where there is a material repugnancy in the verdict, it is not competent for the court to reject either part of the finding, for it is utterly impossible for the court to decide which is the truth of the case, and even if it could, there is no authority to substitute its own opinion for that of the jury. In such a case the repugnancy will be fatal. A verdict which finds two inconsistent material facts is void, and can not be the foundation for a legal judgment. Stearns *v.* Barrett, 1 Mason, 153.

The right of the plaintiff to costs follows from a verdict in his favor for any amount of damages, whether nominal or compensatory, and without any reference to the action of the court in adjudging an increase of damages. Merchant *v.* Lewis, 1 Bond, 172.

Arrest of Judgment.

It is not a sufficient ground to support a motion in arrest of judgment, that the declaration does not set forth the act complained of as contrary to the statute. This is not necessary where damages are sought for on account of an injury done. Parker *v.* Haworth, 4 McLean, 370.

A motion in arrest of judgment ought properly to be heard after the motion for a new trial, which, if granted, might supersede the other motion. Pitts *v.* Whitman, 2 Story, 609.

New Trial.

If in the hurry of a trial, a ruling of the court in admitting evidence is erroneous, but afterwards becomes immaterial or unnecessary in consequence

of other evidence, a new trial will not be granted. Allen *v.* Blunt, 2 W. & M. 121.

If the error consists in an instruction in regard to the measure of damages, the plaintiff may avoid a new trial by consenting that the verdict be reduced to nominal damages. Cowing *v.* Rumsey, 4 Fish. 275; S. C. 8 Blatch. 35.

A new trial should not be granted for a cause existing at the trial, but which was not stated or excepted to then. The more especially is this so, when any wrong or misleading of the jury was likely to flow from the objection not being made. Allen *v.* Blunt, 2 W. & M. 121.

If a party chooses to carry a question to the jury, he can not complain on that ground, and ask for a new trial, when the verdict is against him. Silsby *v.* Foote, 14 How. 218; S. C. 1 Blatch. 445.

In order to justify the granting of a new trial, it must be so clearly shown that the verdict is against the weight of evidence as to raise a strong presumption that the jury either wantonly abused their powers or made some inadvertent mistake. Aiken *v.* Bemis, 3 W. & M. 348; Johnson *v.* Root, 2 Fish. 291; S. C. 2 Cliff. 108; Bray *v.* Hartshorn, 1 Cliff. 538.

Although the verdict of a jury is of less weight in patent cases than in other civil causes, yet it will not be set aside unless they were palpably mistaken, and the weight of the evidence was decidedly against the verdict. Roberts *v.* Schuyler, 12 Blatch. 444.

If the verdict is decidedly against the evidence in the cause, it will be set aside. Wilson *v.* Janes, 3 Blatch. 227.

It must be a very aggravated and oppressive case where the court would feel justified in setting up its own opinion, even if decidedly different from that of the jury, as to the true amount of damages, and award a new trial on that ground. Allen *v.* Blunt, 2 W. & M. 121; Alden *v.* Dewey, 1 Story, 336; Whitney *v.* Emmett, Bald. 303; Aiken *v.* Bemis, 3 W. & M. 348; Stimpson *v.* Railroads, 1 Wall. Jr. 164.

Error in awarding excessive damages may sometimes be obviated by allowing the prevailing party to remit the excess, and that course is frequently adopted in cases where the court is satisfied that the error has resulted from oversight or mere inadvertence; but where the finding is not only contrary to the evidence, but in direct contravention of the charge of the court, the error can not in general be remedied in that way. Johnson *v.* Root, 2 Fish. 291; S. C. 2 Cliff. 108.

Irregularity on the part of the party charged, or of the jury, must be satisfactorily proved, in order to lay the foundation for the interposition of the court; but when the irregular conduct is established, it is not necessary that it should certainly appear that it influenced the jury. In that state of the case it is sufficient that the irregularity appears to be of such a character that it might have affected the impartiality of the proceedings. Johnson *v.* Root, 2 Fish. 291; S. C. 2 Cliff. 108.

It is not necessary that the attempt to influence the jurors should be made by one of the parties, nor even by his agent. It is sufficient if it clearly appear that it was done in his behalf. Johnson *v.* Root, 2 Fish. 291; S. C. 2 Cliff. 108.

It is never necessary to show that the misconduct controlled or determined

the verdict, provided it was of a character that it might have had an undue influence. Johnson *v.* Root, 2 Fish. 291; S. C. 2 Cliff. 108.

A new trial will not be granted upon the discovery of new evidence, if the information might have been obtained by the use of reasonable diligence. Washburn *v.* Gould, 3 Story, 122.

If a party, by the use of ordinary diligence, could have obtained full evidence to any point which could properly sustain his defense, there is no reason for granting him a new trial merely because he could, upon further reflection and further lights, make a fuller and better defense. Ames *v.* Howard, 1 Sum. 482.

A new trial will not be granted upon the discovery of new evidence, if the information was within the reach of the party before the trial was concluded. Washburn *v.* Gould, 3 Story, 122.

A new trial is never granted upon the discovery of mere cumulative evidence, where there is no other ground of objection to the verdict. Ames *v.* Howard, 1 Sum. 482.

If the new evidence is to subordinate points and particular facts not before agitated, it is not cumulative, although the general subject was discussed. Aiken *v.* Bemis, 3 W. & M. 348.

When a new trial is granted for newly discovered evidence, the terms usually are that the costs of the former trial be first paid. Aiken *v.* Bemis, 3 W. & M. 348.

Depositions to be used on a motion for a new trial may always without a special order be *ex parte*. Aiken *v.* Bemis, 3 W. & M. 348.

If counter affidavits offered by the adverse party go to establish strong cumulative proofs the other way, the court will always decline to interfere with the verdict, because it will not undertake to measure the weight of the new testimony upon either side, or send the parties again to a litigation upon the chances of a verdict upon new conflicting evidence. Ames *v.* Howard, 1 Sum. 482.

A party who moves for a new trial upon the ground of the discovery of new evidence can not put in new rebutting evidence to the affidavits of the adverse party, offered in reply to those first offered by himself. He must present his whole case at once to the court, and not lead it on through a series of confirming and rebutting proofs, thus protracting the cause to an unreasonable extent. Ames *v.* Howard, 1 Sum. 482.

SEC. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complain-

ant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

Statute Revised—July 8, 1870, ch. 230, § 55, 16 Stat. 206.

Prior Statutes—February 15, 1819, ch. 19, § 1, 3 Stat. 481.—July 4, 1836, ch. 357, § 16, 5 Stat. 123.

Parties.

A contract for the purchase of any portion of the patent right may be good between the parties as a license, and enforced as such in the courts of justice; but the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it. Gayler *v.* Wilder, 10 How. 477; Sanford *v.* Messer, 5 Fish. 411; S. C. 1 Holmes, 149; 2 O. G. 470; Blanchard *v.* Eldridge, 1 Wall. Jr. 337.

A patentee who has granted a license to make and vend the thing patented within a certain territory, in consideration of the payment of a certain sum for each article so manufactured and sold, reserving to himself the right to sell the thing patented within the territory, is a party aggrieved, and may proceed in equity for the protection of his rights. Hussey *v.* Whiteley, 2 Fish. 120; S. C. 1 Bond, 407.

A party who holds the legal title and has an interest in the damages to be recovered for an infringement, is a necessary party. North *v.* Kershaw, 4 Blatch. 70.

A patentee who has assigned his interest prior to the filing of a bill, can not obtain an injunction. Morse *v.* O'Reilly, 6 Penn. L. J. 501.

An assignee of a territorial interest in a patent may maintain an action in his own name. Chambers *v.* Smith, 3 Fish. 12; S. C. 7 Phila. 575; Olcott *v.* Hawkins, 2 Am. L. J. 317.

A grantee may maintain a bill, although he derives his title through a foreign administrator, and there need be no domestic administrator. Smith *v.* Mercer, 5 Penn. L. J. 529: S. C. 4 West. L. J. 49.

A party who has merely an interest in the profits, without any legal title in the patent, need not be made a party complainant. Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356.

A court of equity, upon a bill by the legal owner of a patent right, can not enjoin the equitable owner from using the thing patented. It considers the equitable title the true title. Clum *v.* Brewer, 2 Curt. 506; Day *v.* Candee, 3 Fish. 9; Chase *v.* Walker, 3 Fish. 120; Continental Co. *v.* Empire Co. 4 Fish. 428; S. C. 8 Blatch. 295.

A party having an equitable title may maintain a bill in equity against a party having the legal title. Ruggles *v.* Eddy, 5 Fish. 581; S. C. 10 Blatch. 52.

If the patentee infringes the rights of a licensee, the licensee may sue in

his own name. The breach of trust is an infringement, and its redress involves a suit arising under the patent laws. Littlefield *v.* Perry, 21 Wall. 205; s. c. 7 O. G. 964.

One tenant in common has as good right to use and to license third persons to use the thing patented as the other tenant in common has. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract modifying the rights which belong to them as tenants in common. Clum *v.* Brewer, 2 Curt. 506.

A mere licensee can not sue strangers who infringe. In such case redress is obtained through or in the name of the patentee or his assignee. Littlefield *v.* Perry, 21 Wall. 205; Hill *v.* Whitcomb, 5 O. G. 430.

A licensee may file a bill in equity to enjoin any party who has actually infringed his right under the license. Brammer *v.* Jones, 3 Fish. 340; s. c. 2 Bond, 100.

A licensee has not such an interest as requires him to be joined as a party complainant. Potter *v.* Wilson, 2 Fish. 102; Grover & Baker S. Co. *v.* Sloat, 2 Fish. 112.

A foreign administrator of the patentee may maintain a suit in the circuit court without taking out new letters of administration in the State where the suit is brought. The title to a patent is regulated by an act of Congress. Smith *v.* Mercer, 5 Penn. L. J. 529; s. c. 4 West. L. J. 49; Goodyear *v.* Hullipen, 3 Fish. 251; Hodge *v.* Missouri Railroad, 4 Fish. 161; s. c. 1 Dillon, 104.

A corporation created under the laws of one State may file a bill in a circuit court in another State. Elm City Co. *v.* Wooster, 6 Fish. 452; s. c. 4 O. G. 83.

A corporation, unless restrained by its charter, may engage in the manufacture of the thing patented in another State. Grover & Baker S. Co. *v.* Sloat, 2 Fish. 112; Blanchard's Factory *v.* Warner, 1 Blatch. 258.

Where one person has the legal title to a patent, and another person has an equitable right in the same, and a suit in equity is instituted complaining of an infringement, the person having the legal right, and the one having an equitable right which has been violated, should join as complainants. Stimpson *v.* Rogers, 4 Blatch. 333; Aiken *v.* Dolan, 3 Fish. 197; Dibble *v.* Augur, 7 Blatch. 86.

The patentee and a licensee may unite in a bill to enjoin an infringement of the interest owned by the licensee. Goodyear *v.* Central R. R. Co. 1 Fish. 626; s. c. 2 Wall. Jr. 356; Goodyear *v.* Allyn, 3 Fish. 374; s. c. 6 Blatch. 33; 1 A. L. T. 94; Dorsey R. & H. Rake Co. *v.* Bradley Manuf. Co. 12 Blatch. 202.

If the patentee has given a license to the defendant, which has been forfeited by a breach of the condition, he is a necessary party to the suit in order to take advantage of the condition, although he has assigned his interest in the patent to another. Woodworth *v.* Cook, 2 Blatch. 151.

The assignor and assignee may unite in a bill in equity for an infringement that occurred before the assignment. Anthony *v.* Carroll, 9 O. G. 199; s. c. 23 Pitts. L. J. 23.

If the assignment of a claim for past damages and profits is in connection with and incident to a transfer of the title to the patent, the assignor is not a necessary party to a bill to recover damages and profits before as well as after the assignment. Henry *v.* Stove Co. 9 O. G. 408.

Until an assignment is made, all suits must be brought in the name of the personal representative of the patentee. The next of kin or heirs have no title or interest in the patent, and should not be joined as parties complainant. Hodge *v.* Missouri Railroad, 4 Fish. 162; S. C. 1 Dillon, 104.

A party who is interested in the patent out of a certain territory may unite with a party who owns the patent within the territory to obtain an injunction to prevent sales of the alleged infringing articles, if they are sold out of the territory. Buck *v.* Cobb, 9 Law Rep. 545.

The patentee may be made a party complainant, jointly with the grantee, of a right to a certain territory. Woodworth *v.* Wilson, 4 How. 712; Ogle *v.* Ede, 4 Wash. C. C. 584.

Where a reissue has been granted to an administrator, the heirs of the patentee are necessary parties to the bill. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

Where the patentee, in his lifetime, parted with his equitable title to the invention, his heirs are not necessary parties if a reissue has been granted to the administrator. Northwestern Co. *v.* Philadelphia Co. 6 O. G. 34; S. C. 31 Leg. Int. 148.

If other persons named as executors did not prove the will, and had nothing to do with the surrender or reissue of letters patent, and the reissue is granted to one executor alone, they need not be made parties to a bill to restrain the infringement of the reissued patent. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

When the patent is owned by a firm, one partner can not file a bill without joining his copartner. Ambler *v.* Chouteau, 3 Cent. L. J. 333.

Where a final decision can not be made between the parties litigating, without directly affecting and prejudicing the rights of others not made parties, the objection may be taken at the hearing, and it may and ought to be raised and acted upon by the court itself. Florence Co. *v.* Singer Co. 4 Fish. 629: S. C. 8 Blatch. 113.

Where the case can not be decided between the parties, it will not avail to suggest that the absentees are beyond the jurisdiction of the circuit court, or have such residence or citizenship that to make them parties would defeat that jurisdiction. Florence Co. *v.* Singer Co. 4 Fish. 329; S. C. 8 Blatch. 113.

If the patentee joins with a party who has no joint interest sufficient to maintain the bill, the bill will be dismissed. Wyeth *v.* Stone, 1 Story, 273.

Objections as to parties are not favored when postponed to the final hearing upon the pleadings and proofs. Potter *v.* Wilson, 2 Fish. 102; Dibble *v.* Augur, 7 Blatch. 86.

If the want of proper parties complainant is not set up in the answer, it will not avail unless the case, if made at the hearing, is one in which the court can not proceed to a decree between the parties before the court without prejudice to the rights of those who are proper to be made parties, but who are not brought into court. Wallace *v.* Holmes, 5 Fish. 37; S. C. 9 Blatch. 65; 1 O. G. 117.

A person who merely gives a license for the use of his own patent to the person who commits the alleged infringement, can not be made a party defendant unless his patent covers, or his license, in form or effect, has some connection with the infringement of the complainant's patent. Hussey *v.* Bradley, 2 Fish. 362; S. C. 5 Blatch. 134.

The manufacturer and the party who sells the alleged infringement of the thing patented, may be sued jointly, although they act independently. Buck *v.* Cobb, 9 Law Rep. 545.

The lessor and lessee of a machine may be joined as parties defendant. Jacques *v.* Wells, 5 O. G. 364.

The officer of a corporation who made a contract in its behalf to allow another to use an infringing machine, may be made a party defendant with the infringer. Nichols *v.* Pearce, 7 Blatch. 5.

A bill may be maintained against the directors of a corporation who have the management and superintendence of the business, and under whose direction the patented articles are manufactured and sold. Goodyear *v.* Phelps, 3 Blatch. 91.

If the bill is filed against one director alone, it ought to appear that he has the power to direct the use or disuse of the patented machine. Jones *v.* Osgood, 3 Fish. 591; S. C. 6 Blatch. 435.

If one does not in person perform the work, but procures another to do it for his advantage on a machine owned by himself, he can still be restrained, and is estopped from denying *qui facit per alium, facit per se.* Woodworth *v.* Hall, 1 W. & M. 248, 389.

It may be that any workman on the machine, though not interested in it, is liable to be restrained in order to prevent evasions by treating all as principals who are aiding. Woodworth *v.* Hall, 1 W. & M. 248, 389; Boyd *v.* McAlpin, 3 McLean, 427.

Possibly if one hires another to do work on a machine he may be restrained. Woodworth *v.* Hall, 1 W. & M. 248. 389.

If the principal and his employees are joined as parties defendant, the bill will be dismissed as to the employees. Hussey *v.* McCormick, 1 Fish. 509; S. C. 1 Biss. 300; Sargent *v.* Larned, 2 Curt. 340.

Parties who are acting in concert in the use of the machine which constitutes the alleged infringement of the complainant's rights, may be joined as parties defendant. The fact that as between themselves they are connected together as the stockholders, managers and servants of a corporation, does not exempt them from the restraints of an injunction. Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493; Goodyear *v.* Phelps, 3 Blatch. 91.

Bill.

It is irregular to entitle the bill in the cause, because until the bill is filed there is no cause pending. An address to the circuit court without the words in equity is sufficient. Sterrick *v.* Pugsley, 1 Cent. L. J. 106.

It is not necessary that the complainant shall deduce his title by setting forth the various assignments. A simple averment that the title to the patent is vested in the complainant, is sufficient. Nourse *v.* Allen, 3 Fish. 63.

A general charge of infringement is all that is necessary to require the defendant to answer the bill, and the particulars of the infringement need not be specified. It would obviously be a very inconvenient practice to require the complainant to set out at length the details of his invention and of the defendant's manufacture. The bill would be very voluminous, and not necessarily more clear or explicit. Turrell *v.* Cammerrer, 3 Fish. 462; Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493.

The bill may allege the character of the improvement and infringement in general terms, without describing the nature of the improvement either in the language of the specifications or in any other way. Haven *v.* Brown, 6 Fish. 413.

If an injunction is applied for, the bill should allege an unquestioned use for some length of time. Gutta Percha Co. *v.* Goodyear Rubber Co. 3 Saw. 542.

Where there has been a thorough trial at law, and a verdict for the patent approved by the court, it is usual and proper to make it the subject of an allegation in the bill. Doughty *v.* West, 2 Fish. 553.

The bill need not allege that the patentee has marked the articles made or vended under the patent as required by the patent law. Goodyear *v.* Allyn, 3 Fish. 374; S. C. 6 Blatch. 33; 1 A. L. T. 94.

If the complainant desires to rely upon a prior judgment at law rendered in his favor against the defendant as matter of estoppel, he should aver the judgment with bill. If no such averment is made, the judgment will not be deemed an estoppel. Blandy *v.* Griffith, 3 Fish. 609.

A bill of complaint by a corporation need not state where the corporation is located or has its place of business. Nat. Hay Rake Co. *v.* Harbert, 2 W. N. 100.

If the claims of several patents appertain to the same general subject, the bill may join them all in the charge of infringement. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Nourse *v.* Allen, 3 Fish. 63.

A complainant who owns several patents, can not charge an infringement of each in one bill, unless he avers that the machine sold by the defendant contains all the improvements embraced in his patents. Nellis *v.* McLanahan, 6 Fish. 286.

If the same article is an infringement of two patents held by the same person, the two causes of action may be joined in the same bill. Gillespie *v.* Cummings, 3 Saw. 259.

If two assignments cover the same territory, a violation of the right conferred by each may be joined in the same bill. Gillespie *v.* Cummings, 3 Saw. 259.

No one but the government, either in its own name or in the name of its appropriate officer, or by some form of proceeding which gives official assurance of the sanction of proper authority, can institute judicial proceedings for the purpose of vacating or rescinding the patent which the government has issued to an individual, except in the cases provided for by the statute. Mowry *v.* Whitney, 5 Fish. 513; S. C. 14 Wall. 434; 1 O. G. 499.

The courts can recognize the United States as a plaintiff on the record only when the record shows that the United States appears as plaintiff by the district attorney for the district in which the suit is brought. The fact that

the suit is instituted on behalf of the United States by the person who is district attorney, and that he acts as such in instituting the suit on behalf of the United States, must appear by the face of the bill or declaration. U. S. *v.* Doughty, 7 Blatch. 424.

An information to repeal a patent should be in the name of the United States, and should be filed by the district attorney in the name and on behalf of the United States. Att. Gen. *v.* Rumford Works, 9 O. G. 1062.

The practice is usually for the complainant to make oath to his bill when it is signed, but this is not imperative or uniform. It is not done if he is absent or indisposed, though it should be done, probably before the hearing, unless it be a bill by a corporation, or unless an answer under oath is not asked, or unless an oath to the bill is waived, or its absence is not objected to by the respondent when first heard. Woodsworth *v.* Edwards, 3 W. & M. 120; Rogers *v.* Abbott, 4 Wash. C. C. 514; Nat. Hay Rake Co. *v.* Harbert, 2 W. N. 100.

If the bill is brought by the patentee and a licensee for the benefit of the licensee, the licensee is the proper party to verify it. Goodyear *v.* Allyn, 3 Fish. 374; S. C. 6 Blatch. 33; 1 A. L. T. 94.

When it appears from the face of the bill that the assignment has never been recorded, the court is bound to take notice of the defect, even though no objection is taken in the pleadings, for it is not the case of a title defectively set forth, but of a title defective in itself. Wyeth *v.* Stone, 1 Story, 273.

If the patent is surrendered while the suit is pending, the action fails, and no remedy can be had for an infringement of a reissue, except by a new suit. Reedy *v.* Scott, 23 Wall. 352; S. C. 7 O. G. 463; Fry *v.* Quinlan, 13 Blatch. 205; *contra*, Woodworth *v.* Stone, 3 Story, 749; Sarven *v.* Hall, 5 Fish. 415; S. C. 9 Blatch. 524; 1 O. G. 437.

If the patent is surrendered after the filing of the bill, it is not necessary that there should be any new breach of the old patent, or any breach of the new patent. The case is not like that of an action at law for the breach of a patent, to support which, it is indispensable to establish a breach before the suit was brought. But in a suit in equity, the doctrine is far otherwise. A bill will lie for an injunction, if the patent right is admitted or has been established, upon well grounded proof of an apprehended intention of the defendant to violate the patent right. A bill *quia timet* is an ordinary remedial process in equity. Woodworth *v.* Stone, 3 Story, 749; Wheeler *v.* McCormick, 4 Fish. 433; S. C. 8 Blatch. 267.

After a bill has been filed in one district for infringements committed in that district, the complainant may file another bill in another district for subsequent infringements. Wheeler *v.* McCormick, 4 Fish. 433; S. C. 8 Blatch. 267; Penn Salt Co. *v.* Myers, 1 W. N. 377.

If the patentee seeks for an injunction on the ground of an infringement, and states nothing about a contract which authorized the use, and such a contract appears by the answer, he must amend his bill before he can impeach the contract. Hartshorn *v.* Day, 3 Fish. 32; S. C. 19 How. 211; Wilson *v.* Stolley, 4 McLean, 275.

Where the rights of the parties under a reissue were in issue under the answer and the replication, the court may allow the bill to be amended, even

after a final decree, by inserting an averment of the reissue. Tremaine *v.* Hitchcock, 23 Wall. 518; s. c. 7 O. G. 1055.

A petition for leave to file a supplemental bill, need not embrace the averment intended to be inserted in the bill, but merely set forth the ground on which the relief is applied for. Parkhurst *v.* Kinsman, 8 N. Y. Leg. Obs. 73.

On an application for leave to file a supplemental bill, the only question is whether the petition states facts and circumstances which, if properly pleaded, would sustain a supplemental bill. Parkhurst *v.* Kinsman, 8 N. Y. Leg. Obs. 73.

A supplemental bill may be filed to bring in a party who has been acting in collusion with the defendant since the filing of the original bill. Parkhurst *v.* Kinsman, 8 N. Y. Leg. Obs. 73.

If, after the filing of the answer, a discovery is sought as to particulars not mentioned in the original bill, a supplemental bill may be filed. Parkhurst *v.* Kinsman, 8 N. Y. Leg. Obs. 73.

A party to whom the complainant has assigned his title since the commencement of the suit, has no interest in an infringement before his right accrued, and a motion by him for leave to file a supplemental bill is a matter in the discretion of the court. Dean *v.* Mason, 20 How. 198.

If the complainant, having surrendered his patent while the action is pending, files a supplemental bill, the irregularity will be deemed to be waived by filing an answer and taking evidence. Reedy *v.* Scott, 23 Wall. 353; s. c. 7 O. G. 463.

A cross bill can only be filed by leave of the court, after due notice to the complainant. Webster Loom Co. *v.* Short, 10 O. G. 1019.

There is no law which authorizes an order of publication on a cross bill against a non-resident complainant. Webster Loom Co. *v.* Short, 10 O. G. 1019.

The question of abandonment of a license can not be raised unless the issue is made by the pleadings, for the proof must correspond with the allegations. Wilson *v.* Stolley, 4 McLean, 275.

Demurrer.

A misjoinder of parties complainant may be taken advantage of by a general demurrer. Hodge *v.* Missouri Railroad, 4 Fish. 161; s. c. 1 Dillon, 104.

Upon a demurrer to a bill of complaint, the court can not act upon the admission of the complainant's counsel. Perry *v.* Corning, 6 Blatch. 134.

Plea.

If a plea of the pendency of a prior suit for the same cause of action, makes a copy of the bill in the prior suit a part thereof, the court will examine the bill as well as the plea. Wheeler *v.* McCormick, 4 Fish. 433; s. c. 8 Blatch. 267.

The filing of two pleas, without special leave given for that purpose, is irregular, and both are liable to be overruled as improperly interposed. Wheeler *v.* McCormick, 4 Fish. 433; s. c. 8 Blatch. 267.

A defense that the complainant is not incorporated, must be pleaded in abatement, and can not be pleaded in bar or given in evidence under the general issue. If the defendant pleads to the merits, he admits the capacity of the complainant to sue, and waives any objection thereto. Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; S. C. 2 Cliff. 555.

If the defendant intends to question the right of an executor or complainant to sue in a representative character, he should do so by a plea or by the answer. If the question is not raised in that way, the objection will not be entertained at the hearing. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

If a defendant omits to set up the non-joinder of other infringers as parties defendant, he must do so by plea or answer, or it will be disregarded at the hearing. Wallace *v.* Holmes, 5 Fish. 37; S. C. 9 Blatch. 65; 1 O. G. 117.

An objection to the jurisdiction of the court is probably too late if it is only made after the answer is put in, the replication filed and the evidence published. Nesmith *v.* Calvert, 1 W. & M. 34.

The setting of a plea down for hearing, is a waiver of any irregularity in the filing of the plea, such as the omission of the certificate of counsel that it is in his opinion well founded in point of law, and of the affidavit of the party that it is not interposed for delay. Goodyear *v.* Toby, 6 Blatch. 130.

In order to constitute the fact of a want of parties a good defense, it must be shown by the plea that the persons alleged to be necessary parties are alive and within the jurisdiction of the court. Goodyear *v.* Toby, 6 Blatch. 130.

If the complainant sets a plea down for argument, he thereby admits the facts therein alleged, and the sufficiency of the plea is the question to be considered. Wheeler *v.* McCormick, 4 Fish. 433; S. C. 8 Blatch. 267.

Answer.

The rules of pleading in chancery require that the defense of a prior invention shall be set up in the answer so as to enable the complainant to meet it. If no such defense is set up, evidence of such prior invention can not be regarded. O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Geier *v.* Goettinger, 7 O. G. 563; Pitts *v.* Edmonds, 2 Fish. 52; S. C. 1 Biss. 168; Pickering *v.* Phillips, 10 O. G. 420; Howe *v.* Williams, 2 Fish. 395; S. C. 2 Cliff. 245; Orr *v.* Merrill, 1 W. & M. 376; Eureka Co. *v.* Bailey Co. 11 Wall. 488; Jordan *v.* Dobson, 4 Fish. 232; S. C. 2 Abb. U. S. 398; 7 Phila. 533; Forbes *v.* Barstow Stove Co. 2 Cliff. 379.

A defense that the invention is not a patentable subject; that is, that it is not a new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, may be made, although it was not set up in the answer. Guidet *v.* Barber, 5 O. G. 149.

When the defense of a prior invention is set up, the settled practice in equity is to require the respondent, as a condition precedent to such a defense, to give the complainant substantially the same information in his answer as is required of a defendant in an action at law. Agawam Co. *v.* Jordan, 7 Wall. 583; Cook *v.* Howard, 4 Fish. 269; Seymour *v.* Osborne, 3 Fish. 555; S. C.

11 Wall. 516; Collender *v.* Griffith, 11 Blatch. 212; S. C. 3 O. G. 689; Decker *v.* Grote, 6 Fish. 143; S. C. 10 Blatch. 331; 3 O. G. 65; La Baw *v.* Hawkins, 6 O. G. 724; Earl *v.* Dexter, 1 Holmes, 412; S. C. 6 O. G. 729; Brown *v.* Hall, 3 Fish. 531; S. C. 6 Blatch. 401; Graham *v.* Mason, 5 Fish. 1.

If the respondent intends to contest the novelty of the invention, his denial in that behalf should be explicit, unqualified, and unconditional. Graham *v.* Mason, 5 Fish. 1.

If there is a general denial that the patentee was the first and original inventor, and a special one, the respondent will be limited to the special one. Agawam Co. *v.* Jordan, 7 Wall. 583; Middletown Co. *v.* Judd, 3 Fish. 141.

If the issue of the novelty of the invention is not raised by the pleadings, evidence to show the state of the art can have no effect on the case beyond the aid it may give the court in construing the patent. Middletown Co. *v.* Judd, 3 Fish. 141; American Saddle Co. *v.* Hogg, 5 Fish. 353; S. C. 1 Holmes, 177; 2 O. G. 595; La Baw *v.* Hawkins, 6 O. G. 724.

If the question of abandonment or surrender is not raised in the answer as a matter of defense, it is not in issue between the parties, and the whole evidence taken on the point is irrelevant and can not be looked to as a matter in judgment. The defect in the pleadings puts the question entirely beyond the reach of the court. Wyeth *v.* Stone, 1 Story, 273.

Evidence that the invention was on sale and in public use for more than two years prior to the application for a patent is not admissible, unless the defense is set up in the answer. Agawam Co. *v.* Jordan, 7 Wall. 583.

An objection to the title of the complainant which is not taken in the answer, or made the subject of examination or inquiry before the examiner, will not be entertained at the hearing. Grover & Baker S. Co. *v.* Sloat, 2 Fish. 112.

Unreasonable neglect or delay in filing a disclaimer can not be set up as a defense, unless it is alleged in the answer. Burden *v.* Corning, 2 Fish. 477.

If the issue that the articles sold by the complainants did not have the word "patented" marked on them, as required by law, is not made by the pleadings, the point can not be raised before the master. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

The objection that a skillful workman can not make the article can not be entertained, unless it is made in the answer. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

A defense which is not set up in the answer can not be relied on at the hearing. Goodyear *v.* Providence Rubber Co. 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

If there has been a trial at law, and the bill charges that the defendant will in future violate the right secured by the patent, unless he is restrained by an injunction, the defendant, in his answer, should distinctly state that he does not intend in future to do the specific things which the court has determined he has no right to do. Poppenhusen *v.* Gutta Percha Co. 2 Fish. 74: S. C. 4 Blatch. 184.

The defendant is in no default by refusing to answer any part of the bill to which he is not specially interrogated, but if the answer responds to the

charges in the bill, it will not be held impertinent. Brooks *v.* Bicknell, 3 McLean, 250.

Evasive answers to specific inquiries, if not positively equivalent to admissions, afford strong presumptive evidence against the respondent. Agawam Co. *v.* Jordan, 7 Wall. 583.

An allegation that a reissue was obtained under false representations should be made in distinct language, without equivocation, and, if relied on at all, should be the subject of very distinct proof. Doughty *v.* West, 2 Fish. 553.

The answer to the charge of infringement should be distinct and unevasive. Jordan *v.* Wallace, 5 Fish. 185; S. C. 8 Phila. 165.

A defense of abandonment and of public use for more than two years before the application for the patent ought not to be blended in the same allegation, as they depend in many respects upon different principles. Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630.

If the defendant claims any right under a license, he must show that he has done everything on his part, which in equity he can be required to do, to entitle him to the right asserted. An alleged violation of the contract by the complainant will not help the equity of the defendant, for if he justifies under the license, he must show that he has done all that is necessary to entitle him to its benefit. Brooks *v.* Stolley, 3 McLean, 523.

Where a clause is omitted in an assignment through mistake or accident, the matter thus entitling the party to an amendment of his contract may be set up by way of equitable defense against a proceeding involving the rights of the parties under the instrument, and which would not be maintainable if the clause in question had formed a part of the contract. Woodworth *v.* Cook, 2 Blatch. 151.

Although the strict legal title may be in the complainant, yet if the defendant has an equitable title he may avail himself of it, for a party who asks for equity is bound to do equity. Day *v.* Candee, 3 Fish. 9.

The complainant is entitled to an answer upon oath to all the material allegations of the bill, although he has not annexed any special interrogatories to the bill. Perry *v.* Corning, 6 Blatch. 134.

A motion to file an answer after default is generally addressed to the discretion of the court. Under some circumstances the court, for the purposes of justice, will go great lengths in opening a default and allowing an answer to be filed. Dean *v.* Mason, 20 How. 198.

An objection that the answer does not disclose the names and places of residence of those who had prior knowledge of the thing, and where it had been used, ought in general to be taken by exception, as the defect is the proper subject of amendment. Graham *v.* Mason, 5 Fish. 1.

The issues raised in chancery suits must be raised by the allegations in the bill and answer, and whenever either the bill or answer is defective, the defect must be cured by amendment, and can not be cured by filing special notices. The filing of a notice of special matter is wholly irregular. Doughty *v.* West, 2 Fish. 553.

A paper filed without leave to amend can not be regarded as an amend-

ment to the original answer. Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87; s. c. 2 Cliff. 555.

The respondent may be allowed to file a supplemental answer denying the validity of the patent, if the application for leave so to do is made within a reasonable time after he discovers the fact. Morehead *v.* Jones, 3 Wall. Jr. 306.

If the respondent sets up a new defense, he may be compelled to pay the costs that have accrued on the abandoned defense. Morehead *v.* Jones, 3 Wall. Jr. 306.

If the answer admits an infringement, the respondent will not be permitted to file a supplemental answer denying the infringement, unless he alleges a mistake of fact or of law in the answer. Morehead *v.* Jones, 3 Wall. Jr. 306.

An amendment of an answer will not make testimony admissible which was taken under objection before the answer was amended, for the party had a right to rely upon his objection, and elect not to cross-examine or offer rebutting proof. Roberts *v.* Buck, 6 Fish. 325; s. c. 1 Holmes, 224; 3 O. G. 268.

Where the complainant will not be taken by surprise, an amendment of the answer may be allowed upon the terms that the defendant is not to recover costs up to the time of filing it. Roberts *v.* Buck, 6 Fish. 325; s. c. 1 Holmes, 224; 3 O. G. 268.

If the defendant desires to amend his answer, so as to set up the defense that the patented invention was in public use for more than two years before the granting of the patent, he must show something more than that he was guilty of laches in omitting to set it up in the original answer. Webster Loom Co. *v.* Higgins, 9 O. G. 965.

If there is a general averment that the patentee was not the first and original inventor, and he will not be taken by surprise, the defendant may be allowed to amend his answer, even at the final hearing, so as to set up the defense with more particularity. Brown *v.* Hall, 3 Fish. 531; s. c. 6 Blatch. 401.

If the answer omitted to give the proper notice of a prior invention, the court may allow an amendment at the hearing *nunc pro tunc* as of the time the answer was filed. Roberts *v.* Ryer, 6 Fish. 293; s. c. 91 U. S. 150: 11 Blatch. 11; 3 O. G. 550; 10 O. G. 204.

When the defendant, in his answer, admitted an infringement, he will not, after a decree, reference and report of the master, be allowed to amend his answer, so as to deny the infringement, where the admission arose from a want of diligence on his part, or a want of intelligence on the part of his counsel. Ruggles *v.* Eddy, 5 Fish. 581: s. c. 11 Blatch. 524.

Good cause for allowing an amendment of an answer, so as to set up a new defense, is not shown when it appears that the matter of the proposed amendment could with reasonable diligence have been sooner introduced into the answer. India Rubber Co. *v.* Phelps, 4 Fish. 315; s. c. 8 Blatch. 85; Rumford Chemical Works *v.* Hecker, 10 O. G. 289; Hitchcock *v.* Tremaine, 5 Fish. 537; s. c. 9 Blatch. 550; 1 O. G. 633; Webster Loom Co. *v.* Higgins, 13 Blatch. 349.

If the new defense is dependent wholly on parol evidence, the courts hesi-

tate in allowing any practice which may encourage carelessness, negligence or inattention in making answers, or which may leave room for the introduction of testimony manufactured for the occasion. India Rubber Co. *v.* Phelps, 4 Fish. 315; S. C. 8 Blatch. 85.

An answer which is not responsive to the bill is not evidence in favor of the defendant. Sargent *v.* Larned, 2 Curt. 340.

An admission made in the answer, is not waived by the complainant's going into the proofs and otherwise treating it as an open question. It would be subversive of all sound practice, and tend largely to defeat the ends of justice, if the courts should refuse to accept a fact as settled, which is distinctly alleged in the bill and admitted in the answer. Jones *v.* Morehead, 1 Wall. 155.

The proofs and the allegations must correspond. The examination of the case by the court is confined to the issues made by the pleadings. Proofs without the requisite allegations are as unavailing as such allegations would be without the requisite proofs to support them. Objections which are not taken in the answer can not be entertained. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; Blandy *v.* Griffith, 3 Fish. 609; Yale Manuf. Co. *v.* North, 3 Fish. 279; S. C. 5 Blatch. 455; Howes *v.* Nute, 4 Fish. 263; Russell Manuf. Co. *v.* Mallory, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495.

An allegation of a use of the invention with the consent of the patentee, for more than two years prior to the application for a patent, is of no avail unless sustained by proofs. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516.

Issues for Jury.

The circuit courts have jurisdiction of controversies arising under the patent laws, by direct grant from Congress. They do not merely act as ancillary to a court of law, and do not, therefore, require the patentee to establish his legal right in a court of law, and by the verdict of a jury. Sanders *v.* Logan, 2 Fish. 167.

There is, on account of the judge being the same for the equity and the law hearings, much less reason than in England, for sending questions to a court of law in the federal tribunals. Brooks *v.* Norcross, 2 Fish. 661.

One of the most arduous and daily duties of a court of chancery, is to decide questions of fact, and if it declines to do so, unless in ordinary and adjudged excepted cases, it declines to do what neither the legislature nor the law in chancery has excused it from the responsibility of doing. It has no more power to decline this responsibility, merely because a party requests it, or from timidity as to consequences, or a willingness to avoid labor, than to decline any other duty imposed on it by law. When it may use a jury, then it has the law so settled previously for its vindication, but if it does so in other cases, however desirable to a party or the court itself, it has not the sanction of law, and does not only do wrong to that but to the other parties in the case who oppose the request. Brooks *v.* Norcross, 2 Fish. 651; Wilson *v.* Barnum, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258; Blanchard *v.* Reeves, 1 Fish. 103.

Federal courts of equity under the Constitution and the laws of Congress, have the power of deciding every question of law or fact which may arise in equity suits over which they have complete jurisdiction, and consequently it is not indispensably necessary as a matter of law in any case, that any question in an equity court should be sent to a jury. Goodyear *v.* Providence Rubber Rubber Co. 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; Ayling *v.* Hull, 2 Cliff. 494; Goodyear *v.* Huilihen, 3 Fish. 251; Shelly *v.* Brannan, 4 Fish. 198; S. C. 2 Biss. 315.

It is not a matter of course to order a feigned issue, but the party applying must lay a foundation for it. A feigned issue is not to be granted, unless the opinion of a jury is found to be needed. Van Hook *v.* Pendleton, 1 Blatch. 187; Brooks *v.* Norcross, 2 Fish. 661.

The practice of sending the parties to law to have the validity of the patent decided, when that is denied in the answer, is founded more on convenience than necessity. It always rests in the sound discretion of the court. A trial at law is ordered by a chancellor to inform his conscience, not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact or of legal titles. The courts do not always consider it a proper exercise of their discretion, to order such issues to be tried at law before granting a final injunction. Goodyear *v.* Day, 2 Wall. Jr. 283; Goodyear *v.* Providence Rubber Co. 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; Foote *v.* Silsby, 1 Blatch. 545; Ayling *v.* Hull, 2 Cliff. 494; Cochrane *v.* Deener, 11 O. G. 637; S. C. 4 W. L. R. 99.

The general rule is, that an interlocutory order for issues to a jury in an equity suit, will not be made until all the proofs are taken and publication has passed. The reason for the rule is, that such an order should not in general be granted at all where the truth of the facts can be conveniently and satisfactorily ascertained by the court itself, and as that question can not usually be determined in advance of publication, the motion should be deferred to that stage of the controversy. Goodyear *v.* Providence Rubber Co. 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

The court will not order an issue to try the validity of the patent, if it feels no doubt or difficulty which would be removed or confirmed by a verdict. Goodyear *v.* Day, 2 Wall. Jr. 283; Buchanan *v.* Howland, 2 Fish. 341; S. C. 5 Blatch. 151; Goodyear *v.* Providence Rubber Co. 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; Ely *v.* Monson Manuf. Co. 4 Fish. 64.

Whether the reissued patent is for the same invention as the original, involves a question of fact. A court of equity has the power to pass upon this or any other facts that may be put in issue by a bill and answer. If the fact is involved in considerable doubt, that may be a reason why it should be sent to a jury. Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493.

When the question whether a reissued patent is for the same invention as the original is intimately connected with inferences to be drawn from the charges in the specification and claim as presented in the reissue, when compared with the original, and the significance of these inferences depends more or less upon the construction to be given to the instrument, there is no occasion for the intervention of a jury for the purpose of determining the fact of

the identity of the inventions described in the old and new patents. Poppenhusen *v.* Falke, 2 Fish. 181; s. c. 4 Blatch. 493.

If the validity of the patent or the fact of infringement is doubtful, the court may at the final hearing order the cause to stand over a reasonable time for the trial of the questions at law. Muscan Hair Co. *v.* Am. Hair Manuf. Co. 4 Fish. 320; s. c. 4 Blatch. 174; Crosby *v.* Lapouraille, Taney, 374.

The court will not direct an issue to try the validity of the patent, after the case has been set down for final hearing on the exhibits and proofs, without any motion or order of the court for such an issue. Goodyear *v.* Day, 2 Wall. Jr. 283.

A motion that the proceedings be stayed until there is a trial at law, or a verdict upon issue framed under the order of the court, ought not in general to be granted, where it appears that a trial at law and a hearing in equity have already been had, and that both have resulted in favor of the complainant. Howe *v.* Williams, 2 Fish. 395; s. c. 2 Cliff. 245.

If a court of equity directs an action at law to be brought to determine the legal right, the declaration may omit a claim for damages, and refer to the suit in equity for an explanation of the omission, in order to prevent a judgment from operating as a bar to an account in that suit. Knox *v.* Great Western Q. M. Co. 3 Saw. 422.

The verdict, when certified from the court to which the issues were sent, is never to be regarded as conclusive, but only as advisory, and may be set aside or even overruled. Silsby *v.* Foote, 20 How. 378; s. c. 2 Blatch. 260; Brooks *v.* Bicknell, 4 McLean, 70; Sickels *v.* Youngs, 3 Blatch. 293.

The preponderance of the evidence against the verdict must be striking and clear to authorize a court to order a new trial of an issue sent to be tried at law. The conscience of the chancellor, it is said, must be satisfied. The word conscience here means nothing more than a sacred and legal conviction in the mind of the court that the verdict is not sustained by the evidence. Brooks *v.* Bicknell, 4 McLean, 70.

Motion for Preliminary Injunction.

A motion for an injunction which is in accordance with a special prayer in the bill, is proper. Orr *v.* Littlefield, 1 W. & M. 13; Goodyear *v.* Mulley, 3 Fish. 420.

When an injunction is applied for on the ground of a violation of a right to an invention secured by patent, it is incumbent on the party making the application to swear at the time of making it as to his belief that he is the original inventor. For although when he obtained his patent he might very honestly have sworn to his belief of such being the fact, yet circumstances may have subsequently intervened, or information have been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect. Sullivan *v.* Redfield, 1 Paine, 441; Rogers *v.* Abbott, 4 Wash. C. C. 574.

If the bill alleges that the patentee was the first and original inventor of the thing patented, and is sworn to, a separate affidavit to that fact is not necessary. Young *v.* Lippman, 5 Fish. 230; s. c. 9 Blatch. 277; 2 O. G. 249.

On a motion for a provisional injunction the patentee must rest on the case

stated in the bill. Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

The patentee may file affidavits stating the matters set forth in the bill with more particularity, and referring to collateral matters which explain or tend to support and strengthen it. Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

Either party may take and read the affidavits of other persons. Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; Wickershaff *v.* Jones, 2 Whart. Dig. 363.

It is irregular to swear a person in a suit before the bill is filed, and if an affidavit is so entitled it will be excluded. The irregularity consists in having the affidavit sworn to under the title of a suit in which no bill has been filed. If the title is omitted there will be no irregularity. The purpose for which they are intended should be stated in the affidavit. Baldwin *v.* Bernard, 5 Fish. 442; S. C. 9 Blatch. 509 *n.*; 2 O. G. 320; Sterrick *v.* Pugsley, 1 Cent. L. J. 106.

The proper venue of an affidavit taken before a United States commissioner, is "United States of America, District of ——," naming the district and State for which the commissioner was appointed. It is irregular to give the State and county. Sterrick *v.* Pugsley, 1 Cent. L. J. 106.

A hearing of both parties is contemplated on an application for an injunction. The defendant may, therefore, file an answer before the time for answering expires, and it will have the same effect as any other answer. Brooks *v.* Bicknell, 3 McLean, 250.

If no answer is filed it will be assumed that the facts stated in the bill and not contradicted, are true. Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

The answer of the defendant is considered as an affidavit on a motion for a preliminary injunction. Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; Parker *v.* Brant, 1 Fish. 58.

If the answer denies an allegation in the bill, the denial will be taken to be true on a motion for a provisional injunction. Boyd *v.* Brown, 3 McLean, 295.

A mere denial in the answer of all equity in the bill, will not prevent the granting of an injunction. In the case of special injunctions, where affidavits and counter affidavits are produced, it is in the discretion of the court whether to issue the injunction or refuse it. Orr *v.* Littlefield, 2 W. & M. 13; Parker *v.* Brant, 1 Fish. 58.

A general allegation on information and belief in an affidavit by the defendant amounts to nothing. If he has any information sufficient to warrant a belief in the truth of what is stated, he is bound to disclose it for the judgment of the court, if it is to be of any avail to him. He can not swear to the conclusion and withhold the particulars of the information. Young *v.* Lippman, 5 Fish. 230; S. C. 9 Blatch. 277; 2 O. G. 249.

If the complainant alleges that the defendant uses a certain machine, and the defendant does not deny it, this is an admission that he uses such a machine. Ely *v.* Monson Manuf. Co. 4 Fish. 64.

Where there is a charge of infringement, it is in the power of the party charged to bring into court the article that he uses, so that the court can see

what he does use. It is his duty to tell the court what he uses, and to describe it. It is not sufficient to aver vaguely and generally that the article is not an infringement, for that is a question for the court to decide on the facts. Ely *v.* Monson Manuf. Co. 4 Fish. 64.

An affidavit by the solicitor for the defendant that he is advised and believes that the defendant's machine does not infringe the patent, will be disregarded if it gives no reason why the defendant does not himself swear to the dissimilarity of his machine, or why some competent machinist does not do so, and does not point out any dissimilarities. Conover *v.* Mers, 3 Fish. 386.

No affidavit of the defendant, unsupported by other testimony, can be considered as evidence to overthrow any averment in the bill. Cooper *v.* Mattheys, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

On a motion for an interlocutory injunction, the grant of a patent to the defendant has no other effect than as it indicates the opinion which highly respectable and skillful officers have formed on an *ex parte* examination of the case, and is not conclusive. Wilson *v.* Barnum, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258; Jones *v.* Merrill, 8 O. G. 401; Goodyear Dental Co. *v.* Evans, 3 Fish. 390; s. c. 6 Blatch. 121; Morse Co. *v.* Esterbrook Co. 3 Fish. 515; Sargent Manuf. Co. *v.* Woodruff, 5 Biss. 444; American Pavement Co. *v.* Elizabeth, 4 Fish. 189; Burleigh R. D. Co. *v.* Lobdell, 1 Holmes, 450; s. c. 7 O. G. 836; *contra*, Goodyear *v.* Dunbar, 1 Fish. 472; s. c. 3 Wall. Jr. 310.

Affidavits to be used in support of, or in opposition to, special motions, ought always to be served on the opposite counsel a reasonable time before the motion is brought on. Where this is not done the court may reject the affidavits, or, in its discretion, allow the same to be read, giving the opposite party the option to proceed with the hearing, or to take time for the perusal and examination of the affidavits, and production of affidavits in reply. Sterrick *v.* Pugsley, 1 Cent. L. J. 106.

It is not necessary for the defendant to give to the complainant previous notice of his defense. He is entitled to make it by answer and depositions when the motion for an injunction is brought on for a hearing. Day *v.* Car Spring Co. 3 Blatch. 154.

If the complainant desires to file counter affidavits, the hearing may be postponed. Day *v.* Car Spring Co. 3 Blatch. 154.

The patentee may file additional affidavits contradicting any statements made by the defendant in his affidavit. Cooper *v.* Mattheys, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; Goodyear *v.* Muller, 3 Fish. 420; Union Paper Bag Co. *v.* Binney, 5 Fish. 166; Day *v.* Car Spring Co. 3 Blatch. 154.

Affidavits which do not refer to title may be offered in support of the bill, and in contradiction of the answer. Brooks *v.* Bicknell, 3 McLean, 250.

The complainant can not file additional affidavits which are not in reply to the defendant's case. Union Paper Bag Co. *v.* Binney, 5 Fish. 166.

If the proof of the infringement is not satisfactory, the court may suspend the motion to allow the evidence to be supplied. Hodge *v.* Railroad Co. 3 Fish. 410; s. c. 6 Blatch. 85.

If the patentee does not by counter affidavits deny the statements of the defendant, such facts are assumed to be true. Cooper *v.* Mattheys, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

The defendant can not by further proof on his part reply to rebutting evidence. This is alike the rule at law and in equity. No court permits a defendant to make a new defense to proofs or arguments made in reply to his own. He has one hearing or chance alone, and must abide the advantage placed in the hands of the complainant. Day *v.* Car Spring Co. 3 Blatch. 154.

When evidence is not accessible at the time when the complainant's case is made up, the order of proof may be varied on suitable terms, giving the defendant an opportunity to answer the new matter. Union Paper Bag Co. *v.* Binney, 5 Fish. 166.

If the bill or affidavits state any fact not denied in the affidavits filed by the defendant, such fact is assumed to be true. Cooper *v.* Mattheys, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; Wells *v.* Gill, 6 Fish. 89; s. c. 2 O. G. 590.

Upon a motion for a preliminary injunction, the court will decline to decide the question of infringement, upon a mere inspection of the machines without other evidence, if they are complicated in their structure. Howe *v.* Morton, 1 Fish. 586; Cooper *v.* Mattheys, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; U. S. Annunciator Co. *v.* Sanderson, 3 Blatch. 184.

Upon a motion for a preliminary injunction, a new patent granted upon a surrender of the old one must be taken *prima facie* to be for the same invention as the old patent. Woodworth *v.* Stone, 3 Story, 749.

A voluntary appearance and the filing of an answer is a waiver of any informality in the service of the notice of a motion for a provisional injunction. Brammer *v.* Jones, 3 Fish. 340; s. c. 2 Bond, 100.

If a demurrer is filed, it should be first heard and disposed of before the merits of the application for an injunction are considered. Woodworth *v.* Edwards, 3 W. & M. 120.

The motion for a provisional injunction is heard in a summary way upon *ex parte* affidavits. A summary hearing is had upon a necessity more or less urgent for the immediate interposition of the court, and it is presumed that there is not time for that full and thorough investigation which is to be made upon the final hearing, where the witnesses can be subjected to cross-examination, and the process of the court may be used to compel the attendance of the witnesses and the production of evidence. Grover & Baker S. Co. *v.* Williams, 2 Fish. 133; Day *v.* Boston Belting Co. 16 Law Rep. 330.

Prior Suit.

An injunction when asked before the trial and resisted, is never to issue as a matter of course till the trial. There must in such case, in order to obtain it in advance, be proof not only of a patent, but also of some length of use under it, or some considerable sales of it, or some recovery establishing the validity of the patent, so as to impart to it weight or strength as valid beyond the mere issue of it. Hovey *v.* Stevens, 1 W. & M. 290; Isaacs *v.* Cooper, 4 Wash. C. C. 259.

The provisional injunction may be refused, if the complainant does not aver any prior adjudication in his bill to support the application. Parker *v.* Brant, 1 Fish. 58.

If the bill omits to aver a prior adjudication it may be amended and the injunction then issued. Parker *v.* Brant, 1 Fish. 58.

There is no necessity that the validity of a patent should be established by a trial at law, when there is no sufficient denial of the invention in the answer. Sickels *v.* Mitchell, 3 Blatch. 548.

If the validity of the patent has not been established on a trial either at law or in equity, and the exclusive right which the patent purports to grant has not been acquiesced in by the public, the right of the patentee must be clear and free from doubt, and the infringement must be equally clear. North *v.* Kershaw, 4 Blatch. 70.

If the results of the previous trials have been conflicting, and there is a strong denial of the originality of the invention in the affidavits, the provisional injunction will be refused. Allen *v.* Sprague, 1 Blatch. 567; Batten *v.* Silliman, 3 Wall. Jr. 124; Grover & Baker S. Co. *v.* Williams, 2 Fish. 133.

The force of a recovery goes upon the ground that the patentee does not sleep over his claim or interests so as to mislead others, and that whenever the validity of his claim has been tried he has sustained it as if good. Orr *v.* Littlefield, 1 W. & M. 13.

Formerly it was generally the practice of the courts, in adjudicating upon patents, when there was a seriously disputed question of fact, to send the matter to a jury; but lately the tendency of the courts has been to consider the cases themselves upon full proof, instead of sending them to a jury. The decision of a competent court, accustomed to the investigation of facts in relation to matters of art and science, is more satisfactory than the verdict of a jury. There is usually a great mass of evidence. Many of the jurors are not accustomed to such investigations, their minds become fatigued, their recollection of the testimony imperfect, and few, if any, take minutes of the evidence. Hence the mere fact that a jury has not passed upon the case will not have much weight, if in other respects the injunction ought to issue. Potter *v.* Fuller, 2 Fish. 251; Potter *v.* Muller, 2 Fish. 465.

If the prior adjudications were rendered upon a different construction of the patent from that claimed in the pending suit, they will not authorize an injunction. Mowry *v.* Railroad Co. 5 Fish. 587; S. C. 10 Blatch. 89.

Where a trial at law has been had, resulting in a verdict in favor of the patentee, and the right to the improvement patented has been fully established to the satisfaction of the court, and the infringement of right made clear, such a trial resulting in such a verdict is sufficient, without any other proof, to authorize the court to grant an injunction to prevent any future violation of right. Such a trial, with such a result, affords sufficient proof that in future there will be an infringement, unless such infringement is restrained by injunction. It is under such circumstances almost a matter of course that the injunction should be allowed. Sickles *v.* Tileston, 4 Blatch. 109; Parker *v.* Brant. 1 Fish. 58; Orr *v.* Badger, 7 Law Rep. 465; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 74; S. C. 4 Blatch. 184; Potter *v.* Muller, 2 Fish. 465; Potter *v.* Stevens, 2 Fish. 163; Potter *v.* Fuller, 2 Fish. 251; Orr *v.* Littlefield, 1 W. & M. 13; Potter *v.* Whitney, 3 Fish. 77; S. C. 1 Lowell, 87; Putnam *v.* Weatherbee, 1 Holmes, 497; S. C. 8 O. G. 320; Goodyear *v.* Hullihen, 3 Fish. 251: Jones *v.* Merrill, 8 O. G. 401; Thompson *v.* Mendelsohn, 5 Fish. 187;

s. c. 8 Phila. 166; Robertson *v.* Hill, 6 Fish. 465; s. c. 4 O. G. 132; American Shoe Co. *v.* National Shoe Co. 11 O. G. 740; U. S. & F. Felting Co. *v.* Asbestos Felting Co. 10 O. G. 828.

A judgment given on verdict and default under an agreement, if not collusive, is as strong, if not stronger evidence of the patentee's rights than it would have been if the claim were so doubtful as to be sent to a jury for decision, rather than so little doubtful as to be admitted or agreed to after being legally examined. Orr *v.* Littlefield, 1 W. & M. 13; Grover & Baker S. Co. *v.* Williams, 2 Fish. 133; Potter *v.* Fuller, 2 Fish. 251.

An interlocutory injunction will not be granted if the verdicts establishing the complainant's title have been obtained on inconsistent and contradictory claims, so that the court can not say with certainty what is or what is not an infringement of the patent. Parker *v.* Sears, 1 Fish. 93.

The fact that a bill of exceptions has been taken upon points which involve the validity of the patent does not present an insuperable objection to the granting of a provisional injunction. The court is bound to exercise its own judgment upon the questions involved in the bill of exceptions, with a view to see whether the litigation that remains presents such serious doubts concerning the title as ought to influence its judgment in granting or withholding the injunction. Furbush *v.* Bradford, 1 Fish. 317; s. c. 21 Law Rep. 471; Wells *v.* Gill, 6 Fish. 89; s. c. 2 O. G. 590; Morris *v.* Lowell Manuf. Co. 3 Fish. 67; Hartshorn *v.* Day, 3 Fish. 32; s. c. 19 How. 211.

A prior adjudication in a suit against other parties is not conclusive, but the considerations which would justify the court on a motion for a provisional injunction in renewing the discussion of a patentee's title after solemn hearing and judgment at law, must be such as if presented to his view after a trial at law would induce him to set aside a verdict. Parker *v.* Brant, 1 Fish. 58; Thayer *v.* Wales, 5 Fish. 130; s. c. 9 Blatch. 170; American Pavement Co. *v.* Elizabeth, 4 Fish. 189; Wells *v.* Gill, 6 Fish. 89; s. c. 2 O. G. 590; Tilghman *v.* Mitchell, 4 Fish. 615; s. c. 9 Blatch. 18.

If the trial at law has not been satisfactory, an injunction will be denied. Day *v.* Hartshorn, 3 Fish. 32.

If the defendant contributed toward the expenses of defending the prior suit, the injunction will be allowed, although he alleges that he can produce additional witnesses to testify to a fact which was in controversy in such prior suit. Birdsell *v.* Manuf. Co. 6 O. G. 604.

A party who voluntarily assumes the position of infringing an existing patent after a decision of the court in another case sustaining its validity, can not allege that any particular hardship attends his case when the court decides that the apparent title of the patentee is such that he must refrain from further infringing until he has proved the invalidity of the patent on a trial at law. Sargent *v.* Seagrave, 2 Curt. 553.

A decision on a motion for an attachment is not sufficient to warrant a preliminary injunction where the infringement is positively denied, without reference to the facts proven in the case. Sargent Manuf. Co. *v.* Woodruff, 5 Biss. 444.

The decree of a court of chancery is more persuasive evidence than the verdict of a jury. Goodyear *v.* Muller, 3 Fish. 420.

If there has been no action at law nor length of possession, the injunction will be refused if the injury would not be irreparable. Earth Closet Co. *v.* Fenner, 5 Fish. 15.

Prior Use.

If the validity of the patent has not been established by an action at law, a preliminary injunction will not be granted unless there has been an exclusive possession of some duration under it. Sullivan *v.* Redfield, 1 Paine, 441; Hockholzer *v.* Eager, 2 Saw. 361; Isaacs *v.* Cooper, 4 Wash. C. C. 259; Toppan *v.* Nat'l Bank Note Co. 2 Fish. 195; S. C. 4 Blatch. 509; Brown *v.* Hinkley, 6 Fish. 370; S. C. 3 O. G. 384; Jones *v.* Field, 12 Blatch. 494.

The ground on which acquiescence is important is that it shows exclusive possession, which if it has been of long standing, open and notorious, is a clear foundation of a presumption of title. It is not always, however, so satisfactory as positive adjudications, because it may have arisen from the comparatively small commercial value of the invention, and in that case shows only that no one has thought it worth infringing. Potter *v.* Whitney, 3 Fish. 77; S. C. 1 Lowell, 87; Toppan *v.* Nat'l Bank Note Co. 2 Fish. 195; S. C. 4 Blatch. 509; Grover & Baker S. Co. *v.* Williams, 2 Fish. 133.

If the possession and use under a patent has been of sufficient duration and exclusiveness, it may be the foundation of an interlocutory injunction. Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356; Foster *v.* Moore, 1 Curt. 279; American Shoe Co. *v.* National Shoe Co. 11 O. G. 740; Washburn *v.* Gould, 3 Story, 122; Ogle *v.* Ege, 4 Wash. C. C. 584; Howe *v.* Newton, 2 Fish. 531; Sargent *v.* Carter, 1 Fish. 277; Woodworth *v.* Sherman, 3 Story, 171; Morse Co. *v.* Esterbrook Co. 3 Fish. 515.

If the bill does not aver that the patentee has ever sold or used his improvement, the motion will be denied. Isaacs *v.* Cooper, 4 Wash. C. C. 259.

If the motion is refused because the bill does not aver that the patentee has ever sold or used his improvement, the bill may be amended. Isaacs *v.* Cooper, 4 Wash. C. C. 259.

When possession for some years has existed, or numerous sales or recoveries have occurred, the court will not refuse an injunction, or dissolve it on a denial of the validity of the patent by a respondent, either through affidavits or an answer, or other pleadings. Hovey *v.* Stevens, 1 W. & M. 290; Cook *v.* Ernest, 5 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 89; Brooks *v.* Bicknell, 3 McLean, 250; Gibson *v.* Betts, 1 Blatch. 163; Woodworth *v.* Rogers, 3 W. & M. 135; Hussey *v.* Whiteley, 2 Fish. 120; S. C. 1 Bond, 407.

Mere lapse of time is not sufficient to show a public recognition of the patentee's claim. The acquiescence in the patent must be attended with circumstances indicating that such acquiescence would not have occurred if any fair doubt had existed as to the validity of the patent. Guidet *v.* Palmer, 6 Fish. 82; S. C. 10 Blatch. 217.

In order to raise a presumption in favor of the patent, the use prior to the application therefor must be public under an avowed claim of a right to a patent. Otherwise there is no exclusive possession as against the public, and no claim in which the public can acquiesce. A secret use prior to the application for a patent will not, therefore, be taken into account on a motion for a provisional

injunction. Toppan *v.* Nat'l Bank Note Co. 2 Fish. 195; S. C. 4 Blatch. 509.

Exclusive possession and sales made between the date of the invention and the application for a patent may be considered. Sargeant *v.* Seagrave, 2 Curt. 553.

The possession must be sufficient to justify a presumption in favor of the validity of a patent. Potter *v.* Muller, 2 Fish. 465.

Injunctions are granted without a previous trial at law, in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years, without any successful impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are usually regarded as sufficient to warrant an injunction to restrain an infringement. Potter *v.* Muller, 2 Fish. 465; Miller *v.* Androscoggin Pulp Co. 5 Fish. 340; S. C. 1 Holmes, 142; 1 O. G. 409; Parker *v.* Brant, 1 Fish. 58.

A sufficient possession will warrant a provisional injunction even where great doubt is felt concerning the validity of the patent. Sargeant *v.* Seagrave, 2 Curt. 553.

It is not possible to fix any precise term of years during which the exclusive possession must have continued. The reason for the presumption in favor of the validity of the grant, is the acquiescence of the public in the exclusive right of the patentee, which, it may reasonably be assumed, would not exist unless the right was well founded. It is obvious that this public acquiescence is entitled to more or less weight according to the degree of utility of the machine and the number of persons whose trade or business is affected by it. Foster *v.* Moore, 1 Curt. 279; Sargeant *v.* Seagrave, 2 Curt. 553.

The courts have seldom refused an injunction on account of the shortness of the time after the grant, however brief, if long enough to permit articles or machines to be constructed by the patentee in conformity with his claim, and to be sold publicly and repeatedly, and they have been so sold and used under the patent without dispute. Orr *v.* Littlefield, 1 W. & M. 13; Potter *v.* Muller, 2 Fish. 465.

The shortest term of use is three years, and in most of the cases the time has been several years longer. Hovey *v.* Stevens, 1 W. & M. 290.

It is not necessary that the possession shall have been undisturbed. Cook *v.* Ernest, 2 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 89.

An unsuccessful attempt to interrupt a possession, strengthens the presumption that arises from it. It tends to show that persons who have found it for their interest to question the right, have questioned it, and for a time have refused to submit to it, but, on inquiry, have submitted. Such submission is the most persuasive kind of acquiescence. Sargeant *v.* Seagrave, 2 Curt. 553.

Each case must depend on its own circumstances. Those circumstances are the extent of the use or sales by the patentee, the degree of utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right. Sargeant *v.* Seagrave, 2 Curt. 553.

The time of the possession in case of a reissue, is to be computed from

the date of the original issue or grant. Orr *v.* Littlefield, 1 W. & M. 13; Grover & Baker S. Co. *v.* Williams, 2 Fish. 133; Orr *v.* Badger, 7 Law Rep. 465.

A preliminary injunction will not be granted when the defendant has been in possession and use of the invention for a long period of time adverse to the title of the complainant and under claim and color of right. Hall *v.* Spier, 6 Pitts. L. J. 403; Isaacs *v.* Cooper, 4 Wash. C. C. 259.

Where possession alone is relied on as a basis for a motion for a preliminary injunction, the infringement must be palpable. Burleigh Drill Co. *v.* Lobdell, 1 Holmes, 450; S. C. 7 O. G. 836.

Preliminary Injunction.

It is not a matter of course to grant an injunction upon the mere exhibition of the patent, and an allegation that it has been infringed. The patent may be, upon a trial at law, *prima facie* evidence of the right, but in order to warrant an interference by injunction, there ought to be but little if any doubt as to the validity of the patent. Sullivan *v.* Redfield, 1 Paine, 441; Thomas *v.* Weeks, 2 Paine, 92; Isaacs *v.* Cooper, 4 Wash. C. C. 259; Serrell *v.* Collins, 4 Blatch. 61.

The power to grant an injunction has existed from the early ages of chancery jurisdiction, and is remedial and useful as a preventative of injury and a multiplicity of suits, when it is properly exercised. An injunction is intended to aid or protect what seems to be a legal title. It is granted for this purpose when issued before a trial on presumptive evidence offered of such a title. It does not delay or retard a trial, but makes the *prima facie* title prevail till then. Woodworth *v.* Rogers, 3 W. & M. 135; Orr *v.* Littlefield, 1 W. & M. 13; Buck *v.* Cobb, 9 Law Rep. 545.

The issuing of an interlocutory injunction is always a matter of discretion with the court, and depends on the peculiar circumstances of each case. Parker *v.* Sears, 1 Fish. 93; Earth Closet Co. *v.* Fenner, 5 Fish. 15; Potter *v.* Davis Sewing Machine Co. 3 Fish. 472; Goodyear *v.* Rust, 3 Fish. 456; S. C. 6 Blatch. 229; Potter *v.* Crowell, 3 Fish. 112; S. C. 1 Abb. U. S. 89; Irwin *v.* Dane, 4 Fish. 359; S. C. 2 Biss. 442.

The right of a party to the most speedy and effectual protection against a meditated wrong, is as complete as his right to redress for wrongs already inflicted, and the accident of position confers no right on one party, whether he be plaintiff or defendant, at the expense of the other. The special injunction of equity may be abused to the injury of an opponent, but it is no less on that account the duty of the judge to grant it when in the exercise of his best discretion, he believes that it is called for by the merits and exigency of the case. Smith *v.* Mercer, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49; Hussey *v.* Whiteley, 2 Fish. 120; S. C. 1 Bond, 407; Potter *v.* Muller, 2 Fish. 465; Goodyear *v.* Schenck, 3 Fish. 82; Hodge *v.* Hudson River R. R. Co. 6 Blatch. 165.

In acting on applications for a provisional injunction, there is much latitude for discretion. The application may be granted or refused unconditionally, or terms may be imposed on either of the parties as conditions for

making or refusing the order. The state of the litigation where the patentee's title is denied, the nature of the invention, the character and extent of the infringement complained of, and the comparative inconvenience which will be occasioned to the respective parties by allowing or denying the motion, must all be considered in determining whether it shall be allowed or refused, and if at all, whether absolutely or upon some and what conditions. Furbush *v.* Bradford, 1 Fish. 317; S. C. 21 Law Rep. 471; Hodge *v.* Hudson River R. R. Co. 6 Blatch. 165.

The court will regard the comparative expense and inconvenience to which the parties will be subjected in case of granting the injunction on the one hand or withholding it on the other, and if the effect of granting an injunction will be very injurious and the refusal will subject the complainant to a comparatively slight inconvenience, the preliminary injunction will be refused. Hockholzer *v.* Eager, 2 Saw. 361; Parker *v.* Sears, 1 Fish. 93; Bliss *v.* Brooklyn, 4 Fish. 596; S. C. 8 Blatch. 533; Furbush *v.* Bradford, 1 Fish. 317; S. C. 21 Law Rep. 471; Gear *v.* Holmes, 6 Fish. 595; Goodyear *v.* Dunbar, 1 Fish. 472; S. C. 3 Wall. Jr. 310; Morris *v.* Lowell Manuf. Co. 3 Fish. 67; Dorsey R. H. Rake Co. *v.* Bradley Manuf. Co. 12 Blatch. 202.

Where an injunction would be disastrous to the defendant, and of no advantage to the complainant, it will not be granted if the defendant will file a bond with proper security to secure to the complainant the profits and damages which may be ultimately awarded. Dorsey Co. *v.* Marsh, 6 Fish. 387; S. C. 9 Phila. 395; Morris *v.* Shelbourne, 4 Fish. 377; S. C. 8 Blatch. 266.

There is not much force in the objection that an injunction would produce irreparable injury if it merely prohibits the sale of articles which are manufactured elsewhere. Potter *v.* Fuller, 2 Fish. 251.

If the injunction leads to serious injury in suspending works, the court can require security of the complainant to indemnify for it if the patent is avoided. Orr *v.* Littlefield, 1 W. & M. 13; Morse *v.* O'Reilly, 6 West. L. J. 102.

There is no power, the exercise of which is more delicate, which requires greater caution, deliberation and sound discretion, or is more dangerous in a doubtful case, than the issuing of an injunction. It is the strong arm of equity that never ought to be extended unless to cases of great injury, where courts of law can not afford an adequate or commensurate remedy in damages. The right must be clear, the injury impending or threatened. An injunction will be refused till the court is satisfied that a right is about to be destroyed or irreparably injured, or that great and lasting injury is about to be done by an illegal act. Hall *v.* Speer, 6 Pitts. L. J. 403.

The responsibility of the defendant for any profits or damages that may be decreed against him is a material circumstance. Morris *v.* Lowell Manuf. Co. 3 Fish. 67; Guidet *v.* Palmer, 6 Fish. 82; S. C. 10 Blatch. 217.

Where the validity of the patent is fully established, and the infringement is clear, a party has a right to protection by injunction, although it may cause great injury to the infringer. Potter *v.* Fuller. 2 Fish. 251.

If no special damage will result to the defendant or his business, the injunction will be granted. Howe *v.* Newton, 2 Fish. 531.

It is too much for a defendant in a clear case, to insist upon having the privilege of using a patented invention, for the reason that he is able to pay

the damages that may be awarded against him at the end of a protracted litigation to ascertain their amount. The patentee may not be as able to prosecute a suit as the defendant is to defend. The inconvenience which may result from an injunction, does not in such a case afford sufficient ground for withholding it. Sickels *v.* Mitchell, 3 Blatch. 548.

In most cases, an injunction will not be granted until the right of the complainant has been established at law; but where the injury would be irreparable, an injunction will be granted. The infringement of a patent constitutes an exception to the general rule. Brooks *v.* Bicknell, 3 McLean, 250.

If the defendant has little or no property, and can not pay the damages which might be recovered against him for an infringement of the patent, the injury would be irreparable. Brooks *v.* Bicknell, 3 McLean, 250: Goodyear *v.* Mullee. 3 Fish. 420.

If more injury may result to the complainant from a refusal of the injunction than to the defendant by granting it, the injunction will be granted. Irwin *v.* Dane, 4 Fish. 359; S. C. 2 Biss. 442.

Damage that may result from the groundless fears of others, is no ground for refusing a preliminary injunction. Rumford Chemical Works *v.* Vice, 11 O. G. 600.

The court, as a condition for allowing an injunction, may require that the complainant shall give bond to indemnify the defendant in the event that the right of the complainant shall not be sustained upon the final hearing. Brammer *v.* Jones, 3 Fish. 340; Shelly *v.* Brannan, 4 Fish. 198: S. C. 2 Biss. 315.

Upon granting an injunction, the court may direct that unless a suit is brought at the next term to try the legal title, the injunction shall then be dissolved. Woodworth *v.* Rogers, 3 W. & M. 135; Orr *v.* Merrill, 1 W. & M. 376: Serrell *v.* Collins, 4 Blatch. 61; Orr *v.* Littlefield, 1 W. & M. 13; Rogers *v.* Abbott, 4 Wash. C. C. 514.

The granting of an injunction being a matter entirely within the discretion of the court, it is for the court to say whether the rights of the complainant are so clear that he ought to be protected by injunction, or whether they are not so clear but that he may be made secure by sufficient guaranties by bond and security. Ely *v.* Monson Manuf. Co. 4 Fish. 64.

The defendant can not have the injunction stayed upon giving bond, with security, to the patentee for his damages when the infringement is clear and the right to the injunction manifest. Tracy *v.* Torrey, 2 Blatch. 275; Tilghman *v.* Mitchell, 4 Fish. 615; S. C. 9 Blatch. 18; Gibson *v.* Van Dresar, 1 Blatch. 532; Conover *v.* Mers, 3 Fish. 386; Consolidated Fruit Jar Co. *v.* Whitney, 31 Leg. Int. 229; Ely *v.* Monson Manuf Co. 4 Fish. 64.

The decree for an injunction may provide for its dissolution on the defendant's giving bond with security to account to the patentee should his right be finally established. Brooks *v.* Bicknell, 3 McLean, 250; Foster *v.* Moore, 1 Curt. 279; Gilbert & Barker Manuf. Co. *v.* Bussing, 12 Blatch. 426; Howe *v.* Morton, 1 Fish. 586; Jones *v.* Merrill, 8 O. G. 401; Furbush *v.* Bradford, 1 Fish. 317; S. C. 21 Law Rep. 471; U. S. Annunciator Co. *v.* Sanderson, 3 Blatch. 184; Stainthorp *v.* Humiston, 2 Fish. 311; Goodyear *v.* Hills, 3 Fish. 134; American Pavement Co. *v.* Elizabeth, 4 Fish. 189; Goodyear *v.* Honsinger, 3 Fish. 147; S. C. 2 Biss. 1; Sykes *v.* Manhattan Co. 6 Blatch. 496.

If the court refuses a provisional injunction upon condition that the defendant file with the clerk a monthly account of all articles manufactured and sold by him, an account giving such a description of the articles as is sufficient to enable persons in the trade to determine the value or price of them in the market, is a compliance with the order, although the prices and the names of the purchasers are not stated. Wilder *v.* Gaylor, 1 Blatch. 511.

The court may refuse an injunction if the defendant will pay a reasonable license fee to the complainant and accept a license. Hodge *v.* Hudson River R. R. Co. 6 Blatch. 165.

If the defendant's machine contains a valuable improvement which is not contained in the patent, the court may provide that if the defendant will file a bond to account for the profits, an injunction shall not issue. Stainthorp *v.* Humiston, 2 Fish. 311.

A provisional injunction is always refused if upon the facts presented there is a fair doubt whether the defendant has infringed. Dodge *v.* Card, 2 Fish. 116; s. c. 1 Bond, 393.

If the defendant shows a belief that he has a just defense, and is not a willful pirate of the patentee's invention, it should be a case of evident mistake of law or fact, or both, in the defense which he sets up which will justify the court in granting an injunction. Goodyear *v.* Dunbar, 1 Fish. 472; s. c. 3 Wall. Jr. 310; Batten *v.* Silliman, 3 Wall. Jr. 124.

It is not enough to authorize the granting of an injunction that the complainant has taken out a patent, and thus obtained a public grant and the sanction or opinion of the patent office in favor of his right. There must be something stronger than the mere issue, for in that there is no opposing party, no notice and no trial with any one of his rights. Orr *v.* Littlefield, 1 W. & M. 13; Tappan *v.* Nat'l Bank Note Co. 2 Fish. 195; s. c. 4 Blatch. 509; Grover & Baker S. Co. *v.* Williams, 2 Fish. 133.

If the complainant's invention is merely an improvement upon a prior patent, the fact that he is infringing such prior patent can not affect the motion for an injunction. The case of each patentee must be treated separately on its merits when presented. Young *v.* Lippman, 5 Fish. 230; s. c. 9 Blatch. 277; s. c. 2 O. G. 249.

If a party who has been using a machine sells his interest prior to the filing of the bill, an injunction will not be granted against him. Brammer *v.* Jones, 3 Fish. 340; s. c. 2 Bond, 100.

A writ of injunction is to act as a remedy against a threatened wrong by preventing the commission of such wrong, and it is not necessary before a writ to prevent a wrong can issue that the wrong should actually have been committed. If it were, the remedy by injunction would be a very inadequate one. If the rights of a party under a patent have been fully and clearly established, and an infringement of such rights is threatened; or if, when they have been infringed, the party has good reason to believe they will continue to be infringed, an injunction will issue. Poppenhusen *v.* Gutta Percha Co. 2 Fish. 74; s. c. 4 Blatch. 184.

No interlocutory injunction should issue, unless the complainant's title and the defendant's infringement are admitted, or are so palpable and clear that the court can entertain no doubt on the subject. The court is not bound, in

this stage of the cause, to decide doubtful and difficult questions of law, or disputed questions of fact, nor exercise this high and dangerous power in doubtful cases, before the alleged offender has an opportunity of a full and fair hearing. Parker *v.* Sears, 1 Fish. 93; Sickels *v.* Youngs, 3 Blatch. 293; Jones *v.* Osgood, 3 Fish. 591; S. C. 6 Blatch. 435; Grover & Baker S. Co. *v.* Williams, 2 Fish. 133; American Pavement Co. *v.* Elizabeth, 4 Fish. 189.

Cases often occur where the answer or affidavits are equivocal or evasive, or disclose a state of facts which show that the conclusions drawn from them are clearly erroneous and founded on a mistake of the law, as when an infringement is denied and a model admitted which shows a palpable infringement, and it is evident that the denial is made under a gross mistake of the true and settled construction of the patent, or where the originality of the invention is denied in general terms, and infringement is admitted, and the patent has been fully established at law, and it is evident that the denial of its validity is but a matter of obstinate opinion, or a mistake of law. Such cases, and only such, can be considered as exceptions to the general rule. Parker *v.* Sears, 1 Fish. 93.

If the defendant admits the infringement, but asserts that after notice or service of the injunction he refrained from the use of the thing patented, and asserts that he will not afterwards infringe, it is no reason why an injunction should not issue and be made perpetual. The complainant, in such a case, is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrong-doer the law supposes the probability of his being so again, and will impose the proper restraint to prevent the repetition of the wrongful act. Jenkins *v.* Greenwald, 2 Fish. 37; S. C. 1 Bond, 126; Potter *v.* Crowell, 3 Fish. 112; S. C. 1 Abb. U. S. 89; Goodyear *v.* Berry, 3 Fish. 439; S. C. 2 Bond, 1; Rumford Chemical Works *v.* Vice, 11 O. G. 600.

The usual practice is to postpone the consideration of difficult or doubtful points till the final hearing of the cause, and not to decide the whole merits of a cause on a mere preliminary motion. Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356; Hovey *v.* Stevens, 1 W. & M. 290; Jones *v.* Hodges, 1 Holmes, 37; Livingston *v.* Van Ingen, 1 Paine, 45; S. C. 4 Am. L. J 56; Winans *v.* Eaton, 1 Fish. 181; Smith *v.* Selden, 1 Blatch. 475; Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

When the objection relates to the technical form or signature of papers connected with the letters patent, and the doubts arise from acts of public officers, and not any neglect or wrong of the patentee, the injunction should not be dissolved. More especially should an injunction once granted not be disturbed for such doubts, when the term for trial of the merits is near. Woodworth *v.* Hall, 1 W. & M. 389.

To warrant the exercise of the extraordinary power of the court in granting a preliminary injunction, the case presented should be free from ambiguity or confusion. Especially should this rule be applied to a case where the alleged infringement is in the disputed territory that lies between the limits fixed by the original patent and those fixed by the reissued patent, for whatever of difficulty or uncertainty there may be arising out of the difference between the two specifications, is the fault or misfortune of the patentee, and not of

the respondent, and should be borne by the former, and not the latter. Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493.

The existence of a substantial doubt as to the question of identity of the inventions described in a reissued patent and the original, is a proper ground for refusing to grant a preliminary injunction. Poppenhusen *v.* Falke, 2 Fish. 181; S. C. 4 Blatch. 493; Grover & Baker S. Co. *v.* Williams, 2 Fish. 133.

A mere denial by an answer of the equity of the bill, does not prevent the court from looking into the law and the facts of the case when a special injunction is moved for, and granting or refusing it according to its discretion. Where the title to an injunction does not depend upon any controverted or doubtful facts, but upon the interpretation to be put by the court upon a written instrument, the court should interpret it on such motion, and grant or refuse the injunction according to the result of that interpretation. There may be cases in which there is so much doubt what the parties to the instrument intended to effect by it, that the court may think it proper to suspend its judgment until the surrounding circumstances can be more fully and safely examined on a final hearing. It is possible, also, that where there are grave doubts concerning the legal effect of an instrument, the court might decline to interfere by special injunction, even though, if compelled to decide, their decision must be in favor of the complainant. Probably the circumstances of the case, and the degree of mischief which would be suffered by refusing the injunction, compared with the inconvenience and loss occasioned by granting it, would control the action of the court in the case supposed. But in general, if the title to a temporary injunction depends on the construction of a deed, the court will construe it and act accordingly, whatever view of that question the answer may have presented. Clum *v.* Brewer, 2 Curt. 506; Goodyear *v.* Central R. R. Co. 1 Fish. 626; S. C. 2 Wall. Jr. 356; Hodge *v.* Hudson River R. R. Co. 6 Blatch. 165.

To authorize a provisional injunction it is not necessary that all the grants of right to the patentee shall have been infringed. All that is required is that some of them should have been so infringed. Potter *v.* Holland, 1 Fish. 382; S. C. 4 Blatch. 206.

A temporary injunction may be granted restraining the defendant from using the invention covered by some of the claims in the patent, and the question as to the others postponed until the case comes up for hearing upon the pleadings and proofs. Colt *v.* Young, 2 Blatch. 471.

It is doubtful whether a misjoinder of parties as plaintiffs can defeat a prayer for a preliminary injunction not to use an invention in which any of them are interested. Such a misjoinder can not probably be objected to at all in equity, though in the final judgment it will be entered up in favor of those alone who appear to have some right and interest to be protected. Woodworth *v.* Hall, 1 W. & M. 248, 389.

Though technical objections are to be weighed and examined and allowed to prevail if legal, yet they ought to be treated with no particular indulgence. In all inquiries in equity, the leaning in doubtful points must certainly be rather against than in favor of them, and more especially must it be so in preliminary injunctions where the decision is only temporary, and may be dissolved on motion at any time on showing fuller proof as to anything affecting the merits of the controversy. Woodworth *v.* Hall, 1 W. & M. 248, 389.

If the defendant's patent was granted after a full hearing before the patent office, on testimony taken on an interference declared between the application for such patent and the complainant's patent, a preliminary injunction will be denied. Asbestos Felting Co. *v.* U. S. & F. Felting Co. 13 Blatch. 453; S. C. 10 O. G. 828.

If the defendant resides out of the district and carries on the business there, in the course of which he committed the alleged infringement, the injunction may be refused. Goodyear *v.* Chaffee, 3 Blatch. 268; Jones *v.* Osgood, 3 Fish. 591; S. C. 6 Blatch. 435; *vide* Thompson *v.* Mendelsohn, 5 Fish. 187; S. C. 8 Phila. 166.

The mere fact that several parties interested in a patent, have made a common fund for the purpose of protecting their common rights by prosecuting infringers, is no ground for refusing an injunction. Potter *v.* Fuller, 2 Fish. 251.

A preliminary injunction can not be resorted to for the purpose of obtaining a contract, although the bid of the defendant is the lowest. American Pavement Co. *v.* Elizabeth, 4 Fish. 189.

An injunction is a proper remedy, because the supposed offense being constantly repeated, the causes of action and the multiplicity of suits would probably become much extended, and the relief at law prove very defective It is useful as a bill of peace. Orr *v.* Littlefield, 1 W. & M. 13.

If there appears from the affidavits such a repugnancy in point of fact as makes it necessary to decide on the relative truth of their conflicting statements or the credibility of the witnesses, no prudent judge will undertake so dangerous an inquiry in the first stage of the cause. The great object is to look for that full information which will lead his mind to a certainty as to all material facts, for doubt or uncertainty is fatal to the motion. Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

In applying for an injunction, the patentee seeks either to interrupt the course of the common law, or to obtain some relief which he can not have at law. He must consequently state and make out a case for equitable relief, on such facts as bring his case within the jurisdiction of courts of equity, and proper for its exercise. Hence, if he fails to satisfy the conscience of the chancellor affirmatively, he has no case before him, for the doubt or uncertainty as to facts is of the same effect on a motion, as their non-existence. Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; American Pavement Co. *v.* Elizabeth, 4 Fish. 189; Fales *v.* Wentworth, 5 Fish. 302; S. C. 1 Holmes, 96; 2 O. G. 58; Gutta Percha Co. *v.* Goodyear Rubber Co. 3 Saw. 542.

Where a subsequent patent set up by the defendant, contains in itself satisfactory evidence on its face, when read by experts, that its process involves an infringement of a prior patent, a provisional injunction will be granted. Goodyear Dental Co. *v.* Evans, 3 Fish. 390; S. C. 6 Blatch. 121.

If the patentee is able and willing to supply the market, an injunction will be granted, although the defendant is willing to accept a license. Baldwin *v.* Bernard, 5 Fish. 75; S. C. 9 Blatch. 494; 2 O. G. 315.

The remedy by injunction in patent cases is given by courts of equity, on account of the insufficiency of that given by a court of law. It is in its

nature preventive, where irreparable mischiefs are apprehended, or when the patentee is likely to be vexed with a multiplicity of suits. Battin *v.* Silliman, 3 Wall. Jr. 124.

If the proof is insufficient, an injunction may be withheld until the complainant satisfactorily establishes the acquiescence of the public, and explains any apparent laches on his part. Sykes *v.* Manhattan Co. 6 Blatch. 496.

If the questions to be decided are difficult and complicated, especially if they involve disputed facts which have never been passed on by a court or jury, then, although the court may be inclined to think the complainant is right, yet it will not interfere, whether the questions relate to title or infringement. There is, therefore, always an element of discretion entering into the consideration of this question, and all that a complainant is entitled to is the best judgment of the court upon a question of judicial discretion, and not absolutely to an injunction on any given state of facts. Potter *v.* Whitney, 3 Fish. 77; S. C. 1 Lowell, 87; Jones *v.* Osgood, 3 Fish. 591; S. C. 6 Blatch. 435; Beane *v.* Orr, 9 O. G. 255; Tilghman *v.* Hartwell, 1 W. N. 52; Day *v.* Candee, 3 Fish. 9; Goodyear *v.* Hills, 3 Fish. 134; Wells *v.* Jacques, 5 Fish. 136.

If the patentee has stood by for many years without complaint or demand of compensation, this is conclusive proof that a continuance of a use of his invention for a few weeks or even months longer, if paid for in the end, will not be an injury of such an irreparable nature as to require the sharp and hasty remedy of an injunction. Parker *v.* Sears, 1 Fish. 93; Jones *v.* Merrill, 8 O. G. 401; Cooper *v.* Mattheys, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; North *v.* Kershaw, 4 Blatch. 70; Whitney *v.* Rollstone Machine Works, 8 O. G. 908; Goodyear *v.* Honsinger, 3 Fish. 147; S. C. 2 Biss. 1; Morris *v.* Lowell Manuf. Co. 8 Fish. 67.

The laches of the complainant in permitting the defendant, with his knowledge, to use the patented article, is ground for refusing a preliminary injunction. Hockholzer *v.* Eager, 2 Saw. 361; Sloat *v.* Plympton, 2 Whart. Dig. 365.

A patentee can not be charged with acquiescence, because he proceeded first against that which was a more palpable and obvious violation of his right, or because he did not bring suit against all the machines which infringed upon it. Van Hook *v.* Pendleton, 1 Blatch. 187.

A delay of three months after the discovery of the infringement before filing a bill, is no ground for refusing an injunction where the defendant has not been induced to change his position. Union Paper Bag Co. *v.* Binner, 5 Fish. 166.

If the complainant has acquiesced in the manufacture of the thing patented by the defendant, with an understanding that the compensation should ultimately be fixed by agreement, and the defendant is ready to pay such compensation as the court may allow, the defendant will be permitted to complete his existing contracts. Smith *v.* Sharp's Rifle Co. 3 Blatch. 545.

The fact that the patent is about to expire, is no ground for refusing a preliminary injunction, if the patentee has been involved in continuous litigation. Rumford Chemical Works *v.* Vice, 11 O. G. 600.

An irregularity in the service of the subpœna is no reason for withholding

an injunction against a defendant who has notice of the motion and appears to oppose it. Thayer *v.* Wales, 5 Fish. 130; S. C. 9 Blatch. 170.

If notes are received as the consideration for a license, with a stipulation that if they or either of them are not paid as they fall due, then the license shall be void, the license is forfeited the moment one of the notes becomes due and is not paid, and it is optional with the patentee to resort to his remedy at common law to enforce the collection of the notes or to treat the right of the licensee as forfeited under the stipulation, and obtain an injunction against the licensee. Woodworth *v.* Weed, 1 Blatch. 165.

The fact that the complainant grants licenses at a fixed sum, and that the defendant is not a maker and vendor, but only one who uses the machine, is a circumstance to be taken into account, but is not a sufficient reason for refusing the writ, excepting in combination with other circumstances, either of doubt as to title or of hardship in the operation of the injunction. Howe *v.* Newton, 2 Fish. 531; Furbush *v.* Bradford, 1 Fish. 317; S. C. 21 Law Rep. 471; Goodyear *v.* Schenck, 3 Fish. 82; Morris *v.* Lowell Manuf. Co. 3 Fish. 67; *vide* Livingston *v.* Jones, 2 Fish. 207; S. C. 3 Wall. Jr. 330; Batten *v.* *v.* Silliman, 3 Wall. Jr. 124.

When a license is granted to any one to use a patent, which license is accompanied with an obligation in favor of the patentee, on the part of the one to whom it is granted, to do or not to do a particular thing, and which obligation is the consideration upon which the license is granted, he upon whom the obligation rests must perform it, and if he will not perform it an injunction will be granted to restrain him from any further right to use the patent under the license. Goodyear *v.* Congress Rubber Co. 3 Blatch. 449.

Dissolution of Injunction.

The filing of an answer denying under oath the legal title of the complainant, is not sufficient to dissolve an injunction already specially granted on a hearing. The presumptions arising from the answer may be disproved by evidence on the part of the complainant, and then counter testimony is admissible on the part of the respondent to sustain his answer. After this it becomes the duty of the court to balance these allegations and proofs, and decide how the weight of them is, and whether in the exercise of a sound discretion on them, the injunction ought to be dissolved or not. Woodworth *v.* Rogers, 3 W. & M. 135; Orr *v.* Merrill, 1 W. & M. 376.

If the defendant on a motion to dissolve an injunction produces evidence on matters not involved in the original motion for an injunction sufficient to throw a doubt over the question of the novelty of the invention, the injunction will be dissolved. Young *v.* Lippman, 5 Fish. 230; S. C. 9 Blatch. 277; 2 O. G. 249.

The motion to dissolve an injunction must be denied unless the proofs overcome the equity of the bill and the evidence supporting it. Sparkman *v.* Higgins, 1 Blatch. 205.

The presumption is that an injunction which was granted after a hearing was rightly issued. The burden is on the defendant on a motion for a dissolution to overcome that presumption. It is open to be overcome by new mat-

ter or evidence arising since the injunction was imposed, though very seldom by matter then existing which the party neglected to present to the consideration of the court. Woodworth *v.* Rogers, 3 W. & M. 135; Hussey *v.* Whiteley, 2 Fish. 120; S. C. 1 Bond, 407.

If the issue and facts involved in a motion for a dissolution before the district judge are substantially those submitted to and passed upon by the circuit judge in granting the injunction, it will be improper to order its dissolution. It would be wrong in a district judge to review or set aside the action of the circuit judge—at least the reasons that would justify such a course must be peculiar and stringent. Hussey *v.* Whiteley, 2 Fish. 120; S. C. 1 Bond, 407.

If the answer does not properly set up a public use for more than two years before the application for the patent, and the time for taking proofs for final hearing has expired, an application to dissolve a preliminary injunction on account of such prior use will not be entertained. Union Paper Bag Co. *v.* Newell, 11 Blatch. 549; S. C. 5 O. G. 173.

If the complainant during the pendency of the suit assigns all his interest in the patent to another, the injunction must be dissolved. Kinsman *v.* Parkhurst, 1 Blatch. 489; S. C. 18 How. 289.

An injunction already granted may be dissolved upon the defendant's filing a bond to secure the payment of such sum as may be awarded by the final decree. Wilson *v.* Barnum, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

The court may direct that an injunction shall be dissolved unless the complainant shall file a bond to indemnify the defendant. Wilson *v.* Barnum, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

Final Injunction.

An injunction is either provisional or perpetual. The first is either common or special,—common being such as is granted upon the defendant's default, either in appearing or answering, and is only applicable to restrain proceedings at law, and special being such as is granted upon the special grounds arising out of the circumstances of the case. Special injunctions are issued sometimes on the merits disclosed by the answer, sometimes on affidavits before the answer is filed, and sometimes even without notice and before the defendant has appeared. A perpetual injunction is a part of the decree made at the hearing upon the merits, whereby the defendant is perpetually inhibited from the assertion of a right, or perpetually restrained from the commission of an act which would be contrary to equity and good conscience. Motte *v.* Bennett, 2 Fish. 642.

The provisions of this section in no manner import that the foundation of the jurisdiction of the court rests on its authority to grant an injunction. On the contrary the language employed would seem to indicate that Congress for greater caution made the power to grant injunctions explicit and positive, perhaps to avoid an inference that the process of injunction being merely a mode of relief in equity, could only issue in cases which under the general practice of courts of equity were brought up specifically by injunction bills. Nevins *v.* Johnson, 3 Blatch. 80.

If the court has jurisdiction of the person of the defendant it may restrain

him, although the construction and use of the thing patented take place beyond the jurisdiction of the court. Boyd *v.* McAlpin, 3 McLean, 427; Wilson *v.* Sherman, 1 Blatch. 536; Thompson *v.* Mendelsohn, 5 Fish. 187; S. C. 8 Phila. 166; Wheeler *v.* McCormick, 4 Fish. 433; S. C. 8 Blatch. 267.

No injunction can be issued at the instance of a patentee to restrain a junior patentee from bringing suits on his patent before the patent is declared invalid. Asbestos Felting Co. *v.* U. S. & F. Felting Co. 13 Blatch. 453; S. C. 10 O. G. 828.

The circuit court has no jurisdiction to restrain the complainant from prosecuting other suits against parties who purchased the thing patented from the defendant, although a decree has been entered requiring the defendant to account for profits arising from the sales thereof. Rumford Chemical Works *v.* Hecker, 11 Blatch. 532; S. C. 5 O. G. 644.

An injunction may be granted at the final hearing, although there has been no trial at law or motion for a preliminary injunction. Buchanan *v.* Howland, 2 Fish. 341; S. C. 5 Blatch. 151; Doughty *v.* West, 2 Fish. 553; Motte *v.* Bennett, 2 Fish. 642; Hoffheins *v.* Brandt, 3 Fish. 218.

There is no adequate remedy at law, for the law does not give a complete remedy to those whose property is invaded. If each infringement were to be made a distinct cause of action, the remedy would be worse than the evil, for the inventor might be ruined by the necessity of perpetual litigation without ever being able to have a final establishment of his right. In addition to this consideration, the patentee could have no preventive at law to restrain the future use of his invention injuriously to his title and interests. Motte *v.* Bennett, 2 Fish. 642.

The granting or refusal of an injunction rests in the sound discretion of the court. A rash or indiscreet exercise of this power may be very oppressive, of no use to the complainant and ruinous to the defendant. As a remedy it should be administered only for prevention or protection. Where it is not necessary for these purposes it is merely vindictive, injuring one party without benefit to the other. To issue an injunction in a case where neither prevention nor protection is sought or required, but only compensation, would be an abuse of power. Sanders *v.* Logan, 2 Fish. 167.

If the complainant has accepted a certain compensation for the use of the thing patented, reserving his right to an additional sum, an injunction will not be granted, for the use is not unlawful. Blanchard *v.* Sprague, 1 Cliff. 288.

Where the complainant makes an assignment after the granting of an injunction, and then files an amended bill, the defendant, after answering the amended bill without taking exception on account of the assignment, can not have the injunction dissolved on that ground. T. & P. Salt Co. *v.* Barry, 2 W. N. 100.

If the patentee assigns his patent while the bill is pending, an injunction will not be granted. Boomer *v.* Power Co. 13 Blatch. 107; Wheeler *v.* McCormick, 6 Fish. 551; S. C. 11 Blatch. 334; 4 O. G. 692.

If it appears that an improvement is not materially useful, and has only been used to a limited extent, an injunction is not the appropriate remedy. Lowell Manuf. Co. *v.* Carpet Co. 2 Fish. 472.

When a party obtains a decree settling the right to an injunction in respect

to the matter in controversy, the practice is to make the injunction a part of the decree. That is the right of the party, unless some special grounds of hardship to the defendant are shown. Potter *v.* Mack, 3 Fish. 428; Rumford Chemical Works *v.* Hecker, 11 O. G. 330.

The court has the power to suspend the injunction until the account shall be determined upon and the decree finally made upon that account. Such power exists as incidental to equity proceedings. Potter *v.* Mack, 3 Fish. 428.

If a reasonable doubt exists in the mind of the court as to its decision upon the merits, or if there is any reason to suppose that the injunction has been indiscreetly granted, the defendant may be allowed to continue to use his machine under proper security until the coming in of the master's report, but if the court is fully satisfied with its decision, such permission will not be granted. Mowry *v.* Whitney, 3 Fish. 157; S. C. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; Barnard *v.* Gibson, 7 How. 650.

If the complainant brings money into court in compliance with the terms imposed upon him by the court, as a condition for granting an injunction to restrain the defendant from declaring a forfeiture of the license, the defendant thereby acquires an equitable lien upon the fund, and in case the bill is dismissed for want of jurisdiction, the court will make no order disposing of the money until the right between the parties is determined in some appropriate proceeding either at law or in equity. Florence Machine Co. *v.* Singer Co. 4 Fish. 348; S. C. 8 Blatch. 177.

Practice.

An allegation of abandonment is an allegation in avoidance of the claim of the complainant, and the facts therein stated must be proved, and the burden of proof is upon the respondent. Howe *v.* Williams, 2 Fish. 395; S. C. 2 Cliff. 245.

The burden of proof rests upon the defendant to sustain averments in the answer, which are not responsive to the allegations of the bill. Hoffheins *v.* Brandt, 3 Fish. 218.

Something more must be produced than the evidence of a single witness, to overcome an answer under oath and responsive to the bill. Woodworth *v.* Hall, 1 W. & M. 248, 389; Hovey *v.* Stevens, 1 W. & M. 290.

If the denial of the infringement in the answer is not positive, and the testimony of the witness is strongly corroborated by other facts and circumstances bearing on the question of infringement, the fact will be considered as established. Goodyear *v.* Berry, 3 Fish. 439; S. C. 1 Bond, 189.

A verdict upon any fact in an action at law, and judgment thereon, concludes the parties thereto in any subsequent action. Jacques *v.* Wells, 5 O. G. 364.

If the record of an action at law does not disclose the nature of the infringement for which the judgment was entered, it will not, without extrinsic evidence, estop the defendant from denying the novelty or validity of the patent. Russell *v.* Place, 13 Pac. L. R. 147.

Documents can not be given in evidence after the argument of the case has commenced, as a matter of right, but only on terms to be imposed by the court. Stainthorp et al. *v.* Humiston, 4 Fish. 107.

If objection is properly made to the testimony of a witness who is not produced until all the evidence on both sides is closed, his testimony can not be considered, although his name was mentioned in the notice. Crouch *v.* Speer, 6 O. G. 187.

If the complainant, on the production of a witness before the examiner, fails to object to his being sworn on the ground of lack of notice, this is a waiver of the want of notice. Roemer *v.* Simon, 5 O. G. 555; Crouch *v.* Speer, 6 O. G 187.

If it appears that the complainant has a meritorious cause of action upon the merits, it is competent for the court to allow additional proofs to obviate merely formal objections. Goodyear *v.* Beverly Rubber Co. 1 Cliff. 348.

An appearance and the filing of an answer is a waiver of any irregularity in the service of a subpœna. Goodyear *v.* Chaffee, 3 Blatch 268.

An assignment of the complainant's interest in the patent after the commencement of the suit, will not affect his right to an account for the profits that accrued prior to the assignment. Dean *v.* Mason, 20 How. 198.

Exceptions to the general rule in the English chancery, are binding on the federal courts, as much as the rule itself. The exception constitutes the rule. Brooks *v.* Bicknell, 3 McLean, 250.

The rule of comity always observed by the justices of the supreme court in cases which admit of being carried before the whole court, is to conform to the opinions of each other, if any have been given. Washburn *v.* Gould, 3 Story, 122; Putnam *v.* Yerringer, 9 O. G. 689; Goodyear *v.* Providence Rubber Co. 2 Fish. 499; s. c. 2 Cliff. 351; 9 Wall. 788; Rumford Chemical Works *v.* Hecker, 10 O. G. 289; G. D. V. Co. *v.* Willis, 7 O. G. 41.

This rule of comity has no application, either by its terms or the reason on which it is founded, to motions for injunctions where error may be followed by irremediable mischief. Many *v.* Sizer, 1 Fish. 31; Cornell *v.* Littlejohn, 9 O. G. 837, 932; Potter *v.* Whitney, 3 Fish. 77; s. c. 1 Lowell, 87; Sargent Manuf. Co. *v.* Woodruff, 5 Biss. 444.

If the defendant desires to test the prior adjudication in the supreme court, and the complainant refuses to stipulate that the proofs taken in another case may be filed in the one pending, the rule will not be followed in granting a preliminary injunction. G. D. V. Co. *v.* Willis, 7 O. G. 41.

If the record presents a different state of facts, the decision in another circuit will not be followed. G. & B. Manuf. Co. *v.* Walworth, 9 O. G. 746.

If the court, as a matter of comity, declines to adjudge the question of novelty on certain claims, in view of the adjudication of a co-ordinate court, the decree should so state. Rumford Chemical Works *v.* Hecker, 11 O. G. 330.

A decision not upon pleadings and proofs, but a decision or opinion on a motion for an injunction, can be hardly claimed to settle a question. Florence Co. *v.* Singer Co. 4 Fish. 329; s. c. 8 Blatch. 113.

The circuit court has no authority to rescind a rule adopted by the supreme court for the government of its practice in chancery. Jenkins *v.* Greenwald, 2 Fish. 37; s. c. 1 Bond, 126.

The examination of the defendant as a witness by the complainant, is not

a waiver of the right to a decree against him. Jenkins *v.* Greenwald, 2 Fish. 37; S. C. 1 Bond, 126.

A party who purchases from the defendant *pendente lite*, and with actual notice of the suit, is bound by the same equities as the defendant. Kinsman *v.* Parkhurst, 18 How. 289; S. C. 1 Blatch. 488.

Under the prayer for general relief, the court may award damages to the complainant. Emerson *v.* Simm, 6 Fish. 281; S. C. 3 O. G. 293.

If a complainant files a bill for an alleged infringement which took place after the filing of the first bill, he will not be compelled to elect between the two proceedings, but on the motion of the defendant, he may be required to enter into a stipulation that the testimony taken in one case, so far as it is relevant, may be used in the other, and that both cases shall be set down for hearing at the same time. Turrell *v.* Spaeth, 9 O. G. 1163.

The court will not so far take notice of parol agreements of counsel made or alleged to be made out of court, as to undertake, when there is a conflict of opinion between the respective counsel as to the terms of the agreement or a difference of recollection as to its existence or meaning, to decide the question of comparative accuracy of recollection or construction. American Saddle Co. *v.* Hogg, 6 Fish. 67; S. C. 1 Holmes, 177; 2 O. G. 595.

A decree establishing the validity of the patent, is conclusive between a party claiming under the complainant and the defendant, together with a party who became his partner after the entry of the decree. Dayton *v.* Wright, 11 O. G. 197.

A decree for an account is interlocutory and not conclusive. Rumford Chemical Works *v.* Hecker, 10 O. G. 289; *contra*, Dayton *v.* Wright, 11 O. G. 197.

If the complainant threatens to institute an action against parties who have purchased from the defendant, the court, on a cross-petition, may enjoin the complainant from bringing any suit against any vendee of the defendant, based upon a user which may become the subject of account in the case. Birdsell *v.* Hagerstown Co. 11 O. G. 641.

The mere entry of an interlocutory decree for an account, will not bar an action against a party who purchased *from* the defendant. Gilbert & Barker Manuf. Co. *v.* Bussing, 12 Blatch. 426.

A patentee can not take compensation for an infringement, including manufacture, sale and use, and thereafter enjoin a purchaser from the use for which he has taken compensation. Gilbert & Barker Manuf. Co. *v.* Bussing, 12 Blatch. 426; S. C. 6 O. G. 144.

Interlocutory decrees are subject to a revision until a final decree is made. Magic Ruffle Co. *v.* Elm City Co. 21 O. G. 501.

The equitable liability of an infringer is not determined by his death, and a bill of revivor against his personal representatives will lie to prevent the abatement of the suit brought in his lifetime to enforce it. Smith *v.* Baker, 5 O. G. 496; S. C. 31 Leg. Int. 126; 21 Pitts. L. J. 145; 19 I. R. R. 149.

Before a decree the inquiry is as to the fact of infringement. The extent of the infringement arises upon a reference for an account after a decree. Turrell *v.* Spaeth, 8 O. G. 986.

License.

Even if a contract to refrain from the manufacture of a patented article can not be enforced as being against public policy, this will afford no answer to a claim for an account of profits actually realized by prosecuting the business, there being no connection between the illegal stipulation and the profits of the business. Kinsman *v.* Parkhurst, 18 How. 289; S. C. 1 Blatch. 488.

The purchase of a license does not estop the licensee from denying the validity of the patent in order to protect his right to use a machine not embraced by the license. The recitals in a deed can estop no one but parties or privies who are claiming under or against it, and in a controversy founded on its covenants. If such machine should be challenged as an infringement of the patent, he has the right to defend himself by any plea that any other person might use. Burr *v.* Duryee, 2 Fish. 275; S. C. 1 Wall. 531.

Where a contract has been violated in its essential terms, or has been made impossible of execution, equity will relieve if it can do so without prejudice, but it never enforces anything in the nature of a forfeiture, whether stipulated in the contract or implied from circumstances. Morse *v.* O'Reilly, 6 Penn. L. J. 501.

Equity may relieve against a forfeiture; it never inflicts one. If the licensee infringes the patent without violating his contract, an injunction will not be granted restraining him from all use of the patent. Burr *v.* Duryee, 2 Fish. 275; S C. 1 Wall. 531; Wilson *v.* Sherman, 1 Blatch. 536.

If a licensee fails to comply with the condition on which the license depends, he may be enjoined as an infringer. Woodworth *v.* Cook, 2 Blatch. 151; Wilson *v.* Sherman, 1 Blatch. 536; Day *v.* Hartshorn, 3 Fish. 32; *contra*, Morse *v.* O'Reilly, 6 Penn. L. J. 501.

An infringement by a licensee who fails to perform the conditions of his license is different from an ordinary infringement where no contract has been made by the parties. In the latter case an absolute injunction is the only adequate relief; but in the former, if the use goes beyond the conditions, there is an infringement which must stand upon the general ground unaffected by the contract, and as to such use the injunction should be absolute. If the defendant has failed to comply with the conditions of the license, an injunction will be granted unless he conforms to them. A court of chancery will not decree the cancellation of a contract, except for fraud or mistake, or grant an injunction which will have that effect. Brooks *v.* Stolley, 3 McLean, 523.

An unpaid royalty due from the licensee to the patentee affords no ground for enjoining an assignee of the license who has paid the royalty that has accrued since the assignment. Goodyear *v.* Congress Rubber Co. 3 Blatch. 449.

The recovery of a judgment for the arrears of royalty does not preclude the patentee from enforcing the forfeiture of the license for non-payment, for he may resort to either or both remedies. Armstrong *v.* Hanlenbeck, 3 N. Y. Leg. Obs. 43.

If a party repudiates a license for the purpose of contesting the validity of the patent, he can not set it up again when the patent is sustained. Moody *v.* Taber, 1 Holmes, 325; S. C. 5 O. G. 273.

If the defendant is dissatisfied with the terms of a license, he should abandon it; but if he claims rights under it, he must conform to the conditions on which it was granted, even though he avers that he did not understand it and was overreached. Brooks *v.* Stolley, 3 McLean, 523.

A grant of an exclusive license to sell is to be enforced against the grantor so long as it lasts, whether the remainder of the contract is mutual or not, providing the whole contract including the grant is not so unequal as to be void in a court of equity. Singer Manuf. Co. *v.* Union B. & E. Co. 6 Fish. 480; S. C. 1 Holmes, 253; 4 O. G. 553.

If a patentee sells the thing patented in violation of the rights of a licensee, the latter may maintain a bill in equity against the purchaser and the patentee where the circuit court has jurisdiction on account of the residence of the parties, for the remedy at law is not as practical and efficient to the ends of justice and its prompt administration as the equitable remedy. Hill *v.* Whitcomb, 1 Holmes, 317; S. C. 5 O. G. 430.

A licensee can not maintain a bill for an injunction and account against a patentee and a party who purchased a machine from him in violation of the license, for the purchaser is not an infringer. Hill *v.* Whitcomb, 1 Holmes, 317; S. C. 5 O. G. 430.

A party can not secretly acquire the outstanding right of another, if any, and set it up against his joint owner in derogation of his rights under an agreement entered into with knowledge of this alleged title. Kinsman *v.* Parkhurst, 18 How. 289; S. C. 1 Blatch. 488.

Attachment.

On a motion for an attachment affidavits to show that the patentee was not the first and original inventor of the thing patented are immaterial and irrelevant. That question was settled, so far as the injunction is concerned, when the writ was granted. Whipple *v.* Hutchinson, 4 Blatch. 190; Woodworth *v.* Rogers, 3 W. & M. 135; Liddle *v.* Cory, 7 Blatch. 1.

On a motion for an attachment the decree must be deemed conclusive of all questions fairly involved in the suit, and until it be set aside as determining beyond dispute the validity of the patent, and that the acts complained of in the suit were an infringement. Liddle *v.* Cory, 7 Blatch. 1; Woodworth *v.* Rogers, 3 W. & M. 135.

If the instrument is not of the same kind as that involved in the decree, and is covered by a patent, a strong and obvious case of infringement beyond all question of mere colorable difference is necessary in order to render the party liable for contempt. Buerk *v.* Imhauser, 11 O. G. 112.

It is not enough to arrest a summary exercise of the power of the court that the proofs of the violation of the decree are conflicting, or that the thing used by the respondent is in some of its features different from the thing whose use is interdicted. The evidence must be carefully weighed, and as it establishes clearly or falls short of establishing a substantial transgression, it is the duty of the court to act or forbear to act accordingly. Wetherill *v.* Zinc Co. 5 O. G. 460.

No attachment will be issued unless the violation of the injunction is plain

and proved to the satisfaction of the court. Birdsell *v.* Hagerstown Manuf. Co. 11 O. G. 420; s. c. 4 Cent. L. J. 211.

In a proceeding for an attachment for a violation of an injunction, the service of the writ claimed to have been disregarded should not be left in doubt. Whipple *v.* Hutchinson, 4 Blatch. 190.

The writ, as a general rule, ought to contain a concise description of the particular acts or things in respect to which the party is enjoined, so that there may be no misapprehension on the subject. Whipple *v.* Hutchinson, 4 Blatch. 190; Goodyear *v.* Muller, 3 Fish. 209; s. c. 5 Blatch. 429.

Where an injunction is issued restraining a party from using any part of a machine, he should take the judgment of the court, whether he can leave off certain parts and use the rest, and not take it for granted that he will not thus violate the injunction. The true course is to move for a dissolution of the injunction, or ask for security from the complainant. Hamilton *v.* Simons, 5 Biss. 77.

A party who has been enjoined from infringing a patent can not work in the factory of another where the thing patented is an infringement. Goodyear *v.* Muller, 3 Fish. 209; s. c. 5 Blatch. 429.

A party who has been enjoined from infringing a patent can not sell the thing patented as agent of another party. Potter *v.* Muller, 1 Bond, 601.

The defendant, after the issuing of an injunction, may manufacture articles which do not infringe the patent. Wire Railing Co. *v.* Walker, 2 Fish. 179; Byam *v.* Eddy, 24 Vt. 666.

If the differences between the thing patented and the article made by the defendant are not merely colorable, but raise questions not before raised between the parties, the issues can not be decided on a motion for an attachment, but will be left to be tried in an action brought for that purpose. Liddle *v.* Cory, 7 Blatch. 1.

If the president of a corporation which has been enjoined, devises the plan for violating the injunction, he may be attached for contempt. Wetherill *v.* Zinc Co. 5 O. G. 460.

If the defendant lease the machine to one of the complainants, the acceptance of the lease is an equitable release of the defendant, and he will not be liable for contempt on account of such use. Smith *v.* Patton, 6 Penn. L. J. 189.

If the defendant desires to mitigate the pecuniary fine to be imposed, he should present his inability to respond in a manner leaving it free from all question. Doubleday *v.* Sherman et al. 4 Fish. 253; s. c. 8 Blatch. 45.

A party who has violated an injunction may be compelled to pay the expenses of the attachment and the counsel fees of the complainant. Doubleday *v.* Sherman et al. 4 Fish. 253; s. c. 8 Blatch. 45; Schillinger *v.* Gunther, 11 O. G. 831.

If the defendant acted under competent advice, and had no intention of disobeying the order of the court, no fine will be imposed, but he will be required to pay costs. Carstaedt *v.* U. S. Corset Co. 13 Blatch. 371; s. c. 10 O. G. 3.

If the defendant is poor, and has been in jail under the attachment for some time, he may be released upon his own recognizance for his appearance whenever ordered to appear, and further proceedings on the attachment may

be suspended indefinitely. Goodyear *v.* Muller, 3 Fish. 260; s. c. 5 Blatch. 463.

If the complainant proves a willful violation of the injunction, without showing the extent of it, he is entitled to an allowance for counsel fees and expenses, but not to a further pecuniary fine by way of indemnity. Doubleday *v.* Sherman et al. 4 Fish. 253; s. c. 8 Blatch. 45.

Profits.

Where there is an infringement, the proper practice is to enter an interlocutory decree, and send the cause to a master to ascertain the amount which the complainant is entitled to recover. Carew *v.* Boston Elastic Fabric Co. 5 Fish. 90; s. c. 1 Holmes. 45; 1 O. G. 91; Jackson *v.* Breck, 11 O. G. 112; Rumford Works *v.* Lauer, 5 Fish. 615; s. c. 10 Blatch. 122; 3 O. G. 349.

The complainant, if he so elects, may waive an account of profits, and bring an action at law. Furbush *v.* Bradford, 1 Fish. 317; s. c. 21 Law Rep. 471.

When there is no dispute about the title, the court may refer the case to a master to take and state an account of the profits which the defendant has made by the use of the patentee's invention. Allen *v.* Blunt, 1 Blatch. 480.

The practice is to take the account of the profits down to the time of the hearing before the master, if the infringement continues to that period, thereby preventing the necessity and expense of a new suit. The right as between the parties to the litigation in respect to the use of the patent, having been decided, there is no question in dispute but the damages. If a second suit were brought the decree in the first would be conclusive of the right, and the only question open would be that of damages, and as to that question the same defense may be made on taking the account for a time subsequent to the commencement of the suit, as could be made in case a new suit were instituted. Tatham *v.* Lowber, 4 Blatch. 86; Rubber Co. *v.* Goodyear, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If the infringing machine has been used by two successive companies, the master should ascertain to what extent each has infringed. Turrill *v.* Ill. C. R. R. Co. 3 Biss. 72.

The account may be taken for profits that accrued after one of the defendants left the partnership, and the liability of the defendants may be apportioned in making up the decree. No decree should be entered against the partner who withdrew from the concern for profits which accrued after such withdrawal. Tatham *v.* Lowber, 4 Blatch. 86; Troy Factory *v.* Corning, 3 Fish. 497; s. c. 6 Blatch. 328.

A release of one of several infringers will not release the others in equity, if it is not under seal, and contains a stipulation that they shall not be released. Ingels *v.* Mast, 6 Fish. 415.

The decree determines the construction of the patent and the fact of infringement, and the master should only inquire into the extent of the infringement. Turrill *v.* Ill. C. R. R. Co. 3 Biss. 72.

If the conduct of the defendant has not been such as to commend him to

the favor of a court of equity, every doubt and difficulty should be resolved against him in stating the account. Rubber Co. *v.* Goodyear, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

The master may refuse to go into the general state of the art, either as to the construction of the patent, or the infringement, where the patent has already been construed by the court. Turrill *v.* Ill. C. R. R. Co. 5 Biss. 344.

There can not be any rule for estimating profits which will apply equally to all cases. The mode of estimating profits must depend upon the peculiar nature of the monopoly granted. Graham *v.* Mason, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

The profits which may be allowed are only such profits and gains as result directly or immediately from the wrongful act of the infringer. Profits which are remote and contingent are not recoverable. Piper *v.* Brown, 6 Fish. 240; s. c. 1 Holmes, 196; 3 O. G. 97.

It is incumbent on the complainant to exhibit affirmatively the whole amount of the production, in order to measure the damages and approximate the extent of the profits. Webster *v.* Carpet Co. 9 O. G. 203.

The defendant is liable for the profits made in repairing infringing machines, although he is also charged with the profits of the manufacture thereof. Graham *v.* Mason, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

The rule in chancery is that the amount of profits received by the unlawful use of the machine is in general the damage done to the owner of the patent. It takes away the motive of the infringer of patented rights by requiring him to pay the profits of his labor to the owner of the patent. Dean *v.* Mason, 20 How. 198; Furbush *v.* Bradford, 1 Fish. 317; s. c. 21 Law Rep. 471.

The profits are to be computed and ascertained by finding the difference between cost and yield. In estimating the cost, the elements of the price of materials, interest, expenses of manufacture and sale, and other necessary expenditures, if there are any, and bad debts, are to be taken into account, and usually nothing else. The calculation is to be made as a manufacturer calculates the profits of his business. Profits is the gain made upon any business or investment when both the receipts and payments are taken into the account. The rule is founded in reason and justice. The controlling consideration is that the wrong-doer shall not profit by his wrong. Rubber Co. *v.* Goodyear, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; Tatham *v.* Lowber, 4 Blatch. 86; Piper *v.* Brown, 6 Fish. 240; s. c. 1 Holmes, 196; 3 O. G. 97.

An allowance of the profits which the defendant could have made with reasonable diligence is erroneous. Dean *v.* Mason, 20 How. 198; Livingston *v.* Woodworth, 15 How. 546.

The inquiry is not what could be, but what was produced. The estimate should be based, not upon the capacity for production, but upon the actual production. Webster *v.* Carpet Co. 9 O. G. 203.

It is the additional advantage which the defendant derived from the invention—advantage beyond what he had without it, for which he must account. Mowry *v.* Whitney, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; Black *v.* Thorne, 12 Blatch. 20; s. c. 7 O. G. 176; Tilghman *v.* Mitchell, 4 Fish. 599; s. c. 19 Wall. 287; 9 Blatch. 1; Turrill *v.* Ill.

C. R. R. Co. 5 Biss. 344; Webster *v.* Carpet Co. 9 O. G. 203; Magic Ruffle Co. *v.* Elm City Co. 11 O. G. 501; Mers *v.* Conover, 11 O. G. 1111.

In ascertaining the profits the comparison must be between the old and the new method. The defendant will not be permitted to show that he could have pursued a more profitable course. Turrill *v.* Ill. C. R. R. Co. 3 Biss. 72.

If the complainant has assented to the defendant's claim for a license, the defendant's liability depends upon whether the infringements were after and in consequence of the admission, and in reliance upon it and before he had notice that it had been withdrawn. Gear *v.* Grosvenor, 6 Fish. 314; s. c. 1 Holmes, 215; 3 O. G. 380.

If the patentee is the infringer against a licensee, and takes out a reissue *pendente lite*, the licensee may claim the profits before as well after the reissue. Littlefield *v.* Perry, 21 Wall. 205; s. c. 7 O. G. 964.

If a license stipulates that a licensee, when he shall find it impracticable to obtain a contract from a town or city, shall allow such town or city to use the thing patented at a certain price, an infringer cannot avail himself of this stipulation so as to limit his liability for profits to that price. American Pavement Co. *v.* Elizabeth, 6 O. G. 764.

If the patent has been surrendered, the patentee is not entitled to an account for profits that accrued prior to the surrender. Sarven *v.* Hall, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437; Buerk *v.* Valentine, 5 Fish. 366; s. c. 9 Blatch. 479; 2 O. G. 295.

If the patent is for an entire process made up of several constituents, the defendant will not be responsible for the profits derived from the use of one of the constituents. Mowry *v.* Whitney, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45.

If the patent is for a combination, the defendant must account for all the profits made by the infringement, and not merely for the difference between such profits and the gains which he might have made by lawful methods. American Pavement Co. *v.* Elizabeth, 6 O. G. 772.

Where the patent is for an improvement, the patentee is not entitled to all the profits that accrued in the manufacture of the whole article, but merely to the profits which were realized as the consequence of the improper use of the improvement. Littlefield *v.* Perry, 21 Wall. 205; s. c. 7 O. G. 964; Ingels *v.* Mast, 2 Cent. L. J. 349; s. c. 9 Pac. L. R. 189; Gould Manuf. Co. *v.* Cowing, 12 Blatch. 243.

Although the patent is for an improvement, yet if the improved article is a new and different species, a specific article having a peculiar value because of the patentee's discovery or invention, the account will be taken for the profits on the whole article, and not merely on the improvement Livingston *v.* Jones, 2 Fish. 207; s. c. 3 Wall. Jr. 330; Mulford *v.* Pearce, 11 O. G. 741.

Where the invention is used in connection with a machine, the profits on the whole are not to be apportioned according to the cost of each part respectively. Graham *v.* Mason, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

If the improvement saves the defendant from a loss, he is liable for the saving, although he made no actual profits. Mers *v.* Conover, 11 O. G. 1111.

The patentee is not entitled to the savings or profits resulting from the

defendant's own invention. Mason *v.* Graham, 5 Fish. 280; S. C. 23 Wall. 261; 7 O. G. 833.

When a machine is sold with an improvement, the profits are not to be divided according to the cost of the improvement and the cost of the machine respectively, but are to be computed according to the profit on the improvement when sold separately. Mason *v.* Graham, 5 Fish. 290; S. C. 23 Wall. 261; 7 O. G. 833.

In general, the defendant should not be charged with interest before the final decree. The profits which are recoverable against an infringer of a patent, are in fact a compensation for the injury he has sustained from the invasion of his right. They are the measure of his damages. Though called profits, they are really damages, and unliquidated until the decree is made. Interest is not generally allowable upon unliquidated damages. Mowry *v.* Whitney, 3 Fish. 157; S. C. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; American Pavement Co. *v.* Elizabeth, 6 O. G. 764; Troy Factory *v.* Corning, 3 Fish. 497; S. C. 6 Blatch. 328; Webster *v.* Carpet Co. 9 O. G. 203; Littlefield *v.* Perry, 21 Wall. 205; S. C. 7 O. G. 964; Livingston *v.* Woodworth, 15 How. 546; Tatham *v.* Lowber, 4 Blatch. 86.

Deductions.

The complainant must take the profits burdened with the just allowance for those disbursements which enable the defendant to offer the thing patented to the public in a salable form, and to keep it in the market, before the eye and within the reach of customers, and generally to properly conduct the business of selling and keep due account thereof. The expenses of clerk hire and rent may be deducted. Hitchcock *v.* Tremaine, 5 Fish. 310; S. C. 9 Blatch. 385.

The market value of the materials on hand when the infringement began, may be allowed, but only the cost of those purchased for the infringement. Rubber Co. *v.* Goodyear, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

If the defendant manufactures the material out of which the thing patented is made, the quantity, if large, may be a ground for reducing the allowance for the price below the ordinary market value. Troy Factory *v.* Corning, 3 Fish. 497; S. C. 6 Blatch. 328.

The loss arising by means of an uncollectible account may be allowed. American Pavement Co. *v.* Elizabeth, 6 O. G. 764.

The use of shop room and tools is a necessary ingredient in the expense of manufacturing most articles, and may be estimated and allowed as a part of the expense account. Troy Factory *v.* Corning, 3 Fish. 497; S. C. 6 Blatch 328.

No allowance can be made as a salary to the defendant, for he is not permitted to gain either wages or salary by a violation of the rights of an inventor. Williams *v.* Leonard, 5 Fish. 381; S. C. 9 Blatch. 476; Piper *v.* Brown, 6 Fish. 240; S. C. 1 Holmes, 196; 3 O. G. 97; *contra*, American Pavement Co. *v.* Elizabeth, 6 O. G. 764.

If the defendant paid a royalty to another patentee for the privilege of using his improvement, this payment may be allowed as an expense. American Pavement Co. *v.* Elizabeth, 6 O. G. 764.

If the defendant has made an improvement on the thing patented, the profits derived therefrom are to be deducted from the gross profits on sales. Hitchcock *v.* Tremaine, 5 Fish. 310; s. c. 9 Blatch. 385.

If the defendant seeks a deduction on account of the use of an improvement made by him, the burden of proving the proportion of the profits due to such improvement rests on him. Carter *v.* Baker, 4 Fish. 404; s. c. 1 Saw. 512; American Pavement Co. *v.* Elizabeth, 6 O. G. 764.

The patentee is entitled to any profit the infringer has made by the unlicensed use of the contrivance included in the monopoly, and of that alone, without any regard to profit or loss on the whole structure or machine of which such mechanism forms a part, and without recoupment for losses on other infringing mechanisms made or sold. Graham *v.* Mason, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

If the defendant sells other articles besides the patented invention, he may deduct a ratable proportion of his general expenses from the profits arising from the sale of the patented invention. Tremaine *v.* Hitchcock, 23 Wall. 518; s. c. 7 O. G. 1055; 9 Blatch. 385.

The apportionment of expenses among the different kinds of business carried on by the defendant should be according to the gross sales, and not according to the profits received from each kind. Hitchcock *v.* Tremaine, 5 Fish. 310; s. c. 9 Blatch. 385.

If the business as to patented articles and articles not patented is so intermingled and confused that approximate results only are possible, these may be ascertained by taking the proportion of the gross amount of the sales of each kind, to the gross profits on both. Rubber Co. *v.* Goodyear, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If the defendant, in one part of his business, saved a certain amount, he is liable for that as profits, although there were no profits on the aggregate results of his whole business. Conover *v.* Mers, 6 Fish. 506; s. c. 11 Blatch. 197.

Where the defendant pays a certain sum to the complainant to prevent him from suing those who have purchased machines from him, but with the express understanding that such payment should not affect the right to recover damages from the defendant, he is not entitled to a deduction on that account. Graham *v.* Mason, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

Damages.

The terms "profits" and "damages," as used in the act, are hardly convertible. They seem to mean different things. The latter are to be awarded "in addition" to the former. Profits doubtless refer to what the defendant has gained by the unlawful use of the patented invention, and damages to what the complainant has lost. Goodyear D. V. Co. *v.* Van Antwerp, 9 O. G. 497.

The sole object of this provision is to enable the patentee, by bringing a suit in equity, to recover in such suit not only the profits made by the defendant by means of such infringement, but also the damages sustained by the patentee thereby. In the absence of this provision this could not be done;

but under this provision the patentee can not recover as damages, any items which he can not recover as damages in an action at law. Consequently, counsel fees can not be recovered as damages. Bancroft *v.* Acton, 7 Blatch. 505.

If no profits are made, the complainant may be allowed his usual royalty as damages. Goodyear D. V. Co. *v.* Van Antwerp, 9 O. G. 497.

The complainant may be allowed the amount of his license fee as damages. Emerson *v.* Simm, 6 Fish. 281; s. c. 3 O. G. 293.

If the inventor has established a license fee and also manufactures the patented article, the price of the article will consist of the cost of the materials, the ordinary profit of manufacture, and an additional profit which is the equivalent of the license fee, but the license fee is the measure of damage for the infringement. Buerk *v.* Imhauser, 10 O. G. 907.

A defendant can not avoid his liability for damages by alleging that he might have used some other machine as advantageously as the complainant's. Emerson *v.* Simm, 6 Fish. 281.

The damages must be confined to the direct and immediate consequences of the infringement, and not embrace those which are remote and conjectural. Buerk *v.* Imhauser, 10 O. G. 907.

Where the patent is for an improvement, the damage is that sustained by the use of the improvement alone. Buerk *v.* Imhauser, 10 O. G. 901.

Master's Report.

Exception should be taken on the spot to each ruling of the master in overruling or sustaining objections to the admission of evidence, if the party intends to contest it. It need not then be drawn up in form, but it should be taken by giving notice to the master, and it is his duty to note the fact in his minutes. The reason of the rule is founded in the interest of justice as its observance tends to narrow the limits of controversy, for if the party in whose favor a ruling is made, is notified that an exception is taken, and the question is to be revised, he can waive the point and admit or withdraw the evidence, as the case may be, and thus avoid future controversy and delay over it. Troy Factory *v.* Corning, 3 Fish. 497; s. c. 6 Blatch. 328; American Pavement Co. *v.* Elizabeth, 6 O. G. 764; Brown *v.* Hall, 3 Fish. 531; s. c. 6 Blatch. 401.

An objection to testimony which does not state the ground of the objection, is not a legal or valid objection. Brown *v.* Hall, 3 Fish. 531; s. c. 6 Blatch. 401.

If it is proper to except at all to the master's final report for rulings admitting or rejecting evidence, this can only be done where objections of the same kind have been made to the draft report. Troy Factory *v.* Corning, 3 Fish. 497; s. c. 6 Blatch. 328.

If the interlocutory decree is erroneous, the proper mode to correct the error is not to except to the master's report but to apply to the court to resettle the decree. Williams *v.* Leonard, 5 Fish. 381; s. c. 9 Blatch. 476.

Exceptions to the master's report should point out the error and the evidence to support the allegation should be referred to in the argument. Turrill *v.* Ill. C. R. R. Co. 3 Biss. 72.

Where the exception fails to point out the evidence that shows the difference in the cost and use of the machines, it may be disregarded. Turrill *v.* Ill. Cent. R. R. Co. 5 Biss. 344.

Where the finding of the master is based not merely upon the evidence, but upon a personal inspection made by him with the consent of the parties, it will not be reversed. Piper *v.* Brown. 6 Fish. 240; S. C. 1 Holmes. 196; S. C. 3 O. G. 97.

Where the costs before the master have been augmented by the production of irrelevant testimony, each party may be left to pay his own costs. Troy Factory *v.* Corning, 6 Fish. 85; S. C. 10 Blatch. 223.

Rehearing.

A decree for a perpetual injunction and for an account of the profits, is an interlocutory and not a final decree, and a rehearing may be granted at any time before a final decree. Reeves *v.* Keystone Bridge Co. 9 O. G. 885; S. C. 2 W. N. 523.

The application for a rehearing after an interlocutory decree must be by a petition for leave to file supplemental bill setting forth the newly discovered evidence, and for a rehearing of the cause at the time when the supplemental bill may be ready for hearing. Reeves *v.* Keystone Bridge Co. 9 O. G. 885; S. C. 2 W. N. 523.

Where a party asks for a rehearing on the ground of newly discovered evidence, he must satisfy the court that the omission to produce the evidence at the former hearing was not due to any negligence on his part, but that he made diligent efforts to discover and obtain it. Reeves *v.* Keystone Bridge Co. 9 O. G. 885; S. C. 2 W. N. 523.

If an application is made for a rehearing on the ground of newly discovered evidence, there must be plain proof of the sufficiency of the evidence to lead the court to a different result. Buerk *v.* Imhauser, 10 O. G. 907.

The want of proper expert testimony is no ground for granting a rehearing. Application should have been made to the court prior to the hearing for opportunity to procure and put in such testimony. Hitchcock *v.* Tremaine, 5 Fish. 537: S. C. 9 Blatch. 550; 1 O. G. 633.

The affidavits to be used on an application for a rehearing, must be entitled in the cause. Buerk *v.* Imhauser, 10 O. G. 907.

If the defendant has been guilty of laches, a decree for an injunction will not be opened. Doubleday *v.* Sherman, 6 Blatch. 513.

The payment of the taxed costs, without taking measures to open a decree for an injunction, affirms the regularity and validity of the decree so as to make it impossible for the defendant to have the decree set aside or opened to let in a defense. Doubleday *v.* Sherman, 6 Blatch. 513.

Where an objection is made to the admissibility of evidence before the examiner, to impeach the novelty of the patent, a rehearing will not be allowed in order to let the defendant amend his answer so as to give the proper notice. American Saddle Co. *v.* Hogg, 6 Fish. 67; S. C. 1 Holmes, 177; 2 O. G. 595.

If the court is not satisfied with the conclusion reached in the testimony, it

may grant a rehearing, with leave to take additional proofs. Rumford Works *v.* Lauer, 5 Fish. 615; s. c. 10 Blatch. 122; 3 O. G. 349.

Application for leave to file a bill of review on the ground of newly discovered evidence, must be made within a reasonable time after the discovery of the evidence. Blandy *v.* Griffith, 6 Fish. 434.

A bill of review will not be allowed where the newly discovered evidence is merely cumulative as to a point already at issue. Blandy *v.* Griffith, 6 Fish. 434.

Costs.

The plaintiff, in patent cases, has never been required to give any security for costs. Woodworth *v.* Sherman, 3 Story, 171; *contra*, Orr *v.* Littlefield, 1 W. & M. 13.

It is too late to move for security for costs when the case has been once heard on issue joined, and is then opened for a further hearing on an amended answer, as a matter of favor to the defendant, if the non-residence of the complainant appeared on the face of the original bill. Bliss *v.* Brooklyn, 10 Blatch. 217.

The general rule is to give costs to the prevailing party, and no departure will be made beyond what is sustained by sound principles and established precedents. Hovey *v.* Stevens, 3 W. & M. 17.

The exceptions to the general rule should be very few, and rest on very strong grounds. Hovey *v.* Stevens, 3 W. & M. 17.

If the complainant and defendant each have judgment in their favor on one issue, no costs will be allowed to either party. Yale Manuf. Co. *v.* North, 3 Fish. 279; s. c. 5 Blatch. 455.

No costs will be awarded to a defendant who has granted a license to the other defendants to use his own patent, and thus indirectly derived advantages from the infringement by reason of the larger number of sales thereby occasioned, especially when he joins with them in the defense. Hussey *v.* Bradley, 2 Fish. 362; s. c. 5 Blatch. 134.

If the defendant has been misled by the complainant into the belief that his machine did not infringe the patent, he will not be charged with costs. Sarven *v.* Hall, 6 Fish. 495; s. c. 11 Blatch. 295; 4 O. G. 666.

If an objection to the title of the complainant is taken by answer, when it could have been taken by demurrer, the bill may be dismissed without costs. Brooks *v.* Byam, 2 Story, 553.

If the patentee fails on account of a defective specification, and his claim to be the original inventor is not established, costs will be awarded to the respondent. Hovey *v.* Stevens, 3 W. & M. 17.

Costs are, perhaps, never in fact taxed until after the judgment is rendered, and in many cases can not be taxed until afterwards. Where this is the case, the amount ascertained is usually, under the direction of the court, entered *nunc pro tunc*, as a part of the original judgment. This mode of proceeding is necessary for the purpose of justice, in order to afford the necessary time to examine and decide upon the several items of costs to which the successful party is lawfully entitled. Sizer *v.* Many, 16 How. 98.

The clerk has no authority to fix the compensation to be allowed to a master. Doughty *v.* Manuf. Co. 4 Fish. 318.

If the costs are not taxed in the circuit court before the transcript of the record is transmitted to the supreme court, they may be taxed and inserted in the blank left for that purpose in the original record, upon the receipt of the mandate by the circuit court. Sizer *v.* Many, 16 How. 98.

Taxable Costs.

A taxation of costs is a right given or refused by statute. Hathaway *v.* Roach, 2 W. & M. 63.

The expenses of the complainant, or his counsel, in attending court, can not be allowed. Hussey *v.* Bradley, 5 Blatch. 210.

Money properly and necessarily paid for telegrams in the progress of the cause may be allowed, but the affidavit showing the actual expenditure should state the payment in detail, and the particular purpose of each telegram, so that the taxing officer may judge of the necessity and propriety of the expenditure, and of its allowance on taxation as a proper disbursement in the suit. Hussey *v.* Bradley, 5 Blatch. 210.

No expenditure for making copies of the pleadings or proofs can be allowed. Hussey *v.* Bradley, 5 Blatch. 210.

The expense of reporting the argument of counsel at the final hearing can not be taxed as a part of the costs. Hussey *v.* Bradley, 5 Blatch. 210.

If the record is printed by an order of the court, the expense may be divided equally between the parties. Brooks *v.* Byam, 2 Story, 553.

The expense of printing the testimony is not chargeable against the losing party as an item of costs. The law does not require the testimony to be printed, and if it is, it must be done voluntarily by the party desiring it, and at his own expense. Spaulding *v.* Tucker, 4 Fish. 633; Hussey *v.* Bradley, 5 Blatch. 210; Troy Factory *v.* Corning, 7 Blatch. 16.

The defendant is entitled to have the costs of copies of the various assignments made by the plaintiff taxed. Hathaway *v.* Roach, 2 W. & M. 63.

The defendant can not have the cost of a copy of the patent taxed. Hathaway *v.* Roach, 2 W. & M. 63; Woodruff *v.* Barney, 2 Fish. 244; S. C. 1 Bond, 528.

The defendant may be allowed a reasonable compensation for the expense of procuring models of the invention claimed in the patent. Hathaway *v.* Roach, 2 W. & M. 63.

The expense of procuring models not referred to in the patent can not be taxed. Woodruff *v.* Barney, 2 Fish. 244; S. C. 1 Bond, 528; Hussey *v.* Bradley, 5 Blatch. 210; Parker *v.* Bigler, 1 Fish. 285; Hathaway *v.* Roach, 2 W. & M. 63.

No fee can be allowed as mileage to the marshal for serving a rule to plead on the defendant. Parker *v.* Bigler, 1 Fish. 285.

The postage paid upon the transmission and return of a commission may be allowed as a part of the costs. Prouty *v.* Draper, 2 Story, 199.

When the parties are not the same, the witness has a right to fees in each suit, and cases where the plaintiff alone is a party are in the same category with those where all the parties are different. Parker *v.* Bigler, 4 Fish. 285.

The fees of a witness attending merely by the request of a party, without subpœna, can not be legally taxed against the losing party as a part of the costs for which he is liable. Such a witness does not attend "pursuant to law." Woodruff *v.* Barney, 2 Fish. 244; S. C. 1 Bond, 528; Spaulding *v.* Tucker, 4 Fish. 633; Hathaway *v.* Roach, 2 W. & M. 63; *contra*, Prouty *v.* Draper, 2 Story, 199.

There can not be two different modes of calculating distances, an air line for jurisdiction and a zig-zag for mileage. When the subpœna is served in another district, mileage can only be allowed for one hundred miles, although the marshal may have actually traveled a greater distance. Parker *v.* Bigler, 4 Fish. 285.

When witnesses come twice at the same term on account of a postponement by agreement of the parties, and not by any order of the court, and not on public account, the presumption of law and fact must be that they continued their atendance, and were paid for it till discharged by the parties or the court, and double travel can not be allowed. Hathaway *v.* Roach, 2 W. & M. 63.

The fees of witnesses who actually attend before the plaintiff becomes nonsuit, though not examined, may be allowed. Hathaway *v.* Roach, 2 W. & M. 63.

Courts of equity may allow costs other than those prescribed in the statute, according as justice and equity may require according to the circumstances of each case. If the testimony of witnesses is taken under a commission by consent, a reasonable sum, as costs for necessary expenses in procuring the attendance of the witnesses, may be allowed. Spaulding *v.* Tucker, 4 Fish. 633.

If a party dispenses with the deposition of a witness, and examines him, the cost of the deposition can not be taxed. Hathaway *v.* Roach, 2 W. & M. 63.

The fee for depositions relates to testimony taken out of court under authority which will entitle it to be read as evidence in court, and has no relation to oral testimony taken in court or before a master. It applies in cases at common law where depositions are given in evidence on the trial, and in suits in equity where depositions are read at the hearing. Troy Factory *v.* Corning, 7 Blatch. 16.

No *per diem* allowance should be taxed for the attendance before the master, of witnesses whose testimony was afterwards abandoned or given up, or was stricken out or rejected by the master, where the striking out or rejection has been sustained by the court. It would be unreasonable and against the established rule of taxation to tax costs in favor of a party for acts or services which were useless or illegal, and which only led to increased expense and to a waste of the time of the court and of all persons concerned. Troy Factory *v.* Corning, 7 Blatch. 16.

The docket fee of twenty dollars is the highest compensation allowed to a solicitor in a cause, and can be allowed but once. Troy Factory *v.* Corning, 7 Blatch. 16.

Trial and final hearing have well-known definite meanings in the law, and they are used in this statute in that well-known sense. "Trial" is used to

describe the process of determining the issues in an action at law, and "final hearing" the submission of the case for a determination thereof upon the pleadings, or pleadings and proofs, or otherwise, so that the case may be finally disposed of. The proceedings before a master upon a reference for a provisional or interlocutory purpose are neither a trial nor a final hearing, and the docket fee of twenty dollars can not be allowed. Doughty *v.* Manuf. Co. 4 Fish. 318.

SEC. 4921 A (Act of February 16, 1875, § 2, 18 Stat. 316). That said courts, when sitting in equity for the trial of patent cases, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient; and the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings.

SEC. 4922. Whenever, through inadvertence, accident or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity for the infringement of any part thereof, which was *bona fide* his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the patent office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

Statute Revised—Act of July 8, 1870, ch. 230, § 60, 16 Stat. 207.
Prior Statute—March 3, 1837, ch. 45, § 9, 5 Stat. 194.

SEC. 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

Statute Revised—July 8, 1870, ch. 230, § 62, 16 Stat. 208.
Prior Statute—July 4, 1836, ch. 357, § 15, 5 Stat. 123.

No description in any printed publication of the thing patented can avoid the patent, unless such description in such printed publication was prior in point of time to the invention of the patentee. A publication after the invention, but before the application for a patent, is not sufficient. Bartholomew *v.* Sawyer, 1 Fish. 516; S. C. 4 Blatch. 347; Howe *v.* Morton, 1 Fish. 586; Cochrane *v.* Deener, 11 O. G. 637; S. C. 4 W. L. R. 99.

The description in a foreign publication, in order to invalidate a patent, must contain and exhibit a substantial representation of the patented improvement, in such full, clear and exact terms, as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information were derived from a prior patent. Seymour *v.* Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G 630; Cohn *v.* U. S. Corset Co. 93 U. S. 366; S. C. 12 Blatch. 225; 6 O. G. 259; 11 O. G. 457; Ex parte John McClosky, 9 C. L. N. 313; Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327; Hays *v.* Sulsor, 1 Fish. 532; S. C. 1 Bond, 279.

Although there has been a previous discovery in a foreign country, yet the patent will be good, unless such discovery or some substantial part of it had been patented or described in a printed publication prior to the application. O'Reilly *v.* Morse, 15 How. 62; S. C. 6 West. L. J. 102; Smith *v.* Ely, 5 McLean, 76; S. C. 15 How. 137; Roemer *v.* Simm, 5 O. G. 555; Furbush *v.* Cook, 2 Fish. 668; Dawsen *v.* Follen, 2 Wash. 311; Judson *v.* Cope, 1 Fish. 615; S. C. 1 Bond, 327; Bartholomew *v.* Sawyer, 1 Fish. 516; S. C. 4 Blatch. 347; Reutgens *v.* Kanowrs, 1 Wash. C. C. 168.

If the foreign discovery is not patented or described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach, and so far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them and places it in their possession. As he does this by the effort of his own genius, the law regards him as the first and original inventor, and protects his patent, although the improvement had, in fact, been invented before and used by others. Gayler *v.* Wilder, 10 How. 477; Sewall *v.* Jones, 6 Fish. 343; S. C. 3 O. G. 630.

This provision goes upon the presumption that if the foreign publication has been made, the patentee may have acquired a knowledge of it, and this presumption is not rebutted by proving as far as a negative can be proved, that the inventor had no knowledge of it. Allen *v.* Hunter, 6 McLean, 303; Swift *v.* Whisen, 3 Fish. 343; s. c. 2 Bond, 115; Webb *v.* Quintard, 5 Fish. 276; s. c. 9 Blatch. 352; 1 O. G. 525.

In considering whether the patentee did believe himself to be the original inventor of what was patented to him, it is material to determine whether he was, in fact, the original inventor thereof. If he was, there is an end to all inquiry on that point. If he was not, still he may have believed himself to be so. Furbush *v.* Cook, 2 Fish. 668.

When there is no evidence to the contrary, the presumption is that a patentee at the time of making his application, believed himself to be the first inventor or discoverer of the thing patented. Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600.

The word "patented," means covered and made known to the world by a public patent, so as to bring home to the public generally and probably a knowledge of its existence, and deprive any one of the credit and protection of being original if he afterward construct a like machine. A private patent is not within this clause. Brooks *v.* Norcross, 2 Fish. 661.

What is meant by Congress, undoubtedly, is in the first place, that there shall have been an invention, and in the second place, that it shall have been made patent to the world—patented. A specification enrolled after the granting of the patent, will be deemed to take effect only from the time of the enrollment so far as it affects other inventors. Howe *v.* Morton, 1 Fish. 586.

The fact whether the patent was private or public ought to be made to appear by the defendant, as he sets up the patent as if coming within the word patented. Brooks *v.* Norcross, 2 Fish. 661.

If no copy of the patent itself is given in evidence, but merely a copy of the specification and drawing, the proof required by law that the invention was in truth patented, is defective. Brooks *v.* Norcross, 2 Fish. 661.

If the machine described in the foreign patent required further invention to make it a practical and operative machine, and to embody the same invention which is described in the American patent, it will not work a forfeiture of the American patent. American Leather Co. *v.* American Tool Co. 4 Fish. 284.

If the description in a foreign patent is sufficient to show the structure of the article, there need not be any proof otherwise of the existence of the article. Cohn *v.* U. S. Corset Co. 93 U. S. 366; s. c. 12 Blatch. 225; 6 O. G. 259; 11 O. G. 457.

The mere existence of a device in a foreign country, unless patented or described in a printed publication, is not a fact having any significance or recognized at all in connection with our patent laws. Tucker & Davis, 2 O. G. 224; Carr *v.* Davids, 3 O. G. 440; Smith *v.* Barter, 7 O. G. 1; Chambers et al. *v.* Duncan et al. 9 O. G. 741; Chambers et al. *v.* Duncan et al. 10 O. G. 787.

If the invention has been described in a foreign patent, it is not patentable. Charles Frampton, 1 O. G. 381.

A foreign patent, to anticipate the novelty of an invention, must contain the device either in a drawing or a description, and in either case the invention must be so distinctly shown or described as to be a matter of certainty, not of inference. Abial C. Herron, 1 O. G. 608.

The date of an invention originated abroad, can be carried back no further than the time when specimens embodying it are shown, on satisfactory evidence, to have reached this country. Hovey *v.* Hufeland et al. 2 O. G. 493.

An English patent is a sufficient anticipation of an application, if the description of the invention is sufficiently full, in view of the state of the art, to enable a skilled mechanic to construct it. J. McClosky, 9 O. G. 299.

An English provisional specification, upon which no patent was issued, can be treated only as a published description in ascertaining the state of the art. R. O. Lowry, 1 Dec. Com. 85; Edward Maynard, 2 Dec. Com. 57.

No previous invention of the same thing, or knowledge or use of the same in any foreign country, can constitute a valid defense to a suit under the patent. Grell *v.* Kuhnert, 1 Dec. Com. 5.

SEC. 4924. Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor, in writing, to the commissioner of patents, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the original term.

Statute Revised—July 8, 1870, ch. 230, § 63, 16 Stat. 208.

Prior Statutes—July 3, 1832, ch. 162, § 2, 4 Stat. 559.—July 4, 1836, ch. 357, § 17, 5 Stat. 124.—May 27, 1848, ch. 47, § 1, 9 Stat. 231.

The word "patentee" is used as equivalent to inventor, and the law looks to him as the sole object of its bounty, and means to reward him and him alone for his time, ingenuity and expense in perfecting his invention. Woodworth *v.* Sherman, 3 Story, 171; Brooks *v.* Bicknell, 4 McLean, 64.

After the decease of the patentee an extension of a patent may be granted to his administrator. The rights under the patent before its extension remain in every respect the same after its extension. The administrator acts as the trustee of the heirs; he represents the deceased. Brooks *v.* Bicknell, 3 McLean, 250; Brooks *v.* Jenkins, 3 McLean, 432; Washburn *v.* Gould, 3 Story,

122; Wilson *v.* Rosseau, 4 How. 646; S. C. 1 Blatch. 3; Woodworth *v.* Sherman, 3 Story, 171.

The extension may be granted to the patentee, although the original patent has been surrendered and a reissue granted to an assignee. Crompton *v.* Belknap Mills, 3 Fish. 536; Potter *v.* Braunsdorff, 7 Blatch. 97.

The extension may be of the original patent, although there has been a reissue to an assignee without the assent of the patentee. Potter *v.* Braunsdorf, 7 Blatch. 97.

In computing the period of ninety days, the day on which the application is filed is to be included. Johnson *v.* McCullough, 4 Fish. 170.

Applicant.

The grant of extensions is for the benefit of inventors, and not of assignees and speculators. G. Peberdy, 2 O. G. 644; Charles Waters, 1 Dec. Com. 42; Cornelius W. Van Vliet, 1 Dec. Com. 93; O. W. Minard, 2 Dec. Com. 36; Gleason & Crossman. 2 Dec. Com. 158; John L. Mason, 3 Dec. Com. 182; T. F. Taft, 3 Dec. Com. 224; G. W. Hildreth, 3 Dec. Com. 261; L. F. Munger, 3 O. G. 323.

If one appears without any authority from the patentee, or not as executor or administrator, an extension will be refused him. Torrey & Tilton, 3 Dec. Com. 245.

The authority of an attorney who signs a petition for an extension for his principal, need not be antecedent to his filing it; if the principal adopts it afterwards it is sufficient. Henry Voelter, 2 Dec. Com. 84; R. H. Garrigues' Admr. 2 Dec. Com. 88.

If one joint inventor alone files the application, and the other ratifies and unites in it before the expiration of the patent, the application will be entertained and acted on in the same manner as if both had originally signed it. D. E. Beadle, 1 O. G. 434.

A patent issued to two joint inventors can not be extended upon the several application of one of them. John B. Wickersham, 4 O. G. 155.

A patentee may apply for an extension of the original patent, although an assignee without his consent surrendered the original patent and obtained a reissue. Harriet L. Low, 1 O. G. 203.

Where an assignment has been recently made of a moiety of the invention for a nominal sum, the rule requiring the patentee to show his interest in the extension will not be waived. Thomas Lee, 1 O. G. 434.

A patent may be extended if the inventor owns a half interest in the extended term. Horace Woodman, 1 O. G. 550.

An extension will not be granted if the inventor has no interest remaining in the extended term. John L. Mason, 3 Dec. Com. 182; H. H. Furbish, 3 Dec. Com. 190.

Statement.

The object of the requirement is to furnish the commissioner data for a reliable judgment as to whether the inventor has been reasonably remunerated, and it is only necessary that the account shall be elaborated to this extent. It is not necessary to give by itself every item of expenditure and receipt on account of the patent. T. H. Willson, 1 O. G. 185.

In order to obtain the extension of a patent, the applicant must furnish a statement, in detail, of what he has received and expended on account of the invention, under oath. John R. Harrington, 2 Dec. Com. 27; Alva B. Taylor,

2 Dec. Com. 68; Levi Averill, 2 Dec. Com. 82; Robert A. Smith, 2 Dec. Com. 87; Albert A. Gray, 2 Dec. Com. 88; Reuben Conins, 3 Dec. Com. 27; A. B. Latta, 3 O. G. 349.

The law requiring an applicant to furnish a statement of the ascertained value of the invention does not necessarily contemplate a *numerical* statement. Peter Cook, 3 Dec. Com. 24; E. F. Whiton, 3 Dec. Com. 201.

The extension may be granted although the statement was not filed within thirty days from filing the application. Horace Woodman, 1 O. G. 550.

The statement must be under oath and show the ascertained value of the invention, giving the patentee's receipts and expenditures. R. N. Allen, 1 O. G. 278.

Whether an account will be deemed to be sufficiently in detail, may be affected by the fact that the party opposing the application does not object to it on that ground. T. H. Willson, 1 O. G. 185.

When the application for an extension is not filed in season, it will not be received and the fee will be returned. J. C. Smith's Adm'rs, 2 Dec. Com. 114.

Value.

If the previous demand for a patent had been limited, and it was found useful and met with large sales only after an improvement had been applied to it, an extension will not be granted. P. H. Roots, 6 O. G. 391.

Where, upon an application for an extension, the value of the invention can be ascertained only from the sales of a machine embracing others with it, the proportionate value of each may be determined upon the affidavit of the applicant, if not inconsistent with their apparent importance. Horace Woodman, 2 Dec Com. 66.

The extension of a patent will be refused where the patentee has sold his interest in it for a trifling consideration. William Gage, 2 Dec. Com. 100; John F. Boynton, 2 Dec. Com. 125; Andrew M. Hall, 2 Dec. Com. 174; John G. Baker, 1 O. G. 632.

A mere allegation that the inventor has sold rights under his patent, is not sufficient unless he produces the affidavits of the vendees to prove the importance of the invention. P. V. Matthews, 1 O. G. 405.

In showing the value of an invention the patentee is entitled to all uses to which his invention may be found adaptable. John G. Baker, 1 O. G. 632.

Affidavits which merely give the opinions of the witnesses, without stating any facts or data, are not sufficient to show the value of the invention. Thomas Lee, 1 O. G. 434; Samuel Falkenberg, 2 O. G. 3; John R. Marston, 1 O. G. 608.

If improvements have been added, the statement of the value of the invention should distinguish how much of the value was due to the portions patented by applicant for extension. John Haseltine, 8 O. G. 45.

Where the value of the invention, and the diligence exercised in introducing it, sufficiently appear from papers filed in the case, though they are not strictly of evidence, the extension of a patent will be allowed. David Munson, 2 Dec. Com. 78.

If a patented machine has proved highly useful, the difference between it and former unsuccessful machines should not be nicely weighed upon a petition for an extension. Cyrus Chambers, Jr. 2 Dec. Com. 124; John A. Montgomery, 4 O. G. 132.

If it is manifest, from the evidence, an invention is valuable, an extension will be granted, although the statements to that effect are defective. David H. Whittemore, 3 Dec. Com. 30; Sidney S. Hogle, 3 Dec. Com. 72; Alonzo M. Giles, 3 Dec. Com. 76.

A patent for a process will not be extended if the composition described to be used in the process was laid aside soon after the patent was granted, and another more effective substituted, which has been kept secret. H. W. Collender, 2 O. G. 727.

Old newspapers are not regarded as such well-known printed matter as can be used in argument, for purposes of evidence, without previous notice. Robert Dick, 2 O. G. 147.

Upon applications for the extension of a patent, the value of the invention will be estimated according to what it was as described in the original patent, irrespective of modifications, improperly interpolated in a reissue. John Taggart, 1 Dec. Com. 102.

Where the invention could have cost but little time, ingenuity or expense, and is not of great public use, an extension will be refused. Hiram Tucker, 1 Dec. Com. 39; M. Riehl, 1 Dec. Com. 52; W. O. Hickok, 1 Dec. Com. 94; William Gee, 2 Dec. Com. 8; Calvin Dodge, 2 Dec. Com. 23; Jabez W. Hayes, 2 Dec. Com. 77; Charles Moore, 2 Dec. Com. 83; G. A. & H. Whipple, 2 Dec. Com. 123; Nathan Martz, 2 Dec. Com. 16; Jean L. Baudelot, 2 Dec. Com. 184; A. C. Gallahue, 3 O. G. 319.

If no attempt is made to prove the invention valuable and important to the public, and no diligence is shown on the part of the inventors in introducing it into public use, an extension will be refused. G. & D. Cook, 3 Dec. Com. 19; John W. Hoard, 3 Dec. Com. 49; Francis D. Ballou, 5 O. G. 29.

If the invention has created and supplied an extensive demand in the market, and has been recognized by the public as one of great utility, an extension will be granted, although there may be grave doubts of its patentability. Wm. E. Lockwood, 3 O. G. 439.

Profits.

A patentee who has not received as much on account of his invention as he has expended, having been compelled by poverty, and the necessity of protecting his rights, to assign most of his interest in the extension, is entitled to have it renewed. Ira Gill, 3 Dec. Com. 12; James E. A. Gibbs, 3 Dec. Com. 155.

An applicant for an extension is not to be allowed a remuneration increased in proportion to the amount realized from the invention. Isaac M. Singer, 2 Dec. Com. 146.

Where different improvements upon the same machine are protected by successive patents, the separate value of which is not easily determinable, and the remuneration received from them all has been small, without any fault or lack of diligence on the part of the inventor, an extension will be granted. Strong & Ross, 3 Dec. Com. 8.

Where the patent has been, from first to last, in the hands of the patentee, the burden is on him to show that the benefit which he might have derived from the use of his invention was not lost through any fault or neglect of his, before an extension will be granted. D. W. Hughes, 1 Dec. Com. 96; Christian Shunk, 2 Dec. Com. 10; Simon Ingersoll, 2 Dec. Com. 38; Smith & Skinner, 2 Dec. Com. 131; Kelly & Livingstone, 3 Dec. Com. 29; Arnton Smith, 3 Dec. Com. 208; Nicholas Whitehall, 3 Dec. Com. 266.

An applicant who makes liberal charges for time, labor and expense bestowed upon the invention, is not entitled to great liberality in the matter of remuneration. Robert Dick, 2 O. G. 147; Jean L. Baudelot, 2 Dec. Com. 184.

If two inventions are so intimately connected in their use that it is impossible to make a distinct statement of receipts and expenditures for each, and the renumeration received from them both has been small, without any

fault or lack of diligence on the part of the inventor, an extension will be granted. J. W. Riggs, 3 Dec. Com. 291.

If it appears that the inventor has been reasonably remunerated for the time, ingenuity and expense bestowed upon the invention, an extension will be refused. William R. Landfear, 2 Dec. Com. 176; S. H. & Joseph Strouse, 2 Dec. Com. 182; Jean L. Baudelot, 2 Dec. Com. 184; Orwell H. Needham, 3 Dec. Com. 3; Wm. B. Bates, Adm'r, 3 Dec. Com. 17.

The restriction of the right to manufacture a machine to companies in which the patentee is a shareholder, is perfectly right, if he so chooses, but he will be held to a stricter account of receipts, and will be considered as keeping the manufacture of the invention in his own hands. Perry G. Gardner, 2 O. G. 359; Hiram Tucker, 1 Dec. Com. 39.

Receipts from foreign patents on account of the invention, must be embraced in the accounts upon an application for an extension. D. N. Woodward, 3 Dec. Com. 42.

If it is impossible to furnish a detailed account of expenditures on account of some unavoidable accident, and it is evident the inventor has been insufficiently rewarded without his fault, an extension will be granted. John Benedict, 3 Dec. Com. 40; L. B. & H. A. Myers, 3 Dec. Com. 55.

If an invention is an obvious one, the first one to produce it is not entitled to the same remuneration for it as the inventor of an improvement less likely to be discovered. Marcus P. Norton, 4 O. G. 156.

An applicant for an extension is not required to account for the profits made under the patent by his assignees, to whom he sold under the pressure of poverty. Roxanna Rice, 3 Dec. Com. 95.

If a patent covers an improvement in an article which could be applied to any other, the patentee will be sustained in crediting the invention with only the amount saved by it in the manufacture. Calvin Adams, 3 Dec. Com. 45.

There is no definite standard as to adequacy of remuneration, and where the invention is of an important character and of great public benefit, the fact of having been liberally compensated will not work against an extension. Henry Waterman, 2 O. G. 247; H. W. Putnam, 3 O. G. 240; Benjamin F. Sturtevant, 5 O. G. 2.

A patent will not be extended if, according to the applicant's statement, large sums must have been received which are not credited in the accounts, and other unexplained discrepancies occur. E. G. Allen, 3 Dec. Com. 269.

An extension will be granted, although no detailed accounts were rendered, where it has been rendered impossible by reason of the bankruptcy and death of the patentee, and his failure to receive a reasonable compensation is accounted for. F. N. Clarke, 3 Dec. Com. 54; Brickman & Sisson, 3 Dec. Com. 92.

A patent will be extended where there has been great outlay in demonstrating its utility without any return, and public interests will be promoted thereby, although the invention is not in public use and its ascertained value not definitely known. Ross & Winans, 2 O. G. 440.

Although a subsequent improvement creates a market for a foundation invention, and carries it into more extensive use than it would otherwise have been, yet this is no ground for reducing the account of proceeds from a license of the foundation invention. Henry W. Fuller, 5 O. G. 643.

If a patent has been extensively infringed, and the infringers are liable for damages to an amount which will give the inventor an ample remuneration, his patent will not be extended. Geo. B. Arnold, 5 O. G. 553.

If the patentee has granted permission to others to make his patented device for a specified royalty, and any considerable number has been thus manufactured, such royalty is the fairest measure of profits. Lewis Miller, 1 O. G. 431.

Where the inventor, without neglect or fault on his part, has failed to obtain from the use and sale of his invention a reasonable remuneration for the time, ingenuity and expense bestowed upon it, an extension will be allowed. Theodore T. Woodruff, 2 Dec. Com. 161; Wendell Wright, 2 Dec. Com. 167; Emanuel Andrews, 2 Dec. Com. 170; Thomas Nelson, 2 Dec. Com. 172; Joseph Kingsland, 2 Dec. Com. 173; Joseph H. Goodell, 2 Dec. Com. 174; John J. Squire, 2 Dec. Com. 179; B. G. Dawley, 2 Dec. Com. 181; Isaac A. Dunham, 2 Dec. Com. 186; Henry Eddy, 3 Dec. Com. 4; James P. Cramer, 3 Dec. Com. 6; John G. Vaughan, 3 Dec. Com. 13; D. H. Whittemore, 3 Dec. Com. 14; Azel S. Lyman, 3 Dec. Com. 20; Jas. Stimpson, 3 Dec. Com. 21; Seth C. Ellis, 3 Dec. Com. 22; P. Cook, 3 Dec. Com. 24; Julia M Milligan, 3 Dec. Com. 29; David H. Whittemore, 3 Dec. Com. 30; Edgar Huson, 3 Dec. Com. 33; J. D. Brown, 3 Dec. Com. 39; C. H. & H. E. Davidson, 3 Dec. Com. 71; Isaac Hayden, 3 Dec. Com. 73; Wm. L. Williams, 3 Dec. Com. 93; A. H. Rowand, 3 Dec. Com. 105; James D. Sarvin, 3 Dec. Com. 170; William Kelly, 3 Dec. Com. 186; John Haw, 3 Dec. Com. 191; F. C. Lowthorp, 3 Dec. Com. 192; L. F. Munger, 3 Dec. Com. 203; John P. Manny, 3 Dec. Com. 205; Benaiah Fitts, 3 Dec. Com. 211; B. D. Whitney, 3 Dec. Com. 211; Philip W. McKensie, 3 Dec. Com. 223; Lovejoy & Butterfield, 3 Dec. Com. 267; C. Chambers, 3 O. G. 320; Michael H. Simpson, 2 Dec. Com. 88; Ethan Rogers, 2 Dec. Com. 92; Emily J. Lamson, 2 Dec. Com. 94; Sopia & P. L. Moen, Adm'rs, 2 Dec. Com. 98; Samuel Thomas, 2 Dec. Com. 99; W. & Wm. H. Lewis, 2 Dec. Com. 118; Tobias J. Kindleberger, 2 Dec. Com. 121; D. P. Estep, 2 Dec. Com. 123; George Thompson, 2 Dec. Com. 128; Samuel Morrill, 2 Dec. Com. 134; El Dora Louis, Adm'x, 2 Dec. Com. 148; Thaddeus Fairbanks, 3 Dec. Com. 15; Samuel R. Smith, 3 Dec. Com. 16; D. W. Shares, 3 Dec. Com. 19; Samuel R. Wilmot, 3 Dec. Com. 31; Wm. C. Hicks, 3 Dec. Com. 50; George F. Hutchins, 3 Dec. Com. 57; Elliott Savage, 3 Dec. Com. 69; An M. Cooley, 3 Dec. Com. 187; John Toulman, 3 Dec. Com. 214; Charles H. Sayer, 3 Dec. Com. 224.

SEC. 4925. Upon the receipt of such application, and the payment of the fees required by law, the commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted.

Statute Revised—July 8, 1870, ch. 230, § 64, 16 Stat. 208.
Prior Statute—July 4, 1836, ch. 357, § 17, 5 Stat. 124.

A notice of an application for an extension of the original patent is sufficient, although it has been surrendered and a reissue granted. Crompton *v.* Belknap Mills, 3 Fish. 536.

The judgment of the commissioner settles conclusively all questions of notice. Crompton *v.* Belknap Mills, 3 Fish. 536; Brooks *v.* Bicknell, 3 McLean. 250; Gear *v.* Grosvenor, 6 Fish. 314; S. C. 1 Holmes, 215; 3 O. G. 380.

SEC. 4926. Upon the publication of the notice of an application for an extension, the commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make the commissioner a full report of the case, stating particularly whether the invention or discovery was new and patentable when the original patent was granted.

Statute Revised—July 8, 1870, ch. 230, § 65, 16 Stat. 208.
Prior Statutes—July 4, 1836, ch. 357, § 17, 5 Stat. 124.—May 27, 1848, ch. 47, § 1, 9 Stat. 231.

SEC. 4927. The commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to the satisfaction of the commissioner that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the commissioner shall make a certificate thereon, renewing and extending the patent for the term of seven years from the expiration of the first term. Such certificate shall be recorded in the patent office, and thereupon such patent shall have the same effect in law as though it had been originally granted for twenty-one years.

Statute Revised—July 8, 1870, ch. 230, § 66, 16 Stat. 208.
Prior Statute—July 4, 1836, ch. 357, § 17, 5 Stat. 124.

The granting of an extended patent is a judicial act. Authority to that end is conferred upon the commissioner of patents. The manner in which it is to be exercised, and the time within which it may be exercised, are prescribed by the act. When an extension is granted in apparent conformity to the act of Congress, the decision of the officer has the attribute of a final judgment. It is not subject to appeal or revision. It can not be shown that the commissioner exceeded or irregularly exercised his authority, except by matter apparent on the face of the patent. Dorsey Co. *v.* Marsh, 6 Fish. 387; s. c. 9 Phila. 395; Clum *v.* Brewer, 2 Curt. 506; Colt *v.* Young, 2 Blatch. 471; Brooks *v.* Bicknell, 3 McLean, 250; Goodyear *v.* Providence Rubber Co. 4 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; Jordan *v.* Dobson, 4 Fish 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533.

The decision of the commissioner is not conclusive as to the right of the

party to whom an extension is granted to obtain it. Brooks *v.* Bicknell, 3 McLean, 250.

The decision of the commissioner in extending a patent is not conclusive upon the question of his jurisdiction to act in a given case. Wilson *v.* Rousseau, 4 How. 646; s. c. 1 Blatch. 3.

The entry of a decision upon the file wrapper provisionally, without being promulgated, will be regarded as a minute of the views of the commissioner, and not as a decision. Wood Paper Co. *v.* Glen Falls Co. 4 Fish. 561; s. c. 8 Blatch. 513.

The expiration of a foreign patent for the same invention forms no objection to the granting of an extension. Tilghman *v.* Mitchell, 4 Fish. 615; s. c. 9 Blatch. 18.

An extension vests an absolute title in the patentee, although he may not have had it at the time of making a surrender and taking a reissue. Potter *v.* Empire Sewing Machine Co. 3 Fish. 474.

A transcript of an extension is sufficient, although it does not state the payment of the fees, the notice or the grounds of the decision. The proceeding is summary, and does not require the same degree of particularity as a judicial record. The function of the commissioner is in its nature judicial. Parties are brought before him, as well those who oppose the extension of the patent as those who apply for it, and evidence on both sides being heard, the commissioner pronounces his judgment. The proceeding, therefore, is not like a tax sale, where every step must be proved, or the title fails, but it is in the nature of a judicial action, where, jurisdiction being acquired, no subsequent errors can affect the title of a purchaser under execution. The courts can not prescribe the form in which duties devolved upon the executive branch of the government shall be performed. They can only say whether enough appears to show that the subject was before the commissioner, and his decision. Brooks *v.* Jenkins, 3 McLean, 452.

An allegation that the patent was extended by the commissioner is substantially supported by proof of an extension by the acting commissioner. A provisional officer, who is invested by law with the functions of the commissioner of patents, is properly described as commissioner so far as the efficacy of his official acts is concerned. Dorsey Co. *v.* Marsh, 6 Fish. 387; s. c. 9 Phila. 395.

The form of an extension, under a special act, may be the same as that in general use. Agawam Co. *v.* Jordan, 7 Wall. 583.

The function of the commissioner in extending a patent is judicial, and his decision is conclusive until it is impeached in a proceeding had directly for that purpose. The extension can not be impeached for fraud not apparent on its face in a collateral proceeding. The regular tribunal is chancery founded on a proceeding by *scire facias*, or by bill or information. Rubber Co. *v.* Goodyear, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; Gear *v.* Grosvenor, 6 Fish. 314; s. c. 1 Holmes, 215; 3 O. G. 380; Crompton *v.* Belknap Mills, 3 Fish. 536; Eureka Co. *v.* Bailey Co. 11 Wall. 488; Mowry *v.* Whitney, 3 Fish. 120; s. c. 4 Fish. 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; Wood Paper Co. *v.* Glen Falls Co. 4 Fish. 324; s. c. 8 Blatch. 513; Tilghman *v.* Mitchell, 4 Fish. 615; s. c. 9 Blatch. 18.

The proof of the alleged fraud in obtaining the extension of a patent must be clear and satisfactory. Goodyear *v.* Providence Rubber Co. 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

A bill to vacate an extension filed after the expiration thereof, will not be entertained, for the extension has ceased to be of any effect, and there remains nothing which can be the subject of a suit. Bourne *v.* Goodyear, 9 Wall. 811; Mowry *v.* Whitney, 5 Fish. 513; s. c. 14 Wall. 434; 1 O. G. 499.

A party who has consented to an act can not afterwards complain of it as a fraud. Goodyear *v.* Providence Rubber Co. 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If a special act extending a patent is procured by fraud, it is nevertheless binding on the courts, and the only remedy is to obtain a repeal. Gibson *v.* Gifford, 1 Blatch. 529.

Practice.

Extensions are not granted, like patents, as a matter of strict right, to which the party is entitled on fulfilling certain requirements; they are more subject to the discretion of the commissioner. Henry Bessemer, 2 Dec. Com. 9; Robert Mushet, 2 Dec. Com. 106; Wm. E. Ward, 2 Dec. Com. 126.

Reason of opposition to an extension must be filed twenty days before the day of hearing, and must not be confounded with the notice of opposition. Christopher Amazeen, 2 Dec. Com. 132.

In any application for extension, absence of satisfactory proof, both of the value and importance of the invention, and of due diligence in introducing it into notice, is a fatal defect. Samuel Falkenberg, 2 O. G. 3; John M. Heck, 1 Dec. Com. 19; Jonathan F. Barrett, 1 Dec. Com. 40; R. W. Lewis, 2 Dec. Com. 8; William P. Maxson, 2 Dec. Com. 87; W. M. Storm, 2 Dec. Com. 97; John F. Boynton, 2 Dec. Com. 125; Samuel A. Knox, 2 Dec. Com. 126; E. W. Sperry, 2 Dec. Com. 139; George Hoyt, 2 Dec. Com. 183; Lydia Moore, 3 Dec. Com. 82; Sylvester Bennett, 3 Dec. Com. 191; W. M. C. Cushman, 3 O. G. 29.

Although the evidence does not give all the information as to the value of the invention, and the diligence of the patentee, which the rules require, yet, if it gives enough to satisfy the commissioner, an extension will be granted. Henry R. Robbins, 3 O. G. 292.

The application of a pioneer, whose invention has been made more practical by subsequent improvement, is regarded with favor. Hymen L. Lipman, 1 O. G. 304; Eli W. Blake, 1 O. G. 605.

Public policy may demand the extension of a patent to be refused on account of claims which the patentee might insist upon on a reissue. T. J. Stealey, 3 Dec. Com. 317.

Where matters have been improperly interpolated in a reissued patent, an extension of it will be refused. John A. Krake, 1 Dec. Com. 100; Mary G. Pratt, 2 Dec. Com. 2; Christian Shunk, 2 Dec. Com. 10; Abner G. Bevin, 2 Dec. Com. 68; Robert H. Fletcher, 3 Dec. Com. 7; Ethan Allen, 5 O. G. 148.

The extension of a patent will be refused where the claim is practically worthless, and the device has gone into extensive use without any effort to obtain a reissue or check notorious infringements. Sarah A. Holmes, Executrix, 2 Dec. Com. 155.

An application for the extension of a patent which has been reissued in several divisions, will be allowed as to one which embraces the same claim substantially as the original patent, and found to be of value: but will be denied as to the others which embrace claims not in the original. Walter

Hunt's Adm'rs, 2 Dec. Com. 29; Levi Bissell, 3 Dec. Com. 207: James R. Floyd, 6 O. G. 541.

When a claim which is allowed to remain on extending a patent, defines the invention by reference to another which is required to be disclaimed, the latter will be understood to remain valid so far as it is connected with the other. S. B. Sexton, 3 O. G. 409.

A patent will not be extended unless it is restricted to the special use described by the device named, if it is one that has been known before in other applications. Sarah Stone, Adm'x, 1 Dec. Com. 48.

Although a patent covering the principle on which a process depends, has already been extended, yet a patent to another person, who first discovered the method of making the principle available, and reduced it to successful practice, will also be extended. Samuel Wetherill, 1 Dec. Com. 87.

A reissued patent will not be extended which claims more than was originated by the patentee. W. W. Lyman, 2 O. G. 705; E. W. Goodale, 1 Dec. Com. 82: S. B. Sexton, 3 O. G. 409.

Although the term for which a patent issued has not elapsed, it can not be extended if it has expired in consequence of the expiring of a foreign patent for the same invention. Ernest Gessner, 3 Dec. Com. 48.

The extension of a patent should not be denied because a previous English patent for the same invention has expired, if the specification in the latter was enrolled less than six months before the application was filed on which the American patent was granted. Apperly & Clissold, 2 Dec. Com. 163; John Neville, 2 Dec. Com. 167; Silas G. Putnam, 2 Dec. Com. 168.

Results are not patentable; therefore, functional claims, or for results, are refused extension. Robert Dick, 2 O. G. 147.

An extension will be refused where the article did not involve invention, or was not new. P. A. Sabbaton, 2 O. G. 703; T. N. Lupton, 1 Dec. Com. 10; John M. Heck, 1 Dec. Com. 19; Samuel Pelton, 1 Dec. Com. 112; W. H. King, 2 Dec. Com. 79; Edwin et al. 2 Dec. Com. 117: Matthew A. Crooker, 2 Dec. Com. 133; John Worsley, 2 Dec. Com. 176; B. T. Babbitt, 3 Dec. Com. 70; Gideon B. Massey, 3 Dec. Com. 213; Lawton & Bliss, 3 O. G. 150; R. A. Stewart, 4 O. G. 665; Francis D. Ballou, 5 O. G. 29; H. H. King, 2 Dec. Com. 79.

An extension may be granted and the question of novelty left for the determination of the courts. A. J. Johnson, 1 O. G. 631.

If the courts have sustained the validity of a patent, and no new references are introduced to the notice of the office, the patent is regarded as unimpeachable, and will be extended Henry Blandy, 2 O. G. 174; George Johnson, Adm'r, 2 Dec. Com. 86; W. W. Lewis, 3 O. G. 92.

If the novelty of the invention has been sustained by the courts, it will be assumed to have been satisfactorily established. Eli W. Blake, 1 O. G. 605.

The extension of a patent will be refused if it be found that the device patented is wanting in novelty, although it has been sustained in two suits at law in which that question was not raised. Mary J. Osborn, Adm'x, 2 Dec. Com. 80; Geo. B. Arnold, 5 O. G. 553.

The question whether an invention was sufficiently perfected when the patent was granted, having been considered at the time, and discussed upon trials in which the patent was sustained, should not be agitated anew upon an application for extension, without good reason. John E. Burrow, 1 Dec. Com. 48.

The novelty of an invention described in a patent for which an extension is prayed, can not be impeached upon the ground that it is described in another patent of nearly the same date, if the grantee in the latter patent has conceded in a written instrument that the applicant is the prior inventor. Thomas J. Chubb, 3 Dec. Com. 233.

An extension may be granted upon *ex parte* affidavits showing that the patentee was the first inventor, although a prior patent had been granted to another. Frederick Nishwitz, 1 O. G. 143.

If it is doubtful whether the inventions shown in a previous patent to the same party were perfected when the prior patent was applied for, an extension will be granted. John Tyler, 2 Dec. Com. 159.

The extension of a patent will be refused, if it appears that the process and machine claimed in the reissues of the patent had been described in a prior printed publication. F. P. E. Carré, 4 O. G. 180.

The extension of a patent will be refused where the applicant has held a previous patent, embodying essentially the same principle. W. G. Creamer, 2 Dec. Com. 133; A. B. Latta, 3 O. G. 349.

Upon an application for extension, in determining whether the alleged invention is new or not, the consideration that the patent has been reissued, and has been extended, and has been sustained in litigation, is of especial weight. Calista E. Cox, 2 O. G. 491.

There can be no extension of an original patent when it has been reissued by the patentee himself, or if he has in any manner assented to such reissue. Henry H. Packer, 2 O. G. 31; Chas. G. Dickinson, 3 O. G. 91.

If one has failed to cure an insufficient specification by reissue during the life of the patent, an extension can not be allowed merely to afford an opportunity. George W. Morse, 6 O. G. 296.

Extended patents should contain only such matters as are proved valuable to the public, and the inventor has no right to an extension of what has no value, that subsequent inventors may not be embarrassed. C. W. Marsh, 2 O. G. 197; Thomas Allender, 1 Dec. Com. 46; Robert M. Wilder, 2 Dec. Com. 40; Darlington & Piper, 2 Dec. Com. 133; John L. Mason, 3 Dec. Com. 182; B. J. Lamothe, 3 Dec. Com. 201; Behr & Mongel, Adm'r, 3 O. G. 292.

If the patentee has made an application for a reissue which has been rejected, he can not ask for an extension on the ground that the invention contains a feature which might be covered by a reissue, where it is the same as that named in the application. Ezra Emmert, 1 O. G. 90.

It is sufficient if, upon an extension, devices are disclaimed, except when used in a certain combination which is new. James A. Woodbury, 1 Dec. Com. 86; Timothy Bailey, 1 Dec. Com. 93; Charles T. Eames, 2 Dec. Com. 47; R. M. Hoe, 2 Dec. Com. 68.

A patent may properly be extended with reference to features in the invention which are not covered by the claims, but which are capable of being embraced in a reissue. Ezra Emmert, 1 O. G. 90.

Phrases intended to extend the scope of an invention, although of genuine import, when they overreach the features of the device, can not be allowed in an extension. M. Smith, 2 O. G. 117; Benjamin F. Avery, 2 Dec. Com. 1.

If other conditions are favorable, it is the established practice of the commissioner to grant extensions of patents having only such defects as may be cured by reissue. Thomas J. Mayall, 4 O. G. 582.

A patent will be extended notwithstanding the claim is too broad, when there is not sufficient time to correct it by a reissue. Mary F. Crocker, Adm'x, 1 Dec. Com. 85.

Diligence.

Where the inventors are themselves the manufacturers of their improvements, but have had their profits decreased by infringers introducing inferior machines into the market, and they have used due diligence in bringing them to justice, it can not be charged that their proper remuneration failed by reason of their own neglect or fault. Henry & F. J. L. Blandy, 2 O. G. 174; Lauris-

ton Towne, 3 Dec. Com. 258; John W. Masury, 4 O. G. 1; Hosea Ball, 2 Dec. Com. 110.

An application for extension will be refused where the failure to receive proper remuneration has arisen mainly from applicant's own fault and neglect. John B. Read, 2 Dec. Com. 137; George W. Morse, 2 Dec. Com. 139.

A patent will not be extended where the patentee has not been diligent in introducing his invention, nor where the affidavits as to the value of the invention are general, and no data are furnished from which it can be estimated. Henry A. Rains, 2 Dec. Com. 82; George U. White, Adm'r, 2 Dec. Com. 160; G. W. Francis, 3 Dec. Com. 268; Wm. M. Draper, 3 O. G. 3.

The question of loyalty or disloyalty during the rebellion has no effect upon the status of the applicant, except so far as it pertains to the question of due diligence in introducing his invention into public use. Geo. W. Morse, 1 O. G. 489; Geo. W. Morse, 1 O. G. 607.

The extension will be refused if the patentee did not use due diligence to introduce the invention into public use. Samuel Falkenberg, 2 O. G. 3.

Extension will not be granted an applicant who has failed to receive a reasonable remuneration in consequence of suffering a foreign patent, previously granted, to run out before its regular determination. Robert Mushet, 2 Dec. Com. 106; Wm. E. Ward, 2 Dec. Com. 126; Jos. E. Boyer, 2 Dec. Com. 130.

SEC. 4928. The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein.

Statute Revised—July 8, 1870, ch. 230, § 67, 16 Stat. 209.
Prior Statute—July 4, 1836, ch. 357, § 17, 5 Stat. 124.

The extension of a patent is a new grant of the exclusive right or monopoly in the subject of the invention. All the rights of assignees or grantees, whether in a share of the patent or to a specified portion of the territory held under it, terminate and become reinvested in the patentee. This clause is a qualification of such exclusive right. It refers to those who are in the use of the patented article at the time of the extension, and is intended to save to them that right which, without the clause, would be vested again exclusively in the patentee. The phrase "the thing patented" as used in the connection here found, with the right simply to use the thing patented, not the exclusive right which would be a monopoly, necessarily refers to the patented machine and not to the invention, and indeed it is in that sense that the expression is to be understood generally throughout the patent law, when taken in connection with the right to use in contradistinction to the right to make and sell. The phrase "to the extent of their respective interests therein" refers to their interests in the thing patented, and in connection with the right simply to use means their interests in the patented machines, be that interest in one or more at the time of the extension. Wilson *v.* Rousseau, 4 How. 646; S. C. 1 Blatch. 3; Woodworth *v.* Sherman, 3 Story, 171; Wilson *v.* Turner, 4 How. 712; Taney, 278.

If that interest was short of the whole of the original term for which the patent was originally issued, it is still to be bounded by it. But if it is an in-

terest in terms designed to be co-extensive with all the interest which the patentee now has or may hereafter acquire, not merely to his present rights *in esse* but with his contingent rights *in posse*, then the section makes that a legal interest which otherwise would be but a mere potential equitable interest to be enforced in equity as a mere right under contract and not as a fixed present vested interest. Woodworth *v.* Sherman, 3 Story, 171; Brooks *v.* Bicknell, 4 McLean, 64.

When a patentee has made and vended to others to be used, one or more of the things patented, to that extent he parts with his exclusive right. He is entitled to but one royalty for a patented machine, and consequently, when he has himself constructed the machine and sold it or authorized another to construct and sell it, or to construct and use and operate it, and the consideration has been paid to him for the right, he has then to that extent parted with his monopoly, and ceased to have any interest whatever in the machine so sold or so authorized to be constructed and operated. Where such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the lifetime of the patent, may continue to use it until it is worn out in spite of any and every extension subsequently obtained by the patentee or his assignee. Bloomer *v.* Millinger, 1 Wall. 340; Blanchard *v.* Whitney, 3 Blatch. 307; Wooster *v.* Seidenberg, 13 Blatch. 88; S. C. 9 O. G. 244.

The patentee under the extension is to be vested with the consequences of the acts of his predecessors. He takes the extension just as it falls to him on the expiration of the original patent from those holding under the original patent, and of course is not to be reinstated in all his original rights in every respect as they stood when the original patent was issued. Goodyear *v.* Honsinger, 3 Fish. 147; S. C. 2 Biss. 1.

The protection which the clause affords is limited to those who have a right to use, and in the construction and operation of the clause it should be limited to the exercise of that particular right, although the persons holding that right may also have held during the original term the exclusive right to use, to make and to vend. This right to use is protected, continued and secured only to the extent of the respective interests of such assignees and grantees therein. If the right to use before the extension was limited, it continues under this clause subject to the same limitation. Day *v.* Union Rubber Co. 3 Blatch. 488; S. C. 20 How. 216.

If a licensee contracts to pay a royalty during the original term and any renewal thereof, he will not be released from his liability upon an extension of the patent. Union Manuf. Co. *v.* Lounsbury, 41 N. Y. 363; S. C. 42 Barb. 125.

If the licensor prohibits the licensee from granting the right to use a machine beyond the original term, a purchaser of a machine from the licensee can not use it during an extended term. Notice to the purchaser of this limitation is not necessary, as the law imposes upon the purchaser the risk as to whether the title of the vendor is such that he can make a valid conveyance as against the real owner. Mitchell *v.* Hawley, 4 Fish. 388; S. C. 6 Fish. 331; 16 Wall. 544; 1 O. G. 306; 3 O. G. 241.

If a party was not rightfully in the enjoyment of the thing patented during the original term of the patent, he has no right to use it during the extended

term, unless he shows that the use is with the license, consent or knowledge of the patentee, or of some person authorized under him to convey the right. Chaffee *v.* Boston Belting Co. 22 How. 217.

A party who buys a machine from an infringer, and then subsequently purchases a territorial right from the patentee, thereby acquires a lawful title to the machine, and may use it after the expiration of the patent. Eunson *v.* Dodge, 18 Wall. 414: S. C. 5 O. G. 95.

An assignee who holds the right to make and use the thing patented may continue to use it after the expiration of the patent, but can not make it for use or for any other purpose. Wood *v.* Railroad Co. 3 Fish 464: S. C. 2 Biss. 62; Hodge *v.* Hudson River R. R. Co. 6 Blatch. 165.

Those who construct machines, or cause them to be constructed, under the authority of the patentee or his assigns, have the same rights as grantees or assignees. Bloomer *v.* Millinger, 1 Wall. 340.

This clause has no reference to the rights or interests of assignees and grantees under the new and extended term. Wilson *v.* Rousseau, 4 How. 646: S. C. 1 Blatch. 3.

The terms of the clause are broad and general, and appropriate enough to secure the just rights of all who can be regarded as assignees or grantees of the right to use the patented invention, whether under a purchase of a machine, or a direct assignment or grant of a limited or unlimited right to use, and the equities of the case and the policy of the patent laws require that the clause should be so construed as to give such security. Day *v.* Union Rubber Co. 20 How. 216; S. C. 3 Blatch. 488; Woodworth *v.* Curtis, 2 W. & M. 524; Woodworth *v.* Cook, 2 Blatch. 151.

The term "the thing patented," as used in connection with the right simply to use, necessarily refers to the patented machine and not to the invention. A licensee of a patented process has no right to use the process after an extension of the patent. Wetherill *v.* Zinc Co. 6 Fish. 50; S. C. 9 Phila. 385; 2 O. G. 471; *vide* Day *v.* Union Rubber Co. 20 How. 216; S. C. 3 Blatch. 488.

Where a process requires a peculiar machine or apparatus for its practice, and the right to each is held by different persons under different patents, the right to use the machine will not give the right to use the process under an extension. Wetherill *v.* Zinc Co. 6 Fish. 50; S. C. 9 Phila. 385; 2 O. G. 471.

The right to use the machine after the expiration of the term is not a mere personal right. It is a right of property. The value of it is attached to the thing used. The machine and the right attached to it may pass by sale, devise or levy of execution, or assignment of an insolvent's effects. Woodworth *v.* Curtis, 2 W. & M. 524.

Between repairing and replacing there is a difference. Form may be given to a piece of any material, so as to produce an original result, or to aid the efficiency of one already known, and that would be the subject for a patent. It would be the right of a purchaser to repair such a thing as that, so as to give to it what was its first shape, if it had been turned from it, or by filing, grinding or cutting, to keep it up to the performance of its original use. But if, as a whole, it should happen to be broken, so that its parts could not be readjusted, or so much worn out as to be useless, then a purchaser can not

make or replace it by another, but he must buy a new one. The doing of either would be entire reconstruction. Wilson v. Simpson, 9 How. 109.

The right to repair may extend to a replacement of an essential part of a combination. It comprehends and permits the resupply of the effective ultimate tool of the invention, which is liable to be often worn out or to become inoperative for its intended effect, which the inventor contemplates would have to be frequently replaced anew during the time that the machine, as a whole, might last. The right to replace is not because the tool is of perishable materials, but because the inventor of the machine has so arranged it as a part of the combination that the machine can not be continued in use without a succession of replacements at short intervals. Unless it were replaced the invention would be of but little use to the inventor or others. The other constituent parts of the invention may not be made with reference to any use of them, which will require them to be replaced. These, without having a definite duration, are contemplated by the inventor to last so long as the materials of which they are formed can hold together in use in such combination. No replacement of them at intermediate intervals is meant or is necessary. They may be repaired as the use may require. With such intention they are put into the structure. So it is understood by a purchaser, and beyond the duration of them a purchaser of the machine has not a longer use. But if another constituent part of the combination is meant to be only temporary in the use of the whole, and to be frequently replaced, because it will not last as long as the other parts of the combination, the inventor can not complain, if he sells the use of the machine, that the purchaser uses it in the way the inventor meant it to be used, and in the only way in which the machine can be used. Such a replacement of temporary parts does not alter the identity of the machine, but preserves it, though there may not be in it every part of its original material. Wilson v. Simpson, 9 How. 109; Farrington v. Commissioners, 4 Fish 216.

If the different parts of a machine are covered by separate patents, the purchase of a machine will not confer upon the purchaser the right to replace one of the parts when it is worn out. Aiken v. Manchester Print Works, 2 Cliff. 435.

When the material of a combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination. Wilson v. Simpson, 9 How 109.

When the wearing or injury is partial, then the repair is restoration and not reconstruction. Repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use. Wilson v. Simpson, 9 How. 109.

A party who purchased a machine during the existence of the original patent is entitled to continue the use of it during the time for which the patent is extended by a special act of Congress, unless there is something in the language of the law requiring a different construction. Bloomer v. McQuewen, 14 How. 539; Bloomer v. Millinger, 1 Wall. 340; Blanchard v. Whitney, 3 Blatch. 307.

If there is no provision in a license beyond the term of the patent, and no

condition is imposed by Congress in favor of the licensee in a special act extending a patent, he has no right under the patent after the expiration of the term. Bloomer *v.* Stolley, 5 McLean, 158.

An assignee has no interest in an extension procured by a special act, unless his rights are expressly mentioned and reserved. Gibson *v.* Gifford, 1 Blatch. 529.

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

Statute Revised—July 8, 1870, ch. 230, § 71, 16 Stat. 209.

Prior Statutes—Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543.—March 2, 1861, ch. 88, § 11, 12 Stat. 248.

The patent allowed by this clause is simply for the design itself, and not for the means of producing the design. Clark *v.* Bousfield, 10 Wall. 133.

To entitle a party to the benefit of this provision, there must be an exercise of the inventive faculty. Mere mechanical skill is insufficient. There must be something akin to genius, an effort of the brain as well as the hand. Northrup *v.* Adams, 2 C. L. B. 84; Wooster *v.* Crane, 2 Fish. 583; S. C. 5 Blatch. 282.

To constitute an inventor of a design it is not necessary that the party should have the manual skill and dexterity to make the drafts. If the ideas are furnished by him for producing the result aimed at, he is entitled to avail of the mechanical skill of others to carry out his contrivance practically. Sparkman *v.* Higgins, 1 Blatch. 205.

It is essential to the validity of a patent for a design, that it should be a new and an original one, but the law does not require that it should be useful. Miller *v.* Young, 33 Ill. 354.

A beautiful appearance is not in itself patentable. The design must be new and original, and the work of invention and genius. Ex parte Frederick G. Neidringhaus, 8 O. G. 279; S. C. 2 McArthur, 149.

A combination of old designs, to be patentable, must produce a new appearance. If the effect produced is simply an aggregation of the old designs, it is not patentable. Northrup *v.* Adams, 2 C. L. B. 84.

A mere design, which is practically a suggestion that a greater degree of inclination of the sides, will make a billiard table more convenient, when other tables already existed, which with a view to the same useful result in kind, were constructed with a similar bevel, is not invention. Collender *v.* Griffith, 11 Blatch. 212; S. C. 3 O. G. 689.

If the patent for a design is not put in evidence, the court can not, without knowing what is patented, adjudge it to be void for want of novelty. Miller *v.* Young, 33 Ill. 354.

The acts of Congress which authorize the grant of patents for designs, were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts. It is a new and original design for a manufacture, whether of metal or other material. A new and orginal design for a bust, statue, bas-relief, or composition in alto or basso relievo; a new or original impression or ornament to be placed on any article of manufacture; a new and original design for the printing of woolen, silk, cotton, or other fabrics; a new and useful pattern, print or picture, to be either worked into or on any article of manufacture; or a new and original shape or configuration of any article of manufacture—it is one or all of these that the law has in view. The thing invented or produced for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious producer of those appearances, the advantages flowing from them. Manifestly, the mode in which those appearances are produced, has very little if anything to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly if not entirely the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration or ornament alone or both conjointly, but in whatever way produced, it is the new thing or product which the patent law regards. To speak of the invention as a combination or process, or to to treat it as such is to overlook its peculiarities. As the acts of Congress embrace only designs applied or to be applied, they must refer to finished products of invention rather than to the process of finishing them, or to the agencies by which they are developed. A patent for a product is a distinct thing from a patent for the elements entering into it, or for the ingredients of which it is composed, or for the combination that causes it. In determining whether two designs are substantially the same, the controlling consideration is the resultant effect. Gorham Manuf. Co. *v.* White, 6 Fish. 94; S. C. 14 Wall. 511; 7 Blatch. 513.

To constitute an infringement, it is not essential that the appearance should be the same to the eye of an expert. Such a test would destroy all the protection which the statute intended to give. There never could be a piracy of a patented design, for human ingenuity has never yet produced a design in all its details exactly like another, so like that an expert could not distinguish them. No counterfeit bank note is so identical in appearance with the true, that an experienced artist can not discern a difference. It is said, an engraver distinguishes impressions made by the same plate. Experts therefore are not the persons to be deceived. Much less than that which would be substantial identity in their eyes, would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, who bring to the examination of the article upon which the design has been placed, that degree of observation which men of ordinary intelligence give. It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled and induced to purchase what is not the article they supposed it to be, the patentee is injured, and that advantage of a market which the patent was granted to secure, is destroyed. The purpose of the patent law must be effected if possible, but plainly it can not be if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, are sufficient to relieve an imitating design from condemnation as an infringement. If in the eye of an ordinary observer, therefore, giving such attention as a purchaser usually gives, two designs are, substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other. Gorham Manuf. Co. *v.* White, 6 Fish. 94; S. C. 14 Wall. 511; 7 Blatch. 513.

The true test of identity of design is sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if insufficient to change the effect upon the eye, will not destroy the substantial identity. An engraving which has many lines, may present to the eye the same picture, and to the mind the same idea or conception as another with much fewer lines. The design, however, would be the same. So, a pattern for a carpet or a print may be made up of wreaths of flowers arranged in a particular manner. Another carpet may have similar wreaths arranged in a like manner, so that none but very acute observers could detect a difference. Yet in the wreaths upon one there may be fewer flowers, and the wreaths may be placed at wider distances from each other. Surely in such a case the designs are alike. The same conception was in the mind of the designer, and to that conception he gave expression. Gorham Manuf. Co. *v.* White, 6 Fish. 94; S. C. 14 Wall. 511; 7 Blatch. 513; Root *v.* Ball, 4 McLean, 177.

What may be Patented.

A device which manifestly is intended for a trade-mark, can not be patented as a design. William Whyte, 3 Dec. Com. 304; William King, 2 Dec. Com. 109.

If a device relates wholly to its mechanical function, and not to ornamenta-

tion, an application for a design patent will be refused. Charles A. Seaman, 4 O. G. 691.

The ordinary use of an article, is a controlling consideration in determining whether or not it presents proper subject-matter for a design patent. Bloomfield Brower, 4 O. G. 450.

A patent will not be granted for a design which is shown in the drawings annexed to a patent already issued for a machine. Alois Kohler, 4 O. G. 53.

The material used, or the mode in which an article is constructed, can not be monopolized under a patent for a design. Walter L. Tyler, 3 Dec. Com. 106.

An application for a patent for a product can not be changed into an application for a patent for a design. George H. Sellars, 2 Dec. Com. 58.

Where the function of a device enters into the claim, a patent for a design will not be given. J. F. Diffenderfer, 2 O. G. 57; Peter C. Parkinson, 3 Dec. Com. 251.

After having obtained a patent for a stove the inventor can not have a patent for a design. Stuart & Bridge, 2 Dec. Com. 15.

New shapes and configurations may be patented as designs, on account of their utility, when that is owing to their form. William N. Bartholomew, 1 Dec. Com. 103.

An old form, when applied to a new article of manufacture, may be considered as a new design. William N. Bartholomew, 1 Dec. Com. 103.

A *mere* substitution of one color for another possesses no element of originality, and indicates no exercise of genius, and can not, therefore, become the subject of a design patent. Philip Weinberg, 3 Dec. Com. 244.

Designs which promote convenience and utility are embraced within the statute, as well as those which are merely ornamental. Jason Crane, 1 Dec. Com. 7; E. R. Fenno, 3 Dec. Com. 52.

When an alteration in any article is calculated to give it a better appearance merely, it can be protected only by a design patent. T. B. Oglesby, 3 O. G. 211.

Practice.

Although the specification of a design patent, embraces a description of the mode in which the article contemplated is constructed, it will not bar a separate patent for such construction. W. N. Bartholomew, 3 Dec. Com. 298.

There is no provision in the act relating to letters patent for designs, which forbids the union of two or more claims or clauses of claim in a single patent. Isaac A. Sheppard, 2 Dec. Com. 22.

All descriptions of the mechanical construction of the article should be eliminated in a design patent, as well as all reference to its purpose as a matter of utility. L. W. Fairchild, 3 O. G. 323.

If the specification and claim are deficient in the requirements of the law respecting clearness, correctness and particularity, an application for a design patent should not be entertained by the examiner. F. G. & W. F. Niedringhaus, 7 O. G. 171.

SEC. 4930. The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

Statute Revised—July 8, 1870, ch. 230, § 72, 16 Stat. 210.

SEC. 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

Statute Revised—July 8, 1870, ch. 230, § 73, 16 Stat. 210.

Prior Statutes—August 29, 1842, ch. 263, § 3, 5 Stat. 543.—March 2, 1861, ch. 88, § 11, 12 Stat. 248.

An applicant for a design patent, must elect at the time of his application, the term for which he desires his patent to issue, and the payment of a fee corresponding to that election. Israel C. Mayo, 2 Dec. Com. 14.

SEC. 4932. Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one.

Statute Revised—July 8, 1870, ch. 230, § 74, 16 Stat. 210.

Prior Statute—March 2, 1861, ch. 88, § 11, 12 Stat. 248.

Upon extending a patent for a design, its utility may be taken into account in estimating its value and importance to the public. B. L. Solomon, 1 Dec. Com. 49.

SEC. 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries, not inconsistent with the provisions of this title, shall apply to patents for designs.

Statute Revised—July 8, 1870, ch. 230, § 76, 16 Stat. 210.

SEC. 4934. The following shall be the rates for patent fees:

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners in chief, ten dollars.

On every appeal from the examiners in chief to the commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them.

Statutes Revised—July 8, 1870, ch. 230, §§ 68, 75, 16 Stat. 209, 210.—March 24, 1871, ch. 5, § 2, 17 Stat. 1.

Prior Statutes—April 10, 1790, ch. 7, § 7, 1 Stat. 112.—February 21, 1793, ch. 11, § 5, 11 Stat. 323.—July 4, 1836, ch. 357, §§ 4, 9, 11, 5 Stat. 118, 121.—March 3, 1839, ch. 88, § 8, 5 Stat. 354.—May 27, 1848, ch. 47, § 2, 9 Stat. 231.—March 2, 1861, ch. 88, § 10, 12 Stat. 248.—June 27, 1866, ch. 143, § 1, 14 Stat. 76.

SEC. 4935. Patent fees may be paid to the commissioner of patents, or to the treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the patent office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever.

Statute Revised—July 8, 1870, ch. 230, § 69, 16 Stat. 209.

Prior Statutes—March 3, 1837, ch. 45, § 14, 5 Stat. 194.—July 20, 1868, ch. 177, § 7, 15 Stat. 119.

SEC. 4936. The treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the treasury, or to any receiver or depositary, to the credit of the treasury, as for fees accruing at the patent office, upon a certificate thereof being made to the treasurer by the commissioner of patents.

Statute Revised—July 8, 1870, ch. 230, § 69, 16 Stat. 209.
Prior Statute—August 29, 1842, ch. 263, § 1, 5 Stat. 543.

CHAPTER TWO.

TRADE-MARKS.

Sec.
4937. Registration of trade-marks authorized.
4938. Accompanying declaration under oath.
4939. Restriction on the registration of trade-marks.
4940. Time of receipt of trade-mark for registration to be certified.
4941. Duration of protection of registered trade-marks, and renewal.
4942. Remedy for infringement of registered trade-marks.
4943. Restriction upon actions for infringement.
4944. Penalty for false registration of trade-marks.
4945. Former rights and remedies preserved.
4946. Saving as to rights after expiration of term for which a trade-mark has been registered.
4947. Regulations for transfer of rights to trade-marks.

SEC. 4937. Any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any State or territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements:

First. By causing to be recorded in the patent office a statement specifying the names of the parties, and their residences and place of business, who desire the protection of the trade-mark; the class of merchandise, and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated; a description of the trade-mark itself, with fac-similes thereof, showing the mode in which it has been or is intended to be applied and used; and the length of time, if any, during which the trade-mark has been in use.

Second. By making payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.

Third. By complying with such regulations as may be prescribed by the commissioner of patents.

Statute Revised—July 8, 1870, ch. 230, § 77, 16 Stat. 210.

The statute does not define the word "trade-mark," or say of what it shall consist. The term is used as though its signification were already well known in the law. Resort must therefore be had to the law outside of the statute to ascertain what is or what may become a lawful trade-mark. Moorman *v.* Hoge, 2 Saw. 78.

If an arbitrary mark or device has been so long used in connection with an article of manufacture, that it has become well known to the trade as designating a particular person's goods, it constitutes a lawful trade-mark. Morrison *v.* Case, 9 Blatch. 548; S. C. 2 O. G. 544.

A simple illustration of a crown in connection with an article, to designate its origin and ownership, is a lawful trade-mark. Smith *v.* Reynolds, 10 Blatch. 100; S. C. 3 O. G. 216.

The name of a town joined to the name of an article is not a legal trade-mark, nor can it be made so by adding the name and place of business of the manufacturer. Armistead *v.* Blackwell, 1 O. G. 603.

The word "centennial" applied to medals generally, is not a good trade-mark. Hartell *v.* Vinez, 2 W. N. 602.

A barrel of peculiar form and dimensions, without any marks, symbols, or devices of any kind impressed upon or connected with it, can not become a trade-mark or a substantive part of a trade-mark. Moorman *v.* Hoge, 2 Saw. 78.

A party can not claim an ornamented tin pail, when used to contain a certain article, as a trade-mark. Harrington *v.* Libby, 4 A. L. T. (N. S.) 47; S. C. 12 O. G. 188.

If a trade-mark is claimed by a firm, it is sufficient to give the name of the firm, without giving the names of the individual members. Smith *v.* Reynolds, 3 O. G. 216; S. C. 6 A. L. T. 38.

A statement of the number in the street, the city, county, and State where the firm is, is a sufficient statement of the residence and place of business of the firm. Smith *v.* Reynolds, 10 Blatch. 100; S. C. 3 O. G. 216.

If a person is engaged in the manufacture and sale of paints generally, a designation of paints as the class of goods intended to be covered by the trade-mark is sufficient without further specification. Smith *v.* Reynolds, 10 Blatch. 100; S. C. 3 O. G. 216.

SEC. 4938. The certificate prescribed by the preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by some member of the firm or officer of the corporation by whom it is filed, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and

that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; and that the description and fac-similes presented for record are true copies of the trade-mark sought to be protected.

Statute Revised—July 8, 1870, ch. 230, § 77, 16 Stat. 210.

The oath annexed to an application for a trade-mark is sufficient, although the seal of the notary is not attached, if that formality is not required by the law of the place where it was administered. Cochran, McLean & Co. 2 O. G. 520.

The statute does not require that the applicant's oath shall be in the exact words of the section. Vidvard & Sheehan, 8 O. G. 143.

If an applicant has not complied specifically with all the requirements of the statute, he will not be entitled to the registration of a trade-mark. Hankinson, 8 O. G. 89.

The law is as imperative in requiring a *description* of the trade-mark as in requiring a fac-simile thereof, and one will not supply the omission of the other. Volta Belt Company, 8 O. G. 144.

SEC. 4939. The commissioner of patents shall not receive and record any proposed trade-mark which is not and can not become a lawful trade-mark, or which is merely the name of a person, firm, or corporation, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public. But this section shall not prevent the registry of any lawful trade-mark rightfully in use on the eighth day of July, eighteen hundred and seventy.

Statute Revised—July 8, 1870, ch. 230, § 79, 16 Stat. 211.

The proceeding before the commissioner is purely *ex parte*. Other parties have no notice, actual or constructive. The decision of the commissioner is not conclusive that the party is entitled to a trade-mark. Moorman *v.* Hoge, 2 Saw. 78.

If a person has registered a trade-mark for a certain article generally, and the same symbol had been in use before he adopted it for certain descriptions thereof, the registration is void, for it is broader than his right. Smith *v.* Reynolds, 10 Blatch. 100; S. C. 3 O. G. 216.

A party who purchases a trade-mark from one partner can not have it registered, for he has not an exclusive right to use it. Armistead *v.* Blackwell, 1 O. G. 603.

No person is entitled to a trade-mark in a numeral which only indicates but does not express the quality of the goods. Kinney *v.* Allen, 4 A. L. T. (N. S.) 258.

If a person uses a numeral of a certain form, size, color and style, he may be entitled to use that as a trade-mark. Kinney *v.* Allen, 4 A. L. T. (N. S.) 258.

Parties who employ a word in an experimental way in five or six instances only, do not thereby gain a title to it as a trade-mark, in opposition to one who has, in the mean time, adopted it and put it into general use. Sternberger *v.* Thalheimer, 3 O. G. 120.

He who was the first to actually adopt and use a trade-mark for the purpose of indicating ownership or proprietorship of the articles to which the mark is applied, is entitled to it as against the person who was the first to suggest and urge its adoption. Swift *v.* Peters, 11 O. G. 1110.

The law does not require a description of every actual and possible matter that can be used in connection with the mark. The thing of value in the matter of registration is the trade-mark itself. No protection is afforded for the use of scrolls, fanciful figures, or other words which are not an essential part of the mark, and a full description of them will not be allowed. William S. Kimball, 11 O. G. 1109.

The production of a judgment establishing the validity of the trade-mark is not essential. The fact that the trade-mark was rightfully in use on the eighth day of July, 1870. may be established by the affidavits of disinterested parties, who have knowledge of the facts, setting forth the length of time the mark has been in notorious use, whether or not it has obtained a commercial value, and is considered by the trade as an indication of the origin and ownership of the articles to which it is affixed. Rubber Clothing Co. 10 O. G. 111.

The right to registration is founded on the adoption of a proper trade-mark, not the property of another party, and the declared intention to use it. Rothschild, 7 O. G. 220.

It is no bar to the registry of a trade-mark that it has already been used as such on articles of a different character. R. W. English, 2 Dec. Com. 142.

It is only necessary that trade-marks shall be so far original as that when known in the market the goods of one merchant or manufacturer may be distinguished from those of another. Porter Blanchard's Sons, 3 Dec. Com. 97; R. J. Roberts, 3 Dec. Com. 100; Dutcher Temple Co. 3 Dec. Com. 248; George E. Glines, 8 O. G. 435; Robert Rohland, 10 O. G. 980.

A word which is descriptive of the quality of the article, can not be used as a trade-mark. Goodyear Rubber Co. 11 O. G. 1062.

When matter that is the proper subject of a trade-mark is apparently claimed by another, the applicant must establish his right to it before he can have it included in a register of a label. Jno. D. Park, 12 O. G. 2.

A combination of two symbols may be registered, although another has previously registered one of them as a trade-mark for the same article. Cornwall et al. 12 O. G. 138.

If a trade-mark is so nearly like that owned by another as to mislead the public, it can not be registered. Coggin, Kidder & Co. 11 O. G. 1109.

An arbitrary combination of numerals, having no other meaning than to distinguish the applicant's goods in the market and indicate to purchasers that

all goods having this mark have one and the same origin, may be used as a trade-mark. Dawes & Fanning, 1 O. G. 27.

The designation "lion," whether used pictorially, or written or printed, is a lawful trade-mark for a medicine for a particular disease. P. G. Weaver, 10 O. G. 1.

The registration of the mere name of a person, firm, corporation, place, or article, or a word or words indicating kind or quality, will be refused. Rowe & Post, 9 O. G. 496; Dundas, Dick & Co. 9 O. G. 538; J. Roach, 10 O. G. 333; Eagle Pencil Co. 10 O. G. 981.

A newly coined word may be registered as a trade-mark, though it is suggestive of the material from which the article stamped with it is made. Francis & Mallon, 3 Dec. Com. 283.

A person has no right to employ a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore with equal right. Pratt & Farmer, 10 O. G. 866.

Generic names and words descriptive of quality are common property, and no one has a right to an exclusive use of them. C. L. Hauthaway, 3 Dec. Com. 284; Solon Palmer, 3 Dec. Com. 289; C. E. Richardson et al. 3 O. G. 120.

Initial letters add nothing to a phrase which is not a lawful trade-mark without them; neither does the addition of a date help it any. J. G. Johnson & Co. 2 O. G. 315; Blakeslee & Co. 3 Dec. Com. 284.

Where the only essential portion of the trade-mark is descriptive and not distinguishing, registration should be denied. B. Graham, 2 O. G. 618; C. L. Hauthaway & Sons, 3 Dec. Com. 97; Robert J. Roberts, 3 Dec. Com. 113; E. Kane & Co. 9 O. G. 105; Dundas, Dick & Co. 9 O. G. 538.

Every emblem or device that can not be divested of its ordinary signification, and would be either descriptive or deceptive, is unlawful as a trade-mark. John F. Tolle, 2 O. G. 415; The American Sardine Co. 3 O. G. 495; American Lubricating Oil Co. 9 O. G. 687; Bennage *v.* Phillippi, 9 O. G. 1159.

A compound trade-mark, one of whose distinguishing features has already been appropriated and registered by another as applied to the same class of merchandise, can not be registered. J. Bush & Co. 10 O. G. 164.

It is no objection to a trade-mark that the several parts of which it is composed have been used separately, provided it is so distinct as not to deceive or mislead the public. Joseph F. Imbs, 10 O. G. 463.

It is sufficient if a trade-mark has an original and a distinctive signification as appertaining to the article. India Rubber Comb Co. 8 O. G. 905.

Phrases which are merely descriptive of the quality of the article, or its destined use, can not be registered as trade-marks. Lawrence & Co. 10 O. G. 163.

An applicant for the registration of a trade-mark may include in his specification either a whole class of merchandise or several specified descriptions thereof. Frank Boehm & Co. 8 O. G. 329.

If an individual permanently ceases to use his trade-mark, and consents to its use and adoption by another, he relinquishes his right to it. Kidd & Co. et al. 5 O. G. 337.

An interference in trade-mark cases can properly be declared in accordance with the usual practice governing interference cases between applications for patents. Lautz Bros. & Co. *v.* Shultz & Co. 9 O. G. 791.

If the applicant is not entitled to the trade-mark, it is not necessary to determine whether another is or not. Swift *v.* Peters, 11 O. G. 1110.

SEC. 4940. The time of the receipt of any trade-mark at the patent office for registration shall be noted and re-

corded. Copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the patent office, certified by the commissioner, shall be evidence in any suit in which such trade-mark shall be brought in controversy.

Statute Revised—July 8, 1870, ch. 230, § 80, 16 Stat. 211.

A certified copy is evidence only that what is shown by it to have been filed was filed. It is not evidence that anything required by the statute to be filed, and not shown by the certificate or by the statement annexed to it to have been filed, was filed. A general certificate of the commissioner can not be taken as evidence that the requirements of the law have been met. Smith *v.* Reynolds, 10 Blatch. 85; S. C. 3 O. G. 213.

The statement required by the statute is a separate and distinct thing from the declaration, and when the statute speaks of certified copies of the statement, it does not thereby include the declaration. Walker *v.* Reid, 2 C. L. B. 133.

A certificate which gives a copy of the statement and shows that a declaration was filed, is sufficient. Walker *v.* Reid, 2 C. L. B. 133.

SEC. 4941. A trade-mark registered as above prescribed, shall remain in force for thirty years from the date of such registration; except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the same time that it becomes of no effect elsewhere. Such trade-mark during the period that it remains in force shall entitle the person, firm, or corporation registering the same, to the exclusive use thereof so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods. And at any time during the six months prior to the expiration of the term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the commissioner of patents. The fee for such renewal shall be the same as for the original registration; and a certificate of such renewal shall be issued in the same manner as for the original registration; and such

trade-mark shall remain in force for a further term of thirty years.

Statute Revised—July 8, 1870, ch. 230, § 75, 16 Stat. 211.

SEC. 4942. Any person who shall reproduce, counterfeit, copy, or imitate any recorded trade-mark, and affix the same to goods of substantially the same descriptive properties and qualities as those referred to in the registration, shall be liable to an action on the case for damages for such wrongful use of such trade-mark, at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use.

Statute Revised—July 8, 1870, ch. 230, § 70 16 Stat. 211.

If the trade-mark is for a combination, there is no infringement unless the whole combination is used. Tucker Manuf. Co. *v.* Boyington, 9 O. G. 455.

If a person who has acquired the exclusive use of a mark for particular kinds of paints, obtains a registration of it as a trade-mark for paints generally, this will not enable him to restrain another from its use upon certain paints to which he had been in the habit of affixing the same mark prior to registration. Smith *v.* Reynolds, 13 Blatch. 458.

The protection given by the statute is to the exclusive use of the trade-mark only so far as regards the particular description of goods set forth in the filed statement as the particular description of goods to or by which the trade-mark has been or is intended to be appropriated. Osgood *v.* Rockwood, 11 Blatch. 310.

It is always a matter of discretion whether to issue an injunction or not in a trade-mark case. Tucker Manuf. Co. *v.* Boyington, 9 O. G. 455.

SEC. 4943. No action shall be maintained under the provisions of this chapter by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

Statute Revised—July 8, 1870, ch. 230, § 84, 16 Stat. 212.

SEC. 4944. Any person who shall procure the registry of any trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark in the

patent office, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such registry or entry, to the person injured thereby; to be recovered in an action on the case.

Statute Revised—July 8, 1870, ch. 230, § 82, 16 Stat. 212.

SEC. 4945. Nothing in this chapter shall prevent, lessen, impeach, or avoid any remedy at law or in equity, which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this chapter had not been enacted.

Statute Revised—July 8, 1870, ch. 230, § 83, 16 Stat. 212.

A person may maintain an action for an infringement of a trade-mark, although it has not been recorded at the patent office, for a trade-mark is property independently of the statute. The act is not obligatory. It offers to manufacturers an opportunity to have their trade-marks recorded, but imposes no penalty or forfeiture of right for neglect to so record them. Rodgers *v.* Philp, 1 O. G. 29.

The recording of a trade-mark does not convey any higher rights than the owner had independently of the statute. Popham *v.* Wilcox, 14 Abb. Pr. (N. S.) 206.

SEC. 4946. Nothing in this chapter shall be construed by any court as abridging or in any matter affecting unfavorably the claim of any person to any trade-mark after the expiration of the term for which such trade-mark was registered.

Statute Revised—July 8, 1870, ch. 230, § 78, 16 Stat. 211.

SEC. 4947. The commissioner of patents is authorized to make rules, regulations, and prescribe forms for the transfer of the right to the use of trade-marks, conforming as nearly as practicable to the requirements of law respecting the transfer and transmission of copyrights.

Statute Revised—July 8, 1870, ch. 230, § 81, 16 Stat. 211.

A stipulation that any breach of the contract by one party shall release the other party from all obligation under the contract, merely enlarges the right of rescission, but does not enable the party to enjoy the fruits of the contract without compensation where he does not elect to rescind, if the stipulation so broken was not so essential to the contract but that the breach can be compensated by damages. Coe *v.* Bradley, 9 O. G. 541.

CHAPTER THREE.

COPYRIGHTS.

Sec.
4948. Copyrights to be under charge of librarian of Congress.
4949. Seal of office.
4950. Bond of librarian.
4951. Annual report.
4952. What publications may be entered for copyright.
4952A. Registration of prints and labels.
4953. Term of copyrights.
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4955. Assignment of copyrights and recording.
4956. Deposit of title and published copies.
4957. Record of entry and attested copy.
4958. Fees.
4958A. Fee for recording and certifying assignments.
4959. Copies of copyright works to be furnished to librarian of Congress.
4960. Penalty for omission.
4961. Postmasters to give receipts.
4962. Publication of notice of entry for copyright prescribed.
4963. Penalty for false publication of notice of entry.
4964. Damages for violation of copyright of books.
4965. For violating copyright of maps, charts, prints, &c.
4966. For violating copyright of dramatic compositions.
4967. Damages for printing or publishing any manuscript without consent of author, &c.
4968. Limitation of action in copyright cases.
4969. Defenses to action in copyright cases.
4970. Injunctions in copyright cases.
4971. Aliens and non-residents not privileged.

SEC. 4948. All records and other things relating to copyrights and required by law to be preserved, shall be under the control of the librarian of Congress, and kept and preserved in the library of Congress; and the librarian of Congress shall have the immediate care and supervision thereof, and, under the supervision of the joint committee of Congress on the library, shall perform all acts and duties required by law touching copyrights.

Statute Revised—July 8, 1870, ch. 230, § 85, 16 Stat. 212.
Prior Statute—February 5, 1859, ch. 22, § 8, 11 Stat. 380.

SEC. 4949. The seal provided for the office of the librarian of Congress shall be the seal thereof, and by it all records and papers issued from the office and to be used in evidence shall be authenticated.

Statute Revised—July 8, 1870, ch. 230, § 85, 16 Stat. 212.

SEC. 4950. The librarian of Congress shall give a bond, with sureties, to the treasurer of the United States, in the sum of five thousand dollars, with the condition that he will render to the proper officer of the treasury a true account of all moneys received by virtue of his office.

Statute Revised—July 8, 1870, ch. 230, § 85, 16 Stat. 212.

SEC. 4951. The librarian of Congress shall make an annual report to Congress of the number and description of copyright publications for which entries have been made during the year.

Statute Revised—July 8, 1870, ch. 230, § 85, 16 Stat. 212.

SEC. 4952. Any citizen of the United States or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph, or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of the models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors may reserve the right to dramatize or to translate their own works.

Statute Revised—July 8, 1870, ch. 230, § 86, 16 Stat. 212.

Prior Statutes—May 31, 1790, ch. 15, § 1, 1 Stat. 124.—April 29, 1802, ch. 36, § 2, 2 Stat. 171.—February 3, 1831, ch. 16, § 1, 4 Stat. 436.—August 18, 1856, ch. 169, § 1, 11 Stat. 138.—March 3, 1865, ch. 126, § 1, 13 Stat. 540.

Subjects of Copyright.

The statute was passed for the encouragement of learning, and was not intended for the encouragement of mere industry, unconnected with learning or science. Clayton *v.* Stone, 2 Paine, 382.

Literary merit is not a necessary element of a legal copyright. Drury *v.* Ewing, 1 Bond, 540.

There may be a valid copyright in the plan of a book as connected with the arrangement and combination of the materials, and the mode of displaying and illustrating the subject, although all the materials employed and the subject of the work may be common to all other writers. Greene *v.* Bishop, 1 Cliff. 186: Emerson *v.* Davies, 3 Story, 768; Boucicault *v.* Fox, 5 Blatch. 87.

A party who first brings together materials drawn from different sources is entitled to a copyright for a compilation. Gray *v.* Russell, 1 Story, 11; Blunt *v.* Patten, 2 Paine, 393.

Where there is nothing immoral or improper in a print itself, the fact that it may be used by persons to violate the law does not of itself deprive it of the protection of the law. To do this it must appear either that there is something immoral, pernicious, or indecent in the thing *per se*, or that it is incapable of any use except in connection with some illegal or immoral act. Richardson *v.* Miller, 15 A. L. J. 340; S. C. 12 O. G. 3.

A dramatic composition which is grossly indecent and calculated to corrupt the morals of the people, is not the proper subject of a copyright. Martinetti *v.* Maguire, 1 Deady, 216; S. C. 1 Abb. C. C. 356.

No reporter can have any copyright in judicial decisions. Wheaton *v.* Peters, 8 Wheat. 591; Little *v.* Gould, 2 Blatch. 165.

A reporter of judicial decisions is entitled to a copyright of his work to the extent of his authorship of the composition contained therein. Little *v.* Gould, 2 Blatch. 165; Little *v.* Gould, 2 Blatch. 362.

Copyrights of the editions of a work other than the original edition, are granted for additions to, emendations of, or improvements in the work, and every copyright should bear date of the day when it was secured. Lawrence *v.* Dana, 7 O. G. 81; S C. 2 A. L. T. (N. S.) 402.

The term "book" does not carry with it the requirement that it shall be printed. A book may exist without printing, and such book, when made or composed, is to be entitled to copyright. Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

The literary property intended to be protected by the act is not to be determined by the size, form or shape in which it makes its appearance, but by the subject-matter of the work. Clayton *v.* Stone, 2 Paine, 382.

A daily or weekly publication of the state of the market is not the subject of a copyright. Clayton *v.* Stone, 2 Paine, 382.

The preliminary steps required by law can not be reasonably applied to a work of so ephemeral a character as a newspaper. Clayton *v.* Stone, 2 Paine, 382.

A book need not be a book in the common and ordinary acceptation of the word, viz., a volume made up of several sheets bound together. It may be printed only on one sheet. Clayton *v.* Stone, 2 Paine, 382: Scoville *v.* Toland, 6 West. L. J. 84; Drury *v.* Ewing, 1 Bond, 540.

A chart which contains a series of diagrams interspersed with printed instructions as to the mode of using them in taking measurements for and cutting garments, is the subject of copyright. Drury *v.* Ewing, 1 Bond, 540.

A label intended for no other use than to be pasted on vials or bottles containing a medicinal preparation, is not the proper subject of a copyright. Scoville *v.* Toland, 6 West. L. J. 84; Coffeen *v.* Brunton, 4 McLean, 516.

A written work consisting wholly of directions set in order for conveying the ideas of the author on a stage or public place by means of characters who represent the narrative wholly by action, is as much a dramatic composition as if language or dialogue were used in it to convey ideas. Daly *v.* Palmer, 6 Blatch. 256.

A spectacular piece which consists almost wholly of scenic effects or representations, and in which the dialogue is very scant and meaningless, is not a dramatic composition. Martinetti *v.* Maguire, 1 Deady, 216; S. C. 1 Abb. C. C. 356.

Playing cards may be a proper subject of copyright. Richardson *v.* Miller, 15 A. L. J. 340; S. C. 12 O. G. 3.

A person who translates a dramatic composition with the consent of the author, is entitled to a copyright. Shook *v.* Rankin, 6 Biss. 477.

A person who deposits in the copyright office, the title of a drama not original with himself, can not secure to himself such title to the exclusion of others who have applied such title to a dramatic composition founded on the same story before the date of such deposit. Benn *v.* Leclercq, 30 Leg. Int. 185.

The musical composition contemplated by the statute, must be substantially a new and original work, and not a copy of a piece already produced, with additions and variations which a writer of music with skill and experience might readily make. Jollie *v.* Jaques, 1 Blatch. 618; Reed *v.* Carusi, Taney, 72.

If an engraving does not involve invention, it is not a subject of copyright. Collender *v.* Griffith, 11 Blatch. 212; S. C. 3 O. G. 689.

A photograph is not a print, cut or engraving. Wood *v.* Abbott, 5 Blatch. 325.

A publication of a new and revised set of rules regularly adopted by the court, is not a republication of the prior rules. Banks *v.* McDivett, 13 Blatch. 163; S. C. 8 O. G. 860.

Parties.

To constitute an author, the person must, by his own intellectual labor, applied to the materials of his composition, produce an arrangement or compilation new in itself. Atwell *v.* Ferrett, 2 Blatch. 39.

No person is entitled to a copyright in alterations and improvements made by others at his procurement and for him. Atwell *v.* Ferrett, 2 Blatch. 39.

No person is entitled to a copyright of an historical print which he did not invent or design, but which was invented, designed and engraved by others, although he employed them to do so. Binns *v.* Woodruff, 4 Wash. 48.

Although an author produces a work while in the general employment of another, yet he will not be deemed to have parted with his right and transferred it to his employer unless there is a valid agreement to that effect. Boucicault *v.* Fox, 5 Blatch. 87.

If an actor agrees with the proprietor to write a drama and allow it to be performed at the theatre so long as it draws good audiences, he is entitled to copyright, and the proprietor is a mere licensee. Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405; Boucicault *v.* Fox, 5 Blatch. 87.

If a person give contributions to the proprietor of a work, the title thereto

is vested in the proprietor as the work is done, to the extent of the gift, and no assignment thereof is necessary. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

If contributions are given to the proprietor of a work, he may take a copyright. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

If contributions are given to be used in one edition of a work, the proprietor acquires no right to use them in any other edition. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

The legal assignee of an author is competent to take out a copyright although he takes it in trust for others. Little *v.* Gould, 2 Blatch. 362.

If a person accepts the office of reporter under a law which prohibits him from having any pecuniary interest therein or taking a copyright therefor, he thereby surrenders his rights as author, and can not confer them on another. Little *v.* Gould, 2 Blatch. 165.

If a person enters the employ of the government under a stipulation that all drawings and sketches made by him shall belong exclusively to it, and Congress orders them to be published, he is not entitled to a copyright. Heine *v.* Appleton, 4 Blatch. 125.

Unless there is a most unequivocal dedication of private letters and papers to the public or to some private person, the author has the exclusive right to a copyright thereof. Folsom *v.* Marsh, 2 Story, 100.

Aliens.

The publisher of the work of a foreign author can secure the exclusive right to such publication only by the voluntary and unconstrained forbearance of the trade. Sheldon *v.* Houghton, 5 Blatch. 285.

The term "resident" means a permanent inhabitant. A mere transient visitant whose family, business, intentions and relations are all abroad can not be considered a resident, and the filing of a declaration of an intention to become a citizen can not make him one. Carey *v.* Collier, 56 Niles Reg. 262.

Residence ordinarily means domicile, or the continuance of a person in a place, having his home there. It is not actually necessary that he shall be the occupant of his own house. He may be a boarder or lodger in the house of another. The main question is as to the intention with which a man or person is staying in a particular place. In order to constitute residence, it is necessary that a man shall go to a place with the intention of remaining, making it his home or place of abode. Boucicault *v.* Wood, 2 Biss. 34; S. C. 16 A. L. Reg. 539.

If a party takes a house in this country with the intention of remaining here, he is a resident, although he may subsequently return to his own country. Boucicault *v.* Wood, 2 Biss. 34; S. C. 16 A. L. Reg. 539.

In order to become a resident, the intention to remain must exist at the time when the party takes up his abode. Boucicault *v.* Wood, 2 Biss. 34; S. C. 16 A. L. Reg. 539.

Infringement.

An author may be said to be the inventor or creator both of the ideas contained in his book and the combination of words to represent them. Before publication he has the exclusive possession of his invention. But when he has published his book and given his thoughts, sentiments, knowledge or discoveries to the world, they become the common property of his readers, who have the right to use them and communicate them to others clothed in their own language, by lecture or treatise. Stowe *v.* Thomas, 2 Wall. Jr. 547; Keene *v.* Clarke, 5 Robt. 38.

The claim of literary property after publication can not be in the ideas or sentiments as dissevered from the language, idiom, style, or the outward semblance and exhibition of them. The author's exclusive property in the creation of his mind is only in the concrete form which he has given to it, and the language in which he has clothed it. When he has sold his book, the only property which he reserves to himself, or which the law gives to him, is the exclusive right to multiply copies of that particular combination of characters which exhibits to the eyes of another the ideas intended to be conveyed. That is what the law terms copy or copyright. Stowe *v.* Thomas, 2 Wall. Jr. 547; Greene *v.* Bishop, 1 Cliff. 186.

In questions of infringement of copyright, the inquiry is not whether the defendant has used the thoughts, conceptions, information or discoveries promulgated by the original, but whether his composition may be considered a new work requiring invention, learning and judgment, or only a mere transcript of the whole or parts of the original, with merely colorable variations. Stowe *v.* Thomas, 2 Wall. Jr. 547.

A translation of an author's ideas and conceptions into another language is not an infringement of a copyright. Stowe *v.* Thomas, 2 Wall. Jr. 547.

If a translator of a dramatic composition obtains a copyright, he can not prevent others from acting a prior translation made with the author's consent in England. Shook *v.* Rankin, 6 Biss. 477.

A fair abridgment of any book is considered a new work, as to write it requires labor and the exercise of judgment. It is only new in the view that the sense of the author is given in a condensed form. Story *v.* Holcombe, 4 McLean, 306; Folsom *v.* Marsh, 2 Story, 100.

Works on law, whether elementary or otherwise, are proper subjects of abridgment. Story *v.* Holcombe, 4 McLean, 306.

There is a clear distinction between a compilation and an abridgment. To abridge requires the exercise of the mind, and that is not copying. To compile is to copy from various authors into one work. An abridgment is a condensation of the views of the author; a compilation consists of selected extracts from different authors. Story *v.* Holcombe, 4 McLean, 306.

It may not be essential to exclude extracts entirely from an abridgment, but in making extracts merely there is no condensation of the language of the author, and consequently there is no abridgment of it. Story *v.* Holcombe, 4 McLean, 306; Folsom *v.* Marsh, 2 Story, 100; Greene *v.* Bishop, 1 Cliff. 186.

A copy of a book must be a transcript of the language in which the conceptions of the author are clothed, of something printed and embodied in a

tangible shape. The same conceptions clothed in another language can not constitute the same composition, nor can it be called a transcript or copy of the same book. Stowe *v.* Thomas, 2 Wall. Jr. 547.

A copy is one thing, an imitation or resemblance another. What degree of imitation constitutes an infringement is a nice question in many cases. Emerson *v.* Davies. 3 Story, 768.

It is not sufficient to show that one work may have been suggested by another, or that some parts and pages of it have resemblances to the other. It must be further shown that the resemblances in those parts and pages are so close, so full, so uniform and so striking as to fairly lead to the conclusion that one is a substantial copy of the other, or mainly borrowed from it. Emerson *v.* Davies, 3 Story, 768.

In order to constitute an invasion of a copyright, it is not necessary that the whole of the work shall be copied, or even a large portion of it, in form or in substance. The entirety of the copyright is the property of the author, and it is no defense that another has appropriated a part and not the whole of any property. Folsom *v.* Marsh, 2 Story, 100; Greene *v.* Bishop, 1 Cliff. 186.

Whether there has been an infringement does not necessarily depend upon the quantity taken. It often depends upon other considerations, the value of the materials taken, and their importance to the sale of the original work. Folsom *v.* Marsh, 2 Story, 100.

If so much is taken that the value of the original is sensibly diminished, or the labors of the author are substantially to an injurious extent appropriated, that is sufficient to constitute a piracy *pro tanto*. Folsom *v.* Marsh, 2 Story, 100; Greene *v.* Bishop, 1 Cliff. 186.

It is not necessary that the infringing book shall be the same, word for word, but a mere alteration of a portion of the book will not deprive the author of the protection given by the law, provided there is a use of the book substantially in all respects. Boucicault *v.* Wood, 2 Biss. 34; s. c. 16 A. L. Reg. 539.

Copying is not confined to literal repetition, but includes the various modes in which the matter of any publication may be adopted, imitated or transferred with more or less colorable alteration to disguise the piracy. Greene *v.* Bishop, 1 Cliff. 186; Drury *v.* Ewing, 1 Bond, 540.

If a copyright is taken of the letters of a famous person, it is a piracy to write a life of him made up mainly by copying certain letters in full. Folsom *v.* Marsh, 2 Story, 100.

In a dramatic composition, the series of events directed in writing by the author in any particular scene is his invention, and a piracy is committed if that in which the whole merit of the scene consists is incorporated in another work without any material alteration in the constituent parts of the series of events, or in the sequence of the events in the series. Daly *v.* Palmer, 6 Blatch. 256.

Movement, gesture and facial expression, which address the eye only, are as much a part of the dramatic composition as is the spoken language which addresses the ear only, and that part of the written composition which gives direction for the movement and gesture is as much a part of the composition, and protected by the copyright, as is the language prescribed to be uttered by the characters. Daly *v.* Palmer, 6 Blatch. 256.

A play which is a mere spectacle, and must be seen to be appreciated, has no value except as it is appreciated by the public. If the result of the exhibition of the original and the alleged infringement is so nearly the same as to produce the impression that they are identical upon ordinary spectators, one should be held to be a mere colorable imitation of the other. Martinetti *v.* Maguire, 1 Deady, 216; s. c. 1 Abb. C. C. 356.

No compiler of a book which is a mere compilation of facts from common and universal sources of information, has a monopoly of the subject of which the book treats. Any other person is permitted to enter that department of literature and make a similar book. But the subsequent investigator must investigate for himself from the original sources which are open to all. He can not use the labors of a previous compiler, *animo furandi*, and save his own time by copying the results of the previous compiler's study, although the same results would have been obtained by independent labor. Banks *v.* McDivett, 13 Blatch. 163; s. c. 8 O. G. 860; Lawrence *v.* Cupples, 9 O. G. 254; Gray *v.* Russell, 1 Story, 11; Blunt *v.* Patten, 2 Paine, 393, 397; Story *v.* Holcombe, 4 McLean, 306; Emerson *v.* Davies, 3 Story, 768; Greene *v.* Bishop, 1 Cliff. 186; Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; s. c. 5 C. L. N. 1.

If the judge prepares the head notes to the reports, the author of a digest made up of such head notes has no ground to complain because another author in his digest uses the same. Chase *v.* Sanborn, 6 O. G. 932.

In case of a dictionary or other work of that kind, similarities and some use of a prior work, even to copying of small parts is allowed, if the main design and execution are in reality novel or improved, and not a mere cover for an important piracy. Webb *v.* Powers, 2 W. & M. 497.

One compiler can not copy the plan or arrangement of another compilation. Story *v.* Holcombe, 4 McLean, 306.

Although the plan or arrangement of a book may be secured to an author, if it is the product of his own genius, yet a mere list of debtors and creditors, with their residences, and the amount and value of their debts, does not possess any such novelty of plan or arrangement as will preclude any other person from making and publishing similar lists from independent sources of information. Lawrence *v.* Cupples, 9 O. G. 254.

The right secured by the act is the property in the literary composition, the product of the mind and genius of the author, and not in the name or title given to it. The title does not necessarily involve any literary composition. It may not be, and the statute does not require that it should be, the product of the author's mind. It is a mere appendage which only identifies, and frequently does not in any way describe, the literary composition itself or represent its character, and if there is no piracy of the book, there is no remedy for the use of the title. Osgood *v.* Allen, 1 Holmes, 185; s. c. 3 O. G. 124; Jollie *v.* Jaques, 1 Blatch. 618; Benn *v.* Leclercq, 30 Leg. Int. 185.

When the title itself is original and the product of the author's own mind, and is appropriated by the infringement, as well as the whole or a part of the literary composition itself, in protecting other portions of the literary composition, the courts will probably also protect the title. Osgood *v.* Allen, 1 Holmes, 185; s. c. 3 O. G. 124.

If a party makes a survey, and deposits it in the navy department, with the understanding that he is to have the exclusive right to publish it, a copy from it will be an infringement. Blunt *v.* Patten, 2 Paine, 393. 397.

No person has the right to publish letters merely because the government bought the manuscript after another had acquired a copyright therein. Folsom *v.* Marsh, 2 Story, 100.

SEC. 4952*a*. (Act of June 18, 1874, ch. 301, § 3, 18 Stat. 79.) That in the construction of this act, the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the commissioner of patents, to the party entering the same.

The claim to a label is void if the label was published before its registration. Marsh *v.* Warren, 24 Pitts. L. J. 207; s. c. 9 C. L. N. 395.

The bill should allege that the title and label were deposited before the publication of the label. Marsh *v.* Warren, 24 Pitts. L. J. 207; s. c. 9 C. L. N. 395.

Matter which may be registered as a trade-mark, can not be registered as a label. Alexius Godillot, 6 O. G. 641.

If matter in a label is purely arbitrary and fanciful in its nature, it should be required to be stricken out before registration. W. Simpson & Sons, 10 O. G. 333.

A print made up of a combination of colors, figures and words, adapted in their use to any goods or merchandise, can be properly registered as a label. Schumacher & Ettinger, 9 O. G. 594.

If the superscription is in its main elements a label, the fact that it contains matter which, taken separately might constitute a trade-mark, is not fatal to its registration. Orcutt & Son, 8 O. G. 277.

SEC. 4953. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

Statute Revised—July 8, 1870, ch. 230, § 87, 16 Stat. 212.

Prior Statutes—May 31, 1790, ch. 15, § 1, 1 Stat. 124.—Feb. 3, 1831, ch. 16, § 1, 4 Stat. 436.

SEC. 4954. The author, inventor, or designer, if he be still living and a citizen of the United States or resident therein, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

Statute Revised—July 8, 1870, ch. 230, § 88, 16 Stat. 212.

Prior Statutes—May 31, 1790, ch. 15, § 1, 1 Stat. 124.—Feb. 3, 1831, ch. 16, §§ 2, 3, 4 Stat. 436, 437.

This section refers to the author and his family, and not to assignees. Pierpont *v.* Fowle, 2 W. & M. 23.

A renewal will not be valid unless there is a valid copyright for the original term. Wheaton *v.* Peters, 8 Pet. 591.

SEC. 4955. Copyrights shall be assignable in law, by any instrument of writing, and such assignment shall be recorded in the office of the librarian of Congress within sixty days after its execution; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

Statute Revised—July 8, 1870, ch. 230, § 89, 16 Stat. 213.

Prior Statute—June 30, 1834, ch. 157, § 1, 4 Stat. 728.

A parol promise for a good consideration, to transfer an interest in a copyright is binding, for the making of the assignment merely concerns the manner of the performance of the promise. Gould *v.* Banks, 8 Wend. 562.

The statute does not say what interest may be assigned, but there is no sufficient reason for preventing an author from conveying a distinct portion of his right. Divisibility as well as assignability enhances the value of his property, for he may find a purchaser able and willing to pay for a part but not for the whole of his copyright. Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

The exclusive right to act and represent a drama is distinct from that of printing and publishing, and may be assigned for certain territory and a limited time. Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

A mere assignment of a copyright will not pass a right to a renewal subse-

quently granted. Pierpont *v.* Fowle, 2 W. & M. 23; Cowen *v.* Banks, 24 How. Pr. 72.

An assignee may maintain an action, although his assignment has never been recorded, for it is valid between the parties. Webb *v.* Powers, 2 W. & M. 497.

A contract to publish a work and give the author a certain price for each copy published, does not give the publisher the sole and exclusive right to publish the work. Willis *v.* Tibbals, 33 N. Y. Sup. 220.

A mere contract for printing and publishing a book does not usually contain anything about the copyright. That is ordinarily retained hy the author unless there is an agreement or understanding that the name of the publisher shall he used for that purpose. Pulte *v.* Derby, 5 McLean, 328.

If a publisher takes a copyright in his own name under a contract to pay a royalty to the author, he holds it for the purposes of the contract, and can not assign the copyright or publish the work except upon the terms of the contract. Pulte *v.* Derby, 5 McLean, 328.

If a contract provides for a first and second edition, and allows the party to print as many as he can sell, the mere fact of inserting the words "third edition" in the title-page of the third impression can not cut off rights expressly given in the agreement. Pulte *v.* Derby, 5 McLean, 328.

If a party who has made a contract with a publisher in his capacity as reporter, is deprived of his office, the legal title to his manuscript not then published, nor given to the publisher for publication, will not vest in the publisher, although the contract stipulated that it should be deemed an assignment of the copyright for all matter furnished under it. Little *v.* Hall, 18 How. 165.

If an author delivers his manuscript to a printer for publication with an agreement that he shall be entitled to the copyright forever, this gives him a right to the renewal. Paige *v.* Banks, 13 Wall. 608; S. C. 7 Blatch. 152.

A contract to reprint any literary work the copyright to which has been secured to the author, is void unless it is entered into with the consent of the author or his assignee, and the printer who executes the contract with knowledge of the rights of the author can not recover anything for his labor. Nichols *v.* Ruggles, 3 Day, 145.

If the joint owners of a copyright make an agreement among themselves in regard to the printing of the work, neither can defeat it by setting up his right as owner to publish. Gould *v.* Banks, 8 Wend. 562.

A relinquishment of a copyright in favor of the State by accepting an office under a statute which so vests it, may be regarded as an assignment by operation of law. Little *v.* Gould, 2 Blatch. 165; Little *v.* Gould, 2 Blatch. 362.

The incorporeal right to multiply copies of a work, being intangible and resting altogether in grant, is not subject to seizure and sale under an execution at common law, but may be reached by a creditor's bill in equity, where the court may compel the debtor to execute an assignment. Stephens *v.* Cady, 14 How. 528.

The property in an engraved plate of a map and the copyright of the map are altogether different and independent of each other, and a sale of the engraved plate under an execution will not give the purchaser a right to print and publish the map. Stephens *v.* Cady, 14 How. 528; Stevens *v.* Gladding, 17 How. 447; S. C. 8 N. Y. Leg. Obs. 297.

If an author sells the copyright and the matter to be printed, and delivers the matter to the vendee, and the consideration is properly delivered or to be delivered to the author or another for his use, or is money to be paid to the author or another for his use, such property or *chose in action* may be subjected to the payment of the author's debts. Cooper *v.* Gunn, 4 B. Mon. 594.

The statute confers upon all the owners full power, without exacting any obligation in return, to print, publish and sell. It gives no superior right to either. Each can exercise his own rights alone, without using or receiving any aid or benefit whatever from the title or property of the others. When one owner at his own expense publishes and sells the book, he is not liable to account to the co-owners for the profits. Carter *v.* Bailey, 64 Me. 458.

SEC. 4956. No person shall be entitled to a copyright unless he shall, before publication, deliver at the office of the librarian of Congress or deposit in the mail addressed to the librarian of Congress, at Washington, District of Columbia, a printed copy of the title of the book or other article, or a description of the painting, drawing, chromo, statue, statuary, or a model or design for a work of the fine arts, for which he desires a copyright, nor unless he shall also, within ten days from the publication thereof, deliver at the office of the librarian of Congress or deposit in the mail addressed to the librarian of Congress, at Washington, District of Columbia, two copies of such copyright book or other article, or in case of a painting, drawing, statue, statuary, model, or design for a work of the fine arts, a photograph of the same.

Statute Revised—July 8, 1870, ch. 230, § 90, 16 Stat. 213.

Prior Statutes—May 31, 1790, ch. 15, § 3, 1 Stat. 125.—February 3, 1831, ch. 16, § 4, 4 Stat. 437.

Congress by the statute created the right, and no protection can be claimed unless its provisions have been complied with. Wheaton *v.* Peters, 8 Pet. 591; Bartlett *v.* Crittenden, 5 McLean, 82; Little *v.* Gould, 2 Blatch. 165: Ewer *v.* Coxe, 4 Wash. 487; Baker *v.* Taylor, 2 Blatch. 82; Jones *v.* Thorne, 1 N. Y. Leg. Obs. 408.

Any person shall be entitled to copyright who before publication, 1st, shall deliver to the librarian a printed copy of the title of the book; and, 2d, shall within ten days after the publication thereof deliver to the librarian two copies of the same. In order to secure a copyright of a book or dramatic composition, the work must be published within a reasonable time after the filing of the title-page, and two copies be delivered to the librarian. Boucicault *v.* Hart, 13 Blatch. 47; *vide* Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

If the publication is made before a deposit of a printed copy of the title, the person is not entitled to a copyright. Baker *v.* Taylor, 2 Blatch. 82; Chase *v.* Sanborn, 6 O. G. 932; Struve *v.* Schwedler, 4 Blatch. 23; Parkinson *v.* Lasalle, 3 Saw. 331.

A sale naturally imports publication. As a purchaser has a right to know the contents of a book and make them known to others, the presumption is that a publication followed a sale. Baker *v.* Taylor, 2 Blatch. 82.

The right accrues from the time a copy of the title of the book is deposited in the librarian's office. Wheaton *v.* Peters, 8 Pet. 591.

No copyright is valid unless two copies of the book are delivered to the librarian of Congress within the prescribed time. Wheaton *v.* Peters, 8 Pet. 591; Chase *v.* Sanborn, 6 O. G. 932; Struve *v.* Schwedler, 4 Blatch. 23; Parkinson *v.* Lasalle, 3 Saw. 331; *vide* Jollie *v.* Jaques, 1 Blatch. 618; Nichols *v.* Ruggles, 3 Day, 145.

If the work consists of several volumes, the delivery of the copies of the first volume within the prescribed time, and of the copies of the other volumes before any piracy is committed, or any action is brought therefor, is sufficient. Dwight *v.* Appleton, 1 N. Y. Leg. Obs. 195.

If there has been no publication, no copies of the book need be deposited with the librarian. Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

SEC. 4957. The librarian of Congress shall record the name of such copyright book or other article, forthwith, in a book to be kept for that purpose, in the words following: "Library of Congress, to wit: Be it remembered that on the day of , A. B., of , hath deposited in this office the title of a book [map, chart or otherwise, as the case may be, or description of the article], the title or description of which is in the following words, to wit: [here insert the title or description,] the right whereof he claims as author [originator, or proprietor, as the case may be,] in conformity with the laws of the United States respecting copyrights. C. D., librarian of Congress." And he shall give a copy of the title or description, under the seal of the librarian of Congress, to the proprietor, whenever he shall require it.

Statute Revised—July 8, 1870, ch. 230, § 91, 16 Stat. 213.

Prior Statutes—May 31, 1790, ch. 15, § 3, 1 Stat. 125.—Feb. 3, 1831, ch. 16, § 4, 4 Stat. 437.

A copy of the record is *prima facie* evidence that a printed title was deposited. Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

SEC. 4958. The librarian of Congress shall receive, from the persons to whom the services designated are rendered, the following fees:

First. For recording the title or description of any copyright book or other article, fifty cents.

Second. For every copy under seal of such record actually given to the person claiming the copyright, or his assigns, fifty cents.

Third. For recording any instrument of writing for the assignment of a copyright, fifteen cents for every one hundred words.

Fourth. For every copy of an assignment, ten cents for every one hundred words.

All fees so received shall be paid into the treasury of the United States.

Statute Revised—July 8, 1870, ch. 230, § 92, 16 Stat. 213.
Prior Statute—June 30, 1834, ch. 157, § 2, 4 Stat. 728.

SEC. 4958*a*. (Act of June 18, 1874, ch. 301, § 2, 18 Stat. 79.) That for recording and certifying any instrument of writing for the assignment of a copyright, the librarian of Congress shall receive from the persons to whom the service is rendered, one dollar; and for every copy of an assignment, one dollar; said fee to cover, in either case, a certificate of the record, under seal of the librarian of Congress; and all fees so received shall be paid into the treasury of the United States.

SEC. 4959. The proprietor of every copyright book or other article shall deliver at the office of the librarian of Congress, or deposit in the mail addressed to the librarian of Congress at Washington, District of Columbia, within ten days after its publication, two complete printed copies thereof, of the best edition issued, or description or photograph of such article as hereinbefore required, and a copy of every subsequent edition wherein any substantial changes shall be made.

Statute Revised—July 8, 1870, ch. 230, § 93, 16 Stat. 213.

Prior Statutes—May 31, 1790, ch. 15, § 4, 1 Stat. 125.—Feb. 3, 1831, ch. 16, § 4, 4 Stat. 437.—Aug. 10, 1846, ch. 178, § 10, 9 Stat. 106.—March 3, 1865, ch. 126, §§ 2, 4, 13 Stat. 540.—Feb. 18, 1867, ch. 43, § 2, 14 Stat. 395.

SEC. 4960. For every failure on the part of the proprietor of any copyright to deliver or deposit in the mail either of the published copies, or description or photograph, required by sections four thousand nine hundred and fifty-six, and four thousand nine hundred and fifty-nine, the proprietor of the copyright shall be liable to a penalty of twenty-five dollars, to be recovered by the librarian of Congress, in the name of the United States, in an action in the nature of an action of debt, in any district court of the United States, within the jurisdiction of which the delinquent may reside or be found.

Statute Revised—July 8, 1870, ch. 230, § 94, 16 Stat. 213.
Prior Statutes—March 3, 1865, ch. 126, § 3, 13 Stat. 540.—Feb. 18, 1867, ch. 43, § 1, 14 Stat. 395.

SEC. 4961. The postmaster to whom such copyright book, title or other article is delivered, shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination.

Statute Revised—July 8, 1870, ch. 230, § 96, 16 Stat. 214.
Prior Statute—Feb. 18, 1867, ch. 43, § 2, 14 Stat. 395.

SEC. 4962 (Act of June 18, 1874, ch. 301, § 1, 18 Stat. 78.) That no person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published, on the title-page or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design, intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz.: "Entered according to act of Congress, in the year ——, by A. B., in the office of the librarian of Congress, at Washington; or, at his option the word "copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out; thus—"Copyright, 18—, by A. B."

Statute Revised—July 8, 1870, ch. 230, § 97, 16 Stat. 214.
Prior Statutes—April 29, 1802, ch. 36, § 1, 2 Stat. 171.—Feb. 3, 1831, ch. 16, § 5, 4 Stat. 437.

Instead of this section being a limitation of the acts to be performed or alleged in order to entitle a party to maintain an action, it imposes an additional duty upon him as a prerequisite to its maintenance. He must first acquire a copyright under the other provisions of the act, and then in order to enforce his right against infringers, he must also give notice of his right by the means prescribed by this section. Parkinson *v.* Lasalle, 3 Saw. 331.

The number of volumes in which it is stated that a work will be published, forms no part of the title, and may be rejected as surplusage. Another edition may be published in a different number of volumes, with the same entry, without impairing the copyright. Dwight *v.* Appleton, 1 N. Y. Leg. Obs. 195.

If an entire work, embracing a complete system, is composed of several volumes, it is sufficient if the entry is made on the first volume. Dwight *v.* Appleton, 1 N. Y. Leg. Obs. 195.

The omission to cause the date of the entry of a map to be engraved on some visible portion thereof, will prevent a recovery. King *v.* Force, 2 Cranch C. C. 208.

When the required notice is plainly engraved on the plate of an engraving from which the print is taken within the line of a reasonable margin, and where it will not be covered when properly framed, it is impressed on the face within the meaning of the statute. Rossiter *v.* Hall, 5 Blatch. 362.

If a second edition of a map has the proper notice engraved on the face thereof, the use of a different year in the title will not vitiate the copyright. Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; S. C. 5 C. L. N. 1.

Notice that copyright is secured is full protection for the original edition throughout its term, but is no protection to a second edition with notes, nor to any succeeding edition with improvements. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

Neglect to give notice that copyright is secured in a second edition will not vitiate the copyright of the original edition, if that was regularly secured. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

Subsequent editions, without alterations or additions, should give the same notice that the copyright is secured as the original edition. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

Successive editions, with additions or alterations, need not specify the date of the original copyright. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

A copyright of a second edition will not cure material defects in the copyright of the original edition. Lawrence *v.* Dana, 7 O. G. 81; S. C. 2 A. L. T. (N. S.) 402.

SEC. 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, musical composition, print, cut, engraving, or photograph, or other article, for which he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person

who shall sue for such penalty, and one-half to the use of the United States.

Statute Revised—July 8, 1870, ch. 230, § 98, 16 Stat. 214.
Prior Statutes—April 29, 1802, ch. 36, § 4, 2 Stat. 172.—Feb. 3, 1831, ch. 16, § 11, 4 Stat. 438.

This section does not authorize an action in the name of several persons and the United States for the recovery of the penalties incurred by its violation. The plain language and sense of the statute restricts the right of action to a single person. Ferrett *v.* Atwill, 1 Blatch. 151.

If the plaintiff brings several actions, and the defendant files a demurrer in each, the court will not, on the motion of the plaintiff, order an argument of the demurrer in one of the cases and stay all proceedings in the mean time in the other cases, to abide the event of the one to be argued. Ferrett *v.* Atwill, 1 Blatch. 151.

SEC. 4964. Every person who, after the recording of the title of any book as provided by this chapter, shall within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, print, publish, or import, or knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such book, shall forfeit every copy thereof to such proprietor, and shall also forfeit and pay such damages as may be recovered in a civil action by such proprietor in any court of competent jurisdiction.

Statute Revised—July 8, 1870, ch. 230, § 99, 16 Stat. 214.
Prior Statutes—May 31, 1790, ch. 15, §§ 2, 6, 1 Stat. 124, 125.—Feb. 3, 1831, ch. 16, § 6, 4 Stat. 437.

The mere recording of the title does not entitle the party to protection for a book not yet made, for the act says a book, but not an intended book. Centennial Catalogue Co. *v.* Porter, 2 W. N. 601.

An action on the case is the appropriate remedy. Atwill *v.* Ferrett, 2 Blatch. 39.

The words "a copy of a book," naturally import a transcript or copy of the entire book. They do not include cases of copying parts of a book, but only the republication of the whole. Rogers *v.* Jewett, 22 Law Rep. 339.

SEC. 4965. If any person, after the recording of the title of any map, chart, musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a

work of the fine arts, as provided by this chapter, shall, within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, or import, either in whole or in part, or by varying the main design with intent to evade the law, or, knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; one-half thereof to the proprietor and the other half to the use of the United States.

Statute Revised—July 8, 1870, ch. 230, § 100, 16 Stat. 214.

Prior Statutes—May 31, 1790, ch. 15, § 2, 1 Stat. 124.—April 29, 1802, ch. 36, § 3, 2 Stat. 171.—Feb. 3, 1831, ch. 16, § 7, 4 Stat. 438.

As the penalty accrues one-half to the proprietor and one-half to the United States, it is a proper subject only of a *qui tam* action. Stevens *v.* Cady, 2 Curt. 200.

A photograph is an infringement of a copyrighted engraving. The word "copy" is a general term added to the more specific terms before used, for the very purpose of covering methods of reproduction not included in the words engrave, etch, or work. Rossiter *v.* Hall, 5 Blatch. 362.

The penalty of one dollar for every sheet, whether printed, or being printed or published, or exposed to sale, is limited to sheets in the possession of the defendant. Backus *v.* Gould, 7 How. Pr. 798.

SEC. 4966. Any person publicly performing or representing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns, shall be liable for damages therefor, such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court shall appear to be just.

Statute Revised—July 8, 1870, ch. 230, § 101, 16 Stat. 214.

Prior Statute—Aug. 18, 1856, ch. 169, § 1, 11 Stat. 138.

The object of this section is to secure to the author of a copyrighted play the sole right to its performance after it is printed. While it is in manuscript he needs no protection. Boucicault *v.* Fox, 5 Blatch. 87; Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

A publication of a dramatic composition after the filing of the title is a violation of this section. Boucicault *v.* Hart, 13 Blatch. 47.

The exclusive right to perform a dramatic composition under the statute depends upon a copyright. There is no such right if there is no copyright. Boucicault *v.* Hart, 13 Blatch. 47.

A composition is a written or literary work invented and set in order. A dramatic composition is such a work in which the narrative is not related, but is represented by dialogue and action. When a dramatic composition is represented in dialogue and action by persons who represent it as real by performing or going through with the various parts or characters assigned to them severally, the composition is performed, acted or represented, and if the representation is in public, it is a public representation. Daly *v.* Palmer, 6 Blatch. 256.

To act is to represent as real by countenance, voice or gesture that which is not real. A character in a play who goes through with a series of events on the stage without speaking, if such be his part in the play, is none the less an actor in it than one who, in addition to motions and gestures, uses his voice. Daly *v.* Palmer, 6 Blatch. 256.

An action may be maintained for a representation after the recording of the title, but before publication as well as after publication. Boucicault *v.* Wood, 2 Biss. 34; S. C. 16 A. L. Reg. 539.

If an author receives compensation for permitting the representation of a play after the deposit of the title, he will not lose his right of action merely in consequence of the non-publication of the play. Boucicault *v.* Wood, 2 Biss. 34; S. C. 16 A. L. Reg. 539.

If an author, after depositing the title of a play with the librarian of Congress, consents to its publication in a foreign country prior to the publication here, any manager has the right to import the play and use it on the stage, for this is an abandonment of his rights under our laws. Boucicault *v.* Wood, 2 Biss. 34; S. C. 16 A. L. Reg. 539.

Whenever the identity, resemblance, or dissimilarity of written or printed documents is sought to be established, the documents themselves must be produced. Boucicault *v.* Fox, 5 Blatch. 87.

If the alleged prior book alone is produced without the play, a witness can not be asked whether the scenery, incidents and language are not substantially the same as those in the play. Boucicault *v.* Fox, 5 Blatch. 87.

If neither the play nor the book from which it is alleged to have been dramatized are put in evidence, no evidence can be given of a part of the book, nor can a witness be asked whether such part is identical with or resembles passages in the play. Boucicault *v.* Fox, 5 Blatch. 87.

If evidence has been taken, the court can not direct a nonsuit. Boucicault *v.* Fox, 5 Blatch. 87.

In determining whether an author assented to the representation of his

play, his silence while the piece is being performed may be considered in connection with the other evidence. Boucicault *v.* Fox, 5 Blatch. 87.

SEC. 4967. Every person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained, if such author or proprietor is a citizen of the United States, or resident therein, shall be liable to the author or proprietor for all damages occasioned by such injury.

Statute Revised—July 8, 1870, ch. 230, § 102, 16 Stat. 215.
Prior Statute—February 3, 1831, ch. 16, § 9, 4 Stat. 438.

The word "manuscript" does not include a picture. A picture is the thing itself, but a manuscript is only a description of it in language, and leaves the mind of the reader to make the picture. Parton *v.* Prang, 2 O. G. 619; S. C. 6 A. L. T. 105.

A surreptitious publication of a substantial part of a manuscript is within the principle of the statute. Bartlett *v.* Crittenden, 5 McLean, 32.

If the author is a non-resident alien, his assignee is not entitled to protection under the statute. Keene *v.* Wheatley, 4 Phila. 157; S. C. 9 A. L. Reg. 331.

The jurisdiction of the Federal courts is confined to cases of threatened or actual printing and publication, and probably does not include the public performance of a manuscript play. Boucicault *v.* Fox, 5 Blatch. 87.

Right at Common Law.

The right of an author in his manuscript at common law has not been taken away or abridged by the statute relating to copyright. Woolsey *v.* Judd, 4 Duer, 379; Crowe *v.* Aiken, 2 Biss. 215; S. C. 4 A. L. Rev. 456; Jones *v.* Thorne, 1 N. Y. Leg. Obs. 408.

An author at common law has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy endeavors to realize a profit by its publication. Wheaton *v.* Peters, 8 Pet. 591; Bartlett *v.* Crittenden, 5 McLean, 82; Paige *v.* Banks, 13 Wall. 608; S. C. 7 Blatch. 152.

The exclusive right of an author in a manuscript yet unpublished rests solely upon the right which every man has to the exclusive possession and control of the products of his own labor. Woolsey *v.* Judd, 4 Duer, 379; Grigsby *v.* Breckenridge, 2 Bush, 480.

The right of the author is not confined to the material on which his manuscript is written. The exclusive right is the right of property in the words, thoughts and sentiments which in their connection form the written composition which his manuscript embodies and preserves. Woolsey *v.* Judd, 4 Duer, 379.

The right of property in the author of a manuscript is absolute and unlimited. As owner he has an absolute right to suppress as well as to publish. Woolsey *v.* Judd, 4 Duer, 379.

An author of a literary work or composition has a right to the first publication of it. He has a right to determine whether it shall be published at all, and if published, when, where, by whom, and in what form. Palmer *v.* De Witt, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

An author's property in his manuscript is not distinguishable from any other personal property. It is governed by the same rules of transfer and succession. It is personal like other movable property, following the person of the owner, and is governed by the law of his domicile. Palmer *v.* De Witt, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

After publication an author's exclusive right to his manuscript ceases at common law. Such publication may be either by words, writing, printing, lectures, sermons, or dramatic representation. If in any of these modes the public become possessed of the contents of a manuscript, without restrictions express or implied, it is such a publication as divests the author of an exclusive property in the work. Palmer *v.* De Witt, 5 Abb. Pr. (N. S.) 130; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

A publication may be limited or general. It is general, whenever the communication effecting it is not restricted, both as to the persons to whom, and the purpose for which it is made. When general, it is a dedication to the public for such unlimited uses, including all modes of publishing and republishing, as it may be the means of directly or secondarily enabling any person to make. Keene *v.* Wheatley, 4 Phila. 157; s. c. 9 A. L. Reg. 331.

Publication is circulation before the public eye by printing or multiplied copies in writing. Grigsby *v.* Breckinbridge, 2 Bush, 480.

An author retains his right in his manuscript, until he relinquishes it by contract or some unequivocal act indicating an intent to dedicate it to the public. Palmer *v.* Dewitt, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

When a literary work is exhibited for a particular purpose, or to a limited number of persons, it will not be construed as a general gift or authority for any purpose of profit or publication by others. Palmer *v.* De Witt, 47 N. Y. 532; s. c. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

If an author permits copies of his manuscript to be taken for the gratification of his friends, he does not authorize them to print it for general use. Bartlett *v.* Crittenden, 4 McLean, 300.

The mere use of a manuscript for the purpose of imparting instruction to pupils, does not constitute an abandonment of it, although they were required or permitted to make copies for that purpose. Bartlett *v.* Crittenden, 5 McLean, 82; Bartlett *v.* Crittenden, 4 McLean, 300.

The right of property in a manuscript may be abandoned the same as any other right of property. Bartlett *v.* Crittenden, 5 McLean, 82.

The intention to publish is only material on the question of abandonment. Bartlett *v.* Crittenden, 5 McLean, 82.

An unqualified publication by printing and offering for sale, is a dedication

to the public. Palmer *v.* DeWitt, 47 N. Y. 532; S. C. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 113; 2 Sweeny, 530.

A person who has been employed by the State to make surveys and explorations, or to act as draughtsman for a party doing such work, has no right to publish a map from materials so collected. Comm. *v.* Desilver, 3 Phila. 31.

The owner of a manuscript copy of a map which has been dedicated to the public, can not interfere by injunction or otherwise with the right of others to make a copy from manuscripts owned by them, or to put them to any use desired. Rees *v.* Peltzer 75 Ill. 475.

If the manuscript contains the framework of a system, it will be protected although it is incomplete. Bartlett *v.* Crittenden, 4 McLean, 300.

An abstract book which contains a complete history of the title and incumbrances to land in a certain locality, can not be published without the consent of the compiler. Banker *v.* Caldwell, 4 Minn. 94.

If the author of a map gives a copy of it to a municipal corporation for public use, and sells copies to others for their use without restriction, this is such a publication as to deprive him of his proprietorship in the literary property. Rees *v.* Peltzer, 75 Ill. 475.

If the bill alleges that the defendant wrongfully obtained possession of the complainant's manuscript and stereotype plates and published the work, it will be dismissed, for there is ample remedy at law. Monk *v.* Harper, 3 Edw. Ch 109.

A manuscript, however valuable, can not be seized by the author's creditors as property. Bartlett *v.* Crittenden, 5 McLean, 82.

A sheriff who has levied an execution upon an unpublished work, has no right to make copies thereof in the interval between the levy and the sale. The debtor's ownership is not divested by a levy, and the sheriff merely has the custody. Banker *v.* Caldwell, 4 Minn. 94.

The protection afforded by the common law to literary labor, is accorded to alien friend and citizen alike. Palmer *v.* De Witt, 47 N. Y. 532; S. C. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

Dramatic Compositions.

A manuscript of a dramatic composition is equally under the protection of the law with any other work. Keene *v.* Kimball, 23 Law Rep. 669.

The rights of an author of a drama in his composition are two-fold. He is entitled to the profit arising from its performance, and also from the sale of the manuscript or the printing and publishing it. Palmer *v.* DeWitt, 47 N. Y. 532; S. C. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

The permission to act a play at a public theatre, does not amount to an abandonment by an author of his title to it, or to a dedication of it to the public. Palmer *v* De Witt, 47 N. Y. 532; S. C. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr (N. S.) 13; 2 Sweeny, 530.

The performance of a play in public, with the consent of the author, for a compensation, is no evidence of his abandonment of the manuscript to the

public. Boucicault *v.* Fox, 5 Blatch. 87; *contra*, Keene *v.* Kimball, 82 Mass. 545; S. C. 23 Law Rep. 339.

A performance of a play at a theatre is a general publication. Keene *v.* Wheatley, 4 Phila. 157; S. C. 5 A. L. Reg. 331.

If a general publication of a play does not enable others to represent it through a retention of the words in their memory, the author's proprietorship continues. Keene *v.* Wheatley, 4 Phila. 157; S. C. 9 A. L. Reg. 331; Boucicault *v.* Wood, 2 Biss. 34; S. C. 16 A. L. Reg. 539; Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg Int. 405; Keene *v.* Clarke, 5 Robt. 38; Crowe *v.* Aiken, 2 Biss. 215; S. C. 4 A. L. Rev. 450; *vide* Keene *v.* Kimball, 82 Mass. 545; S. C. 23 Law Rep. 339.

If a play is represented in public, and a spectator retains it by memory alone and publishes it, the exclusive right is gone. Palmer *v.* De Witt, 5 Abb. Pr. (N. S.) 130; S. C. 36 How. Pr. 222; 40 How. Pr. 293; 5 Abb. Pr. (N. S.) 13; 2 Sweeny, 530.

The evidence must clearly establish the fact that the copy of the play was produced from memory, and negative any other conclusion. Crowe *v.* Aiken, 2 Biss. 215; S. C. 4 A. L. Rev. 450.

A spectator of a play has no right to cause its reproduction by phonographic or other *verbatim* reports, independent of memory. Keene *v.* Clarke, 5 Robt. 38; Crowe *v.* Aiken, 2 Biss. 215; S. C. 4 A. L. Rev. 450.

An intent to abandon a dramatic composition to the public, is inferable from frequent and continued representations for a long time and at different places. Keene *v.* Clarke, 5 Robt. 38; Keene *v.* Kimball, 82 Mass. 545; S. C. 23 Law Rep. 339.

A play once published by its author may be represented on the stage by any person without infringement upon the author's right. Keene *v.* Kimball, 82 Mass. 545; S. C. 23 Law Rep. 339.

Letters.

The author of any letter, whether it is a literary composition, or a familiar letter, or a letter of business, possesses the sole and exclusive copyright therein. Folsom *v.* Marsh, 2 Story, 100; Woolsey *v.* Judd, 4 Duer, 379; Grigsby *v.* Breckenridge, 2 Bush, 480; Denis *v.* Leclerc, 1 Orleans T. R. 297; *contra*, Wetmore *v.* Scovill, 3 Edw. Ch. 515; Hoyt *v.* Mackenzie, 3 Barb. Ch. 314.

By sending a letter the author parts with his right to the possession, control, or reclamation thereof, without the consent of the receiver, and gives the latter the exclusive right to read and keep it. Grigsby *v.* Breckenridge, 2 Bush, 480.

The author has a right to publish the letter, if he keeps or can procure a copy; but the recipient is not bound to keep the original for his transcription, inspection, or other use. Grigsby *v.* Breckenridge, 2 Bush, 480.

The possession of a letter addressed to the christian name of the possessor is *prima facie* evidence of title and ownership. Tefft *v.* Marsh, 1 W. Va. 38.

The recipient of a letter has a right to keep it, or destroy it, or dispose of

it in any other way than by publication. Grigsby *v.* Breckenridge, 2 Bush, 480.

The recipient may read a letter to a friend, or deposit it for safe-keeping, without violating the author's right of publication. Grigsby *v.* Breckenridge, 2 Bush, 480.

A person to whom a letter is addressed has no right to publish it, except to protect or vindicate himself. Folsom *v.* Marsh, 2 Story, 100.

The government has the right to give publicity to letters addressed to any of the departments by a public officer, even against the will of the writer. Folsom *v.* Marsh, 2 Story, 100.

A *feme covert* has the right, as between herself and her husband, to keep and dispose of a confidential letter addressed to her, and not affecting his rights, regardless of his will, whether received before or after marriage. Grigsby *v.* Breckenridge, 2 Bush, 480.

A *feme covert*, when she is about to die, may give and deliver a letter addressed to her to another, and after such alienation the letter will not constitute any portion of her estate which can pass to her executor or administrator. Grigsby *v.* Breckenridge, 2 Bush, 480.

Although letters pass to an executor or administrator, yet they are not assets in his hands which may be sold to pay debts, but come to his possession solely for the purpose of being transferred to the widow or next of kin. Eyre *v.* Higbee, 22 How. Pr. 198; S. C. 35 Barb. 502.

SEC. 4968. No action shall be maintained in any case of forfeiture or penalty under the copyright laws, unless the same is commenced within two years after the cause of action has arisen.

Statute Revised—July 8, 1870, ch. 230, § 104, 16 Stat. 215.

Prior Statutes—May 31, 1790, ch. 15, § 2, 1 Stat. 124.—April 29, 1802, ch. 36, § 4, 2 Stat. 172.—February 3, 1831, ch. 16, § 13, 4 Stat. 439.

Although the plates were engraved more than two years before the institution of the suit, yet every printing for sale is a new infraction of the right, and if such printing was within two years before the suit was brought, the defendant is liable. Reed *v.* Carusi, Taney, 72.

SEC. 4969. In all actions arising under the laws respecting copyrights, the defendant may plead the general issue, and give the special matter in evidence.

Statute Revised—July 8, 1870, ch. 230, § 105, 16 Stat. 215.

Prior Statutes—May 31, 1790, ch. 15, § 6, 1 Stat. 126.—February 3, 1831, ch. 16, § 10, 4 Stat. 438.

SEC. 4970. The circuit courts, and district courts having the jurisdiction of circuit courts, shall have power, upon bill in equity, filed by any party aggrieved, to grant in-

junctions to prevent the violation of any right secured by the laws respecting copyrights, according to the course and principles of courts of equity, on such terms as the court may deem reasonable.

Statute Revised—July 8, 1870, ch. 230, § 160, 16 Stat. 215.

Prior Statutes—February 15, 1819, ch. 19, § 1, 3 Stat. 481.—February 3, 1831, ch. 16, § 9, 4 Stat. 438.

Parties.

A party who has an equitable title to a copyright may maintain a bill. Little *v.* Gould, 2 Blatch. 165; Folsom *v.* Marsh, 2 Story, 100; Little *v.* Gould, 2 Blatch. 362.

The assignee of the right to act and represent a drama within certain territory and for a limited time may maintain an action in his own name, without joining the assignor. Roberts *v.* Myers, 23 Law Rep. 396; S. C. 17 Leg. Int. 405.

A party who surreptitiously obtained a copy of a play, can not enjoin another who fraudulently obtains a transcript of his copy. Martinetti *v.* Maguire, 1 Deady, 216; S. C. 1 Abb. C. C. 356.

A vendor is liable for the sale of a book which invades the copyright of another. Greene *v.* Bishop, 1 Cliff. 186.

Pleading.

Instances of similarity or identity should be brought before the court by affidavit, and not by allegations in the bill. Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; S. C. 5 C. L. N. 1.

Inconsistent pleading is matter of form, and can be taken advantage of only by special demurrer. Atwill *v.* Ferrett, 2 Blatch. 39.

A special demurrer which does not point out precisely the parts of the bill intended to be embraced by it is insufficient. Atwill *v.* Ferrett, 2 Blatch. 39.

A general demurrer to the whole bill will be overruled if any independent part of the bill is sufficient. Atwill *v.* Ferrett, 2 Blatch. 39.

An answer may consist in part of a demurrer and in part of a reply. Pierpont *v.* Fowle, 2 W. & M. 23.

One defendant can not object on the ground that his co-defendants are required to answer matters involved in a suit at law against him, especially when they reside out of the district. Atwill *v.* Ferrett, 2 Blatch. 39.

If an averment in the bill that the complainant is a citizen of the United States is not denied in the answer, it will be considered as admitted. Webb *v.* Powers, 2 W. & M. 497.

Where the answer is responsive to the bill, it is conclusive, unless it is overcome by the testimony of two witnesses, or of one witness and equivalent circumstances. Emerson *v.* Davies, 3 Story, 768.

If the complainant sets the cause down for hearing on bill and answer, everything well pleaded in the answer is thereby admitted to be true. Parton *v.* Prang, 2 O. G. 619; S. C. 6 A. L. T. 105.

Discovery and Account.

The court may compel a party to disclose the sums received for sales of the work, and account for the same. Pierpont *v.* Fowle, 2 W. & M. 23.

A defendant can not be compelled to make discoveries in answer to a bill which seeks to enforce penalties and forfeitures against him by means of such discoveries. Atwill *v.* Ferrett, 2 Blatch. 39.

A discovery will not be decreed in aid of an action of trespass, for the complainant can not maintain such action. Atwill *v.* Ferrett, 2 Blatch. 39.

If the defendant answers, it is too late to raise the objection that the discovery may render him liable to a penalty or forfeiture. Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; s. c. 5 C. L. N. 1.

An injunction and an account of the profits may be awarded, although the complainant did not expressly waive the forfeiture and penalty in the bill. Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; s. c. 5 C. L. N. 1.

The right to an account is an incident of a right to an injunction, and an account may be ordered under a prayer for general relief. Stevens *v.* Gladding, 17 How. 447; s. c. 8 N. Y. Leg. Obs. 297; Stevens *v.* Cady, 2 Curt. 200.

If there is no prayer for an account or for general relief, no decree can be made for profits. Stevens *v.* Cady, 2 Curt. 200.

If the infringer sold on commission, he must account for the commissions so received as profits. Stevens *v.* Gladding, 2 Curt. 608.

Issues.

When the rights of the parties depend on the construction of a written instrument, the court will decide the controversy, without directing an issue to be tried at law. Pierpont *v.* Fowle, 2 W. & M. 23.

On an issue to a jury the bill and answer can not be read in evidence by the defendant, unless it is so ordered by the court at the time of directing the issue. King *v.* Force, 2 Cranch C. C. 208.

Preliminary Injunction.

A motion for a preliminary injunction will be disposed of on the affidavits filed by the parties, and will not be referred to a master. Smith *v.* Johnson, 4 Blatch. 252.

On a motion for a preliminary injunction, affidavits taken to be used in the cause may be so used, although they are not entitled in the case. Shook *v.* Rankin, 6 Biss. 477.

A preliminary injunction may be granted although the questions involved have never been settled by any prior adjudication. Little *v.* Gould, 2 Blatch. 165.

Where an infringement is palpable and a provisional injunction will not be attended with serious injury, it is not ordinarily refused as to so much of the work as is a plain infringement of the prior publication. Banks *v.* McDivett, 13 Blatch. 163; s. c. 8 O. G. 860.

If the questions involved are grave, they will not be determined on a mo-

tion for a preliminary injunction, but will be postponed till the final hearing. Miller *v.* McElroy, 2 Penn. L. J. 305; S. C. 1 A. L. Reg. 198.

Where a question is doubtful, a decision on a motion for an injunction may be suspended and an issue sent to be tried at law. Jollie *v.* Jaques, 1 Blatch. 618.

The doubt which will justify a refusal to grant a preliminary injunction must be a serious doubt remaining after a faithful investigation of the law and the facts. Little *v.* Gould, 2 Blatch. 165.

If there is nothing to identify or distinguish the parts in which the complainant claims a copyright, and the defendant's affidavits deny the equities of the bill, a preliminary injunction will not be granted. Flint *v.* Jones, 1 W. N. 334.

On a motion to dissolve an injunction, the complainant can not read affidavits for the purpose of rebutting averments in the answer as to his title, but must depend on the affidavits filed with his bill. Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; S. C. 5 C. L. N. 1.

A denial of the complainant's title on information and belief, not supported by the affidavit of any person having personal knowledge, is not sufficient to entitle the defendant to a dissolution of an injunction. Farmer *v.* Calvert Publishing Co. 5 A. L. T. 168; S. C. 5 C. L. N. 1.

Injunction.

If the alleged infringement does not prejudice the complainant, he is not entitled to an account or an injunction. Chase *v.* Sanborn, 6 O. G. 932.

If a book infringes a copyright of another book in some parts and in other parts is no infringement, the remedy will not be extended beyond the injury. Story *v.* Holcombe, 4 McLean, 306; Emerson *v.* Davies, 3 Story, 768.

If the motive was not culpable and the part copied can not be separated from the rest of the work, an injunction will not be awarded. Webb *v.* Powers, 2 W. & M. 497.

If the complainant aided the defendant in the publication of the work without asserting any claim under his copyright, he can not restrain the sale thereof. Heine *v.* Appleton, 4 Blatch. 125.

A defendant may be restrained from using the name of a play in advertisements with the intent to lead the public to believe that the genuine play will be performed. Shook *v.* Wood, 32 Leg. Int. 264.

A party who is attached for contempt in violating a perpetual injunction can not contest the validity of the copyright. Drury *v.* Ewing, 1 Bond, 540.

Practice.

The complainant must show that he is the author of the work, or that his title is derived from one sustaining that relation to the publication. Greene *v.* Bishop, 1 Cliff. 186.

The burden of proof is on the complainant to establish his right to copyright as well as the infringement. Chase *v.* Sanborn, 6 O. G. 932.

The copyright is *prima facie* evidence that the party is the author, and

the burden of proof is on the defendant to show the contrary. Reed *v.* Carusi, Taney, 72.

Master.

The usual course is to send the case to a master before determining the merits. Chase *v.* Sanborn, 6 O. G. 932; Story *v.* Derby, 4 McLean, 160.

A master is required to report conclusions, and in general it is irregular for him to incorporate the details of the evidence into his report without the direction of the court. Greene *v.* Bishop, 1 Cliff. 186.

Whenever it is requested by either party, a master should specify and identify the evidence, and refer to it in such a manner as to inform the court on what state of facts his conclusions are based. Greene *v.* Bishop, 1 Cliff. 186.

Exceptions to a master's report are written enumerations of the errors alleged by the complaining party, and of the corrections he requests to have made, and they should be so framed as not merely to allege error in general terms, but should be sufficiently definite and explicit to enable the court understandingly to decide on each point in dispute. General allegations of error without pointing to any particulars are insufficient. Greene *v.* Bishop, 1 Cliff. 186.

An exception which, without any suggestion or imputation of fraud or undue influence, merely alleges that the master has arrived at a wrong conclusion on the evidence, without pointing out any specific portion of the testimony to support the allegation, can not in general be regarded as sufficient to put the finding of the master in issue, or to require the court to review and revise the same in a matter of fact dependent entirely upon the weight and effect of the evidence submitted to his consideration. Greene *v.* Bishop, 1 Cliff. 186.

Although an exception is insufficient, yet if the court is satisfied that any error has been committed by the master in the finding referred to, it may recommit the report in order that the error may be corrected. Greene *v.* Bishop, 1 Cliff. 186.

The finding of the master in a matter of fact depending on the weight and effect of the evidence will not be interfered with unless it is clearly shown that there is manifest error. Greene *v.* Bishop, 1 Cliff. 186.

If the exceptions to the master's report are overruled, all matters found by the master and embraced in the order of reference must be taken to be true. All other matters depend on the evidence, and must be heard and determined by the court as in other cases on final hearing. Greene *v.* Bishop, 1 Cliff. 186.

SEC. 4971. Nothing in this chapter shall be construed to prohibit the printing, publishing, importation, or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving, or photograph, written, composed, or made by any person not a citizen of the United States nor resident therein.

Statute Revised—July 8, 1870, ch. 230, § 103, 16 Stat. 215.

Prior Statutes—May 31, 1790, ch. 15, § 5, 1 Stat. 125.—February 3, 1831, ch. 16, § 8, 4 Stat. 438.

RULES OF PRACTICE

IN THE

UNITED STATES PATENT OFFICE.

APPENDIX OF FORMS.

RULES OF PRACTICE

IN THE

UNITED STATES PATENT OFFICE.

UNITED STATES PATENT OFFICE,

November 1, 1876.

The following information and regulations, designed to be in strict accordance with the revised, consolidated, and amended law relating to patents for inventions and designs, and to trade-marks and labels, are published for gratuitous distribution.

Copious forms, to which inventors and attorneys are recommended to conform as nearly as possible, will be found in an appendix.

Printed copies of the revised and amended law may also be obtained by applying to the patent office.

Who may Obtain a Patent.

1. Any person, whether citizen or alien, being the original and first inventor or discoverer of any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent for his invention or discovery, subject to the conditions hereinafter named.

2. In case of the death of the inventor, the patent may be applied for by, and will issue to, his executor, or administrator. In case of an assignment of the whole interest in the invention, or of the whole interest in the patent if granted, the patent will issue to the assignee, upon the request of the latter, or his assignor; and so, if the assignee holds an undivided part interest, the patent will, upon a similar request, issue jointly to him and the inventor; but the assignment must first have been entered of record, and at a day not later than the date of the payment of the final fee. The application and oath must be made by the actual inventor, if alive, even if the patent is to issue to an assignee; but where the inventor is dead, the application and oath must be made by his executor or administrator.

3. Joint inventors are entitled to a joint patent; neither can claim one separately; but the independent inventors of separate and independent improvements in the same machine can not

obtain a joint patent for their separate inventions, nor does the fact that one man furnishes the capital and the other makes the invention entitle them to make application as joint inventors.

4. A patent will not be granted to an applicant if what he claims as new has been, before his invention, patented or described in any printed publication in this or any foreign country, or been invented or discovered in this country, nor if he has once abandoned his invention, nor if it has been in public use or on sale more than two years previous to his application.

5. If it appears that the inventor, at the time of making his application, believes himself to be the first inventor or discoverer, a patent will not be refused on account of the invention or discovery, or any part thereof, having been known or used in any foreign country before his invention or discovery thereof, it not appearing that the same, or any substantial part thereof, had before been patented or described in any printed publication.

6. Merely conceiving the idea of an improvement or machine is not an "invention" or "discovery." The invention must have been reduced to a practical form, either by the construction of the machine itself, or by such disclosure of its exact character, that a mechanic, or one skilled in the art to which it relates, can and does construct the improvement, before it will prevent a subsequent inventor from obtaining a patent.

Mode of Proceeding to Obtain a Patent.

APPLICATION.

7. No application for a patent will be regarded as completed or be placed upon the files for examination until the fee is paid, the specification, the petition, and the oath, properly signed, are filed, and the drawings and a model or specimens (when required) are furnished. The application must be completed and prepared for examination within two years after the filing of the petition: and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action thereon, of which notice shall have been mailed to him or his agent, it shall be regarded as abandoned, unless it be shown, to the satisfaction of the commissioner, that such delay was unavoidable.

It is desirable that everything necessary to make the application complete should be deposited in the office at the same time. If otherwise, a letter should accompany each part, stating to what application it belongs, and giving the date thereof.

8. During the pendency of an application, either the drawing or model (but not both at the same time) may be withdrawn for correction, but the specification will not be permitted to be withdrawn for any purpose whatever.

9. The application must be in writing, in the English language, and addressed to the commissioner of patents. The petition and

specification must be separately signed by the applicant. The specification, claims, and all amendments must be written in a fair, legible hand; otherwise the office may require them to be printed; and all interlineations or erasures should be clearly marked in a marginal or foot note written on the same sheet of paper. Legal-cap paper is deemed preferable, and a wide margin should always be left upon the left-hand side of the page, both of the specification and amendments. All the papers constituting the application should be attached together.

10. The applicant, if the inventor, must take oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen, and of what a resident. If the application be made by an executor or administrator, the form of the oath will be correspondingly changed. The oath or affirmation may be made before any person within the United States, authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be, the oath being attested in all cases, in this and other countries, by the proper official seal of such notary.

11. In case the applicant by amendment seeks to introduce any claim or claims, not substantially embraced in the original affidavit, he will be required to file a supplemental oath relative to the invention as covered by such new or enlarged claim or claims; and such supplemental oath must be upon the same paper which contains the proposed amendment.

SPECIFICATIONS.

12. The specification is a written description of the invention or discovery, and of the manner and process of making, constructing, compounding, and using the same, and is required to be in such full, clear, concise, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same. It must be followed by a specific and well defined claim of the part, improvement, or combination which the applicant regards as his invention or discovery.

13. Where there are drawings, the specification should refer by letters and figures to the different parts; and it must set forth the precise invention for which a patent is claimed, explaining the principle thereof and the best mode in which the applicant has contemplated applying that principle, so as to distinguish it from other inventions.

14. In all applications for patents upon mere improvements, the specification must particularly point out the part or parts to which the improvement relates, and must by explicit language distinguish between what is old and what is claimed as the improvement, so that the office and the public may understand exactly for what the patent is granted; and in such cases the description and the drawings, as well as the claims, should be confined to the specific improvement and such parts as necessarily co-operate with it.

15. Two or more separate and independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other, and mutually contribute to produce the new result, they may be so claimed.

16. If more than one invention is claimed in a single application, and they are found to be of such a nature that a single patent may not be issued to cover the whole, the office will require the inventor to confine the description and claim of the pending application to whichever invention he may elect; the other inventions may be made the subject of separate applications. The same prerequisites as to form are necessary in such applications as in original ones.

17. The specification must be signed by the inventor, or by his executor or administrator, and must be attested by two witnesses. Full names must be given, *and all names, whether of applicants or witnesses, must be legibly written.*

DRAWINGS.

18. The applicant for a patent is required by law to furnish a drawing of his invention, where the nature of the case admits of it.

19. Three several editions of patent drawings are printed and published: one for office use, certified copies, &c., of the size and character of those attached to patents, the work being about 6 by 9½ inches; one reduced to half that scale, or one-fourth the surface, of which four will be printed on a page to illustrate the volumes distributed to the courts, &c.; and one reduction—to about the same scale—of a selected portion of each drawing, to illustrate the Official Gazette.

This work will all be done by the photolithographic or other analogous process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of the process, and calculated to give the best results, in the interests of inventors, of the office, and of the public generally. The following rules will therefore be rigidly enforced, and any departure from them will be certain to cause delay in the examination of an application for letters patent:

a. Drawings should be made upon paper stiff enough to stand in the portfolios, the surface of which must be calendered

and smooth. Owen Company's three-sheet bristol-board, used by the patent office, is recommended. Indian ink of good quality, to the exclusion of all other kinds of ink or color, must be employed, to secure perfectly black and solid work.

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

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

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

e. The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must never be increased unless it is absolutely necessary. It often happens that an invention, although constituting but a small part of a machine, has yet to be represented in connection with other and much larger parts. In such cases a general view on a small scale is recommended, with one or more of the invention itself on a much larger scale.

f. Letters of reference must be well and carefully formed; they are of the first importance. When at all possible, no letter

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

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

When figures are larger than the width of the sheet, the latter is turned on its side, and the space for heading will be left at the right, and that for the signatures at the left, occupying the same space and position as in the upright subject, so that the heading and names will read right when the drawing is held in an upright position.

h. As a rule, one view only of each invention can be shown in the Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the specific improvement would be facilitated, and the final result improved, by the judicious execution of a figure with express reference to the Gazette, but which might, at the same time, act as one of the figures referred to in the specification. For this purpose, the figure may be a plan, elevation, section, or perspective view, according to the judgment of the draftsman. It must not cover a space exceeding sixteen square inches. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate the invention claimed only, to the exclusion of all other details. (See Fig. 3, specimen drawing.) When well executed, it will be used without curtailment or change; but any attempt at excessive fineness, crowding, or unnecessary elaborateness of detail, will insure its rejection for Gazette purposes.

i. Drawings should be rolled for transmission to the office, not folded. No agent's or attorney's stamp, or advertisement,

or any written address, will be permitted upon the face of a drawing within or without the marginal line.

20. These rules do not always apply to drawings for designs and trade-marks. (See Rules for Designs and Trade-marks.)

21. The foregoing rules relating to drawings will be rigidly enforced, and all drawings not artistically executed in conformity therewith will be returned to the respective applicants, or, at the applicant's option and cost, the office will make the necessary corrections.

22. All reissue applications must be accompanied by new drawings, as in original applications, and the inventor's name must appear in all cases upon the same.

23. Applicants are advised to employ competent artists to make their drawings, or, if desired, the office will furnish the drawings on payment of the cost of making the same.

24. In all cases which admit of representation by model, the applicant, if required, shall furnish a model to exhibit advantageously the several parts of his invention or discovery. As a rule, a model will not be dispensed with, except by recommendation of the examiner. The model must clearly exhibit every feature of the machine which forms the subject of a claim of invention, but should not include other matter than that covered by the actual invention or improvement, unless it is necessary to the exhibition of a working model.

25. The model must be neatly and substantially made of durable material, metal being deemed preferable; and should not in any case be more than one foot in length, width, or height. If made of pine or other soft wood, it should be painted, stained, or varnished. Glue must not be used, but the parts should be so connected as to resist the action of heat or moisture. Where practicable, to prevent loss, the model or specimen should have the name of the inventor permanently fixed thereon. In cases where models are not made strong and substantial, as here directed, the application will not be considered until a proper model is furnished.

26. A working model is always desirable, in order to enable the office fully and readily to understand the precise operation of the machine.

27. The model, unless it is deemed necessary that it be preserved in the office, or unless it be otherwise disposed of, may be returned to the applicant upon demand, and at his expense, in all cases where an application has been rejected more than two years; and the model, in any pending case of less than two years' standing, may be returned to the applicant upon the filing of a formal abandonment of the application, signed by applicant in person. Models belonging to patented cases will not be allowed to be taken from the office, except by some employee thereof, when authorized by the commissioner, and in whose custody it will remain until returned.

28. Models filed as exhibits, in interference and other cases, may be returned to the applicant or otherwise disposed of at the discretion of the commissioner.

Models in patented cases will, when necessary, be repaired by the office at the cost of the proper owner, on request by such owner.

When the invention or discovery is a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients, and of the composition, sufficient in quantity for the purpose of experiment. In all cases where the production is not perishable, a specimen put up in form, so as to be preserved by the office, should be filed. Ordinary, well-known ingredients need not be furnished, unless the office disputes their operation in the manner as stated by applicant.

The Examination.

29. All cases in the patent office are classified and taken up for examination in regular order; those in the same class being examined and disposed of, as far as practicable, in the order in which the respective applications are completed. When, however, the invention is deemed of peculiar importance to some branch of the public service, and when, for that reason, the head of some department of the government specially requests immediate action, the case will be taken up out of its order. These, with applications for extensions, for reissue, for letters patent for inventions for which a foreign patent has already been obtained, and for designs, which cases have precedence over all others, are the only exceptions to the above rule in relation to the order of examination. If an application is found to conflict with a caveat, its examination will be suspended, as hereinafter provided.

The first step in the examination of any application will be to determine whether it is, in all respects, in proper form. If, however, an objection as to form is not vital, the examiner may proceed to the consideration of the application on its merits; but in such case he must, in his first letter to applicant, state all his objections, whether formal or otherwise.

30. The personal attendance of the applicant at the patent office is unnecessary. The business can be done by correspondence or by attorney; and if there has been an assignment of the whole or of an undivided part of the invention, the assignee, or, in the latter case, the assignee and the inventor jointly, will be recognized as the proper party to prosecute the application.

31. The applicant has a right to amend after the first rejection: and he may amend as often as the examiner presents any new references. After a second rejection, and at any time before the issue of a patent, special amendments may be received for examination by the approval of the commissioner. But such amendments must first be submitted to the tribunal last acting on the case, for

recommendation or objection, and will be subject to revision and restriction the same as original amendments. Affidavits in support of applications will not be received at any stage of the examination, unless the office denies that the invention is operative or useful.

32. All amendments of the model, drawings, or specification, in the case of original applications which are capable of illustration by drawing or model, must conform to at least one of them as they were at the time of the filing of the application; further changes than this, involving a departure from the original invention, can only be made by filing a new application. If the invention does not admit of illustration by drawing, amendment of the specification may be made upon proof satisfactory to the commissioner that the proposed amendment is a part of the original invention.

All amendments of specifications or claims must be made on separate sheets of paper from the original, and must be filed in the manner above directed. Even when the amendment consists in striking out a portion of the specification or other paper, the same course should be observed. No erasure must be made by the applicant. In every case of amendment the exact word or words to be stricken out or inserted should be clearly specified, and the precise point indicated where the erasure or insertion is to be made.

33. Whenever, on examination, any claim for a patent is rejected for any reason whatever, the applicant will be notified thereof, and the reasons for such rejection will be given, together with such information and references as may be useful in judging of the propriety of prosecuting his application or of altering his specification; and if, after receiving such notice, he shall persist in his claim for a patent, with or without altering his specification, the case will be re-examined.

34. Upon the rejection of an application for want of novelty, the examiner must cite the best references at his command, and the applicant will, if he demands it, be entitled to a specific reference (by name, date, and class, or the equivalent thereof) to the article or articles by which it is anticipated. If he desires a copy of the cases so referred to, or of the plates or drawings connected with them, they will be forwarded to him, if in the possession of the office, on payment of the cost of making such copies.

35. Pending applications must not be cited as references, except for the purposes of an interference.

36. The specification, especially if the claim be amended, must be amended and revised, when required, for the purpose of correcting inaccuracies of description or unnecessary prolixity, and of securing correspondence between the statement and description of the invention and the claim. Mere errors of orthography or of grammatical construction may be corrected by the examiner in charge.

37. The office will not return specifications for amendment. If applicants have not preserved copies of such papers as they wish to amend, the office will furnish them on the usual terms.

Date of Patent.

38. Every patent will bear date as of a day not later than six months from the time at which the application was passed and allowed, and notice thereof was mailed to the applicant or his agent, and if the final fee (or, in case the fee has been paid to the treasurer or any of the assistant treasurers, or any of the designated depositaries of the United States, the certificate of deposit) be not received at the office within that period, the patent will be withheld. The party may, however, obtain a patent upon a new application, as hereinafter provided.

A patent will not be antedated.

Abandoned Applications.

39. When an application for a patent has been rejected, and the applicant fails to renew the same, or to file a new one within two years after the date when notice of the last official action was mailed to him or to his agent, his application will be held to have been abandoned.

Any act which calls such rejected application up for further consideration, within the time mentioned, will be regarded as constituting a renewal.

40. When a new application is filed in place of an old one, a new specification, oath, drawing, and fee will be required, but the old model, if suitable, may be used.

41. Upon the hearing of applications attempted to be renewed after the expiration of the two years after any action thereon, it must be shown to the satisfaction of the commissioner that such delay was unavoidable.

In those cases above mentioned where the patent has been withheld by reason of non-payment of the final fee, any person, whether inventor or assignee, who has an interest in the invention for which such patent was ordered to issue, may renew the former application by filing a second one for the same invention; but such second application must be made within two years after the allowance of the original one. Upon the hearing of the renewed applications abandonment shall be considered as a question of fact.

Appeals.

42. Every applicant for a patent or the reissue of a patent, any of the claims of which have twice been rejected upon the merits of the invention, may appeal from the decision of the primary examiner in such case to the board of examiners in chief, having once paid a fee of ten dollars. For this purpose a petition in writing must be filed, signed by the party, or his authorized agent or attorney, praying an appeal, and setting forth the reasons upon which the appeal is taken.

This statement of the reasons of appeal should point out distinctly and specifically the supposed errors of the examiner's action, and should constitute a brief of the argument upon which

the applicant will rely in support of his appeal. The mere allegation that the examiner has erred will not be received as a proper reason for appeal. Before the appeal is entertained by the board, this statement will be submitted to the primary examiner, who will make answer in writing touching all the points involved therein.

Both the reasons of appeal and the examiner's answer should set forth the invention, the claims rejected, the references cited, and other objections going to the merits of the case generally. It will not be sufficient compliance with this rule to refer to letters as containing the examiner's answer and references.

If the appellant desires to be heard orally before the board, he should so indicate when he files his appeal; a day of hearing will then be fixed, and due notice of the same be given him.

In contested cases the appellant shall have the right to make the opening and closing arguments.

43. The examiners in chief will consider the case as it was when last passed upon by the primary examiner, merely revising his decisions so far as they were adverse to the appellant. If, however, they discover any reason not given by the examiner why a patent should not issue, they should make a statement to that effect to the commissioner.

If affidavits are received under Rule 31, after the case has been appealed, the application will be remanded to the examiner for reconsideration.

44. There must be two rejections upon the claims as originally filed, or, if amended in a matter of substance, upon the amended claims; and all the claims must be passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention must be settled before the case is appealed to the board.

All cases must be thoroughly examined and all references exhausted before final rejection.

Decisions of examiners upon preliminary or intermediate questions, or refusals to act, once repeated, will be re-examined by the commissioner in person, upon written application setting forth the grounds of the appeal, and answer thereto by the examiner as in other appeals. For appeals of this class no fee is required.

45. Cases which have been heard and decided on appeal will not be reopened by the examiner without the written authority of the commissioner, and cases which have been decided by the examiners in chief will not be reheard by them, when no longer pending before them, except upon the same authority.

Cases will be regarded as pending before a tribunal until appeal has been taken from its decision, or until the limit of appeal has expired.

Cases which have been deliberately decided by one commissioner will not be reconsidered by his successor upon the same state of facts. They may, however, be reopened in accordance

with the general principles which govern the granting of new trials.

46. All cases which have been acted on by the board of examiners in chief may be brought before the commissioner in person, upon a written request to that effect, and upon the payment of the fee of twenty dollars required by law.

47. From the adverse decision of the commissioner upon the claims of an application, an appeal may be taken to the Supreme Court of the District of Columbia, sitting *in banc*. In taking such appeals the applicant is required, under the rules of the court, to pay to the clerk of the court a docket fee of ten dollars, and he is also required by law to lay before the court certified copies of all the original papers and evidence in the case. The petition should be filed and the fee paid at least ten days before the commencement of the term of court at which the appeal is to be heard.

Immediately upon taking an appeal the appellant must give notice thereof to the commissioner of patents, and file in the patent office his reasons of appeal, specifically set forth in writing.

The docket for the trial of cases appealed from the decision of the commissioner of patents will be called on the first day of each session of the Supreme Court of the District of Columbia in general term. These sessions are held three in each year, and begin respectively on the first Monday in January, the third Monday in April, and the fourth Monday in September.

48. In cases of interference parties have the same remedy by appeal to the examiners in chief, and to the commissioner, as in *ex parte* cases; but no appeal lies in such cases from the decision of the commissioner. Appeals in interference cases should be accompanied with a brief statement of the reasons therefor; and both parties will be required to file briefs of their arguments at least five days before the day of hearing. Printed briefs are in all cases preferred.

Hearings.

49. All cases pending before the commissioner, the board of examiners in chief, or the examiner in charge of interferences, will stand for argument at 12 o'clock on the day of hearing, unless some other hour be specially designated. If either party in a contested case, or the appellant in an *ex parte* case, appears at that time, he will be heard, but a contested case will not be taken up for oral argument after the day of hearing, except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard. Unless otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each counsel. After any case has been argued, nothing further relating thereto will be heard unless requested by

the tribunal having the decision of the case; and all interviews for this purpose, with parties in interest or their attorneys, will be invariably denied.

Motions.

50. In contested cases reasonable notice of all motions, and copies of the motion, papers, and affidavits, must be served upon the opposite party or his attorney. Proof of such service must be made before the motion will be entertained by the office, and motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken to the commissioner in person.

Interferences.

51. An "interference" is a proceeding instituted for the purpose of determining the question of *priority of invention* between two or more parties claiming the same patentable subject-matter.

Before the declaration of an interference it is desirable that all preliminary questions shall be settled by the primary examiner, and the issue must be clearly defined; the invention which is to form the subject of the controversy must be decided to be patentable, and the claims of the respective parties should be put in such condition that they will not require alteration after the interference has been finally decided, unless the testimony adduced upon the trial should necessitate such change.

Where a party who is required to put his case in proper shape for the purposes of an interference delays doing so beyond a reasonable time specified, the interference will at once proceed. After final judgment of priority the application of such party will be held for revision and restriction, subject to interferences with other applications or new references.

An interference will be declared in the following cases:

First. When two or more parties have applications pending before the office at the same time, and their respective claims conflict in whole or in part.

Second. When two or more applications are pending at the same time, in each of which a like patentable invention is shown or described, and claimed in one though not specifically claimed in all of them.

Third. When an applicant, having been rejected upon any unexpired patent, claims to have made the invention before the patentee.

Applications for reissue of patents are included in the above classification, and will be put in interference with subsequent as well as prior patents when in conflict therewith.

Where a preliminary interference is declared on matter shown

but not claimed in the application last filed, the applicant must, in order to avoid the continuance of the interference, disclaim the invention of the particular matter so shown.

52. The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the commissioner has no power to cancel a patent already issued, he may, if he finds that another person was the prior inventor, give him a patent also, and thus place both parties on an equal footing before the courts and the public.

When a patent is involved in an interference the assignees, as well as the inventor, will be notified.

53. Before the declaration of an interference proper a preliminary interference will be declared, in which the primary examiner will briefly and concisely define the interfering subject-matter, and specify the claims embracing the same, and also notify the respective parties when the applications of the other parties were filed, together with their names and residences. Each party to the interference will be required to file a brief statement under oath, showing the date of the original conception, the date that the invention was reduced to drawings or model, the date of its completion, and the extent of use. The parties will be strictly held in their proof to the dates set up in their preliminary statements. This statement must be sealed up before filing (to be opened only by the examiner of interferences), and the name of the party filing it and the subject of the invention indicated on the envelope.

These statements shall not be open to the inspection of the opposing parties until both have been filed, or until the time for filing both has expired; nor then, until they have been examined by the proper officer and found to be satisfactory. At the time of the examination of the preliminary statements the examiner of interferences will also make an examination of the preliminary declaration (instituted by the primary examiner), in order to ascertain whether or not the issue between the parties has been clearly defined. If it be found, upon such examination, that the preliminary declaration is ambiguous in this particular, the interference will be suspended and the case returned to the primary examiner for amendment.

If the party upon whom rests the burden of proof fails to file a preliminary statement, or if his statement fails to overcome the *prima facie* case made by the respective dates of application, the other party will be entitled to an immediate adjudication of the case upon the record.

If the earlier applicant fails to file a preliminary statement, no testimony will subsequently be received from him going to prove that he made the invention at a date prior to his application. The preliminary statement can in no case be used as evidence in behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination for the other party.

If either party requires a postponement of the time for filing the preliminary statements, he must present his reasons therefor, in the form of an affidavit, prior to the day previously fixed upon.

54. Where no testimony is taken by the applicant upon whom rests the burden of proof, or where testimony has been taken by such applicant, but not by the other party during the time assigned to the latter, the case will be considered closed; upon motion duly made at the expiration of the time assigned to such parties, respectively, the case may be set for hearing at any time not less than ten days thereafter.

55. In cases of interference, appeals may be taken to the examiners in chief and to the commissioner, in the manner provided in Rule 48.

56. When an interference is declared, notice will be given to both parties or to their attorneys. When one of the parties has received a patent, duplicate notices will be sent to the patentee and to his attorney of record. Where one of the parties resides abroad and has no known agent in the United States, in addition to the notice sent by mail, notice may be given by publication in a newspaper of general circulation in the city of Washington, once in a week for three successive weeks.

57. In cases of interference the party who first filed so much of his application for a patent as is required by Rule 7, will be deemed the first inventor in the absence of all proof to the contrary. A time will be assigned in which the other party shall complete his direct testimony; and a further time in which the adverse party shall complete the testimony on his side; and a further time in which the party who first took testimony may take rebutting testimony, but shall take no other. If there are more than two parties, the times for taking testimony will be so arranged that each shall have a like opportunity in his turn, each being held to go forward and prove his case against those who filed their application before him.

58. If it becomes necessary for either party to have the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit, as provided in Rule 113, filed before the time previously appointed has elapsed, if practicable, and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his motion.

59. After the declaration of the interference and before the time for filing the preliminary statements has expired, motions to dissolve the same on the ground of lack of novelty, or that no interference in fact exists, or that there has been such other irregularity in declaring the same as will preclude the proper determination of the question of right between the parties, must be made before the examiner by whom the interference was instituted. An appeal from his decision may be taken to the commissioner in per-

son; but if the examiner should decide that the subject-matter is not patentable in view of the state of the art, the interference will be dissolved, and the matter decided upon can be proceeded with *ex parte*.

After the declaration of the interference proper, it will not be determined without judgment of priority founded upon the testimony, or the written concession of one of the parties. In their decision of the question of priority, the examiner of interferences, or the examiners in chief, as the case may be, will direct the attention of the commissioner to any fact not relating to priority which may have come to their attention (by motion or otherwise), and which, in their opinion, amounts to a statutory bar to the grant of a patent to either or both parties. After final judgment the primary examiner will consider and determine any such matter not previously disposed of by the commissioner.

If at any time during the continuance of an interference the primary examiner discovers new references, he may request a suspension of the interference for their consideration: but after testimony has been taken new parties will not be admitted into the interference.

Where final judgment of priority has been rendered in favor of an applicant whose application has passed to issue, the final fee been paid, and nothing more remains to be done but to issue the patent, the patent will not be withheld for the purpose of putting such application in interference with any application filed subsequent to the rendition of such judgment and the payment of said final fee; but a new interference may be declared with the patent.

If judgment be based upon a concession of priority by either of the parties, such concession must be in writing, and under the signature of the inventor himself; and if there has been an assignment, the assignee must join in the concession.

60. No amendments to the specification will be received during the pendency of an interference, except as provided in § 61, nor will the reissue of a patent be allowed while the patent is in interference. A second interference will not be declared upon a new application on the same invention filed by either party during the pendency of an interference, or after judgment, nor a rehearing be granted, unless it be shown to the satisfaction of the commissioner that the party desiring a new interference or rehearing has new and material testimony which he could not have procured in time for the hearing, or unless other sufficient reasons be shown.

61. When an application is adjudged to interfere with a part only of another pending application, the interfering parties will be permitted to see or obtain copies of so much only of the specifications as refers to the interfering claims. And either party may, if he so elect, withdraw from his application the claims adjudged not to interfere, and file a new application therefor: *Provided*, that the claims so withdrawn cover inventions which do not in-

volve the devices in interference: *And provided also*, that the devices in interference are eliminated from the new application. In such case the latter will be examined without reference to the interference from which it was withdrawn.

Reissues.

62. A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. In the cases of patents issued and assigned prior to July 8, 1870, the application for reissue may be made by the assignee; but, in the case of patents issued or assigned since that date, the application must be made and the specification sworn to by the inventor, if he be living.

63. The petition for a reissue must be accompanied with a certified copy of the abstract of title, giving the names of all assignees owning any undivided interest in the patent: and in case the application is made by the inventor, it must be accompanied with the written assent of such assignees.

64. The general rule is, that whatever is really embraced in the original invention, and so described or shown that it might have been embraced in the original patent, may be the subject of a reissue; but no new matter shall be introduced into the specification, nor shall the model or drawings be amended except each by the other; but, when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

65. Reissued patents expire at the end of the term for which the original patents were granted. For this reason applications for reissue will take precedence, in examination, of original applications.

66. A patentee in reissuing may, at his option, have a separate patent for each distinct and separate part of the invention comprehended in his original patent, by paying the required fee in each case, and complying with the other requirements of the law, as in original applications. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts. All the divisions of a reissue will issue simultaneously. If there be controversy as to one, the others will be withheld from issue until the controversy is ended.

67. In all cases of applications for reissues, the original claim,

if reproduced in the amended specification, is subject to re-examination, and may be revised and restricted in the same manner as in original applications. The application for a reissue must be accompanied by a surrender of the original patent, or, if lost, then by an affidavit to that effect and a certified copy of the patent; but if any reissue be refused, the original patent will, upon request, be returned to the applicant.

Where more than one patent to the same person shows or describes a device but does not claim it, a reissue to cover it must be of the patent first granted.

Disclaimers.

68. Whenever, by inadvertence, accident, or mistake, the claim of invention in any patent is too broad, embracing more than that of which the patentee was the original or first inventor, some material or substantial part of the thing patented being truly and justly his own, the patentee, his heirs or assigns, whether of a whole or of a sectional interest, may, upon payment of the duty required by law, make disclaimer of such parts of the thing patented as the disclaimant shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, shall be recorded in the patent office, and shall thereafter be considered as part of the original specification, to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof.

This class of disclaimers must be distinguished from those which are embodied in original or reissue applications referring to matter shown or described, but to which the disclaimant does not choose to claim title. These require no fee.

Extensions.

69. No patent granted since March 2, 1861, can be extended except by act of Congress.

70. When a patent has been so extended, subject to the further decision of the commissioner, the subsequent proceedings will be conducted in accordance with the following rules:

71. Any person may oppose an application for extension, but must give notice of such intention to the applicant or his attorney of record within the time hereafter named, and furnish him with a statement of his reasons of opposition. After this he will be regarded as a party in the case, and will be entitled to notice of the time and place of taking testimony, to a list of the names and residences of the witnesses whose testimony may have been taken previous to his service of notice of opposition, and to a copy of the application and of any other papers on file, upon paying the cost of copying. He must also immediately file a copy of such

notice and reasons of opposition, with proof of service of the same, in the patent office.

If the extension is opposed on the ground of lack of novelty in the invention, the reasons of opposition should contain a specific statement of any and all matter relied upon for this purpose.

72. The application for an extension must furnish to the office a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures on account thereof, both in this and foreign countries. This statement must be made particular and in detail, unless sufficient reason is set forth why such a statement can not be furnished. It must *in all cases* be filed with the petition. No exceptions will be made to this rule.

Such statement must also be accompanied with a *certified abstract of title and* a declaration, under oath, setting forth the extent of applicant's interest in the extension sought.

73. The questions which arise on each application for an extension are:

First. Was the invention *new* and *useful* when patented?

Second. Is it *valuable* and *important to the public*, and to what extent?

Third. Has the inventor been *reasonably remunerated* for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use? If not, has his failure to be so remunerated arisen from neglect or fault on his part?

Fourth. What will be the effect of the proposed extension upon the public interests?

No proof will be required from the applicant upon the first question unless the invention is assailed upon those points by opponents.

To enable the commissioner to come to a correct conclusion in regard to the second point of inquiry, the applicant must, if possible, procure the testimony of persons disinterested in the invention, which testimony should be taken under oath. *This testimony must distinguish carefully between the specific devices covered by the claims of the patent and the general machine in which those devices may be incorporated.*

In regard to the third point of inquiry, in addition to his own oath, showing his receipts and expenditures on account of the invention, the applicant must show, by testimony under oath, that he has taken all reasonable measures to introduce his invention into general use; and that, without neglect or fault on his part, he has failed to obtain from the use and sale of the invention a reasonable remuneration for the time, ingenuity, and expense bestowed on the same, and the introduction of it into use.

74. In case of opposition to the extension of a patent by any person, both parties may take testimony, each giving reasonable notice to the other of the time and place of taking said testimony, which shall be taken according to the rules hereinafter prescribed.

75. Any person desiring to oppose an extension must serve his notice of opposition, and file his reasons therefor, at least ten days before the day fixed for the closing of testimony; but parties who have not entered formal opposition in time to put in testimony may, at the discretion of the commissioner, be permitted to appear on the day of hearing, and make argument upon the record in opposition to the grant of the extension. But in such case good cause for the neglect to make formal opposition must be shown.

76. In contested cases no testimony will be received, unless by consent, which has been taken within thirty days next after the filing of the petition for the extension.

77. Service of notice to take testimony may be made upon applicant, upon the opponent, upon the attorney of record of either, or, if there be no attorney of record, upon any attorney or agent who takes part in the service of notice, or in the examination of the witnesses of either party. Where notice to take testimony has already been given to an opponent, and a new opponent subsequently gives notice of his intention to oppose, the examination need not be postponed, but notice thereof may be given to such subsequent opponent by mail or by telegraph. This rule, however, does not apply to *ex parte* examinations, or those of which no notice has been given when notice of opposition is served.

78. In the notice of the application for an extension a day will be fixed for the closing of testimony, and the day of hearing will also be named. Application for a postponement of the day of hearing, or for further time for taking testimony, must be made and supported according to the same rules as are to be observed in other contested cases; but they will not be granted in such a manner as to cause a risk of preventing a decision prior to the expiration of the patent. Immediately upon the closing of the testimony the application will be referred to the examiner in charge of the class to which the invention belongs for the report required by law; and said report shall be made not less than five days before the day of hearing. As this report is intended for the information of the commissioner, neither the parties nor their attorneys will be permitted to make oral arguments before the examiner. In contested cases briefs are deemed desirable, and these should always be filed at least five days before the day of hearing.

Designs.

79. A patent for a design may be granted to any person, whether citizen or alien, who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise

placed on or worked into any articles of manufacture; or any new, useful and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries.

80. Patents for designs are granted for the term of three and and one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

81. The proceedings in applications for patents for designs are substantially the same as for other patents. The specification must distinctly point out the characteristic features of the design, and carefully distinguish between what is old and what is held to be new. The claims also should be as distinct and specific as in the case of patents for inventions or discoveries.

82. When the design can be sufficiently represented by drawings or photographs, a model will not be required.

83. Whenever a photograph or an engraving is employed to illustrate the design, it must be mounted upon bristol-board, ten by fifteen inches in size, and properly signed and witnessed; the applicant will be required to furnish ten extra copies of such photograph or engraving (not mounted), of a size not exceeding seven and a half inches by eleven. Negatives are not required.

Whenever the design is represented by a drawing made to conform to the rules laid down for drawings of mechanical inventions, but one copy need be furnished. Additional copies will be supplied by the photolithographic process, at the expense of the patent office.

Trade-Marks.

84. Any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any State or Territory thereof, and any person, firm, or corporation resident of or located in any foreign country which, by treaty or convention, affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements, to wit:

First. By causing to be recorded in the patent office the names of the parties, and their residences and place of business, who desire the protection of the trade-mark.

Second. The class of merchandise and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated.

Third. A description of the trade-mark itself, with fac-similes

thereof, and the mode in which it has been or is intended to be applied and used.

Fourth. The length of time, if any, during which the trade-mark has been used.

Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.

Sixth. The compliance with such regulations as may be prescribed by the commissioner of patents.

Seventh. The filing of a declaration, under the oath of the person, or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and that no other person, firm, or corporation has a right to such use, either in the identical form or having such near resemblance thereto as might be calculated to deceive, and that the description and fac-similes presented for record are true copies of the trade-mark sought to be protected. The oath must also state the domicile and citizenship of the person desiring registration.

The petition asking for registration should be accompanied with a distinct statement or specification, setting forth the domicile and residence of the applicant, the length of time the trade-mark has been used, the mode in which it is intended to apply it, and the particular description of goods comprised in the class by which it has been appropriated, and giving a full description of the design proposed, particularly distinguishing between the essential and the non-essential features thereof.

85. The protection for such trade-mark will remain in force for thirty years, and may, upon the payment of a second fee, be renewed for thirty years longer, except in cases where such trade-mark is claimed for, and applied to, articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have force in this country, by virtue of the registration, at the same time that it becomes of no effect elsewhere.

86. No proposed trade-mark will be received or recorded which is not and can not become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public; but any lawful trade-mark rightfully used at the time of the passage of the act relating to trade-marks (July 8, 1870) may be registered.

All applications for registration are referred in the first instance to a trade-mark examiner. From adverse decision by such examiner upon the applicant's right to registration, an appeal directly to the commissioner will lie, no fee being charged therefor.

In case of conflicting applications for registration, the office reserves the right to declare an interference, in order that the parties may have opportunity to prove priority of adoption or right; and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents.

87. Where the trade-mark can be represented by a fac-simile which conforms to the rules for drawings of mechanical patents, such a drawing may be furnished by applicant, and the additional copies will be produced by the photolithographic process at the expense of the office. Or the applicant may furnish one fac-simile of the trade-mark, mounted on a card ten by fifteen inches in size, and ten additional copies not mounted, as in designs, but in all cases the mounted fac-simile or the drawing must be signed by the applicant or his authorized attorney, and the signature must be attested by two witnesses.

88. The right to the use of any trade-mark is assignable by any instrument of writing, and such assignment must be recorded in the patent office within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice. The fees will be the same as are prescribed for recording assignments of patents.

Foreign Patents.

89. The taking out of a patent in a foreign country does not prejudice a patent previously obtained here; nor does it prevent obtaining a patent here subsequently, unless the invention shall have been introduced into public use in the United States for more than two years prior to the application; but when a patent is taken out in this country for an invention previously patented abroad, the American patent will expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years.

90. When application is made for a patent for an invention which has been already patented abroad, the inventor will be required to make oath that, according to the best of his knowledge and belief, the same has not been in public use in the United States for more than two years prior to the application in this country.

91. An applicant whose invention has been patented abroad should state the fact that a foreign patent has actually been obtained, giving its date, and if there be more than one, the date of each.

Caveats.

92. Any citizen of the United States, or alien who has resided for one year last past in the United States, and has made oath of

his intention to become a citizen thereof, can file a caveat in the secret archives of the patent office on the payment of a fee of ten dollars therefor. And if, at any time within one year thereafter, another person applies for a patent with which such caveat would in any manner interfere, such application will be suspended, and notice thereof will be sent to the person filing the caveat, who, if he shall file a complete application within the prescribed time, will be entitled to an interference with the previous application, for the purpose of proving priority of invention, and obtaining the patent, if he be adjudged the prior inventor. The caveator, if he would avail himself of his caveat, must file his application within three months from the day on which the notice to him is deposited in the post office at Washington, adding the regular time for the transmission of the same to him; and the day when the time for filing expires will be mentioned in the notice or indorsed thereon.

93. The caveator will not be entitled to notice of any application pending at the time of filing his caveat, nor of any application filed after the expiration of one year from the date of filing the caveat; but he may renew his caveat at the end of one year by paying a second caveat fee of ten dollars, which will continue it in force for one year longer, and so on from year to year as long as he may desire. If a caveat is not renewed at the end of the year for which it was filed, it will still be preserved in the secret archives of the office.

94. No caveat can be filed in the secret archives of the office unless accompanied by an oath of the caveator that he is a citizen of the United States, or, if he is an alien, that he has resided for one year last past within the United States, and has made oath of his intention to become a citizen thereof; nor unless the applicant also states, under oath, that he believes himself the original and first inventor of the art, machine, or improvement set forth in his caveat.

95. A caveat need not contain as particular a description of the invention as is requisite in a specification; but still it must set forth the design of the invention and the distinguishing characteristics thereof, and the description should be sufficiently precise to enable the office to judge whether there is a probable interference when a subsequent application is filed. A caveat, equally with an application, must be limited to a single invention or improvement.

96. Caveat papers can not be withdrawn from the office, nor undergo alteration, after they have once been filed. Amendments which are necessary to secure a compliance with the above conditions may be received when required. The examination will only go to this extent.

97. When practicable, the caveat must be accompanied by full and accurate drawings, separate from the specifications, well executed on tracing muslin or paper that may be folded, and of the same size as demanded in drawings for patents.

Assignments.

98. A patent or trade-mark may be assigned, either as to the whole interest or any undivided part thereof, by an instrument of writing. No particular form of words is necessary to constitute a valid assignment, nor need the instrument necessarily be sealed, witnessed, or acknowledged.

99. Letters, copies of assignments, or *ex parte* statements in relation to assignments are not proper matters for record.

100. In every case where it is desired that the patent shall issue to an assignee, the assignment must be recorded in the patent office at a date not later than the day on which the final fee is paid.

101. When the patent is to issue in the name of the assignee, the entire correspondence will be with him or his authorized agent.

102. A patentee may not only assign the whole or an undivided interest in his patent, but he may grant and convey an exclusive right under his patent to the whole or any specified portion of the United States by an instrument in writing.

103. Every assignment or grant of an exclusive territorial right, as well as of an interest in a patent or trade-mark, must be recorded in the patent office; if a patent, within three months, if a trade-mark, within sixty days, from the execution thereof; otherwise it will be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice.

104. The patentee may convey separate rights under his patent to make or to use or to sell his invention, or he may convey territorial or shop rights which are not exclusive. Such conveyances are mere licenses, and need not be recorded.

105. The receipt of assignments is not generally acknowledged by the office; they will be recorded in their turn within a few days after their reception, and then transmitted to the person entitled to them.

Office Fees, and How Payable.

106. Nearly all the fees payable to the patent office are positively required by law to be paid in advance; that is, upon making application for any action by the office for which a fee is payable. For the sake of uniformity and convenience, the remaining fees will be required to be paid in the same manner.

107. The following is the tariff of fees established by law:

On filing every application for a design patent for three years and six months	$10 00
On filing every application for a design patent for seven years	15 00
On filing every application for a design patent for fourteen years	30 00
On filing every caveat	10 00

On filing every application for a patent for an invention or discovery	$15 00
On issuing each original patent for an invention or discovery	20 00
On filing a disclaimer	10 00
On filing every application for a reissue	30 00
On filing every application for a division of a reissue	30 00
On filing every application for an extension	50 00
On the grant of every extension	50 00
On filing the first appeal from a primary examiner to examiners in chief	10 00
On filing an appeal to the commissioner from examiners in chief	20 00
On depositing a trade-mark for registration	25 00
On depositing a label for registration	6 00
For every certified copy of a patent or other instrument, for every 100 words	10
For certified copies of drawings, the reasonable cost of making them.	
For recording every assignment of 300 words or under	1 00
For recording every assignment, if over 300 and not over 1,000 words	2 00
For recording every assignment, if over 1,000 words	3 00
For uncertified copies of the specifications and accompanying drawings of all patents which are in print—	
Single copies	25
Twenty copies or more, whether of one or several patents, per copy	10
For uncertified copies of the specifications and drawings of patents not in print, the reasonable cost of making the same.	

In ordering copies of any drawing or specification the name of the inventor and patentee, the title of the invention, and the date of the patent must be given. So, in ordering a copy of an assignment, the *liber* and page of the record, as well as the name of the inventor, must be given; otherwise an extra charge will be made for the time consumed in making any search that may become necessary.

108. No person will be allowed to make copies or tracings from the files or records of the office. Such copies will be furnished, when ordered, at the rates already specified.

109. The money for the payment of fees may be paid to the commissioner, or to the treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the patent office. When this cannot be done without much inconvenience, the money may be remitted by mail, and

in every such case the letter should state the exact amount inclosed. Letters containing money may be registered. Post office money orders now afford a safe and convenient mode of transmitting fees. All such orders should be made payable to the "Commissioner of Patents."

The weekly issue will close on Friday at 2 o'clock. If the final fee in any application is not paid before this time, the patent will not go to issue until the following week.

When patents are to issue to assignees, the assignment must be on record before the closing of the issue, and the request to issue to an assignee must be made in writing at the time of paying the final fee.

110. All money sent by mail, either to or from the patent office, will be at the risk of the owner. In no case should money be sent inclosed with models. All payments to or by the office must be paid in specie, treasury notes, national bank notes, certificates of deposit, or post office money orders.

REPAYMENT OF MONEY.

111. Money paid by actual mistake, such as a payment in excess, or when not required by law, will be refunded, but a mere change of purpose after the payment of money, as when a party desiring to withdraw his application for a patent or for the registration of a trade-mark, will not entitle a party to demand such return.

POSTAGE.

112. The postage on all matter sent to the patent office by mail must be prepaid in full, otherwise it will not be received.

Taking and Transmitting Testimony.

113. In extension, interference, and other contested cases, the following rules have been established for taking and transmitting testimony:

First. Before the deposition of a witness or witnesses is taken by either party, due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where such deposition or depositions will be taken, with the names and residences of the witness or witnesses then and there to be examined, so that the opposite party, either in person or by attorney, shall have full opportunity to cross-examine the witness or witnesses: *Provided*, that if the opposite party, or his counsel, be actually present at the taking of testimony, witnesses not named in the notice may be examined, but not otherwise; and that neither party shall take testimony in more than one place at the same time, nor so nearly at the same time as not to allow reasonable time to travel from one place of examination to the other.

Second. The notice for taking testimony must be served by

delivering a copy to the adverse party, or his agent, or attorney of record, or counsel, as provided in rule 77, or by leaving a copy at the party's usual place of residence, with some member of the family who has arrived at the years of discretion, or by leaving the same at the office of the attorney; and such notice shall, with proof of service of the same, and a certificate, duly sworn to, giving the manner and time of making the service, be attached to the deposition or depositions, whether the party cross-examine or not.

Third. The magistrate before whom the deposition is taken must append thereto his certificate, stating the time and place at which it was taken, the name of the witness, the administration of the oath, at whose request the testimony was taken, the occasion upon which it is intended to be used, the names of the adverse party, (if any,) and whether they were present; and immediately upon the close of the examination, he shall securely seal up all the evidence, &c., and forward the same forthwith to the commissioner of patents, making upon the envelope a certificate, giving the title of the case and the date of sealing and addressing the package.

Fourth. In cases of extension, where no opposition is made, *ex parte* testimony will be received from the applicant: and such testimony as may have been taken by the applicant prior to notice of opposition will be received, unless taken within thirty days after filing the petition for the extension: *Provided*, That, immediately upon receiving notice of opposition, the applicant shall give notice to the opposing party or parties of the names and residences of the witnesses whose testimony has thus been taken.

Fifth. If either party shall be unable, for good and sufficient reasons, to procure the testimony of a witness or witnesses within the stipulated time, it shall be the duty of said party to give notice of the same to the commissioner of patents, accompanied by statements, under oath, of the cause of such inability, and of the names of such witnesses, and of the facts expected to be proved by them, and of the steps which have been taken to procure said testimony, and of the time or times when efforts have been made to procure it; which notice to the commissioner shall be received by him previous to the day of hearing aforesaid. Copies of the papers, and notice of any motion based upon them, must also be served upon the opposite party, as provided in rule 50.

Sixth. Whenever a party relies upon a caveat to establish the date of his invention, the caveat itself, or a certified copy thereof, must be filed in evidence, with due notice to the opposite party, as no notice can be taken by the office of a caveat filed in its secret archives.

The official records of the office, and books and documents contained in the library, and other books in general circulation, may be used at the hearing; but notice of any special matter con-

tained therein, upon which a party relies, should be given to the opposite party previous to the day set for closing testimony.

114. The folios of each deposition must be numbered consecutively, and the name of the witness be plainly and conspicuously written at the top of each folio. It is deemed desirable that the testimony be taken upon legal-cap paper, with a wide margin on the left-hand side of the page, and that only one side of the sheet be written upon.

115. The testimony may be taken in narrative form; but, if either party desires it, it must be taken in answer to interrogatories, having the questions and answers committed to writing in their regular order by the magistrate, or, unless by consent, by some person not interested in the case, either as a party thereto or as attorney. The deposition, when complete, must be signed by the witness.

116. No evidence touching the matter at issue will be considered upon the day of hearing which shall not have been taken and filed in compliance with these rules; but no notice will be taken of any merely formal or technical objection which shall not appear to have wrought a substantial injury to the party raising it; and in such case it should be made to appear that, as soon as the party became aware of the objection, he immediately gave notice thereof to the office, and also to the opposite party, informing him at the same time that, unless corrected, he shall urge his objection at the hearing; but this rule is not to be construed so as to modify well established rules of evidence, which will be applied strictly in all practice before the office.

117. The law requires the clerks of the various courts of the United States to issue subpœnas to secure the attendance of witnesses whose depositions are desired to be read in evidence in any contested cases in the patent office.

118. In contested cases, whether of interference or of extension, parties may have access to the testimony on file prior to the hearing, in presence of the officer in charge; and copies may be obtained by them at the usual rates.

As a general rule, printed copies of the testimony will be required; but this requirement may be dispensed with on special application to the commissioner, and showing satisfactory reasons therefor.

After the testimony is filed in the office, it will not be allowed to be withdrawn by the parties for the purpose of printing; but the testimony may be printed by some one specially designated by the office for that purpose, under proper restrictions.

Three printed copies should be furnished; two for the use of the office, and one for the use of the opposing party. These copies must be filed not less than one week previous to the day of hearing.

It is also desirable that all arguments should be submitted in printed form, and all arguments filed at least two days previous to the day of hearing.

Rules of Correspondence.

119. All correspondence must be in the name of the "commissioner of patents," and all letters and other communications intended for the office must be addressed to him, and postage must be prepaid in full. Communications will not be noticed if addressed to any of the other officers, unless it be seen that the mistake was owing to inadvertence. *A separate letter should in every case be written in relation to each distinct subject of inquiry or application*, the subject of the invention and the date of filing being always carefully noted.

120. When an agent has filed his power of attorney, duly executed, the correspondence will, in ordinary cases, be held with him only, as a double correspondence with an assignee and the inventor, or with an attorney and his principal, if generally allowed, would largely increase the labor of the office. The assignee of an entire interest in an invention is entitled to hold correspondence with the office to the exclusion of the inventor.

121. If the principal becomes dissatisfied, he must revoke his power of attorney and notify the office, which will then communicate directly with him.

122. After a second rejection none of the papers can be inspected, save in the presence of a sworn officer; nor will any of the papers be returned to the applicant or agent.

123. Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner in charge will notify each of said principal parties, and also the attorney, of this fact.

124. Aside from the caveats, which are required by law to be kept secret, all pending applications are, as far as practicable, preserved in like secrecy. No information will therefore be given those inquiring whether any particular case is before the office, or whether any particular person has applied for a patent.

125. But information is given in relation to any case after a patent has issued.

126. The models, in patented cases, are so placed as to be subject to general inspection. The specifications and drawings in any patented case can be seen by any one having occasion to examine them, and copies thereof will be furnished as hereinbefore specified. Copies will be made on parchment, at the request of the applicant, on his paying the additional cost.

127. Even after a case is rejected, the application is regarded as pending, unless the applicant allows the matter to rest for two years without taking any further step therein, in which case it will be regarded as abandoned.

128. Information in relation to pending cases is given so far as it becomes necessary in conducting the business of the office, but no further. Thus, when an interference is declared between two pending applications, each of the contestants is entitled to a

knowledge of so much of his opponent's case as to enable him to conduct his own understandingly.

129. The office can not respond to inquiries as to the novelty of an alleged invention in advance of an application for a patent, nor to inquiries founded upon brief and imperfect descriptions, propounded with a view of ascertaining whether such alleged improvements have been patented, and if so, to whom; nor can it act as an expounder of the patent law, nor as counselor for individuals, except as to questions arising within the office. A copy of the rules, with this section marked, sent to the individual making an inquiry of the character referred to, is intended as a respectful answer by the office.

130. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged verbal promise or understanding, in relation to which there is any disagreement or doubt.

Attorneys.

131. Any person of intelligence and good moral character may appear as the agent or the attorney in fact of an applicant, upon filing a proper power of attorney. As the value of patents depends largely upon the careful preparation of the specification and claims, the assistance of competent counsel will, in most cases, be of advantage to the applicant, but the value of their services will be proportioned to their skill and honesty. So many persons have entered this profession of late years without experience that too much care can not be exercised in the selection of a competent man. The office can not assume responsibility for the acts of attorneys, nor can it assist applicants in making a selection. It will, however, be a safe rule to distrust those who boast of the possession of special and peculiar facilities in the office for procuring patents in a shorter time or with more extended claims than others.

132. Powers of attorney to authorize the attorney to substitute for, or associate with, himself a second agent, must contain a clause of substitution; but such powers will not authorize the second agent to appoint a third.

133. A power of attorney must be filed in every case, both by original and associate attorneys, before such attorney will be allowed to inspect papers or take action of any kind. Parties or their attorneys will be permitted to examine their cases in the attorney's room, but not in the rooms of the examiners. Personal interviews with examiners will be discouraged. All intercourse in relation to pending cases ought to be in writing.

134. Attorneys will be expected to conduct their business with the office with decorum and courtesy. For gross misconduct the commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; and for less offenses

attorneys may be r. ed the privilege of oral interviews, and be required to transact all business with the office in writing.

135. As members of Congress can not examine cases, or act in them without regular powers of attorney, and as cases can not be taken up out of their regular order upon their request, and as the delay in transmitting papers to and from the capitol involves a loss of time which would be avoided by communicating directly with the office, applicants are recommended not to add to the sufficiently arduous duties of their representatives by ordering copies or attempting to transact business with the office through them.

Library.

136. No persons are allowed to take books from the library except those employed in the office.

All books taken from the library must be entered in a register kept for the especial purpose, and returned on the call of the librarian.

Any book lost or defaced must be replaced by another.

Patentees and others doing business with the office can examine the books only in the library hall.

All translations will be made at the usual rates by the office.

Persons will be allowed to make notes or extracts, but not copies or tracings, from works in the library. Such copies will be furnished at the usual rates.

R. H. DUELL,
Commissioner.

Approved.

CHAS. T. GORHAM,
Acting Secretary.

APPENDIX.

REGISTRATION OF PRINTS AND LABELS.

By an act of Congress approved June 18, 1874, (to take effect on and after the 1st day of August, 1874,) it is provided that certain prints and labels may be registered in this office.

SEC. 3. That in the construction of this act the words "engraving," "cut," and "print," shall be applied only to pictorial illustrations of works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print, or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the commissioner of patents, to the party entering the same.

SEC. 4. That all laws and parts of laws inconsistent with the foregoing provisions be, and the same are hereby, repealed.

SEC. 5. That this act shall take effect on and after the first day of August, eighteen hundred and seventy-four.

Approved, June 18, 1874.

By the word "print," as used in the said act, is meant any device, picture, word or words, figure or figures (not a trade-mark) impressed or stamped directly upon the articles of manufacture, to denote the name of the manufacturer, or place of manufacture, style of goods, or other matter.

By the word "label," as therein used, is meant a slip or piece of paper, or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, and packages containing them, and bearing an inscription, (not a trade-mark,) as, for example, the name of the manufacturer or the place of manufacture, the quality of goods, directions for use, &c.

By the words "articles of manufacture," to which such print or label is applicable by said act, are meant all vendible commodities produced by hand, machinery, or art.

But no such print or label can be registered unless it properly belong to an article of commerce, and be as above defined; nor

can the same be registered as such print or label when it amounts in law to a technical trade-mark.

To entitle the owner of any such print or label to register the same in this office, it is necessary that five copies of the same be filed, one of which copies shall be certified under the seal of the commissioner of patents, and returned to the registrant.

The certificate of such registration will continue in force for twenty-eight years.

The fee for registration of a print or label is six dollars, to be paid in the same manner as fees for patents.

The benefits of this act seem to be confined to citizens, or residents of the United States.

Forms for application for registration of labels are given in the appendix of forms.

APPENDIX OF FORMS.

PETITIONS.

1. BY A SOLE INVENTOR.

To the Commissioner of Patents:

Your petitioner, a resident of , , prays that letters patent be granted to him for the invention set forth in the annexed specification.

A. B.

2. BY JOINT INVENTORS.

To the Commissioner of Patents:

Your petitioners, residing respectively in , , and , , pray that letters patent may be granted to them, as joint inventors, for the invention set forth in the annexed specification.

A. B.
C. D.

3. BY AN INVENTOR FOR HIMSELF AND AN ASSIGNEE.

To the Commissioner of Patents:

Your petitioner, a resident of , prays that letters patent may be granted to himself and C. D., of , as his assignee, for the invention set forth in the annexed specification, the assignment to the said C. D. having been duly recorded in the patent office, in liber , page .

A. B.

4. BY AN ADMINISTRATOR.

To the Commissioner of Patents:

Your petitioner, A. B., of , , administrator of the estate of C. D., deceased, (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear,) prays that letters patent may be granted to him for the invention of the said C. D., set forth in the annexed specification.

A. B., *Administrator, &c.*

5. BY AN EXECUTOR.

To the Commissioner of Patents:

Your petitioner, A. B., of , , executor of the last will and testament of C. D., deceased, (as by reference to the duly certified copy of letters testamentary, hereto annexed, will more fully appear,) prays that letters patent may be granted to him for the invention of the said C. D., set forth in the annexed specification.

A. B., *Executor*, &c.,

6. FOR A REISSUE. (BY THE INVENTOR.)

To the Commissioner of Patents:

Your petitioner, of , , prays that he may be allowed to surrender the letters patent for an improvement in coal scuttles, granted to him May 16, 1867, whereof he is now sole owner, [or "whereof C. D., on whose behalf and with whose assent this application is made, is now sole owner, by assignment,"] and that letters patent may be reissued to him [or "the said C. D."] for the same invention, upon the annexed amended specification. Accompanying this petition is an abstract of title, duly certified, as required in such cases.

A. B.

ASSENT OF ASSIGNEE TO REISSUE.

The undersigned, assignee of the entire [or an undivided] interest in the above mentioned letters patent, hereby assents to the accompanying application.

C. D.

7. FOR A REISSUE, (BY ASSIGNEE.)

(To be used only when the inventor is dead, or the original patent was issued and assigned prior to July 8, 1870.)

To the Commissioner of Patents:

Your petitioners, of the city of , State of , pray that they may be allowed to surrender the letters patent for an improvement in coal scuttles, granted May 16, 1867, to E. F., now deceased, whereof they are now owners, by assignment, of the entire interest, and the letters patent may be reissued to them for the same invention, upon the annexed amended specification. Accompanying this petition is an abstract of title, duly certified, as required in such cases.

A. B.
C. D.

8. FOR AN EXTENSION, (BY A PATENTEE.)

To the Commissioner of Patents:

Your petitioner, now residing at , , prays that letters patent No. 12841, for an improvement in steam engines, granted to him August 17, 1853, may be extended for seven years from and after the expiration of the original term.

A. B.

9. FOR AN EXTENSION, (BY AN ADMINISTRATOR.)

To the Commissioner of Patents:

Your petitioner, A. B., of , , administrator of the estate of C. D., deceased (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear), residing at , , prays that letters patent No. 12842, for an improvement in stoves, granted to said C. D., August 24, 1853, may be extended for seven years from and after the expiration of the original term.

A. B., *Administrator.*

10. FOR LETTERS PATENT FOR A DESIGN.

To the Commissioner of Patents:

Your petitioner, residing in , , prays that letters patent may be granted to him for the term of three and one-half years [or "seven years," or "fourteen years"] for the new and original design set forth in the annexed specification.

A. B.

11. FOR THE REGISTRATION OF A TRADE-MARK.

To the Commissioner of Patents:

Your petitioner [or petitioners, if a firm] respectfully represents that he [or it, if a corporation] is engaged in the manufacture of , at , and at , , and that he is entitled to the exclusive use upon the class of goods which he manufactures, of the trade-mark described in the annexed statement or specification [and accompanying fac-simile].

He therefore prays that he may be permitted to obtain protection for such lawful trade-mark under the law in such cases made and provided.

A. B.

12. FOR THE RENEWAL OF AN APPLICATION.

To the Commissioner of Patents:

Your petitioner represents that on May 8, 1868, he filed an application for letters patent for an improvement in churns, which

application was allowed July 7, 1868, but that he failed to make payment of the final fee within the time allowed by law. [Or "which application has been rejected, but has not been abandoned."] He now makes renewed application for letters patent for said invention, and prays that the original specification, oath, drawings, and model may be used as a part of this application.

A. B.

13. PETITION WITH POWER OF ATTORNEY.

To the Commissioner of Patents:

Your petitioner, a resident of the city of , State of , prays that letters patent may be granted to him for the invention set forth in the annexed specification; and he hereby appoints C. D., of the city of , State of , his attorney, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent office connected therewith.

A. B.

14. POWER OF ATTORNEY.

If the power of attorney be given at any time other than that of making application for patent, it will be in substantially the following form:

To the Commissioner of Patents:

The undersigned having, on or about the 20th day of July, 1859, made application for letters patent for an improvement in a horse power, hereby appoints C. D., of the city of , State of , his attorney, with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent office connected therewith.

A. B.

Signed at , and State of , this day of , 18 .

15. REVOCATION OF POWER OF ATTORNEY.

The undersigned having, on or about the 26th day of December, 1867, appointed C. D., of the city of , and State of , his attorney to prosecute an application for letters patent, made on or about the 1st day of June, 1868, for an improvement in the running gear of wagons, hereby revokes the power of attorney then given.

Signed at , , this 21st day of July, 1869.

A. B.

SPECIFICATION.

16. FOR A MECHANICAL DEVICE.

(*See Rule* 19 *for instructions for making drawings.*)

To all whom it may concern:

Be it known that I, , of , in the county of , and State of , have invented a new and useful improvement in machine clutch, which improvement is fully set forth in the following specification and accompanying drawing, in which

Figure 1 is a perspective view of a sawing machine with my clutch attached; Figure 2 a front view of the clutch; and Figure 3 a longitudinal section of the same.

The object of my invention is to furnish a device by which to connect or disconnect a pulley with the shaft on which it is placed, so that the motion of the shaft may be communicated to the pulley or not, as desired.

In the drawings: A is the shaft; BB are pulleys, loose upon the shaft, and prevented from longitudinal movement by collars CC. D is a sleeve fitted to the shaft and made to revolve with it by means of a spline E, but having a free longitudinal movement on the shaft. Bars, I I, are connected to and carried by the sleeve, one at each end. These bars have T heads on the ends toward the pulleys, and the pulleys have annular slots of shape to receive these heads and permit them to travel round and round, but to prevent them from turning on their own centers. The bars have longitudinal movement in the sleeve parallel to the shaft A, but a tendency to a rotatory movement is given to the bars when the sleeve is moved lengthwise, by means of a spiral slot in the bars and a pin in the sleeve, as shown in Figures 2 and 3.

It will be seen from the foregoing that when the sleeve is in position midway between the two pulleys, both will be disconnected, and the T or bolt heads on bars I I will run round and round in the annular slots without driving the pulleys. When the sleeve is shifted to one side, however, the spiral groove and pin act like a screw thread, and clamp the pulley and sleeve firmly together, as between a bolt head and nut. The opposite pulley, of course, runs free at the time.

The operation of my device is not confined to a double pulley movement. It is obvious that a single pulley may be driven in the same way.

Having thus described my invention, what I claim as new and desire to secure by letters patent is:

1. The sleeve D, having bar I connected therewith by spiral groove and pin connection, substantially as shown and described.

2. The combination of the sleeve D, bar I, connected therewith

as shown, pulley B, and shaft A, all substantially as shown and described.

A. B.

Witnesses: C. D.
E. F.

17. FOR A PROCESS.

To all whom it may concern:

Be it known that I, [here insert the name of the inventor,] of , in the county of , and State of , have invented a new and useful process for separating smut and other impurities from wheat, which process is fully set forth in the following specification:

This invention relates to that class of processes employed for removing "smut" and other impurities mixed with and adhering to grain; and it consists in mixing "newly slaked" lime, while yet warm, with the grain before it is passed through the smut mill.

In carrying out our invention, take of lime newly slaked, and while yet warm, one and a half pounds to each one hundred pounds of wheat. Mix the lime well with the wheat, let it stand one hour, then pass it through a smut-mill in the usual way, and it will be found that all the lime, smut, dirt, and other impurities attached to the wheat, of every kind (and which no smut mill without my liming process will fully separate), will be entirely removed, and the flour will be as white and as sweet as though made from the best of wheat.

We are aware that lime has before been used for the purpose of cleaning wheat, being first mixed with the grain as above proposed, and the whole being then passed through a smut-mill; but in all previous processes, so far as we are aware, the lime has been used in a cold state, and for this reason they have proved ineffectual. We propose to take lime newly slacked and while yet warm.

We claim as our invention—

The process of cleaning wheat by mixing with it lime newly slacked and warm before passing it through a smut-mill, so as to cleanse the wheat from all impurities, substantially as described.

A. B.
C. D.

Witnesses: E. F.
G. H.

18. FOR A COMPOSITION OF MATTER.

To all whom it may concern:

Be it known that I, [here insert the name of the inventor,] of , in the county of , and State of , have invented

a new and useful compound, called "wool-oil," which compound is fully described in the following specification:

This invention relates to that class of compounds used to lubricate wool in the process of manufacture; and it consists in a composition formed by mixing any one or more of the oils ordinarily used in manufacturing wool, such as olive, lard, or rape-seed oil, with a solution of oil-soap.

To prepare the wool-oil, take a quantity of oil-soap of any kind, provided the quality be good, and dissolve the same in hot water, say about thirty pounds of oil-soap to thirty gallons of water, or a sufficient quantity of soap to saturate the water. Then take equal parts, by measure, of olive, lard, rape seed, or any other kind of oil which can be used on wool in the process of its manufacture, and mix with it the preparation aforesaid, to wit, the solution, which, after such mixture, is ready to be used on wool with as beneficial an effect as if pure oil only had been used. The wool-oil will not decompose by age, because the oil volatilizes the stearine in the oil; hence there is not that decompose. And for the same reason spontaneous combustion is prevented.

I claim:

A compound consisting of an oil or oils, ordinarily used in the lubrication of wool, in combination with a solution of an oil-soap, substantially as and for the purpose specified.

C. D.

Witnesses: E. F.
G. H.

19. FOR A DESIGN.

To all whom it may concern:

Be it known that I, [here insert the name of the originator of the design,] of , in the county of , and State of , have originated and designed a pattern for carpets, or other fabrics, of which the following is a full, clear and exact description, reference being had to the accompanying photographic illustration, [or drawing,] making part of this specification:

A represents a portion of the body of the carpet and B a portion of the border. The body may be ornamented with any figures that may be selected; the border consists of three parallel stripes, the middle one wide, and the other two narrow. Along the middle stripe of the border run two angular bars, crossing each other and intertwining, as shown, while the narrow stripes are ornamented with rows of spots arranged in groups of three, so as to form triangles. Suitable colors should be employed to produce a harmonious effect.

What I claim as my invention is:

A design for a carpet in which the border is composed of stripes ornamented substantially in the manner above described.

20. FOR A TRADE-MARK.

[*If the application is made by a corporation or a firm, this form should be modified to conform to the facts.*]

To all whom it may concern:

Be it known that I, [here insert the name of the applicant,] domiciled in [the United States, or in the Dominion of Canada, or as the case may be], and residing at , and doing business at , in the county of , and State of , have adopted [or intend to adopt] for my use a trade-mark for , of which the following specification is a full, clear, and exact description:

My trade-mark consists of the letters and words, "S. N. & Co.'s Buckeye Sheetings." These generally have been arranged as shown in the accompanying fac-simile; above and below a figure of a man represented as ascending the side of a mountain and carrying a banner, upon which is inscribed the word "Buckeye;" and the whole has been inclosed within an ornamental border substantially like that shown in the fac-simile. But the figure of the man with the banner may be omitted, or some other device substituted for it, and the border may be changed at pleasure or omitted altogether without materially changing the character of my trade-mark, the essential features of which are the letters "S. N. & Co.'s" and the word symbol "Buckeye."

This trade-mark I have used in my business for ten years last past.

The class of merchandise to which the trade-mark is appropriated is ; and the particular description of goods [comprised in said class] upon which I intend to use my said trade-mark are . I have been accustomed to print it in blue ink upon each piece of said goods, and also to have it printed on labels, which I afterwards paste upon said articles or on boxes and cases containing the same.

A. B.

Witnesses: C. D.
F. H.

21. AMENDMENT.

WASHINGTON, D. C., *July* 20, 1869.

To the Commissioner of Patents:

In the matter of my application for letters patent for an improvement in wagon brakes, I hereby amend my specification by striking out all between the ninth and twentieth lines, inclusive, on page 3; by inserting the words "*connected with*" after the word "*and*" in the first line of the second claim; and by striking out the third claim and substituting therefor the following:

3. The combination of the self-acting brake C, pin A, and slotted flanges D, substantially as described, and for the purposes set forth.

A. B.,
By C. D.,
His Attorney in Fact.

OATHS.

22. BY A SOLE INVENTOR.

(To follow specification.)

STATE OF , *County of* , *ss.:*

A. B., the above-named petitioner, being duly sworn, [or affirmed], deposes and says, that he verily believes himself to be the original and first inventor of the improvement in seed-drills described and claimed in the foregoing specification; that he does not know and does not believe that the same was ever before known or used; and that he is a citizen of , and a resident of .

A. B.

Sworn to and subscribed before me this 13th day of March, 1869.

C. D.,
Justice of the Peace.

[If the applicant be an alien, the sentence "and that he is a citizen of the United States" will be omitted, and in lieu thereof will be substituted "and that he is a citizen of the Republic of Mexico," or "and that he is a subject of the King of Italy," or "of the Queen of Great Britain," or as the case may be.

If the applicants claim to be *joint inventors*, the oath will read "that they verily believe themselves to be the original, first and joint inventors," &c.

If the inventor be dead, the oath will be taken by the administrator or executor, and will declare his belief that the party named as inventor was the original and first inventor.]

23. BY AN APPLICANT FOR A REISSUE (INVENTOR).

STATE OF , *City and County of* , *ss.:*

A. B., the above-named petitioner, being duly sworn [or affirmed], deposes and says, that he verily believes that, by reason of an insufficient or defective specification, his aforesaid letters patent are inoperative or invalid; that the said error has arisen from inadvertance, accident or mistake, and without any fraudulent or deceptive intention, to the best of his knowledge and belief; that he is the sole owner of said letters patent [or, "that E. F. is the sole owner of said letters patent, and that this application is made on the behalf and with the consent of said E. F."];

and that he verily believes himself to be the first and original inventor of the improvement set forth and claimed in this amended specification.

A. B.

Sworn to and subscribed before me this 26th day of July, 1869.

C. D.,
Notary Public.

[Notarial seal.]

24. BY AN APPLICANT FOR A REISSUE (ASSIGNEE).

(To be used only when the inventor is dead or when the patent was issued and assigned prior to July 8, 1870.)

STATE OF , *County of* , *ss.:*

A. B. and C. D., the above named petitioners, being duly sworn [or affirmed], depose and say, that they verily believe that, by reason of an insufficient specification, the aforesaid letters patent granted to E. F. are inoperative; that the said error has arisen from inadvertence, accident or mistake, and without any fraudulent or deceptive intention, to the best of their knowledge and belief; that the entire title to said letters patent is vested in them; and that they verily believe the said E. F. to be the first and original inventor of the invention set forth and claimed in the foregoing amended specification; and that the said E. F. is now deceased.

A. B.
C. D.

Sworn to and subscribed before me this 14th day of November, 1869.

A. B.,
Justice of the Peace.

25. BY AN APPLICANT FOR EXTENSION (PATENTEE).

STATE OF , *County of* , *ss.:*

A. B., the above-named applicant, being duly sworn [or affirmed], deposes and says, that the foregoing statement and account by him signed are correct and true in all respects and particulars, to the best of his knowledge and belief.

A. B.

Sworn to and subscribed before me this 1st day of November, A. D. 1868.

C. D.,
Justice of the Peace.

26. BY AN APPLICANT FOR AN EXTENSION (EXECUTOR).

STATE OF , *County of* , *ss.:*

A. B., executor of the last will and testament of Simon New

come, deceased, being duly sworn [or affirmed], deposes and says, that the foregoing statement and account by him subscribed are correct and true in all respects and particulars, to the best of his information, knowledge and belief.

A. B.
Executor, &c.

Sworn to and subscribed before me this 20th day of May, 1869.

C. D.,
Justice of the Peace.

27. SUPPLEMENTAL OATH TO ACCOMPANY A NEW OR AN ENLARGED CLAIM.

STATE OF , *County of* , *ss.:*

A. B., whose application for letters patent for an improvement in seed-drills was filed in the United States Patent Office on or about the 15th day of March, 1869, being duly sworn [or affirmed], deposes and says, that, in addition to the claims originally made, he verily believes himself to be the original and first inventor of the improvement as described and claimed in the foregoing amendment, and that he does not know, and does not believe, that the same was ever before known or used.

A. B.

Sworn to and subscribed before me this 11th day of July, 1870.

C. D.,
Justice of the Peace.

28. OATH AS TO THE LOSS OF LETTERS PATENT.

STATE OF , *County of* , *ss.:*

A. B., of said county, being duly sworn [or affirmed], doth depose and say, that the letters patent No. 12213, granted to him, and bearing date on the 9th day of January, A. D. 1855, have been either lost or destroyed; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and that he has not been able to find them.

A. B.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.
Justice of the Peace.

29. OATH OF ADMINISTRATOR AS TO THE LOSS OF LETTERS PATENT.

STATE OF , *County of* , *ss.:*

A. B., of said county, being duly sworn, doth depose and say,

that he is administrator of the estate of E. F., deceased, late of Boston, in said county; that the letters patent No. 12219, granted to said E. F., and bearing date on the 9th day of January, A. D. 1855, have been lost or destroyed, as he verily believes; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and especially among the papers of the decedent, and that he has not been able to find said letters patent.

A. B.,
Administrator, &c.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.
Justice of the Peace.

30. OATH OF APPLICANT FOR REGISTRATION OF A TRADE-MARK.

[*If the application is made by a corporation, or a firm, this form should be modified to conform to the facts.*]

STATE OF , *County of* , *ss.*:

A. B., being duly sworn, deposes and says, that he is the applicant named in the accompanying petition; that he verily believes that the facts set forth in the foregoing specification are true; that he has a right to the use of the trade-mark described in said specification; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the description and fac-similes presented for record are true copies of the trade-mark sought to be protected, and that he is a citizen of the United States [or, a citizen of the Republic of France, or, as the case may be].

A. B.

Sworn to and subscribed before me this 15th day of , 187 .

E. F.,
Justice of the Peace.

APPEALS.

31. FROM THE EXAMINER TO THE EXAMINERS IN CHIEF.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners in chief from the decision of the principal examiner in the matter of my application for letters patent for an improvement in wagon-brakes, which, on the 20th day of July, 1869, was rejected the second time. The following are assigned for reasons of appeal: [Here follow the reasons].

A. B.

31*a*. FROM THE EXAMINER OF TRADE-MARKS TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: I hereby appeal to you in person from the decision of the examiner of trade-marks, dated November 15, 1872, in the matter of my application for the registration of a trade-mark for cigars. The following are the reasons assigned: [Here follow the reasons].

32. FROM THE EXAMINER IN CHARGE OF INTERFERENCES TO THE EXAMINERS IN CHIEF.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners in chief, from the decision of the principal examiner in charge, in the matter of the interference between my application for letters patent for improvement in sewing machines and the letters patent of A. B., in which priority of invention was awarded to said A. B. The following are assigned for reasons of appeal: [Here follow the reasons].

C. D.

33. FROM THE EXAMINERS IN CHIEF TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: We hereby appeal to the commissioner in person from the decision of the examiners in chief, in the matter of our application for the reissue of letters patent for an improvement in cotton presses, granted to A. B., May 18, 1865. The following are assigned for reasons of appeal: [Here follow the reasons].

C. D.
E. F.

34. FROM THE COMMISSIONER TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

WASHINGTON, D. C., *July* 20, 1871.

To the Supreme Court of the District of Columbia, in banc:

The petition of A. B., of , in the county of , and , respectfully showeth: That he has heretofore invented a new and useful improvement in velocipedes; that on or about the 1st day of May, 1870, he applied to the patent office of the United States for a patent for the same [or for the reissue of a patent granted therefor under date of June 10, 1862], and complied with the requirements of the several acts of Congress, and with the rules of the patent office prescribed in such cases; that his said application was rejected by the commissioner of patents, on appeal to him on or about June 20, 1871; that he has filed in said office due notice to the commissioner of patents, of this his

appeal, accompanied with the reasons of appeal; and that the commissioner had furnished him with complete copies of all the original papers and evidence in the case, all of which, together with a copy of the reasons of appeal, accompany this petition, and are to be taken as a part hereof.

And the said A. B. prays that his said appeal may be heard and determined by your honorable court at such early time as may be appointed for that purpose; and that the commissioner of patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

A. B.

To the Commissioner of Patents:

A. B. of , in the county of , and State of , hereby gives notice that he has appealed from your decision, rendered on or about the 20th day of June, 1871, rejecting his application for a patent [or, for a reissue of a patent granted to him June 10, 1862,] for an improvement in velocipedes; and of this you are respectfully requested to take notice.

And the said A. B. assigns the following reasons for appealing from the said decision of the commissioner of patents, viz.:

[Here follow reasons, which should be full and explicit, and constitute a brief of the appellant's argument.]

A. B.

35. RULES OF THE SUPREME COURT IN APPEALS FROM THE COMMISSIONER OF PATENTS, ADOPTED NOVEMBER 30, 1870.

1. The appellant's petition shall be addressed to the court, and shall be substantially as follows:

"*To the Supreme Court of the District of Columbia, in banc,* , 187 .

"The petition of , a citizen of , in the [*State, Territory, District*] of , respectfully shows as follows:

"*a.* About the day of , 18 , I invented [*describe the subject of the desired patent in the identical words of the application to the patent office*].

"*b.* On the day of , 18 , in the manner prescribed by the law, I presented my application to the patent office, praying that a patent be issued to me for said invention.

"*c.* Such proceedings were had in said office, upon said application, that on the day of , 18 , it was rejected by the commissioner of patents.

"*d.* I thereupon appealed to this court, and gave notice thereof to the commissioner, and filed in his office the following reasons for said appeal:

"*e.* The commissioner of patents has furnished me a com-

plete copy of all the proceedings in his office upon my said application, which copy has been filed herewith, and is to be taken as part hereof.

"*f.* And thereupon I pray that the court do revise and reverse said decision, to the end that justice may be done in the premises.

"_____ _____"

2. This petition shall be filed in the clerk's office of this court; and as soon as the petitioner has made the deposit required by law, at the commencement of suits in this court, or said deposit has been dispensed with, the clerk shall enter the case in a docket to be provided by him for the purpose, and in which a brief of said filing and of all subsequent proceedings in the case shall be entered as and when they successively occur, down to and including the final decision.

3. The clerk shall provide a minute-book of his office, in which he shall record every order, rule, judgment, or decree of the court in each case, in the order of time in which said proceedings occur; and of this book there shall be two alphabetical indexes, one showing the name of the party applying for the patent, and the other designating the invention by its subject-matter or name.

4. The cases in the docket of causes shall be successively numbered from No. 1 onward, and each case shall also be designated by the number assigned to it on the records of the patent office.

5. This docket shall be called for the trial of the cases thereon, on the first day of each session of this court in general term, provided the petition has been filed ten days before the commencement of the term.

6. The opinions of the court, when written, shall be kept by the clerk in the order of their delivery and in a temporary book-file, indexed; and when so many have been delivered as will make a volume of convenient size, he shall cause them to be bound.

7. The clerk shall furnish to any applicant a copy of any paper in any of said appeals on payment of the lawful fees.

8. Hearings of said appeals shall be subject to the rules of the court provided for other causes therein.

9. When the testimony of the commissioner, or of any examiner, touching the principles of invention in question, shall be deemed necessary, it shall be taken orally in open court, unless otherwise ordered by the court. And, in such case, the court may order it to be reduced to writing, or filed or entered on its minutes, if it think proper.

10. The final judgment or order of the court shall not recite any of the facts made to appear in the case, but shall be to the following effect:

"This appeal having been heard upon the record from the patent office, [and upon the testimony of the commissioner of patents,] [of one of the examiners,] [touching the principles of the inven-

tion,] and having been argued by [counsel for] the petitioner and [for] the commissioner.

"It is thereupon ordered and adjudged that the [petition be dismissed,] [commissioner do issue to the petitioner a patent,] [as prayed,] [granting the petitioner (*so and so*)].

"And that the clerk of this court transmit to the commissioner of patents a copy of this decree duly authenticated."

36. DISCLAIMER.

To the Commissioner of Patents:

Your petitioner, A. B., of , county of , and State of , represents that he has, by grants duly recorded in the United States patent office, liber , p. , become the owner of an exclusive right within and for the several States of [Maine, New Hampshire, and Vermont] to make, use, and vend to others to be used, a certain improved mechanical movement, for which letters patent of the United States were granted to C. D. of , in the county of , and State of , April 1, 1869; that he has reason to believe that, through inadvertence, accident, or mistake, the specification and claim of said letters patent are too broad, including that of which said patentee was not the first inventor. Your petitioner, therefore, hereby enters his disclaimer to that part of the claim in said specification which is in the following words, to wit:

"I also claim the sleeves A B, having each a friction cam C, and connected, respectively, by means of chains or cords K L and M N, with an oscillatory lever, to operate substantially as herein shown and described."

A. B.

Witness:
C. D.

37. CAVEAT.

The petition of A. B., of , in the county of , and State of , respectfully represents:

That he has made certain improvements in velocipedes, and that he is now engaged in making experiments for the purpose of perfecting the same, preparatory to applying for letters patent therefor. He therefore prays that the subjoined description of his invention may be filed as a caveat in the confidential archives of the patent office.

A. B.

Specification.

The following is a description of my newly invented velocipede, which is as full, clear, and exact as I am able to give, reference being had to the drawing hereto annexed.

This invention relates to that class of velocipedes in which there are two wheels connected by a beam forming a saddle for the rider, the feet being applied to cranks that revolve the front wheel.

The object of my invention is to render it unnecessary to turn the front wheel so much as heretofore, and at the same time to facilitate the turning of sharp curves. This I accomplish by fitting the front and the hind wheels on vertical pivots, and connecting them by means of a diagonal bar, as shown in the drawing, so that the turning of the front wheel also turns the back wheel with a position at an angle with the beams, thereby enabling it easily to turn a curve.

In the drawing, A is the front wheel, B the hind wheel, and C the standards extending from the axle of the front wheel to the vertical pivot *a*, in the beam *b*, and D is the cross-bar upon the end of *a*, by which the steering is done. The hind wheel B is also fitted with jaws *c* and a vertical pivot *d*.

A. B.

Witnesses: C. D.
E. F.

[The form of oath will be substantially that provided for original applications, except that, as a caveat can only be filed by a citizen, or an alien who has resided for one year last past in the United States, and made oath of his intention to become a citizen, the oath should be modified accordingly.]

ASSIGNMENTS.

38. OF AN ENTIRE INTEREST IN AN INVENTION BEFORE THE ISSUE OF LETTERS PATENT.

Whereas I, A. B., of , county of , State of , have invented a certain new and useful invention, or improvement in , [giving the title of the same], for which I am about to make application for letters patent of the United States; and whereas, G. D., of , county of , State of , is desirous of acquiring an interest in said invention, and in the letters patent to be obtained therefor:

Now, therefore, to all whom it may concern, be it known, that for and in consideration of the sum of dollars, to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned, transferred, and set over, and by these presents do sell, assign, transfer, and set over unto the said G. D., the full and exclusive right to the said invention, as fully set forth and described in the specification prepared and executed by me preparatory to obtaining letters patent of the United States therefor, and I do hereby authorize and request the commissioner

of patents to issue the said letters patent to the said G. D., as the assignee of my entire right, title, and interest in and to the same, for the sole use and behoof of the said G. D. and his legal, representatives.

In testimony whereof I have hereunto set my hand and affixed my seal this day of , A. D. 187 .

A. B. [SEAL.]

In presence of:
O. P.
S. T.

39. OF THE ENTIRE INTEREST IN LETTERS PATENT.

Whereas I, C. D., of , county of , State of . did obtain letters patent of the United States for [mentioning the title of the invention], which letters patent are numbered , and bear the date the day of , in the year one thousand eight hundred and , and whereas I am now the sole owner of said patent and of all rights under the same; and whereas E. F., of , county of , State of , is desirous of acquiring the entire interest in the same:

Now, therefore, to all whom it may concern, be it known, that for and in consideration of the sum of dollars, to me in hand paid, the receipt of which is hereby acknowledged, I, the said C. D., have sold, assigned, transferred, and set over, and by these presents do sell, assign, transfer, and set over unto said E. F., all the right, title, and interest whatsoever which I have in and to the said improvement in [title], and in and to the letters patent therefor aforesaid; the same to be held and enjoyed by the said E. F., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted [thus including extension], as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof have hereunto set hand and affixed seal this day of , A. D. 187 .

C. D. [SEAL.]

In presence of:
N. P.
O. T.

40. OF AN UNDIVIDED INTEREST IN THE LETTERS PATENT.

Whereas I, L. M., of , county of , State of , did obtain letters patent of the United States for [giving title], which letters patent are numbered , and bear date the day of , in the year one thousand eight hundred and ; and whereas D. E., of , county of , State of , is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known, that for and in consideration of the sum of dollars, to me in hand paid, the receipt of which is hereby acknowledged, I, the said L. M., have sold, assigned, transferred, and set over, and by these presents do sell, assign, transfer, and set over, unto the said D. E., the undivided one-half part of all the right, title, and interest whatsoever which I have in and to the said invention, and in and to the letters patent therefor aforesaid; the said undivided one-half part to be held and enjoyed by the said D. E., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted (thus including extension), as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof have hereunto set hand and affixed seal, this day of , A. D. 187 .

—— ——. [SEAL.]

In the presence of:

—— ——.

—— ——.

41. TERRITORIAL INTEREST AFTER GRANT OF PATENT.

Whereas I, Q. X., of , county of , State of , did obtain letters patent of the United States for (giving title), which letters patent are numbered , and bear date the day of , in the year one thousand eight hundred and ; and whereas I am now the sole owner of the said patent and of all rights under the same in the below recited territory; and whereas W. O., of , county of , State of , is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known, that for and in consideration of the sum of dollars, to me in hand paid, the receipt of which is hereby acknowledged, I, the said Q. X., have sold, assigned, transferred, and set over, and by these presents do sell, assign, transfer, and set over, unto the said W. O., all the right, title, and interest whatsoever which I have in and to the said invention (or improvement), as secured to me by said letters patent, for, to, and in the State of , and for, to, or in no other place or places; the same to be held and enjoyed by the said W. O. within and throughout the above specified territory, but not elsewhere, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted (thus including extension), as fully and entirely as the same would have been held and enjoyed by me therein had this assignment and sale not been made.

In testimony whereof have hereunto set hand and affixed seal, this day of , A. D. 187 .

Q. X. [SEAL.]

In the presence of:
S. T.
R. D.

42. LICENSE—SHOP-RIGHT.

In consideration of fifty dollars, to be paid by the firm of S. J. & Co., of , I do hereby license and empower the said S. J. & Co. to manufacture, at a single foundery and machine-shop in said , and in no other place or places, the improvement in cotton-seed planters for which letters patent of the United States No. 71846 were granted to me November 13, 1868, and to sell the machines so manufactured throughout the United States, to the full end of the term for which said letters patent are granted.

Witness my hand this 22d day of April, 1869.

A. B.

43. LICENSE—NOT EXCLUSIVE—WITH ROYALTY.

This agreement, made this 12th day of September, 1868, between A. B., party of the first part, and C. D. & Co., party of the second part, witnesseth that, whereas letters patent of the United States for an improvement in horse-rakes were granted to the party of the first part, dated October 4, 1867; and whereas the party of the second part is desirous of manufacturing horse-rakes containing said patented improvement: Now, therefore, the parties have agreed as follows:

I. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their factory in , and in no other place or places, to the end of the term for which said letters patent were granted, horse-rakes containing the patented improvements, and to sell the same within the United States.

II. The party of the second part agrees to make full and true returns to the party of the first part, under oath, upon the first days of July and January in each year, of all horse-rakes containing the patented improvements manufactured by them.

III. The party of the second part agrees to pay to the party of the first part five dollars, as a license fee upon every horse-rake manufactured by said party of the second part containing the patented improvements; provided, that if the said fee be paid upon the days provided herein for semi-annual returns, or within ten days thereafter, a discount of fifty per cent. shall be made from said fee for prompt payment.

IV. Upon a failure of the party of the second part to make returns, or to make payment of license fees, as herein provided, for thirty days after the days herein named, the party of the first part may terminate this license by serving a written notice upon

the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license fees due at the time of the service of said notice.

In witness whereof the parties above named (the said Uniontown Agricultural Works, by its president) have hereunto set their hands the day and year first above written.

A. B.

C. D. & CO.

44. TRANSFER OF A TRADE-MARK.

We, A. B. and C. D., of , partners under the firm name of B. & D., in consideration of five hundred dollars to us paid by E. F., of the same place, do hereby sell, assign and transfer to the said E. F., and his assigns, the exclusive right to use in the manufacture and sale of stoves a certain trade-mark for stoves, deposited by us in the United States Patent Office, and recorded therein July 15, 1870, the same to be held, enjoyed and used by the said E. F., as fully and entirely as the same would have been held and enjoyed by us if this grant had not been made.

Witness our hands this 20th day of July, 1870.

A. B.
C. D.

EXTENSIONS.

45. STATEMENT AND ACCOUNT.

In the matter of the application of A. B., of the city, county and State of New York, executrix of the last will and testament of C. D., deceased, for extension of Letters Patent No. 10817, granted to him January 9, 1855, for improvements in mowing machines.

To the Commissioner of Patents:

The applicant respectfully represents that, prior to obtaining the letters patent now sought to be extended, the said C. D. was a farmer; that his attention was called to the subject of mowing machines by the difficulty of cutting grass by the machines then in use; that, after numerous patient and costly experiments, he succeeded in perfecting his invention and in obtaining his patent. He immediately made arrangements to manufacture the improvement, and for this purpose sold three-fourths of his farm. He then, with others, built a factory and commenced operations; but, two years afterward, the establishment was destroyed by fire, without insurance. In the exposure at the fire C. D. contracted a disease which confined him to the house for three years, when he died, leaving applicant, his executrix and widow, with a large family and small means. Nevertheless, applicant made every

effort to induce manufacturers to use the improvement, and at last succeeded in inducing the firm of E. T. & Co., of , to recommence the manufacture of the machines. But after four years the firm failed, being largely in debt to applicant for royalties. After this it became impossible for applicant to do anything with the invention. She wrote to various manufacturers, and made personal application to others, but found them unwilling to make arrangements to pay royalties, or to use the invention in any way, unless she would sell the patent, including the extension, for a nominal sum. She states, however, that she has at length succeeded in perfecting an agreement with G. H. & Co., of , conditioned upon the extension, whereby the said firm agreed to manufacture the patented machines, and to pay her a royalty of three dollars upon each one made. Aside from the interest so vested in G. H. & Co., the entire interest in the extension remains vested in her, and she has made no assignment, contract or agreement of any kind for the sale or assignment of the extended term to any person whatsoever.

The following is believed to be a correct statement of receipts and expenditures, and is as full as it is possible to make it:

Receipts.

From profits from business (for particulars for which see Schedule A)	$1,236 00
From royalties from E. T. & Co. (for details of which see Schedule B)	2,341 50
From sale of shop right to L. M	250 00
Total receipts	$3,827 50

Expenditures.

Expense of procuring patent	$250 00
Net receipts	$3,577 50

The invention is exceedingly useful, as will be abundantly proved. The testimony will show that it has been introduced upon 20,000 mowing machines, and has increased the value of said machines not less than three dollars each. It is evident, therefore, that the public have been greatly benefited by the use of this invention, while the fact that C. D. invested his entire time and means, and finally lost his life in the prosecution of his invention, is respectfully offered as proof that he has not been adequately remunerated for his time, ingenuity and expense bestowed upon this invention, and the introduction thereof into use.

Respectfully submitted,

A. B., *Executrix.*

[Here follows oath. See Form 25.]

46. REASONS OF OPPOSITION TO AN EXTENSION (BY INDIVIDUALS).

In the matter of the application of A. B. for an extension of letters patent for improvements in sewing machines, No. 12213, dated May 15, 1855.

To the Commissioner of Patents:

We wish to oppose the application above referred to, for the following reasons, viz.:

First. Applicant was not the original and first inventor of the improvement claimed by him in said letters patent, the same having been fully described in the English patent No. 27, of the year 1853.

Second. If said alleged invention was ever made by applicant, which we deny, it is not *useful.*

Third. Said invention is not *valuable* and *important* to the public.

Fourth. Applicant has been *adequately remunerated* for his time, ingenuity and expense in originating and perfecting his alleged invention.

Fifth. Applicant has not used due diligence in introducing his alleged invention into general use.

Sixth. Applicant has assigned to other parties all interest in the extension; and the extension, if granted, would not be for his benefit.

(See assignment to C. D., dated April 1, 1864; recorded June 2, 1864, in liber J[10], page 217.)

Seventh. The statement and account filed by applicant do not present a true statement of his receipts and expenditures.

E. F.
G. H.
I. K.

DEPOSITIONS.

47. NOTICE OF TAKING TESTIMONY.

BOSTON, MASSACHUSETTS, *March* 29, 1869.

In the matter of the interference between the application of A. B., for a paper collar machine, and the patent No. 85038, granted December 15, 1868, to C. D., now pending before the Commissioner of Patents.

SIR: You are hereby notified that on Wednesday, March 31, 1869, at the office of E. F., Esq., No. 30 Court street, Boston, Massachusetts, at nine o'clock in the forenoon, I shall proceed to take testimony of G. H., J. K. and L. M., all of Boston, as witnesses in my behalf.

The examination will continne from day to day until completed. You are invited to attend and crose-examine.

A. B.,
By R. Q., *his Attorney.*

——— ———, *Providence, Rhode Island.*

Proof of Service.

STATE OF , *County of* , *ss.:*

Personally appeared before me, a justice of the peace, the above-named A. B., who, being duly sworn, deposes and says that he served the above notice upon O. P., the attorney of the said C. D., at one o'clock, P. M., of the 30th day of March, 1869, by leaving a copy at his office in Providence, Rhode Island, in charge of his partner, R. S.

A. B.

Sworn to and subscribed before me, this 31st day of March, 1869.

E. F.

(Service may be acknowledged by the party upon whom it is made as follows:

Service of the above notice acknowledged.

C. D.,
By E. F., *his Attorney.*]

48. FORM OF DEPOSITION.

Before the Commissioner of Patents, in the matter of the interference between the application of A. B., for a paper collar machine, and the Letters Patent No. 58038, granted December 15, 1868, to C. D.

Depositions of witnesses examined on behalf of A. B., pursuant to the annexed notice, at the office of E. F., No. 30 Court street, Boston, Massachusetts, on Wednesday, March 31, 1869. Present, S. T., Esq., on behalf of A. B., and V. W., Esq., on behalf of C. D.

G. H. (1.)

G. H., being duly sworn [or affirmed], doth depose and say, in answer to interrogatories proposed to him by S. T., Esq., counsel for A. B., as follows, to wit:

Question 1. What is your name, age, residence and occupation?

Answer 1. My name is G. H.; I am forty-three years of age; I am a manufacturer of paper collars, and reside in Chelsea, Massachusetts.

Question 2, &c. * * * * *

And in answer to cross interrogatories proposed to him by V. W., Esq., counsel for C. D., he saith:

Cross-question 1. How long have you known A. B.?

Answer 1. * * * * * *

G. H.

49. CERTIFICATE OF OFFICER.

[To follow deposition.]

STATE OF , *County of* , *ss.*:

At Boston, in said county, on the 31st day of March, A. D. 1869, before me personally appeared the above-named G. H., and made oath that the foregoing deposition, by him subscribed, contains the truth, the whole truth, and nothing but the truth. The said deposition is taken at the request of A. B., at the time and place named in the notice hereto attached, to be used upon the hearing of an interference between the claims of the said A. B. and those of C. D., before the Commissioner of Patents, on the 3d day of May, A. D. 1869.

The said C. D. was duly notified, as appears by the original notice hereto annexed, and attended by V. W., Esq., his counsel.

E. F.,
Justice of the Peace.

The magistrate shall then append to the deposition the notice under which it was taken, shall seal up the testimony and direct it to the Commissioner of Patents, placing upon the envelope a certificate, in substance as follows:

I hereby certify that the within deposition of G. H. [if the package contains more than one deposition, give all the names], relating to the matter of interference between A. B. and C. D., was taken, sealed up, and addressed to the Commissioner of Patents by me this 26th day of April, A. D. 1869.

E. F.,
Justice of the Peace.

50. APPLICATION FOR REGISTRATION OF A LABEL.

[FOR AN INDIVIDUAL.]

To the Commissioner of Patents:

The undersigned, John Fisher, of the city of Brooklyn, county of Kings, and State of New York, and a citizen of the United States [or resident therein, as the case may be], hereby furnishes five copies of a print [or "*label*," *as the case may be*], of which he is the sole proprietor.

The said print [or "label"] consists of the words and figures as follows, to wit: [Description and statement of articles on which used.]

And he hereby requests that the said print be registered in the patent office, in accordance with the acts of Congress to that effect.

BROOKLYN, N. Y., *August* 1, 1874.

_____.
Proprietor.

51.

[FOR A CORPORATION.]

The applicant, a corporation created by authority of the laws of the State of New York [or other authority, as the case may be], and doing business in said State, hereby furnishes five copies of a label [or "print," *as the case may be*], of which it is the sole proprietor.

The said label consists of the words and figures as follows, to wit: [Description.]

And it is hereby requested that the said label be registered in the patent office, in accordance with the acts of Congress to that effect.

Witness the seal of the said corporation at , , 1874.

[SEAL.]

_____,

President [*or other officer*].

52. ASSIGNMENT OF COPYRIGHT.

This indenture, made this day of , 187 , between , of , in the State of , of the first part, and , of , in the State of , of the second part.

Whereas the said has written and compiled a book entitled ; for which he obtained a copyright on the day of , 187 .

Now, this indenture witnesseth that the said , for and in consideration of the sum of dollars, to him in hand paid by the said , the receipt whereof is hereby acknowledged, has bargained, sold, and assigned, and by these presents doth bargain, sell, and assign unto the said , all the said book, and all copyright, title, interest, property, claim and demand of, in and to the same, to have and to hold the said book, copyright, and all the profit, benefit and advantage that shall or may arise by and from printing, reprinting, publishing and vending the same, unto the said , his heirs, executors, administrators and assigns, forever.

In witness whereof, the said party of the first part hath hereunto set his hand and seal, the day and year first above written.

Signed, sealed and delivered in the presence of . } [SEAL.]

53. DECLARATION IN CASE FOR THE INFRINGEMENT OF A PATENT.

To answer to A. of B., in the county of S., in the district of , manufacturer, in a plea of trespass on the case, for that the plaintiff was the original and first inventor [or discoverer] of a certain new and useful art [machine, manufacture, composition of matter, or improvement on any art, machine, &c., taking the words of the statute most applicable to the subject of the invention] in the letters patent hereinafter mentioned and fully described, the same being a new and useful [here insert the title or description

given in the letters patent], which was not known or used before his said invention [or discovery], and which was not, at the time of his application for a patent as hereinafter mentioned, in public use or on sale with his consent or allowance; and the plaintiff being so, as aforesaid, the inventor [or discoverer] thereof, and being also a citizen of the United States [if the fact is so], on the day of [here insert the date of the patent], upon due application therefor, did obtain certain letters patent therefor in due form of law under the seal of the patent office of the United States, signed by the Secretary of State and countersigned by the Commissioner of Patents of the United States, bearing date the day and year aforesaid, whereby there was secured to him, his heirs, administrators, executors or assigns, for the term of fourteen years from and after the date of the patent, the full and exclusive right and liberty of making, using and vending to others to be used, the said invention [machine, improvement or discovery] as by the said letters patent, in court to be produced, will fully appear. And the plaintiff further says, that from the time of the granting to him of the said letters patent; hitherto he has made, used and vended to others to be used [or he has made, *or*, has used, *or*, has vended to others to be used, as the case may be] the said invention [machine, improvement or discovery] to his great advantage and profit [or if he has not made, used or vended, then, instead of the above averments, may be substituted after the word "hitherto," "the said exclusive right has been and now is of great value to him, to wit, of the value of $]."

Yet the said D., well knowing the premises, but continuing to injure the plaintiff, did, on the [some day after the date of the patent], and at divers times before and afterwards, during the said term of fourteen years mentioned in said letters patent, and before the purchase of this writ, at C., in the county of M., in said district of , unlawfully and wrongfully, and without the consent or allowance, and against the will of the plaintiff, make [use and vend to others to be used, or did make, or did use, or did vend to others to be used, as the case may be] the said invention [machine, improvement or discovery] in violation and infringement of the exclusive right so secured to the plaintiff by said letters patent as aforesaid, and contrary to the form of the statute of the United States, in such case made and provided, whereby the plaintiff has been greatly injured and deprived of great profits and advantages which he might and otherwise would have derived from said invention, and has sustained actual damage to the amount of $, and by force of the statute aforesaid, an action has accrued to him to recover the said actual damage, and such additional amount, not exceeding in the whole three times the amount of such actual damages, as the court may see fit to order and adjudge, yet the said D., though requested, has never paid the same or any part thereof to the plaintiff, but hath refused, and yet refuses so to do.

54. DECLARATION WHERE THERE IS AN ASSIGNMENT.

To answer unto H. L., a citizen of the same State, in a plea of trespass on the case, &c. And thereupon the said H. L., plaintiff in this action, by W. S., his atttorney, complains, for that whereas, heretofore, to wit, on the day of , in the year , at the district of aforesaid, a certain J. N., of , in the State of , a citizen of the United States, being the original and first inventor of a new and useful improvement in dredging machines not known or used before his said invention or discovery, and not at the time of his application hereinafter mentioned for a patent, in public use or on sale with his consent and allowance, did duly apply for and there was duly granted to the said J. N., letters patent of the said United States, bearing date the day and year aforesaid, signed by C. B. S., then the Secretary of the Interior of the said United States, and countersigned by D. P. H., then the Commissioner of Patents of the said United States, and sealed with the seal of the patent office of the said United States, granting according to law: to the said J. N., his heirs, administrators, or assigns, for the term of seventeen years from the said day of , in the year aforesaid, the full and exclusive liberty of making, constructing, using, and vending to others to be used, the said new and useful improvement in dredging machines, to wit, at the district aforesaid, as by the said letters patent, reference thereto being had, will, among other things, more fully and at large appear, and which said letters patent the said plaintiff now brings here into court, and which said letters patent are duly recorded in the patent office aforesaid, and whereas also the said J. N. afterwards, to wit, day of , in the year , and while the said letters patent were still in force and unexpired, to wit, at the district aforesaid, by a certain power of attorney in that behalf, under his hand and seal, having date the day and year last aforesaid, did make, constitute and appoint T. S. of , in the State of , his lawful agent in his behalf, to sell to any person whomsoever in the said United States, the right to manufacture, construct, sell or use the said new and useful improvement in dredging machines, which said power of attorney, afterwards, to wit, on the day of , in the year , was duly recorded in the said patent office, to wit, at the district aforesaid, and which the said plaintiff now brings here into court, and whereas, also, afterwards to wit, on the day of , in the year , and while the said letters patent were still in force and unexpired, and the said power of attorney was still in force and unrevoked, to wit, at the district aforesaid, the said J. N., by his sealed assignment in due form of law, by and through the said T. S., his agent as aforesaid, bearing date the day and year last aforesaid, and which the said plaintiff now brings here into court, for the consideration therein mentioned, did, among other things, assign, transfer and set over unto the said plaintiff H. L., his executors, administrators and

assigns, all the right, title, interest, property, claim and demand which he the said J. N. had in the invention and improvement as secured to him by the said letters patent, for, to and in the State of Virginia and the District of Columbia, with full, entire and complete right to manufacture, construct, sell and use the said improvement in dredging machines in and for the said State of Virginia and the District of Columbia, the same to be held and enjoyed by the said plaintiff for his own use and behoof, and for the use and behoof of his legal representatives, for and to the full end of the term for which said letters patent were or might be granted, as fully and entirely as the same would have been held and enjoyed by the said J. N., had the said assignment and sale not been made, which said assignment, afterwards, to wit, on the day of , in the year , was duly recorded in the said patent office, to wit, at the district aforesaid. And the said plaintiff in fact saith, that the said assignment in and for the said State of Virginia, was, at the time of said assignment, and from thence hitherto has been, and still is, at the commencement of this suit, of great value to him the said plaintiff, to wit, of the value of $, to wit, at the district aforesaid. Yet the defendant well knowing the premises, but contriving and wrongfully and injuriously intending to injure the said plaintiff, and to deprive him of the benefit, profits and advantages which he might and otherwise would have derived from manufacturing, making, using and selling the said new and useful improvement and invention in the State of Virginia aforesaid, after the making of said letters patent, and of the said power of attorney, and of the assignment aforesaid, to wit, on the day of , in the year , and on divers other days and times between that day and the day of the commencement of this suit, to wit, at the district aforesaid, within the term of years in the said letters patent mentioned, and while the said letters patent and the said assignment to the said plaintiff were both in force and unexpired, unlawfully, unjustly, without the leave or license and against the will of the said plaintiff, did within the State of Virginia aforesaid, use the said new and useful improvement in dredging machines, in divers, to wit, five other dredging machines, in violation of the said letters patent and of the rights of the said plaintiff as such assignee as aforesaid, and thereby the said plaintiff has been greatly injured and deprived of great part, of great value, to wit, $, of the benefits, profits and advantages which he might and otherwise would have acquired and had as such assignee as aforesaid, to wit, at the district aforesaid, to the damage of the said plaintiff $, and therefore he brings his suit, &c.

55. PLEA OF GENERAL ISSUE WITH NOTICE.

The said defendant, by , his attorney, comes and defends the force and injury, &c., and says he is not guilty of the trespass

specified in the said plaintiff's declaration in manner and form as the said plaintiff hath above thereof complained, &c., and of this the said defendant puts himself on the country.

And the said defendant files herewith, in compliance with the exigency of the statute in such case made and provided, the following notice in writing of special matters of defense intended to be relied on by the defendant at the trial of this cause.

To , Attorney for the plaintiff in the above cause:

Take notice, that the defendant, under the general issue, will give in evidence at the trial of this cause, the following matter, to wit:

1. That the patentee was not the original and first inventor or discoverer of the thing patented to him by the United States, and described in the patent in the declaration mentioned, but that the said alleged invention of said plaintiff was described anterior to the supposed discovery thereof by the said plaintiff in the specification of the following English patents, viz.: [Here insert name of patentee and number and date of patent.]

Also, that the thing patented, or a substantial part thereof, claimed as new, was described anterior to the supposed discovery thereof by the plaintiff in the following public works, viz.: [Here insert the title of the work and give the number of the volume and the page.]

2. And the said defendant will offer in evidence various facts tending to prove that the said plaintiff surreptitiously and unjustly obtained said patent for that which was in fact invented or discovered by , of the town of , in the State of , who was then using reasonable diligence in adapting and perfecting his said invention or discovery.

56. SUPPLEMENTAL NOTICE.

SIR: In addition to the public works specified in a notice of special matter intended to be relied on at the trial of the above cause, and served on you on the day of , 18 , you are hereby notified that the following public works, viz.: [Here insert as in original notice] will also be relied on for the purpose of proving that the said plaintiff was not the original and first inventor of that for which he obtained the patent mentioned in the declaration, and that the thing so patented, or a material and substantial part thereof claimed as new, was described anterior to the supposed discovery thereof by the said plaintiff in the said public work, and which was published in the year 18 .

———, ———,
Atty. for Defendant.

To ———, ———,
Atty. for Plaintiff.

57. BILL TO RESTRAIN INFRINGEMENT OF PATENT.

To the Honorable the Justices of the Circuit Court of the United States for the Circuit within and for the District of .

IN EQUITY.

M. M., Executrix of the last will and testament of J. M. and R. G. E., of the and county of , State of , citizen of the United States, bring this their bill against , of the of , county of , State of .

And thereupon your orators complain and say, that heretofore, and before the 23d of May, 1854, the said J. M. and R. G. E., being then citizens of the United States, were the true, original and first inventors or discoverers of a certain new and useful invention, to wit, an improved machine for sawing thin boards, &c., and that the said invention was not known or used by others before their invention or discovery thereof, and was not at the time of the application for letters patent therefor, in public use or on sale with the consent or allowance of the said J. M. and said R. G. E., as the inventors or discoverers thereof, contrary to the provisions of the statutes of the United States in such case made and provided.

That, being such inventors, the said J. M. and said R. G. E. made application in writing to the Commissioner of Patents of the United States, for the granting of letters patent for said invention, and accompanied the same with a written description of the said invention or discovery, and the manner and process of making and using the same, in such full, clear and exact terms as to enable any person skilled in the art or science to which the said invention or discovery appertains, or with which it is most nearly connected, to make and use the same, and with a specification of the parts and improvements and combination which they claimed as their invention, and with drawings and models and written references explaining the said invention or discovery, and explaining the principle and the mode in which they contemplated the application of the principle by which it might be distinguished from other inventions; which said description was signed by the said J. M. and said R. G. E., and attested by two witnesses, and filed in the patent office.

That the said J. M. and said R. G. E. made oath that they verily believed that they then were the original and first inventors or discoverers of the invention or discovery for which they then solicited a patent, and that they did not know or believe that the same was ever before known or used; and also, that they then were citizens of the United States.

And the said J. M. and said R. G. E., at the same time paid into the treasury of the United States the sum of thirty dollars, and received a receipt therefor, and then and there also duly com-

plied in all other respects with all the necessary conditions and requirements of the statutes of the United States in such case made and provided, prior to the granting of the letters patent hereinafter mentioned.

That on the 23d day of May, 1854, letters patent of the United States, bearing date on that day, were issued to the said J. M. and said R. G. E., according to law, whereby there was granted to them, their heirs, executors, administrators or assigns, for the term of fourteen years, from the 23d day of May, 1854, the full and exclusive right and liberty of making, constructing, using and vending to others to be used, the invention or discovery aforesaid, a description whereof was given in the words of the said J. M. and said R. G. E. in the said schednle annexed to the said letters patent, and was made part of the same.

And the said letters patent were issued in the name of the United States of America, and were sealed with the seal of the patent office of the United States, and were signed by the Secretary of the Interior, and were countersigned by the Commissioner of Patents, and were numbered 10965, and were issued and delivered to the said J. M. and R. G. E.

That thereupon, after the issuing of the said letters patent as aforesaid, the said J. M. and said R. G. E. put the said invention into use, by making, using and vending the same to others, and licensing large numbers of such machines.

And your orators pray, that said letters patent, and the schedule annexed thereto, as aforesaid, may be deemed and taken as part of their bill, and to the originals of which, or a duly authenticated copy thereof, now in your orators' possession and ready to be produced, they crave leave to refer.

And your orators further show, that on the 13th day of May, 1868, on the application of the said J. M. and said R. G. E., they having then and there duly complied in all respects with the provisions of the statutes in such case made and provided, and paid the fees required by law, the said letters patent were extended for the term of seven years from the 23d day of May, 1868, pursuant to the statute in such case made and provided.

And your orators further show, that since the obtaining of said extension of said letters patent, the said J. M. has died, leaving a will, whereby he appointed the said M. M., who is the widow of said J. M., deceased, his sole executrix, and the said M. M. has duly qualified as said executrix.

And your orators further show, that prior to the commencement of this present suit, your orators duly filed in the patent office of the United States a disclaimer of part of the first claim of said letters patent, to which said disclaimer your orators crave leave to refer.

And your orators further show, that said letters patent have been in controversy before the Circuit Court of the United States for the Southern District of New York, in various actions and

suits at law and in equity founded thereon, viz.: 1st. One action at law, wherein Eben Peck and Gilbert J. Bogert were plaintiffs, and John Frame, John M. Nichols and William O. Robbins were defendants. 2d. One suit in equity, wherein Eugene S. Eunson and Margaret Myers, executrix, were complainants, and John Dunbar and Jeremiah Hopper were defendants. 3d. One suit in equity, wherein Eugene S. Eunson and Margaret Myers, executrix, were complainants, and Joseph Swift was defendant. 4th. One suit in equity, wherein Eugene S. Eunson, Margaret Myers, executrix, Eben Peck and Gilbert J. Bogert were complainants, and John Frame, John M. Nichols and William O. Robbins were defendants. 5th. One suit in equity, wherein Eugene S. Eunson and Jacob Lagowitz were complainants, and Thomas B. Peddie was defendant. That said first mentioned action at law came on for trial before the Honorable Lewis B. Woodruff and a jury, at the April term of said Circuit Court, in the year 1870. Said defendants were represented by counsel, and vigorously contested said action, denied infringement of said letters patent, and denied the novelty of the invention therein described, and attempted to prove that the said invention had been previously known to be used by John Frame, Isaac Smith, John N. Lyman and Charles Turner.

That nevertheless the said jury rendered a verdict in favor of the said plaintiffs upon all the issues in said action, and sustained the validity of said letters patent, and the charge of the infringement thereof, and assessed the plaintiffs' damages at the sum of five thousand dollars.

That each and all of said suits in equity came on for hearing before the Honorable Samuel Blatchford, at the February term of said Circuit Court, in the year 1871, the said defendants respectively denying infringement of said letters patent, and also denying the novelty of the inventions therein described, and setting up various and separate defenses thereto, contending that the same had been previously known to and used by C. T. at Troy, Batestown and Cohoes, New York, I. S. at New York, J. L. N. at Yonkers and New York, D. D. at Albany, J. H., H. McC. and J. M. at Cohoes, C. M. W. at Franklin, Mass., G. W. C. at Franklin, Mass., A. M. at Franklin, Mass., W. R. at Franklin, Mass., E. W. R. at New York, A. B. at Hillsborough, New Hampshire, G. H. at Brooklyn, New York, J. B. G. at the city of New York, R. D. at the city of New York, and H. J. N. at the city of New York, and had been described in a certain printed publication called , published in London, 1847, at vol. 2, pages 804 to 816, and in letters patent of the United States, to P. C., dated November 3, 1841, and April 8, 1851, and in letters patent of the Kingdom of Great Britain, to A. E. L. B., dated May 2, 1853, sealed November 2, 1853, and in letters patent of the United States to M. A. and J. S., dated December 31, 1839.

That said suits were argued by counsel at said term; and

thereupon, upon consideration thereof, decisions were rendered in said several suits, decreeing that said letters patent were valid, and that the defendants had severally infringed the same, and directing perpetual injunctions and accounts of profits.

And your orators have, ever since the date of the said letters patent, been and now are entitled to all the rights, interests and privileges thereby secured unto them in and to the said invention or discovery, in the said letters patent, and assignments and extension particularly set forth, and are, and ever since the date thereof have been, entitled to the exclusive use of the said invention and improvement.

And your orators further show unto your honors, that the said invention or discovery so patented, aforesaid, unto the said J. M. and the said R. G. E., is of very great utility; and that the same has been extensively introduced into public use, and that the public have generally acquiesced in your orators' exclusive right to the same; and your orators would, but for the wrongful acts the said defendant and others acting in concert with him, have made large gains, profits and advantages, from the manufacture, use and sale of the said invention; and your orators would, but for the wrongful acts and doings of the said defendant and others acting in concert with him. now be enabled to use the said invention, to which they are entitled to the exclusive right as aforesaid, with profit and advantage, but that by the said wrongful acts and doings they are now prevented and hindered from so doing.

And your orators further show unto your honors, upon information and belief, that the said defendant, well knowing the premises, and the rights and privileges secured unto your orators, and in order to deprive them of the profits, benefits and advantages which might and otherwise would have accrued to them, at , and within the said district of , and without license or permission of your orators, or either of them, the said defendant has, ever since the day of , 18 , unlawfully and wrongfully made or caused to be made, sold or caused to be sold, used or caused to be used.

each and all containing the said invention, discovery, improvements and combinations, consisting as therein and in the schedule set forth, of the employment or use of the deflecting plate E E, both placed at the sides of the saw as therein shown, for the purpose therein described. 2d. The employment of the clamps I I, as therein shown, substantially as and for the purpose described, and also the employment of an adjustable bed, F, with clamps as described in combination with the saw, when the saw has a stiffening plate in line with said bed, as and for the purpose described, the exclusive right to which is secured to your orators, as hereinbefore set forth, and which said unlawful making, use and sale, by the defendant as aforesaid, is a violation and infringement of your orators' exclusive rights and privileges, and that the said defendant has derived and received, and is still de-

riving and receiving from such use great gain and profits, but to what amount your orators are ignorant and can not set forth, but your orators believe the same to be about the full sum of thousand dollars, and so charge the fact to be, and pray that the defendant may be required to make a disclosure of all such gains and profits.

And your orators in like manner aver that the defendant though requested to desist from such unlawful use, and to pay your orators such gains and profits as the defendant has actually made, refuse so to do, by means whereof your orators are and have been greatly injured, and are now prevented from putting the said invention or discovery into successful operation, and are deprived and prevented from receiving the gains and profits to which they are lawfully entitled, from the exclusive rights and privileges so granted and secured to them as aforesaid, and which they would have derived and acquired, and would now derive and acquire, but for the said wrongful acts of the said defendant.

And your orators pray that the said defendant may be compelled by a decree of this honorable court, to account for and pay over unto your orators all such gains and profits as have accrued or arisen to, or been earned or received by the said defendant, and all such gains and profits as your orators would have received, but for the said wrongful acts and doings of the said defendant.

And that the said defendant, his attorneys, solicitors, clerks, servants, agents and workmen may be perpetually enjoined and restrained by the decree of this court from directly or indirectly making, or causing to be made, using or causing to be used, or vending to others to be used in any manner, any machines containing or embodying the said invention granted by the said letters patent, as issued, and extended and assigned as aforesaid unto your orators, and from infringing upon or violating the said letters patent, by the use or sale of the said machines, in any way whatsoever. And that all such infringing machines may be forthwith destroyed, or delivered up to your orators, and that the said defendant may be decreed to pay the costs of this suit, and that your orators may have such other relief as the equity of the case may require, and as to your honors may seem meet.

To the end, therefore, that the said defendant may, if he can, show why your orators should not have the relief hereby prayed, and may full, true, direct and perfect answer make, according to the best of his or his clerks', agents', or workmen's knowledge, remembrance, information and belief, to the several matters hereinbefore averred and set forth, as fully and particularly as if the same were here repeated paragraph by paragraph, and he and they thereto severally and specifically interrogated, and especially that said defendant answer and set forth:

First. Whether the said J. M. and R. G. E. were not, prior

to the 23d day of May, 1854, the true, first and original inventors or discoverers of the said invention or discovery, described in said letters patent, and every material part thereof, and if not, who was or were the true, original or first inventor and inventors of the same, and if any other person or persons was or were the true, first and original inventor or inventors of the same, where he or they reside, and where and when he or they invented or discovered the same, and how the invention or discovery of such other person or persons, if any, differed, if at all, from the said invention or discovery of said J. M. and R. G. E.

Second. Whether the said defendant has at any time, and if so, where and when, made, sold, used, or caused to be made, sold or used, any circular saw or saws, having, employing or using deflecting plates, one or both placed at the sides of the saw, as and for the purpose described in said letters patent, or if the circular saw or deflecting plates differed from those described in said letters patent, in what particulars they differed therefrom, or in what respect they were differently applied or combined from those described in said letters patent, if at all.

Third. Whether said defendant has at any time, and if so, where and when, made. sold, used, or caused to be made, sold or used, in connection with a circular saw or saws, or with deflecting plates substantially as described in said letters patent, or both, any clamp or clamps substantially as and for the purpose described in said letters patent, and if said defendant has used a clamp or clamps in connection with a circular saw or deflecting plates, in what respect such clamp or clamps differed from the clamps described in said letters patent, and in what respect they were differently applied to or combined with such saw or deflecting plates, if at all.

Fourth. Whether the machine or machines now in use by the defendant, for the purpose of sawing or resawing thin boards, was and is not substantially similar to the machine described in said letters patent; and if not, how the same differs therefrom.

Fifth. Whether the defendant has not made large gains and profits from the use of such saw and deflecting plates and clamps, and if so, to what amount.

May it please your Honors to grant to your orators a writ of *subpœna ad respondendum*, issuing out of and under the seal of this honorable court, directed to the said defendant, commanding him to be and appear, and make answer to this bill of complaint, and to perform and abide by such order and decree herein, as to this court may seem required by the principles of equity and good conscience.

May it also please your Honors to grant to your orators a provisional or preliminary injunction issuing out of and under the seal of this honorable court, enjoining and restraining the defendant, and his attorneys, solicitors, clerks, servants, workmen and

agents to the same purport, tenor and effect hereinbefore prayed for, in regard to said perpetual injunction.

And your orators will ever pray, &c.

MARGARET MYERS, *Executrix.*
ROBERT G. EUNSON.

——— ———,
Complainants' Solicitors.

NOTE.—The defendant is required to answer the interrogatories numbered respectively 1, 2, 3, 4, 5.

UNITED STATES OF AMERICA, } ss. :
District of }

On this day of 187 , before me came R. G. E., to me personally known, who, being by me duly sworn, did depose and say, that he is one of the complainants in the foregoing bill of complaint named, and that he has read the said bill, subscribed by him, and knows the contents thereof, and that the same is true of his own knowledge, except as to matters which are therein stated to be on information and belief, and as to those matters, he believes it to be true.

BILL TO RESTRAIN THE INFRINGEMENT OF COPYRIGHTS.

To the Judges of the Circuit Court of the United States for the

The bill of complaint of C. F., T. G. W., and L. T., printers and publishers, and copartners, doing business under the name and style of F., W. & T., and J. S., gentleman, all of C., in the county of M., in said , and all being citizens of the United States, shows that the said J. S. is and heretofore at the time of the infringement hereinafterwards mentioned, was proprietor of the copyright of a work of which the said J. S. is the author and compiler, entitled, "The Writings of George Washington, being his Correspondence, Addresses, Messages and other Papers, official and private, selected and published from the original Manuscripts, with a Life of the Author, Notes and Illustrations, by J. S.," consisting of twelve volumes, of all which volumes respectively the copyright was taken out by said J. S. previous to the publication thereof respectively, and secured according to law, the said J. S., at the time of taking out and securing said copyrights respectively, and still being a citizen of the United States, and the term of each and all of which copyrights has still more than eight years to run; and that said F. W., & T., before the infringement hereinafterwards complained of, had, by an agreement with said J. S., undertaken and become interested in and assumed a part of the risk and responsibility of the publication of said work, and have ever since continued, and still continue, to be thus interested, and that ever since the first publication of the several volumes of said work,

the public have been supplied with copies of the same by said J. S., and the publishers of the same, at reasonable prices; and that said J. S. and said F., W. & T., have incurred very large expenses upon said publication, and have been and are in the receipt of large amounts, the proceeds of the sale of said work to reimburse their expenses and remunerate their labor and care bestowed upon the same.

And your orators further show, that they, your orators, being in the receipt of large sums, the proceeds of the sale of said work as aforesaid, under said copyrights, B. M., N. C. and T. H. W., all of B., in the county of S., in said , and G. P. L., of C., in the county of M., in the district of N. H., booksellers, being copartners under the name, style and firm of M., C., L. & W., and also C. W. U., of S., in the county of E., in said district of , clerk, all of them well knowing that the said J. S. held such copyrights, and said F., W. and T. were interested in the said publication, and deliberately, after due notice, intending to infringe said copyrights at said B., on the fifth day of August, in the year of our Lord, eighteen hundred and forty, and at divers times before and since the said fifth day of August, without the allowance and consent of your orators, or either of them, published and exposed to sale and sold a work in two volumes, entitled "The Life of Washington," in the form of an autobiography, the narrative being, to a great extent, conducted by himself in extracts and selections from his own writing, with portraits and other engravings, consisting of pages in the whole, which they still continue to expose to sale, having had due notice, and well knowing that the same is a copy from, and an infringement and piracy of, said "Writings of George Washington, &c., with a Life of the Author," so published by your orators as aforesaid. And your orators aver, that three hundred and eighty-eight pages of said piratical work were copied *verbatim et literatim* from the said work so edited and compiled by said J. S. as aforesaid, and so published by your orators as aforesaid, consisting of matter which was published originally by said J. S., under his said copyright, and which had never before been published or printed, and which he, the said J. S., and his assigns, had the exclusive right and privilege to print, publish and sell, and expose to sale; and that many other parts of said piratical work, published by said parties complained of, besides three hundred and eighty-eight pages, are infringements upon said J. S.'s copyrights, whereby your orators have sustained great damage, detriment and injury.

And your orators further show, that said M., C., L. and W. and U. still continue, and threaten hereafter to continue to print, publish and expose to sale and sell copies of the said piratical work, the protests, expostulations and warnings of your orators to them to the contrary notwithstanding.

All which actions, doings and pretenses are contrary to equity and good conscience, and tend to the wrong and injury of your

orators in the premises. In consideration whereof, and forasmuch as your orators are remediless in the premises at law, and can not have adequate relief save in a court of equity, where matters of this and the like nature are properly cognizable and relievable, and to the end that the said M., C. and W. and U. may appear and answer all and singular the matters and things hereinbefore set forth and complained of, particularly how many copies of said piratical work they have sold, and what number they have on hand; and that they be restrained by injunction issuing from this court, from selling or exposing to sale, or causing or being in any way concerned in the selling or exposing to sale, or otherwise disposing of any copies of said piratical work, and that they be ordered and decreed to render an account of the copies of the same that they have sold, and to pay over the profits of such sales to the plaintiffs, and that they be ordered to surrender and deliver up the copies on hand and the stereotype plates of said piratical work to an officer of this court, to be canceled and destroyed, and be ordered to pay the plaintiffs their costs; and that your orators may have such other and further relief as to this honorable court may seem meet, or as equity may require—may it please this honorable court to grant to your orators a writ of *subpœna* directed to the said M., C., L. & W. and U., commanding them, at a certain day, and under acertain penalty to be therein inserted, personally to be and appear before this honorable court, then and there to answer the premises, and to stand and abide such order and decree therein as to this honorable court shall seem agreeable to equity and good conscience.

P. & R.

By their solicitors.

58. BILL FOR AN ACCOUNT AND AN INJUNCTION AGAINST THE ILLEGAL USE OF A TRADE-MARK.

Circuit Court of the United States for the District of .

To the Judges of the Circuit Court of the United States for the District of .

A. B. and C. D., of , and citizens of the State of , bring this their bill against E. F., of , and a citizen of the State of . And thereupon your orators humbly complaining, show unto your honors, that they are the assignees and successors in business of & Co., a firm which was composed of and your orators, and which firm was formerly engaged in the manufacture and sale of sewing machines in ; and for the period of more than five years, your orators and their predecessors had been engaged in the manufacture and sale of sewing machines at the same place; and that during the whole period of time of such manufacture and sale by them, they had exclusively used, and your orators are now so using, and had, and still

have, the right so to use, a certain trade-mark for said sewing machines, which trade-mark was printed on paper of an ultramarine ground, on which is represented a view of the Princess Penelope weaving, and the name "Penelope," which is the essential part of said mark printed thereon; and that no person, firm or corporation, except the said and your orators, have had at any time heretofore, and none except your orators now have any right to use the said trade-mark or any trade-mark essentially the same.

They further show to your honors that on the said day of in the year , being entitled as aforesaid to the exclusive use of said trade-mark, and desiring to secure to themselves full and lawful protection for the same by due registration thereof in the United States patent office, according to law, your orators did deposit in said patent office of the United States, for registration, their trade-mark aforesaid for sewing machines; and having fully complied with all the requirements of the act of Congress, in such cases made and provided, the trade-mark aforesaid was on the day of , in the year , duly and lawfully registered and recorded in said United States patent office, with protection to remain in force for thirty years from said date, all of which, with an accurate copy and description of said trade-mark and the declaration of a member of the firm, on which it was registered, will more fully and at large appear from copies from the patent office, duly certified by , commissioner of patents, under his seal of office, and herewith filed as a part of this bill, marked ; and thereupon protection in the exclusive use of the trade-mark aforesaid previously held and enjoyed by your orators, was secured to them for the period of thirty years from said day of , in the year .

Your orators further respectfully show unto your honors, that since your orators have had the exclusive right to use the said trade-mark, to wit, from the day of , in the year , to the present time, the said , of , in the State of , has been manufacturing sewing machines in said city of , and has been unlawfully and without your orators' consent using, in the sale thereof, a trade-mark substantially like, and indeed almost identical with, that of your orators.

And your orators do further show that they hold and estimate their said trade-mark at the price and value of thousand dollars, but can not with certainty state the exact amount of their loss and injury, suffered by reason of said wrongful acts of the defendant, but believe the same to be the full sum of thousand dollars, and do so charge the fact.

To the end, therefore, that your orators may obtain relief in the premises in this honorable court, where alone adequate relief can be afforded, they pray:

1st. That the said E. F. may be made a defendant to this bill, and compelled to answer each and every allegation thereof on oath,

as fully and to the same extent as if he were directly and particularly interrogated as to each allegation.

2d. That he may be compelled to render, before a commissioner of this court, a full, true and perfect account of all profits of every description which he has made, or might have made, by the use of the simulated trade-mark aforesaid, or by the use of any other trade-mark for sewing machines having thereon as a constituent part thereof, the word "Penelope," or a representation of the Princess Penelope weaving, or any trade-mark having such near resemblance to that of your orators, as aforesaid, as might be calculated to deceive; and that he, the said E. F., be decreed to pay over to them all such profits.

3d. That the said commissioner be required to ascertain and report to this court, also, what loss and damage has been inflicted upon your orators by reason of the infringement of their rights, and the interference aforesaid with the right of exclusive use of the trade-mark first above mentioned, and that the said E. F. be also decreed to pay them such damages.

4th. And may it please your honors to grant unto your orators a restraining against the said defendant, enjoining and restraining him, his clerks, attorneys, agents and servants from using the simulated trade-mark aforesaid, or any other trade-mark containing the word "Penelope," or being substantially the same with that of your orators.

5th. And that your orators may obtain the relief prayed for, and all such further or other relief as the nature of their case may require, may it please your honors to grant to your orators the writ of subpœna against the said E. F., &c.

_____ _____,

Solicitor for Complainant.

C. D. [for the firm.]

UNITED STATES OF AMERICA, } ss.:
District of , }

At the city of , in the county of , and district aforesaid, this day of , in the year , personally appeared before me , U. S. commissioner for said district, the above-named C. D., and made oath that the facts set forth in the foregoing bill, so far as they purport to be stated as of his own knowledge, are true, and so far as they purport to be stated on information and belief, he believes it to be true.

Given under my hand this day of , in the year .

_____ _____,

[L. S.] *U. S. Commissioner for District of* .

59. ORDER OF REFERENCE TO A MASTER IN A COPYRIGHT CASE.

It is hereby ordered, this day of , 18 , that this cause be referred to , a master of this court, to examine and report the coincidences and differences of the complainant's and

defendant's books; how far the defendant has used the complainant's book in compiling his own, and how far he has made use of the similar or the same materials, independently of any use or with how great a use of the complainant's book, and to report the evidence in the case as far as either party may request, and his conclusion therenpon, whether the whole or any part, and if any, what parts of the defendant's book is an infringement of the complainant's copyright.

60. ORDER TO SHOW CAUSE.

Upon reading the bill of complaint herein, with the affidavit of , and on motion of , solicitor for the complainant, it is hereby ordered, this day , 18 , that the defendant show cause, if any he has, before the judge of said court, at , in the said , district of , on the day of . 18 , at o'clock A. M., or as soon thereafter as counsel can be heard, why an injunction should not issue pursuant to the prayer of said bill.

61. ORDER FOR PRELIMINARY INJUNCTION.

The bill of complaint and the affidavits filed by the respective parties having been read, and the arguments of the counsel for the respective parties having been heard and duly considered by the court, and it appearing that letters patent of the United States No. , were issued in due form of law on the day of , 18 , to , for , and that the said defendant has infringed the rights secured by the aforesaid letters patent, by manufacturing, making and selling to , manufactured and made according to said letters patent, contrary to the form of the statute in such case made and provided:

Now, therefore, it is hereby ordered, adjudged and decreed this day of , 18 , that an injunction be issued pursuant to the prayer of the bill herein, strictly commanding and enjoining the said defendant , his clerks, attorneys, agents, servants and workmen, that they forthwith and until the further order, judgment and decree of this court, desist from making, using and selling any substantially as described and claimed in the said letters patent.

62. INTERLOCUTORY DECREE.

This cause came on to be finally heard at this term, upon the pleadings and proofs, and was argued by the counsel for the respective parties, and the pleadings and proofs having been duly considered, it is hereby, this day of , 18 , ORDERED, ADJUDGED AND DECREED as follows, viz., that the letters patent referred to in the complainant's bill, being letters patent of the

United States granted unto John Myers and Robert G. Emerson for a machine for sawing thin boards, &c., dated May 23, 18 , No. , is a good and valid patent, and that the said John Myers and Robert G. Emerson were the inventors of the improvements therein described and claimed therein, and that the said defendant has infringed the said patent, and upon the exclusive rights of the complainants under the same.

And it is further ORDERED, ADJUDGED AND DECREED that the defendants above named, and each of them, their servants, agents, operators and workmen, and each and every one of them be, and they are hereby perpetually enjoined and restrained from either directly or indirectly making, constructing, using or vending to others to be used, the machine known as the Myers & Emerson Resawing Machine, or any machine whether known by that name or any other, constructed and operated in the manner and upon the principles described in said letters patent of the United States, bearing date the day of , 18 , No. , and described in said letters patent as an improved machine for sawing thin boards, &c., which said letters patent are the foundation of these proceedings.

And it is further ORDERED, ADJUDGED AND DECREED that the complainants recover of the defendants the profits which they have received or made, or which have accrued to them from said infringement by the manufacture, use or sale of the improvement described and secured by said letters patent at any and all times since the day of , 18 , and also the damages which the complainants have sustained thereby.

And as it does not appear to the court what said profits and damages are, it is further ORDERED, ADJUDGED AND DECREED that this cause be referred to , a master of this court, to take and report to the court an account of the profits which the defendants have received or which have arisen or accrued to them from the manufacture, use or sale of said improvement, or from said infringement, and to ascertain and report the damages which the complainants have sustained thereby since the day of , 18 , from the papers and evidence in the cause, and from any evidence which either party may produce before him of the same, and when he shall have taken an account of said profits and assessed the damages therein, he shall return the same to this court for further action in the premises.

And it is further ORDERED, ADJUDGED AND DECREED that the complainants recover of defendants their costs of suit.

63. MASTER'S REPORT.

To the Honorable , Judges of said court:

In pursuance of a decretal order made and entered in this cause on the day of , A. D., 18 , by which it was referred to of , one of the masters of the court, to

take and state an account of the gains and profits made by the defendant in the manufacture, use and sale of , described in the complainant's bill of complaint:

I, , a master in said court, do respectfully report that I have proceeded to investigate the matters so referred to me, and that, pursuant to a notice duly given, I have been attended by the parties, complainant and defendant, and their respective counsel in the above case, and that after taking due proofs I find and report that .

I do therefore respectfully report that the said defendant should be decreed to pay to the said complainant the sum of dollars, besides costs to be taxed.

I respectfully refer to schedules A, B, C, hereto annexed, as making a part of this my report.

All of which is respectfully submitted.

Dated , 18 .

Master.

64. EXCEPTIONS TO MASTER'S REPORT.

Exceptions taken by the complainant [*or* defendant] to the report made herein by , one of the masters of the court to whom the cause was referred by an order of this court, made and entered on the day of , 18 , which report bears date the day of , 18 .

First exception. For that the said master in said report , whereas the said master should have .

Second exception. For that, &c.

65. FINAL DECREE.

This cause having come to be heard upon the report of , Esq., one of the masters of this court, to whom it was referred to ascertain and report , which report bears date the day of , 18 , and also upon exceptions taken to the said report on the part of said complainant, and also on the part of said defendant:

It is ordered, adjudged and decreed, this day of , 18 , that the said defendant pay to the said complainant the sum of dollars.

And it is further ordered, adjudged and decreed that the said defendant pay to the said complainant his costs in this suit to be taxed, and that the complainant have execution for such costs and for the sums above decreed to be paid to said complainant as aforesaid.

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