# IN PREPARATION

PARTIALLY COMPLETED AND TO BE PUBLISHED SHORTLY

# A CONTINUATION OF THE PRESENT VOLUME

EMBRACING

# THE DECISIONS

IN

# PATENT,

# TRADE-MARK AND COPYRIGHT CASES

## FROM 1862

TO THE PRESENT TIME.

220
J. L. SHORROW,
40 STATE ST. - BOSTON.

# DIGEST

OF

# AMERICAN CASES

RELATING TO

# PATENTS FOR INVENTIONS

AND

# COPYRIGHTS

FROM

## 1789 TO 1862

## INCLUDING NUMEROUS MANUSCRIPT CASES

DECISIONS ON APPEALS FROM THE COMMISSIONERS OF PATENTS AND THE OPINIONS OF THE ATTORNEYS GENERAL OF THE UNITED STATES UNDER THE PATENT AND COPYRIGHT LAWS

AND EMBRACING ALSO THE AMERICAN CASES IN RESPECT TO

## TRADE-MARKS

ARRANGED IN CHRONOLOGICAL ORDER

WITH THE YEAR IN WHICH AND THE NAME OF THE JUDGE BY WHOM DECIDED

FIFTH AND REVISED EDITION

WITH A SUPPLEMENT

CONTAINING THE EXISTING

PATENT AND COPYRIGHT LAWS OF THE UNITED STATES AND CANADA

AND ALL THE EXPIRED

UNITED STATES PATENT AND COPYRIGHT LAWS

BY STEPHEN D. LAW

AUTHOR OF "LAW'S UNITED STATES COURTS" ETC

NEW YORK

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NYPL

TO THE MEMORY OF

MY WIFE

THIS VOLUME IS

AFFECTIONATELY DEDICATED.

---

Her intereſt in this work encouraged me in undertaking it, and has been a conſtant incentive to my exertions in its preparation. Her cheerful ſociety made light and pleaſant my earlier labors upon it; and had her life been ſpared, to no one could this volume have been dedicated more appropriately, or with more ſincere pleaſure, than to her. Her early death, which made ſad and lonely the hours ſpent in its completion, and which has ſhadowed my life with ſorrow, has left me only the melancholy ſatisfaction of inſcribing it to her Memory.

# PREFACE

## TO THE REVISED EDITION OF 1870.

---

When, some eight years since, this work was originally published, it was submitted by the author to his professional brethren with not a little doubt and hesitation, lest it should be found, on careful and critical examination, of but doubtful value or assistance in the investigation of the subjects of which it professed to treat; and such doubt and hesitation was not diminished by the fact that Law Publishers declined to assume the cost of its publication, arguing that the demand for such a work must necessarily be small, and its sale, therefore, very limited. Encouraged, however, by the favorable opinion of those who had to some extent examined and made use of the work in manuscript, the author became his own publisher, and sent forth his volume with his sincere hope and wish that it might "be found convenient as a Reference, and reliable as an Authority."

To those who took an interest in its preparation, and encouraged its publication, it may be a pleasure to know that its sale was, at the first, highly satisfactory and flattering, and that from that time to the present the demand for the work has continued, and has been increasing. To the author it has been a much higher gratification, and a source of honest pride, that his work has been so favorably received by his profession and the public, and has been deemed worthy to fill, in some degree at least, the place he desired for it as a Reference and an Authority.

## PREFACE TO THE REVISED EDITION.

Since the first publication of this volume very many of the Cases digested therein, and cited as "Manuscript Cases," have been published in the later volumes of "Blatchford's Reports," in "Clifford's Reports," and in "Fisher's Patent Cases." In the present Revised Edition of the DIGEST the references to those cases have been corrected, and made to conform to the pages of such volumes. The author believes he has thereby materially increased its convenience and value.

The author has also in course of preparation, as a supplement to, or continuation of the present volume, a Digest of Patent, Copyright, and Trade-mark Cases decided since 1862, which will be published as soon as completed.

THE AUTHOR.

NEW YORK, June, 1870.

# EXPLANATORY PREFACE.

THIS volume is a Digest, or rather a Digested Abstract, of all the American Cases, so far as they could be obtained, relating to Patents for Inventions, Copyright, and Trade-Marks.

It owes its origin to a want experienced by the Author, of some work which should contain a general summary of the Statute Law and of the Decisions of the Courts in respect to Patents for Inventions, and was commenced for the purpose of supplying such deficiency.

To render the work more complete, the decisions relating to the kindred subjects of Copyright and Trade-Marks are included in it.

The whole number of cases digested is eight hundred and thirty-four, of which seven hundred and thirty-four have reference to Patents for Inventions, and the remaining cases, in about equal proportion, relate to Copyright and Trade-Marks.

Of such cases, about four hundred are to be found in the Reports of the Supreme and Circuit Courts of the United States, which now number over one hundred volumes; over fifty cases have been obtained from the various Law Periodicals which have from time to time been published, and which exceed eighty volumes; and some eighty are Manuscript Cases, or cases which have been determined in the Federal Courts but which are not to be found in any of the Reports or Law Periodicals. The opinions of the Attorneys-General of the United States have also been examined, and some thirty cases, having reference to the Patent and Copyright Laws, have been taken therefrom; and about one

hundred and fifty decisions of the Justices of the Circuit Court of the District of Columbia, on appeals from the decisions of the Commissioner of Patents, have also been digested. In addition to all these, about one hundred and thirty cases, relating to Trade-Marks, or deciding questions incidentally connected with, or growing out of contracts respecting Patents, have been gathered from the voluminous mass of State Reports, and incorporated into the volume.

From this statement as to the several sources from which the Cases Digested have been collected, it will be at once apparent that such cases are very widely scattered, and that quite a considerable number of them are not within reach of the profession at large, except at considerable difficulty and expense: and the general nature and scope of the work will also be best understood.

The plan or method of arrangement adopted by the Author in the Digest, and the manner of citing, and referring to, the Cases Digested are somewhat peculiar, but it is believed that they will be found convenient and useful.

The digested notes are arranged, under the several titles and sub divisions, in Chronological order, and, in addition to the title of the case, there is also given the name of the Judge by whom, and the place where, and the year in which the case was decided. By this arrangement, it is easy to trace the course of Judicial decision, in respect to any question, and learn whether there has been any conflict or diversity in respect to it, and also readily determine the character and bearing of the latest decisions. The digested note also carries with it the weight of authority due to the Judge who decided the case, and the date of decision is a guide to determine under what law any particular case arose, and was decided.

In digesting the cases, the Author has not confined himself to the Head Notes of Reporters and others, but has carefully read and studied the cases for himself, and his digested notes have been prepared from the opinions of, and as far as possible they appear in the very language used by, the Court. It has not, however, been the intention

of the Author to digest only such points as might more strictly be called the leading or turning points of the case, but it has been his aim to digest all such points as the Court may have deemed it proper to decide; or, in other words, whatever the Court, in any case, deemed it necessary and proper to declare and decide to be the law, as applicable to the questions arising in such case, that the Author has considered it to be his duty to digest and arrange under its appropriate heading. Nor has the Author limited himself to digesting merely those parts of the decisions which have more exclusive reference to, or are declaratory of, the law of Patents, Copyright, &c., but points of practice, such as questions relating to evidence, new trials, &c., which have arisen and been decided in any such cases, have also been digested—not because any different rule or principle governs in such cases in the decision of questions of such character, but because such decisions furnish authority and precedent, should like questions arise in other cases.

In short, it has been the design of the Author to digest all the points, whether of law or practice, decided in the cases embraced within the scope of his work, and thus make it an Abstract of the whole of such cases, and not merely of portions of them.

In respect, also, to such cases as have not been reported, and such as are not generally accessible, the digested notes are somewhat more full and comprehensive than they would otherwise have been.

In the preparation of this volume, it has been the constant aim and endeavor of the author to make it as correct as possible. For that purpose, he restudied the cases digested, correcting the digested notes, when necessary, from the original authorities; and, to guard as effectually as possible against error, the proof-sheets, while the work was in the hands of the printer, were compared with the original decisions, and not alone with the manuscript. Absolute correctness, however, is not claimed; but the Author can honestly affirm, that he has not knowingly or intentionally spared or omitted any labor or care which would be likely to render his volume what it should be both as a Reference and an Authority.

The Author returns his acknowledgments to the several Judges of the United States Courts, and particularly to Judges NELSON and BETTS of New York, SPRAGUE of Massachusetts, and SHIPMAN of Connecticut, for the assistance they have so kindly afforded him; and to SAMUEL BLATCHFORD, ESQ., of New York, and JOHN WILLIAM WALLACE, ESQ., of Philadelphia, the Reporters of the United States Circuit Courts for the Second and Third Circuits, for the privilege of examining the cases contained in the Third volumes of their Reports, not yet published; and, also, to all his professional brethren and others, who have assisted him in the collection of cases, and otherwise.

That the volume may be found of real practical value, and convenient as a Reference and reliable as an Authority, is the sincere wish and hope of

THE AUTHOR.

NEW YORK, *September*, 1862.

# CONTENTS.


| | PAGES |
|---|---|
| PREFACE | 5 |
| TABLE OF ABBREVIATIONS | 11 to 14 |
| INDEX OF TITLES | 15 " 29 |
| TABLE OF CASES, IN ALPHABETICAL ORDER, DIRECT AND REVERSED, WITH REFERENCES UNDER THE FORMER TO PAGES WHERE FOUND | 29 " 58 |
| TABLE OF CASES, ARRANGED ACCORDING TO THEIR SUBJECT MATTER | 59 " 74 |
| TABLE OF CASES, AFFIRMED, APPROVED, CRITICISED, DISAPPROVED, EXAMINED, EXPLAINED, OVERRULED, QUESTIONED, REVERSED, &c. | 75 " 90 |
| CHRONOLOGICAL DIGEST | 91 " 698 |


## CONTENTS OF SUPPLEMENT.


| | PAGES |
|---|---|
| PREFACE TO COPYRIGHT AND PATENT LAWS | iii to iv |
| PROVISIONS OF THE CONSTITUTION OF THE UNITED STATES AS TO COPYRIGHT AND PATENTS, WITH NOTES | v " vii |
| LAWS OF U. S. NOW IN FORCE AS TO PATENTS, TRADE-MARKS AND COPYRIGHT, AND INDEX | 1 " 32 |
| U. S. COPYRIGHT LAWS, 1790 TO 1874, NOW OBSOLETE, WITH NOTES | 8 " 29 |
| U. S. PATENT LAWS, 1790 TO 1874, NOW OBSOLETE, WITH NOTES | 30 " 134 |
| INDEX TO OBSOLETE COPYRIGHT LAWS, 1790 TO 1874 | 135 " 141 |
| INDEX TO OBSOLETE PATENT LAWS, 1790 TO 1874 | 142 " 159 |
| LAWS OF CANADA IN FORCE AS TO PATENTS, TRADE-MARKS AND COPYRIGHTS, AND INDEX | 1 " 36 |

# ABBREVIATIONS USED IN THIS WORK.

| | | |
|---|---|---|
| Abb. Pr., | Abbott's Practice Reports, | New York. |
| Ala., | Alabama Reports, and | Alabama. |
| Amer. Law Reg., or A. L. Reg., | American Law Register, | Philadelphia. |
| Anon., | Anonymous. | |
| App. Cas., | Cases decided by the Justices of the Cir. Court, Dist. Col., on appeals from the decisions of the Commissioner of Patents, | Dist. Columbia. |
| Ark., | Arkansas Reports, and | Arkansas. |
| Atty. Gen., | Attorney General of United States. | |
| Bald., | Baldwin's Reports U. S. Circuit Court, | 3d Circuit. |
| Barb. S. C., | Barbour's Supreme Court Reports, | New York. |
| " Ch., | " Chancery, " | New York. |
| B. Monr., | B. Monroe's Reports, | Kentucky. |
| Blackf., | Blackford's Reports, | Indiana. |
| Blatchf., | Blatchford's Reports U. S. Circuit Court, | 2d Circuit. |
| Bosw., | Bosworth Reports, | New York. |
| Bright., | Brightly's Reports, | Pennsylvania. |
| Brock., | Brockenbrough's Reports U. S. Cir. Ct., | 4th Circuit. |
| Cal., | California. | |
| Chan., | Chancellor. | |
| Comst., | Comstock's Reports, | New York. |
| Conn., | Connecticut Reports, | Connecticut. |
| Cra., | Cranch's Reports U. S. Supreme Court. | |
| Cra. C. C., | " Reports U. S. Circuit Court, | Dist. Columbia. |
| Ct., | Connecticut. | |
| Curt., | Curtis' Reports U. S. Circuit Court, | 1st Circuit. |
| Cush., | Cushing's Reports, | Massachusetts. |
| D. C., | District Columbia. | |
| Day, | Day's Reports, | Connecticut. |
| Deve., | Devereaux's Reports, | Court of Claims. |
| Dev. & Bat., | Devereaux & Battle's Reports, | North Carolina |

| | | |
|---|---|---|
| Denio, | Denio's Reports, | New York. |
| Duer, | Duer's Reports, | New York. |
| E. D. Smith, | E. D. Smith's Reports, | New York. |
| Edw. Ch., | Edwards' Chancery Reports, | New York. |
| Fes. on Pat., | Fessenden on Patents, 2d dition, | Boston. |
| Gall., | Gallison's Reports U. S. Circuit Court, | 1st Circuit. |
| Geo., | Georgia Reports, and | Georgia. |
| Gilp., | Gilpin's Reports U. S. District Court, | Pennsylvania. |
| Gray, | Gray's Reports, | Massachusetts. |
| Greenlf., | Greenleaf's Reports, | Maine. |
| Halst. Ch., | Halsted's Chancery Reports, | New Jersey. |
| Harring., | Harrington's Reports, | Delaware. |
| Hilton, | Hilton's Reports, | New York. |
| Hoff. Ch., | Hoffman's Chancery Reports, | New York. |
| How., | Howard's Reports U. S. Supreme Court. | |
| How. App. Cas., | " Court of Appeal Cases, | New York. |
| How. Pr., | " Practice Reports, | New York. |
| Ill., | Illinois Reports, and | Illinois. |
| Ind., | Indiana Reports, and | Indiana. |
| John., | Johnson's Reports, | New York. |
| Jones Eq., | Jones' Equity Reports, | North Carolina. |
| Jour. Fr. Inst., | Journal Franklin Institute, | Philadelphia. |
| La., | Louisiana. | |
| Law Int. & Rev., | Law Intelligencer and Review. | |
| Law Rep. or L. Rep., | Law Reporter, 1st Series, | Boston. |
| Mart., | Martin's Reports, | Louisiana. |
| Mass., | Massachusetts Reports, and | Massachusetts. |
| Mas., | Mason's Reports U. S. Circuit Court, | 1st Circuit. |
| McAllis., | McAllister's Reports U. S. Circuit Court, | California. |
| Metc., | Metcalf's Reports, | Massachusetts. |
| McLean, | McLean's Reports U. S. Circuit Court, | 7th Circuit. |
| Mich., | Michigan Reports, and | Michigan. |
| Mir. Pat. Off., | Mirror of the Patent Office, | Washington. |
| Mo., | Missouri Reports, and | Missouri. |
| Mo. Law Rep., or Mo. L. Rep., | Monthly Law Reporter, 2d Series, | Boston. |
| MS., | Manuscript Cases. | |

| | | |
|---|---|---|
| N. Car., | North Carolina. | |
| N. H., | New Hampshire. | |
| N. Hamp., | New Hampshire Reports, | New Hampshire. |
| N. Y. Leg. Obs., | New York Legal Observer, | New York. |
| Niles' Reg., | Niles' Register, | Washington. |
| Opin., | Opinions of the Attorneys General U. S., | Washington. |
| Ohio, | Ohio Reports, and | Ohio. |
| Paige, | Paige's Chancery Reports, | New York. |
| Paine, | Paine's Reports U. S. Circuit Court, | 2d Circuit. |
| Pa., | Pennsylvania. | |
| Penn., | Pennsylvania Reports, | Pennsylvania. |
| Penn. Law Jour. or P. L. Jour., | Pennsylvania Law Journal, | Philadelphia. |
| Pet., | Peters' Reports U. S. Supreme Court. | |
| Pet. C. C., | Peters' Reports U. S. Circuit Court, | 3d Circuit. |
| Pick., | Pickering's Reports, | Massachusetts. |
| Rich. Law, | Richardson's Law Reports, | South Carolina |
| S. Car., | South Carolina. | |
| Sand. Ch., | Sandford's Chancery Reports, | New York. |
| Sand. C. C., | Sandford's Superior Court Reports, | New York. |
| Serg. & R., | Sergeant & Rawle, | Pennsylvania. |
| Story, | Story's Report U. S. Circuit Court, | 1st Circuit. |
| Sumn., | Sumner's Reports U. S. Circuit Court, | 1st Circuit. |
| Sup. Ct., | Supreme Court U. S. | |
| Upt. on Tr. Mk., | Upton on Trade-Marks, | New York. |
| U. S. Law Jour., or U. S. L. Jour., | U. S. Law Journal, | Connecticut. |
| Verm., | Vermont Reports, | Vermont. |
| Vt., | Vermont. | |
| Wall., Jr., | Wallace, Jr.'s, Reports U. S. Circuit Court, | 3d Circuit. |
| Wash., | Washington's Reports U. S. Circuit Court, | 3d Circuit. |
| Wend., | Wendell's Reports, | New York. |
| West. Law Jour., or W. L. Jour., | Western Law Journal, | Cleveland. |
| Whart., | Wharton's Reports, | Pennsylvania. |
| Whart. Dig., | Wharton's Digest. | |
| Wheat., | Wheaton's Reports U. S. Supreme Court. | |
| Wood. & Min., | Woodbury & Minot's Reports U. S. Cir. Ct.. | 1st Circuit. |
| Wright, | Wright's Reports, | Ohio. |

# INDEX OF TITLES.


PAGE

## A.

ABANDONMENT.
A. Of Copyright and Manuscript, . . . . . 91
B. Of Invention,
1. *Before Patent granted*, . . . . . 92
2. *After Patent granted*, . . . . . 95
3. *Defence of, and who to decide*, . . . . . 96
4. *Proof of.* See EVIDENCE, H. 1.
C. Of Trade-Marks, . . . . . 98
ABRIDGEMENT OF BOOK, what is; when no piracy, . . . . 98
ACCOUNT OF PROFITS, when ordered; what accounted for, . . 100
See also DAMAGES.
ACTIONS.
A. In respect to Copyrights, and Manuscripts, and defences to, 103
B. In respect to Patents.
1. *Right of action, and principles governing*, . . . 104
See also COURTS, B.; EQUITY, B., 1; INJUNCTION, B.
2. *Where to be brought, and how commenced*, . . . . 108
See also COURTS, B. 2.
3. *Parties to.*
See also EQUITY, B. 2.
*a.* Plaintiffs, . . . . . 110
*b.* Defendants, . . . . . 113
See also CORPORATIONS.
4. *Discontinuance of, by whom*, . . . . . 115
5. *Defences to.* See DEFENCES.
6. *Pleadings in.* See PLEADING.
C. In respect to Trade-Marks, and defences to, . . . . 115
See also ALIENS; COURTS, C.; INFRINGEMENT, C.; INJUNCTION, C.
ADDITIONS TO A LITERARY WORK, to whom belong, . . . 117
ADMINISTRATORS, rights of, as to Inventions, . . . . . 117
AGENT AND EMPLOYEE, liability of, as infringers, . . . 119
AGREEMENTS.
A. As to Copyrights, . . . . . 120
B. As to Patents, . . . . . 121
See also ASSIGNMENT, C., and LICENSE, A.

PAGE.

ALIENS.
A. Rights and liabilities of, in respect to Patents, . . . 128
See also PATENTS, K.
B. Rights of, as to infringement of Trade-Marks, . . . . 128
AMBIGUITY IN PATENTS, effect of, as to their validity, . . . 129
See also COMPOSITION OF MATTER, B.; IMPROVEMENT, B.; MACHINE, B.; SPECIFICATION, B.
AMOUNT IN CONTROVERSY, how affects jurisdiction in Patent Cases. 132
ANALOGOUS USE. See DOUBLE USE; NEW APPLICATION.
ANALYSIS, importance of evidence decided by, . . . . . 132
ANSWER. See EQUITY, B. 5.
APPEALS IN PATENT CASES.
A. To the Supreme Court, . . . . . 133
See also WRIT OF ERROR.
B. To Justices of the Circuit Court, District Columbia.
1. *What is; when lies and when not; when lost*, . . . . 135
2. *Duty of Commissioner of Patents in cases of*, . . . . 137
3. *Jurisdiction of justices on appeal*, . . . . . 138
4. *Reasons of appeal; sufficiency of*, . . . . . 141
5. *Practice in cases of appeal*, . . . . . 143
APPLICATION FOR PATENT.
A. When and by whom made; effect of; effect of delay in making or prosecuting, . . . . . 143
B. Powers and duties of Commissioner of Patents on applications for, and in granting patents, . . . . . 149
C. Withdrawal of; effect of, . . . . . 153
ART. What is; when patentable, . . . . . 154
See also EFFECT; PRINCIPLE; PROCESS.
ARTS, LOST. When patentable, . . . . . 155
ARTICLE OF MANUFACTURE. See MANUFACTURE.
ASSIGNEE.
A. Of Copyright and Manuscript, . . . . . 156
B. Of Patent.
1. *Who is, under the Statute*, . . . . . 157
2. *General rights of*, . . . . . 157
3. *When Patent may issue to*, . . . . . 158
4. *When may maintain action*, . . . . . 159
5. *Right of, as to Disclaimer.* See DISCLAIMER, C.
6. " *in cases of Reissue.* See REISSUE OF PATENT.
7. " *in Extensions.* See EXTENSION, C.
C. Of Trade-Marks, rights of, . . . . . 160
ASSIGNMENT.
A. Of Copyright and Manuscript; requisites of; what amounts to, 161

PAGE.

ASSIGNMENT—*continued.*
B. Of Invention or Patent.
1. *What may be assigned, and when; who may make; kinds of,* 162
2. *Recording of,* . . . . . 164
3. *What amounts to; construction of,* . . . . . 166
C. Of Patent or Copyright, by operation of law, . . . . 169
ATTACHMENTS IN PATENT CASES.
A. Commencement of suits by, . . . . . 171
B. To enforce obedience to process, . . . . . 171
C. Practice in cases of, . . . . . 173
AUTHOR. Who is; rights of, in his property, . . . . . 173
See also CHARTS; COPYRIGHT, C.

**B.**

BILL IN EQUITY. See EQUITY, B., 2, 3.
BILLS OF EXCEPTIONS IN PATENT CASES. When taken; what to contain, . . . . . 174
BOOK AND COPY OF. What is, under the copyright laws, . . 176
BURDEN OF PROOF. See EVIDENCE, A.

**C.**

CAVEAT, purpose and effect of, . . . . . 177
CHARGE OF JUDGE IN PATENT ACTIONS, practice as to, . 178
CHARTS, MAPS, PRINTS, &c., extent of Copyright in, . . . 179
COLORABLE ALTERATIONS AND VARIATIONS, bearing of, as to invention, . . . . . 180
See also DOUBLE USE; EQUIVALENT; FORM; INVENTION, E.
COMBINATION.
A. What is; what patentable; construction of patents for, . . 181
B. What an Infringement of, and what not, . . . . . 186
COMMISSIONER OF PATENTS.
A. Power of, on applications for and in granting patents. See APPLICATIONS FOR PATENTS, B.
B. Power of, on Interferences. See INTERFERENCES, A.
C. Power of, on Surrenders and Reissues. See REISSUE OF PATENT, B.
D. Power of, on Extensions. See EXTENSION OF PATENT, B.
E. Power of, in cases of Appeal. See APPEALS, B. 2.
F. Action of; when conclusive, . . . . . 191
G. Acting Commissioner; powers of, . . . . . 193
COMPILATION OF A BOOK; what is, . . . . . 193
COMPOSITION OF MATTER.
A. What patentable, . . . . . 194
B. How should be set forth in Specification, . . . . . 195
C. Infringement of Patent for, . . . . . 196

PAGE

CONGRESS, legislative power of, in respect to patents, . . . . 197
CONSIDERATION ON SALE OF PATENTS, when may be impeached, 199
CONSPIRACY AGAINST PATENT, effect of, . . . . 206
CONSTRUCTION OF PATENT. See PATENT, P.
CONTRACTS AS TO PATENTS. See AGREEMENTS.
COPIES OF PAPERS FROM PATENT OFFICE, how far evidence, . 206
COPYRIGHT.
A. On what founded; nature of property in; what includes, . 208
B. Subject matter of, . . . . . 209
See also ABRIDGEMENT; CHARTS; COMPILATION; DICTIONARIES; DRAMATIC COMPOSITIONS; ENGRAVINGS; MAPS; MUSIC; PLAN; REPORTS; REVIEWS; TRANSLATION.
C. Who entitled to take and hold, . . . . . 210
D. How acquired; right to; how lost, . . . . . 212
E. Second term of, to whom belongs, . . . . . 214
F. Abandonment of. See ABANDONMENT, A.
G. Actions respecting. See ACTIONS, A.
H. Agreements as to. See AGREEMENTS, A.
I. Assignment and transfer of. See ASSIGNEE; ASSIGNMENT, A., C.
J. Author, who is. See AUTHOR.
K. Book, what is. See BOOK.
L. Courts, jurisdiction as to. See COURTS, A.
M. Injunctions, in respect to. See INJUNCTIONS, A.
N. Publication, what is. See PUBLICATION.
O. Translation, Copyright in. See TRANSLATION.
P. Violation of. See INFRINGEMENT, A.
CORPORATIONS, rights and liabilities of, as to Patents, . . . . 215
COSTS IN PATENT SUITS, when recoverable, what taxable, . . 217
COUNSEL FEES, whether recoverable as damages, . . . . . 219
COURTS, JURISDICTION OF.
A. In respect to Copyrights and Manuscripts, . . . . 220
See also ACTIONS, A.; EQUITY, A.; INJUNCTIONS, A.; LETTERS; MANUSCRIPTS.
B. In respect to patents.
1. *Supreme Court, United States,* . . . . . 222
See also APPEALS, A.; BILL OF EXCEPTIONS; WRIT OF ERROR.
2. *Circuit Courts, United States,* . . . . . 223
See also ACCOUNT; EQUITY, B.; INJUNCTION, B.
3. *District Courts, United States, under acts of* 1790 *and* 1793, 227
4. *State Courts,* . . . . . 228
C. Authority of decisions of, in other Courts, . . . . 230

## D.

DAMAGES IN PATENT CASES, who liable for; measure of, &c., . 230
See also COUNSEL FEES.

PAGE.

DECLARATION. See EVIDENCE, D.; PLEADING, A.
DEFENCES TO PATENT ACTIONS, . . . . . 241
See also GENERAL ISSUE; PLEADING, B.; PRIOR USE.
DEMURRER. See EQUITY, B. 4; PLEADING, E.
DEPOSITIONS. See EVIDENCE, C.
DESIGN. Patent for, and infringement of, . . . . . 246
DISCLAIMER.
A. When proper; what to set forth; effect of, . . . . . 247
B. Effect of delay or neglect in filing, . . . . . 249
B. Assignee, right of under, and to make, . . . . . 251
DICTIONARIES, GAZETTEERS, &c., extent of Copyright in, . . 252
DISCOVERY, what is, and what patentable, . . . . . 252
DOUBLE USE, what is; when patentable, . . . . . 254
See also NEW APPLICATION.
DRAMATIC COMPOSITION, right of author in, . . . . . 255
DRAWINGS, requisites of; of what evidence, . . . . . 256

## E.

EFFECT, whether patentable; how far evidence of invention, . . 259
See also PRINCIPLE; PROCESS.
ENGRAVINGS. See CHARTS.
EQUITY, Jurisdiction of, and Pleadings in.
A. As to Copyrights and Manuscripts, . . . . . 262
See also ACTIONS, A.; DRAMATIC COMPOSITIONS; INJUNCTIONS, A.
B. As to Patents.
1. *General Jurisdiction*, . . . . . 263
See also FEIGNED ISSUE; INJUNCTION, B.
2. *Original bill; parties to; what to set forth; Multifariousness of; amendment and dismissal of*, . . . . . 267
3. *Supplemental and cross bill; bill of discovery*. . . . . 269
4. *Demurrer*, . . . . . 270
See also PLEADING.
5. *Answer; what to set forth; when considered only as an affidavit; amendment of*, . . . . . 270
See also DEFENCES; GENERAL ISSUE.
C. As to Trade-Marks, . . . . . 272
See also INJUNCTION, C.
EQUIVALENTS, doctrine as to, and application of, . . . . . 275
See also FORM; INVENTIONS, C.
ESTOPPEL, application of doctrine of, in patent cases, . . . . 278
EVIDENCE IN PATENT CASES.
A. Burden of proof, on whom lies, . . . . . 282
B. Presumptions, . . . . . 283
See also PATENT, P. 2; REISSUE OF PATENT, C.

PAGE.

EVIDENCE IN PATENT CASES—*continued.*
C. Depositions, what are, . . . . . 284
1. *De bene esse under Acts of Congress,* . . . . . 285
2. *Under rule of court, or commission,* . . . . . 287
3. *Under rules of the Patent Office,* . . . . . 288
D. Declarations and acts of parties and third persons, . . . 290
E. Parol and secondary evidence, . . . . . 293
F. Public records and papers; Verdict, . . . . . 294
G. Witnesses. . . . . .
1. *Competency and credit of.*
See also EXPERTS; EVIDENCE, G. 3.
*a.* Of witnesses generally, . . . . . 295
*b.* Of Assignor of Invention in Interferences, . . . 298
2. *Examination and Impeachment of,* . . . . . 298
3. *Parties, Examination of,* . . . . . 300
See also EVIDENCE, G. 1. *a.*
H. Rules as to particular facts and issues.
1. *Abandonment,* . . . . . 300
See also ABANDONMENT.
2. *Fraudulent intent,* . . . . . 302
3. *Infringement,* . . . . . 302
See also COMBINATION, B.; COMPOSITION OF MATTER, C.; INFRINGEMENT.
4. *Invention, and originality and priority of,* . . . 304
5. *Invention, novelty and utility of,* . . . . . 307
EXAMINERS OF PATENT OFFICE, position and duties of, . . 311
EXECUTION, sale of Patents and Copyrights under, . . . . 312
EXPERIMENTS, relation of, as to invention, . . . . . 313
EXPERTS, testimony of; when admissible, and force of, . . . 316
EXTENSION OF LETTERS PATENT.
A. Who may apply for and obtain; in what cases, . . . 319
B. Power of Commissioner on applications for; conclusive nature of action of, . . . . . 320
C. Rights of Assignees and others under, . . . . . 321
D. Authority and force of Extended Patent, . . . . . 327
See also EXTENSION OF PATENT, B.
E. Extension of special laws, and rights under . . . . 328

## F.

FEIGNED ISSUE IN PATENT ACTIONS.
A. When ordered and practice on, . . . . . 329
B. Effect of verdict in, . . . . . 331
FOREIGN PATENT; bearing of, on Home patent; how proved, . . 332

PAGE.

FORM; changes in, when patentable, and when not, . . . . 333
See also COLORABLE ALTERATIONS.

FRAUD, AND FRAUDULENT INTENT IN RESPECT TO PATENTS; what deemed to be, and effect of, . . . . . 337

G.

GENERAL ISSUE, AND NOTICE OF SPECIAL MATTER.
A. Evidence under general issue, . . . . . 341
B. When notice required; what to contain, . . . . 342
C. When special pleas allowable, . . . . . 346
GOOD-WILL OF BUSINESS; what is, and property in, . . . 347
GRANTEE OF PATENT, who is. See ASSIGNEE, B. 1.

I.

IMPROVEMENTS.
A. What patentable; and to what extent, . . . . 348
B. How should be set forth, . . . . . 352
C. Patent for; what secured by; construction of, . . . . 355
INFRINGEMENT.
A. Of Copyright; what constitutes, . . . . . 357
B. Of Patents.
1. *General principles as to*, . . . . . 360
See also ACTIONS, B.; INVENTION, E.
2. *What held to amount to*, . . . . . 365
See also COMBINATION, B.; COMPOSITION OF MATTER, C.; DESIGN.
3. *What held not to amount to*, . . . . . 370
4. *Actions for, and defences in.* See ACTIONS, B. 1, 3; EQUITY, B. 1; DEFENCES.
5. *Evidence as to, and by whom decided.* See EVIDENCE, H. 3.
C. Of Trade-Marks; what is, and nature of, . . . . 373
See also EQUITY, C.
INJUNCTIONS.
A. In respect to Copyrights; when will issue and extent of, . . 377
B. In respect to Patents.
1. *General principles applicable to all kinds of*, . . . 379
2. *Preliminary or Provisional.*
*a.* Allowance or refusal of, . . . . . 381
See also INJUNCTIONS, B. 2. *d.*
*b.* Right to, from exclusive possession or former recoveries; character of such exclusive possession, . . . . . 388
*c.* Security in place of, or on granting, . . . . . 396
*d.* Practice on motions for, . . . . . 398
*e.* Continuance or dissolution of, . . . . . 401

PAGE.

INJUNCTIONS—*continued.*
3. *Final or Perpetual; when granted and when not,* . . 404
See also INJUNCTIONS, B. 1.
4. *Violation of, and attachment on,* . . . . . 407
C. In respect to Trade-Marks, . . . . . 409
See also EQUITY, C.; TRADE-MARKS, C.
INSPECTION OF MACHINES; when ordered, . . . . . 415
INTENT.
A. Patentability of. See PURPOSE.
B. Bearing of, as to Abandonment, Infringement, &c., . . 415
INTERFERENCES ON APPLICATIONS FOR PATENTS.
A. When arise, and general nature of, . . . . . 417
See also EQUIVALENTS; INVENTION, E.
B. Practice in cases of, and evidence in, . . . . . 418
See also EVIDENCE, C. 2; D., E., G.
INTRODUCER OF INVENTION; how protected, . . . . 419
INVENTION.
A. What is, and when patentable, . . . . . 420
See also COLORABLE VARIATIONS; COMBINATION; COMPOSITION OF MATTER; DISCOVERY; DOUBLE USE; EFFECT; FORM; IMPROVEMENTS; INVENTOR, A.; MACHINES; MANUFACTURE, ARTICLE OF; MATERIAL; MECHANIC, SKILL OF; NEW APPLICATION; PATENT, D.; PRINCIPLE; PURPOSE; SUGGESTIONS.
B. Perfecting, or reducing to practice; what is; necessity of; diligence in, . . . . . 424
C. Originality and priority of. See INVENTOR, B.; PRIOR KNOWLEDGE.
As to evidence of, see EVIDENCE, H. 4.
D. Novelty and utility of, . . . . . 429
As to evidence of, see EVIDENCE, H. 5.
E. Identity of, . . . . . 435
See also COLORABLE VARIATIONS; EQUIVALENTS; FORM; INTERFERENCES.
INVENTOR.
A. Who is; and rights of, as such, . . . . . 441
B. First and original; subsequent; rights of, . . . . . 444

J.

JOINT INVENTION AND PATENT; when and rights under, . . 452
JURISDICTION.
Of Courts, see COURTS; EQUITY.
Of Justices' Circuit Court. See APPEALS, B. 3.
JURY; what questions determined by, . . . . . 454
See also PATENT, P. 4.

PAGE.

## L.

LECTURES, right of property in, . . . . . 457
LETTERS, property in and protection of, . . . . . 457
See also MANUSCRIPT.
LICENSE.
A. What constitutes; rights under; effect of taking, . . . 460
See also ASSIGNMENT, B.; EXTENSION OF PATENT, B.
B. Recording, and transfer of, . . . . . 464
C. Forfeiture of; Actions on, . . . . . 466
LIMITATIONS.
A. Of Applications for Patents, . . . . . 469
B. Of Appeals to Justices' Circuit Court, . . . . . 469
C. Of commencing actions, . . . . . 469
LOST ARTS. See ARTS, LOST.

## M.

MACHINE.
A. When patentable; principles of; identity of, . . . . 470
See also FORM; IMPROVEMENT; INVENTION, A., E.
B. Principles of, and modes of application, how explained and described, . . . . . 472
MANUFACTURE, article of, when patentable, . . . . . 473
MANUSCRIPTS, right of property in, and how lost, . . . . 475
See also LETTERS.
MATERIAL OF INVENTION, whether patentable, . . . . 477
MECHANICS, skill and suggestions of; effect of, . . . . . 478
See also SUGGESTIONS.
MEDICINES, rights of inventors in, . . . . . 480
MISTAKES IN PATENTS, effect and correction of, . . . . 482
See also REISSUES OF PATENT.
MODE, METHOD, OR PROCESS; when patentable, . . . 483
See also EFFECT; PRINCIPLE.
MODELS, part of patent; of what evidence, . . . . . 486
MUSIC, copyright in, when, and extent of, . . . . . 487

## N.

NAME, property in. See TRADE-MARK, A.
NEW APPLICATION OR USE, when patentable, . . . . 488
NEW TRIALS IN PATENT CASES, when ordered, when not, . 491
NEWSPAPER, property in; copyright as to, . . . . . 494
NONSUIT, power of Federal Courts to order, . . . . . 495

## O.

OATH IN INVENTION, necessity and force of, . . . . . 495
OYER & PROFERT. See PLEADING, C.

PAGE.

## P.

PARTIES TO ACTIONS. See ACTIONS, B. 3; EQUITY, B. 2.
" DECLARATIONS OF. See EVIDENCE, D.
" EXAMINATION OF. See EVIDENCE, C. 1, *b.*, 3.
PARTNERSHIP IN PATENTS, what constitutes, . . . . 497
PATENTS.
A. Subject Matter of.
See ART; COLORABLE ALTERATIONS; COMBINATION, A.; COMPOSITION OF MATTER, A.; DISCOVERY; DOUBLE USE; EFFECT; EQUIVALENT; EXPERIMENTS; FORM; IMPROVEMENTS, A.; INTENT; INVENTION, A.; MACHINES, A.; MANUFACTURE, ARTICLE OF; MATERIAL; MEDICINE; MECHANIC, SKILL OF; MODE, METHOD, OR PROCESS; NEW APPLICATION; PRINCIPLE; PROCESS; PURPOSE; SUGGESTIONS.
B. Right to, how lost or forfeited. See ABANDONMENT, B.; APPLICATION FOR PATENT, A.; PRIOR USE; and also PRIOR KNOWLEDGE.
C. Grant, or Issue of; by and to whom. See APPLICATION, B.; INTRODUCER; INVENTOR, A., B.; JOINT INVENTOR; and also INVENTION, D.
D. What granted or secured by.
1. *General nature of the grant,* . . . . . 498
See also PATENT, P.
2. *Whether may include more than one invention,* . . . 501
E. What embraced in the Letters Patent, . . . . . 504
F. Application for Patent. See APPLICATION FOR PATENT.
G. Interfering Applications. See INTERFERENCES.
H. Term of; date of; when begins to run, . . . . . 505
See also EXTENSION OF PATENT.
I. Territorial extent of, . . . . . 506
K. Name and title of, . . . . . 506
L. Prior and subsequent for same invention, . . . . . 507
M. Surrender and reissue of. See REISSUE OF PATENT.
N. Renewal and extension of. See EXTENSION OF PATENT.
O. Mistakes in, correction of. See MISTAKES IN PATENT.
P. Construction of.
1. *General principles of construction,* . . . . . 508
See also AMBIGUITY; PATENT, D.; SPECIFICATION, A.
2. *Prima facie authority of,* . . . . . 513
3. *How far construed by the Court,* . . . . . 517
4. *How far construed by the Jury,* . . . . . 519
See also JURY.
5. *Claim in, force and construction of,* . . . . . 521

PAGE.

PATENTS—*continued.*

Q. Violation of. See ACTIONS, A.; COMBINATION, B.; COMPOSITION OF MATTER; DESIGNS; FORM; INFRINGEMENT, B.

R. When void, . . . . . 525

See also ABANDONMENT, B.; DEFENCES; PRIOR KNOWLEDGE; PRIOR USE.

S. TRANSFER OF. See ASSIGNMENT, B., C.

PARTICULAR PATENTS.

Apple-Paring Machine, . . . . . 531
Auger, for boring Muskets, . . . . . 531
Bank-Note printing, . . . . . 531
Bark Mills, . . . . . 532
Bran Duster, . . . . . 532
Brass Kettles, . . . . . 533
Brick Machine, . . . . . 533
Burring Machines, . . . . . 533
Buttons, Designs for, . . . . . 534
Cars, supporting Bodies of, . . . . . 534
Cars for Coal, . . . . . 535
Carriages for Railways, &c., . . . . . 535
Cars, Eight-Wheeled, . . . . . 535
Car Wheels, . . . . . 536
Casters for Bedsteads, . . . . . 537
Cotton Gin, Ribs of, . . . . . 537
Cotton Speeder, . . . . . 537
Cultivators, . . . . . 538
Dyeing Parti-Colored Yarn, . . . . . 538
Dyeing and finishing Silk Goods, . . . . . 539
Electric Telegraph, . . . . . 539
Fire-Engines, . . . . . 542
Glass Knobs, . . . . . 542
Grain-cleaning Machines, . . . . . 543
Grinding Tools, . . . . . 543
Gun Locks, . . . . . 544
Harvesting Machines, . . . . . 544
Hat Bodies, making, . . . . . 546
Ice, cutting, . . . . . 547
India-rubber, . . . . . 547
Irregular Forms, turning, . . . . . 550
Lead Pipe Machines, . . . . . 552
Locomotives, Variable Exhaust of, . . . . . 553
Looms, . . . . . 554
Matches, Friction, . . . . . 554
Millstones, regulating, &c., . . . . . 555

PAGE.

PARTICULAR PATENTS—*continued.*
Mouldings, making, . . . . . 555
Nails, Manufacture of, . . . . . 555
Palm-leaf, preparing, . . . . . 556
Paper, Manufacture of, . . . . . 556
Planing Machines, . . . . . 557
Ploughs, . . . . . 560
Puddle Balls, rolling, . . . . . 561
Rails for Railroad Carriages, . . . . . 561
Rocking Chairs, . . . . . 562
Saddles, . . . . . 562
Saw Mills, Circular, . . . . . 562
" Portable, Circular, . . . . . 563
Sewing Machines, . . . . . 563
Sowing Seed, . . . . . 568
Steam-Engines, . . . . . 568
" Generators, . . . . . 569
Stoves, . . . . . 569
Straw-Cutter, . . . . . 570
Tailors' Shears, . . . . . 571
Thread, packing, &c., . . . . . 571
Valves for Governors, . . . . . 571
" Lifting and Tripping, . . . . . 572
" Lifting, . . . . . 573
Water-Closet Valves, Governors for, . . . . . 573
Water Wheels, . . . . . 573
Wheels, horizontal, for Boats, . . . . . 575
Wood-Bending Machine, . . . . . 575

PATENTED ARTICLES OR MACHINES.
A. Rights of purchasers to use, repair, &c., . . . . . 576
B. Products of, right to sell and use, . . . . . 580

PENALTIES, AND ACTIONS FOR.
A. Under the Copyright laws, . . . . . 583
B. Under the Patent laws, . . . . . 584

PERFECTING AN INVENTION. See INVENTION, B.

PLAN OF A WORK. See COPYRIGHT, B.

PLEADING.
A. Declaration; what to set forth, . . . . . 585
B. Pleas in bar, . . . . . 588
See also DEFENCES; GENERAL ISSUE.
C. Oyer and Profert, . . . . . 589
D. Defects in, cured by verdict, . . . . . 590
E. Demurrer, . . . . . 590
See also PLEADINGS, A. B.

PAGE.

PRINCIPLE, whether patentable; to what extent, . . . . . 591
See also ART; DISCOVERY; EFFECT; MODE OR METHOD; PURPOSE.
PRINCIPLE OF A MACHINE. See MACHINES, A.
PRINTED PUBLICATION. See PUBLIC WORK.
PRIOR KNOWLEDGE, AND INVENTION, . . . . . 595
See also INVENTION, A.; INVENTOR, A., B.; PUBLIC WORK.
PRIOR USE, which will forfeit a patent, . . . . . 603
See also ABANDONMENT, B. 1.
PROFERT. See PLEADING, C.
PUBLIC USE, what meant by, . . . . . 608
PUBLIC WORK, OR PRINTED PUBLICATION . . . . 608
See also PRIOR KNOWLEDGE AND INVENTION.
PUBLICATION OF BOOK, what is; effect of, . . . . . 609
PURPOSE, . . . . . 610
See also EFFECT; NEW APPLICATION.

## R.

REISSUE OF PATENT.
A. When may be had; by whom; for what, . . . . . 612
See also REISSUE OF PATENT, B.
B. Action of Commissioner in cases of, . . . . . 617
C. To be for same Invention as the original, . . . . . 618
D. Validity and force of, and rights conferred by, . . . . 622
See also REISSUE OF PATENT, B.
E. Effect of, on assignees and others, and their rights under, . 625
REPAIRS OF PATENTED MACHINES. See PATENTED MACHINES, A.
REPORTS, Copyright in, . . . . . 626
RESTRAINT OF TRADE AS TO PATENTS, what is not, . . . 626
RESULT. See EFFECT; PURPOSE.
REVIEWS, when piracy of Copyright; when not, . . . . . 627
RULES OF PATENT OFFICE, authority of, . . . . . 627

## S.

SECRET USE OF INVENTION, effect of, . . . . . 628
SPECIFIC PERFORMANCE OF CONTRACTS AS TO PATENTS, 630
SPECIFICATION.
A. General principles of construction. See PATENTS, P. 1.
B. How invention to be described in, . . . . . 630
See also COMPOSITION OF MATTER, B.; IMPROVEMENT, B.; MACHINE, B.
C. Ambiguity in, and effect of. See AMBIGUITY.
D. Concealment in, and effect of, . . . . . 636
E. Defects in, how remedied. See MISTAKES; REISSUE OF PATENT.

PAGE.

STATUTES, CONSTRUCTION OF.

A. Copyright acts, . . . . . 638

B. Patent acts.

1. *Power of Congress to enact.* See CONGRESS.

2. *Policy and Intent of,* . . . . . 647

See also PATENTS, P.

3. *General or Public acts,* . . . . . 649

4. *Special or Private acts.*

*a.* Generally, . . . . . 676

*b.* Act for relief of Thomas Blanchard, . . . . 677

*c.* " " Oliver Evans, . . . . . 678

*d.* " " William Woodworth, . . . . 679

SUGGESTIONS, bearing of, on invention, . . . . . 680

See also MECHANIC, SKILL OF.

T

TECHNICAL TERMS, &c., meaning of; who may prove, . . . 681

THEORY, patentability of, . . . . . 682

TRADE-MARKS.

A. Property in; in what may exist, . . . . . 683

B. Who may acquire property in, . . . . . 687

See also ALIENS.

C. Property in; how protected. See ACTIONS, C.; EQUITY, C.

D. Violation of, what is. See INFRINGEMENT, C.

E. When violation of, will be restrained. See INJUNCTION, C.

TRANSLATION, Copyright in, . . . . . 691

U.

UNITED STATES, rights and liabilities of, as to patents, . . . 692

V.

VERDICT IN PATENT CASES, effect of, . . . . . 693

See also FEIGNED ISSUE, B.; PLEADING, D.; INJUNCTION, B. 2. *b.*

W.

WARRANTY, as to Patents, . . . . . 694

WITHDRAWAL. See APPLICATION FOR PATENT, C.

WITNESSES. See EVIDENCE, G.

WORKMEN. See AGENT; EMPLOYEE.

WRIT OF ERROR IN PATENT CASES, . . . . . 695

See also APPEALS; BILLS OF EXCEPTIONS; COURTS, B. 1.

# TABLE OF CASES

IN ALPHABETICAL ORDER,

DIRECT AND REVERSED, WITH REFERENCES UNDER THE FORMER

TO THE PAGES OF THIS DIGEST.

---

## A.


| | | | |
|---|---|---|---|
| Abbott, Howe *v.* | 2 Story, 190, | Mass., 1842. | |
| " Rogers *v.* | 4 Wash., 514, | Pa., 1825. | |
| " Spear *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Adams, Ex parte, | " " | " 1860, | 255, 478. |
| " *v.* Edwards, | MS., | Mass., 1848, | 183, 608, 682. |
| " Herbert *v.* | 4 Mason, 15, | " 1825. | |
| " *v.* Jones, | 1 Fisher, 527, | Pa., 1859, | 95, 147, 607. |
| " Minis' Assignee *v.* | 3 Wall, Jr., | " 1861. | |
| " Wilder *v.* | 2 Wood. & Min., 329, | Mass., 1846. | |
| Ager's Case, | MS. Opin., | " 1859, | 159, 669. |
| Aiken, Ex parte (Propellers), | MS. (App. Cas.), | D. C., 1850, | 137, 139, 142, 151, 312, 433. |
| " " " (Car-Wheel), | " " | " 1850, | 139, 142, 143, 151, 433. |
| " *v.* Bemis, | 3 Wood. & Min., 348, | Mass., 1847, | 188, 233, 287, 291, 371, 477, 493, 522. |
| Alden *v.* Dewey, | 1 Story, 336, | " 1840, | 232, 243, 290, 303, 305, 361, 491, 496, 513, 680. |
| Allen, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 254, 490. |
| " *v.* Alter, | " " | " 1860, | 143, 290, 298. |
| " *v.* Blunt, | 3 Story, 742, | Mass., 1845, | 191, 294, 317, 331, 437, 613, 617, 623, 693. |
| " *v.* " | 2 Wood. & Min., 121, | " 1846, | 144, 175, 179, 192, 220, 232, 243, 280, 283, 286, 293, 294, 303, 447, 469, 492, 617, 618, 624, 666. |
| " *v.* " | 1 Blatchf., 480, | N. Y., 1849, | 100, 109, 132, 225, 265. |
| " *v.* Hunter, | 6 McLean, 303, | Ohio, 1855, | 133, 177, 181, 197, 297, 317, 368, 427, 449, 512, 515, 523, 600, 608. |
| " Nourse *v.* | 4 Blatchf., 376, | N. Y., 1858. | |
| " Palmer *v.* | MS., | " 1854. | |
| " *v.* Sprague, | 1 Blatchf., 567, | " 1850, | 331, 392, 544. |
| Alter, Allen *v.* | MS. (App. Cas.), | D. C., 1860. | |
| Amer. Elas. Cloth Co., Cong. Rubber Co. *v.* | MS., | Pa, 1857. | |
| Amer. Pin Co. *v.* Oakville Co., | 3 Blatchf., 190; 3 A. L. Reg., 136, | Ct., 1854, | 260, 336, 372, 523, 529, 635. |
| Amer. Hair Co., Muscan Hair Co. *v.* | 4 Blatchf., 174, | N. Y., 1858. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


| | | | |
|---|---|---|---|
| Ames *v.* Howard, | 1 Sumn., 482, | Mass., 1833, | 105, 131, 182, 361, 488, 491, 509, 527, 557, 622, 648. |
| " *v.* King, | 2 Gray, 379, | " 1854, | 116. |
| Ames. Nail Fac., Odiorne *v.* | 2 Mason, 28, | " 1819, | |
| Amosk. Mfg. Co. *v.* Spear, | 2 Sand., S. C., 599, | N. Y., 1849, | 98, 161, 272, 374, 410, 684, 688. |
| Anonymous, | 1 Opin., 110, | 1802, | 128. |
| " | 1 " 171, | 1812, | 206, 649, 655. |
| " | 5 " 701, | 1814, | 149, 417, 654. |
| " | 1 " 376, | 1820, | 206, 655. |
| " | 1 " 718, | 1825, | 206, 655. |
| " | 2 " 455, | 1831, | 149, 206, 612, 622, 655. |
| " | 2 " 511, | 1832, | 150. |
| " | 3 " 165, | 1836, | 339, 612. |
| " | 3 " 532, | 1840, | 496. |
| " | 4 " 399, | 1845, | 158, 453, 669. |
| " | 3 W. L. Jour., 144, | 1845, | 114, 405, 581. 371. |
| " | 5 Opin., 18, | 1848, | 447, 597, 665. |
| " | 6 " 36, | 1853, | 153. |
| " | 6 " 38, | 1853, | 137. |
| " | MS.," | 1857, | 153, 177, 662. |
| " | MS.," | 1859, | 259. |
| Appleton *v.* Chambers, | MS. (App. Cas.), | D. C., 1860, | 429, 452. |
| " Dwight *v.* | 1 N. Y. L. Obs., 195, | N. Y., 1843. | |
| " Heine *v.* | 4 Blatchf., 125, | " 1857. | |
| Armstrong *v.* Hanlenbeck, | 3. N. Y. L. Obs., 43, | " 1844, | 279, 405, 41, 466. |
| Arnold *v.* Bishop, | MS. (App. Cas.), | D. C., 1841, | 135, 138, 30, 288, 296, 418, 453, 627, 673, 674. |
| " *v.* Potter, | " " | " 1860, | 423. |
| Arthur, Ex parte, | " " | " 1861, | 311. |
| Atkinson *v.* Boardman, | " " | " 1847, | 283, 284, 291, 442. |
| " *v.* " | MS., | N. Y., 1851, | 265, 666. |
| Atwill, Ferrett *v.* | 1 Blatchf., 151, | " 1846. | |
| " *v.* " | 2 " 39, | " 1846, | 103, 174, 211, 270, 642, 644. |

## B.

| | | | |
|---|---|---|---|
| Babcock *v.* Degener, | MS. (App. Cas.), | D. C., 1859, | 136, 147, 602, 660. |
| Backus *v.* Gould, | 7 How., 798, | Sup. Ct., 1848, | 584, 644. |
| Bacon's Case, | 2 Opin., 109, | 1828, | 480, 506 |
| " Peck *v.* | 18 Conn., 377, | Ct., 1847. | |
| Badger, Orr *v.* | 7 Law Rep., 465, | Mass., 1844. | |
| Bagley, Hawley *v.* | MS., | N. Y., 1855. | |
| Bagot, Gebberd *v.* | MS., | Ct., 1857. | |
| Bain *v.* Morse, | MS. (App. Cas.), | D. C., 1849, | 139, 184, 259, 335, 417, 540, 592. |
| Baker *v.* Taylor, | 2 Blatchf., 82, | N. Y., 1848, | 213, 609. |
| Ball, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 616, 620, 628, 669. |
| " *v.* Murry, | 10 Penn., 111, | Pa., 1848, | 203, 314, 425. |
| " Root *v.* | 4 McLean, 177, | Ohio, 1846. | |
| Bal. & Sus. R. R., Stimpson *v.* | 10 How., 329, | Sup. Ct., 1850. | |
| Bamker, Parker *v.* | 6 McLean, 631, | Ohio, 1855. | |
| Banks, Gould *v.* | 8 Wend., 562, | N. Y., 1832. | |
| Barber, Mowry *v.* | MS. (App. Cas.), | D. C., 1858. | |
| Barbour, Woodworth *v.* | Cited 1 Blatchf., 529. | Me., 1850. | |
| Barclay, Mitchell *v.* | MS., | N. Y., 1860. | |
| Barnard, Gibson *v.* | 1 Blatchf., 388, | " 1848. | |
| " *v.* " | 7 How., 650, | Sup. Ct., 1848, | 134. |
| " Parsons *v.* | 7 John., 144, | N. Y., 1810. | |
| Barnum, Hopkins *v.* | MS. (App. Cas.), | D. C., 1854. | |
| " Wilson *v.* | 1 Wall, Jr., 342, | Pa., 1849. | |
| " " | 1 " 347, | " 1849. | |
| " " | 8 How., 258, | Sup. Ct., 1849. | |
| Barrett *v.* Hall, | 1 Mason, 447, | Mass, 1818, | 129, 181, 187, 278, 316, 349, 353, 355, 436, 452, 470, 502, 507, 508, 525, 539 59?. |
| " Morris *v* | 1 Fisher, 461, | Ohio, 1859. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Barrett, Stearnes *v.* | 1 Mason, 153, | Mass., 1816. | |
| " " | 1 Pick., 443, | " 1823. | |
| Barry *v.* Clirhugh, | 12 Law Rep., 367, | N. Y., 1849, | 626. |
| Barstow, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 441, 611. |
| " *v.* Swan, | " " | " 1860, | 298, 307, 516. |
| Bartholomew *v.* Sawyer, | 4 Blatchf., 347, | N. Y., 1859, | 306, 427, 450, 457, 516, 519, 573, 602, 609, 659. |
| Bartlette *v.* Crittenden, | 4 McLean, 300, | Ohio, 1847, | 91, 104, 221, 262, 457, 476, 645. |
| " *v.* " | 5 " 32, | " 1849. | 91, 162, 213, 221, 457, 458, 476, 609, 645. |
| Battel, Tomlinson *v.* | MS., | N. Y., 1857. | |
| Battin *v.* Clayton, | 2 Whar. Dig., 409, | Pa., 1848 | 183, 248. |
| " Heilner *v.* | 27 Penn., 517, | " 1856. | |
| " *v.* Silliman, | 3 Wall, Jr., | " 1861. | 388. |
| " *v.* Taggert, | 2 " 101, | " 1851, | 96, 618. |
| " *v.* " | 17 How., 74, | Sup. Ct., 1854, | 96, 97, 192, 245, 310, 321, 327, 439, 456, 520, 615, 618, 619, 622, 625. |
| Beach *v.* Wheeler, | 24 Penn., 212. | Pa., 1855, | 107. |
| Bean, Seeley *v.* | MS. (App. Cas.), | D. C., 1861. | |
| " *v.* Smallwood, | 2 Story, 408, | Mass., 1843. | 432, 471, 488, 562, 611. |
| Bedford *v.* Hunt, | 1 Mason, 302, | Mass., 1817, | 150, 242, 342, 430, 445, 446, 525, 595, 653, 682. |
| Beech *v.* Tucker, | MS. (App. Cas.), | D. C., 1860, | 136, 148, 307, 673. |
| Beecher, Wilbur *v.* | 2 Blatchf., 132, | N. Y., 1850, | |
| Beers, Blanchard *v.* | 2 " 411, | Ct., 1852. | |
| Bell *v.* Daniels, | 1 Fisher, 372, | Ohio, 1858, | 96, 190, 239, 246, 306, 311, 364, 507, 513, 516, 607. |
| Bell, Davis *v.* | 8 N. Hamp., 500, | N. H., 1837. | |
| " *v.* Hill, | MS. (App. Cas.), | D. C., 1854, | 317. |
| " *v.* Locke, | 8 Paine, 75, | N. Y., 1840, | 494. |
| " *v.* McCullough, | 1 Fisher, 380, | Ohio, 1858, | 115, 164, 169, 239, 464. |
| " *v.* Phillips, | MS., | " 1858, | 240. |
| Bellas *v* Hays, | 5 Serg. & R., 427, | Pa., 1819, | 199. |
| Bemis, Aiken, *v.* | 3 Wood. & Min., 348, | Mass., 1847. | |
| Bennett *v* Martin, | 6 Mo., 460, | Mo., 1840, | 588. |
| Berg *v.* Thistle, | MS. (App. Cas.), | D. C., 1860, | 148, 629. |
| Berger, Samuel *v.* | 24 Barb. S. C., 163, | N. Y., 1856. | |
| Berry, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 186, 255. |
| Betts, Gibson *v.* | 1 Blatchf., 163, | N. Y., 1846. | |
| Beverly Rub. Co. *v.* Wiag, | MS. (App. Cas.), | D. C., 1860, | 429, 451. |
| Bicknell, Brooks *v.* | 3 McLean, 250, | Ohio, 1843. | |
| " " | 3 " 432, | " 1844. | |
| " " | 4 " 64, | " 1845. | |
| " " | 4 " 70, | " 1845. | |
| " *v.* Todd, | 5 " 236, | " 1851, | 112, 160, 265, 462, 578 |
| Bigler, Parker *v.* | 1 Fisher, 285, | " 1857, | |
| Billings, Marsh *v.* | 7 Cush., 322, | Mass., 1851. | |
| Binns *v.* Woodruff, | 4 Wash, 48. | Pa., 1821, | 179, 210, 247, 640. |
| Bird, Harmon *v.* | 22 Wend., 113, | N. Y., 1839. | |
| Birt, Loudon *v.* | 4 Ind., 566, | Ind., 1853. | |
| Bishop, Arnold *v.* | MS. (App. Cas.), | D. C., 1841. | |
| " Goodyear *v.* | 4 Blatchf., 438 | N. Y., 1860. | |
| Bladen, Treadwell *v.* | 4 Wash., 703, | Pa., 1827. | |
| " Watson *v.* | 4 " 580, | " 1826. | |
| Blake *v.* Sperry, | 2 N. Y. L. Obs., 251, | Ct., 1843, | 131, 472, 488, 537. |
| Blakinton, Douglass *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Blanchard's Case, | 5 Opin., 722, | 1820, | 505. |
| " " | Opin., Gilpin's Ed., p. 1125, | 1837, | 328, 677, 692. |
| " *v.* Beers, | 2 Blatchf, 411, | Ct, 1852, | 276, 362, 367, 437, 551. |
| " *v.* Eldridge, | 1 Wall, Jr., 337, | Pa., 1849, | 112, 163, 462, 500, 661, 664. |
| " *v.* Haynes, | 6 W. L. Jour., 82, | N. H., 1848, | 198, 328. |
| " *v.* Sprague, | 3 Sumn., 535; 2 Story, 164, | Mass., 1839, | 198, 328, 510, 521, 551, 552, 592, 676, 677. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Blanchard *v.* Sprague, | 3 Sumn., 279, | Mass., 1838, | 552, 677. |
| " *v.* Whitney, | 3 Blatchf., 307, | N. Y., 1855, | 579. |
| Blan. Gun-Stk. Fac. *v.* Jacobs, | 2 Blatchf., 69, | " 1847, | 114, 493, 581. |
| " *v.* Warner, | 1 " 258, | C., 1846, | 165, 198, 216, 220, 275, 323, 328, 420, 437, 456, 479, 522, 551, 552, 661, 676, 678. |
| Blandy, Ex parte, | MS. (App. Cas.), | D. C., 1858, | 254, 490. |
| " Lee *v.* | 2 Fisher, 89, | Ohio, 1860. | |
| Bliss *v.* Negus, | 8 Mass., 46, | Mass., 1811, | 199. |
| Blood, Wellman *v.* | MS. (App. Cas.) | D. C., 1856. | |
| Bloomer, Bloss *v.* | 23 Barb. S. C., 604, | N. Y., 1857. | |
| " *v.* McQuewan, | 14 How., 539, | Sup. Ct., 1852, | 110, 158, 164, 199, 226, 229, 325, 326, 329, 578, 638, 677. |
| " *v.* Stolley, | 5 McLean, 158, | Ohio, 1850, | 198, 324, 328, 511, 578, 624, 676, 679. |
| " *v.* Vaught, | Cited 1 Blatchf., 529, | La., 1850, | 680. |
| Bloss *v.* Bloomer, | 23 Barb. S. C., 604, | N. Y., 1857, | 690. |
| Blunt, Allen *v.* | 3 Story, 742, | Mass., 1845. | |
| " " | 2 Wood. & Min., 121, | " 1846. | |
| " " | 1 Blatchf., 480, | N. Y., 1849. | |
| " *v.* Patten, | 2 Paine, 393, | " 1828, | 91, 179, 208, 377, 638. |
| Boardman, Atkinson *v.* | MS. (App. Cas.), | D C., 1847. | |
| " " | MS., | N. Y., 1851. | |
| Booth *v.* Garelly, | 1 Blatchf., 247, | " 1847, | 94, 95, 247, 301, 393, 456, 534 581, 672. |
| Borden, Sickles *v.* | 3 Blatchf., 535, | N. Y., 1856. | |
| " " | 4 Blatchf., 14, | " 1857 | |
| Bost. Belt. Co., Chaffee *v.* | 22 How., 217, | Sup. Ct., 1859. | |
| " Day *v.* | 6 Mo. L. Rep., 300, | Mass., 1853. | |
| " " | " | " 1854. | |
| Bost. Manuf'g. Co. *v.* Fiske, | 2 Mason, 119, | Mass., 1820, | 219, |
| Bost. & Prov. R. R., Winans *v.* | 2 Story, 412, | " 1843. | |
| Boughton, Ex parte, | MS. (App. Cas.), | D. C., 1854, | 276. |
| Bourne, Goodyear *v.* | 3 Blatchf., 266, | N. Y., 1855. | |
| Boyd *v.* Brown, | 3 McLean, 295, | Ohio, 1843, | 370, 404, 499, 580. |
| " *v.* McAlpine, | 3 " 427, | " 1844, | 113, 119, 157, 163, 165, 371, 405, 580. |
| Boyden *v.* Burke, | 14 How., 575, | Sup. Ct., 1852, | 207, 658. |
| Bradford, Forbush *v.* | 11 Mo. L. Rep., 471, | Mass., 1856. | |
| Braint. Manuf'g Co., Carver *v.* | 2 Story, 432, | " 1843. | |
| Brant, Parker *v.* | 1 Fisher, 58, | Pa., 1850. | |
| Brewer, Clum *v.* | 2 Curt., 506, | Mass., 1855. | |
| " " | 11 Mo. L. Rep., 390, | " 1856. | |
| Brewster, Burnham *v.* | 1 Verm., 87, | Vt., 1828. | |
| Brockway, Darst *v.* | 11 Ohio, 462, | Ohio, 1842. | |
| Brook, W. L. Co. *v.* Masury, | 25 Barb. S. C., 416, | N. Y., 1857, | 414, 690. |
| Brookfield, Yearsley *v.* | MS. (App. Cas.), | D. C., 1853. | |
| Brooks *v.* Bicknell, | 3 McLean, 250, | Ohio, 1843, | 111, 117, 159, 180, 191, 256, 267, 271, 319, 320, 321, 329, 354 361, 365, 383, 390, 399, 420, 436, 455, 477, 557, 597, 633, 652, 667. |
| " *v.* " | 3 " 432, | " 1844, | 117, 163, 188, 207, 248, 250, 282, 294, 303, 316, 319, 320, 327, 354, 455, 471, 510, 514, 517 520, 527, 557, 633, 648, 658, 681. |
| " *v.* " | 4 " 64, | " 1845, | 320, 322. |
| " *v.* " | 4 " 70, | " 1845, | 188, 329, 332, 383, 491, 558. |
| " *v.* Byam, | 1 Story, 300, | Mass., 1840, | 270. |
| " *v.* " | 2 " 525, 553, | " 1843, | 162, 165, 217, 460, 464, 661. |
| " De Witt *v.* | MS., | N. Y., 1861. | |
| " *v.* Fiske, | " | Mass., 1851, | 366, 473, 522, 559, 593. |
| " *v.* " | 15 How., 212, | Sup. Ct., 1853, | 189, 340, 523, 560, 624. |
| " Stimpson *v.* | 3 Blatchf., 456, | N. Y., 1856. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Brooks, *v.* Stolley, | 3 McLean, 523, | Ohio, 1845, | 121, 224, 264, 280, 405, 461, 466, 630. |
| Brown, Boyd *v.* | 3 " 295, | " 1843. | |
| " Davoll *v.* | 1 Wood. & Min., 53, | Mass., 1845. | |
| " " | 3 W. L. Jour., 151, | " 1845. | |
| " *v.* Duchesne, | 2 Curt., 97, | " 1854, | 591. |
| " *v.* " | 2 " 371, | " 1855, | 372, 506. |
| " *v.* " | 19 How., 183, | Sup. Ct., 1856, | 372, 506, 648. |
| " *v.* Shannon, | 20 How., 55, | " 1857, | 133, 223, 227, 630. |
| " *v.* Wright, | 17 Ark., 9, | Ark., 1856, | 204. |
| Brown Bros., Phelps, Dodge & Co. *v.* | 4 Blatchf., 362, | N. Y., 1859. | |
| Brundage & Wood, Ex parte, | 9 Wheat, 603, | Sup. Ct., 1824, | 228. 654. |
| Brunswick *v.* Holzalb, | MS., | Ohio, 1858, | 345. |
| Brunton, Coffeen *v.* | 4 McLean, 516, | Ind., 1849. | |
| Bryan, McGaw *v.* | 1 U. S. L. Jour., 82, | N. Y., 1822. | |
| Bryce *v.* Dorr, | 3 McLean, 582, | Mich., 1845, | 114, 119, 232, 365. |
| Buck *v.* Cobb & Hermance | 9 Law Rep., 545, | N. Y., 1846, | 114, 119, 268, 383, 391. |
| " *v.* Gill, | 4 McLean, 174, | Ohio, 1846, | 405, 570. |
| " *v.* Hermance, | 1 Blatchf., 322, | N. Y., 1848, | 295, 297, 300, 494, 693. |
| " *v.* " | 1 " 398, | " 1849, | 183, 234, 335, 518, 569. |
| Bull *v.* Pratt, | 1 Conn., 342, | Ct., 1815, | 338, 694. |
| Bullard, Byam *v.* | 1 Curt., 100, | Mass., 1852. | |
| Burden *v.* Corning, | MS., | N. Y., 1850, | 309, 366, 484, 561. |
| " Corning *v.* | 15 How., 252, | Sup. Ct., 1853. | |
| Burke, Boyden *v.* | 14 " 575, | " 1852. | |
| Burlew *v.* O'Niel, | MS. (App. Cas.), | D. C., 1853, | 139, 152, 340, 456. |
| Burnham *v.* Brewster, | 1 Verm., 87, | Vt., 1828, | 200. |
| " Dietz *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Burr *v.* Cowperthwaite, | 4 Blatchf., 163, | Ct., 1858, | 261, 373, 547. |
| " *v.* Gregory, | 2 Paine, 426, | N. Y., 1828, | 223, 263, 267, 630. |
| " McCay *v.* | 6 Penn., 147, | Pa., 1847. | |
| Burnett *v.* Phalon, | 12 Mo. L. Rep., 220, | N. Y., 1859, | 376, 686. |
| " *v.* " | 19 How. Pr., 530, | " 1860, | 300. |
| " *v.* " | 21 " " 100, | " 1861, | 376. |
| Burrall *v.* Jewett, | 2 Paige, 134, | N. Y., 1830, | 200, 223, 256, 632, 653, 656. |
| Burrows *v.* Wetherell, | MS. (App. Cas.), | D. C., 1854, | 427. |
| Buss *v.* Putney, | 11 Mo. L. Rep., 687, | N. H., 1858, | 205, 464, 580. |
| Byam, Brooks *v.* | 1 Story, 300, | Mass., 1843. | |
| " Brooks *v.* | 2 Story, 525, 553, | " 1843. | |
| " *v.* Bullard, | 1 Curt., 100, | " 1852, | 107, 372. |
| " *v.* Eddy, | 2 Blatchf., 521, | Vt., 1853, | 197, 408, 555. |
| " *v.* Farr, | 1 Curt., 260, | Mass., 1852, | 189, 196, 275, 554. |
| Byass *v.* Sullivan, | 21 How. Pr., 50, | N. Y., 1860, | 300. |


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| Cady, Stephens *v.* | 14 How., 528, | Sup. Ct., 1852. | |
| " Stevens *v.* | 2 Curt., 200, | R. I., 1854. | |
| Cahoon *v.* Ring, | 1 Fisher, 397, | Me., 1859, | 278, 283, 306, 337, 364, 428, 440, 451, 516, 568, 602. |
| Caldwell, Stephens *v.* | MS., | Mass., 1860. | |
| Calvert, Nesmith *v.* | 1 Wood. & Min., 34, | " 1845. | |
| Campbell, Dobson *v.* | 1 Sumn., 319, | Me., 1833. | |
| " Vance *v.* | 1 Fisher, 483, | Ohio, 1859. | |
| Cansler *v* Eaton, | 2 Jones Eq., 499, | N. C., 1856, | 205, 695. |
| Card, Dodge *v.* | 2 Fisher, 116, | Ohio, 1860. | |
| Carey *v* Collier, | 56 Niles' Reg., 262, | N. Y., 1839, | 210, 641. |
| Carlan, Stone *v.* | 3 Mo. L. Rep., 360, | Mass., 1855. | |
| Carpenter, Taylor *v.* | 11 Paige, 293, | N. Y., 1844. | |
| " " | 3 Story, 458, | Mass., 1844. | |
| " " | 2 Wood. & Min., 1, | " 1846. | |
| " " | 2 Sand. Ch., 603, | N. Y., 1846. | |
| Carr *v.* Rice, | 1 Fisher, 198, | " 1856, | 434, 449, 625, 635. |
| " " | 4 Blatchf., 200, | " 1858, | 261. 532. |
| Carroll *v.* Gambril, | MS. (App. Cas.), | D. C., 1853, | 281. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Carter *v.* Carter, | MS. (App. Cas.), | D. C., 1855, | 136, 289, 419. |
| " Sargeant *v.* | 11 Mo. L. Rep., 651, | Mass., 1858. | |
| " Whitney *v.* | Fes. on Pat. (2d Ed.) 130, | Geo., 1809. | |
| Carver *v.* Braint. Mfg. Co., | 2 Story, 432, | Mass., 1843, | 182, 334, 455, 473, 510, 519, 537, 613, 618, 622. |
| " *v.* Hyde, | 16 Pet., 513, | Sup. Ct., 1842, | 187, 259, 537. |
| Carusi, Reed *v.* | 8 Law Rep., 410, | Md., 1845. | |
| Cary, Day *v.* | 4 Blatchf., 271, | N. Y., 1859. | |
| Case *v.* Morey, | 1 N. Hamp., 347, | N. H., 1818, | 167, 199. |
| " *v.* Redfield, | 4 McLean, 526, | Ind., 1849, | 165, 324, 588. |
| Chaffee *v.* Boston Belt Co., | 22 How., 217, | Sup. Ct., 1859, | 176, 327, 370, 580, 638. |
| " Goodyear *v.* | 3 Blatch., 268, | N. Y., 1855. | |
| " *v.* Hayward, | 20 How., 208, | Sup.Ct., 1857, | 110, 171, 227. |
| " *v.* N. E. Car Spring Co., | MS., | N. Y., 1854. | |
| Chamberlin *v.* Ganson, | 2 Blatchf., 279, | " 1851, | 367. |
| Chambers, Ex parte, | MS. (App. Cas.), | D. C., 1859, | 137. |
| " Appleton *v.* | " " | " 1860. | |
| " Evans *v.* | 2 Wash., 125, | Pa., 1807. | |
| Champ. Trans. Co., Sherman *v.* | 31 Verm., 162, | Vt., 1858. | |
| Chandler *v.* Ladd, | MS. (App. Cas.), | D. C., 1857, | 427, 434. |
| Chatfield & Dutcher, Ex parte, | " " | " 1859, | 337. |
| Christy *v.* Murphy, | 12 How. Pr., 77, | N. Y., 1856, | 412, 685, 689. |
| Clark *v.* Clark, | 25 Barb. S. C., 75, | " 1857, | 376, 414, 690. |
| " " *v.* | 25 " 75, | " 1857. | |
| " Greenough *v.* | MS. (App. Cas.), | D. C., 1853. | |
| Claypool, Haussknecht *v.* | 1 Black, 431, | Sup. Ct., 1861. | |
| Clayton, Battin *v.* | 2 Whar. Dig., 409, | Pa., 1848. | |
| " *v.* Stone, | 2 Paine, 382, | N. Y., 1828, | 176, 208, 209, 494, 638. |
| Clirhugh, Barry *v.* | 12 Law Rep., 367, | " 1849. | |
| Clum *v.* Brewer, | 11 Mo. L. Rep., 390, | Mass., 1856, | 127, 266. |
| " " | 2 Curt., 506, | " 1855, | 164, 192, 321, 325, 327, 385, 393, 400, 406, 454, 463. |
| Coates *v.* Holbrook, | 2 Sand. Ch., 586, | N. Y., 1845, | 100, 115, 129, 374, 410. |
| Cobb & Hermance, Buck *v.* | 9 Law Rep., 545, | " 1846. | |
| " Woodruff *v.* | MS. (App. Cas.), | D. C., 1860. | |
| Cochrane *v.* Waterman, | " " | " 1844, | 138, 177, 275, 291, 293, 305, 420, 488. |
| Coffeen *v.* Brunton, | 4 McLean, 516, | Ind., 1849, | 129, 176, 210, 273, 375, 411, 416, 481, 500, 639, 684. |
| Cole, Ex parte, | MS. (App. Cas.), | D. C., 1857, | 434. |
| Coleman *v.* Liesor, | MS., | Ohio, 1859, | 240, 246, 281, 311, 345, 357, 370, 435, 516, 602, 609. |
| Collier, Carey *v.* | 56 Niles' Reg., 262, | N. Y., 1839. | |
| Collins, Jolliffe *v.* | 21 Mo., 338, | Mo., 1855. | |
| " Serrell *v.* | 4 Blatchf., 61, | N. Y., 1857. | |
| " " | " | " 1858. | |
| " *v.* White, | MS. (App. Cas.), | D. C., 1860, | 178, 290, 621. |
| Colt *v.* Young, | 2 Blatchf., 471, | N. Y., 1852, | 192, 321, 392, 675. |
| " Young *v.* | 2 " 373, | " 1852. | |
| Comstock *v.* Moore, | 18 How. Pr., 421, | " 1860, | 414, 482. |
| " Phelps *v.* | 4 McLean, 353, | Ind., 1848. | |
| Combstock, Phillips *v.* | 4 " 525, | " 1849. | |
| Com. Ins. Co. *v* Sennett, | 37 Penn., 205, | Pa., 1860, | 580. |
| Cong. Rub. Co. *v.* Amer. Elas. Cloth Co., | MS., | " 1857, | 386, 515. |
| Connison, Pomeroy *v.* | MS. (App. Cas.), | D. C., 1842. | |
| Cook, Eames *v.* | 2 Fisher, 146, | Mass., 1860. | |
| " Forbush *v.* | 10 Law Rep., 664, | " 1857. | |
| " Geiger *v.* | 3 W. & Serg., 266, | Pa., 1842. | |
| " Gibson *v.* | 2 Blatchf., 144, | N. Y., 1850. | |
| " Woodworth *v.* | 2 Blatchf., 151, | " 1850. | |
| Cooper *v.* Gunn, | 4 B. Mon., 594, | Ky., 1844, | 170, 174, 313. |
| " Isaacs *v.* | 4 Wash., 259, | Pa., 1821. | |
| " *v.* Matthews, | 8 Law Rep., 413, | Pa., 1842, | 271, 282, 381, 382, 389, 399, 401, 486. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Cooper, Shaw *v.* | 7 Pet., 292, | Sup. Ct., 1833. | |
| Cope, Judson *v.* | 1 Fisher, 615, | Ohio, 1860. | |
| Corbin & Martlett, Ex parte, | MS. (App. Cas.), | D. C., 1857, | 195, 435. |
| " Parker *v.* | 4 McLean, 462, | Ohio, 1848. | |
| Cornell, Gay *v.* | 1 Blatchf., 506, | N. Y., 1849. | |
| " *v.* Hyatt, | MS. (App. Cas.), | D. C., 1856, | 297. |
| " Perry *v.* | " " " | " 1847. | |
| Corning, Burden *v.* | MS., | N. Y., 1850. | |
| " *v.* " | 15 How., 252, | Sup. Ct., 1853, | 155, 245, 253, 260, 306, 309, 317, 351, 472, 484, 512, 514, 561, 650, 682. |
| " Troy Iron & Nail Fac. *v.* | 1 Blatchf., 467, | N. Y., 1849. | |
| " " " " " *v.* | 14 How., 193, | Sup. Ct., 1852. | |
| " *v.* " " " " *v.* | 15 " 451, | " 1853, | 134. |
| Corwin *v.* Daly, | { Upton's Trade-Mks., 187, | } N. Y., 1860, | 98, 274, 686, 691. |
| Cowperthwaite, Burr *v.* | 4 Blatchf., 163, | Ct., 1858. | |
| " *v.* Gill, | MS. (App. Cas.), | D. C., 1859, | 607. |
| Coxe, Ewer *v.* | 4 Wash., 487, | Pa., 1824. | |
| Crawley, Walton *v.* | 3 Blatchf., 440, | N. Y., 1856. | |
| Crehore *v.* Norton, | MS., | " 1853, | 276, 356, 363. |
| Cressler *v.* Custer, | " (App. Cas.), | D. C., 1853, | 297. |
| Crittenden, Bartlette *v.* | 4 McLean, 300, | Ohio, 1847. | |
| " " | 5 " 32, | " 1849. | |
| Crooker, Ex parte, | MS. (App. Cas.), | D. C., 1850, | 142, 143, 496, 659. |
| Cross *v.* Huntley, | 13 Wend., 385, | N. Y., 1835, | 201, 527. |
| Culver *v.* Webb, | 12 Conn., 441, | Ct., 1838, | 121, 339. |
| Cundell *v.* Parkhurst, | MS. (App. Cas.), | D. C., 1847, | 137, 305. |
| Cunningham, Drake *v.* | " " " | " 1855. | |
| Curtis, Holden *v.* | 2 N. Hamp., 61, | N. H., 1819. | |
| " Woodworth *v.* | 2 Wood. & Min., 524, | Mass., 1847. | |
| " " | 1 Blatchf., 529, | " 1850. | |
| Curtius, Wilson *v.* | 2 W. L. Jour., 511, | La., 1845. | |
| Cushman, S. D., Ex parte, | MS. (App. Cas.), | D. C., 1858, | 435. |
| " W. M. C. " | " " " | " 1858, | 506, 615. |
| Custer, Cressler *v.* | " " " | " 1853. | |
| Cutter, Reed *v.* | 1 Story, 590, | Mass., 1841. | |
| " Whittemore *v.* | 1 Gall., 429, 478, | " 1813. | |
| Cutting *v.* Meyers, | 4 Wash., 220, | Pa., 1818, | 586, 589. |

## D.

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| Daboll's Case, | 1 Opin., 532, | 1822, | 212, 639. |
| Dale *v.* Smithson, | 12 Abb. Pr., 237, | N. Y., 1861, | 117, 417, 687. |
| Daly, Corwin *v.* | { Upton's Trade-Mks., 187, | } " 1860. | |
| Danforth, Winans *v.* | MS., | " 1860. | |
| Daniels, Bell *v.* | 1 Fisher, 372, | Ohio, 1858. | |
| Darst *v.* Brockway, | 11 Ohio, 462, | " 1842, | 202, 694. |
| Davidson, Garrett *v.* | MS. (App. Cas.), | D. C., 1857. | |
| Davidson *v.* Lewis, | " " " | " 1858, | 450. |
| Davies, Emerson *v.* | 3 Story, 768, | Mass., 1845. | |
| Davis, Ex parte, | MS. (App. Cas.), | D. C., 1859, | 635. |
| " *v.* Bell, | 8 N. Hamp., 500, | N. H., 1837, | 201. |
| " *v.* Kendall, | 2 R. I., 566. | R. I., 1853, | 375, 416, 481, 684, 688. |
| " *v.* McCormick, | 2 Brock., 298, | Va., 1827. | |
| " *v.* Palmer, | " " | " " | 334, 336, 353, 365, 455, 517, 519, 526, 560, 651. |
| " Stearnes *v.* | MS. (App. Cas.), | D. C., 1859, | |
| Davoll *v.* Brown, | 1 Wood. & Min., 53, | Mass., 1845, | 308, 432, 491, 510, 517, 538, 634, 648. |
| " *v.* " | 3 W. L. Jour., 151, | " " | 182. |
| Dawson *v.* Follen, | 2 Wash., 311, | Pa., 1808, | 595. |
| Day *v.* Bost. Belt. Co., | 6 Mo. L. Rep., 330, | Mass., 1853, | 385, 400. |
| " *v.* " " " | MS., | N. Y., 1854, | 299. |
| " *v.* Cary, | 4 Blatchf., 271, | " 1859, | 127, 164, 549. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Day, Goodyear *v.* | 1 Blatchf., 565, | N. Y., 1850. | |
| " " *v.* | MS., | N. J., 1852. | |
| " " *v.* | " | " 1852. | |
| " " *v.* | 2 Wall, Jr., 282, | " 1852. | |
| " " *v.* | MS., | N. Y., 1858. | |
| " *v.* " | " | N. J., 1850, | 192, 265, 548, 617. |
| " & Cong. Rub. Co., Goodyear *v.* | 3 Blatchf., 449, | N. Y., 1856. | |
| Day *v.* Hartshorn, | MS., | R. I., 1853, | 397. |
| " *v.* " | " | " 1854, | 126, 463, 589. |
| " *v.* " | " | " 1855, | 332, 394, 468. |
| " Hartshorn *v.* | 19 How., 211, | Sup. Ct., 1856. | |
| " *v.* Hayward, | 20 " 208, | " 1857. | |
| " Judson *v.* | MS., | N. Y.. 1851. | |
| " *v.* Lyons, | " | La., 1860, | 549. |
| " *v.* N. E. Car-Spring Co., | 3 Blatchf., 154, 179, | N. Y., 1854, | 347, 401. |
| " *v.* Newark I. R. Co., | 1 Blatchf., 628, | " 1850, | 109, 110, 132, 171, 216, 225. |
| " *v.* Stillman, | 1 Fisher, 487, | Md., 1859, | 127, 318, 549. |
| " Suydam *v.* | 2 Blatchf., 20, | N. Y., 1846. | |
| " *v.* Union Rub. Co., | 3 Blatchf., 488, | " 1856, | 325, 486, 548, 579, 648, 668. |
| " *v.* " " " | 20 How., 216, | Sup. Ct., 1857, | 549. |
| Dean *v.* Mason, | 20 " 198, | " 1857, | 134, 239, 268, 272. |
| Dederick, Ex parte, | MS. (App. Cas.), | D. C., 1860. | 153. |
| Degener, Babcock *v.* | " " " | " 1859. | |
| Degroot, Langdon *v.* | 1 Paine, 203, | N. Y., 1822. | |
| Delano *v.* Scott, | Gilpin, 489, | Pa., 1834, | 113, 119, 207, 228, 243, 294, 296, 334, 361, 653, 654. |
| Denis *v.* Le Clerc, | 1 Martin, 297. | La., 1811, | 457. |
| Denmead, Winans *v.*, | 15 How., 330, | Sup. Ct., 1853. | |
| Derby, Pulte *v.* | 5 McLean, 328, | Ohio, 1852. | |
| " Story *v.* | 4 " 160, | " 1846. | |
| Derringer, Pettibone *v.* | 4 Wash, 215, | Pa., 1818. | |
| Detmold's Case, | 4 Opin., 335, | 1844, | 505, 671. |
| " *v.* Reeves, | 4 Amer. L. J., 188, | Pa., 1851, | 253, 500. |
| Deval, Tyler *v.* | 1 Code Rep., 30, | La., 1848. | |
| Dewey, Alden *v.* | 1 Story, 336, | Mass., 1840. | |
| De Witt *v.* Brooks, | MS., | N. Y., 1861, | 174, 642. |
| De Young. Keplinger *v.* | 10 Wheat., 358, | Sup. Ct., 1825. | |
| Dialogue, Pennock *v.* | 4 Wash., 538, | Pa., 1825. | |
| " " *v.* | 2 Pet., 1, | Sup. Ct., 1829. | |
| Dickinson *v.* Hall, | 14 Pick., 217, | Mass., 1833, | 200, 431. |
| Dietz, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 620. |
| " *v.* Burnham, | " " | " 1859, | 429, 451. |
| Dixon, Ex parte, | " " | " 1860, | 155, 423. |
| " *v.* Moyer, | 4 Wash., 68, | Pa., 1821, | 303, 316, 333, 338, 343, 353, 562, 596, 631. |
| Dobson *v.* Campbell, | 1 Sumn., 319. | Me., 1833, | 590. |
| Dodge *v.* Card, | 2 Fisher, 116, | Ohio, 1860, | 190, 387. |
| Dorr, Bryce *v.* | 3 McLean, 582, | Mich., 1845. | |
| Dougherty *v.* Van Nostrand, | 1 Hoff. Ch., 68. | N. Y., 1839, | 348. |
| Douglass *v.* Blakinton, | MS. (App. Cas.), | D. C., 1859, | 142. |
| Downing, Smith *v.* | 1 Fisher, 64, | Mass., 1850. | |
| Drake *v.* Cunningham, | MS. (App. Cas.), | D. C., 1855, | 135. |
| Duchesne, Brown *v.* | 2 Curt., 97, | Mass., 1854. | |
| " " *v.* | 2 " 371, | " 1855. | |
| " " *v.* | 19 How., 183, | Sup. Ct., 1856. | |
| Dudley *v.* Mayhew, | 3 Coms., 9, | N. Y., 1849, | 109, 208, 225, 229, 380, 500. |
| Dunbar, Goodyear *v.* | 1 Fisher, 472. | N. J., 1861. | |
| " *v.* Marden, | 13 N. Hamp., 311, | N. H., 1842, | 202, 432. |
| Dunklee, Hill *v.* | MS. (App. Cas.), | D. C., 1857. | |
| Dupont's Case, | 1 Opin., 332, | 1820, | 128, 655. |
| Dutcher, Loveridge *v.* | MS. (App. Cas.), | D. C., 1861, | |
| Dyer *v.* Rich, | 1 Metc., 180, | Mass., 1840, | 496. |
| Dyson, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 620, 621, 628, 660, 663, 674. |
| " *v.* Gambrill, | " " | " 1861, | 141, 622. |
| Dwight *v.* Appleton, | 1 N. Y. L. Obs., 195, | N. Y., 1843, | 213, 583, 639, 643, 644. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.

## E.


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|---|---|---|---|
| Eagle Screw Co., Pierson *v.* | 3 Story, 402, | R. I., 1844. | |
| Eames *v.* Cook, | 2 Fisher, 146, | Mass., 1860, | 311, 435, 441, 472. |
| " *v.* Richards, | MS. (App. Cas.), | D. C., 1859, | 140, 289. 298, 419, 427, 451. |
| Earle, Judkins *v.* | 7 Greenl., 9, | Mass., 1830. | |
| " *v.* Page, | 6 N. Hamp., 477 | N. H., 1834, | 201. |
| " *v.* Sawyer, | 4 Mason, 1, | Mass., 1825, | 105, 170, 182, 231, 242, 256, 350, 431, 588, 592, 651, 693 |
| " The Wash. Mac. Co., *v.* | 2 Fisher, 203. | Pa., 1861. | |
| Eaton, Cansler *v.* | 2 Jones Eq., 498, | N. C., 1856. | |
| " Evans *v.* | Pet. C. C., 322, | Pa., 1816. | |
| " " *v.* | 3 Wheat., 454, | Sup. Ct., 1818. | |
| " " *v.* | 3 Wash., 443, | Pa., 1818. | |
| " " *v.* | 7 Wheat., 356, | Sup. Ct., 1822. | |
| Eddy, Byam *v.* | 2 Blatchf., 521, | Vt., 1853. | |
| Edmunds *v.* Hildreth, | 16 Ill., 215, | Ill., 1854, | 340. |
| " *v.* Meyers, | 16 " 207, | " 1854, | 204, 340. |
| Edwards, Adams *v.* | MS., | Mass., 1848. | |
| " *v.* Richards, | Wright, 596, | Ohio, 1834, | 121, 201. |
| " Woodworth *v.* | 3 Wood. & Min., 120, | Mass., 1847. | |
| Ege, Ogle *v.* | 4 Wash., 584, | Pa., 1826. | |
| Eldridge, Blanchard *v.* | 1 Wall., Jr, 337, | " 1849. | |
| Ellithorpe, Gibbs *v.* | MS. (App. Cas.), | D. C., 1859. | |
| " *v.* Robertson, | " " | " 1858, | 98, 146, 148, 469, 608, 629, 673 |
| " *v.* " | 4 Blatchf., 307, | N. Y., 1859, | 315, 428, 601. |
| Elmer *v.* Pennel, | 40 Maine, 430, | Me., 1855, | 204, 226, 229. |
| Ellsworth, Prentiss *v.* | Mir. Pat. Off., 35, | Pa., 1846. | |
| Ely, Smith *v.* | 5 McLean, 76, | Ohio, 1849. | |
| " " *v.* | 15 How., 137, | Sup. Ct., 1853. | |
| Emerson *v.* Davies, | 3 Story, 768, | Mass., 1845, | 103, 180, 210, 359, 377, 691. |
| " *v.* Hogg, | 2 Blatchf., 1, | N. Y., 1845, | 131, 175, 207, 257, 294, 301, 365, 492, 502, 504, 517, 527, 633, 652, 658, 668. |
| " " *v.* | 6 How., 437, | Sup. Ct, 1847. | |
| " " *v.* | 11 " 587, | " 1850. | |
| Emery, Ex parte, | MS. (App. Cas.), | D. C., 1859, | 440, 611. |
| Emmett, Whitney *v.* | Bald., 303, | Pa., 1831. | |
| Evans' Case, | 7 Opin., 133, | 1855, | 524. |
| " *v.* Chambers, | 2 Wash., 125, | Pa., 1807, | 504, 525, 649. |
| " *v.* Eaton, | Pet. C. C., 322, | " 1816, | 92, 105, 154, 181, 186, 197, 241, 278, 296, 298, 302, 328, 333, 341, 342, 349, 355, 430, 460, 504, 508, 525, 591, 595, 638, 678. |
| " *v.* " | 3 Wheat., 454, | Sup. Ct., 1818, | 105, 198, 302, 328, 343, 346, 347, 349, 430, 470, 501, 509, 596, 653, 676, 679. |
| " *v.* " | 3 Wash., 443, | Pa., 1818, | 287, 353, 526, 631, 679. |
| " *v.* " | 7 Wheat., 356, | Sup. Ct., 1822, | 130, 175, 286, 296, 350, 353, 526, 632, 679. |
| " *v.* Hettick, | 3 Wash., 408, | Pa., 1818, | 130, 231, 285, 287, 290, 296, 299, 303, 304, 341, 353, 436, 596, 656, 678. |
| " *v.* " | 7 Wheat., 453, | Sup. Ct., 1822, | 286, 296, 299, 341, 343, 679. |
| " *v.* Jordan, | 1 Brock., 248, | Va., 1813, | 113, 327, 441, 498, 653, 656. |
| " *v.* " | 9 Cra., 199, | Sup. Ct., 1815, | 678. |
| " *v.* Kremer, | Pet. C. C., 215, | Pa., 1816, | 342. |
| " *v.* Weiss, | 2 Wash., 342, | " 1809, | 361, 365, 444, 498, 678. |
| Everson & Ricard, Ex parte, | MS. (App. Cas.), | D. C., 1855, | 181, 254, 422. |
| Ewer *v.* Coxe, | 4 Wash., 487, | Pa., 1824, | 212, 377, 639, 640. |
| Eyre *v.* Higbee, | 22 How. Pr., 205, | N. Y., 1861, | 92, 459. |


## F.


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|---|---|---|---|
| Fallis *v.* Griffith, | Wright, 303, | Ohio, 1833, | 201. |
| Farish & Keeler's Case, | 7 Opin., 390, | 1855, | 153. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Farley *v.* N. S. Guage Co., | MS (App. Cas.), | D. C., 1859, | 428. |
| Farr, Byam *v.* | 1 Curt., 260, | Mass., 1852. | |
| Farrington, Peck *v.* | 9 Wend., 44, | N. Y., 1832. | |
| Felt, Stephens *v.* | 2 Blatchf., 37, | " 1846. | |
| Ferguson, Parker *v.* | 1 " 407, | " 1849. | |
| Ferrett *v.* Atwill, | 1 " 151, | " 1846, | 583, 591, 645. |
| " Atwill *v.* | 2 " 39, | " 1846. | |
| Ferry, Page *v.* | 1 Fisher, 298, | Mich., 1857. | |
| Fetridge *v.* Merchant, | 4 Abb. Pr, 156, | N. Y., 1857, | 413, 685, 690. |
| " *v.* Wells, | 13 How. Pr., 385, | " 1857, | 274, 413, 685, 690. |
| Fiske, Bost. Mfg. Co. *v.* | 2 Mas., 119, | Mass, 1820. | |
| " Brooks *v.* | 1 Fisher, 298, | " 1851. | |
| " " *v.* | 15 How., 212, | Sup. Ct., 1853. | |
| " Moody *v.* | 2 Mas., 112, | Mass., 1820. | |
| Flickenger, Smith *v.* | MS. (App. Cas.), | D. C., 1843. | |
| Fogg, McDougal *v.* | 2 Bosw., 387. | N. Y., 1858. | |
| Follen, Dawson *v.* | 2 Wash., 311, | Pa., 1808. | |
| Folsom *v.* Marsh, | 2 Story, 100, | Mass., 1841, | 99, 103, 358, 458, 627, 643, 644. |
| Foote *v.* Silsby, | 1 Blatchf, 445, | N. Y., 1849, | 184, 234, 248, 335, 344, 425, 489, 494, 495, 520, 570, 592, 611. 670 |
| " *v.* " | 1 " 542, | " 1850, | 132, 134, 175, 666, 696. |
| " *v.* " | 1 " 545, | " 1850, | 272, 330. |
| " *v.* " | 2 " 260, | " 1851, | 184, 259, 309, 332, 490, 570, 593, 699. |
| " *v.* " | 3 Blatchf., 507, | " 1856, | 300. |
| " Silsby *v.* | 14 How., 218, | Sup. Ct., 1852. | |
| " " | 20 How., 290, 378, | " 1857. | |
| Forbes, Walker *v.* | MS. (App. Cas.), | D. C., 1861. | |
| Forbush *v.* Bradford, | 11 Mo. L. Rep., 471, | Mass., 1856, | 385, 394, 397. |
| " *v.* Cook, | 10 " 664, | " 1857, | 185, 277, 423, 450, 478, 601. |
| Foss *v.* Richardson, | 11 " 670, | " 1859, | 206. |
| Foster *v.* Moore, | 1 Curt., 279, | " 1852, | 189, 276, 351, 356, 392, 397. |
| Fowle, Pierpont *v.* | 2 Wood. & Min., 23, | " 1846. | |
| Fox, Treadwell *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Francais, Hobbs *v.* | 19 How. Pr., 567, | N. Y., 1860. | |
| French *v.* Rogers, | 1 Fisher, 133, | Pa., 1851, | 155, 258, 317, 437, 496, 505. 541, 614, 619, 624, 659, 662, 669, 671. |
| Fry & Seeley, Ex parte, | MS. (App. Cas.), | D. C., 1859, | 602. |
| Fultz, Ex parte, | " " | " 1853, | 136, 140, 142, 306, 351, 496, 514, 660, 674. |


## G.


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|---|---|---|---|
| Garr, Moffitt *v.* | 1 Fisher, 610, | Ohio, 1860. | |
| Gale's Case, | 3 Opin., 594, | 1840, | 320. |
| Gamble, Spain *v.* | MS. (App. Cas.), | D. C., 1855. | |
| Gambril, Carroll *v.* | " " | " 1853. | |
| " Dyson *v.* | " " | " 1861. | |
| Ganson, Chamberlain *v.* | 2 Blatchf., 279, | N. Y., 1851. | |
| Garelly, Booth *v.* | 1 Blatchf., 247, | " 1847. | |
| Garner, Merimack Mfg. Co. *v.* | 4 E. D. Smith, 387, | " 1855. | |
| Garrett *v.* Davidson, | MS. (App. Cas.), | D. C., 1857, | 292. |
| Gatling *v.* Newall, | 9 Ind., 572, | Ind., 1857, | 127, 310, 333, 340, 515. |
| Gauton, Lemoine *v.* | 2 E. D. Smith. 343, | N. Y., 1854. | |
| Gavit, Knight *v.* | Mir. Pat. Off., 94, 131, | Pa., 1846. | |
| Gay *v.* Cornell, | 1 Blatchf., 506, | N. Y., 1849, | 145, 151, 159, 160, 163, 166, 268, 666, 669. |
| Gayler, Wilder *v.* | 1 " 511, | " 1849. | |
| " " | 1 " 597, | " 1850. | |
| " *v.* " | 10 How., 477, | Sup. Ct., 1850, | 107, 112, 155, 156, 158, 160, 163, 175, 179, 462, 598, 599, 601, 661, 664. |
| Gedney, King *v.* | MS. (App. Cas.), | D. C., 1856. | |
| Geiger *v.* Cook, | 3 Watts & Serg., 266, | Pa., 1844, | 202. |
| Gebhard *v.* Bagot, | MS., | N. Y., 1857, | 386, 515. |
| Gibbs *v.* Ellithorpe, | MS. (App. Cas.), | D. C., 1859, | 628. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Gibbs *v.* Johnson, | MS. (App. Cas.), | D. C., 1860, | 292, 298, 429, 451. |
| Gibson *v.* Barnard, | 1 Blatchf., 388, | N. Y., 1848, | 122. |
| " " *v.* | 7 How., 650, | Sup. Ct., 1848. | |
| " *v.* Betts, | 1 Blatchf., 163, | N. Y., 1846, | 400, 558. |
| " *v.* Cook, | 2 " 144, | " 1850, | 158, 163, 166, 244, 283, 324, 329, 384, 661, 667. |
| " *v.* Gifford, | 1 " 529, | " 1850, | 324, 329. 559, 676, 680. |
| " *v.* Harris, | 1 " 167, | " 1846, | 327, 328. 383. 558, 614. |
| " *v.* Richards, | Pat. Dig., No. 376, | " 1845, | 106. 127, 225. |
| " *v.* Van Dressar, | 1 Blatchf., 532, | " 1850, | 394, 396, 559. |
| " *v.* Woodworth, | 8 Paige, 132, | " 1840, | 224, 229, 264. |
| Gifford, Gibson *v.* | 1 Blatchf., 529, | " 1850. | |
| Gill, Buck *v.* | 4 McLean, 174, | Ohio, 1846. | |
| " Cowperthwaite *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Gillott *v.* Kettle, | 3 Duer, 624, | N. Y., 1854, | 273, 376, 411. |
| Gladding, Stevens *v.* | 17 How., 447, | Sup. Ct., 1854. | |
| " " | 2 Curt., 608, | R. I., 1856. | |
| Glou. Mfg. Co., Sickles *v.* | 1 Fisher, 222, | N. J., 1856. | |
| Goddard *v.* Lyman, | 14 Pick., 268, | Mass., 1833, | 201. |
| " Stein *v.* | 1 McAllis., 82, | Cal., 1856. | |
| Goodwin, Ryan *v.* | 3 Sumn., 514, | Mass., 1839. | |
| Goodyear *v.* Bishop, | 4 Blatchf., 438, | N. Y., 1860, | 113, 115. 464. |
| " *v.* Bourne, | 3 " 266, | " 1855, | 268, 404. |
| " *v.* Chaffee, | 3 " 268, | " 1855, | 226, 272. 380. |
| " *v.* Day, | 1 " 565, | " 1850, | 226. |
| " *v.* " | MS., | N. J., 1850, | 235, 339, 342. 468, 589. |
| " *v.* " | 2 Wall, Jr., 283, | " 1852, | 314, 331. 406. 426, 443, 448. |
| " *v.* " | MS., | " 1852, | 95, 112. 151. 168. 245, 266, 272 280, 302. 331, 351. 363, 437, 443 514, 606, 614, 619. 624, 628, 673 |
| " Day *v.* | MS., | N. J., 1850. | |
| Goodyear *v.* Day & Cong. Rub. Co., | 3 Blatchf., 449, | N. Y., 1856, | 465, 468. |
| Goodyear *v.* Dunbar, | 1 Fisher, 472, | N. J., 1861, | 102, 381, 388. 398. |
| " *v.* McBurney, | 3 Blatchf., 32, | N. Y., 1853, | 112, 245. 463. |
| " " *v.* | 11 Cush., 569, | Mass., 1853. | |
| " *v.* Matthews, | 1 Paine, 300, | Ct., 1814, | 355, 525. |
| " and N. E. Car Spg. Co. *v.* Phelps, | 3 Blatchf., 91, | N. Y., 1853, | 114, 119. 216, 385. |
| " *v.* Railroads, | 2 Wall., Jr., 356, | N. J., 1853, | 194, 196. 363. 367, 421, 474. 485, 512, 548, 582. |
| " Warner *v.* | MS. (App. Cas.), | D. C., 1846. | |
| Gorham *v.* Mixter, | 1 Am. L. Jour., 543, | Mass., 1849, | 188, 275, 335. 356. |
| Gould, Backus *v.* | 7 How., 798, | Sup. Ct., 1848. | |
| " *v.* Banks, | 8 Wend., 562, | N. Y., 1832, | 120, 161, 645. |
| " Little *v.* | 2 Blatchf., 165, | " 1851. | |
| " " *v.* | 2 " 362, | " 1852. | |
| " Washburn *v.* | 3 Story, 122, | Mass., 1844. | |
| Goulding's Case, | 2 Opin., 572, | 1833, | 612. |
| Goulard, Wolfe *v.* | 18 How. Pr., 64, | N. Y., 1859. | |
| Grant, Kernodle *v.* | 4 Blackf., 57, | Ind., 1835. | |
| " *v.* Mason, | 1 L. Int. & Rev., 22, | N. Y., 1828, | 256, 486, 612. |
| " *v.* Raymond, | 6 Pet., 218, | Sup Ct., 1832, | 150, 191. 242. 302, 339, 343, 346, 347, 482, 588, 612, 622, 647, 650, 654. |
| Gray *v.* James, | Pet., C. C., 394, | Pa., 1817, | 95, 155, 186. 231. 302, 338, 341, 342, 355, 436, 519, 556, 631, 636, 656. |
| " *v.* " | " " 476, | " 1817, | 430, 585. 589, 590. |
| " *v.* Russell, | 1 Story, 11, | Mass., 1839, | 98, 103, 209, 357, 358, 626, 643. |
| Green, Hazard *v.* | MS. (App. Cas.), | D. C., 1847. | |
| " Wright *v.* | " " | " 1854. | |
| Greenough *v.* Clark, | " " | " 1853, | 135, 137, 139, 673. |
| " Sturtevant *v.* | " " | " 1860. | |
| Greenwood, Hotchkiss *v.* | 4 McLean, 456, | Ohio, 1848. | |
| " " *v.* | 11 How., 248, | Sup. Ct., 1850. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Gregory, Burr *v.* | 2 Paine, 426, | N. Y., 1828. | |
| Griffith, Fallis *v.* | Wright, 303, | Ohio, 1833. | |
| Grover & Baker Sew. Mach. Co. *v.* Sloat, | 2 Fisher, 112, | N. Y., 1860, | 568. |
| Guild, Sawin *v.* | 1 Gall., 485, | Mass., 1813. | |
| Gunn, Cooper *v.* | 4 B. Mon., 594, | Ky., 1844. | |
| Guyon *v.* Serrell, | 1 Blatchf., 244, | N. Y., 1847, | 219, 233, 250, 656, 664. |

**H.**

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| Haight, Thompson *v.* | 1 U. S. L. Jo.. 85, 563, | N. Y., 1822. | |
| Haines, Rugg *v.* | MS. (App. Cas.), | D. C., 1855. | |
| Hall, Barrett *v.* | 1 Mas., 447, | Mass., 1818. | |
| " Dickinson *v.* | 14 Pick., 217, | " 1833. | |
| " Pitts *v.* | 2 Blatchf. 229, | N. Y., 1851. | |
| " " *v.* | 3 Blatchf., 201, | " 1854, | |
| " *v.* Wiles, | 2 " 194, | " 1851, | 184, 219, 235, 249, 250, 259, 335, 350, 671. |
| " Woodworth *v.* | 1 W. & M., 248, 389, | Mass., 1846. | |
| Hanlenbeck, Armstrong *v.* | 3 N. Y. L. Obs., 43, | N. Y., 1844. | |
| Hallock, Parker *v.* | MS., | Pa., 1858. | |
| Hardesty *v.* Smith, | 3 Ind., 39, | Ind., 1851, | 203. |
| Harmon *v.* Bird, | 22 Wend., 113, | N. Y., 1839, | 167, 202, 263, 354. |
| Harper, Monk *v.* | 3 Edw. Ch.. 109, | " 1837. | |
| Harris, Gibson *v.* | 1 Blatchf., 167, | " 1846, | |
| " Nichols *v.* | MS. (App. Cas.), | D. C., 1854. | |
| Hartshorn *v.* Day, | 19 How., 211, | Sup. Ct., 1856, | 126, 169, 326, 549. |
| Hatfield, Parker *v.* | 4 McLean, 61, | Ohio, 1845. | |
| Hathaway *v.* Roach, | 2 W. & M., 63, | Mass., 1846, | 218, 487. |
| Haussknecht *v.* Claypool | 1 Black, 431, | Sup. Ct., 1861, | 300. |
| Hawes, O'Hara *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Hawkins, Olcott *v.* | 2 A. L. Jour., 319, | Wis., 1849. | |
| Hawley *v.* Bagley, | MS., | N. Y., 1855, | 584, 588, 675 |
| Haworth, Parker *v.* | 4 McLean, 370, | Ill., 1848. | |
| Hayden, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 154, 249, 311, 503, 616, 670. |
| Haynes, Blanchard *v.* | 6 W. L. Jour., 82, | N. H., 1848. | |
| Hays, Bellas *v.* | 5 S. & Rawle, 427, | Pa., 1819. | |
| Hayward, Chaffee *v.* | 20 How., 208, | Sup. Ct., 1857. | |
| " Day *v.* | " " | " 1857. | |
| Hazard *v.* Green, | MS. (App. Cas.), | D. C., 1847, | 489, 611. |
| Head, Stevens *v.* | 9 Verm., 174, | Vt., 1837. | |
| " *v.* " | 19 Wend., 411, | N. Y., 1838, | 202, 527. |
| Heath, Hildreath *v.* | MS. (App. Cas.), | D. C., 1841. | |
| " *v.* Wright, | 3 Wall., Jr., | Pa., 1861, | 275, 482. |
| Heilner *v.* Battin, | 27 Penn.. 517, | Pa., 1856, | 204, 280, 457, 619. |
| Heine *v.* Appleton, | 4 Blatchf., 125, | N. Y., 1857, | 91, 211, 214, 379. |
| Heinrich *v.* Luther, | 6 McLean, 345, | Ohio, 1855, | 258, 486, 515, 523, 571, 606. |
| Henriques, Howard *v.* | 3 Sand. S. C., 725, | N. Y., 1851. | |
| Henry, Ex parte, | MS. (App. Cas.), | D. C., 1856, | 137, 138. |
| Henry, Hovey *v.* | 3 W. L. Jour., 153, | Mass., 1845. | |
| Herbert *v.* Adams, | 4 Mason, 15, | " 1825, | 111, 159, 162, 279, 653 |
| Hermance, Buck *v.* | 9 Law Rep., 545, | N. Y., 1846. | |
| " " *v.* | 1 Blatchf., 322, | " 1848. | |
| " " *v.* | 1 " 398, | " 1849. | |
| Herriet, Kingsley *v.* | MS. (App. Cas.), | D. C., 1854. | |
| Herring *v.* Leffingwell, | " " " | " 1861, | 281, 292, 307. |
| Hettick, Evans *v.* | 3 Wash., 408, | Pa., 1818. | |
| " " *v.* | 7 Wheat, 453, | Sup. Ct., 1822. | |
| Hiatt *v.* Twomey, | 1 Dev. & Bat. Eq., 315, | N. Car., 1836, | 201, 694. |
| Hibbard, Ex parte, | MS. (App. Cas.), | D. C., 1857, | 277, 352. |
| Hicks, Richardson *v.* | MS. (App. Cas.), | D. C., 1854. | |
| " *v.* Shaver, | " " " | " 1861, | 418, 429, 452. |
| " Williams *v.* | 2 Verm., 36, | Vt., 1829. | |
| Higbee, Eyre *v.* | 22 How. Pr., 205, | N. Y., 1861. | |
| Higgins, Smith *v.* | MS., | " 1856. | |
| " " *v.* | " | " 1857. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Higgins, Smith *v.* | 1 Fisher, 537 | N. Y., 1859. | |
| " " *v.* | 2 " 97, | " 1860. | |
| " Sparkman *v.* | 1 Blatchf., 205, | " 1846. | |
| " " *v.* | 2 " 29, | " 1846. | |
| " *v.* Strong, | 4 Blackf., 182, | Ind., 1836, | 164, 201, 652. |
| Hildreath, Edmunds *v.* | 16 Ill., 215, | Ill., 1854. | |
| " *v.* Heath, | MS. (App. Cas.), | D. C., 1841, | 96, 97, 128, 144, 150, 177, 243, 424, 446, 455, 469, 605, 628, 659, 661, 665, 672, 683. |
| " *v.* Turner, | 17 Ill., 184, | Ill., 1855, | 166, 204. |
| Hill, Bell *v.* | MS. (App. Cas.), | D. C., 1854. | |
| " *v.* Dunklee, | " " " | " 1857, | 298, 299, 450. |
| " *v.* Thuermer, | 13 Ind., 351, | Ind., 1859, | 169. |
| Hite, McKernan *v.* | 6 Ind., 428, | " 1855. | |
| Hobbs *v.* Francais, | 19 How. Pr., 567, | N. Y., 1860, | 274, 414, 691. |
| Hogg, Emerson *v.* | 2 Blatchf., 1, | " 1845. | |
| " *v.* Emerson, | 6 How., 437, | Sup. Ct., 1847, | 132, 133, 257, 487, 496, 503, 504, 511, 518, 651, 658, 666, 696. |
| " *v.* " | 11 How., 587, | Sup. Ct., 1850, | 235, 257, 416, 494, 503, 504, 512, 634, 652, 668. |
| Holbrook, Coates *v.* | 2 Sand. Ch., 586, | N. Y., 1845. | |
| Holcombe, Story *v.* | 4 McLean, 306, | Ohio, 1847. | |
| Holden *v.* Curtis, | 2 N. Hamp., 61, | N. H., 1819, | 164, 167, 199, 591, 652 |
| Holland, Potter *v.* | 4 Blatchf., 206, 238. | Ct., 1858. | |
| Holliday, Rheem *v.* | 16 Penn., 347, | Pa., 1851. | |
| " *v.* Rheem, | 18 " 465, | " 1852, | 132, 500, 523, 529. |
| Holzalb, Brunswick *v.* | MS., | Ohio, 1858. | |
| Hopkins *v.* Barnum, | MS. (App. Cas.), | D. C. 1854, | 135. |
| Hopkins *v.* Lewis, | MS. (App. Cas.), | D. C., 1859, | 136. |
| Hotchkiss *v.* Greenwood, | 4 McLean, 456, | Ohio, 1848, | 194, 453, 478, 479, 489, 514. |
| " *v.* " | 11 How., 248, | Sup. Ct., 1850, | 254, 474, 478, 489. |
| " *v.* Oliver, | 5 Denio, 314, | N. Y., 1848, | 122, 250, 302, 339, 528. |
| " Rich *v.* | 16 Conn., 409, | Ct., 1844. | |
| Hovey *v.* Henry, | 3 W. L. Jour., 153, | Mass., 1845, | 183, 282, 301, 432, 488, 571, 605, 672. |
| " *v.* Stevens, | 1 Wood. & Min., 290, | " 1846, | 131, 183, 291, 334, 362, 390, 399, 402, 432, 511, 521, 528, 613. |
| " *v.* " | 3 Wood. & Min., 17, | " 1846, | 218, 131, 354, 473, 522, 544, 633, 682. |
| Howard, Ames *v.* | 1 Sumn., 482, | " 1833. | |
| " *v.* Henriques, | 3 Sand. S. C., 725, | N. Y., 1851, | 689. |
| Howe *v.* Abbott, | 2 Story, 199, | Mass., 1842, | 187, 254, 361, 484, 488, 556. |
| " Hunt *v.* | MS. (App. Cas.), | D. C., 1855. | |
| " *v.* Morton, | 13 Mo. L. Rep., 70, | Mass., 1860, | 186, 333, 357, 370, 564, 666. |
| " *v.* Searing, | 19 How. Pr., 14, | N. Y., 1860, | 98, 348, 415, 691. |
| " *v.* Underwood, | 1 Fisher, 160, | Mass., 1854, | 314, 427, 434, 600. |
| Hoyt, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 311, 441, 611. |
| " *v.* McKenzie, | 3 Barb. Ch., 320, | N. Y., 1848, | 104, 221, 262, 458, 476. |
| " Stephenson *v.* | MS. (App. Cas.), | D. C., 1854. | |
| Hudson *v.* Patten, | 1 Root, 133, | Ct., 1789, | 357. |
| " Sadlier *v.* | 2 Curt., 6, | Me., 1854. | |
| Hulme, Parker *v.* | 7 W. L. Jour., 417, | Pa., 1849. | |
| Humphrey, Peterson *v.* | 4 Abb. Pr., 394, | N. Y., 1857. | |
| " Wintermute *v.* | 10 W. L. Jour., 52, | Ohio, 1851. | |
| Hunt, Bedford *v.* | 1 Mason, 302, | Mass., 1817. | |
| " *v.* Howe, | MS. (App. Cas.), | D. C., 1855, | 97, 145, 152, 606, 608. |
| Hunter, Allen *v.* | 6 McLean, 303, | Ohio, 1855. | |
| " Young *v.* | 2 Seld., 203, | N. Y., 1852. | |
| Huntington, Morris *v.* | 1 Paine, 348, | " 1824. | |
| " Rudderow *v.* | 3 Sand., S. C., 252, | " 1849. | |
| " Teese *v.* | 23 How., 2, | Sup. Ct., 1859. | |
| Huntley, Cross *v.* | 13 Wend., 385, | N. Y.,1835. | |
| Hussey *v.* McCormick, | 1 Fisher, 509, | Ill., 1859, | 284, 546, 620. |
| " *v.* Whiteley, | 2 " 120, | Ohio, 1861, | 113, 169, 404, 464. |
| Hutchinson *v.* Meyers, | MS. (App. Cas.), | D. C., 1861, | 278. |
| " Whipple *v.* | 1 Blatchf., 190, | N. Y., 1858. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Hyatt, Cornell *v.* | MS. (App. Cas.), | D. C., 1856. | |
| Hyde, Carver *v.* | 16 Pet., 513, | Sup. Ct., 1842. | |
| " Tyler *v.* | 2 Blatchf., 308, | N. Y., 1851. | |

**I.**

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|---|---|---|---|
| Imlay *v.* Nor. & Wor. R. R., | 4 Blatchf., 227, | Ct., 1858, | 102, 369, 387, 440, 513, 534 |
| Isaacs *v.* Cooper, | 4 Wash., 259, | Pa., 1821, | 267, 388, 398, 575. |

**J.**

| | | | |
|---|---|---|---|
| Jackson, Ex parte, | MS. (App. Cas.), | D. C., 1856, | 143. |
| Jacobs, Ex parte, | " " | " 1859, | 261. |
| " Blan. Gun-Stk. Fac. *v.* | 2 Blatchf., 69, | N. Y., 1847. | |
| Jacques, Jollie *v.* | 1 " 618, | " 1850. | |
| Jagger, Many *v.* | 1 " 372, | " 1848. | |
| James, Gray *v.* | Pet. C. C., 394, | Pa., 1817. | |
| " " *v.* | " 476, | " 1817. | |
| " Laidley *v.* | MS. (App. Cas.), | D. C., 1860. | |
| Jameson, Pitts *v.* | 15 Barb. S. C., 310, | N. Y., 1853. | |
| Janney, Ex parte, | MS. (App. Cas.), | D. C., 1847, | 135, 469, 660. |
| Jeffrey, McClure *v.* | 8 Ind., 79, | Ind., 1856. | |
| Jerome, McCormick *v.* | 3 Blatchf., 486, | N. Y., 1856. | |
| Jewett & Root, Ex parte, | MS. (App. Cas.), | D. C., 1853, | 140, 152. |
| Jewett, Burrall *v.* | 2 Paige, 134, | N. Y., 1830. | |
| " Rogers *v.* | 12 Mo. L. Rep., 339, | Mass., 1858. | |
| Jillson *v.* Winsor, | MS. (App. Cas.), | D. C., 1850, | 294, 305. |
| Johnson, Gibbs *v.* | " " | " 1860. | |
| " Nevins *v.* | 3 Blatchf., 80, | N. Y., 1853. | |
| " *v.* Root, | 1 Fisher, 351, | Mass., 1858, | 178, 278, 283, 304, 319, 369, 428, 451, 516, 519, 524, 564. |
| " Smith *v.* | 4 Blatchf., 252, | N. Y., 1858. | |
| " Turner *v.* | 2 Cra. C. C., 287, | D. C., 1822. | |
| " Williams *v.* | 2 Bosw., 1. | N. Y., 1857. | |
| Jollie *v.* Jacques, | 1 Blatchf., 618, | " 1850, | 104, 213, 221, 262. 487, 643. |
| Jolliffe *v.* Collins, | 21 Mo., 338, | Mo., 1855, | 168, 204, 695. |
| Jones, Adams *v.* | 1 Fisher, 527, | Pa., 1859. | |
| " Justice *v.* | MS. (App. Cas.), | D. C., 1859. | |
| " Livingston *v.* | 2 Fisher, 207, | Pa., 1861. | |
| " Merryfield *v.* | 2 Curt., 306, | Mass., 1855. | |
| " North *v.* | 4 Blatchf., 70, | N. Y., 1857. | |
| " *v.* Thorne, | 1 N. Y. L. Obs., 408, | " 1843, | 255, 476, 645. |
| " *v.* Wetherell, | MS. (App. Cas.), | D. C., 1855, | 177, 294, 306, 486. |
| " Wickershaff *v.* | 2 Whar. Dig., 413, | Pa., 1848. | |
| " Wilson *v.* | 3 Blatchf., 227, | N. Y., 1854. | |
| Jordan, Evans *v.* | 1 Brock., 248, | Va., 1813. | |
| " " *v.* | 9 Cra., 199, | Sup. Ct., 1815. | |
| " *v.* Overseers of Poor, | 4 Ohio, 294, | Ohio, 1831, | 481, 499. |
| Judd, Woolsey *v.* | 4 Duer, 379, | N. Y., 1855. | |
| Judkins *v.* Earle, | 7 Greenl., 9. | Me., 1830, | 200. |
| Judson *v.* Cope, | 1 Fisher, 615, | Ohio, 1860, | 283, 284, 287, 304, 307, 311, 346, 364, 441, 457, 472, 572, 603, 609, 636. |
| " *v.* Day, | MS., | N. Y., 1851. | |
| " *v.* Moore, | 1 Fisher. 544, | Ohio, 1860, | 258, 315, 440, 451, 480, 490, 513, 516, 521, 571, 611, 636, 681. |
| " & Goodyear *v.* Un. Rubber Co., | 4 Blatchf., 63, | N. Y., 1857, | 227, 369, 373. |
| Justice *v.* Jones, | MS. (App. Cas.), | D. C., 1859, | 136, 146. |

**K.**

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| Kanowrs, Reutgen *v.* | 1 Wash., 168, | Pa., 1804. | |
| Keene *v.* Wheatley, | 9 Am. L. Reg., 33, | " 1860, | 100, 104, 117, 156, 162, 174, 177, 209, 212, 214, 222, 255, 256, 263, 360, 477, 609, 610, 627, 641, 642, 645, 646, 692. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Kelly, Lippincott *v.* | 1 W. L. Jour., 513, | Pa, 1844. | |
| Kelsey, Lillie *v.* | MS. (App. Cas.), | D. C., 1858. | |
| Kemper, Ex parte, | " " | " 1841, | 137, 138, 150, 253, 259, 432, 510, 610. |
| Kendall, Davis *v.* | 2 R. I., 566, | R. I., 1853. | |
| " *v.* Winsor, | 21 How., 322, | Sup. Ct., 1858, | 95, 97, 146, 457, 501, 629, 649. |
| Keplinger *v.* De Young, | 10 Wheat., 358, | " 1825, | 113, 370, 580. |
| Kernodle *v.* Grant, | 4 Blackf., 57, | Ind., 1835, | 201. |
| Ketchum, McCormick *v.* | MS. (App. Cas.), | D. C., 1853. | |
| Kettle, Gillott *v.* | 3 Duer, 624, | N. Y., 1854. | |
| Kidd *v.* Spence, | MS., | " 1859, | 373. |
| King, Ames *v.* | 2 Gray, 379, | Mass., 1854. | |
| " *v.* Gedney, | MS. (App. Cas.), | D. C., 1856, | 418, 444, 480, 496. |
| " *v.* U. States, | 10 Mo. L. Rep., 631, | Ct. Clms., 1857, | 281, 530 693. |
| Kingsland, McClurg *v.* | 1 How., 202, | Sup. Ct., 1843. | |
| Kingsley *v.* Herriet, | MS. (App. Cas.), | D. C., 1854, | 135. |
| Kinsman, Parkhurst *v.* | 2 Halst. Ch., 600, | N. J., 1847. | |
| " " *v.* | 2 Blatchf., 72; 8 N. Y. L. Obs., 75 76, | N. Y., 1848. | |
| " " *v.* | 2 Blatchf., 76, | " 1848. | |
| " " *v.* | 2 " 78, | " 1848. | |
| " " *v.* | 1 Blatchf., 488; 8 N. Y. L. Obs., 146, | " 1849. | |
| " *v.* " | 18 How., 289, | Sup. Ct., 1855, | 101, 126, 158, 176, 222, 280, 497, 626. |
| Kittle *v.* Merriam, | 2 Curt., 475, | Mass., 1855, | 185, 483, 500, 523, 663. |
| Kneass *v.* Schuylkill Bank, | 4 Wash., 9, | Pa., 1820, | 155, 215, 231, 259, 341, 430, 482, 504, 532, 649. |
| " *v.* " | 4 " 106, | " 1821, | 217. |
| Knight *v.* Gavit, | Mir. Pat. Off., 94, 131, | " 1846, | 114, 233, 257, 366, 371, 421, 504, 556. |
| Kremer, Evans *v.* | Pet. C. C., 215, | " 1816. | |


## L.


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| Ladd. Chandler *v.* | MS. (App. Cas.), | D. C., 1857. | |
| Laidley *v.* James, | " " " | " 1860, | 95, 141, 143, 419, 616. |
| Lamb's Case, | 5 Opin., 725, | 1820, | 169. |
| Landgraff, Stokes *v.* | 17 Barb. S. C., 608, | N. Y., 1853. | |
| Langdon *v.* De Groot, | 1 Paine, 203, | " 1822, | 130, 308, 353, 430, 455, 517, 526, 571, 632. |
| Larned, Sargent *v.* | 2 Curt. 340, | Mass., 1855. | |
| Larowe, Ex parte, | MS. (App Cas.), | D. C., 1860, | 153, 186, 193. |
| Latta *v.* Shawk, | 1 Fisher, 465, | Ohio, 1859, | 190, 283, 318, 345, 347, 440, 472, 513, 516, 569. |
| Latchem, Mulliken *v.* | 7 Blackf., 136, | Ind., 1844. | |
| Leach, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 435. |
| Le Clerc, Dennis *v.* | 1 Mart., 297, | La., 1811. | |
| Lee *v.* Blandy, | 2 Fisher, 89, | Ohio, 1860, | 103, 186, 190, 207, 284, 295, 311, 441, 503, 516, 563, 658. |
| Leffingwell, Herring *v.* | MS. (App. Cas.), | D. C., 1861. | |
| Leiper, Simpson *v.* | 2 Whar. Dig., 414, | Pa., 1848. | |
| Lemoine *v.* Gauton, | 2 E. D. Smith, 343, | N. Y., 1854, | 116, 375, 376, 685. |
| Le Roy, Tatham *v.* | MS., | " 1849, | 553. |
| " " *v.* | 2 Blatchf., 474, | " 1852. | |
| " *v.* Tatham, | 14 How., 156, | Sup. Ct., 1852, | 184, 260, 474, 484, 553, 594. |
| " *v.* " | 22 How., 132, | " 1859, | 186, 472, 553, 595. |
| Lewis, Davidson *v.* | MS. (App. Cas.), | D. C., 1858. | |
| " Hopkins *v.* | " " " | " 1859. | |
| " Lowell *v.* | 1 Mason, 182, | Mass., 1817. | |
| Liesor, Coleman *v.* | MS., | Ohio, 1859. | |
| Lillie *v.* Kelsey, | MS. (App. Cas.), | D. C., 1858, | 419. |
| Linton, Ex parte, | " " " | " 1860, | 137. |
| Lippincott *v.* Kelly, | 1 W. L. Jour., 513, | Pa., 1844. | 248, 633, 669. |
| " Rich *v.* | 2 Fisher, 1, | " 1853. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Little *v.* Gould, | 2 Blatchf., 165, | N. Y., 1851, | 378, 626. |
| " *v.* " | 2 " 362, | " 1852, | 211, 626, 642. |
| " *v.* Hall, | 18 How., 168, | Sup. Ct., 1855, | 378, 477, 645. |
| " Park *v.* | 3 Wash., 196, | Pa., 1813. | |
| Littlefield, Orr *v.* | 1 Wood. & Min., 13, | N. H., 1845. | |
| Livingston, *v.* Jones, | 2 Fisher, 207, | Pa., 1861, | 102, 108, 240, 266, 319, 387. |
| " *v.* Van Ingen, | 1 Paine, 45, | N. Y., 1811, | 223, 263, 379, 655, 656. |
| " *v.* " | 9 John, 507, | " 1812, | 197, 328, 404, 419, 498, 576, 637. |
| " *v.* Woodworth, | 15 How., 546, | Sup. Ct., 1853, | 101, 134, 236, 239, 268, 560. |
| Locke, Bell *v.* | 8 Paige, 75, | N. Y., 1840. | |
| Logan, Sanders *v.* | 2 Fisher, 167, | Pa., 1861. | |
| Loring, Tatham *v.* | 5 N. Y. L. Obs., 207, | Mass., 1845. | |
| Lowber, Tatham *v.* | 2 Blatchf., 49, | " 1847. | |
| " " *v.* | 4 Blatchf., 86, | " 1857. | |
| Louden *v.* Birt, | 4 Ind., 566, | Ind., 1853, | 166. |
| Louth, Savory *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Loveridge *v.* Dutcher, | " " " | " 1861, | 141, 148, 629. |
| Lowell *v.* Lewis, | 1 Mason, 182, | Mass., 1817, | 129, 231, 241, 307, 333, 338, 342, 352, 430, 444, 513, 517, 525, 631, 637, 656, 682. |
| Luther, Hienrich *v.* | 6 McLean, 345, | Ohio, 1855. | |
| Lyman, Goddard *v.* | 14 Pick., 288, | Mass., 1833. | |
| Lyons, Day *v.* | MS., | La., 1859. | |


## M.


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|---|---|---|---|
| McAlpine, Boyd *v.* | 3 McLean, 427, | Ohio, 1844. | |
| McBurney *v.* Goodyear, | 11 Cush., 569, | Mass., 1853, | 125, 327, 463, 624, 625. |
| " Goodyear *v.* | 3 Blatchf., 32, | N. Y., 1853. | |
| McCay *v.* Burr, | 6 Penn., 147, | Pa., 1847, | 94. |
| McClure *v.* Jeffrey, | 8 Ind., 79, | Ind., 1856, | 168, 205, 695. |
| McClurg *v.* Kingsland, | 1 How., 202, | Sup. Ct., 1843, | 155, 198, 460, 510, 605, 648, 657, 672. |
| McCormick, Davis *v.* | 2 Brock., 298, | Va., 1847. | |
| " Hussey *v.* | 1 Fisher, 509, | Ill., 1859. | |
| " *v.* Jerome, | 3 Blatchf., 486, | N. Y., 1856, | 172, 408. |
| " *v.* Ketchum, | MS. (App. Cas.), | D. C., 1853, | 145, 289, 314, 426, 448, 594. |
| " *v.* Manny, | 6 McLean, 539, | Ill., 1855, | 181, 189, 277, 505, 523, 545. |
| " *v.* Seymour, | MS., | N. Y., 1850. | |
| " *v.* " | 2 Blatchf., 240, | " 1851, | 236, 275, 301, 350, 362, 426, 433, 544, 606, 673. |
| " *v.* " | MS., | " 1851, | 301, 314, 426, 443, 472, 544. |
| " *v.* Seymour, | 3 Blatchf., 209, | " 1854, | 237, 250, 251, 351, 545. |
| " Seymour *v.* | 16 How., 480, | Sup. Ct., 1853. | |
| " " *v.* | 19 How., 96, | " 1856. | |
| " *v.* Talcott, | 20 " 402, | " 1857, | 108, 190, 277, 318, 357, 364, 373, 487. |
| " Wilder *v.* | 2 Blatchf., 31, | N. Y., 1846. | |
| McCullogh, Bell *v.* | 1 Fisher, 380, | Ohio, 1858. | |
| McDonald's Case, | 1 Opin., 170, | 1812, | 149. |
| McDougal *v.* Fogg, | 2 Bosw., 387, | N. Y., 1858, | 205. |
| McDowell *v.* Meredith, | 4 Whart., 311, | Pa., 1839, | 202. |
| McElroy, Miller v. | 1 Am. L. Reg., 148, | " 1839. | |
| McFall *v.* Wilson, | 6 Blackf., 260, | Ind., 1842, | 165. |
| McGaw *v.* Bryan, | 1 U. S. L. Jour., 82, 88, 582, | N. Y., 1822, | 228, 654. |
| McKenzie, Hoyt *v.* | 3 Barb. Ch., 320, | " 1848. | |
| McKernan *v.* Hite, | 6 Ind., 428, | Ind., 1855, | 166. |
| McQuewan, Bloomer *v.* | 14 How., 539, | Sup. Ct., 1852. | |
| Mackay, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 186. |
| Mad. Riv. R. R., Simpson *v.* | 6 McLean, 603, | Ohio, 1855. | |
| Mann, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 475, 486. |
| Many *v.* Jagger, | 1 Blatchf., 372, | N. Y., 1848, | 291, 334, 344, 354, 425, 432, 437, 511, 522, 536, 598, 683. |
| " McCormick *v.* | 6 McLean, 539, | Ill., 1855. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Many *v.* Sizer, | 1 Fisher, 17, | Mass., 1849, | 184, 230, 295, 391, 448, 537. |
| " Sizer *v.* | 16 How., 98, | Sup. Ct., 1853. | |
| Marsh, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 254, 490. |
| Marcy *v* Trotter, | " " | " 1860, | 98, 148, 152, 284, 629. |
| Marden, Dunbar *v.* | 13 N. Hamp., 311, | N. H., 1842. | |
| Marsh *v.* Billings, | 7 Cush., 322, | Mass., 1851, | 689. |
| " Folsom *v.* | 2 Story, 100, | " 1841. | |
| Marshall *v.* Mee, | MS. (App. Cas.), | D. C., 1853, | 297, 314, 426, 448, 665, 683. |
| Martin, Bennett *v.* | 6 Mo., 460, | Mo., 1840. | |
| Mason, Dean *v.* | 20 How., 198, | Sup. Ct., 1857. | |
| " Grant *v.* | 1 L. Int. & Rev., 22, | N. Y., 1828. | |
| " *v.* Tallman, | 1 Blatchf., 529, | R. I., 1850, | 680. |
| Masury, Brook. W. L. Co. *v.* | 25 Barb. S. C., 416, | N. Y., 1857. | |
| Matthews, Cooper *v.* | 8 Law. Rep., 413, | Pa., 1842. | |
| " Goodyear *v.* | 1 Paine, 300, | Ct., 1814. | |
| " *v.* Skates, | 1 Fisher, 602, | Ala., 1860, | 197, 444. |
| " Wade *v.* | 5 Opin., 220, | 1849. | |
| " " *v.* | MS. (App. Cas.), | D. C., 1850. | |
| Maule, Ex parte, | " " | " 1853, | 253, 421, 474, 490 |
| Mayer, Phelps *v.* | 15 How., 160, | Sup. Ct., 1853. | |
| Mayhew, Dudley v. | 3 Coms., 9, | N. Y., 1849. | |
| Maynard, Ex parte, | MS. (App. Cas.), | D. C., 1857, | 478. |
| Mayor, &c., N. Y., Ransom *v.* | 1 Fisher, 252, | N. Y., 1856. | |
| " *v.* " | 23 How., 487, | Sup. Ct., 1859, | 240. |
| Mee, Marshall *v.* | MS. (App. Cas.), | D. C., 1853. | |
| Mellus *v.* Silsbee, | 4 Mason, 108, | Mass., 1825, | 92, 338, 445, 650. |
| Menck, Partridge *v.* | 2 Sand. Ch., 622, | N. Y., 1846. | |
| " " *v.* | 2 Barb. Ch., 101, | " 1847. | |
| " " *v.* | How. App Cas., 547, | " 1848. | |
| Mercer, Smith *v.* | 4 W. L. Jour., 49, | Pa., 1846. | |
| Merchant, Fetridge *v.* | 4 Abb. Pr., 156, | N. Y., 1857. | |
| Meredith, McDowell *v.* | 4 Whart., 311, | Pa., 1839. | |
| Merriam, Kittle *v.* | 2 Curt., 475, | Mass., 1845. | |
| Merrill, Orr *v.* | 1 Wood. & Min., 376, | Me., 1846. | |
| Merrifield *v.* Jones, | 2 Curt., 306, | Mass., 1855, | 266. |
| Merrim'k Manuf. Co. *v.* Garner, | 4 E. D. Smith, 387, | N. Y, 1855, | 116, 273, 411 |
| Meyers, Cutting *v.* | 4 Wash., 220, | Pa., 1818. | |
| " Edmunds *v.* | 16 Ill.. 207, | Ill., 1854. | |
| " Hutchinson *v.* | MS. (App. Cas.), | D. C., 1861. | |
| " *v.* Turner, | 17 Ill., 179, | Ill., 1855, | 204. |
| Middlesex Co., Whipple *v.* | MS., | Mass., 1859. | |
| Miller *v.* McElroy, | 1 Am. L. Reg., 198, | Pa., 1839, | 211, 358, 377. |
| Millett *v.* Snowden, | 1 W. L. Jour., 240, | N. Y., 1843, | 103, 359, 416, 583, 644. |
| Mini's Assignee *v.* Adams, | 3 Wall., Jr., | Pa., 1861, | 128, 617. |
| Mitchell *v.* Barclay, | MS., | N. Y., 1860, | 281, 387, 395, 464. |
| " Sickles *v.* | 3 Blatchf., 548, | " 1857. | |
| Mix *v.* Perkins, | MS. (App. Cas.), | D. C., 1859, | 95. |
| Mixter, Gorham *v.* | 1 Am. L. Jour., 543, | Mass., 1849. | |
| Monk *v.* Harper, | 3 Edw. Ch., 109, | N. Y., 1837, | 103, 221, 262. |
| Moody *v.* Fiske, | 2 Mason, 112, | Mass., 1820, | 105, 181, 187, 502, 521, 526, 631 |
| Moore, Comstock *v.* | 18 How. Pr., 421, | N. Y., 1860. | |
| " Foster *v.* | 1 Curt., 279, | Mass., 1852. | |
| " Judson *v.* | 1 Fisher, 544, | Ohio, 1860. | |
| Morey, Case *v.* | 1 N. Hamp., 347, | N. H., 1818. | |
| Moffitt *v.* Garr, | 1 Fisher, 610, | Ohio, 1860, | 108, 501, 530, 616, 625, 663. |
| Morrill *v.* Worthington, | 14 Mass., 389, | Mass., 1817, | 164, 652. |
| Morris *v.* Barrett, | 1 Fisher, 461, | Ohio, 1859, | 108, 318, 440, 487, 503, 524, 575. |
| " *v.* Huntington, | 1 Paine, 348, | N. Y., 1824, | 92, 97, 415, 455, 507, 596, 612, 650, 653, 693. |
| Morse, Bain *v.* | MS. (App. Cas.), | D. C., 1849. | |
| " *v.* O'Reilly, | 6 Pa. L. Jour., 501. | Pa., 1848, | 122. |
| " *v.* " | MS., | D. C., 1849, | 380, 396. |
| " O'Reilly, *v.* | 15 How., 62, | Sup. Ct., 1853. | |
| Morton's Case, | 8 Opin., 269, | 1856, | 152, 481, 500, 530, 594. |
| " Howe *v.* | MS., | Mass., 1859. | |
| Mowry *v.* Barber, | MS. (App. Cas.), | D. C., 1858, | 98, 153, 607. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Moyer, Dixon *v.* | 4 Wash., 68, | Pa., 1821. | |
| Mulliken *v.* Latchem, | 7 Blackf., 136, | Ind., 1844, | 203. |
| Munson, Ex parte, | MS. (App. Cas.), | D. C., 1859, | 136. |
| Murphy, Christy *v.* | 12 How. Pr., 77, | N. Y., 1856. | |
| Murry, Ball *v.* | 10 Penn., 111, | Pa., 1848. | |
| Muscan Hair Co. *v.* Amer. Hair Co. | 4 Blatchf., 174, | N. Y., 1858, | 395. |
| Myers, Roberts *v.* | 13 Mo. L. Rep., 396, | Mass., 1860. | |
| " *v.* Turner, | 17 Ill., 179, | Ill., 1855, | 204. |

**N.**

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|---|---|---|---|
| Nat. Bk. Note Co., Tappan *v.* | 4 Blatchf., 509, | N. Y., 1861. | |
| Nat. St. Guage Co., Farley *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Negus, Bliss *v.* | 8 Mass., 46, | Mass., 1811. | |
| Nesmith *v.* Calvert, | 1 Wood. & Min., 34, | Mass., 1845, | 163, 224, 264, 267, 293, 630. |
| Nevins *v.* Johnson, | 3 Blatchf., 80, | N. Y., 1853, | 101, 107, 226, 266, 380, 667. |
| Newall, Gatling *v.* | 9 Ind., 572, | Ind., 1857. | |
| Newark Ind. Rub. Co., Day *v.* | 1 Blatchf., 628, | N. Y., 1850. | |
| New Castle & Fr. Tn. R. R., Winans *v.* | Cited 2 Blatchf., 294, | Md., 1850. | |
| N. E. Car Spg. Co., Chaffee *v.* | MS., | N. Y., 1854. | |
| " Day *v.* | 3 Blatchf., 154, 179, | " 1854. | |
| " *v.* Union Rub. Co., | 4 Blatchf., 1, | " 1857, | 407. |
| N. E. Screw Co. *v.* Sloan, | MS. (App. Cas.), | D. C., 1853, | 143, 145, 297, 306, 426. |
| Newman, Ex parte, | " " | " 1859, | 490. |
| N. Y. & Brk. Brass Co., Waterbury Brass Co. *v.* | 3 Fisher, 43 | N. Y., 1858. | |
| N. Y. & E. R. R., Winans *v.* | 21 How., 88. | Sup. Ct., 1858. | |
| N. Y. G. P. Comb Co., Poppenheusen *v.* | 2 Fisher, 62, | N. Y., 1858. | |
| N. Y. G. P. Comb Co., Poppenheusen *v.* | 4 Blatchf., 253, | " 1859. | |
| N. Y. & Har. R. R., Winans *v.* | 31 Jour. Fr. Inst., 320 (3d Ser.), | " 1855. | |
| Newton's Case, | 2 Opin., 571, | 1833, | 144. |
| Nichols *v.* Harris, | MS. (App. Cas.), | D. C., 1854, | 289, 299, 674. |
| " *v* Ruggles, | 3 Day, 145, | Ct., 1808, | 120, 212, 357, 415, 639. |
| Noah, Snowden *v.* | 1 Hopk. Ch., 347, | N. Y., 1825. | |
| North *v.* Jones, | 4 Blatchf., 70, | " 1857, | 113, 386, 394. |
| Norton, Crehore *v.* | MS., | " 1853. | |
| Norw. & Wor. R. R., Imlay *v.* | 4 Blatchf., 227, | Ct., 1858. | |
| Nourse's Case, | 1 Opin., 575, | 1822, | 149, 361. |
| Nourse *v.* Allen, | 4 Blatchf., 376, | N. Y., 1858, | 268, 270. |
| Nye *v.* Raymond, | 16 Ill., 153, | Ill., 1854, | 203, |
| Nyman's Case, | 3 Opin., 446, | 1839, | 117, 319. |

**O.**

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| Oakville Pin Co., Amer. Co. *v.* | 3 Blatchf., 190, 3 Am. L. Reg., 136 | Ct., 1854. | |
| Odiorne *v.* Amesbu. Nail Fac., | 2 Mason., 28, | Mass., 1819, | 279, 507. |
| " Troy Iron & Nail Fac. *v.* | 17 How., 72, | Sup. Ct., 1854. | |
| " *v.* Winkley, | 2 Gall., 51, | Mass., 1814, | 180, 284, 298, 349, 355, 361, 436, 444, 455, 507, 525. |
| Ogle *v.* Ege, | 4 Wash., 584, | Pa., 1826, | 100, 111, 159, 267, 389, 653. |
| O'Hara, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 154. |
| " *v.* Hawes, | " " | " 1859, | 289, 628, 674. |
| Olcott *v.* Hawkins, | 2 Am. L. Jour., 319, | Wis., 1849, | 166, 317, 471. |
| Oliver, Hotchkiss *v.* | 5 Denio, 314, | N. Y., 1848. | |
| O'Niel, Burlew *v.* | MS. (App. Cas.), | D. C., 1853. | |
| O'Reilly, Morse *v.* | 6 Pa. L. Jour., 501, | Pa., 1848. | |
| " *v.* " | MS., | D. C., 1849. | |
| " *v.* " | 15 How., 62, | Sup. Ct., 1853, | 152, 249, 250, 258, 260, 336, 345, 351, 356, 422, 449, 485, 505, 508, 529, 541, 594, 615, 617, 619, 634, 659, 663, 669, 672, 681. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| O'Reilly *v.* Smith, | MS. (App. Cas.), | D. C., 1853, | 289, 298, 418. |
| Orr, Ex parte, | " " | " 1859, | 475. |
| " *v.* Badger, | 7 Law Rep., 465, | Mass., 1844, | 390, 401, 514, 623. |
| " *v.* Littlefield, | 1 Wood. & Min., 13, | N. H.. 1845, | 383, 390, 396, 402. |
| " *v.* Merrill, | 1 " " 376, | Me., 1846, | 271, 330, 380, 402. |
| " Rathbone *v.* | 5 McLean, 131, | Mich., 1850. | |
| Overseers of Poor, Jordan *v.* | 4 Ohio, 294, | Ohio, 1831. | |

**P.**

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|---|---|---|---|
| Pac. Mail S. S. Co., Sickles *v.* | MS., | N. Y., 1857. | |
| Page, Earle *v.* | 6 N. Hamp., 77, | N. H.. 1834. | |
| " *v.* Ferry, | 1 Fisher, 298, | Mich., 1857, | 239, 277, 318, 351, 369, 372, 417, 434, 439, 487, 501, 513, 519, 520, 563, 635, 682. |
| " *v.* Georgia, | MS., | N. Y., 1856, | 563. |
| " Phillips *v.* | 24 How., 159, | Sup. Ct., 1860. | |
| Paine, Vannani *v.* | 1 Harring., 65, | Del., 1832. | |
| Palmer *v.* Allen, | MS., | N. Y., 1854, | 584, 675. |
| " Davis *v.* | 2 Brock., 298, | Va., 1837. | |
| " Sone *v.* | 28 Mo., 539, | Mo., 1859. | |
| Park *v.* Little, | 3 Wash., 196, | Pa., 1813, | 105, 307, 333, 349, 370, 454, 631. |
| Parker *v.* Bamker, | 6 McLean, 631, | Ohio, 1855, | 107, 238. |
| " *v.* Brant, | 1 Fisher, 58, | Pa., 1850, | 269, 392. |
| " *v.* Bigler, | 1 " 285, | " 1857, | 207, 219, 295. |
| " *v.* Corbin, | 4 McLean, 462, | Ohio, 1848, | 220, 234. |
| " *v.* Ferguson, | 1 Blatchf., 407, | N. Y., 1849, | 308. |
| " *v.* Hallock, | MS., | Pa., 1858, | 108, 469. |
| " *v.* Hatfield, | 4 McLean, 61, | Ohio, 1845, | 329, 405. |
| " *v.* Haworth, | 4 " 370, | Ill., 1848, | 165, 188, 207, 295, 341, 366, 574, 584, 588, 648, 658. |
| " *v.* Hulme, | 7 W. L. Jour., 417, | Pa., 1849, | 220, 234, 305, 362, 416, 421, 442, 471, 518, 574, 593, 598. |
| " *v.* Perkins, | MS., | " 1848, | 234. |
| " Perry *v.* | 1 Wood. & Min., 281, | Mass., 1846. | |
| " *v.* Sears, | 1 Fisher, 93, | Pa., 1850, | 132, 248, 272, 384, 385, 392, 400, 405, 522, 529, 574. |
| " *v.* Stiles, | 5 McLean, 44, | Ohio, 1849, | 106, 132, 180, 244, 250, 283, 303, 304, 308, 317, 448, 456, 472, 496, 511, 518, 520, 528, 574, 598, 608, 634. |
| " Woodcock *v.* | 1 Gall., 438, | Mass., 1813. | |
| Parkhurst, Cundell *v.* | MS. (App. Cas.), | D. C., 1847. | |
| " *v.* Kinsman, | 2 Halst. Ch., 600, | N. J., 1847, | 225, 229. |
| " *v.* " | 2 Blatchf., 72; 8 N. Y. L. Obs., 75, 76, | N. Y., 1848, | 122, 269. |
| " *v.* " | 2 Blatchf., 76, | " 1848, | 173. |
| " *v.* " | 2 " 78, | " 1848, | 396, 404. |
| " *v.* " | 1 " 488, | " 1849, | 94, 100, 102, 124, 167, 280, 301, 314, 335, 362, 421, 425, 433, 443, 448, 453, 479 497, 598, 626. |
| " Kinsman *v.* | 18 How., 289, | Sup. Ct., 1855. | |
| Parsons *v.* Barnard, | 7 John, 144, | N. Y., 1810, | 228, 652. |
| " Sanders *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Partridge *v.* Menck, | 2 Sand. Ch., 622, | N. Y., 1846, | 374. |
| " *v.* " | 2 Barb. Ch., 101, | " 1847, | 410, 687. |
| " *v.* " | How. App. Cas., 547, | " 1848, | 160, 272, 374, 683, 688. |
| Patten, Blunt *v.* | 2 Paine, 393, | " 1828. | |
| " Hudson *v.* | 1 Root, 133, | Ct., 1789. | |
| " Sloat *v.* | 4 W. L. Jour., 49, | Pa., 1846. | |
| " " *v.* | 24 Jour. Fr. Inst, 25, (3d Ser.), | " 1852. | |
| Pearce, Smith *v.* | 2 McLean, 176, | Ohio, 1840. | |
| Peck *v.* Bacon, | 18 Conn., 377, | Ct., 1847, | 166. |
| " *v.* Farrington, | 9 Wend., 44, | N. Y., 1832, | 200, 206, 294, 651. |
| Pendleton, Van Hook *v.* | 1 Blatchf., 187, | " 1846 | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Pendleton, Van Hook *v.* | 2 Blatchf., 85, | N. Y., 1848. | |
| Pender, Ex parte, | MS. (App. Cas.), | D. C., 1861, | 255, 475. |
| Pennel, Elmer *v.* | 40 Maine, 430, | Me., 1855. | |
| Pennock *v.* Dialogue, | 4 Wash., 538, | Pa., 1825, | 93, 182, 290, 293, 304, 313, 333, 338, 416, 445, 478, 596, 608, 680. |
| " *v.* " | 2 Pet., 1, | Sup. Ct., 1829, | 93, 97, 149, 175, 178, 242, 243, 343, 455, 603, 647, 650, 654. |
| Perkins' Case, | 1 Opin., 64, | 1796, | 631. |
| " Mix *v.* | MS. (App. Cas.), | D. C., 1859. | |
| " Parker *v.* | MS., | Pa., 1848. | |
| Perry *v.* Cornell, | MS. (App. Cas.), | D. C., 1847, | 138, 143, 145, 151, 244, 288, 299, 300, 305, 312, 339, 425, 469, 665, 673. |
| " *v.* Parker, | 1 Wood. & Min., 281, | Mass., 1846, | 380. |
| Peters, Wheaton *v.* | 8 Pet., 591, | Sup. Ct., 1834. | |
| Peterson *v.* Humphrey, | 4 Abb. Pr., 394, | N. Y., 1857, | 376, 414. |
| " *v.* Wooden, | 3 McLean, 248, | Ohio, 1843, | 354, 527, 587, 671. |
| Pettibone *v.* Derringer, | 4 Wash., 215, | Pa., 1818, | 130, 285, 290, 293, 304, 495, 531 |
| Phalon, Burnett *v.* | 12 Mo. L. Rep., 220, | N. Y., 1859. | |
| " " *v.* | 19 How. Pr., 530, | " 1860. | |
| " " *v.* | 21 " " 100, | " 1861. | |
| Phelps *v.* Comstock, | 4 McLean, 353, | Ind., 1848, | 324, 587. |
| " Goodyear & N. E. Car Sp. Co. *v.* | 3 Blatchf., 91, | N. Y., 1853. | |
| Phelps *v.* Mayer, | 15 How., 160, | Sup. Ct., 1852, | 175. |
| " Teese *v.* | 1 McAllis., 17, | Cal., 1855. | |
| " Dodge & Co. *v.* Brown Bros., | 4 Blatchf., 362, | N. Y., 1859, | 178, 246, 340, 662, 665. |
| Phil. & Tr. R. R. *v.* Stimpson, | 14 Pet., 448, | Sup. Ct., 1840, | 282, 284, 291, 293, 299, 305, 314, 344, 513, 618, 623. |
| Phillips, Bell *v.* | MS., | Ohio, 1858. | |
| " *v.* Combstock, | 4 McLean, 525, | Ind., 1849, | 347. |
| " *v.* Page, | 24 How., 159, | Sup. Ct., 1860, | 346, 355, 423, 563. |
| Pierce, Snowden, *v.* | MS. (App. Cas.), | D. C., 1861. | |
| Pierpont *v.* Fowle, | 2 Wood. & Min., 23, | Mass., 1846, | 103, 120, 161, 211, 214, 221, 377, 641, 642. |
| Pierson *v.* Eagle Screw Co., | 3 Story, 402, | R. I., 1844, | 94, 232, 576, 597, 672, 673. |
| Pitts *v.* Hall, | 2 Blatchf., 229, | N. Y., 1851, | 94, 235, 280, 283, 284, 301, 416, 443, 448, 462, 529, 606, 681. |
| " *v.* " | 3 Blatchf., 201, | " 1854, | 107, 168, 325, 453, 497. |
| " *v.* Jameson, | 15 Barb. S. C., 310, | " 1853, | 118, 125, 168, 245, 462, 468. |
| " *v.* Wemple, | 6 McLean, 558, | Ill., 1855, | 189, 351, 356, 543. |
| " *v.* Whitman, | 2 Story, 609, | Me., 1843. | 106, 165, 178, 182, 188, 502, 504, 510, 543, 586, 589, 658, 661, 670. |
| Plympton, Sloat *v.* | 4 W. L. Jour., 49, | Pa., 1846. | |
| Pomeroy *v.* Connison, | MS. (App. Cas.), | D. C., 1842, | 135, 138, 150, 659, 660. |
| Poud, Stimpson *v.* | 2 Curt., 502, | Mass., 1855. | |
| Poppenheusen *v.* Falke, | 4 Blatchf., 493, | N. Y., 1861, | 115, 120, 217, 249, 388, 550, 617, 622. |
| " *v.* N. Y. G. P. Comb Co., | 2 Fisher, 62, | " May, 1858, | 216, 239, 246, 310, 315, 318, 373, 381, 395, 435, 515, 549, 550, 601, 635. |
| Poppenheusen *v.* N. Y. G. P. Comb Co., | 4 Blatchf., 253, | " July, 1859, | 172, 409. |
| Porter, Vaugham *v.* | 16 Verm., 266, | Vt., 1844. | |
| Potter, Arnold *v.* | MS. (App. Cas.), | D. C., 1860. | |
| " *v.* Holland, | 4 Blatchf., 206, 238, | Ct., 1858, | 113, 157, 185, 193, 252, 310, 352, 387, 395, 463, 513, 516, 566, 615, 618, 625, 663, 670. |
| " *v.* Wilson, | 2 Fisher, 102, | N. Y., 1860, | 454, 567. |
| Pottle *v.* Thomas, | 12 Conn., 565, | Ct., 1838, | 202. |
| Powers, Webb *v.* | 2 Wood. & Min., 497, | Mass., 1847. | |
| Pratt, Bull *v.* | 1 Conn., 342, | Ct., 1815. | |
| Prentiss *v.* Ellsworth, | Mir. Pat. Off., 35, | Pa., 1846, | 108, 224, 265, 666. |
| " St. John *v.* | MS., | N. Y., 1853. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Pringle, Selden *v.* | 17 Barb. S. C., 458, | N. Y., 1854. | |
| Prouty *v.* Ruggles, | 1 Story, 568, | Mass., 1841, | 187, 561. |
| " *v.* " | 16 Pet., 336, | Sup. Ct., 1842, | 187, 561. |
| " *v.* " | 2 Story, 199, | Mass., 1842, | 217, 286. |
| Pulte *v.* Derby, | 5 McLean, 328, | Ohio, 1852, | 91, 104, 120, 214, 221, 476, 610, 643. |
| Putney, Buss *v.* | 11 Mo. L. Rep., 687, | N. H., 1858. | |

**Q.**

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| Quintard, Thomas *v.* | 5 Duer., 80, | N. Y., 1855. | |

**R.**

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| Railroads, Goodyear *v.* | 2 Wall., Jr., 356, | N. J., 1853. | |
| " Stimpson *v.* | 1 " 164, | Pa., 1847. | |
| " Wilton *v.* | 1 " 192, | " 1847. | |
| " " *v.* | 2 Whar. Dig., 410, | " 1848. | |
| Rankin, Tyson *v.* | MS. (App. Cas.), | D. C., 1853. | |
| Ransom, *v.* Mayor, &c., N. Y., | 1 Fisher, 252, | N. Y., 1856, | 95, 96, 146, 216, 238, 246, 302, 306, 315, 422, 427, 444, 449, 454, 480, 500, 515, 518, 524, 529, 542, 600, 648, 649, 659. |
| " " " *v.* | 23 How., 487. | Sup. Ct., 1859. | |
| Rathbone *v.* Orr, | 5 McLean, 131, | Mich., 1850, | 158, 163, 588. |
| Rawson, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 490. |
| Raymond, L., Ex parte, | " " | " 1861, | 149. |
| " Ch., " | " " | " 1861, | 141. |
| " Grant *v.* | 6 Pet., 218, | Sup. Ct., 1832. | |
| " Nye *v.* | 16 Ill., 153, | Ill., 1854. | |
| Redfield, Case *v.* | 4 McLean, 526, | Ind., 1849. | |
| " Sullivan *v.* | 1 Paine, 441. | N. Y., 1825. | |
| Redington, Wintermute *v.* | 1 Fisher, 239, | Ohio, 1856. | |
| Reed *v.* Carusi, | 8 Law Rep., 410, | Md., 1845, | 173, 211, 487, 583, 642, 644. |
| " *v.* Cutter, | 1 Story, 590, | Mass., 1841, | 217, 249, 339, 424, 445, 605, 659, 683. |
| " Van Nostrand *v.* | 1 Wend., 424, | N. Y., 1828. | |
| Reeves, Detmold *v.* | 4 Am. L. Jour., 188, | Pa., 1851. | |
| Renton, Whipple *v.* | MS. (App. Cas.), | D. C., 1854. | |
| Reutgen *v.* Kanowrs, | 1 Wash., 168, | Pa., 1804, | 230, 333, 338, 348, 452, 454, 460, 576, 595, 636, 649. |
| Rheem, Holliday *v.* | 16 Penn., 347, | " 1851, | 351, 356. |
| " *v.* " | 18 " 465, | " 1852. | |
| Rice, Carr *v.* | 1 Fisher, 198, | N. Y., 1856, | |
| " " *v.* | 4 Blatchf., 200, | " 1858, | |
| Rich Dyer *v.* | 1 Metc., 180. | Mass., 1840. | |
| " *v.* Hotchkiss, | 16 Conn., 409, | Ct., 1844, | 121, 229, 279, 461. |
| " *v.* Lippincott, | 2 Fisher, 1, | Pa., 1853, | 164, 363, 368, 440, 456, 474, 599, 683. |
| Richards, Edwards *v.* | Wright, 596, | Ohio, 1834. | |
| " Gibson *v.* | MS., | N. Y., 1845. | |
| Richardson, Eames *v.* | MS. (App. Cas.), | D. C., 1859. | |
| " Foss *v.* | 11 Mo. L. Rep., 670, | Mass., 1859. | |
| " *v.* Hicks, | MS. (App. Cas.), | D. C., 1854, | 140, 292, 312, 674. |
| Ring, Cahoon, *v.* | 1 Fisher, 397. | Me., 1859. | |
| Ritter *v.* Serrell, | 2 Blatchf., 379, | N. Y., 1852, | 163, 168, 500. |
| Roach, Hathaway *v.* | 2 Wood. & Min., 63, | Mass., 1846. | |
| Roberts *v.* Myers, | 13 Mo. L. Rep., 396, | " 1860, | 104, 156, 162, 176, 211, 214, 222, 255, 610, 646. |
| " *v.* Ward, | 4 McLean, 565, | Mich., 1849, | 432, 471. |
| Robertson, Ellithorpe *v.* | MS. (App. Cas.), | D. C., 1858. | |
| " " *v.* | 4 Blatchf., 307, | N. Y., 1859. | |
| Rogers *v.* Abbott, | 4 Wash, 514, | Pa., 1825, | 267, 398. |
| " French, *v.* | 1 Fisher, 133. | " 1851. | |
| " *v.* Jewett, | 12 Mo. L. Rep., 339, | Mass., 1858, | 176, 584, 644. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Rogers, Stimpson *v.* | 4 Blatchf., 333, | Ct., 1859. | |
| " Woodworth *v.* | 3 Wood. & Min., 135, | Mass., 1847. | |
| Root *v.* Ball, | 4 McLean, 177, | Ohio, 1846, | 97, 145, 188, 244, 247, 341, 366, 503, 589. |
| " Johnson *v.* | 1 Fisher, 351, | Mass., 1849. | |
| Rosseau, Wilson *v.* | 1 Blatchf., 3, | N. Y., 1845. | |
| " " *v.* | 4 How., 646, | Sup. Ct., 1845. | |
| Rouse, Ex parte, | MS. (App. Cas.), | D. C., 1854, | 136, 152. |
| Rudderow *v.* Huntington. | 3 Sand. S. C., 252, | N. Y., 1849, | 375. |
| Rugg *v.* Haines, | MS. (App. Cas.), | D. C., 1855, | 606. |
| Ruggles, Nichols *v.* | 3 Day, 145, | Ct., 1808. | |
| " Prouty *v.* | 1 Story, 568, | Mass., 1841. | |
| " " *v.* | 16 Pet., 336, | Sup. Ct., 1842. | |
| " " *v.* | 2 Story, 199, | Mass., 1842. | |
| " *v.* Young, | MS. (App. Cas.), | D. C., 1853, | 143, 448. |
| Russell, Gray *v.* | 1 Story, 11, | Mass., 1839. | |
| Ryan *v.* Goodwin, | 3 Sumn., 514, | " 1839, | 131, 194, 472, 509, 521, 554, 604, 652. |

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| Saddler *v.* Hudson, | 2 Curt., 6, | Me., 1854, | 110, 171, 226. |
| St. John *v.* Prentiss, | MS., | N. Y., 1853, | 367, 393, 547. |
| Salisbury, Stephens *v.* | MS. (App. Cas.), | D. C., 1855. | |
| Samuel *v.* Berger, | 24 Barb. S. C., 163, | N. Y., 1856, | 273, 376, 412. |
| Sanders, Ex parte, | MS. (App. Cas.), | D. C., 1861, | 141. |
| " *v.* Logan, | 2 Fisher, 167, | Pa., 1861, | 108, 227, 240, 266, 387, 607, 673. |
| " *v.* Parsons, | MS. (App. Cas.), | D. C., 1859, | 298. |
| Sanderson, U. S. Bell Tel. Co., *v.* | 3 Blatchf., 184, | N. Y., 1854. | |
| Sandford, Wilson *v.* | 10 How., 99, | Sup. Ct., 1850. | |
| Sargent *v.* Carter, | 11 Mo. L. Rep., 651, | Mass., 1858, | 387, 473. |
| " *v.* Larned, | 2 Curt., 340, | " 1855, | 101, 119, 337, 363, 368, 380, 531. |
| " *v.* Seagrave, | 2 " 553, | R. I., 1855, | 393, 606. |
| Savory *v.* Louth, | MS. (App. Cas.), | D. C., 1859, | 147, 629. |
| Sawin *v.* Guild, | 1 Gall., 485, | Mass., 1813, | 105, 169, 313, 361, 370, 415, 576, 656. |
| Sawyer, Bartholomew *v.* | 4 Blatchf., 347, | N. Y., 1859. | |
| " Earle *v.* | 4 Mason, 1, | Mass., 1825. | |
| Schn. & Troy R. R., Winans *v.* | 2 Blatchf., 279, | N. Y., 1851. | |
| Schuyl. Bank, Kneass *v.* | 4 Wash., 9, | Pa., 1820. | |
| " " *v.* | 4 " 106, | " 1821. | |
| Schwelder, Struve *v.* | 4 Blatchf., 23, | N. Y., 1857. | |
| Scott, Delano *v.* | Gilpin, 489, | Pa., 1834. | |
| Scoville, Wetmore *v.* | 3 Edw. Ch., 515, | N. Y., 1842. | |
| Scudder, Van Hook *v.* | Cited 3 McLean, 438; 3 Story, 132, | " 1843. | |
| Seagrave, Sargent *v.* | 2 Curt. 553, | R. I., 1855. | |
| Searing, Howe *v.* | 19 How. Pr., 14, | N. Y., 1860. | |
| Sears, Parker *v.* | 1 Fisher, 93, | Pa., 1850. | |
| Seely's Case, | 2 Opin., 52, | 1827, | 420, 477. |
| Seeley, Ex parte, | MS. (App. Cas.), | D. C., 1853, | 140, 152, 185, 260, 309, 312, 426, 433, 490, 496, 674. |
| " " | " " | " 1860, | 603. |
| " *v.* Bean, | " " | " 1861, | 315, 607. |
| Seibert's Case, | 7 Opin., 656, | 1856, | 211, 642. |
| Solden, Ex parte, | MS. (App. Cas.), | " 1861, | 137, 616. |
| " *v.* Pringle, | 17 Barb. S. C., 458, | N. Y., 1854, | 126. |
| " Smith *v.* | 1 Blatchf., 475, | " 1849. | |
| Sennett, Com. Ins. Co. *v.* | 37 Penn., 205, | Pa., 1860. | |
| Servell *v.* Collins, | 4 Blatchf., 61. | N. Y., 1857, | 239, 310, 395, 457. |
| " *v.* " | MS., | " 1858, | 515, 518, 555. |
| " Guyon *v.* | 1 Blatchf., 244, | " 1847. | |
| " Ritter *v.* | 2 " 379 | " 1852. | |
| Seymour, McCormick *v* | MS., | " 1850. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Seymour, McCormick *v.* | 2 Blatchf., 240, | N. Y., 1851. | |
| " " *v.* | MS., | " 1851. | |
| " " *v.* | 3 Blatchf., 209, | " 1854. | |
| " *v.* " | 16 How., 480, | Sup. Ct., 1853, | 236, 237, 241, 653, 664. |
| " *v.* " | 19 How., 96, | " 1856, | 219, 251, 545, 609. |
| Shannon, Brown *v.* | 20 How., 55, | " 1857. | |
| Sharp Rifle Co., Smith *v.* | 3 Blatchf. 545 | N. Y., 1857. | |
| Shaver, Hicks *v.* | MS. (App. Cas.), | D. C., 1861. | |
| Shaw *v.* Cooper, | 7 Pet., 292, | Sup. Ct., 1833, | 93, 95, 128, 144, 301, 416, 445, 455, 499, 604, 612, 622, 651, 655. |
| Shawk, Latta *v.* | 1 Fisher, 465, | Ohio, 1859, | |
| Sherman *v.* Cham. Trans. Co., | 31 Verm., 162, | Vt., 1858, | 169, 230, 516. |
| " Sherwood *v.* | MS. (App. Cas.), | D. C., 1860. | |
| " Wilson *v.* | 1 Blatchf., 536, | N. Y., 1850. | |
| " Woodworth *v.* | 3 Story, 171, | Mass., 1844. | |
| Sherwood *v.* Sherman, | MS. (App. Cas.), | D. C., 1860, | 307. |
| Shreeve *v.* United States, | MS., | Ct.Clms., 1859, | 108, 246, 364, 501, 607, 693. |
| Sickles *v.* Borden, | 3 Blatchf., 535, | N. Y., 1856, | 171, 238, 253, 310, 337, 368, 423, 456, 480. 573, 694. |
| " *v.* " | 4 Blatchf., 14, | " 1857. | 119, 172, 408. |
| " *v* Glou. Manuf. Co., | 1 Fisher, 222, | N. J., 1856, | 101, 277, 363, 473, 506, 512, 572 |
| " *v.* Mitchell, | 3 Blatchf., 548, | N. Y., 1857, | 386, 394, 607. |
| " *v.* Pac. Mail S. S. Co., | MS., | " 1857, | 331, 569. |
| " *v.* The Falls Co., | 4 Blatchf., 508, | Ct., 1861. | 261, 508, 573. |
| " *v.* Tilleson, | 4 " 109, | N. Y., 1857, | 508. |
| " Wash. & Alex. Steam Pack. Co., *v.* | 10 How., 419, | Sup. Ct., 1850. | |
| " *v.* Youngs, | 3 Blatchf., 293, | N. Y., 1855, | 393, 401, 572. |
| Silliman, Battin v. | 3 Wall., Jr., | Pa., 1861. | |
| Silsbee, Mellus *v.* | 4 Mason, 108, | Mass., 1825. | |
| Silsby, Foote *v.* | 1 Blatchf., 445, | N. Y., 1849. | |
| " " *v.* | 1 " 542, | " 1850 | |
| " " *v.* | 1 " 545, | " 1850. | |
| " " *v.* | 2 " 260, | " 1851. | |
| " *v.* " | 14 How., 218, | Sup. Ct., 1852, | 185, 249, 345, 495, 520, 522, 670, 696. |
| " *v.* " | 20 How., 290, 378, | " 1857, | 251, 332, 570, 594. |
| " Foote *v.* | 3 Blatchf., 507, | N. Y., 1856. | |
| Silver, Street *v.* | Brightly, 96, | Pa., 1846. | |
| Simpson, Ex parte, | MS. (App. Cas.), | D. C., 1861, | 153, 154, 193. |
| " *v.* Liesor, | 2 Whar. Dig., 414, | Pa., 1848, | 220. |
| " *v.* Mad Riv. R. R., | 6 McLean, 603, | Ohio, 1855, | 107, 237, 310. |
| " *v.* Wilson, | 4 How., 709, | Sup. Ct., 1845, | 167, 323. |
| " Wilson *v.* | MS., | La., 1849. | |
| " " *v.* | 9 How., 109, | Sup. Ct., 1849. | |
| Singer *v.* Walmsley, | 1 Fisher, 558, | Md., 1859, | 251, 565, 566, 595. |
| " Wickersham *v.* | MS. (App. Cas.), | D. C., 1859, | |
| " *v.* Wilson, | MS., | N. Y., 1858, | 590. |
| " Wilson, *v.* | MS. (App. Cas.), | D. C., 1860. | |
| " *v.* Wooster, | MS., | N. Y., 1857, | 386. |
| Sizer, Many *v.* | 1 Fisher, 17, | Mass., 1849. | |
| " *v.* " | 16 How., 98, | Sup. Ct., 1853, | 134, 219, 667, 696. |
| Skates, Matthews *v.* | 1 Fisher, 602, | Ala., 1860. | |
| Sloan, N. E. Screw Co, *v.* | MS. (App. Cas.), | D. C., 1853. | |
| Sloat, Grover & Baker Sewing Mach. Co. *v.* | 2 Fisher, 112, | N. Y., 1860. | |
| Sloat *v.* Patten, | 4 W. L. Jour., 49, | Pa., 1846, | 172, 408. |
| " *v.* " | 24 Jour. Fr. Inst., 25, 3d Ser., | " 1852, | 363, 560. |
| " *v.* Plympton, | 4 W. L. Jour., 49, | " 1846, | 558. |
| Smallwood, Bean *v.* | 2 Story, 408, | Mass., 1843. | |
| Smith, B. C., Ex parte, | MS. (App. Cas.), | D. C., 1860, | 423, 480. |
| " H. L., " | " " | " 1853, | 254, 474. |
| " *v.* Downing, | 1 Fisher, 64, | Mass., 1850, | 155, 177, 189, 275, 356, 371, 437, 484, 511, 529, 540, 593, 634. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Smith *v.* Ely, | 5 McLean, 76, | Ohio, 1849, | 350, 505, 508, 528, 540, 588, 589, 590, 592, 659, 671. |
| " *v.* " | 15 How., 137, | Sup. Ct., 1853, | 222, 347. |
| " *v.* Flickenger, | MS (App. Cas.), | D. C., 1843, | 138, 143, 288, 418, 627. |
| " Hardesty *v.* | 3 Ind., 39, | Ind., 1851. | |
| " *v.* Higgins, | MS., | N. Y., 1856, | 238, 369. |
| " *v.* " | " | " 1857, | 190, 239, 284, 337, 364, 439, 457, 501, 512, 518, 521, 539, 601, 620 |
| " *v.* " | 1 Fisher, 537, | " 1859, | 240, 539 |
| " *v.* " | 2 " 97, | " 1860, | 190. |
| " *v.* Johnson, | 4 Blatchf., 252. | " 1858, | 180, 379. |
| " *v.* Mercer, | 4 W. L. Jour., 49, | Pa., 1846, | 118, 252, 614, 618, 625, 662, 660. |
| " O'Rielly *v.* | MS. (App. Cas.), | D. C., 1853. | |
| " *v.* Pearce, | 2 McLean, 176, | Ohio, 1840, | 180, 334, 350, 355, 361, 436, 442 455, 471, 499, 555, 622. |
| " *v.* Selden, | 1 Blatchf., 475, | N. Y., 1849, | 123. |
| " *v.* Sharp Rifle Co., | 3 " 545, | Ct., 1857, | 406. |
| Smithson, Dale *v.* | 12 Abb. Pr., 237, | N. Y., 1861. | |
| " Stewart *v.* | 1 Hilton, 119, | " 1856. | |
| Snowden, Millett *v.* | 1 W. L. Jour., 240, | 1844. | |
| " *v.* Noah. | 1 Hopk. Ch., 347, | N. Y., 1825, | 347, 409, 494. |
| " *v.* Pearce, | MS. (App. Cas.), | D. C., 1861, | 141, 149, 312. 418, 630, 676. |
| Sone *v.* Palmer, | 28 Mo., 539, | Mo., 1859, | 166. |
| Spain *v.* Gamble, | MS. (App. Cas.), | D. C., 1855, | 277, 432. |
| Sparkman *v.* Higgins, | 1 Blatchf., 205, | N. Y., 1846, | 94, 144, 177, 301, 400, 403, 442, 479, 605. |
| " *v.* " | 2 Blatchf., 29. | " 1846, | 106, 114, 172, 371, 408. |
| Spear *v.* Abbott, | MS. (App. Cas.), | D. C., 1859, | 136, 289, 419, 628. |
| " Amosk. Mfg. Co. *v.* | 2 Sand. S. C., 599, | N. Y., 1849. | |
| " *v.* Stuart, | MS. (App. Cas.), | D. C., 1859, | 98, 147, 148, 629. |
| Spence, Kidd *v.* | MS., | N. Y., 1859. | |
| Spencer, Ex parte, | MS. (App. Cas.), | D. C., 1859, | 136, 140. |
| Sperry, Blake *v.* | 2 N. Y. L. Obs., 251, | Ct., 1843. | |
| Sprague, Ex parte, | MS. (App. Cas., | D. C., 1859, | 524. |
| " Allen *v.* | 1 Blatchf., 567, | N. Y., 1850. | |
| " Blanchard *v.* | 3 Sumn., 279, | Mass., 1838. | |
| " " | 3 Sumn., 535; 2 Story, 164, | " 1839. | |
| " Stone *v.* | 1 Story, 270, | R. I., 1840. | |
| St. John *v.* Prentiss, | MS., | N. Y., 1853. | |
| Staats, Thompson *v.* | 15 Wend., 395, | " 1836. | |
| Stanley *v.* Whipple, | 2 McLean, 35, | Ohio, 1839, | 232, 279, 293, 308, 334, 466, 491, 527, 586, 590, 622. |
| Stearnes *v.* Barrett, | 1 Mason, 153, | Mass., 1816, | 227, 282, 338, 491, 654, 695. |
| " *v.* " | 1 Pick., 443, | " 1823, | 242, 279, 452, 507. |
| " *v.* Davis, | MS. (App. Cas.), | D. C., 1859, | 451. |
| Stein *v.* Goddard, | 1 McAllis., 82, | Cal., 1856, | 107, 112, 160. |
| Stellman, Day *v.* | 1 Fisher, 487, | Md., 1859. | |
| Stephens *v.* Caldwell, | MS., | Mass., 1860, | 585, 675. |
| " *v.* Felt, | 2 Blatchf., 37, | N. Y., 1846, | 232, 492, 664. |
| " *v.* Salisbury, | MS. (App. Cas.), | D. C., 1855, | 145, 246, 258, 306, 427, 487, 512. |
| Stephenson *v.* Hoyt, | " " | " 1854, | 145, 427. |
| Stephens *v.* Cady, | 14 How., 528, | Sup. Ct., 1852, | 170, 174, 208, 313. |
| Stevens *v.* " | 2 Curt., 200, | R. I., 1854, | 101. |
| " *v.* Gladding, | 17 How., 447, | Sup. Ct., 1854, | 101, 170, 174, 221, 262, 313, 641, 657. |
| " *v.* " | 2 Curt., 608, | R. I., 1856, | 102. |
| " *v.* Head, | 9 Verm., 174, | Vt., 1837, | 164, 202, 464, 652. |
| " " *v.* | 19 Wend., 411, | N. Y., 1838. | |
| " Hovey *v.* | 1 Wood. & Min., 290, | Mass., 1846. | |
| " " *v.* | 3 " 17, | " 1846. | |
| Stewart *v.* Smithson, | 1 Hilton, 119, | N. Y., 1856, | 116, 376. |
| Stiles, Parker *v.* | 5 McLean, 44, | Ohio, 1849. | |
| Stimpson *v.* Balt. & Sus. R. R., | 10 How., 329, | Sup. Ct., 1850, | 189, 562, 696. |
| " *v.* Brooks, | 3 Blatchf., 456, | N. Y., 1856, | 219, 285. |
| " Phil. & Tr. R. R. *v.* | 14 Pet., 448, | Sup. Ct., 1840. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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|---|---|---|---|
| Stimpson *v.* Pond, | 2 Curt., 502, | Mass., 1855, | 470, 584, 675. |
| " *v.* The Railroads, | 1 Wall, Jr., 164, | Pa., 1847, | 220, 233, 234, 493, 664. |
| " *v.* Rogers, | 4 Blatchf., 333, | Ct., 1859, | 118, 119, 269, 660. |
| " *v.* West. Ches. R. R., | 4 How., 380, | Sup. Ct., 1845, | 175, 192, 243, 321, 327, 365, 456, 605, 613, 618, 623, 657, 662, 672. |
| Stokes *v.* Landgraff, | 17 Barb., S. C., 608, | N. Y., 1853, | 273, 375, 684, 689. |
| Stolley, Bloomer *v.* | 5 McLean, 158, | Ohio, 1850. | |
| " Brooks *v.* | 3 " 523, | " 1845. | |
| " Wilson *v.* | 4 " 272, | " 1847. | |
| " " *v.* | 4 " 275, | " 1847. | |
| " " *v.* | 5 " 1, | " 1849. | |
| Stone, Clayton *v.* | 2 Paine, 382, | N. Y., 1828. | |
| " *v.* Carlan, | 3 Mo. L. Rep., 360, | " 1850, | 684, 688. |
| " *v.* Sprague, | 1 Story, 270, | R. I., 1840, | 484, 554, 592. |
| " Woodworth *v.* | 3 " 749, | Mass., 1845. | |
| " Wyeth *v.* | 1 " 273, | " 1840. | |
| Story *v.* Holcombe, | 4 McLean, 306, | Ohio, 1847, | 99, 104, 193, 210, 360, 416, 627, 644. |
| " *v.* Derby, | 4 " 160, | " 1846, | 377. |
| Stowe *v.* Thomas, | 2 Am. Law Reg., 210, | Pa., 1853, | 174, 176, 208, 360, 476, 610, 644, 691. |
| Street *v.* Silver, | Brightly, 96, | " 1846, | 194, 350, 354, 447, 528, 597. |
| Strong, Higgins *v.* | 4 Blackf., 182, | Ind., 1836. | |
| Struve *v.* Schwedler, | 4 Blatchf., 23, | N. Y., 1857, | 214, 379, 643. |
| Stuart, Spear *v.* | MS. (App. Cas.), | D. C., 1859. | |
| Sturtevant *v.* Greenough, | " " | " 1860, | 98, 148, 603. |
| Sullivan's Case, | Opin., Gilp.'s Ed., 168, | 1818, | 505, 612. |
| Sullivan, Byass *v.* | 21 How. Pr., 50, | N. Y., 1860. | |
| " *v.* Redfield, | 1 Paine, 441, | " 1825, | 130, 263, 353, 379, 389, 398. 495, 504, 509, 513, 526, 632, 656. |
| Suydam *v.* Day, | 2 Blatchf., 20, | " 1846, | 111, 159, 163, 462, 499, 587, 664. |
| Swan, Barstow *v.* | MS. (App. Cas.), | D. C., 1860. | |

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| Taggert, Battin *v.* | 2 Wall, Jr., 101, | Pa., 1851. | |
| " " *v.* | 17 How., 74, | Sup. Ct., 1854. | |
| Talcott, McCormick *v.* | 20 " 402, | " 1857. | |
| Talmann, Mason *v.* | 1 Blatchf., 529, | R. I., 1850. | |
| Tatham *v.* Le Roy, | MS., | N. Y., 1849, | 128, 183, 244, 371, 456, 489, 581 592. |
| " Le Roy *v.* | 14 How., 156, | Sup. Ct., 1852. | |
| " *v.* " | 2 Blatchf., 474, | N. Y., 1852, | 236, 260, 276, 335, 436, 456, 479, 552, 553. |
| " " *v.* | 22 How., 132, | Sup. Ct., 1859. | |
| Tatham *v.* Loring, | 5 N. Y. L. Obs., 207, | Mass., 1845, | 128, 157, 527. |
| " *v.* Lowber, | 2 Blatchf., 49, | N. Y., 1847, | 128, 158, 283, 618. |
| " *v.* " | 4 Blatchf., 86, | " 1857, | 102, 398. |
| Taylor, Baker *v.* | 2 Blatchf., 82, | " 1848. | |
| " *v.* Carpenter, | 11 Paige, 293, | " 1844, | 115, 129, 409, 687. |
| " *v.* " | 3 Story, 458, | Mass., 1844, | 115, 129, 374, 410. |
| " *v.* " | 2 Wood. & Min., 1, | " 1846, | 116, 129. |
| " *v.* " | 2 Sand. Ch., 603, | N. Y., 1846, | 129, 272, 410, 683, 687. |
| Teese *v.* Huntington, | 23 How., 2, | Sup. Ct., 1859, | 220, 345. |
| " *v.* Phelps, | 1 McAllis., 17, | Cal., 1855, | 110, 226, 261, 310, 337, 422, 434, 449, 480, 515, 518, 520, 529, 635, 681. |
| The Falls Co., Sickles *v.* | 4 Blatchf., 508, | Ct., 1861. | |
| The Washing Mac. Co. *v.* Earle, | 2 Fisher, 203, | Pa., 1861, | 164. |
| Thistle, Berg *v.* | MS. (App. Cas.), | D. C., 1860. | |
| " *v.* U. States, | Dev. Rep., 130, | Ct. Clms., 1856, | 114, 692. |
| Thomas, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 186. |
| " Pottle *v.* | 12 Conn., 565, | Ct., 1838. | |
| " *v.* Quintard, | 5 Duer, 80, | N. Y., 1855, | 204, 281. |
| " Stowe *v.* | 2 Amer. L. Reg., 210, | Pa., 1853. | |
| " *v.* Weeks, | 2 Paine, 92, | N. Y., 1827, | 379, 381, 389, 445, 453, 526, 680. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


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| Thomson *v.* Winchester, | 19 Pick., 214, | Mass., 1837, | 106, 373, 481. |
| Thompson *v.* Haight, | 1 U.S.L.Jour., 95, 563, | N. Y., 1822, | 228, 596, 603. |
| " *v.* Staats, | 15 Wend., 395, | " 1836, | 481, 499. |
| Thorne, Jones *v.* | 1 N. Y. L. Obs., 408, | " 1843. | |
| Thuermer, Hill *v.* | 13 Ind., 351, | Ind., 1859. | |
| Tillman, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 525. |
| Tilleson, Sickles *v.* | 4 Blatchf., 109, | N. Y., 1857. | |
| Todd, Bicknell *v.* | 5 McLean, 236, | Ohio, 1851. | |
| Tomlinson *v.* Battel, | MS., | N. Y., 1857, | 227, 229, 230, 685. |
| Toppan *v.* Nat. Bank Note Co., | 4 Blatchf., 509, | " 1861, | 395. |
| Torrey, Tracy *v.* | 2 Blatchf., 275, | " 1851. | |
| Tracy *v.* Torrey, | 2 " 275, | " 1851, | 101, 335, 350, 367, 397, 538. |
| Treadwell *v.* Bladen, | 4 Wash, 703, | Pa., 1827, | 93, 144, 248, 279, 296, 301, 304, 343, 445, 507, 592, 597, 650 |
| " *v.* Fox, | MS. (App. Cas.), | D. C., 1859, | 261, 475. |
| Trotter, Marcy *v.* | " " | " 1860. | |
| Troy Iron & Nail Fac. *v.* Corning, | 1 Blatchf., 467, | N. Y., 1849, | 123, 293, 294, 305. |
| " *v.* " | 14 How., 193, | Sup. Ct., 1852, | 125, 163, 462, 465. |
| " " *v.* | 15 " 451, | " 1853. | |
| " *v.* Odiorne, | 17 " 72, | " 1854, | 126. |
| Tryon *v.* White, | Pet. C. C., 96, | N. J., 1815, | 495, 585, 590. |
| Tucker, Beech *v.* | MS. (App. Cas.), | D. C., 1860. | |
| Tuel, Tyler *v.* | 6 Cra., 324, | Sup. Ct., 1810. | |
| Turner *v.* Johnson, | 2 Cra. C. C., 287, | D. C., 1822, | 200, 338, 526. |
| " Hildreath *v.* | 17 Ill., 184, | Ill., 1855. | |
| " Meyers *v.* | 17 " 179, | " 1-55. | |
| " Wilson *v.* | 7 Law Rep., 527, | Md., 1845. | |
| " " | 4 How., 712, | Sup. Ct., 1845. | |
| Tyler *v.* Deval, | 1 Code Rep., 30, | La., 1848, | 183, 421, 471, 489, 528, 611. |
| " *v.* Hyde, | 2 Blatchf., 308, | N. Y., 1851, | 245, 295, 694. |
| " *v.* Tuel, | 6 Cra., 324, | Sup. Ct., 1810, | 110, 159, 652. |
| Tyson *v.* Rankin, | MS. (App. Cas.), | D. C., 1853, | 417. |
| Twomey, Hyatt *v.* | 1 Dev. & Bat. Eq., 315, | N. Car., 1836. | |

**U.**

| | | | |
|---|---|---|---|
| Underhill, Wood *v.* | 5 How., 1, | Sup. Ct., 1846. | |
| Underwood, Howe *v.* | 1 Fisher, 160, | Mass., 1854. | |
| Union Rub. Co., Day *v.* | 3 Blatchf., 488, | N. Y., 1856. | |
| " " *v.* | 20 How., 216, | Sup. Ct., 1857. | |
| " Judson & Goodyear *v.* | 4 Blatchf., 63, | N. Y., 1857. | |
| Union Rub. Co., N. E. Car Spg. Co. *v.* | 4 " 1, | " 1857. | |
| United States, King *v.* | 10 Mo. L. Rep., 631, | Ct. Clms., 1857. | |
| " Shreeve *v.* | MS., | " 1859. | |
| " Thistle *v.* | Dev. Rep., 130, | " 1856. | |
| " Bell Tel. Co. *v.* Sanderson, | 3 Blatchf., 184, | N. Y., 1854, | 317, 397. |

**V.**

| | | | |
|---|---|---|---|
| Vance *v.* Campbell, | 1 Fisher, 483, | Ohio, 1859, | 190, 246, 311, 435, 457, 516. |
| " *v.* " | MS., | " 1860, | 281. |
| Van Dresser, Gibson *v.* | 1 Blatchf., 532, | N. Y., 1850. | |
| Van Hook *v.* Pendleton, | 1 " 187, | " 1846, | 330, 332, 383, 391, 558. |
| " *v.* " | 2 " 85, | " 1848, | 286, 287. |
| " *v.* Scudder, | Cited 3 McLean, 438; 3 Story, 132, | " 1843, | 117, 319, 557. |
| Van Ingen, Livingston *v.* | 1 Paine, 45. | " 1811. | |
| " " *v.* | 9 John., 507, | " 1812. | |
| Vannani *v.* Paine, | 1 Harring., 65, | Del., 1832, | 499. |
| Van Nostrand, Dougherty *v.* | 1 Hoff. Ch., 68, | N. Y., 1839. | |
| Van Ostrand *v.* Reed, | 1 Wend., 424, | " 1828, | 200, 694. |
| Vaughan *v.* Porter, | 16 Verm., 266, | Vt., 1844, | 121, 203. |
| Vaught, Bloomer *v.* | Cited 1 Blatchf., 529, | La., 1850. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.

## W.


| | | | |
|---|---|---|---|
| Wade *v.* Matthews, | 5 Opin., 220, | 1849, | 151, 417. |
| " *v.* " | MS. (App. Cas.), | D. C., 1850, | 135, 139, 142, 143, 332. |
| Walch, Ex parte, | " " | " 1857, | 423. |
| Walker *v.* Forbes, | " " | " 1861, | 149, 290, 429, 452. |
| Walton *v.* Crawley, | 3 Blatchf., 440, | N. Y., 1856, | 117, 161, 274, 412, 685, 689. |
| Ward, Roberts *v.* | 4 McLean, 565, | Mich., 1849. | |
| Warner, Blan. Gun-Stk. Fac. *v.* | 1 Blatchf., 258, | Ct., 1848. | |
| " *v.* Goodyear, | MS. (App. Cas.), | D. C., 1846, | 138, 183, 283, 288, 297, 442, 447, 548. |
| Washburn *v.* Gould, | 3 Story, 122, | Mass., 1844, | 111, 118, 131, 159, 167, 230, 232, 257, 282, 303, 305, 313, 316, 319, 321, 356, 389, 424, 442, 447, 461, 466, 491, 517, 520, 557, 558, 652, 657, 661, 664, 682. |
| Washing Mach. Co. *v.* Earle, | 3 Wall., Jr., | Pa., 1861, | 164, 464, 501, 582. |
| Wash. & Alex., Steam Pack. Co. *v.* Sickles, | 10 How., 419, | Sup. Ct., 1850, | 106, 124, 467. |
| Waterby Brs. Co. *v.* N. Y. & Brk. Brs. Co., | MS., | N. Y., 1858, | 239, 310, 369, 457, 516, 519, 533 |
| Waterman, Cochrane *v.* | MS. (App. Cas.), | D. C., 1844. | |
| Watson *v.* Bladen, | 4 Wash., 580, | Pa., 1826, | 334, 479, 526, 596, 680. |
| Wayne *v.* Winter, | 6 McLean, 344, | Ohio, 1853, | 145. |
| Webb, Culver *v.* | 12 Conn., 441, | Ct., 1838. | |
| " *v.* Powers, | 2 Wood. & Min., 497, | Mass., 1847, | 99, 162, 194, 252, 359, 378, 416, 645. |
| Weed, Woodworth *v.* | 1 Blatchf., 165, | N. Y., 1846. | |
| Weeks, Thomas *v.* | 2 Paine, 92, | " 1827. | |
| Weiss, Evans *v.* | 2 Wash., 342, | Pa., 1809. | |
| Wellman *v.* Blood, | MS. (App. Cas.), | D. C., 1856, | 444, 480. |
| Wells, Fetridge *v.* | 13 How Pr., 385, | N. Y., 1857. | |
| Wemple, Pitts *v.* | 6 McLean, 558, | Ill., 1855. | |
| Westchester R. R., Stimpson *v.* | 4 How., 380, | Sup. Ct., 1845. | |
| Wetherell, Burrows *v.* | MS. (App. Cas.), | D. C., 1854. | |
| " Jones *v.* | " " | " 1855. | |
| Wetmore *v.* Scoville, | 3 Edw. Ch., 515, | N. Y., 1842, | 262, 458. |
| Wheatley, Keene *v.* | 9 Am. L. Reg., 33, | Pa., 1860. | |
| Wheaton *v.* Peters, | 8 Pet., 591, | Sup. Ct., 1834, | 103, 156, 208, 213, 215, 220, 262, 475, 626, 638, 640. |
| Wheeler Beach *v.* | 24 Penn., 212, | Pa., 1855. | |
| Whipple *v.* Hutchinson, | 4 Blatchf., 190, | N. Y., 1858, | 172, 173, 381, 409. |
| " *v.* Middlesex Co., | MS., | Mass., 1859, | 370, 524, 534. |
| " *v.* Renton, | MS. (App. Cas.), | D. C., 1854, | 135. |
| " Stanley *v.* | 2 McLean, 35. | Ohio, 1839. | |
| White, Collins *v.* | MS. (App. Cas.), | D. C., 1860. | |
| " Tryon *v.* | Pet., C. C., 96, | N. J., 1815. | |
| Whitman, Pitts *v.* | 2 Story, 609, | Me., 1843. | |
| Whitney, Blanchard *v.* | 3 Blatchf., 307, | N. Y., 1858. | |
| " *v.* Carter, | Fes. on Pat., 2d ed., 130. | Geo., 1809, | 591, 636. |
| Whitney *v.* Emmett, | Bald., 303, | Pa., 1831, | 130, 144, 150, 182, 224, 231, 248, 252, 279, 304, 313, 339, 350, 354, 420, 431, 455, 471, 483, 486, 499, 504, 509, 517, 519, 521, 526 543, 604, 632, 647, 650, 654, 682. |
| Whittemore *v.* Cutter, | 1 Gall., 429, | Mass., 1813, | 104, 110, 117, 159, 162, 196, 219, 230, 241, 338, 342, 365, 370, 435, 495, 636, 651, 652, 653, 656. |
| *v.* " | 1 " 478, | " 1813, | 92, 96, 97, 105, 169, 181, 230, 259, 349, 355, 429, 444, 454, 470, 525, 588, 693. |
| Wickershaff *v.* Jones, | 2 Whar. Dig., 413, | Pa., 1848. | 308, 514. |
| Wickersham *v.* Singer, | MS. (App. Cas.), | D. C., 1859, | 98, 147, 148, 153. |
| Wilbur *v.* Beecher, | 2 Blatchf., 132, | N. Y., 1850, | 189, 235, 309, 362, 433, 532. |
| Wilder *v.* Adams, | 2 Wood. & Min., 329, | Mass., 1846, | 203, 244, 467. |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


| | | | |
|---|---|---|---|
| Wilder *v.* Gayler, | 1 Blatchf., 511, | N. Y., 1849, | 100. |
| " *v.* " | 1 " 597, | " 1850, | 347. |
| " Gayler *v.* | 10 How., 477, | Sup. Ct., 1850. | |
| " *v.* McCormick, | 2 Blatchf., 31, | N. Y., 1846, | 144, 151, 192, 469, 514, 587, 590, 591. |
| Wiles, Hall *v.* | 2 " 194, | " 1851, | |
| Williams *v.* Hicks, | 2 Verm., 36, | Vt., 1829, | 200. |
| " *v.* Johnson, | 2 Bosw., 1, | N. Y., 1857, | 413, 686, 690. |
| " *v.* Wilson, | 4 Sand. Ch., 379, | " 1846, | 348. |
| " Wood *v.* | Gilpin, 517, | Pa., 1834. | |
| Wilson *v.* Barnum, | 1 Wall., Jr., 342, | " 1849, | 151, 330, 494. |
| " *v.* " | 1 " 347, | " 1849, | 384, 396, 514. |
| " *v.* " | 8 How., 258, | Sup. Ct., 1849, | 222. |
| " *v.* Curtius, | 2 W. L. Jour., 511, | La., 1845, | 402. |
| " *v.* Jones, | 3 Blatchf., 227, | N. Y., 1854, | 337, 434, 514. |
| " McFall *v.* | 6 Blackf., 260, | Ind., 1842. | |
| " *v.* Potter, | 2 Fisher, 102, | N. Y., 1860. | |
| " *v.* Rosseau, | 1 Blatchf., 3, | " 1845. | |
| " *v.* " | 4 How., 646, | Sup. Ct., 1845, | 111, 118; 159, 192, 193, 320, 321, 323, 324, 326, 558, 576, 613, 657, 664, 667. |
| " *v.* Sandford, | 10 How., 99, | " 1850, | 134, 578, 638, 666, 696. |
| " *v.* Sherman, | 1 Blatchf., 536, | N. Y., 1850, | 109, 380, 384, 467, 581. |
| " Simpson *v.* | 4 How., 709, | Sup. Ct., 1845. | |
| " *v.* " | 9 " 109, | " 1849, | 292, 323, 326, 577. |
| " Singer *v.* | MS., | N. Y., 1858, | |
| " *v.* " | MS. (App. Cas.), | D. C., 1860, | 158, 454, 618, 621. |
| " *v.* Stolley, | 4 McLean, 272, | Ohio, 1847, | 271, 400. |
| " *v.* " | 4 " 275, | " 1847, | 97, 384, 462, 465, 577. |
| " *v.* " | 5 " 1, | " 1849, | 465, 467. |
| " *v.* Turner, | 7 Law Rep., 529, | Md., 1845, | 320, 322, 667. |
| " *v.* " | 4 How., 712, | Sup. Ct., 1845, | 323. |
| " Williams *v.* | 4 Sand. Ch., 379, | N. Y., 1846. | |
| " Wright *v.* | 11 Rich. Law., 144, | S. Car., 1857, | |
| " Woodworth *v.* | 4 How., 712, | Sup. Ct., 1845. | |
| Wilton *v.* Railroads, | 1 Wall., Jr., 192, | Pa., 1847, | 344, 665. |
| " *v.* " | 2 Whar. Dig., 410, | " 1848, | 257, 504. |
| Winans *v.* Bost. & Prov. R. R., | 2 Story, 412, | Mass., 1843, | 254, 488, 489, 535. |
| " *v.* Danforth, | MS., | N. Y., 1860, | 315, 423, 429, 451, 553, 554, 603. |
| " *v.* Denmead, | 15 How., 330, | Sup. Ct., 1853, | 335, 336, 363, 367, 456, 518, 523, 535, 651. |
| " *v.* New Cas. & Fr. R. R., | Cited 2 Blatchf., 294, | Md., 1850. | |
| " *v.* N. Y. & E. R. R., | 21 How., 88, | Sup. Ct., 1858, | 258, 318, 487, 519, 536, 682. |
| " *v.* N. Y. & Har. R. R., | 31 Jo. Fr. Ins., 320, 3d Ser., | N. Y., 1855, | 238, 283, 306, 315, 427, 443, 449, 515, 606. |
| " *v.* Sche. & Troy R. R., | 2 Blatchf., 279, | " 1851, | 132, 145, 258, 425, 433, 469, 490, 529, 535, 611, 668. |
| " York & Md. R. R., *v.* | 17 How., 30. | Sup. Ct., 1854. | |
| Winchester, Thomson *v.* | 19 Pick., 214, | Mass., 1837. | |
| Wing, Bev. Rub. Co. *v.* | MS. (App. Cas.), | D. C., 1860. | |
| Winkley, Odiorne *v.* | 2 Gall., 51, | Mass., 1814. | |
| Winslow, Ex parte, | MS. (App. Cas.), | D. C., 1850, | 139, 141, 309, 317. |
| Winsor, Jillson *v.* | " " | " 1850. | |
| " Kendall *v.* | 21 How., 322, | Sup. Ct., 1858. | |
| Winter, Wayne *v.* | 6 McLean, 344, | Ohio, 1855. | |
| Wintermute *v.* Humphrey, | 10 W. L. Jour., 52, | " 1851, | 124. |
| " *v.* Redington, | 1 Fisher, 239, | " 1856, | 238, 355, 368, 422, 434, 439, 456, 472, 486, 518, 524, 575, 594, 635 |
| Wolfe *v.* Gourard, | 18 How. Pr., 64, | N. Y., 1859, | 686. |
| Wood & Brundage, Ex parte, | 9 Wheat., 603, | Sup. Ct., 1824, | 228, 654. |
| " *v.* Underhill, | 5 How., 1, | " 1846, | 195, 518, 520, 528, 533. |
| " *v.* Williams, | Gilpin, 517, | Pa., 1834, | 228, 655, 692. |
| Woodcock *v.* Parker, | 1 Gall., 438, | Mass., 1813, | 105, 333, 349, 424, 444, 595. |
| Wooden, Peterson *v.* | 3 McLean, 248, | Ohio, 1843. | |
| Woodruff, Ex parte, | MS. (App. Cas.). | D. C., 1859, | 261, 475. |
| " Binns *v.* | 4 Wash., 48, | Pa., 1821. | |

IN ALPHABETICAL ORDER, WITH REFERENCES TO PAGES WHERE FOUND.


| | | | |
|---|---|---|---|
| Woodruff & Cobb, Ex parte, | MS. (App. Cas.), | D. C., 1860, | 178. |
| Woodworth *v.* Barbour, | Cited 1 Blatchf., 529, | Me., 1850, | 680. |
| " *v.* Cook, | 2 Blatchf., 151, | N. Y., 1850, | 106, 112, 124, 160, 245, 265, 467, 582. |
| " *v.* Curtis, | 1 Wood. & Min., 524, | Mass., 1847, | 170, 313, 323, 465, 576. |
| " *v.* " | Cited 1 Blatchf., 529, | " 1850, | 680. |
| " *v.* Edwards, | 3 Wood. & Min., 120, | " 1847, | 119, 270, 271, 327, 383, 391, 403, 559, 614, 624. |
| " Gibson *v.* | 8 Paige, 132, | N. Y., 1840. | |
| " *v.* Hall, | 1 Wood. & Min., 248, | Mass., 1846, | 111, 118, 193, 207, 268, 271, 294, 320, 321, 327, 383, 391, 399, 402, 482, 613, 623, 624, 657, 658. |
| " *v.* " | 1 Wood. & Min., 389, | Mass., 1846, | 193, 483. |
| " Livingston *v.* | 15 How., 546, | Sup. Ct., 1853. | |
| " *v.* Rogers, | 3 Wood. & Min., 135, | Mass., 1847, | 330, 356, 384, 403, 408, 559. |
| " *v.* Sherman, | 3 Story, 171, | " 1844, | 118, 206, 218, 319, 322, 390, 667. |
| " *v.* Stone, | 3 Story, 749, | " 1845, | 106, 192, 264, 269, 321, 380, 401, 623, 625. |
| " *v.* Weed, | 1 Blatchf., 165, | N. Y., 1846, | 467. |
| " *v.* Wilson, | 4 How., 712, | Sup. Ct., 1845, | 118, 267, 320, 323, 557. |
| Woolsey *v.* Judd, | 4 Duer, 379, | N. Y., 1855, | 222, 262, 459, 477, 641. |
| Wooster, Singer *v.* | MS., | " 1857. | |
| Worthington, Morrill *v.* | 14 Mass., 389, | Mass., 1817. | |
| Wright, Brown *v.* | 17 Ark., 9, | Ark., 1856. | |
| " *v.* Green, | MS. (App. Cas.), | D. C., 1854. | |
| " Heath *v.* | 3 Wall., Jr., | Pa., 1861. | |
| " *v.* Wilson, | 11 Rich. Law, 144, | S. Car., 1857, | 205, 229, 695. |
| Wyeth *v.* Stone, | 1 Story, 273, | Mass., 1840, | 95, 96, 97, 106, 165, 243, 248, 249, 252, 264, 271, 334, 365, 381, 404, 473, 502, 503, 521, 527, 547, 592, 604, 605, 633, 652, 658, 665, 669, 670. |


## Y.


| | | | |
|---|---|---|---|
| Yearsley *v.* Brookfield, | MS. (App. Cas.), | D. C., 1853, | 132, 145, 276, 292, 298, 300, 306, 310, 453, 634. |
| York & Md. R. R. *v.* Winans, | 17 How., 30, | Sup. Ct., 1854, | 193, 216, 657. |
| Young *v.* Colt, | 2 Blatchf., 373, | N. Y., 1852, | 269. |
| " Colt *v.* | 2 " 471, | " 1852. | |
| " *v.* Hunter, | 2 Seld., 203, | " 1852, | 203. |
| " Ruggles *v.* | MS. (App. Cas.), | D. C., 1853. | |
| " Sickles *v.* | 3 Blatchf., 293, | N. Y., 1855. | |

# TABLE OF CASES

ARRANGED ACCORDING TO THEIR

# SUBJECT MATTER.

## A.

| | | | |
|---|---|---|---|
| Air, as a Motive Power, | Case *v.* Morey, | 1 N. Hamp., 347, | N. H., 1818. |
| Ambrotypes, | Tomlinson *v.* Battel, | MS., | N. Y., 1857. |
| Anæsthetic Agent, | Morton's Case, | 8 Opin. Atty. Gen., 269, | 1856. |
| Apple-Pearer, | Sargeant *v.* Larned, | 2 Curt., 340, | Mass., 1855 |
| " " | " *v.* Seagrave, | 2 " 553, | R. I., 1855. |
| " " | " *v.* Carter, | 11 Mo. Law Rep., 651, | Mass., 1858 |
| Auger to bore Muskets, | Pettibone *v.* Derringer, | 4 Wash., 215, | Pa., 1818. |
| Axle-Boxes, | Roberts *v.* Ward, | 4 McLean, 565, | Mich., 1849 |
| " " | Matthews *v.* Skates. | MS., | Ala., 1860. |

## B.

| | | | |
|---|---|---|---|
| Babbitt's Composition, | Roberts *v.* Ward, | 4 McLean, 565, | Mich., 1849. |
| Baker, reflecting, | Dobson *v.* Campbell, | 1 Sumn., 319, | Me., 1833. |
| Bank Bills, printing, | Kneass *v.* Schuylkill Bank, | 4 Wash., 9, 106, | Pa., 1820. |
| Bark Mill, | Wilbur *v.* Beecher, | 2 Blatchf., 132, | N. Y., 1850 |
| Bedsteads, | Berg *v.* Thistle, | MS. (App. Cas.), | D. C., 1860. |
| " | Boyd *v.* Brown, | 3 McLean, 295, | Ohio, 1843. |
| " | " *v.* McAlpine, | 3 " 427, | " 1844. |
| " | Herbert *v.* Adams, | 4 Mason, 15, | Mass., 1825. |
| " | Nourse's Case, | 1 Opin. Atty. Gen., 575, | 1822. |
| Bell Telegraph, | Crehore *v.* Norton, | MS., | N. Y., 1853. |
| " " | U. S. Bell Tel. Co. *v.* Sanderson, | 3 Blatchf., 134, | " 1854. |
| Benzole, burning, | Drake *v.* Cunningham, | MS. (App. Cas.), | D. C., 1855. |
| Billiard-Table Cushions, | Brunswick *v.* Holzalb, | MS., | Ohio, 1859. |
| Bilge Levers, for Ships, | Thomas *v.* Weeks. | 2 Paine, 92, | N. Y., 1827. |
| Biscuit Machine, | See *Cracker Machine*, | | |
| Blast, for Furnaces, | Bell *v.* Daniels, | 1 Fisher, 372, | Ohio, 1858. |
| " " " | " *v.* McCullogh, | 1 " 380. | " 1858. |
| " " " | Detmold *v.* Reeves, | 4 Amer. L. Jour., N. S., 188, | Pa., 1851. |
| Boat Frames, | Raymond L., Ex parte, | MS. (App. Cas.), | D. C., 1861. |
| Boats, propelling, | Isaacs *v.* Cooper, | 4 Wash., 259, | Pa., 1821. |
| Boilers, heating, | Bell *v.* Phillips, | MS., | Ohio, 1858. |
| Bonnet Frames, | Kidd *v.* Spence, | MS., | N. Y., 1859. |
| Boot Cramp, | Eames *v.* Cook, | 2 Fisher, 146, | Mass., 1860. |
| Boots, Manuf. of, | Bedford *v.* Hunt, | 1 Mason, 302, | " 1817. |
| Bottles, Screw-Caps for, | Mitchell *v.* Barclay, | MS., | N. Y., 1860. |
| Bran Duster, | Carr *v.* Rice, | 1 Fisher, 198, | " 1856. |
| " " | " *v.* " | 4 Blatchf., 200, | " 1858. |
| Brass Kettles, | Phelps, Dodge & Co. *v.* Brown Bros., | 4 " 362, | " 1859. |
| " | Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co., | 3 Fisher, 43, | " 1858 |

ARRANGED AS TO SUBJECT MATTER.

| | | | |
|---|---|---|---|
| Brick Machine, | McDonald's Case, | 1 Opin. Atty. Gen., 170, | 1812. |
| " " | Wood *v.* Underhill, | 5 How., 1, | Sup. Ct., 1846. |
| " Press, | Hall *v.* Wiles, | 2 Blatchf., 194, | N. Y., 1851. |
| Bridge, | McCay *v.* Burr, | 6 Penn., 147, | Pa., 1847. |
| " | Sprague, Ex parte, | MS. (App. Cas.), | D. C., 1859. |
| Bucket Machine, | Edwards *v.* Richards, | Wright, 596, | Ohio, 1834. |
| Burring Machine, | Cundell *v.* Parkhurst, | MS. (App. Cas.), | D. C., 1847. |
| " " | Parkhurst *v.* Kinsman, | 2 Halst., Ch., 600, | N. J., " |
| " " | " *v.* " | 8 N. Y. Leg. Obs., 74, | N. Y., " |
| " " | " *v.* " | 2 Blatchf., 72, | " 1848 |
| " " | " *v.* " | 2 " 76, | " " |
| " " | " *v.* " | 2 " 78, | " " |
| " " | " *v.* " | 1 " 488, | " 1849. |
| " " | Kinsman *v.* Parkhurst, | 18 How., 289, | Sup. Ct, 1855. |
| " " | Whipple *v.* Middlesex Co., | MS., | Mass., 1859. |
| Buttons, Designs for, | Booth *v.* Garelly, | 1 Blatchf., 247, | N. Y., 1847. |
| " Eyes of, | Goodyear *v.* Matthews, | 1 Paine, 300, | Ct., 1814. |

## C.

| | | | |
|---|---|---|---|
| Capstan, | Walker *v.* Forbes, | MS. (App. Cas.), | D. C., 1861. |
| Canal-Lock Gate, | Hildreth *v.* Heath, | " " | " 1841. |
| " " | Seeley, Ex parte, | " " | " 1860. |
| Cannon, Rifled, | Laidley *v.* James, | " " | " " |
| Cards, Cotton and Wool, | Whittemore *v.* Cutter, | 1 Gall., 429, 478, | Mass., 1813. |
| Carding Machine, | Carroll *v.* Gambril, | MS. (App. Cas.), | D. C., 1858. |
| " " | Dyson, Ex parte, | " " | " 1860. |
| " " | " *v.* Gambril, | " " | " 1861. |
| " " | See also *Burring Machines.* | | |
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ARRANGED AS TO SUBJECT MATTER.

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ARRANGED AS TO SUBJECT MATTER.


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| Iron Bridges, | Whipple *v.* Hutchinson, | 4 Blatchf., 190. | N Y., 1858. |
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| Irregular Forms, turning, | See *Turning Irregular Forms.* | | |

**J.**

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| Jails, Iron, | Jacobs, Ex parte, | MS. (App. Cas.), | D. C., 1859. |
| Journal Boxes, | Matthews *v.* Skates, | MS., | Ala., 1860. |
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**K.**

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| Knives for Harvesters, | Wright *v.* Green, | " " | " 1854. |
| Knobs, Door, | Hotchkiss *v.* Greenwood, | 4 McLean, 456, | Ohio, 1848. |
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**L.**

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| Lacteal Instruments, | Davidson *v.* Lewis, | MS. (App. Cas.), | D. C., 1858. |
| Ladies' Dresses, | Douglass *v.* Blakinton, | " " | " 1859. |
| Lamps, | Bell *v.* Hill, | " " | " 1854. |
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| Lead Pipe, | Gay *v.* Cornell, | 1 Blatchf., 506, | N. Y., 1849. |
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| " " | " *v.* Lowber, | 2 Blatchf., 49, | " 1847. |
| " " | " *v.* " | 4 Blatchf., 86, | " 1857. |
| Leather, cutting into Soles, | Foster *v.* Moore, | 1 Curt., 279, | Mass., 1852. |
| " splitting, | Woodcock *v.* Parker, | 1 Gall., 437, | " 1813. |
| " tanning, | Davis *v.* Bell, | 8 N. Hamp., 500, | N. H., 1837. |
| Letter File, | Smith, H. L., Ex parte, | MS. (App. Cas.), | D. C., 1853. |
| Levels, Spirit, | Gibberd *v.* Bagot, | MS., | Ct., 1857. |
| " Pendulum, | Chandler *v.* Ladd, | MS. (App. Cas.), | D. C., 1857. |
| Lever for raising Weights, | Guyon *v.* Serrell, | 1 Blatchf., 244, | N. Y., 1847. |
| " Ships, Bilge, | Thomas *v.* Weeks, | 2 Paine, 92, | " 1827. |
| Lightning Rods, | Cushman, S. D., Ex parte, | MS. (App. Cas.), | D. C., 1858. |
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| Locomotives, removing Wheels of, | Simpson *v.* Mad Riv. R. R., | 6 McLean, 603, | Ohio, 1855. |
| Locomotives, variable exhaust of, | Winans *v.* Danforth, | MS., | N. Y., 1860. |
| Looms, | Dyer *v.* Rich, | 1 Metc., 180, | Mass., 1840. |
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| Lotteries, drawing, | Vannani *v.* Paine, | 1 Harrington, 65, | Del., 1832. |

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| Machine Cards, | Wellman *v.* Blood, | MS. (App. Cas.), | D. C., 1856. |
| Machinery, driving, | Thomas, Ex parte, | " " | " 1860. |
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| Matches, friction, | Brooks *v.* Byam, | 1 Story, 300, | Mass., 1840. |
| " " | " *v.* " | 2 Story, 525, 553, | " 1843. |
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| Moss, treating as Hair, | Mus. Hair Co. *v* Amer. Hair Co.. | 4 Blatchf., 174, | N. Y., 1858. |
| Mouldings, planing, | Sorrell *v.* Collins, | 4 " 61, | " 1857. |
| Mowing Machines, | See *Harvesters.* | | |
| Muskets, Auger to bore, | Pettibone *v.* Derringer, | 4 Wash., 215, | Pa., 1818. |

## N.

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|---|---|---|---|
| Nails, Brad, cutting, | Sawin *v.* Guild, | 1 Gall., 485, | Mass., 1813. |
| " cutting and heading, | Gray *v.* James, | Pet., C. C., 394, | Pa., 1817. |
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## O.

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| " Cloth, | Sparkman *v.* Higgins , | 1 Blatchf., 205, | N. Y., 1846 |
| " " | " *v.* " | 2 " 29, | " " |
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| Omnibus Step, | Stephenson *v.* Hoyt, | MS. (App. Cas.), | D. C., 1854. |

## P.

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| Paint, metallic, | Maule, Ex parte, | MS. (App. Cas.), | D. C., 1853. |
| Palm-leaf, for Beds, | Howe *v.* Abbott, | 2 Story, 199, | Mass., 1842. |
| Paper, making, | Ames *v.* Howard, | 1 Sumn., 482, | " 1833 |
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ARRANGED AS TO SUBJECT MATTER.

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| Pegging Machine, | Sturtevant *v.* Greenough, | " " | " 1860. |
| Pen and Pencil Case, | Hawley *v.* Bagley, | MS., | N. Y., 1855. |
| " " " | Richardson *v.* Hicks, | MS. (App. Cas.), | D. C., 1854. |
| Pendulum, Level, | Chandler *v.* Ladd, | " " | " 1857. |
| Perforating Paper, | Toppan *v.* Nat. Bk. Note Co., | 4 Blatchf., 509, | N. Y., 1861. |
| Photographs, | Fry & Seely, Ex parte, | MS. (App. Cas.), | D. C., 1859. |
| Pins, papering, | Amer. Pin Co. *v.* Oak'vl. Pin Co., | 3 Blatchf., 190, | Ct., 1854. |
| Pistol, Self-cocking, | Allen *v.* Blunt, | 2 Wood. & Min., 121, | Mass., 1846. |
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| Planing Machines, | Barnard *v.* Gibson, | 7 How., 650, | Sup. Ct., 1848. |
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ARRANGED AS TO SUBJECT MATTER.

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ARRANGED AS TO SUBJECT MATTER.

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| Reaping Machines, | See *Harvesters.* | | |
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| " " | Lillie *v.* Kelsey, | " " | " 1858. |
| Shingle Machines, | Earle *v.* Page, | 6 N. Hamp., 477, | N. H., 1834. |
| " " | " *v.* Sawyer, | 4 Mason, 1, | Mass., 1825. |
| " " | Judkins *v.* Earle, | 7 Greenl., 9, | Me., 1830. |
| " " | Peck *v.* Bacon, | 18 Conn., 377, | Ct., 1847. |
| " " | " *v.* Farrington, | 9 Wend., 44, | N. Y., 1832. |
| Ship's Timbers, preserving, | Mellus *v.* Silsby, | 4 Mason, 108, | Mass., 1825 |

ARRANGED AS TO SUBJECT MATTER.

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| Shoes, riveting, | Hazard *v.* Green. | MS. (App. Cas.), D. C., 1847. |
| " Soles of, | Eames *v.* Richards, | " " " 1859. |
| Silks, printing, | McGaw *v.* Bryan, | 1 U. S. Law Jour., 82, 582, N. Y., 1822. |
| Skirts, | Chambers, Ex parte, | MS. (App. Cas.), D. C., 1859. |
| " | Mann, " | " " " 1860. |
| " | Newman, " | " " " 1859. |
| " | Sherwood *v.* Sherman, | " " " 1860. |
| Slates, Artificial, | Street *v.* Silver, | Brightly, 96, Pa., 1846. |
| Smut Machine, | Cansler *v.* Eaton, | 2 Jones' Eq., 499, N. Car., 1856. |
| Speeder for roving Cotton, | Davoll *v.* Brown, | 3 West. Law Jour., 151, Mass., 1845. |
| " " | " *v.* " | 1 W. & M., 53, " 1845. |
| " " | Moody *v.* Fiske, | 2 Mason, 112, " 1820. |
| Spikes, Brad-headed, | Corning *v.* Troy Iron & Nail Fac., | 15 How., 451, Sup. Ct., 1853. |
| " " | Troy Iron & Nail Fac. *v.* Corning, | 1 Blatchf., 467, N. Y., 1849. |
| " " | " *v.* " | 14 How., 193, Sup. Ct., 1852. |
| " " | " *v.* Odiorne, | 17 " 72, " 1854. |
| Spinner, Self-adjusting, | Burnham *v.* Brewster, | 1 Verm., 87, Vt., 1828. |
| Spinning Frame, | Bos. Manuf. Co. *v.* Fiske, | 2 Mason, 119, Mass., 1820. |
| Spirits, purifying, | Holden *v.* Curtis, | 2 N. Hamp., 61, N. H., 1819. |
| Spoons, Iron, | Mix *v.* Perkins, | MS. (App. Cas.), D. C., 1859. |
| Staves, sawing, | Janney, Ex parte, | " " D. C., 1847. |
| Steam-boilers, | Bellas *v.* Hays, | 5 Serg. & Rawle, 427, Pa., 1819. |
| " " fusible Alloy, | Evans' Case, | 7 Opin. Atty. Gen., 133, 1855. |
| " " " | Everson & Ricard, Ex parte, | MS. (App. Cas.), D. C., 1855. |
| " Generator, | Latta *v.* Shawk, | 1 Fisher, 465, Ohio, 1859. |
| " Gauges, | Farley *v.* Nat. Stm. Gauge Co., | MS. (App. Cas.), D. C., 1859. |
| " Boats, | Cutting *v.* Meyers, | 4 Wash., 220, Pa., 1818. |
| " Engines, | Blandy, Ex parte, | MS (App. Cas.), D. C., 1858. |
| " " | Fallis *v.* Griffith, | Wright, 303, Ohio, 1833. |
| " " Cut-off, | Sherman *v.* Cham. Trans. Co., | 31 Verm., 162, Vt., 1858. |
| " " " | Judson *v.* Cope, | MS., Ohio, 1860. |
| " " " | " *v.* Moore, | MS., " 1860. |
| " " Valves, | Sickles *v.* Borden, | 3 Blatchf., 535. N. Y., 1856. |
| " " " | " *v.* Glou. Manuf. Co., | 1 Fisher, 222, N. J., 1856. |
| " " " | " *v.* Borden, | 4 Blatchf., 14, N. Y., 1857. |
| " " " | " *v.* Mitchell, | 3 " 548, " 1857. |
| " " " | " *v.* Pac. Mail S. S. Co., | MS., " 1857 |
| " " " | " *v.* The Falls Co., | 4 Blatchf., 508, Ct., 1861. |
| " " " | " *v.* Tilleson, | 4 Blatchf., 109, N. Y., 1857. |
| " " " | " *v.* Young, | 3 Blatchf., 293, " 1855. |
| Steamboats, to remove Snags, | Shreeve *v.* U. States, | MS., Ct. Clms., 1859 |
| Steam Tow-boats, | Sullivan *v.* Redfield, | 1 Paine, 441, N. Y., 1825. |
| Stop-cocks, | Morris *v.* Huntington, | 1 " 348, " 1824. |
| Stoves, | Barstow, Ex parte, | MS. (App. Cas.), D. C., 1860. |
| " | Buck *v.* Gill, | 4 McLean. 174, Ohio, 1846. |
| " | " *v.* Cobb & Hermance, | 9 Law Rep., 545, N. Y., 1846. |
| " | " *v.* " | 1 Blatchf., 322, " 1848. |
| " | " *v.* " | 1 " 398, " 1849. |
| " | Dudley *v.* Mayhew, | 3 Coms., 9, " 1849. |
| " | Hathaway *v.* Roach, | 2 W. & M., 63, Mass., 1846. |
| " | Jewett & Root, Ex parte, | MS. (App. Cas.), D. C., 1853. |
| " | Orr *v.* Badger, | 7 Law Rep., 465, Mass., 1844. |
| " | " *v.* Littlefield, | 1 W & M, 13, N. H., 1845. |
| " | " *v.* Merrill, | 1 " 376, Me., 1846. |
| " | Peterson *v.* Wooden, | 3 McLean, 248, Ohio, 1843. |
| " | Rathbone *v.* Orr, | 5 " 131, Mich., 1850. |
| " | Stanley *v.* Whipple, | 2 " 35, Ohio, 1839. |
| " | Vance *v.* Campbell, | 1 Fisher, 483, " 1859. |
| " Designs, | Root *v.* Ball. | 4 McLean, 177, " 1846. |
| " regulating Draft of, | Foote *v.* Silsby, | 1 Blatchf., 445, N. Y., 1849. |
| " " " | " *v.* " | 1 " 542, " 1850. |
| " " " | " *v.* " | 1 " 545, " 1850. |
| " " " | " *v.* " | 2 " 260, " 1851. |
| " " " | " *v.* " | 3 Blatchf., 507, " 1856. |
| " " " | Silsby *v.* Foote, | 14 How., 218, Sup. Ct., 1852. |
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ARRANGED AS TO SUBJECT MATTER.

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| Straw Cutters, | Hovey *v.* Henry, | 3 West. Law Jour., 153, | Mass., 1845. |
| " " grind'g Knives, | " *v.* Stevens, | 1 W. & M., 290, | " 1846. |
| " " " | " *v.* " | 3 " 17, | " 1846. |
| Suspenders, making, | Dawson *v.* Follen, | 2 Wash., 311, | Pa., 1808. |
| Syringes, | Garrett *v.* Davidson, | MS. (App. Cas.), | D. C., 1857. |

## T.

| | | | |
|---|---|---|---|
| Tailors' Shears, | Heinrich *v.* Luther, | 6 McLean, 345, | Ohio, 1855. |
| Tanning Leather, | Davis *v.* Bell, | 8 N. Hamp., 500, | N. H., 1837. |
| Teeth, Mineral, | Allen *v.* Hunter, | 6 McLean, 303, | Ohio, 1855. |
| Thistle Digger, | Boughton, Ex parte, | MS. (App. Cas.), | D. C., 1854. |
| Thread, packing, | Langdon *v.* De Groot, | 1 Paine, 203, | N. Y., 1822. |
| Threshing Machines, | Burrall *v.* Jewett, | 2 Paige, 134, | " 1830. |
| " " | Culver *v.* Webb. | 12 Conn., 441, | Ct., 1838. |
| " " | Goddard *v.* Lyman, | 14 Pick., 268, | Mass., 1833. |
| " " | Harmon *v.* Bird, | 22 Wend., 113, | N. Y., 1839. |
| " " | Moffitt *v.* Garr, | 1 Fisher, 610, | Ohio, 1860. |
| " " | Pitts *v.* Jameson, | 15 Barb., S. C., 310, | N. Y., 1853 |
| " " | " *v.* Wemple, | 6 McLean, 558, | Ill., 1855. |
| " " | " *v* Whitman, | 2 Story, 609, | Mass., 1843. |
| " " | Smith *v.* Flickenger, | MS. (App. Cas.), | D. C., 1843. |
| " " | Van Nostrand *v.* Reed, | 1 Wend., 424, | N. Y., 1828. |
| Tools, grinding, | Hovey *v.* Stevens, | 1 W. & M., 290, | Mass., 1846. |
| " " | " *v.* " | 3 " 17, | " 1846. |
| Trade-Marks— | | | |
| Balm of Thousand Flowers, | Fetridge *v.* Merchant, | 4 Abb. Pr., 156, | N. Y., 1857. |
| " " " | " *v.* Wells, | 4 " 144, | " 1857. |
| Berger's Watches, | Samuel *v.* Berger, | 24 Barb., S. C., 163, | " 1856. |
| Calfskins, Mark of, | Lemoine *v.* Gauton, | 2 E. D. Smith, 343, | " 1854. |
| Chinese Liniment, | Colleen *v.* Brunton, | 4 McLean, 516, | Ind., 1849. |
| Christy's Minstrels, | Christy *v.* Murphy, | 12 How. Pr., 77, | N. Y., 1856. |
| Club-House Gin, | Corwin *v.* Daly, | Upton on Trade-mks, 187, | " 1860. |
| Cocoaine, | Burnett *v.* Phalon, | 12 Mo. L. Rep., 220, | " 1859. |
| " | " *v.* " | { 11 Abb. Pr., 157; 19 How. Pr., 530, } | " 1860. |
| " | " *v.* " | { 12 Abb. Pr., 186; 21 How. Pr., 100, } | " 1861. |
| Davis' Pain-Killer, | Davis *v.* Kendall, | 2 R. I., 566, | R. I., 1850. |
| Eye Water, | Rudderow *v.* Huntington, | 3 Sand. S. C., 252, | N. Y., 1849. |
| Glass, Mark of, | Stokes *v.* Landgraff, | 17 Barb. S. C., 608, | " 1853. |
| Good-will, | Williams *v.* Wilson, | 4 Sand. Ch., 379, | " 1846. |
| Howe's Bakery, | Howe *v.* Searing, | 19 How. Pr., 14, | " 1860. |
| Indian Root Pills, | Comstock *v.* Moore, | 18 " 421, | " 1860. |
| Irving House, | Howard *v.* Henriques, | 3 Sand. S. C., 725, | " 1851. |
| " " | Stone *v.* Carlan, | 3 Mo. Law Rep., 360, | Mass., 1850. |
| Matches, Friction, | Partridge *v.* Menck, | 2 Sand. Ch., 622, | N. Y., 1846. |
| " " | " *v.* " | 2 Barb. Ch., 101, | " 1847. |
| " " | " *v.* " | How. App. Cas., 547, | " 1848. |
| Meen Fun, | Hobbs *v.* Francais, | 19 How. Pr., 567, | " 1860. |
| Merrimack Prints, | Merri Mfg Co. *v.* Garner, | 4 E. D. Smith, 387, | " 1855. |
| Needles, Mark of, | Walton *v* Crawley, | 3 Blatchf., 440. | " 1856. |
| Porter Bottles, | Byass *v.* Sullivan, | 21 How. Pr., 50, | " 1860. |
| Revere House, | Marsh *v.* Billings, | 7 Cush., 322, | Mass., 1851. |
| Scheidam Schnapps, | Wolfe *v.* Goulard, | 18 How. Pr., 64, | N. Y., 1859. |
| Seeds, Labels for | Bloss *v.* Bloomer, | 23 Barb. S. C., 604, | " 1857. |
| Shovels, Ames, | Ames *v.* King. | 2 Gray, 379, | Mass., 1854. |
| Steel Pens, Labels | Gillott *v.* Kettle, | 2 Duer, 624, | N. Y., 1854. |
| Store Sign, | Peterson *v.* Humphrey, | 4 Abb. Pr., 394, | " 1857. |
| Thread Barnsley, | Stewart *v.* Smithson, | 1 Hilton, 119, | " 1856. |
| " Courtria Flax, | Dale *v.* " | 12 Abb. Pr., 237, | " 1861. |
| " Persian, | Taylor *v.* Carpenter, | 11 Page, 293, | " 1844. |
| " " | " *v.* " | 3 Story, 458, | Mass., 1844. |
| " " | " *v.* " | 2 W. & M., 1, | " 1846. |
| " " | " *v.* " | 2 Sand. Ch., 603, | N. Y., 1846. |

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| TRADE-MARKS—*continued.* | | | |
| Thread six-cord Wire, | Clark *v.* Clark, | 25 Barb., S. C., 75, | N. Y., 1857. |
| " three-cord Cable, | Coates *v.* Holbrook, | 2 Sand. Ch., 586, | " 1845. |
| Ticking, Label for, | Amosk. Mfg. Co. *v.* Spear, | 2 Sand, S. C., 599, | " 1849. |
| White Lead, Mark of, | Brk. W. Lead Co. *v.* Masury, | 25 Barb., S. C., 416, | " 1857. |
| Yankee Soap, | Williams *v.* Johnson, | 2 Bosw., 1, | " 1857. |
| " " | Corwin *v.* Daly, | Upton on Trade-mks, 187, | " 1860. |
| Truss, | Bennett *v.* Martin, | 6 Mo., 460, | Mo., 1840. |
| " | Higgins *v.* Strong, | 4 Blackf., 182, | Ind., 1836. |
| Turning Irregular Forms, | Blanchard's Case, | Opin. Atty. Gen., Gilpin's Ed., 1841, 1125, | 1837. |
| " " " | Blanchard *v.* Beers, | 2 Blatchf., 411, | Ct., 1852. |
| " " " | " *v.* Eldridge, | 1 Wall., Jr., 337, | Pa. 1849. |
| " " " | " *v.* Haynes, | 6 West. Law Jour., 82, | N. H., 1848. |
| " " " | " *v.* Sprague, | 3 Sumn., 279, | Mass., 1838. |
| " " " | " *v.* " | 3 Sumn., 535; 2 Story, 164, | " 1839. |
| " " " | " *v.* Whitney, | 3 Blatchf., 307, | N. Y., 1855. |
| " " " | Blan. Gun-St'ck Turning Fac. *v.* Jacobs, | 2 Blatchf., 69, | " 1847. |
| " " " | Blan. Gun-St'ck Turning Fac. *v.* Warner, | 1 " 258, | Ct., 1846. |

## V.

| | | | |
|---|---|---|---|
| Valves, Steam-Engines, | Sickles *v.* Borden, | 3 Blatchf., 535, | N. Y., 1856. |
| " " | " *v.* " | 4 " 14, | " 1857. |
| " " | " *v.* Glou. Manuf. Co., | 1 Fisher, 222, | N. J., 1856 |
| " " | " *v.* Mitchell, | 3 Blatchf., 548, | N. Y., 1857. |
| " " | " *v.* Pac. Mail S. S. Co., | MS., | " 1857. |
| " " | " *v.* The Falls Co., | 4 Blatchf., 508, | Ct., 1861. |
| " " | " *v.* Tilleson, | 4 " 109, | N. Y., 1857. |
| " " | " *v.* Young, | 3 " 293, | " 1855. |
| " " | Judson *v.* Cope, | 1 Fisher, 615, | Ohio, 1860. |
| " " | " *v.* Moore, | 1 " 544, | " 1860. |
| " Water Closets, | Bartholomew *v.* Sawyer, | 4 Blatchf., 347, | N. Y., 1859. |
| Vault Lights, | Cornell *v.* Hyatt, | MS. (App. Cas.), | D. C., 1856. |
| " " | Jackson, Ex parte, | MS. " | " 1856. |
| Veneers, | Burr *v.* Gregory, | 2 Paine, 426, | N. Y., 1828. |
| Vessels, Gaffs for, | Brown *v.* Duchesne, | 2 Curt., 97, | Mass., 1854. |
| " " | " *v.* " | 2 " 371, | " 1855. |
| " " | " *v.* " | 19 How., 183, | Sup. Ct., 1856 |
| " Steering Apparatus, | Cochrane *v.* Waterman, | MS. (App. Cas.), | D. C., 1844. |

## W.

| | | | |
|---|---|---|---|
| Wagon Wheels, | Young *v.* Hunter, | 2 Seld., 203, | N. Y., 1852. |
| Washing Machines, | Cross *v.* Huntley, | 13 Wend., 385, | " 1835. |
| " " | King *v.* Gedney, | MS. (App. Cas.), | D. C., 1856. |
| " " | Wayne *v.* Winter, | 6 McLean, 344, | Ohio, 1853. |
| Watch Chains, making, | Keplinger *v.* De Young, | 10 Wheat., 358, | Sup. Ct., 1825 |
| Water, salt to fresh, | Lamb's case, | 5 Opin., Atty. Gen., 725, | 1820. |
| " Wheels, | Bryce *v.* Dorr, | 3 McLean, 582, | Mich., 1845. |
| " " | Case *v.* Redfield, | 4 " 526, | Ind., 1849. |
| " " | Hiatt *v.* Twomey, | 1 Dev. & Bat. Eq., 315, | N. C., 1836. |
| " " | Holliday *v.* Rheem, | 18 Penn., 465, | Pa., 1852. |
| " " | Hotchkiss *v.* Oliver, | 5 Denio, 314, | N. Y., 1848. |
| " " | Parker *v.* Banker, | 6 McLean, 631, | Ohio, 1855. |
| " " | " *v.* Bigler, | 1 Fisher, 285, | Pa., 1857. |
| " " | " *v.* Brant, | 1 " 58, | " 1850. |
| " " | " *v.* Corbin, | 4 McLean, 462, | Ohio, 1848. |
| " " | " *v.* Ferguson, | 1 Blatchf., 407, | N. Y., 1849. |
| " " | " *v.* Hallock, | MS., | Pa., 1858. |
| " " | " *v.* Hatfield, | 4 McLean, 61, | Ohio, 1845. |
| " " | " *v.* Haworth, | 4 " 370, | Ill., 1848. |
| " " | " *v.* Hulme, | 7 West. Law Jour., 417, | Pa., 1849. |
| " " | " *v.* Perkins, | MS., | " 1848. |

ARRANGED AS TO SUBJECT MATTER.


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|---|---|---|---|
| Water Wheels, | Parker *v.* Sears, | 1 Fisher, 93, | Pa., 1850. |
| " " | " *v.* Stiles, | 5 McLean, 44, | Ohio, 1849. |
| " " | Phelps *v* Comstock, | 4 " 353, | Ind., 1848. |
| " " | Rheem *v.* Halliday, | 16 Penn, 347, | Pa., 1851. |
| " " | Wintermute *v.* Humphrey, | 10 West. Law Jour., 52, | Ohio, 1851. |
| " " | " *v.* Redington, | 1 Fisher, 239, | " 1856. |
| Weather Strip, | Leach, Ex parte, | MS. (App. Cas.), | D. C., 1860. |
| Weavers' Temples, | Jillson *v.* Winsor, | " " | " 1850. |
| " " | Loveridge *v.* Dutcher, | " " | " 1861. |
| Weaving Goods, | Prentiss *v.* Ellsworth, | Mir. Pat. Off., 35, | Pa., 1846. |
| Wheels, horizontal propelling, | Isaacs *v.* Cooper, | 4 Wash., 259, | " 1821. |
| Winnowing Machines, | Sanders *v.* Logan, | 2 Fisher. 167, | " 1861. |
| " " | Seeley *v.* Bean, | MS. (App. Cas.), | D. C., 1861. |
| Wood Bending Machines, | Morris *v.* Barrett, | 1 Fisher, 461, | Ohio, 1858. |
| Wool and Cotton cleaning, | Nesmith *v.* Calvert, | 1 W. & M., 34, | Mass., 1845. |
| " " carding, | See *Carding Machines.* | | |


## Z.


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|---|---|---|---|
| Zinc, Oxide of, | Burrows *v.* Wetherell, | MS. (App. Cas.), | D. C., 1854. |
| " " | Jones *v.* " | " " | " 1855. |

# TABLE OF CASES

## AFFIRMED, APPROVED, CRITICISED, DISAPPROVED, EXAMINED, EXPLAINED, OVERRULED, QUESTIONED, REVERSED, &c.

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ALLEN *v.* BLUNT, 3 Story, 742.—Mass., 1845. Approved, that a former verdict upon a feigned issue, ordered by the court, is in no just sense final upon the facts found by it, nor binding upon the court, and in no case, unless sanctioned by a subsequent hearing on the merits of the case. *Allen* v. *Blunt*, 2 Wood. & Min., 132.—Mass., 1846. Criticised, as to the conclusiveness of the decision of the Commissioner of Patents in respect to a reissue. *Ibid.*, 139. Approved, as to the conclusiveness of the decision of the Commissioner in such case. *Brooks* v. *Fiske*, 15 How., 228.—Sup. Ct., 1853.

AMES *v.* HOWARD, 1 Sumn., 482.—Mass., 1833. Approved, as to doctrine that patents and specifications should be construed liberally. *Davis* v. *Palmer*, 2 Brock, 309. —Va., 1827. *Davoll* v. *Brown*, 1 Wood. & Min., 57.—Mass., 1845.

AMOSKEAG MANUFAC. CO. *v.* SPEAR, 2 Sand. S. C., 599.—N. Y., 1849. Approved, as to the nature of the wrong in violating a trade-mark. *Samuel* v. *Berger*, 24 Barb. S. C., 164.—N. Y., 1856. That where the exclusive right in a trade-mark is denied, an injunction will not generally issue in the first instance. *Ibid.*, 165. *Fetridge* v. *Merchant*, 4 Abb. Pr., 161.—N. Y., 1857. Approved, as to the exclusive right to sell an article by its descriptive name. *Fetridge* v. *Wells*, 13 How. Pr., 388.—N. Y., 1857. Approved, that an exclusive right cannot be had in words or signs indicating only the origin of the article, its appropriate name, or the mode or process of its manufacture. *Wolfe* v. *Goulard*, 18 How. Pr., 67.—N. Y., 1859. *Corwin* v. *Daly*, Upton on Trade-Marks, 198.—N. Y., 1860.

ATWILL *v.* FERRETT, 2 Blatchf., 39.—N. Y., 1846. Approved, that a person employing another to compile a work is not entitled to take a copyright for such work. *Pierpont* v. *Fowle*, 2 Wood. & Min., 46.—Mass., 1846.

BARRETT *v.* HALL, 1 Mason, 447.—Mass., 1818. Approved, that parties having obtained a joint patent, neither can set up a separate patent granted to himself for the same thing. *Stearns* v. *Barrett*, 1 Pick., 447.—Mass., 1823. Examined, as to doctrine that a patent cannot embrace distinct inventions; and restricted to such inventions as are not contemplated to be used in connection. *Wyeth* v. *Stone*, 1 Story, 288, 290.—Mass., 1840. This case attempts a generalization of the doctrines of the patent law, as to the question whether the same patent can be at once for a combination, and for each of the improved machines, but the definition adopted had no necessary connection with the case

*Emerson* v. *Hogg*, 2 Blatchf., 7.—N. Y., 1845. Approved, that a specification must state in what an improvement consists and be limited to it. *Tyler* v. *Deval*, 1 Code Rep., 30 (La.)—1848.

Bartholomew *v.* Sawyer, MS.—N. Y., 1859. Approved, that the patenting of an invention abroad to defeat a patent granted here, must have been before the invention here, and not merely before the application. *Howe* v. *Morton*, 13 Mo. Law Rep., 70.—Mass., 1860.

Battin *v.* Taggert, 2 Wall., Jr., 101.—Pa., 1851. Reversed, that a description, in a specification, of a part of a machine, without making a claim for it, is a dedication of such part, and that it cannot afterward be recalled by a reissue. *Battin*, v. *Taggert*, 17 How., 83.—Sup. Ct., 1854. Examined and considered, that his case does not decide, that the question whether a reissued patent is for the same invention as the original, is one exclusively for the jury. *Poppenheusen* v. *Falke*, MS.—N. Y., 1861.

Battin *v.* Taggert, 17 How., 73.—Sup. Ct., 1854. Approved, that differences in the claims of an original and reissued patent are consistent with identity of invention. *Hussey* v. *McCormick*, MS.—Ill., 1859.

Bean *v.* Smallwood, 2 Story, 408.—Mass., 1843. Approved, that a machine, &c., to be patentable, must be substantially new—an application to a new purpose is not sufficient. *Tyler* v. *Deval*, 1 Code Rep.; 31.—La., 1848. *Le Roy* v. *Tatham*, 14 How., 177.—Sup. Ct., 1852.

Bedford *v.* Hunt, 1 Mason, 302.—Mass., 1817. *Whitney* v. *Emmett*, Bald., 309.—Pa., 1831. Approved, that an invention is useful if it is not frivolous or injurious. Examined, as to what constitutes the *use* of an invention within the meaning of the act of 1793. *Watson* v. *Bladen*, 4 Wash., 583.—Pa., 1826. Commented on, as to the doctrine that "the first inventor who has reduced his invention to practice, and he only, is entitled to a patent." *Hildreath*, v. *Heath*, MS.—D. C., 1841. Approved, that a patent may be defeated by showing that the thing patented had been before used, however limited the use or knowledge of the prior discovery. *Rich* v. *Lippincott*, 26 Jour. Fr. Inst., 3d Ser., 15.—Pa., 1853.

Bell *v.* Locke, 8 Paige, 75.—N. Y., 1840. Approved, that an injunction will issue for the fraudulent assumption of the name of a newspaper. *Taylor v. Carpenter*, 11 Paige, 297.—N. Y., 1844. Or for the fraudulent use of another's trade-mark. *Coffeen* v. *Brunton*, 4 McLean, 519.—Ind., 1849.

Binns *v.* Woodruff, 4 Wash., 48.—Pa., 1821. Approved, that the person employing others to execute a literary work is not entitled to a copyright. *Pierpont* v. *Fowle*, 2 Wood. & Min., 46.—Mass., 1846.

Blanchard *v.* Eldridge, 1 Wall., Jr., 337.—Pa., 1849. Approved, that in case of a license, the legal right of the monopoly remains in the patentee, who can alone maintain an action for infringement of the right of the licensee. *Gayler* v. *Wilder*, 10 How., 495.—Sup. Ct., 1850.

Bliss *v.* Negus, 8 Mass., 46.—Mass., 1811. Questioned, as to the position that the title to a patent will fail because assignment from original patentee is not recorded. *Holden* v. *Curtis*, 2 N. Hamp., 63.—N. H., 1819. Approved, that state courts may exercise jurisdiction of suits where patents come in question collaterally. *Rich* v. *Hotchkiss*, 16 Conn., 414—Ct., 1844. Approved, that the fraudulent obtaining of a patent is a good defence to a note given for it. *Wilder* v. *Adams*, 2 Wood. & Min., 332.—Mass., 1846.

CASES AFFIRMED, CRITICISED, ETC.

BLOOMER *v.* MCQUEWAN, 14 How., 539.—Sup. Ct., 1852. Examined, as to the position that in an extension under § 18 of the act of 1836, the right of assignees is limited to the use of the particular machines used by them at the time of the extension, and held that such precise question did not arise and was not necessarily decided in it. *Day* v. *Union Rub. Co.*, 3 Blatchf., 488.—N. Y., 1856.

BOSTON MANUF. CO. *v.* FISKE, 2 Mason, 119.—Mass., 1820. Disapproved, as to including as a part of damages for infringement of a patent, counsel fees and other like charges. *Stimpson* v. *The Railroads*, 1 Wall., Jr., 164.—Pa., 1847.

BROOKLYN WHITE LEAD CO. *v.* MASURY, 25 Barb. S. C., 416.—N. Y., 1857. Approved, that no exclusive right of trade-mark can exist, in the use of words indicating merely the nature of the article sold. *Wolfe* v. *Goulard*, 18 How. Pr., 69.—N. Y., 1859.

BROOKS *v.* BICKNELL, 3 McLean, 250.—Ohio, 1843. Approved, that an administrator can apply for and take an extension of a patent. *Woodworth* v. *Sherman*, 3 Story, 172.—Mass., 1844.

BROWN *v.* DUCHESNE, 2 Curt., 371.—Mass., 1855. Affirmed, that the right of property vested in a patentee by his patent does not extend to the use of the thing patented upon a foreign vessel lawfully entering our ports, if such thing was put upon her in a foreign country, and authorized by the laws of such country. *Brown* v. *Duchesne*, 19 How., 198.—Sup. Ct., 1856.

BURRALL *v.* JEWETT, 2 Paige, 134.—N. Y., 1830. Approved, as to doctrine that the jurisdiction of the Federal courts under the act of 1819 was not exclusive in all cases in equity under the patent laws; but *Held*, that the decision was under the act of 1819, which was superseded by the act of 1836. *Gibson* v. *Woodworth*, 8 Paige, 133.—N. Y., 1840.

CARVER *v.* HYDE, 16 Pet., 213.—Sup. Ct., 1842. Approved, that the use of part of a combination is no infringement. *Stimpson* v. *Bal. & Sus. R. R. Co.*, 10 How, 345.—Sup. Ct., 1850.

CLARK *v.* CLARK, 25 Barb. S. C., 75.—N. Y., 1857. Approved, that one manufacturer may use the same word to designate his manufacture as another, provided he does not use it so as to imitate an article before sold by the other. *Wolfe* v. *Goulard*, 18 How. Pr., 68, 69.—N. Y., 1859.

COATES *v.* HOLBROOK, 2 Sand. Ch., 586.—N. Y., 1845. Approved, that the imitation of a trade-mark, though without fraudulent representations, is a fraud which may be restrained. *Amoskeag Manuf. Co.* v. *Spear*, 2 Sand. S. C., 613.—N. Y., 1849.

CROSS *v.* HUNTLEY, 13 Wend., 385.—N. Y., 1835. Approved, that the invalidity of a patent is a good defence to an action on a note given for the purchase thereof. *McDougall* v. *Fogg*, 2 Bosw., 391.—N. Y., 1858.

DAVIS *v.* PALMER, 2 Brock., 298.—Va., 1827. Criticised, as to whether it does not present a too rigid adherence to *form* to be a guide for the present. *Many* v. *Sizer*, MS., Mass., 1849. Referred to, as a case in which the patent is limited to a particular form, as described. *Winans* v. *Denmead*, 15 How., 343.—Sup. Ct., 1853.

DAVOLL *v.* BROWN, 1 Wood. & Min., 53.—Mass., 1845. Approved, that in constructing the claim of a patent, resort may be had to the introduction of the specification as well as the summing up. *Hovey* v. *Stevens*, 1 Wood. & Min., 294.—Mass., 1846; S. C., 3 Wood. & Min., 21.—Mass., 1846.

DAY *v.* CARY, MS.—N. Y., 1859. Criticised and disapproved, that the term

"shirred goods," in the Goodyear-Day contracts of 1846, is limited to goods made under the shirred patent of March 9th, 1844. *Day* v. *Lyons*, MS.—La., 1860.

DAY *v.* HAYWARD, 20 How., 208.—Sup. Ct., 1857. Examined and considered, that the question whether the license of Goodyear to the Naugatuck Rubber Co., of July, 1844, carried the extended term of the patent of June 15th, 1844, was not decided in this case, as it was not before the court. *Day* v. *Stellman*, MS.—Md., 1859.

DAY *v.* UNION RUBBER CO., 20 How., 216.—Sup. Ct., 1857. Approved, as to construction of the agreement of September 5th, 1850, between Judson and Chaffee; but held, that the case did not turn upon the construction of the licenses referred to in that case. *Day* v. *Stellman*, MS.—Md., 1859.

DEAN *v.* MASON, 20 How., 203.—Sup. Ct., 1857. Examined and held, that the question whether a court of equity would punish an infringement, by assuming the functions of a court of law, and whether the remedies given by a Court of Chancery, should not be such as are peculiar to that jurisdiction, did not arise in the case. *Livingston* v. *Jones*, 3 Wall., Jr.—Pa., 1861.

DEDERICK, EX PARTE, MS.—D. C., 1860. Approved, as to abandonment, arising from neglect to prosecute an application for a patent. *Raymond, L., Ex parte*, MS.—D. C., 1861.

DICKINSON *v.* HALL, 14 Pick., 217.—Mass., 1833. Approved, that a note given for a patent which is void, is without consideration. *Jolliffe* v. *Collins*, 21 Mo., 343.—Mo., 1855. *Foss* v. *Richardson*, 11 Mo. Law Rep., 675.—Mass., 1859.

DOBSON *v.* CAMPBELL, 1 Sumn., 319.—Me., 1833. Approved, that under the act of 1793, the recording of an assignment of a patent is indispensable. *Boyd* v. *McAlpine*, 3 McLean, 428.—Ohio, 1844.

DOLLAND'S CASE, 2 H. Bl., 478 (Eng. Rep.) Not a just exposition of the patent law of the United States. *Reed* v. *Cutter*, 1 Story, 598.—Mass., 1841.

DOUGHERTY *v.* VAN NOSTRAND, 1 Hoff. Ch., 68.—N. Y., 1839. A leading authority, that the good-will of a business does not survive to a continuing partner. *Williams* v. *Wilson*, 4 Sand. Ch., 380.—N. Y., 1846. *Howe* v. *Searing*, 19 How. Pr., 17.—N. Y., 1860.

DUDLEY *v.* MAYHEW, 3 Com., 9.—N.Y., 1849. Approved, that state courts have no jurisdiction of cases respecting the validity of patents. *Judson & Goodyear* v. *Union Rub. Co.*, 4 Blatchf.—N. Y., 1857. *Tomlinson* v. *Battel*, MS. DUER, J.—N. Y., 1857.

EARLE *v.* SAWYER, 4 Mason, 1.—Mass., 1825. Examined and held, that the decision in this case, that the patent act of 1793 required the specification to contain written *references* to the drawings, was not called for by the case. *Emerson* v. *Hogg*, 2 Blatchf., 9, 10.—N. Y., 1845.

ELLITHORPE *v.* ROBERTSON, MS.—D. C., 1858. Approved, as to what constitutes a forfeiture of a patent. *Berg* v. *Thistle*, MS.—D. C., 1860.

EMERSON *v.* DAVIES, 3 Story, 768.—Mass., 1845. Approved, that to constitute an infringement of a copyright, it is not necessary there should be a complete copy or imitation throughout; but only such an important and valuable portion used as would operate injuriously to the copyright. *Story's Exrs.* v. *Holcombe*, 4 McLean, 313.—Ohio, 1847.

EVANS *v.* EATON, Pet. C. C., 323.—Pa., 1816. Reversed, that Evans' patent was only for the general result produced by the combination of all his machinery, and not for the several machines as well as the general result. *Evans* v. *Eaton*, 3 Wheat., 505, 517.—Sup. Ct., 1818. Affirmed, that

under the act of 1790, under a notice served with the general issue, that an invention had been used, evidence could be given of a use in other places than those named in such notice. *Ibid.*, 503, 504. Approved, that it is no infringement of a patent for a combination to use less than the whole. *Barrett* v. *Hall*, 1 Mas., 474.—Mass., 1818. Approved, that prior use or knowledge of an invention will invalidate a patent. *Brooks* v. *Bicknell*, 3 McLean, 263.—Ohio, 1843.

Evans *v.* Eaton, 3 Wheat., 454.—Sup. Ct., 1818. Examined and explained. *Evans* v. *Eaton*, 3 Wash., 450.—Pa., 1818. *Pettibone* v. *Derringer*, 4 Wash., 217.—Pa., 1818. *Evans* v. *Hettick*, 3 Wash., 429.—Pa., 1818. Approved, that the terms "an improved machine" and "an improvement on a machine," are substantially the same. *Whitney* v. *Emmett*, Bald., 314.—Pa., 1831. Approved, that an act of Congress is not unconstitutional because it grants a patent for what was in public use. *Blanchard* v. *Sprague*, 3 Sumn., 541.—Mass., 1839. Examined, as to point that a patent cannot include more than one invention. *Wyeth* v. *Stone*, 1 Story, 288.—Mass., 1840. Questioned, as to doctrine intimated that the same patent cannot give a right to the use of several machines separately and for them in combination. *Emerson* v. *Hogg*, 2 Blatchf., 7.—N. Y., 1845. Approved, that a special act of Congress as to a patent is to be regarded as engrafted on the general acts. *Bloomer* v. *McQuewan*, 14 How., 548.—Sup. Ct., 1852. Approved, that a defendant is not limited to the plea of the general issue, with notice, but may plead specially. *Day* v. *N. E. Car-Spring Co.*, 3 Blatchf., 181.—N. Y., 1854.

Evans *v.* Eaton, 3 Wash., 443.—Pa., 1818. Affirmed, that Evans' patent issued under a special act was not an exception to the general provisions of the patent laws; being for an improvement, it should have set out what his improvement was. *Evans* v. *Eaton*, 7 Wheat., 356.—Sup. Ct., 1822.

Evans *v.* Eaton, 7 Wheat., 356.—Sup. Ct., 1822. Approved, that if a patent does not describe the new from the old, it will be void. *Brooks* v. *Bicknell*, 3 McLean, 444.—Ohio, 1844. Approved, that a patentee must state distinctly what he claims. *Brooks* v. *Fiske*, 15 How., 215.—Sup. Ct., 1853.

Evans *v.* Hettick, 3 Wash., 408.—Pa., 1818. Affirmed. *Evans* v. *Hettick*, 7 Wheat., 453.—Sup. Ct., 1822.

Evans *v.* Jordan, 1 Brock., 248.—Va., 1813. Decided on certificate of division, that under the act of 1808 for relief of O. Evans, those who had erected his machinery between the expiration of his old patent and the grant of the new, had no right to continue its use. *Evans* v. *Jordan*, 9 Cra., 204.—Sup. Ct., 1815.

Ewer *v.* Coxe, 4 Wash., 487.—Pa., 1824. Approved, that under the copyright act of 1790 the publication of the record of copyright and the deposit of a book with the Secretary of State are not prerequisites to obtaining a copyright. *Wheaton* v. *Peters*, 8 Pet., 693.—Sup. Ct., 1834. Commented on, whether any change as to the requirements to secure a copyright were made by the act of 1802. *Ibid.*, 696.—Dis. Opin.

Fallis *v.* Griffith, Wright, 303.—Ohio, 1833. Approved, that a *useless* patent is no consideration for a promise to pay. *McDougall* v. *Fogg*, 2 Bos., 391.—N. Y., 1858.

Fetridge *v.* Wells, 13 How. Pr., 355.—N. Y., 1857. Approved, that a name cannot be protected as a trade-mark when it is used to designate the article, and has become its proper appellation, and does

not indicate its origin or ownership. *Tomlinson* v. *Battell*, MS.—N. Y. 1857. *Wolfe*, v. *Goulard*, 18 How. Pr., 38.—N. Y., 1859.

Folsom *v.* Marsh, 2 Story, 100.—Mass., 1841. Approved, as to the extent a reviewer may cite from an original work without infringing. *Story's Exrs.* v. *Holcombe*, 4 McLean, 309, 310.—Ohio, 1847. And that a *bona fide* abridgment is not an infringement. *Ibid.*, 311–315. Approved, that the right of property in private letters remains in the writer. *Bartlett* v. *Crittenden*, 5 McLean, 43.—Ohio, 1849. Approved, that all letters are literary compositions, and entitled to protection; and as to right of property therein. *Woolsey* v. *Judd*, 4 Duer, 396, 405, 406.—N. Y., 1855.

Foote *v.* Silsby, 1 Blatchf., 445.—N. Y., 1849. Affirmed, as to what is a sufficient statement of the interest, in a disclaimer of the patent, of the person making the disclaimer. *Silsby* v. *Foote*, 14 How., 221.—Sup. Ct., 1852. Affirmed, that a reference to a book, mentioned in the notice, required with the plea of the general issue, must be to page or section; a general reference not enough. *Ibid.*, 223, 224. Affirmed, that in a patent for a combination, a claim for such machinery as produces a given result is sufficiently definite. *Ibid.*, 225.

Foote *v.* Silsby, 2 Blatchf., 275.—N. Y., 1851. Affirmed, as to what is granted by Foote's patent, but reversed, as to the allowance of interest and costs. *Silsby* v. *Foote*, 20 How. 385.—Sup. Ct., 1857. Sustains, in fact, the ruling below, that a judge may disregard the finding of a jury upon a feigned issue, and give a decree in opposition thereto. *Ibid.*, 385.

Foster *v.* Moore, 1 Curt., 283.—Mass., 1852. Approved, that no fixed time of possession of patent is necessary to warrant an injunction. *Sargeant* v. *Seagrave*, 2 Curt., 557.—R. I., 1855.

Gayler *v.* Wilder, 10 How., 477.—Sup. Ct., 1850. Approved, that by an assignment before patent issued, the legal title of the patent enures to the assignee. *Sargeant* v. *Seagrave*, 2 Curt., 555, 556.—R. I., 1855. Commented on, as to when, under § 15 of the act of 1836, a prior use and knowledge abroad will invalidate a patent. *Cahoon* v. *Ring*, MS.—Me., 1859.

Geiger *v.* Cook, 3 Watts & Serg., 266.—Pa., 1842. Approved, that a party cannot recover on a note given for a purchase of a patent, if the patent was not new and useful, though both parties acted in good faith. *McClure* v. *Jeffrey*, 8 Ind., 82.—Ind., 1856.

Goodyear *v.* Day, 2 Wall., Jr., 283.—N. J., 1852. Approved, as to what constitutes such a prior invention as will defeat a subsequent patent. *Singer* v. *Walmsley*, MS.—Md., 1859.

Goodyear *v.* Matthews, 1 Paine, 302.—Ct., 1814. Examined, as to what use of an invention, before patent, will deprive a party of a right to a patent. *Shaw* v. *Cooper*, 7 Pet., 317.—Sup. Ct., 1833.

Goodyear & N. E. Car Spring Co. *v.* Phelps, 3 Blatchf., 91.—N. Y., 1853. Approved, that the directors, managers, and agents of a corporation, are liable, individually, as for an infringement of a patent, and may be enjoined. *Poppenheusen* v. *Falke*, MS.—N. Y., 1861.

Grant *v.* Raymond, 6 Pet., 218.—Sup. Ct., 1832. Approved, as to the right to surrender a patent, and obtain a reissue thereof. *Ames* v. *Howard*, 1 Sumn., 488.—Mass., 1833. *Shaw* v. *Cooper*, 7 Pet., 315.—Sup. Ct., 1833. *Brooks* v. *Bicknell*, 3 McLean, 438.—Ohio, 1844. *Battin* v. *Taggert*, 17 How., 83.—Sup. Ct., 1854. Approved, that a defendant may pleah specially, instead of the general issue, with notice. *Day* v. *N. E. Car-Spring Co.*, 3 Blatchf., 181.—N. Y., 1854.

CASES AFFIRMED, CRITICISED, ETC.

GRAY *v.* JAMES, Pet. C. C., 394.—Pa., 1817. Criticised and questioned, as to the position that the patentee of a worthless machine is entitled to damages when such machine is combined with an improvement made by another, and thereby made useful. *Whitney* v. *Emmett*, Bald., 328.—Pa., 1831.

GRAY *v.* RUSSELL, 1 Story, 11.—Mass., 1839. Approved, that the arrangement or combination of the materials of a book upon a new plan, may be subject of copyright. *Emerson* v. *Davies*, 3 Story, 781.—Mass., 1845.

HARTSHORN *v.* DAY, 19 How., 211.—Sup. Ct., 1856. Decision in this case rests upon the contract of November 12th, 1851, between Chaffee & Judson, and under it the Chaffee patent was in Judson for the benefit of Goodyear, and Day took no interest in such patent by Chaffee's assignment of July 1st, 1853. *Day* v. *Stellman*, MS.—Md., 1859. Approved, *Day* v. *Union Rub. Co.*, 20 How., 217.—Sup. Ct., 1857.

HEAD *v.* STEVENS, 19 Wend., 411.—N. Y., 1838. Approved, that the uselessness of a patent may be set up as a defence to a note given for the purchase thereof. *McDougal* v. *Fogg*, 2 Bosworth, 391.—N. Y., 1858.

HERBERT *v.* ADAMS, 4 Mas., 5.—Mass., 1825. Approved, that in case of an assignment of a patent before issue, an action for an infringement must be brought in the name of the assignee. *Gayler* v. *Wilder*, 10 How., 493.—Sup. Ct., 1850.

HIATT *v.* TWOMEY, 1 Dev. & Bat., 315.—N. Car., 1836. Criticised and explained. *Cansler* v. *Eaton*, 2 Jones, Eq., 499.—N. Car., 1856.

HIGGINS *v.* STRONG, 4 Blackf., 182.—Ind., 1836. Approved, that under act of 1793, an assignment of patent, to be valid, must be recorded. *McFall* v. *Wilson*, 6 Blackf., 26.—Ind., 1842. *Mulliken* v. *Latchem*, 7 Blackf., 138.—Ind., 1844. *McKernan* v. *Hite*, 6 Ind., 429.—Ind., 1855.

HILDREATH *v.* HEATH, MS.—D. C., 1841. Approved, that the first one to conceive an invention is entitled to a patent, provided he uses reasonable diligence to perfect it. *Beverly Rub. Co.* v. *Wing*, MS.—D. C., 1860.

HILL *v.* THOMSON, 3 Meriv. R., 622, Ld. Eldon, Chan. Approved, as to rule governing allowance of injunctions. *Sullivan* v. *Redfield*, 1 Paine, 449.—N. Y., 1825. *Washburn* v. *Gould*, 3 Story, 170.—Mass., 1844.

HOGG *v.* EMERSON, 6 How., 437.—Sup Ct., 1847. Explained and affirmed. *Hogg* v. *Emerson*, 11 How., 587.—Sup. Ct., 1850.

HOTCHKISS *v.* GREENWOOD, 4 McLean, 456.—Ohio, 1844. Affirmed, that the alleged invention was but a new application, and not patentable. *Hotchkiss* v. *Greenwood*, 11 How., 248.—Sup. Ct., 1850.

HOVEY *v.* STEVENS, 1 Wood. & Min., 303.—Mass., 1846. Approved, that mere possession of a patent will not warrant an injunction. *Mitchell* v. *Barclay*, MS.—N. Y., 1860.

HOWE *v.* ABBOTT, 2 Story, 194.—Mass., 1842. Explained, as to point that a new application or purpose is not patentable. *Hotchkiss* v. *Greenwood*, 11 How., 270.—Sup. Ct., 1850. Dis. Opin.

HOYT *v.* MCKENZIE, 3 Barb. Ch., 320.—N. Y., 1848. Criticised and held, that the decision therein, that the publication of private letters will not be restrained, unless they possess the character of *literary* compositions, was a departure from established law, and not a binding authority. *Woolsey* v. *Judd*, 4 Duer, 389, 406.—N. Y., 1855.

KENDALL *v.* WINSOR, 21 How., 328.—Sup. Ct., 1858. Approved, as to forfeit-

ure of patent. *Berg* v. *Thistle*, MS.—D. C., 1860. *Marcy* v. *Trotter*, MS.—D. C., 1860. Approved, as to effect of delay in applying for a patent. *Walker* v. *Forbes*, MS. —D. C., 1861. *Loveridge* v. *Dutcher*, MS.—D. C., 1861.

KEPLINGER *v.* DE YOUNG, 10 Wheat., 358.—Sup. Ct., 1825. Approved, that it is not the product, but the thing patented which is protected, and which cannot be sold or used. *Boyd* v. *McAlpine*, 3 McLean, 430.—Ohio, 1844. Examined, as to constructive infringement. *Byam* v. *Ballard*, 1 Curt., 102.—Mass., 1852.

LAROWE, EX PARTE, MS.—D. C., 1860. Approved, that a decision of one Commissioner in respect to applications for patents, while unreversed, binds his successors. *Simpson*, *Ex parte*, MS.—D. C., 1861.

LE ROY *v.* TATHAM, 14 How., 156.—Sup. Ct., 1852. Considered, as holding that the patentee was not entitled to a patent for the newly-discovered principle of lead reuniting under pressure, but for the process or method of making lead pipe which this discovery enabled him to apply. *O'Reilly* v. *Morse*, 15 How., 117.—Sup. Ct., 1853. Examined, and commented on. *Le Roy* v. *Tatham*, 22 How., 137–139.—Sup. Ct., 1859.

LIVINGSTON *v.* VAN INGEN, 9 John., 507.—N. Y., 1812. Overruled in fact, as to the power of a state to grant privileges which should interfere with the coasting laws of the United States. *Gibbons* v. *Ogden*, 9 Wheat., 1.—Sup. Ct., 1824. The principles of this case as to injunctions do not apply to suits brought under the general patent laws, as this case arose under a state law. *Sullivan* v. *Redfield*, 1 Paine, 448.—N. Y., 1825.

LIVINGSTON *v.* WOODWORTH, 15 How. 546.—Sup. Ct., 1853. Approved, as to, rule of damages, that a party is accountable only for profits *actually made*, and not what he might have made. *Dean* v. *Mason*, 20 How., 203.—Sup. Ct., 1857.

LOVERIDGE *v.* DUTCHER, MS.—D. C., 1861. Approved, as to effect of negligence in failing to apply for a patent for an invention. *Snowden* v. *Pierce*, MS.—D. C., 1861.

LOWELL *v.* LEWI, 1 Mason, 182.—Mass., 1817. Approved, that a patent for an improvement must distinguish the new from the old. *Evans* v. *Hettick*, 3 Wash., 425.—Pa., 1818. Approved, that an invention is useful if it is not frivolous or mischievous. *Kneass* v. *Schuyl. Bank*, 4 Wash., 12.—Pa., 1820. *Whitney* v. *Emmett*, Bald., 309.—Pa., 1831.

MANY *v.* JAGGER, 1 Blatchf., 372.—N. Y., 1848. Correctness of Nelson, J.'s charge as to construction of plaintiff's patent for car-wheels questioned. *Many* v. *Sizer*, MS.—Mass., 1849.

MCCLURG *v.* KINGSLAND, 1 How., 202.—Sup. Ct., 1843. Commented on, as to prior use under § 7 of the act of 1839. *Pierson* v. *Eagle Screw Co.*, 3 Story, 405, 409.—R. I., 1844. Examined, as to provision respecting assignees, under § 18 of the act of 1836. *Wilson* v. *Rousseau*, 4 How., 683.—Sup. Ct., 1845. Considered to be a patent for the application of a known law of nature to a new purpose. *O'Reilly* v. *Morse*, Dis. Opin., 15 How., 131.—Sup. Ct., 1853. Commented on. *Day* v. *Union Rub. Co.*, 3 Blatchf., 505.—N. Y., 1856.

MCCORMICK *v.* SEYMOUR, 2 Blatchf., 240.—N. Y., 1851. Reversed, as to rule of damages laid down therein. *Seymour* v. *McCormick*, 16 How., 491.—Sup. Ct., 1853. Approved, as to construction of McCormick's patent. *McCormick* v. *Many*, 6 McLean, 556.—Ill., 1855.

MCCORMICK *v.* SEYMOUR, 3 Blatchf., 209.—N. Y., 1854. Affirmed, except as to

construction of one claim of patent, and the right of plaintiff to recover costs. *Seymour* v. *McCormick*, 19 How., 106.—Sup. Ct., 1856.

MERRIMACK MANUF. CO. *v.* GARNER, 4 E. D. Smith, 387.—N. Y., 1855. Approved, that one may imitate and sell the style of goods made by another, unless the label used by him deceives purchasers as to their true character. *Wolfe* v. *Goulard*, 18 How. Pr., 69.—N. Y., 1859.

MOODY *v.* FISKE, 2 Mason, 112.—Mass., 1820. Approved, that the claim is conclusive as to the patentee's rights. *Wyeth* v. *Stone*, 1 Story, 285.—Mass., 1840. Examined, as to doctrine that a patent cannot embrace distinct inventions, and held to apply to machines having a common object or purpose. *Ibid.*, 291, 292. Examined, as to same doctrine, and held that the facts of the case did not demand a judgment on that point. *Emerson* v. *Hogg*, 2 Blatchf., 8.—N. Y., 1845.

MORRIS *v.* HUNTINGTON, 1 Paine, 348.—N. Y., 1824. Approved, that a person cannot have two valid, subsisting patents at the same time, for the same invention. *Treadwell* v. *Bladen*, 4 Wash., 708.—Pa., 1827. Examined, as to what use of an invention will defeat a patent. *Shaw* v. *Cooper*, 317.—Sup. Ct., 1833.

NICHOLS *v.* RUGGLES, 3 Day, 145.—Ct., 1808. Approved, that under the copyright act of 1790, the publication of the title of a book, and the depositing a copy with the Secretary of State, are merely directory. *Wheaton* v. *Peters*, 8 Pet., 693.—Sup. Ct., 1834.

NYMAN'S CASE, 3 Opin. Atty. Gen., 446.—1839. Approved, as to power of an administrator to take out an extension of a patent. *Brooks* v. *Bicknell*, 3 McLean, 437, 438.—Ohio, 1844.

ODIORNE *v.* AMESBURY NAIL FAC., 2 Mason, 28.—Mass., 1849. Approved, that a person cannot have two subsisting valid patents at the same time for the same invention. *Treadwell* v. *Bladen*, 4 Wash., 708, 709.—Pa., 1827. *Ogle* v. *Eye*, 4 Wash., 585.—Pa., 1826. Approved, as to principles governing issue of injunctions. *Hussey* v. *Whiteley*, MS.—Ohio, 1861.

O'REILLY *v.* MORSE, 15 How., 62.—Sup. Ct., 1853. Considered, as having settled the question of extent of the rights secured to an inventor by his patent. *Amer. Pin Co. v. Oakville Pin Co.*, 3 Amer. Law Reg., 137.—Ct., 1854. Approved as to the question of unreasonable delay in filing a disclaimer. *Seymour* v. *McCormick*, 19 How., 106.—Sup. Ct., 1856. Approved, that a patent confers only a right to use the thing described and nothing more. *Burr* v. *Cowperthwaite*, 4 Blatchf.—Ct., 1858. *Potter* v. *Holland*, 4 Blatchf.—Ct., 1858. Approved, as to the patentability of a principle. *Singer* v. *Walmsley*, MS.—Md., 1859. Approved, that a reissued patent is presumably for same invention as the original patent. *Hussey* v. *McCormick*, MS.—Ill., 1859.

ORR *v.* LITTLEFIELD, 1 Wood. & Min., 13.—N. H., 1845. Referred to, as collecting most of the precedents as to injunctions. *Hovey* v. *Stevens*, 1 Wood. & Min., 304.—Mass., 1846. Approved, as to rules governing issuing of injunctions. *Orr* v. *Merrill*, 1 Wood. & Min., 379.—Me., 1846. Approved, that mere possession of a patent is not alone cause for injunction. *Mitchell* v. *Barclay*, MS.—N. Y., 1860. Approved, as to the principles governing allowance of injunctions. *Hussey* v. *Whiteley*, MS.—Ohio, 1861.

PARKER *v.* CORBIN, 4 McLean, 462.—Ohio, 1848. Criticised, as at variance with *Parker* v. *Hulme*, 7 West. Law Jour., 417.—Pa., 1849; *Parker* v. *Ferguson*, 1 Blatchf.,

407.—N. Y., 1849. *Parker* v. *Sears*, MS. —Pa., 1850.

PARKER *v.* FERGUSON, 1 Blatchf., 407. N. Y., 1849. Criticised, as at variance with *Parker* v. *Hulme*, 7 West., Law Jour., 417.—Pa., 1849; and *Parker* v. *Corbin*, 4 McLean, 462.—Ohio, 1848. *Parker* v. *Sears*, MS.—Pa., 1850.

PARKER *v.* HULME, 7 West. Law Jour., 417.—Pa., 1847. Criticised, as at variance with *Parker* v. *Corbin*, 4 McLean, 462. —Ohio, 1848; and *Parker* v. *Ferguson*, 1 Blatchf., 407.—N. Y., 1849. *Parker* v. *Sears*, MS.—Pa., 1850.

PARKER *v.* BANKER, 6 McLean, 631.—Ohio, 1855. Approved, as to rule of damages laid down in it. *Wintermute* v. *Redington*, MS.—Ohio, 1856.

PARKHURST *v.* KINSMAN, 1 Blatchf., 488. —N. Y., 1849. Approved, that a change in the form of a machine is not invention. *Wilbur* v. *Beecher*, 2 Blatchf., 141, 142.—N. Y., 1850. Affirmed by Supreme Court. *Kinsman* v. *Parkhurst*, 18 How., 289.—Sup. Ct., 1855. Approved, that imperfect experiments will not stand in the way of a subsequent original inventor. *Potter* v. *Wilson*, MS.—N. Y., 1860.

PARSONS *v.* BARNARD, 7 John., 144.—N. Y., 1810. Approved, that the Federal courts have exclusive cognizance of suits for infringements of patents. *Livingston* v. *Van Ingen*, 9 John., 582.—N. Y., 1812. *Gibson* v. *Woodworth*, 8 Paige, 134.—N. Y., 1840. *Smith* v. *Mercer*, 4 West. Law Jour., 53.—Pa., 1846.

PARTRIDGE *v.* MENCK, 2 Sand. Ch., 622. —N. Y., 1846. Affirmed, that an injunction to restrain the use of a trade-mark will not be granted, when the imitation is not such as to deceive a purchaser using ordinary attention. *Partridge* v. *Menck*, 2 Barb. Ch., 101.—N. Y., 1847. Approved, that the question upon the violation of a trade-mark is not whether the party is the inventor of the thing sold, but depends upon the fact of appropriation and use. *Fetridge* v. *Merchant*, 4 Abb. Pr., 160.—N. Y., 1857.

PARTRIDGE *v.* MENCK, How., App. Cas., 547.—N. Y., 1848. Approved, that a party using a trade-mark, though the purchaser of it, to palm off upon the public an article made by himself as made by another, is guilty of a fraud, and cannot be protected in the use of such mark. *Fetridge* v. *Merchant*, 4 Abb. Pr., 157.—N. Y., 1857. *Fetridge* v. *Wells*, 4 Abb. Pr., 155.—N. Y., 1857. *Hobbs* v. *Francais*, 19 How. Pr., 570.—N. Y., 1860.

PENNOCK *v.* DIALOGUE, 4 Wash., 538. —Pa., 1825. Affirmed, that an inventor cannot have a valid patent, if he permits his invention to go into public use before application for a patent. *Pennock* v. *Dialogue*, 2 Pet., 19, 24.—Sup. Ct., 1829.

PENNOCK *v.* DIALOGUE 2 Pet., 1.—Sup. Ct., 1829. Approved, that the words "known and used," in the act of 1793 refer to the *application* for a patent. *Whitney* v. *Emmett*, Bald., 309.—Pa., 1831. Approved, that under the act of 1793, if an inventor makes his discovery public before application for a patent, he abandons his inchoate right to his exclusive right. *Grant* v. *Raymond*, 6 Pet., 248.—Sup. Ct., 1832. *Shaw* v. *Cooper*, 7 Pet., 318.—Sup. Ct., 1833. Approved, that the words "not known or used before the application" in § 1, act of 1793, mean not known or used by the public before the application. *Reed* v. *Cutter*, 1 Story, 598, 599.—Mass., 1841. Approved, that the use of an invention before application for a patent, with approbation of the inventor, renders void a patent. *Cooper* v. *Matthews*, 8 Law Rep., 420.—Pa., 1842, and that such use without objection is an abandonment. *McClurg* v. *Kingsland*, 1 How., 207.—Sup. Ct., 1843. Referred to as

CASES AFFIRMED, CRITICISED, ETC.

a leading case upon question of abrogation or relinquishment of patent privileges, resulting from avowed intention, abandonment, or use known and assented to. *Kendall* v. *Winsor*, 21 How., 329.—Sup. Ct., 1858. Approved, as to the doctrine laid down as to the prior use of an invention, before application for a patent, with the knowledge of the inventor, which will make void a patent. *Adams* v. *Jones*, MS., GRIER, J.—Pa., 1859. Approved, as to effect of negligence in obtaining a patent, upon the right to a patent. *Loveridge* v. *Dutcher*, MS.—D. C., 1861.

PHIL. & TREN. R. R. *v.* STIMPSON, 14 Pet., 448.—Sup. Ct., 1840. Approved, that a patent is sufficient evidence that all preliminary steps required to obtain it have been taken. *Emerson* v. *Hogg*, 2 Blatchf., 34.—N. Y., 1845.

POMEROY *v.* CONNISON, MS.—D. C., 1841. Affirmed, that a patentee has no right of appeal from a decision of the Commissioner of Patents, allowing a patent to an interfering applicant. *Whipple* v. *Renton*, MS.—D. C., 1854. *Hopkins* v. *Barnum.*—*Ibid.*, 1854. *Kingsley* v. *Herriet.*—*Ibid.*, 1854. *Drake* v. *Cunningham.*—*Ibid.*, 1855. CONTRA, *Babcock* v. *Degener*, —*Ibid.*, 1859. *Spear* v. *Abbott.*—*Ibid.*, 1859. *Beech* v. *Tucker.*—*Ibid.*, 1860.

PROUTY *v.* RUGGLES, 1 Story, 568.—Mass., 1841. Affirmed, that the use of a part of a combination is no infringement. *Prouty* v. *Ruggles*, 16 Pet., 341.—Sup. Ct., 1842.

PROUTY *v.* RUGGLES, 16 Pet., 336.—Sup. Ct., 1842. Examined and criticised, as to construction of patents for combinations. *Many* v. *Sizer*, MS.—Mass. 1849. Approved, that the use of part of a combination is no infringement. *Stimpson* v. *Bal. & Sus. R. R.*, 10 How., 345.—Sup. Ct., 1850. *Singer* v. *Walmsley*, MS.—Md., 1859.

RYAN *v.* GOODWIN, 3 Sumn., 514.—Mass., 1839. Approved, that patents are to be construed liberally. *Brooks* v. *Bicknell*, 3 McLean, 261.—Ohio, 1843. Approved, that the simplicity of an invention is no objection to it. *Smith, Ex parte*, MS.—D. C., 1860.

SANDERS *v.* LOGAN, 3 Wall., Jr., 477.—1861. Approved, that in the case of a wrongful use of a patent, the right to use which has been granted on the payment of a license fee, the proper remedy is by an action at law, and that an injunction is not required or appropriate. *Livingston* v. *Jones*, 3 Wall., Jr.—1861.

SARGEANT *v.* SEAGRAVE, 2 Curt., 553.—R. I., 1855. Approved, as to the *prima facie* right of patentee, founded on an exclusive possession of the thing patented. *Sargeant* v. *Carter*, 11 Mo. Law Rep., 651.—Mass., 1858.

SEYMOUR *v.* MCCORMICK, 16 How., 480.—1853. Commented on and explained, as to the rule of damages laid down therein, and held not to apply to an invention which was a unit in itself, and had a peculiar value in the market. *Livingston* v. *Jones*, 3 Wall., Jr.—Pa., 1861.

SHAW *v.* COOPER, 7 Pet., 292.—Sup. Ct., 1833. Approved, as to power to grant reissues. *Battin* v. *Taggert*, 17 How., 83.—Sup. Ct., 1854. Referred to, as a leading case upon the question of abrogation or relinquishment of patent privileges from abandonment or neglect, or use known or assented to. *Kendall* v. *Winsor*, 21 How., 329.—Sup. Ct., 1858.

SILSBY *v.* FOOTE, 14 How., 218.—Sup. Ct., 1852. Examined and explained, as to the extent of the decision made therein. *Silsby* v. *Foote*, 20 How., 391.—Sup. Ct., 1857.

SIMPSON *v.* WILSON, 4 How., 709.—Sup. Ct., 1845. The question whether Congress can grant, in an extension, rights to

assignees, was not directly raised, but was discussed in this case. *Blanch. Gun-Stock Turning Co.* v. *Warner*, 1 Blatchf., 276. —Ct., 1846.

SMITH *v.* ELY, 5 McLean, 76.—Ohio, 1849. Remanded, as the questions arising therein were virtually decided in *O'Reilly* v. *Morse*, 15 How., 62. *Smith* v. *Ely*, 15 How., 142.—Sup. Ct., 1853.

SPEAR *v.* STUART, MS.—D. C., 1859. Approved, as to doctrine of forfeiture. *Berg* v. *Thistle*, MS.—D. C., 1860. Approved, that the concealment of an invention for more than two years, stands on no better footing than a sale for same period. *Loveridge* v. *Dutcher*, MS.—D. C., 1861.

STIMPSON *v.* WEST CHESTER R. R., 4 How., 380.—Sup. Ct., 1845. Approved, that the action of the government, in renewing a patent, is conclusive except as to fraud. *Brooks* v. *Fiske*, 15 How., 228. —Sup. Ct., 1853. Dis. Opin. Approved, that the use of an invention, under a defective patent, does not prevent the patentee from taking out an amended patent. *Battin* v. *Taggert*, 17 How., 84.—Sup. Ct., 1854.

STOKES *v.* LANDGRAFF, 17 Barb. S. C., 608.—N. Y., 1853. Approved, that no property can be acquired in words, marks, or devices, which denote only the nature, kind, or quality of the articles to which affixed. *Wolfe* v. *Goulard*, 18 How. Pr., 68.—N. Y., 1859.

STURTEVANT *v.* GREENOUGH, MS.—D. C., 1860. Approved, as to doctrine of forfeiture. *Berg* v. *Thistle*, MS.—D. C., 1860.

SULLIVAN *v.* REDFIELD, 1 Paine, 441, —N. Y., 1825. Approved, as to rules and principles governing allowance of injunctions. *Thomas* v. *Weeks*, 2 Paine, 97. —N. Y., 1827.

TATHAM *v.* LE ROY, MS.—N. Y., 1849. Held that the claim in plaintiff's patent was for the combination of machinery described; and that the question, whether the newly discovered property of lead, of welding after being separated, was patentable, was not in this case. *Le Roy* v. *Tatham*, 14 How., 175.—Sup. Ct., 1852.

TAYLOR *v.* CARPENTER, 11 Paige, 293. —N. Y., 1844. Approved, that a Court of Equity will protect a person in the possession and use of his trade-mark. *Taylor* v. *Carpenter*, 2 Sand. Ch., 612, 613.—(Ct. Errors), N. Y., 1846. Also, that aliens are entitled to like protection in that respect, as citizens. *Ibid.*, 610.

TAYLOR *v.* CARPENTER, 3 Story, 458.—Mass., 1844. Defectively reported in 7 Mo. Law Rep., 437. *Coats* v. *Holbrook*, 2 Sand. Ch., 596.—N. Y., 1845. Approved, that aliens are entitled to protection, as to trade-marks, the same as citizens. *Taylor* v. *Carpenter*, 2 Wood. & Min., 10.—Mass., 1846. *Coffeen* v. *Brunton*, 4 McLean, 520.—Ind., 1849.

TROY IRON & NAIL FAC. *v.* CORNING, 1 Blatchf., 467.—N. Y., 1849. Reversed, on the ground of a misconstruction of the agreement, as to which the action was brought, and the nature of the rights under it. *Troy Iron & Nail Fac.* v. *Corning*, 14 How., 193.—Sup. Ct., 1852.

TYLER *v.* TUEL, 6 Cra., 324.—Sup. Ct., 1810. Criticised, as to right of assignees of a patent, to maintain an action for infringement, and distinguished from the case under consideration. *Whittemore* v. *Cutter*, 1 Gall., 431.—Mass., 1813.

VAN HOOK *v.* SCUDDER, MS.—N. Y. 1843. Approved, as to right of an administrator to take an extension of a patent *Brooks* v. *Bicknell*, 3 McLean, 438.—Ohio, 1844. Also 3 Story, 132.

VAN OSTRAND *v.* REED, 1 Wend., 424. —N. Y., 1828. Approved, that a note given for the purchase of a patent, which is useless, is without consideration. *Jolliffe* v. *Collins*, 21 Mo., 341.—Mo., 1855.

CASES AFFIRMED, CRITICISED, ETC.

WASHBURN *v.* GOULD, 3 Story, 122.—Mass., 1844. Approved, that a specification need not contain written references to the drawings, but it will suffice if such references are on the drawings themselves. *Emerson* v. *Hogg*, 2 Blatchf., 10.—N. Y., 1845. Rule in, as to the comity of courts in conforming to the decisions of sister tribunals, commented on, and held not to apply to proceedings for injunctions. *Many* v. *Sizer*, MS.—Mass., 1849.

WATSON *v.* BLADEN, 4 Wash., 580.—Pa., 1826. Sustained, that there can be no unauthorized use of a patent-right without damage. *Byam* v. *Bullard*, 1 Curt., 104.—Mass., 1852.

WETMORE *v.* SCOVILLE, 3 Edw. Ch., 515.—N. Y., 1842. Approved, that a court will not restrain the publication of private letters, where they possess no attribute of a literary composition. *Hoyt* v. *McKenzie*, 3 Barb. Ch., 325.—N. Y., 1848. Examined, and criticised, and held, that the decision therein, as also that in *Hoyt* v. *McKenzie*, that the publication of private letters will not be restrained, unless they possessed the character of *literary* compositions, was a departure from established law, and not a binding authority. *Woolsey* v. *Judd*, 4 Duer, 389, 406.—N. Y., 1855.

WHEATON *v.* PETERS, 8 Pet., 591.—Sup. Ct., 1834. Criticised as to the extent of copyright in reports, and how far one person is at liberty to extract the substance of such reports, or publish select cases therefrom, with notes. *Gray* v. *Russell*, 1 Story, 20.—Mass., 1839. Held, that the principle of this case is, that under the copyright laws, a title is not perfected without a strict compliance with the provisions of the statute. *Baker* v. *Taylor*, 2 Blatchf., 84.—N. Y., 1848.

WHITTEMORE *v.* CUTTER, 1 Gall., 429, 478.—Mass., 1813. Approved, that the making a machine, to be an offence, must be with intent to use it for profit, and not for philosophical experiment. *Sawin* v. *Guild*, 1 Gall., 487.—Mass., 1813. Overruled, that counsel fees cannot be allowed as a part of the damages in an action for the infringement of a patent. *Boston Manuf. Co.* v. *Fiske*, 2 Mas., 122.—Mass. 1820. Criticised, as to rule of damages. *Whitney* v. *Emmett*, Bald., 327.—Pa. 1831. Examined, as to use of an invention, which will defeat a patent. *Shaw* v. *Cooper*, 7 Pet., 317.—Sup. Ct., 1833. Approved, that a patent is insusceptible of local subdivision. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 339.—Pa., 1849. Questioned, whether there can be any making of a patented machine without damage. *Byam* v. *Bullard*, 1 Curt., 104.—Mass., 1852.

WICKERSHAM *v.* SINGER, MS.—D. C., 1859. Approved, as to the effect of a withdrawal of an application for a patent, on question of abandonment. *Dederick, Ex parte*, MS.—D. C., 1860. *Raymond, L., Ex parte*, MS.—D. C., 1861.

WILDER *v.* GAYLER, 1 Blatchf., 597.—N. Y., 1850. Criticised and disproved, in so far as it holds that a defendant in a patent suit must plead the general issue with notice, and cannot set up his defence by special pleas. *Day* v. *N. E. Car-Spring Co.*, 3 Blatchf., 181.—N. Y., 1854.

WILSON *v.* BARNUM, 1 Wall., Jr., 342.-Pa., 1849. Remanded, because question certified was one of fact, when only questions of law can be certified. *Wilson* v. *Barnum*, 8 How., 262.—Sup. Ct., 1849.

WILSON *v.* ROSSEAU, 4 How., 646.—Sup. Ct., 1845. Approved, that an extended patent may be reissued. *Gibson* v. *Harris*, 1 Blatchf., 169.—N. Y., 1846. Examined, as to validity of Woodworth's patent. *Van Hook* v. *Pendleton*, 1 Blatchf., 194.—N. Y., 1846. Approved, that an ad

ministrator may take out the renewal of a patent; and that an "acting Commissioner" may issue a patent. *Woodworth* v. *Hall*, 1 Wood. & Min., 254, 397.—Mass., 1846. Considered a leading decision as to rights of assignees under a renewed patent. *Woodworth* v. *Curtis*, 2 Wood. & Min., 528.—Mass., 1847. And approved in respect thereto. *Gibson* v. *Gifford*, 1 Blatchf., 531.—N. Y., 1850. *Woodworth* v. *Cook*, 2 *Ibid.*, 161.—N. Y., 1850. *Bloomer* v. *McQuewan*, 14 How., 549.—Sup. Ct., 1852. Explained, as to the opinions of the dissenting judges, on page 487, *et seq.* *Phelps* v. *Comstock*, 4 McLean, 355.—Ind., 1848. Criticised and held, that the question whether Congress can grant, in an extension, rights to assignees, was not directly raised in the case, but was discussed. *Blanch. Gun-Stock Turn. Co.* v. *Warren*, 1 Blatchf., 276.—Ct., 1848. Approved, as to right to renew or repair a patented machine when worn out. *Wilson* v. *Simpson*, 9 How., 129.—Sup. Ct., 1849. Decision in this case made under the act of 1836, and has no application to extensions under special acts. *Bloomer* v. *Stolley*, 5 McLean, 163.—Ohio, 1850. Considered as sustaining the position, that an inventor may sell his right in an extended patent. *Clum* v. *Brewer*, 2 Curt., 520.—Mass., 1855. Criticised, as to apparent decision therein, that under the act of 1836 the right of assignees in the original patent is limited, under an extension, to the use of the machines in use at the time the extension took place, and held, that such precise question did not arise in the case, and was not necessarily decided in it. *Day* v. *Union Rub. Co.*, 3 Blatchf., 498.—N. Y., 1856. Examined, as to the construction given to the term "renewal." *Potter* v. *Holland*, MS. —Ingersoll, J.; 1858.

Wilson *v.* Sandford, 10 How., 99.—Sup. Ct., 1850. Approved, that contracts as to patented machines are regulated by state laws, not by those of the United States. *Bloomer* v. *McQuewan*, 14 How., 550.—Sup. Ct., 1852. Approved, that a patent, signed by an "acting Commissioner," is good. *York & Maryl. R. R.* v. *Winans*, 17 How., 41.—Sup. Ct., 1854.

Wilson *v.* Simpson, 9 How., 109.—Sup. Ct., 1849. Referred to, as involving the points that an action to restrain the unlawful use of a machine may be instituted in the district where the owner is, except when necessary to proceed against the machine itself, when it should be brought where the machine is located. *Wilson* v. *Sherman*, 1 Blatchf., 541.—N. Y., 1850. Examined, as to the apparent decision, that the right of assignees of an original patent is limited, under a renewal thereof, to the use of the particular machines in use at the time the extended term commenced; and held that such precise question did not necessarily arise in the case. *Day* v. *Union Rub. Co.*, 3 Blatchf., 493.—N. Y., 1856.

Wilson *v.* Turner, 7 Law Rep., 527.—Md., 1845. Affirmed. *Wilson* v. *Turner*, 4 How., 712.—Sup. Ct., 1845.

Winans *v.* Boston & Prov. R. R., 2 Story, 412.—Mass., 1843. Explained, as to the position that a new application is not entitled to a patent. *Hotchkiss* v. *Greenwood*, 11 How., 270., Dis. Opin.—Sup. Ct., 1850.

Winans *v.* Denmead, 15 How., 330.—Sup. Ct., 1855. Approved, and held not to conflict with *O'Reilly* v. *Morse*, 15 How., 62; and *Corning* v. *Burden*, 15 How., 268.—Sup. Ct., 1853. *Singer* v. *Walmsley*, MS.—Md., 1859. Reconciled with *McCormick* v. *Talcott*, 20 How., 402,—1857, as to the right of an original inventor to invoke the doctrine of equivalents. *Ibid.*

Woodworth *v.* Rogers, 3 Wood. & Min.,

135.—Mass., 1847. Approved, as to the principles governing motions for a dissolution of an injunction. *Hussey* v. *Whiteley*, MS.—Ohio, 1861.

Woodworth *v.* Stone, 3 Story, 749.—Mass., 1845. Approved, that the action of the Commissioner in accepting the surrender of a patent and reissuing a new one, is conclusive, unless fraud be shown. *Brooks* v. *Fiske*, 15 How., 228.—Sup. Ct., 1853. Approved, that the action of an "acting Commissioner" will be presumed valid. *Smith* v. *Mercer*, 4 West. Law Jour., 53.—Pa., 1846. Approved, that a patentee cannot, by a surrender of his letters patent, affect the rights of third persons, to whom he had previously conveyed interests, without their consent. *Potter* v. *Holland*, MS.—Ct., 1858.

Woodworth *v.* Wilson, 4 How., 712.—Sup. Ct., 1845. Approved, that an administrator, to whom a renewed patent has been issued, need not produce his letters of administration in any suit he may institute. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—Mass., 1846. Explained, that the question whether Congress can grant in an extension rights to assignees, was not directly raised in this case, but was discussed. *Blanch. Gun-Stock Turning Co.* v. *Warner*, 1 Blatchf., 276.—Ct., 1846.

Wyeth *v.* Stone, 1 Story, 273.—Mass., 1840. Approved, that a patent may cover a combination, and also include a right to each distinct improvement. *Pitts* v. *Whitman*, 2 Story, 621.—Mass., 1843. Examined, and explained as to above position. *Emerson* v. *Hogg*, 2 Blatchf., 8.—N. Y., 1845. *Hogg* v. *Emerson*, 6 How., 483.—1847. Approved, as to same position. *Hogg* v. *Emerson*, 11 How., 605, 606.—1850.

# DIGEST.

## ABANDONMENT.


**A.** Of Copyright or Manuscript..... 91
**B.** Of Invention.
1. *Before Patent granted*..... 92
2. *After Patent granted*..... 95
3. *Defence of; who to decide*..... 96
4. *Proof of*..... 97
**C.** Of Trade-Marks..... 97


### A. Of Copyright or Manuscript.

1. The deposit, by the author, of his work in a public office, as a chart in the Navy Department, does not make such chart a public document which any one may copy. *Blunt* v. *Patten*, 2 Paine, 396.—Thompson, J.; N. Y., 1828.

2. The use of a manuscript, by the author, for the purpose of instruction, is not an abandonment of it to the public. *Bartlett* v. *Crittenden*, 4 McLean, 303. —McLean, J.; Ohio, 1847.

3. Nor does he abandon his right in it by permitting his pupils or friends to take copies thereof. *Ibid.*, 303, 304.

4. The publication of a work without having secured a copyright is a dedication of it to the public; that having been done, any one may republish it. *Bartlett* v. *Crittenden*, 5 McLean, 37. —McLean, J.; Ohio, 1849.

5. The right of property in a manuscript may be transferred or abandoned, the same as any other right of property. *Ibid.*, 41.

6. An acquiescence in the publication of a manuscript, or in the republication of a printed book, authorizes a presumption of assignment or abandonment. *Ibid.*, 41.

7. But a gift of a copy of a manuscript is not a transfer of the right, or an abandonment of it, any more than the gift of a copy of a printed book is a transfer or abandonment of the exclusive right to republish it. *Ibid.*, 41.

8. An author may license the publication of his manuscript. But unless a copyright is secured, the first publication of it will abandon it to the public. *Pulte* v. *Derby*, 5 McLean, 332.—McLean, J.; Ohio, 1852.

9. The publication of an official report, under the direction of Congress, and for the benefit of the public, is a dedication of it, and of what is contained in it, to the public, and any one may reprint it. *Heine* v. *Appletons*, 4 Blatchf., 128.—Ingersoll, J.; N. Y., 1857.

10. Where sketches and drawings were made for the government, and incorporated in such a report, *Held*, that

the artist could have no copyright in them, but that any person could use them. *Ibid*, 128.

11. As regards private letters, the right of publication, as one of literary property, remains for a reasonable length of time (to allow its assertion by publication), in the writer and his personal representatives. After such a period has elapsed, that there ceased to be a probability that such right to publish was treated as a legal right, any one may publish who can obtain copies. *Eyre* v. *Higbee*, 22 How. Pr., 207.—GOULD, J.; N. Y., 1861.

## B. OF INVENTION.

### 1. *Before Patent granted.*

As to what delay in applying for a patent will take away a right thereto, see APPLICATION FOR PATENT, A.

As to what use before application will amount to an abandonment, see PRIOR USE.

1. If an inventor suffers his invention to be used freely and fully by the public, he will be deemed to have made a gift of it to the public, as much as a person who voluntarily opens his land as a highway. *Whittemore* v. *Cutter*, 1 Gall., 482.—STORY, J.; Mass., 1813.

2. If an original inventor do not choose to obtain a patent for his invention, it becomes public property by his abandonment of it. He can maintain no action against any person for using it, nor can any other person obtain a patent for it. *Evans* v. *Eaton*, Pet. C. C., 348, 349.—WASHINGTON, J.; Pa., 1816.

3. No man is to be permitted to lie by for years, and then take out a patent. If he has been practising his invention with a view to improve it, that will not prejudice; but it should always be a question for the jury, what was the intent of the delay of the patent, 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, 354.—THOMPSON, J.; N. Y., 1824.

4. If an inventor dedicates his invention to the public, he cannot afterward resume it, or claim an exclusive right in it. It is like the dedication of a public highway, or other public easement. *Mellus* v. *Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825.

5. His acts are, however, to be construed liberally; that is, he is not estopped 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. *Ibid.*, 111.

6. If the inventor proclaim his intention to all the world, and suffer his invention to go into general and public use, without objection; if he assert no exclusive right for years, with a full knowledge that the public are led by it to a general use, such conduct amounts to strong proof that he waives the exclusive right, and dedicates the invention to the world. *Ibid.*, 111.

7. If an inventor makes his discovery public, looks on, and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for before such use; and it

makes no difference that the article so publicly used and afterward patented was made by a particular individual, who did so by the private permission of the inventor. *Pennock* v. *Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825. (Affirmed, 1829, *post* 10.)

8. Though the inventor may not have intended to give the benefit of his discovery to the public, and may have supposed that by giving permission to a particular individual to manufacture the thing, he could not be presumed to have given his invention to the public, it matters not. It is not a question of intention, but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. *Ibid.*, 544.

9. If before the patent is taken out, the inventor looks on, and sees his invention going into general use, without objection on his part, the court will treat his conduct as equivalent to an abandonment or transfer of his exclusive right to the public. *Treadwell* v. *Bladen*, 4 Wash., 708.—WASHINGTON, J.; Pa., 1827.

10. An inventor may abandon his invention, and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterward be resumed at his pleasure: where gifts are once made to the public in this way they become absolute. *Pennock* v. *Dialogue*, 2 Pet., 16.—STORY, J.; Sup. Ct., 1829.

11. Under the Patent Act of 1793, the voluntary act or acquiescence of an inventor in the public sale and use of his invention before his application for a patent, is an abandonment of his right to a patent, or rather creates a disability to comply with the terms and conditions on which alone he could receive a patent. *Ibid.*, 24.

12. No matter by what means an invention may be communicated to the public before a patent is obtained, any acquiescence in the public use, by the inventor, will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor. *Shaw* v. *Cooper*, 7 Pet., 320.—McLEAN, J.; Sup. Ct., 1833.

13. If an individual witness a sale and transfer of property, in which he has an equitable lien or interest, and does not make known his interest, he cannot afterward be permitted to assert it. On this principle it is, that a discoverer abandons his right, if before the obtainment of his patent his discovery goes into public use. But his right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. *Ibid.*, 321.

14. The acquiescence of an inventor, however, 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. And if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use as forever afterward to prevent him from asserting it. *Ibid.*, 321.

15. A strict construction of the act, as it regards the public use of an invention before it is patented, is not only required by its letter and spirit, but also by sound policy. The doctrine of presumed acquiescence, where the public use is known, or might be known to the inventor, is the only safe rule

which can be adopted on this subject. *Ibid.*, 321, 322.

16. The question of abandonment does not turn upon the intention of the inventor. Whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right. *Ibid.*, 323.

17. The inventor, and he alone, is competent to abandon his invention to the public, and no use by the public, except with his knowledge and consent, can be deemed an abandonment of his invention. *Pierson* v. *Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844.

18. Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during his application for a patent, is an abandonment, or such a use as gives it to the public. The inventor may do this without vitiating his claim. *Sparkman* v. *Higgins*, 1 Blatchf., 209.—BETTS, J.; N. Y., 1846.

19. Whether the sale and manufacture for some few months, before the application for a patent, of an article, as an ornamental button, for the design of which letters patent had been granted, and which design was apparent on the article itself, would amount to an abandonment, is a question of fact to be settled by the jury. *Booth* v. *Garelly*, 1 Blatchf., 249, 250.—NELSON, J.; N. Y., 1847.

20. A right to an invention or discovery, like every other right, may be surrendered or dedicated to the public; and such right, when abandoned, cannot be resumed. *McCay* v. *Burr*, 6 Penn., 153.—GIBSON, Ch. J.; Pa., 1847.

21. But a license, restrained to individuals, is not an abandonment. *Ibid.*, 154.

22. Where experiments as to an invention were imperfect and unsatisfactory, and subsequently the inventor threw aside his temporary model, and wholly neglected for years to follow up his experiments, so as to produce a perfect machine, *Held*, that such acts afforded strong and decisive evidence of an abandonment of the thing as a failure. *Parkhurst* v. *Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

23. An inventor may abandon his invention within two years, or at any time before the procurement of the patent. *Pitts* v. *Hall*, 2 Blatchf., 237. —NELSON, J.; N. Y., 1851.

24. The mere use or sale of the invention, however, within the two years, will not alone or of itself work an abandonment. The use or sale must be accompanied by some declarations or acts going to establish an intention on the part of the inventor to give to the public the benefit of the improvement. *Ibid.*, 237.

25. The mere expression of an intention not to take out a patent, or the mere declaration of an intention to dedicate an invention to the public, cannot be regarded as equivalent to an actual dedication. *Ibid.*, 238.

26. Abandonment or dedication is in the nature of a forfeiture of a right, which the law does not favor, and it should be made out beyond all reasonable doubt. *Ibid.*, 238.

27. The question of abandonment must always depend, in a great measure, on the peculiar nature of the subject matter. The mere sale of a peculiar manufacture—as vulcanized rubber—which does not, on its face, disclose the

nature of the compound, or the mode of producing it, is not such an abandonment. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

28. Even under the English laws, the sale in England of manufactured rubber goods imported from abroad, was held not to be an abandonment, or such a use of the thing—as the material itself did not disclose the means of making it—as would invalidate a patent, granted to an original inventor there subsequently to such sale. *Ibid.*

29. The publication of an invention or discovery by a defective specification is not an abandonment.—*Ibid.*

30. If, after an inventor has made an invention, he deliberately abandons it, and dedicates it to the public, no matter for what reason, the dedication cannot be recalled. *Ransom* v. *Mayor*, &c., 1 Fisher, 273.—HALL, J.; N. Y., 1856.

31. An inventor may abandon his invention to the public, either by express declaration or by conduct equally significant with language—such, for instance, as an acquiescence, with full knowledge, in the use of his invention by others. *Kendall* v. *Winsor*, 21 How., 329.—DANIEL, J.; Sup. Ct., 1858.

32. The cases of *Pennock* v. *Dialogue*, 2 Pet., 1; and of *Shaw* v. *Cooper*, 7 Pet., 292; may be regarded as leading cases upon the questions of the abrogation or relinquishment of patent privileges as resulting from avowed intention, from abandonment or neglect, or from use known and assented to. *Ibid.*, 329.

33. If an inventor claims two distinct improvements in a machine, and has made a mistake as to one of the improvements claimed, but is entitled to a patent for the other, he cannot be said to have abandoned either during a litigation as to both. *Adams* v. *Jones*, 1 Fisher, 530.—GRIER, J.; Pa., 1859.

34. The application of the doctrine of abandonment depends upon the circumstances of each case—it implies laches on the part of the original inventor. *Mix* v. *Perkins*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

35. A statement in an original patent that a part is old, or a disclaimer of a part, does not necessarily operate as a dedication of such part to the public, or prevent it being claimed in a reissued patent; though it seems it would have that effect if made advisedly, and not by inadvertence, accident, or mistake. *Laidley* v. *James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

## 2. *After Patent granted.*

1. After an invention has been patented, no disuser of it will amount to an abandonment, so as to deprive the patentee or his assigns of the exclusive right to it for fourteen years. *Gray* v. *James*, Pet. C. C., 403.—WASHINGTON, J.; Pa., 1817.

2. After the right of an inventor is perfected by a patent, no presumption arises against it from a subsequent use by the public. *Shaw* v. *Cooper*, 7 Pet., 321.—MCLEAN, J; Sup. Ct., 1833.

3. After patent obtained, a patentee may abandon or surrender his rights, by overt acts, or express declaration. And if for a series of years he 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 strong presumption of such actual surrender and abandonment. *Wyeth* v. *Stone*, 1 Story, 282.—STORY, J.; Mass., 1840.

4. *A fortiori*, the doctrine will apply to a case, where the patentee has openly encouraged, or silently acquiesced in such use, by the very defendants whom he afterward seeks to prohibit, by injunction, from any further use. *Ibid.*, 282.

5. And it is no answer to such a presumption, that the defendants used the invention in a different branch of trade from that in which the inventor was engaged in using his invention, and that therefore there was no actual interference. *Ibid.*, 283.

6. If a patentee means to surrender his exclusive right in a qualified manner, he should give public notice of the nature and extent of his allowance, so that the public may be on their guard. *Ibid.*, 283.

7. A court of equity will not interfere, in behalf of a patentee, either to grant an injunction, or to give him any relief, in respect to any alleged violation of his patent, if, after having obtained his patent, he has surrendered or dedicated it to the public, or acquiesced for a long period in the public use thereof, without objection—as his own conduct may be considered as having led to such use, or application, or acts of the defendants. *Ibid.*, 282, 284.

8. A citizen patentee cannot lose his right by *non-user*, unless it amounts to evidence of an abandonment of the patent; the question of abandonment is a question of fact for a jury on a trial at law. *Hildreth* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

9. If a patentee neglects, in his specification, to assert his invention as to a certain part, and omits to claim specifically such part, and suffers his patent so to stand for a number of years, he cannot afterward surrender it, and take a reissue, claiming such part, as the use under the former patent, without any claim, will be a dedication thereof to the public. *Batten* v. *Taggert*, 2 Wall.; Jr., 102.—KANE, J.; Pa., 1851. [Overruled, 1854, *post* 10.]

10. The decision of the court below in this case, as to a dedication of an invention by a description of it in the specification of a former patent, unaccompanied by notice that he was right in it, or desires to secure those rights, is erroneous. By the defects mentioned in the statute, and to remedy which a surrender and reissue is permitted, nothing passes to the public from the specifications and claims, within the scope of the patentee's invention. *Batten* v. *Taggert*, 17 How., 83, 84.—McLEAN, J.; Sup. Ct., 1854.

11. A patentee, subsequent to his patent, may abandon his invention to the public, and waive the exclusive privileges secured to him; and the jury may infer such an abandonment from an acquiescence in the use of his invention by others, a neglect to assert his claims by suit or otherwise, an omission to sell licenses, a neglect to make efforts to realize any advantage from his patent, and similar circumstances. *Ransom* v. *Mayor, &c.*, 1 Fisher, 273.—HALL, J.; N. Y., 1856.

12. An inventor may abandon his right to a patent, as well after patent granted as before, but in the former event it would require a strong case to be made out. *Bell* v. *Daniels*, 1 Fisher, 378.—LEAVITT, J.; Ohio, 1858.

### 3. *Defence of; who to decide.*

1. The question of dedication is one for the consideration of the jury. *Whit-*

*temore* v. *Cutter*, 1 Gall., 482.—STORY, J.; Mass., 1813.

2. It should always be a question submitted to the jury, what was the intent of the delay of the patent, 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, 354.—THOMPSON, J.; N. Y., 1824.

3. 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. But when all the facts are given, there does not seem any reason why the court may not state the legal conclusion deducible from them. *Pennock* v. *Dialogue*, 2 Pet., 16.—STORY, J.; Sup. Ct., 1829.

4. If a defendant, in an action for an infringement of a patent, wish to avail himself of the defence of abandonment or acquiescence of the plaintiff in the public use of his invention, he must set forth such defence in his answer, and put it in issue. If the point is not put in issue, any evidence as to it will be irrelevant, and cannot be looked to. *Wyeth* v. *Stone*, 1 Story, 284.—STORY, J.; Mass., 1840.

5. The question of forfeiture or abandonment, is a question of fact for a jury on a trial at law. *Hildreth* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D C., 1841.

6. Under § 7 of the act of 1836, the question of delay or abandonment is not submitted to the jurisdiction of the commissioner of patents in determining as to the issuing of a patent. *Ibid.* [Qualified, 1858, *post* 13.]

7. When an abandonment is relied on, it should be stated in the plea, and the facts on which the pleader relies, as showing an abandonment. *Root* v. *Ball*, 4 McLean, 179.—MCLEAN, J.; Ohio, 1846.

8. Whether the manufacture and sale of an article, as an ornamental button, for the design of which letters patent had been obtained, for some few months before the application for a patent, would amount to an abandonment, is a question of fact to be settled by a jury. *Booth* v. *Garelly*, 1 Blatchf., 249, 250. —NELSON, J.; New York, 1847.

9. If a party wishes to introduce evidence, in an action of abandonment, there must be the proper allegations to that effect, in the pleadings. *Wilson* v. *Stolley*, 4 McLean, 276.—MCLEAN, J.; Ohio, 1847.

10. It is a question for the jury whether an invention has been abandoned to the public. *Batten* v. *Taggert*, 17 How., 85.—MCLEAN, J.; Sup. Ct., 1854.

11. Under the statute, the commissioner has jurisdiction of the question of abandonment, at least when it grows out of a public use or sale with the applicant's consent. *Hunt* v. *Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

12. Whether an inventor has abandoned or surrendered his invention, and whether this is sought to be proved from his declarations or acts, or from a forbearance or neglect to act or speak, is an inquiry or conclusion of *fact* for the jury to decide. *Kendall* v. *Winsor*, 21 How., 331.—DANIEL, J.; Sup. Ct., 1858.

13. The question of abandonment, referred to in *Hildreth* v. *Heath*, and in *Pomeroy* v. *Connison*, and which it was held was not within the jurisdic

tion of the commissioner, in deciding as to the issuing of a patent, is that of delay or general abandonment, and which intention and special circumstances constitute. *Mowry* v. *Barber*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

14. But as to the abandonment or statutory disability of an applicant to assert his right to a patent, because of a public use or sale by others, with his knowledge and consent, of the invented machine, for more than two years before application for a patent, the commissioner has jurisdiction. *Ibid.*

15. Same position held in *Ellithorpe* v. *Robertson*, MORSELL, J., 1858; in *Wickersham* v. *Singer*, MERRICK, J., 1859; in *Spear* v. *Stuart*, DUNLOP, J., 1859; and in *Sturtevant* v. *Greenough*, MERRICK, J., 1860.

16. The jurisdiction of the commissioner of patents over the question of abandonment, is clear under section 7, act of 1839, without resort to section 8, act of 1836. *Wickersham* v. *Singer*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

17. The question of abandonment, in a suit for an infringement, is a question of fact for a jury, but on an *application* to the commissioner for the issue of a patent, it is his duty to decide all questions, both of law and fact, which go to establish the right, or the *absence of right*, in the applicant to a patent. *Marcy* v. *Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

4. *Proof of.*

See EVIDENCE, H. 1.

### C. OF TRADE-MARKS.

The acquiescence of a manufacturer to the use or imitation of his trade mark may be inferred from his knowledge and silence; but such consent, whether express or implied, may be withdrawn; it is no more than a revocable license. *Amoskeag Manuf. Co.*, v. *Spear*, 2 Sand., S. C., 615.—DUER, J.; N. Y., 1849.

The neglect of a party to carry on his business under its well-known name, for a number of years, does not prevent him from resuming the same, or entitle another to use the name of his business. *Howe* v. *Searing*, 19 How. Pr., 25.—HOFFMAN, J.; N. Y., 1860.

Though a trade-mark may have been used previously, if its use has been so long discontinued as to justify the inference that it had been abandoned, it may be taken up by another dealing in the same article, whose right will be protected if used exclusively by him, and long enough to be recognized as the indicia of his ownership. *Corwin* v. *Daly*, Upton on Trade-Marks, 190.—ROBERTSON, J.; N. Y., 1860.

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## ABRIDGMENT OF BOOK.

1. The question as to an abridgment is made up of various considerations; whether it is a *bona fide* abridgment, or only an evasion by the omission of unimportant parts; whether it will prejudice or supersede the original; whether it will be adapted to the same class of readers, &c. *Gray* v. *Russell*, 1 Story, 19.—STORY, J.; Mass., 1839.

2. The doctrine that an abridgment is not a piracy of the original copyright must be received with many qualifications. *Ibid.*, 19, 20.

3. A fair and *bona fide* abridgment of an original work is not a piracy of the copyright; but what constitutes a fair and *bona fide* abridgment, is one of the most difficult points, under particular circumstances, that can arise. *Folsom* v. *Marsh*, 2 Story, 106, 107.—STORY, J.; Mass., 1841.

4. A mere selection, or different arrangement of parts of the original work, so as to bring the work into a smaller compass, is not such an abridgment. There must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon. *Ibid.*, 107.

5. If the leading design is truly to abridge a work and cheapen the price, and that by mental labor is faithfully done, it is no ground for a prosecution by the owner of a copyright of the principal work. But it is otherwise if the abridgment or similar work be colorable or a mere substitute. *Webb* v. *Powers*, 2 Wood. & Min., 520.—WOODBURY, J.; Mass., 1847.

6. An abridgment should contain an epitome of the work abridged—the principles in a condensed form, of the original book. *Story's Exrs.* v. *Holcombe*, 4 McLean, 308.—CURIAM, Ohio, 1847.

7. A mere selection, or different arrangement of the parts of the original work, so as to bring it into a smaller compass, is not an abridgment. There must be real, substantial condensation, of the materials, and intellectual labor and judgment bestowed thereon, and not merely the facile use of the scissors, or extracts of the essential parts, constituting the chief value of the original work. *Ibid.*, 311.

8. A fair abridgment of any book is considered a new work, as to write it requires labor and exercise of judgment. It is only new, however, in the sense that the view of the author is given in a condensed form. *Ibid.*, 311.

9. Such a work must not only contain the arrangement of the book abridged, but the ideas must be taken from its pages. It must be in good faith an abridgment, not a treatise interlarded with citations. *Ibid.*, 311.

10. To copy certain passages from a book, omitting others, is in no just sense an abridgment. The judgment is not exercised in condensing the views of the author. This language is copied, not condensed. *Ibid.*, 311.

11. To abridge is to preserve the substance, the essence of the work, in language suited to such purpose; it requires the exercise of the mind; it is not copying. To compile is to copy from various authors into one work. *Ibid.*, 311, 313.

12. Such a work entitles the compiler, under the statute, to a right of property; which right may be compared to that of a patentee, who, by a combination of known mechanical structures, has produced a new result. *Ibid.*, 314.

13. Between a compilation and an abridgment there is a clear distinction. A compilation consists of selected extracts from different authors; an abridgment is a condensation of the views of the author. *Ibid.*, 314.

14. The former cannot be so extended as to convey the same knowledge as the original work; the latter contains an epitome of the work abridged, and consequently conveys substantially the same knowledge. The former cannot adopt the arrangement of the work cited; the latter must adopt the arrangement of the work abridged. *Ibid.*, 314.

15. The former infringes the copyright, if the matter transcribed, when published, shall impair the value of the original book; a fair abridgment, though it may injure the original, is lawful. *Ibid.*, 314.

16. The abridgment of a work, for which a copyright has been secured, and which has been publicly circulated, is not an infringement of the statutory privilege; but such an abridgment would violate the right of the literary proprietor of a book of which the circulation had been private only. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 82.—CADWALLADER, J.; Pa., 1860.

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## ACCOUNT OF PROFITS.

See also DAMAGES.

1. If there is a reasonable doubt as to the plaintiff's right, or the validity of the patent, he may first be required to substantiate his right in a court at law, before he can have his remedy for an account. *Ogle* v. *Ege*, 4 Wash., 585.—WASHINGTON, J.; Pa., 1826.

2. Equity will decree a perpetual injunction to restrain the use of another's trade-mark, and will decree an account as to damages, with the costs of suit. *Coats* v. *Holbrook*, 2 Sand. Ch., 595, 596.—SANDFORD, V. Ch.; Ct. Chy., N. Y., 1845.

3. On an injunction bill filed for an infringement of a patent, where there is no dispute as to title, the courts of the United States have power under § 17 of the act of 1836, to refer the case to a master, to take and state an account of the profits which the defendant has made, instead of sending it to a court at law to assess the damages, *Allen* v. *Blunt*, 1 Blatchf., 486, 487.—NELSON, J.; N. Y., 1849.

4. The defendant is regarded as having been in the use and enjoyment of the property of the patentee, and as being bound in equity to account for the profits. *Ibid.*, 487.

5. An owner of an undivided interest in a patent made an agreement with the patentee as to their becoming jointly interested in the manufacture of the patented article, and sharing the profits of such manufacture according to their respective interests; and such agreement was made with a knowledge of the alleged claims of a third person as being the first inventor of the thing patented. To a suit for an injunction, and an account brought by the patentee against such joint owner, *Held*, it was no defence that the patentee was not the first and original inventor, but that such third person was such inventor. *Parkhurst* v. *Kinsman*, 1 Blatchf., 495.—NELSON, J.; New York, 1849. [Affirmed *post* 17.]

6. An order in a suit in equity, requiring the defendant to file a monthly account, on oath, of all "iron safes hereafter manufactured or sold by him," will be sufficiently complied with, by giving their inside dimensions, without stating the prices at which sold, or the names of the purchasers. *Wilder* v. *Gayler*, 1 Blatchf., 511.—NELSON, J.; New York, 1849.

7. A knowledge of the names is not essential to the ascertainment of the manufacture and sale of the article, or of the profits arising therefrom. *Ibid.*, 512.

8. It is sufficient to describe the articles in the account, so that persons in the trade can determine the value or

price of them in the market, with a view to the amount of profits. *Ibid.*, 512.

9. Where an infringement is clear, and the right to an injunction manifest, an injunction will not be stayed, on the defendants' giving security, and rendering a periodical account of their sales, even though the defendant is a person of pecuniary responsibility. *Tracy* v. *Torrey*, 2 Blatchf., 279.—NELSON, J.; N. Y., 1851.

10. A suit demanding a discovery of the extent of an infringement of a patent, and an account of the profits realized therefrom, is a case arising under the patent laws, as well as where an injunction is asked for. *Nevins* v. *Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

11. Accordingly, where the plaintiff's patent had expired, and a bill in equity filed by him alleged an infringement of the patent, and prayed for a discovery and an account, but not for an injunction, *Held*, on a demurrer to the bill, that the court had jurisdiction of such a suit. *Ibid.* 83.

12. In a bill filed for an injunction, and for an account of profits which had accrued to the defendant from the use of the machines, which were an infringement upon the plaintiff's patent, the defendant is accountable for such profits as he has actually made, and not for such as "with due diligence and prudence" might have been made. *Livingston* v. *Woodworth*, 15 How., 559; —DANIEL, J.; Sup. Ct., 1853.

13. An account of profits may be decreed to the owner of a copyright, as incidental to an injunction, but it must be prayed for; but it cannot include penalties. *Stevens* v. *Cady*, 2 Curt., 200, 201.—CURTIS, J.; R. I., 1854.

14. An account for profits, may be ordered under the prayer for general relief. *Stevens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

15. The right to an account for profits is incidental to the right to an injunction in copy and patent right cases. *Ibid.*, 455.

16. A decree for an account cannot be had against a workman, as he has nothing to do with the profits. *Sargeant* v. *Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

17. An agreement made with a patentee to manufacture his patented machines upon certain conditions, and making and selling of such machines under the patentee's title, estops such party, in an action for account brought by the patentee, from alleging the invalidity of the patent. *Kinsman* v. *Parkhurst*, 18 How., 293.—CURTIS, J.; Sup. Ct., 1855.

18. And even if the patent was invalid, it would not have rendered the sales of the machines illegal, so as to release such party from the obligation to account. *Ibid.*, 293.

19. And if such an agreement was void, as against public policy, it would furnish no answer to a claim for an account of profits realized from the business. *Ibid.*, 294.

20. In the American courts, in patent cases, a decree for an account may be made, when an injunction will not be granted. *Sickles* v. *Glou. Manuf. Co.*, 1 Fisher, 225.—GRIER, J.; N. J., 1856.

21. Whenever the subject matter cannot be as well investigated in an action for money had and received, or *indebitatus assumpsit*, a court of equity exercises a sound discretion in decreeing an account. *Ibid.*, 224.

22. Commissions received from the sales of a printed copyright are profits

which must be accounted for by the party selling on commission, on a bill by the proprietor of the copyright. *Stevens* v. *Gladäing*, 2 Curt., 608–610.—CURTIS, J.; R. I., 1856.

23. It is common in case of a bill filed for an infringement and motion made for a preliminary injunction, where the question of infringement is not manifest, and enjoining the defendant would produce serious hardship and inconvenience of his business, to withhold the injunction on the defendant's keeping an account, or giving security for damages accruing. *Tatham* v. *Lowber*, 4 Blatchf., 87.—NELSON, J.; N. Y., 1857.

24. An account of profits need not be limited to the time of the commencement of the suit. The practice is to take the account down to the time of the hearing before the master, if the infringement continues to that period, thereby preventing the necessity of expense of a new suit. *Ibid.*, 86.

25. And such account may be so continued though some of the defendants may have ceased to become liable; but in such case their liability should be properly apportioned in making up the decree, and none should be entered for accruing profits against any one after his liability ceased. *Ibid.*, 87.

26. An account may be ordered and other relief granted, though for any reason, as the expiration of the patent, an injunction to restrain its infringement cannot issue. *Imlay* v. *Nor. & Wor. R. R. Co.*, 4 Blatchf., 229.—INGERSOLL, J.; Ct., 1858.

27. Where a patentee has been accustomed to grant licenses to use his invention on the payment of a certain fee, his appropriate remedy for the use of such invention without authority is an action at law; an account is not wanted. *Livingston* v. *Jones*, 2 Fisher, 210.—GRIER, J.; Pa., 1861.

28. An account cannot be required unless where a knowledge of the profits made by the infringer is necessary to a just determination of the controversy. *Ibid.*, 210.

29. Wherever a defendant presents a case showing in fact a *bona fide* issue of law, or a *prima facie* right to continue his manufacture, a preliminary injunction will not be granted, but he may be required to keep an account. *Goodyear* v. *Dunbar*, 1 Fisher, 474.—GRIER, J.; N. J., 1861.

30. Where a defendant was manufacturing under a patent, which was claimed to be an infringement of another and an older patent, the court refused to grant a preliminary injunction, but ordered the defendant to keep an account of all goods manufactured and sold by him. *Ibid.*, 474.

For form of a decree ordering a reference to a master to take and state an account, see *Parkhurst* v. *Kinsman*, 1 Blatchf., 498. (Note.)

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## ACTIONS.

**A.** IN RESPECT TO COPYRIGHTS AND MANUSCRIPTS ..... 103

**B.** IN RESPECT TO PATENTS.

1. *Right of action and principles governing* ..... 104
2. *Where to be brought and how commenced* ..... 108
3. *Parties to*..... 110
   - *a.* Plaintiffs..... 110
   - *b.* Defendants..... 113
4. *Discontinuance of, by whom*.... 115
5. *Defences to*..... 115
6. *Pleadings in*..... 115

**C.** IN RESPECT TO TRADE-MARKS..... 115

## A. Actions respecting Copyrights and Manuscripts, and Defences to.

See also Courts, A.; Equity, A.; Infringement, A.; Injunction, A.

1. At common law the author of a manuscript may obtain redress against any one who deprives him of it, or endeavors to realize a profit from its publication. *Wheaton* v. *Peters*, 8 Pet., 657.—McLean, J.; Sup. Ct., 1834.

2. Where a wrong has been committed in respect to a literary work, but the bill does not ask an injunction to protect the common law rights of the author, or the violation of any copyright secured, but only asks an account, redress cannot be sought in a court of equity, but the party must proceed at law for damages. *Monk* v. *Harper*, 3 Edw. Ch., 110, 111.—McCoun, V. Ch.; N. Y., 1837.

3. It is of no consequence in what form the works of another are used, whether it be a simple reprint, or by incorporating in some other work. If his copyright is violated, he can maintain an action therefor. *Gray* v. *Russell*, 1 Story, 19.—Story, J.; Mass., 1839.

4. To entitle a party to an action for the infringement of a copyright, it is not necessary that the whole, or a greater part of his work should be taken. If so much is taken as to impair the value of the original, or so that the labors of the original author are substantially appropriated, an action will lie. *Folsom* v. *Marsh*, 2 Story, 115.—Story, J.; Mass., 1841.

5. The entirety of the copyright is the property of the author; and it is no defence that another has appropriated only a part of such property and not the whole. *Ibid.*, 116.

6. If a copyright has been invaded, whether the party knew the work was copyrighted or not, he is liable to the penalty for violation. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—Betts, J.; N. Y., 1843.

7. A defendant may show that the work copyrighted was not original with the author, or that it was an abreviation or alteration, and the jury can decide whether it was calculated to deceive. *Ibid.*, 240.

8. An *action on the case* is the proper form of action to recover damages for a violation of a copyright: *trespass* will not lie. *Atwill* v. *Ferrett*, 2 Blatchf., 47, 48.—Betts, J.; N. Y., 1846.

9. If the similitude between the defendant's work and the one copyrighted by the plaintiff can be supposed to have arisen from accident, or necessarily from the nature of the subject, the defendant is not liable. *Emerson* v. *Davis*, 3 Story, 791.—Story, J.; Mass., 1845.

10. Under the acts of 1790 and 1819, as to patents and copyrights, the owners of copyrights and patents do not have redress or relief in any cases where they could not before have had relief in some court, either of equity or law. *Pierpont* v. *Fowle*, 2 Wood. & Min., 27.—Woodbury, J.; Mass., 1846.

11. These acts merely enabled them to prosecute such claims in the Circuit Court as they legally had done before, but without going to the state tribunals: the public interest required a uniform construction to be placed by one tribunal on all important questions connected with rights so held. *Ibid.*, 27.

12. A book may in one part of it infringe the copyright of another work, and in other parts be no infringement;

in such a case the remedy will not be extended beyond the injury. *Story's Exrs.* v. *Holcombe*, 4 McLean, 315.—McLean, J.; Ohio, 1847.

13. Independently of the statute, the author of a manuscript may obtain redress against one who has surreptitiously gained possession of it. *Bartlett* v. *Crittenden*, 4 McLean, 301.—McLean, J.; Ohio, 1847.

14. At common law an author may maintain an action for the damages which he might sustain by his manuscript being surreptitiously printed by others. *Hoyt* v. *McKenzie*, 3 Barb. Ch., 323.—Walworth, Ch.; N. Y., 1848.

15. In a suit under the copyright acts, the plaintiff must make out a title to sue under his copyright. The court cannot interfere to prevent the use of the title of a work in favor of the plaintiff, upon principles relating to the good-will of trades. *Jollie* v. *Jaques*, 1 Blatchf., 627.—Nelson, J.; N. Y., 1850.

16. A suit arising out of an agreement as to the publication of a manuscript, and to determine the rights of the parties under it, is not a suit under the copyright laws, of which the Circuit Court has jurisdiction, by reason of the subject matter. *Pulte* v. *Derby*, 5 McLean, 336.—McLean, J.; Ohio, 1852.

17. An assignee of the exclusive right of acting and representing a drama in certain places may maintain an action in his own name, even after a representation by him, for an injunction to prevent its being represented by another within such places. *Roberts* v. *Myers*, 13 Mo. Law Rep., 400, 401.—Sprague, J.; Mass., 1860.

18. And such action may be maintained although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 308, 401. [Contra, *post* 19.]

19. A person who has only adopted measures to secure a copyright for a drama, but who has not fully completed such copyright, has no statutory right of redress for an unauthorized theatrical representation of such drama. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—Cadwallader, J.; Pa., 1860.

20. If a play has never been printed, the literary proprietor may, independently of the statutes, maintain a suit for damages for its unauthorized representation, if such representation has not been preceded by a representation by the proprietor. If the previous performance by the proprietor has been the means of enabling the defendants to bring it out, no action will lie. *Ibid.*, 49, 92.

## B. In Respect to Patents.

1. *Right of action, and principles governing.*

See also Courts, B.; Equity, B. 1; Injunction, B.

As to what constitutes Infringement, see Combination, B.; Composition of Matter, C.; Infringement, B.

1. An action of infringement will lie for making a machine fit for use, and with a design to use it for profit, even though there is no actual user, and no actual damage; the law implies damage. *Whittemore* v. *Cutter*, 1 Gall., 431.—Story, J.; Mass., 1813.

2. But the making a patented machine, merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects, is not an infringement for which an action will lie. *Ibid.*, 431.

3. The recovery of a verdict by the plaintiff in an action for the infringement of a patent, will not prevent him from bringing another action of infringement for a future use of the defendant's machine; every future use is an infringement. *S. C.*, 1 Gall., 484.—STORY, J.; Mass., 1813.

4. To constitute an offence for which an action will lie, the making of a machine must be with an intent to infringe the patent-right, and deprive the owner of the lawful rewards of his discovery. *Sawin* v. *Guild*, 1 Gall., 486.—STORY, J.; Mass., 1813.

5. A patentee is entitled to recover for a violation of his patent, no matter what private agreement subsists between him and any other one, as to an interest in his invention, unless he has made a legal assignment and transfer of his interest in the invention. *Park* v. *Little*, 3 Wash., 197.—WASHINGTON, J.; Pa., 1813.

6. A subsequent inventor and patentee of a machine, cannot maintain an action against a prior inventor and patentee of the same thing, or oust him of his right. *Woodcock* v. *Parker*, 1 Gall., 439.—STORY, J.; Mass., 1813.

7. An action for infringement is founded on the patent, and the plaintiff can claim no right which is not included in the patent. The patent is the foundation of the action, and the gist of the action is the violation of a right which the patent has granted. And this even though the patent is issued under a special law, and is not as broad as the law under which it is issued—the right is under the patent, and not under the law. *Evans* v. *Eaton*, Pet. C. C., 340, 345.—WASHINGTON, J.; Pa., 1816. [See *post* 9.]

8. If an inventor do not choose to obtain a patent for his invention, it becomes public property; and he can maintain no action against any one for using it. *Ibid.*, 348, 349.

9. In construing a patent, the intention of the parties, who are the government and the patentee, is entitled to great consideration; the act authorzing the issue of the patent, the petition for the issue of the patent, and the specification, may all be resorted to for such intention. *Evans* v. *Eaton*, 3 Wheat., 506, 507.—MARSHALL, Ch. J.; Sup. Ct., 1818.

10. Where a plaintiff claims several distinct and independent improvements in the *same* machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements so patented, notwithstanding there has been no violation of the other improvements. *Moody* v. *Fiske*, 2 Mas., 115, 118.—STORY, J.; Mass., 1820.

11. Where a declaration goes for the user of a machine during a limited period, a verdict and judgment in such action is no bar to a subsequent action for a user during another and subsequent period. *Earle* v. *Sawyer*, 4 Mas., 14.—STORY, J.; Mass., 1825.

12. Whether a patentee is ever required to give notice to one actually using a machine in violation of his patent, in order to maintain an action against him, even though such machine may have been erected and put in use before the patent issued; *query*. *Ames* v. *Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833.

13. Without obtaining a patent, a person has no exclusive right or privilege to make and sell the thing invented or discovered by him; without a patent,

the right to make and sell is common to all. *Thompson* v. *Winchester*, 19 Pick., 216, 217.—SHAW, Ch. J.; Mass., 1837.

14. If another person makes such invention, of an inferior quality, and sells it, and by this means brings the thing into disrepute, the inventor can maintain no action, as there is no infringement of his right, nor recover damages, unless the person so making and selling passes off the things sold as made by the plaintiff. *Ibid.*, 217.

15. If a patent is for two distinct machines, conducing to a common end, and either one is used by the defendant, the plaintiff may maintain an action therefor, under the acts of 1836 and 1837. *Wyeth* v. *Stone*, 1 Story, 287.—STORY, J.; Mass., 1840.

16. The act of 1837, § 9, gives to a patentee a right of action for the piratical use of any one of his invented improvements, which is distinctly stated in his patent, although he may have included something of which he was not the original inventor. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Maine., 1843.

17. A surrender of letters patent renders void all assignments under such patent, so far as those are concerned who assent to such surrender. It is necessary that a prior assignee should have a new assignment, before he can maintain an action for an invasion of the patent. *Gibson* v. *Richards*, Index Pat. Dec., No. 376.—NELSON, J.; N. Y., 1845.

18. In an action at law for a breach of a patent, it is indispensable to establish a breach before the suit was brought. But in equity, a bill will lie for an injunction, if the patent-right is admitted or established, upon well grounded proof of an apprehended intention of the defendant to violate the patent-right. *Woodworth* v. *Stone*, 3 Story, 752.—STORY, J.; Mass., 1845.

19. An attempted purchase from the defendants, of a patented article by an agent of the plaintiff, and for the purpose of entrapping the defendants, is not such a sale as will render them liable. *Sparkman* v. *Higgins*, 2 Blatchf., 30, 31.—BETTS, J.; N. Y., 1846.

20. To entitle a plaintiff to recover in an action for an infringement, the jury must be satisfied that the invention embraced in the plaintiff's patent is new and useful. The patent, however, raises the presumption of the novelty and utility of the plaintiff's invention. *Parker* v. *Stiles*, 5 McLean, 60.—LEAVITT, J.; Ohio, 1849.

21. A contract to use a patented machine, during the continuance of the patent, and to pay therefor a fixed proportion of the value of the fuel saved thereby, will not support an action until the expiration of the patent. *Wash. Alex. &c. Steam Pack. Co.* v. *Sickles*, 10 How., 441.—GRIER, J.; Sup. Ct., 1850.

22. It is an entire contract; but if the defendants had agreed to pay by instalment at the end of certain times, an action would lie for every breach, as occurring. *Ibid.*, 441.

23. Upon the breach of the conditions of a license, the patentee or licenser has a right to avoid the contract and be remitted to his original rights, and prosecute the licensees for an infringement of the patent. *Woodworth* v. *Cook*, 2 Blatchf., 160.—NELSON, J.; N. Y., 1850.

24. An action for an infringement cannot be maintained by an inventor against any one for using his invention before a patent is obtained. *Gayler* v.

*Wilder*, 10 How., 493—Taney, Ch. J.; Sup. Ct., 1850.

25. To support an action for a violation of a patent, there must be injury and damage; injury by a violation of the right, and damage, at least nominal, presumed by law to arise from such violation. *Byam* v. *Bullard*, 1 Curt., 103.—Curtis, J.; Mass., 1852.

26. A sale of the thing patented to an agent of the patentee, employed by him to make the purchase, and on account of the patentee, is not an act from which damage will be presumed, as it must be supposed to have been done for the patentee's benefit, or at least not to have been to his loss. *Ibid.*, 103, 104.

27. After a patent has expired, the court may *maintain jurisdiction of* a bill filed for its infringement, and for a discovery and account of profits, though no injunction is prayed for.—*Nevins* v. *Johnson*, 3 Blatchf., 83.—Nelson, Betts, JJ.; N. Y., 1853.

28. No satisfactory reason exists why the part owner of a patent-right cannot, like the part owner of a chattel, have his remedy, by an action on the case against his co-proprietor, for the exclusive appropriation of the joint property, in the same form as though the plaintiff were the sole owner and the defendant a stranger. *Pitts* v. *Hall*, 3 Blatchf., 208.—Hall, J.; N. Y., 1854.

29. In such an action against his co-owner for an infringement of the patent, he can recover his actual damages according to his interest in the patent, without regard to the amount which his co-proprietor has received by means of the infringement. *Ibid.* 208.

30. A patent issued is probable cause for a suit against one who infringes it, unless it is invalid, and *known to be so by the patentee.* *Beach* v. *Wheeler*, 24 Penn., 213, 214.—Knox, J.; Pa., 1855.

31. If there is an actual infringement, or if the patentee really believed there was his belief being reasonably founded, there was probable cause for the institution of the suit; if there was no infringement, and the patentee had not reasons which would induce a person of ordinary sagacity to believe his right had not been infringed, there would be no probable cause, and from its absence malice may be inferred, unless disproved by other evidence, and the party may be liable for malicious prosecution. *Ibid.*, 215.

32. The approval of an improvement, secured by a patent, by a party who however refuses to pay the price asked for it, furnishes no excuse for using it, but the party so using will be liable in damages.—*Simpson* v. *Mad River R. R.*, 6 McLean, 603, 604.—McLean; Ohio, 1855.

33. Where in an action for an infringement of a patent, no plea or answer is put in, the charge in the declaration is considered as admitted. *Parker* v. *Bamker*, 6 McLean, 632.—McLean, J.; Ohio, 1855.

34. The infringement of a patent is a *tort;* but the wrongful act not being committed with direct force, the form of action is that description of tort called trespass on the case. *Stein* v. *Goddard*, 1 McAllis., 82.—McAllister, J.; Cal., 1856.

35. If a patentee be an original inventor of a machine, or thing, he has the right to treat as infringers all who make a like invention operating on the same principle, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an im-

provement on the original and patentable as such. *McCormick* v. *Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

36. It is competent for a patentee to embrace two improvements on the same machine in the same patent, and if a person uses either or both of the improvements, he is an infringer. *Morris* v. *Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858.

37. There is no act of Congress limiting the time in which a suit may be brought for an infringement of a patent-right. *Parker* v. *Hallock*, MS.—GRIER, J.; Pa., 1858.

38. By statute, the remedy for an infringement of a patent is an action on the case; but an infringement of a patent is a cause of action at common law, and the party injured may waive the tort and sue in assumpsit on the implied contract for the use of his property. *Shreeve* v. *U. States*, MS.—LORING, J.; Ct. Claims, 1859.

39. There may be a claim for two inventions in the same patent, if they both relate to the same machine or structure; and an action can be sustained for the infringement of either one or the other of these separate inventions, where claimed as separate and distinct in their character. *Lee* v. *Blandy*, 2 Fisher, 92.—MCLEAN, LEAVITT, JJ.; Ohio, 1860.

40. After a patent has been surrendered, an action cannot be maintained for damages for an infringement occurring under the old patent, before the surrender. *Moffit* v. *Garr*, 1 Fisher, 613.—LEAVITT, J.; Ohio, 1860.

41. Where a patentee has been accustomed to grant the use of his invention upon the payment of a license-fee, an action against an infringer is best brought at law, as the price or value of the license is the true measure of the actual damage sustained, and the court may treble the verdict, where the defendant has acted wantonly or vexatiously. *Sanders* v. *Logan*, 2 Fisher, 170.—GRIER, J.; Pa., 1861.

42. A patentee whose invention is only valuable because used by all who pay a license-fee, and who suffers no other wrong than the detention of such fee, needs none of the remedies which it is the duty of the chancellor to give for such protection. *Livingston* v. *Jones*, 2 Fisher, 210.—GRIER, J.; Pa., 1861.

43. A court of law is his proper resort, the only remedy to which he is entitled being a judgment for a given sum of money, with interest; and then he may recover a penalty to the extent of treble damages, if the judge sees fit to inflict it. Pénalties and punitive damages can be recovered only in courts of law. *Ibid.*, 210.

2. *Where to be brought and how commenced.*

As to the jurisdiction of the Circuit Courts. See COURTS, B. 2.

1. Proceedings by bill in equity, under § 16 act 1836, and § 10 act 1839, against the Commissioner of Patents, to compel him to issue a patent, must be commenced in the Circuit Court of the United States for the District of Columbia, and cannot be brought elsewhere. No tribunal out of the District has jurisdiction over the person of the Commissioner of Patents as such, and the Patent Office. *Prentiss* v. *Ellsworth*, Mir. Pat. Off., 36.—RANDALL, J.; Pa., 1846.

2. Consent of parties cannot confer

jurisdiction, or render effectual the judgment of a tribunal in a matter of which it has not by law any cognizance. *Dudley* v. *Mayhew*, 3 Coms., 12–19.—STRONG, J.; N. Y., 1849.

3. Where, therefore, a bill was filed for an injunction for an infringement of a patent in a state court, and the defendant stipulated not to raise the question of jurisdiction, *Held*, that such consent could not confer jurisdiction, and that the bill must be dismissed on the ground that the state courts had no jurisdiction of actions in patent cases. *Ibid.*, 10–19.

4. Under § 17 of the act of 1836, the Circuit Courts of the United States have not only *original*, but *exclusive* jurisdiction of all actions arising under the patent laws. *Ibid.*, 14.

5. § 11 of the Judiciary Act of 1789, requiring one of the parties, plaintiff or defendant, to be an inhabitant of the state where the suit is brought, does not apply to actions arising under the patent laws. It is only necessary to give jurisdiction in patent cases that the process is served personally upon the defendant in the district where the suit is brought, as provided by the latter clause of § 11 of that act. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

6. The return of the marshal upon the writ or subpœna should state that the service of such writ or subpœna was made within the district where suit is brought. *Ibid.*, 487.

7. Where an alleged violation of a license was in Vermont, and the suit was brought in New York, *Held*, in a suit brought for the purpose of restraining the unlawful use of the machine, that proceedings were rightly commenced against the party concerned in the infringement, and that the action could, under § 11 of the Judiciary Act of 1789, be brought in the district where the defendant resided, or where he might be found at the time of serving the writ. *Wilson* v. *Sherman*, 1 Blatchf., 541.—NELSON, J.; N. Y., 1850.

8. But where it might become necessary to proceed directly against the machine itself, as in extreme cases of contumacy, or fraudulent contrivance to evade an injunction, the proceedings should be instituted in the district where the machine is located. *Ibid.*, 541.

9. Although the jurisdiction of the Circuit Courts embraces cases both at law and in equity, arising under the patent laws, for infringements of letters-patent, without regard to the citizenship of the parties, or the amount in controversy, the provisions of § 11 of the Judiciary Act of 1789, as to the commencement of suits, applies to these cases as well as to others; hence such a suit cannot be brought in any other district than that whereof the defendant is an inhabitant, or in which he shall be found at the time of serving the writ or process, and whatever the character of such process. *Day* v. *Newark I. R. Co.*, 1 Blatchf., 630–632.—NELSON, J.; N. Y., 1850.

10. The right to attach property, to compel the appearance of persons, can properly be used only in cases in which such persons are amenable to process *in personam*, and in such case also an attachment against his property cannot be issued, except as part of or together with process to be served upon his person. *Ibid.*, 630, 631.

11. In order to give jurisdiction to the Circuit Courts of the United States, the party defendant must be an inhabitant of the district in which the suit is

brought, or he must be found within it at the time of the service of the original process, and whatever may be the nature or character of the process used. *Ibid.*, 631, 632.

12. Where a corporation was created by the laws of New Jersey, and had its place of business in that state, but also had a store in New York, where its goods were sold, and a suit was commenced against it in New York by attachment of its goods, and by service of process on its president, who happened to be in New York, *Held*, that the corporation was not an inhabitant of New York, or found within it at the time of the service of the process, and that the court had no jurisdiction of the action. *Ibid.*, 633.

13. The purchaser of an implement or machine, for use in the ordinary pursuits of life, does not become possessed of a portion of the franchise or monopoly conferred by the patent—he exercises no right conferred by Congress; but when the machine passes into his hands it is no longer within the limits of the monopoly, or under the protection of the acts of Congress; and if his right is infringed he must seek redress in the courts of the state, and according to its laws, and not in the courts of the United States or under the acts of Congress. *Bloomer* v. *McQuewan*, 14 How., 549.—TANEY, Ch. J.; Sup. Ct., 1852.

14. A process of attachment, whether direct or foreign, by which the property of a defendant is attached, by virtue of state laws, cannot give the Circuit Court jurisdiction over a person not an inhabitant of, and not found within the district. *Saddler* v. *Hudson*, 2 Curt., 7.—CURTIS, J.; Me., 1854.

15. If a defendant is sued out of his district he must plead his personal privilege. *Teese* v. *Phelps*, 1 McAllis., 17.—McALLISTER, J.; Cal., 1855.

16. Under § 11 of the Judiciary Act of 1789, jurisdiction of the person of a defendant (who is an inhabitant of another state) can only be obtained, in a civil action, by service of process on his person within the district where the suit is instituted. *Chaffee* v. *Hayward*, 20 How., 215.—CATRON, J.; Sup. Ct., 1857.

17. And this provision is not changed by any of the process acts, or by the act of Congress conferring jurisdiction on the Circuit Courts in patent cases, without regard to citizenship. § 11 of the Judiciary Act is not affected by the subsequent process acts, and it applies to *all* civil suits. *Ibid.*, 216.

### 3. *Parties to.*

See also EQUITY, B. 2.

#### *a.* Plaintiffs.

1. Under § 5 of the act 1793, an assignee of a *part* of a patent-right cannot maintain an action for a violation of it. *Tyler* v. *Tuel*, 6 Cra., 327.—CURIAM; Sup. Ct., 1810.

2. But if a patentee has sold a moiety of his invention to another, a joint action lies, under such section 5, by himself and such assignee, for a violation of the patent. The action is brought by those who have the whole patent in themselves, which distinguishes it from the case of *Tyler* v. *Tuel*. *Whittemore* v. *Cutter*, 1 Gall., 430.—STORY, J.; Mass., 1813.

3. The executor or administrator of a joint patentee may maintain an action jointly with the surviving patentee for an infringement. *Ibid.*, 431

4. A patentee cannot maintain an action for an infringement after he has made an assignment of his invention; but the suit must be brought by the assignee. *Herbert* v. *Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

5. And it will make no difference that the assignment was made before patent issued, and the patent afterward taken out in the name of the inventor. *Ibid.*, 15.

6. Whether an assignee of part of a patent, circumscribed as to the interest by local limits, can, in his own name, or with the patentee, maintain a suit at law or not, there can exist no doubt but that he may support a suit in equity to enjoin third persons from infringing the patent, and for an account. *Ogle* v. *Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

7. An assignee of a part interest, which is exclusive, in a patent, may, at law or in equity, maintain a suit for infringement, without joining the patentee. *Brooks* v. *Bicknell* 3 McLean, 250.—MCLEAN, J.; Ohio, 1843. (So held in fact, as the suit was by an assignee without joining any other person, but no question raised as to parties. —ED.)

8. An action for a violation of an exclusive right in a patent can only be brought by the owner of such a right. *Washburn* v. *Gould*, 3 Story, 131, 166. —STORY, J.; Mass., 1844.

9. The assignees of an exclusive right in a patent are the proper persons to maintain an action for a violation of such right. *Ibid.*, 131, 167.

10. The grantee of an exclusive right under a patent, though such right may be limited to the use of a certain number of machines within a certain territory or district, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within that district, under § 14 of the act of 1836. *Wilson* v. *Rosseau*, 4 How., 686, 688.—NELSON, J.; Sup. Ct., 1845.

11. An 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 the patent, or a grant or conveyance of the whole interest within some particular district or territory. *Suydam* v. *Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

12. By § 11 of the act of 1836, taken in connection with § 14 of the same act, an action is given only to such party, composed of one or more persons, as possesses the whole interest. *Ibid.*, 23.

13. Where a party has an interest in only a part of a patent, as a license to use the invention patented, only in the manufacture of a particular kind of goods, he cannot maintain an action for an infringement. *Ibid.*, 23.

14. In an action by an administrator it is not necessary that he should produce his letters of administration. The patent, being renewed to him as administrator, is proof that he had satisfied the officer authorized to grant a renewal, of his being administrator, and it is not competent for the court to go behind that decision. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

15. Where a patentee granted an exclusive license to C to use his patent for a specified purpose, as a grant by Blanchard of a license to use his patent for turning irregular forms, for turning lasts, boot-trees, &c., and a third party. E, infringed by turning lasts, *Held*, that such grant to C did not vest any

legal title to the patent in him, and that the action for such infringement was properly brought in the name of the patentee. *Blanchard* v. *Eldridge*, 1 Wall, Jr., 341.—GRIER, J.; Pa., 1849.

16. In an action of infringement founded upon the non-performance of the conditions of a license, the original patentee and licenser are properly joined as parties plaintiff, notwithstanding the whole beneficial interest is in his assignee, inasmuch as he was a party to the agreement or license, and may be interested in the patent and in upholding it. *Woodworth* v. *Cook*, 2 Blatchf., 161.—NELSON, J.; N. Y., 1850.

17. An assignee of an invention, under an assignment made before patent issued, and such patent being also issued in the name of the inventor or assignee, may maintain an action in his own name for an infringement. *Gayler* v. *Wilder*, 10 How., 493, 494.—TANEY, Ch. J.; Sup. Ct., 1850.

18. But to enable an assignee of a sectional interest in a patent to sue in his own name under § 14 of the act of 1836, he must have the exclusive right or entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others. *Ibid.*, 494.

19. An agreement purporting to grant an exclusive right to make and sell a patented article within a certain territory, but reserving to the patentee the right to manufacture and make and sell the article within such territory, is not such an assignment as will enable the assignee to bring an action in his name, but it should be brought in the name of the patentee. *Ibid.*, 495.

20. A patentee or his assignee, in assigning the use of a patent within a particular district, may reserve the right to sue for infringements. But if he afterward assigns all his right in such district, the owner of the patent may sue. *Bicknell* v. *Todd*, 5 McLean, 240.—MCLEAN, J.; Ohio, 1851.

21. A mere licensee need not be made a party plaintiff in an action of infringement, though he may be benefited by the decree or judgment in the case. *Goodyear* v. *Day*, MS.—GRIER, DICKERSON, JJ.; N. J., 1852.

22. Neither need a party interested as *cestui que trust*, in the profits of the patent, be made a party, when the conveyance to such party reserves to the patentee the whole and sole power of disposal, and consequently the legal title. *Ibid.*

23. Under § 14 act of 1836, an action at law is properly brought in the name of the patentee in behalf of a licensee who is damaged by the infringement. *Goodyear* v. *McBurney*, 3 Blatchf., 33.—NELSON, J.; N. Y., 1853.

24. If to such an action a release from the patentee is set up, the plaintiff may file a replication setting up the license, the bringing of suit for the benefit of the licensee, notice to the defendants of such license, and its recording prior to the release, want of power to give the release, and that it was given without the consent and authority of the licensee. *Ibid.* 33.

25. The assignees of a patent, though their title accrues to them by several deeds, may all join, as the holders of the title, in an action for the recovery of damages for an infringement of the patent. *Stein* v. *Goddard*, 1 McAllis., 84.—MCALLISTER, J.; Cal., 1856.

26. Where a license had been granted to a person to use a patent, and the patentees had covenanted not to license any other persons, nor use the patent

themselves, but all damages recovered for infringement were to belong equally to the patentees and such licensee, *Held*, that an action for an infringement could not be maintained in the name of the licensee alone, but that the patentees were both proper and necessary parties. *North* v. *Jones*, 4 Blatchf., 72.—INGERSOLL, J.; N. Y., 1857.

27. A mere licensee cannot bring an action at law for a violation of his interest or right in a patent. *Potter* v. *Holland*, 4 Blatchf., 412, 413.—INGERSOLL, J.; Ct., 1858.

28. A licensee may bring an action for his own benefit, in the name of the patentee, but the nominal plaintiff can require indemnity for costs. *Goodyear* v. *Bishop*, 4 Blatchf., 439.—NELSON, J.; N. Y., 1860.

29. Where a patentee granted to another the exclusive right to make and sell his patented invention, within a certain territory, for which he was to pay a certain sum for each machine so made and sold, but the patentee reserved the right of sending machines of his own manufacture into such territory, *Held*, that such contract was not an assignment of the patentee's interest in the patent in such territory, but a mere grant or license to make and sell the article therein; and that the patentee could maintain an action in his own name against those infringing, and that such action could not be brought in the name of his grantees. *Hussey* v. *Whiteley*, 2 Fisher, 123.—LEAVITT, J.; Ohio, 1861.

*b*. Defendants.

See also CORPORATIONS.

1. Whenever any person, previous to a patent, constructs a machine discovered by another, he constructs it subject to the right of that other, and his right to use it is qualified by the paramount right of the inventor to prescribe the conditions on which he shall use it, and he may be held in damages. *Evans* v. *Jordan*, 1 Brock, 252.—MARSHALL, Ch. J.; Va., 1813.

2. The purchase of a manufactured article, made in violation of a patent of a third person, but without any connection on the part of such purchaser with the manufacture, except as a purchaser, will not make the party buying guilty of an infringement of the rights of the patentee, as having used the patented invention. A contract to purchase articles manufactured in violation of a patent, is not of itself an infringement of such patent. *Keplinger* v. *De Young*, 10 Wheat., 365.—WASHINGTON, J.; Sup. Ct., 1825.

3. A mere workman employed by a person other than the patentee to make parts of a patented article, is not liable to an action for damages. *Delano* v. *Scott*, Gilpin, 497, 498.—HOPKINSON, J.; Pa., 1834.

4. The seller of an article is the owner for whom it is sold; not the man or boy in the shop who delivers it to the buyer, and receives the money. *Ibid.*, 498.

5. Whether a person, who acts as the mere agent of another, is responsible in damages for the infringement of a patent, and may be enjoined; *query*. *Boyd* v. *McAlpine*, 3 McLean, 430.—McLEAN, J.; Ohio, 1844.

6. There are, however, strong reasons why the interest of a principle should, by an action at law, and also by a bill in chancery, be reached through his agent. *Ibid.*, 431.

7. An action for infringement will

lie against the parties making an article which is patented, though such persons are employed by others to do the work. *Bryce* v. *Dorr*, 3 McLean, 583.—McLean, J.; Mich., 1845.

8. The defendants were employed by S., who furnished them a model, to make or cast certain patented articles, *Held* by the court, that the defendants were liable, and that it was not necessary to bring the action against S. *Ibid.*, 583.

9. A purchaser, for his own account, of articles manufactured by a patented machine, though purchased with a full knowledge that they were manufactured in violation of the patent, cannot be enjoined, or held liable in any other way. *Anon.*, 3 West. Law Jour., 144.—N. Y., 1845.

10. An agent selling an article which infringes on the plaintiff's patent, may be joined as a party defendant with the one who manufactures such article, as they are joint trespassers, and are liable to be sued jointly. *Buck* v. *Cobb & Hermance*, 9 Law Rep. O. S., 547.—Conkling, J.; N. Y., 1846.

11. A purchase from the defendants of a patented article, by an agent of the patentee, and for the purpose of entrapping the defendant, is not such a sale as will render them liable. *Sparkman* v. *Higgins*, 2 Blatchf., 30, 31.—Betts, J.; N. Y., 1846.

12. If a machine, as made by the defendant, was not an infraction of the plaintiff's patent, the alteration of it by a third party, will not make the defendant liable; but if the machine, as made by the defendant, was intended by him to operate in such a way as to violate the plaintiff's patent, and has in fact so operated, he is a party to the infringement, notwithstanding the ingenuity with which he may have sought to disguise his wrong. *Knight* v. *Gavit*, Mir. Pat. Off., 133.—Kane, J.; Pa., 1846.

13. An action of infringement cannot be maintained against a mere purchaser of articles manufactured in violation of a patent, after they have been manufactured, unless he is concerned in the manufacture. *Blanch. Gun-Stock Turn. Co.* v. *Jacobs*, 2 Blatchf., 70, 71.—Betts, J.; N. Y., 1847.

14. The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction articles are manufactured which are an infringement of a patent, and the agents who conduct the business of selling such articles, are responsible for such infringement, and may be restrained by injunction. *Goodyear & N. E. Car Spring Co.* v. *Phelps*, 3 Blatchf., 92.—Nelson, J.; N. Y., 1853.

15. S. being an inventor of an improvement in dragoon and pack saddles, made application for a patent therefor before May, 1847. In November, 1847, before such application was acted on, G. made application for a patent for the same invention; but notice of interference was not given. In December, 1847, the secretary of state addressed the Commissioner of Patents, that an early issue of a patent to G. would facilitate a supply of saddles to the government; G.'s application was taken up, and a patent issued Dec. 11, 1847—S.'s application remaining not acted upon, and postponed, *Held*, that the wrong done to S. was not committed by the United States, or by any of its officers, so as to render them pecuniarily responsible therefor. *Thistle* v. *United States*, Devereaux, 130.—Scarburgh, J.; Ct. Claims, 1856.

16. If a person take a license, but neglect for a long time to pay the license price, and when prosecuted, abandon it, or defend upon other grounds, the license will be deemed forfeited, and he will be liable as an infringer. *Bell* v. *McCullough*, 1 Fisher, 381.—LEAVITT, J.; Ohio, 1858.

17. The fact that as between themselves parties are connected together as the stockholders, managers, and servants of a corporation, will not exempt them from being enjoined, or being liable to an action for infringement. *Poppenhausen* v. *Falke*, 4 Blatchf., 494.—SHIPMAN, J.; N. Y., 1861.

4. *Discontinuance of, by whom.*

1. The nominal plaintiff cannot discontinue a suit, which is in reality brought for the benefit of a licensee, but such real plaintiff in interest may have the suit continue for his benefit. *Goodyear* v. *Bishop*, 4 Blatchf., 439.—NELSON, J.; N. Y., 1860.

2. The nominal plaintiff may, however, claim indemnity for costs. *Ibid.*, 439.

3. It will make no difference that the nominal plaintiff has covenanted to sue infringers, upon which covenant he may be liable to his licensees. Such a stipulation does not take away from the licensees the remedy which the law has provided, of proceeding directly against the wrongdoer. *Ibid.*, 439.

5. *Defences to.*

See DEFENCES.

6. *Pleadings in.*

See PLEADING.

## C. IN RESPECT TO TRADE-MARKS, AND DEFENCES TO.

As to right of aliens to maintain such actions, see ALIENS, B.

See also COURTS, C.; INFRINGEMENT, C.; INJUNCTIONS, C.

1. To an action for the infringement of a trade-mark, it is wholly immaterial whether the simulated article is or is not of equal goodness and value with the real article. *Taylor* v. *Carpenter*, 11 Paige, 298.—WALWORTH, Chan.; N. Y., 1844.

2. It is no defence to an action for violation of plaintiff's labels and trade-marks, that the defendants have not used all the plaintiff's labels; it is sufficient, if there be a violation, in imitating and using any of such labels. *Taylor* v. *Carpenter*, 3 Story, 462, 463.—STORY, J.; Mass., 1844.

3. Nor is it any excuse that others have used such labels; this rather aggravates than excuses the misconduct, unless done with the consent or acquiescence of the plaintiff. *Ibid.*, 464.

4. It is no excuse for a violation of plaintiff's trade-mark, that the imitated article is as good as the original. *Coats* v. *Holbrook*, 2 Sand. Chy., 595.—SANDFORD, V. Ch.; Ct. Chy., N. Y., 1845.

5. Nor is it any defence to an action for a fraudulent use of such trade-marks, that other persons are engaged in like infringements. *Ibid.*, 596.

6. Nor that the maker of the imitation, or the commission merchant who sells to the jobber, told the purchaser that they were selling an imitation or spurious article. *Ibid.*, 597.

7. Evidence of a usage or custom

in the United States, England, &c., to use and imitate the trade-marks of foreigners with impunity is not a good defence to an action for a wrongful use of a trade-mark: no usage is competent evidence in defence of a wrong. *Taylor* v. *Carpenter*, 2 Wood. & Min., 7.—WOODBURY, J.; Mass., 1846.

8. It might be competent in mere mitigation of damages, so far as regards smart-money, or vindictive damages, if such were permissible. *Ibid.*, 8.

9. A neglect to prosecute infringements of a trade-mark, because one believed he had no rights, or from mere procrastination, is no bar to an action for such infringement, except under the Statute of Limitations, or under some positive statute, like that as to patents, which avoids the right, if the inventor permits the public to use the patent for some time before taking out letters. *Ibid.*, 8.

10. It is no defence to an action for a wrongful use of the plaintiff's trade-mark, that the articles sold as and for his, were not inferior in value to his. *Ibid.*, 20.

11. If the use of a trade-mark by one, in violation of the rights of the original possessor, is for such a length of time and under such circumstances as to indicate a dedication or abandonment of the marks to the public, or a license to use them, the plaintiff cannot recover. *Ibid.*, 20.

12. To enable a party to maintain a bill in equity to restrain the use of trade-marks, he must allege and prove that such use was for the purpose of effecting a false representation, and that the articles were made by those who did not in fact make them. *Amee* v. *King*, 2 Gray, 282.—BIGELOW, J.; Mass., 1854.

13. The fact that a person has discontinued the use of a particular trade-mark for a time, and adopted another, will not deprive him of a right of action against a party selling an article with such discontinued trade-mark. *Lemoine* v. *Gauton*, 2 E. D. Smith Rep., 347.—DALY, J.; N. Y., 1854.

14. Whether the sale of an article, with a forged or counterfeited trade-mark, to the owner of the trade-mark, would be sufficient to give a right of action; *query*. *Ibid.*, 348.

But if so, only nominal damages could be recovered. *Ibid.*, 348.

15. It will not support an action for the violation of a trade-mark that the imitation trade-mark or label has a resemblance to the original; but any imitation is actionable which requires a careful inspection to distinguish its marks and appearances from those of the manufacture imitated. *Merrimack Manuf. Co.* v. *Garner*, 4 E. D. Smith, 391, 392.—DALY, J.; N. Y., 1855.

16. One person has a right to imitate and sell the same style of goods as those manufactured by another; and the latter has no right to complain unless the label used upon the article in imitation would lead purchasers to suppose that they were buying goods actually manufactured by him. *Ibid.*, 392.

17. It is no defence to an action to restrain the use of the plaintiff's trade-mark, that the article upon which it is used is not patented, or that the words on the trade-mark are fictitious. *Stewart* v. *Smithson*, 1 Hilton, 121.—BRADY, J.; N. Y., 1856.

18. The assignee of a trade-mark and of the articles or goods to which it is attached, is entitled to the enjoyment of the exclusive rights thereto, and may maintain an action in his own name for any wrongful use by others of such

trade-mark, to the same extent as the originator thereof. *Walton* v. *Crawley*, 3 Blatchf., 448.—BETTS, J.; N. Y., 1856.

19. The right of a plaintiff to maintain an action for a violation of a trade-mark, does not depend upon the intention of the defendant to appropriate such trade-mark (violate it); it is enough if it is made to appear that he has done so. *Dale* v. *Smithson*, 12 Abb. Pr., 238.—HILTON, J.; N. Y., 1861.

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## ADDITIONS TO A LITERARY WORK OR MANUSCRIPT, TO WHOM BELONG.

1. Additions to a former manuscript are not independent literary productions, capable of independent proprietorship; but *literary accessions*, whose proprietorship is incidental to that of the principal composition. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 47.—CADWALLADER, J.; Pa., 1860.

2. And even though such additions may not have been made by the proprietor, but by others, provided such persons were in the employ of the proprietor. *Ibid.*, 48.

3. Where A in the general theatrical employment of B was engaged in the office of assisting in the adaptation of a play for representation, and made additions in the course of the performance of his duty, *Held*, that B became the proprietor of such additions, as products of his intellectual exertions in a particular service in his employment. *Ibid*, 49.

4. Where an inventor, in the course of his experimental essays, employs an assistant, who suggests and adapts a subordinate improvement, it is, in law, an incident or part of the employer's main invention. *Ibid.*, 49.

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## ADMINISTRATORS, RIGHTS AND POWERS OF, AS TO INVENTIONS.

1. An executor or administrator of a joint patentee may maintain an action jointly with the surviving patentee for an infringement. *Whittemore* v. *Cutter*, 1 Gall., 431.—STORY, J.; Mass., 1813.

2. Under the act of 1836, § 18, the Board of Commissioners appointed to grant an extension of a patent may allow such extension to the legal representatives of a patentee, upon their application, in the same manner as though the application had been made in the lifetime of the patentee. *Nyman's Case*, 3 Opin., 446.—GRUNDY, Atty.-Gen.; 1839.

3. An administrator or executor of a deceased patentee may apply for an extension of a patent, and the patent may lawfully issue to him on such application. *Van Hook* v. *Scudder*, MS.—THOMPSON, J.; N. Y., 1843. (Cited in *Brooks* v. *Bicknell*, 3 McLean, 438.)

4. If a patentee is dead, his administrator may apply for and obtain an extension of the patent, under the provisions of the 18th section of the act of 1836. *Brooks* v. *Bicknell*, 3 McLean, 258, 260.—MCLEAN, J.; Ohio, 1843.

5. The administrator of a deceased patentee may apply for and obtain a renewal of the patent, originally granted to such patentee. *Brooks* v. *Bicknell*, 3 McLean, 436, 438.—MCLEAN, J.; Ohio, 1844.

6. And such an administrator, in whose name a patent has been renewed,

may grant an assignment of an interest therein. *Ibid.*, 441.

7. An extension of a patent may be taken out by an administrator of a deceased patentee. *Washburn* v. *Gould*, 3 Story, 133, 137.—STORY, J.; Mass., 1844.

8. An administrator is competent to apply for and receive a renewal or extension of a patent. *Woodworth* v. *Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844.

9. § 18 of the act of 1836 authorizes the extension of a patent, on the application of the executor or administrator of the deceased patentee; and although the patentee had, during his lifetime, disposed of all his interest in the then existing patent, having at the time of his death no right or title to, or interest in, the original patent. *Wilson* v. *Rosseau*, 4 How., 675–677, —NELSON, J.; Sup. Ct., 1845.

10. And such an extension inures to the benefit of the administrator only in such capacity, and not to assignees and grantees, so as to vest in them any exclusive right whatever. Those, however, who are in the use of the patented article at the time of the renewal, may continue to use such machines or articles. *Ibid.*, 676–684.—(MCLEAN, J., and WOODBURY, J., dissenting, holding that such extension would inure to those assignees who had by express agreement secured an interest in the extension.)

11. An administrator may, under § 18 of the act of 1836, apply for and take an extension of a patent. *Woodworth* v. *Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

12. The renewal of a patent in the name of an administrator is good, as an invention is personal property. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

13. It is not necessary, in an action by an administrator, that he should produce his letters of administration. The patent being renewed to him as administrator, is proof that he had satisfied the officer authorized to grant a renewal, of his being administrator, and it is not competent for the court to go behind that decision. *Ibid.*, 254.

14. An administrator of a patentee, residing in one state, may commence an action in the United States Circuit Court of another state, for the recovery of damages for an infringement of a patent, without taking out letters of administration in the latter state. *Smith* v. *Mercer*, 5 Penn. Law Jour., 531.—KANE, J.; Pa., 1846.

15. The same right extends to the grantee or assignee of such administrator. *Ibid.*

16. Administrators of an intestate have no right, as administrators, to carry on the business of manufacturing and selling a patented article, by virtue of a license or agreement held by the intestate, farther than to complete the machines begun by the intestate during his lifetime, and unfinished at his death; but they can sell and transfer such right, and the purchaser would acquire all the rights secured to the intestate during his lifetime. *Pitts* v. *Jameson*, 15 Barb., S. C., 316.—JOHNSON, J.; N. Y., 1853.

17. Under § 10 of the act of 1836, if an inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such persons in trust for the heirs at law or devisees of the inventor. *Stimpson* v.

*Rogers*, 4 Blatchf., 335–6.—INGERSOLL, J.; Ct., 1859.

18. It need not however be expressed in the patent that it is issued to such executor *in trust for* those entitled to it. It will be sufficient that the patent set forth that it was issued to the grantee, as executor. What the executor does in relation to the property of the devisor, he does in trust for those to whom such property is given by the will. *Ibid.*, 336.

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## AGENT AND EMPLOYEE.

1. A mere workman, employed by others than the patentee to make parts of a patented article, is not liable to an action for infringement and damages.—*Delano* v. *Scott*, Gilpin, 497, 498.—HOPKINSON, J.; Pa., 1834.

2. The seller of an article is the owner for whom it is sold; not the man or boy in the shop who delivers it to the buyer and receives the money.—*Ibid.*, 498.

3. Whether a person who acts as the mere agent of another, is responsible in damages for the infringement of a patent, and may be enjoined; *query*. *Boyd* v. *McAlpine*, 3 McLean, 430.—McLEAN, J.; Ohio, 1844.

4. There are, however, strong reasons why the interest of a principal should, by an action at law and also by a bill in chancery, be reached through his agent. *Ibid.*, 431.

5. An action of infringement will lie against the parties making a machine which is patented, though such persons are employed by others to do the work. But if such parties have acted without a knowledge of the plaintiff's right, only nominal damages should be found against them. *Bryce* v. *Dorr*, 3 McLean, 582, 583.—McLEAN, J.; Mich., 1845.

6. An injunction will be granted as well against an agent, who merely sells the article which infringes a patent, as against the manufacturer, as both are joint trespassers, and they may be sued jointly. *Buck* v. *Cobb & Hermance*, 9 Law Rep., O. S., 547.—CONKLING, J.; N. Y., 1846.

7. An injunction will issue against a person who runs a machine, as well as against those who own it. *Woodworth* v. *Edwards*, 3 Wood. & Min., 133.—WOODBURY, J.; Mass., 1847.

8. An action for an infringement of a patent will lie against the managing directors and agents of an incorporated company, and it is not a good objection that they are not liable for the infringement charged, because they are only stockholders in the company. *Goodyear & N. E. Car Spring Co.* v. *Phelps*, 3 Blatchf., 92.—NELSON, J.; N. Y., 1853.

9. A decree for an account cannot be had against a workman, as he has nothing to do with the profit. *Sargeant* v. *Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

10. An attachment for a violation of an injunction may issue against the agent and acting officer of the defendant, a foreign corporation, and he is not exempted therefrom on the ground that he is a mere servant of the defendant. —*Sickles* v. *Borden*, 4 Blatchf., 20.—HALL, J.; N. Y., 1857.

11. Where the violation of the injunction was the use of the thing patented, on a steamboat, *Held*, that the engineer was properly made a party to

the proceeding, and that an attachment would issue against him.—*Ibid.*

12. The fact that as between themselves, parties are connected together as the stockholders, managers, and servants of an incorporated company, will not exempt them from being enjoined, or being liable to an action for infringement. *Poppenhausen* v. *Falke*, 4 Blatchf., 494.—SHIPMAN, J.; N. Y., 1861.

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## AGREEMENTS.

**A.** AS TO COPYRIGHTS..... 120
**B.** AS TO PATENTS..... 121

### A. AS TO COPYRIGHTS.

1. A contract to reprint a literary work, the copyright to which has been secured by the author, is void, unless it is entered into with the consent of the author, or his assignee. *Nichols* v. *Ruggles*, 3 Day, 158.—Ct., 1808.

5. A printer who executes such a contract with a knowledge of the rights of the author, can recover nothing for his labor. *Ibid.*, 158.

3. Joint owners of a copyright may make a contract between themselves as to the printing and publishing of the work, and neither will be permitted to set up against the other his original rights as a joint owner, in violation of such contract. *Gould* v. *Banks*, 8 Wend., 568.—NELSON, J.; N. Y., 1832.

4. Where an agreement was entered into between two persons, that the one should prepare for press a certain volume, and the other agreed to pay "for the copyright" of said volume the sum of five hundred dollars, *Held*, that such agreement must be construed as having been made with reference to the then existing term of fourteen years, and did not include the second term of fourteen years. *Pierpont* v. *Fowle*, 2 Wood. & Min., 25, 43.—WOODBURY, J.; Mass., 1846.

5. A further agreement between the same parties in respect to other volumes, provided that the copyright of them should be "considered their joint and equal property." *Held* also as to this, that it was to be construed according to the same principle as referring only to the first term. *Ibid.*, 25, 43.

6. If the second term is to be embraced in any agreement, there must be language used more comprehensive than "copyright," showing an intention to treat as to the future interest. *Ibid.*, 45.

7. Where an agreement as to the publication of a manuscript was made with a party, who was authorized to "print as many copies as he could sell," *Held*, that this did not apply to a single edition, but was intended to operate as long as sales could be made. *Pulte* v. *Derby*, 5 McLean, 332, 333.—MCLEAN, J.; Ohio, 1852.

8. And such party is bound to publish as long as there is a demand. *Ibid.*, 335.

9. Where, under such an agreement, the publisher took the copyright in his own name, and with the consent of the author, such copyright is in him only for the purposes of such contract. He has no right to assign it, nor to publish the work except upon the terms of such contract. *Ibid.*, 335.

10. Nor has the author a right to take out a copyright in his own name, or publish the work, in disregard of the contract. *Ibid.*, 335.

## B. As to Patents.

See also Assignment, C., and License, A.

1. Where a contract for the sale and purchase of a patent is reduced to writing, it is supposed to embody the understanding of the parties, and cannot be altered or enlarged by parol, or explained except in respect to a latent ambiguity. *Edwards* v. *Richards*, Wright, 597.—Lane, J.; Ohio, 1834.

2. A offered to sell a patent-right to B, who declined to purchase unless C would join with him. A then went to C and agreed with him that he should join with B, and that he, A, would take the notes of each for half the agreed sum; but as soon as the business was closed he would give back to C his note, and pay him for thus inducing B to buy. B was thus induced to buy; but he afterward sold his interest for more than he gave for it. In an action by B against A for the fraud, *Held*, that B had a right to recover against A any damages he might have suffered, by not having C as a joint owner, to aid or assist in making sales of the patent, and that the fact that he had sold his interest for more than he gave for it did not show that he had not sustained damage. *Culver* v. *Webb*, 12 Conn., 441, 443.—Waite, J.; Ct., 1838.

3. Where in the conditions of a contract for the sale of a patent, it was provided that if certain defects were found to exist in the patent, the contract should be void, and a general clause followed, providing that if there should be *any other defect whatever*, the contract should also be void, *Held*, that this had reference to defects in the patent, and not in the machine itself, affecting its intrinsic value. *Vaughan* v. *Porter*, 16 Verm., 267, 270.—Redfield, J.; Vt., 1844.

4. Where it was stipulated between A and B that B should be entitled to use A's patent three days in a week until a given date, and that A would not prosecute any action against B for any former violation, provided B should not use such patent after the specified date, or by any other machine infringe A's right, *Held*, that such proviso, introduced by the plaintiff, and not placing any personal obligation on the defendant, did not operate as an estoppel against B to prevent him showing the truth in regard to the validity of the right of A. *Rich* v. *Hotchkiss*, 16 Conn., 419, 420.—Williams, Ch. J.; Ct., 1844.

5. If a party has been misled in a contract, and on that ground contends that he is not bound by it, he must repudiate it and claim nothing under it. He cannot claim that part which is favorable, and reject that which operates against him. *Brooks* v. *Stolley*, 3 McLean, 526.—McLean, J.; Ohio, 1845.

6. But if he claim any right under the contract, he must show that he has done every thing on his part equitably required of him, to entitle him to the rights asserted. *Ibid.*, 527.

7. He must take the contract as it is. A court of equity may, for fraud or mistake, direct a contract to be delivered up and cancelled, but cannot alter it. *Ibid.*, 528.

8. Where a party K. entered into an agreement with a patentee P. in respect to the manufacture of the machines patented by P., and P., though an *original* inventor of such machine, was not

the *first* inventor, of which facts however K. was aware at the time of making such agreement, *Held*, that an injunction would issue against K. to restrain him from making and vending such machines in violation of such agreement. *Parkhurst* v. *Kinsman*, 8 N. Y. Leg. Obs., 74.—BETTS, J.; N. Y., 1848.

9. While the exclusive rights of a patentee are specially guarded from intrusion, the contracts which he makes to share them with third persons are interpreted and enforced in the same manner as other legal engagements. *Morse* v. *O'Rielly*, 6 Penn. Law Jour., 501 (2 Whar. Dig., 414), Pa., 1848.

10. Where the purchaser of an interest in a patent had an election under the contract of sale, within a given time, to recede from the purchase, and return the deed taken, or complete it and pay the purchase price, and he failed or neglected to return the deed within such time, although at the time the contract of sale was entered into the patent was actually void because embracing more than the patentee had invented, but during the period of election an act was passed (§ 9 of act of 1837,) rendering such patents valid to the extent of the actual invention of the patentee, *Held*, that the patentee became entitled to the benefit of the act, provided his invention was a material and substantial part of the thing patented and definitely distinguishable from the other parts claimed without right; that it afforded a sufficient consideration for the agreement, which was to be construed the same as if made at the end of the time at which the right to recede was limited. *Hotchkiss* v. *Oliver*, 5 Denio, 319, 320.—MCKISSOCK, J.; N. Y, 1848.

11. W., the patentee of a patent about to expire, sold to G. all his right in the extension thereof, if granted, for a certain territory, except as to two machines, the right to one of which was held by K. under the original patent, and the right to the other was reserved by W. himself. On the same day W. agreed with K., if the patent was extended, to give him an assignment to run his machine during such extension, and W. also sold to K. the right to the machine reserved to himself. K. paid a sum of money down on such agreement, but afterward refused to fulfil such agreement. W. assigned to I. all his interest in such agreement as to such two machines, and afterward G. released to I. all interest, if any, he might have in those machines. I. then gave a license to use the two machines to the defendants, and they put them in use under such license. K. also continued the use of his two machines. G. then filed his bill to restrain the use of the machines by the defendants, under the license from I., the assignee of W. *Held*, that the failure of K. to fulfil his agreement with W. did not annul and cancel such agreement; it was a contract partly executed. *Gibson* v. *Barnard*, 1 Blatchf., 389–392.—NELSON, J.; No. N Y., 1848.

12. *Held*, also, that although a court of equity might decree a surrender of such agreement on terms, until that was done, K. was in the lawful use and enjoyment of the two machines under the extended patent. *Ibid.*, 392.

13. And even if the agreement was annulled, W. could grant to I. only the right to use one machine, as the other was secured to K. by the decision of the Supreme Court in 4 How. *Ibid.*, 392.

14. *Held*, therefore, that the defendants had no right to use the machines under the license from I., and that G. was entitled to an injunction restraining such use. *Ibid.*, 392.

15. B having a patent for "making hooks or brad-headed spikes," brought a suit in his own name against C for infringing such patent. B and C had also each a patent for "making horse-shoes," but B claimed the exclusive right to make such horse-shoes. B and C then, afterward and during the pendency of such suit, entered into an agreement to discontinue such suit, and farther, "that the said parties may each hereafter manufacture and vend spikes of such character and kind as they see fit, notwithstanding their conflicting claims;" and B was to have the sole right to manufacture horse-shoes. *Held*, that such agreement was a license to C to manufacture the hook-headed spike under the patent of B. *Troy Iron and Nail Factory* v. *Corning*, 1 Blatchf., 470, 472.—NELSON, J.; No. N. Y., 1849. [Reversed, *post* 28, 1852.]

16. B having, at the time of the making such agreement, the legal title to the patent, and the suit for the infringement, which was one of the subjects of the settlement, being also in his name, *Held*, that such settlement or agreement bound third parties, who claimed to hold the equitable title at the time of such settlement, and who afterward took the legal title, and that such agreement of settlement was a bar to an action brought by such third parties against C; and particularly as B, at the time of such settlement, was the agent of such third parties, and largely interested with them in their business. *Ibid.*, 474.

17. By an agreement with M., the patentee of the electro-magnetic telegraph, and his associates, O'R., was to construct a line of telegraph "to connect the seaboard line at Philadelphia, or at some other point nearest to Harrisburgh, thence through Harrisburgh to Pittsburgh, and through Wheeling and Cincinnati to St. Louis, *and also to the principal towns on the Lakes.*" *Held*, on a bill filed to restrain the use of M.'s instruments on a line of telegraph from Buffalo to Erie, that the line running through the places named might be considered as a base line, and that the whole of the territory north of that line, extending to the towns on the Lakes, was intended to be included in the grant; and that therefore the defendants ought not to be enjoined. *Smith* v. *Selden*, 1 Blatchf., 476–478.—NELSON, J.; N. Y., 1849.

18. *Held*, also, from looking at such telegraph line on the map, or construing the agreement from its subject matter, that the *lakes* contemplated embraced the lakes Erie, Huron, Michigan, and Superior, but that the line specifically named and the lakes in connection therewith, fairly excluded the lake Ontario. *Ibid.*, 478.

19. The reservation of a right, in such agreement, to M. and his associates "to extend a line from Buffalo to connect with the lake towns at Erie," was not an exclusive right, and therefore not inconsistent with the grant to O'R. *Ibid.*, 479.

20. In the case of a well-founded doubt as to the true construction of the agreement, as to the extent of the grant, the conclusion should be against the parties who have made the grant, as they are chargeable with any obscurity in that respect in the agreement. *Ibid.*, 479.

21 K. purchased an interest in a pat

ent, and agreed with the patentee, upon certain conditions, to give his personal attention to manufacturing of machines under the patent; afterward he made a second agreement with the patentee, whereby he, K., agreed to discontinue such manufacture, and the patentee was to carry it on, rendering to K. a certain proportion of the profits. *Held*, that by virtue of such agreements K. was estopped, in an action brought against him by the patentee for continuing such manufacture, and for an account, from setting up the defence that such patentee was not the original and first inventor of the thing patented. *Parkhurst* v. *Kinsman*, 1 Blatchf., 490, 495.—NELSON, J.; N. Y., 1849. [Affirmed 1855, *post* 41.]

22. *Held*, also, that such agreement was not void as being in restraint of trade, and against the principles of public policy, but was simply an ordinary partnership business arrangement. *Ibid.*, 495, 496. [Affirmed 1855, *post* 43.]

23. Where it is evident that the legal effect of a contract, according to the terms of it, is different from the actual agreement made at the time between the parties, a court of equity would probably, upon a proper application, direct the contract to be reformed by the insertion of a clause to the effect claimed. *Woodworth* v. *Cook*, 2 Blatchf., 158.—NELSON, J.; N. Y., 1850.

24. But such contract cannot be reformed, where rights of a *bona fide* purchaser have intervened, which would or might be seriously prejudiced by allowing such contract to be reformed, or defence set up. *Ibid.*, 159.

25. Where a contract as to the use of a patent, provided for a certain mode of ascertaining the amount of fuel saved by it in steam machinery, evidence having been given of that test, it is competent to confirm it by other tests made by others and in other boats. *Wash. &c. Packet Co.* v. *Sickles*, 10 How., 438.—GRIER, J.; Sup. Ct., 1850.

26. A contract to use a patent machine during the continuance of the patent, and to pay therefor a fixed proportion of the value of the fuel saved thereby, is an entire contract, and will not support an action until the expiration of the patent. It would be otherwise if payments had been agreed to have been made by installments. *Ibid.*, 441.

27. A contract for the sale of a patent right for a given sum, to be paid out of moneys which the purchaser should, at his own cost and risk, collect from persons infringing the rights of the patentee within the territory sold, is void, as amounting to champerty, and the assignment of torts. *Wintermute* v. *Humphrey*, 10 West. Law Jour., 52.—STILWELL, J.; Ohio, 1851.

28. An agreement made between B and C and others, providing for the settlement of various matters; the discontinuance of certain suits, and also as to the manufacture of a certain article, as follows: "that the said parties may each hereafter manufacture and vend spike of such kind and character as they see fit, notwithstanding their conflicting claims to this time," must be construed with reference to the situations of the parties to it; and B having claimed that he had the exclusive right, under his patent, to make such spikes, which right the defendant C was infringing, but the defendant claiming that he did not infringe such patent, but made such spikes by an entirely different method, *Held*, that such agreement did not give C a license to make such spikes after B's patent,

but only a right to make them by the same process or machinery he had been before using. *Troy Iron and Nail Fac.* v. *Corning*, 14 How., 213.—WAYNE, J.; Sup. Ct., 1852.

29. An agreement made between the owner of a patent, securing to the grantee the exclusive right to make, use, and sell to others to be used, the machine patented, within a certain territory, but reserving to the grantor the right to sell, within such territory, machines of his own manufacture, does not operate as an assignment or transfer to the grantee of the right and title secured by the patent, within such territory. *Pitts* v. *Jameson*, 15 Barb., 315.—JOHNSON, J.; N. Y., 1853.

30. It is an agreement in the nature of a license to manufacture and sell, but more than a mere technical license; it is a fixed contract right, vested in the grantee, and assignable by him. *Ibid.*, 315.

31. It is however a chose in action, not in possession, and the grantee and his assigns can retain the right only so long as the business is prosecuted under it. Whenever the business is abandoned, the rights secured by the contract revert to the grantor. Then, but not till then, the grantor can sell rights to third persons to make, sell and use, the patented machine, in such territory without being responsible to the grantee, or his representatives, for damages. *Ibid.*, 316.

32. The reservation by the grantor is also a mere personal privilege, and not transferable to others. *Ibid.*, 316.

33. Upon the death of the grantee, the contract, and the rights under it, go to his admininistrators as assets. *Ibid.*, 316.

34. The granting a new license by the grantor, to another person, is no bar to an action on such contract to recover the amount agreed to be paid for machines manufactured under such contract, but may be available by way of recoupment of damages. *Ibid.*, 317.

35. G. made an agreement with B., as follows: "In consideration of one dollar, I engage to grant to B. license to manufacture under my patents and improvements, india-rubber hose, in general, except that made of pure gum." "In the event of the right of said hose being disposed of, said B. is to receive one-half the bonus obtained therefor, it being optional with him to retain, if he prefers it instead, a half-right to manufacture." *Held*, that such agreement embraced a reissued patent; and that B. obtained an immediate right to manufacture, and not merely an obligation for a future right; and that B. could recover of G. one-half of any sales made by G. of the right to make such hose, and that B. became entitled to such moiety immediately upon any such disposal. *McBurney* v. *Goodyear*, 11 Cush., 570, 572.—MERRICK, J.; Mass., 1853.

36. Where by an agreement between S. and L., there was sold by S. to L., the half of a certain machine for making lead, and the one-half of the patent to be obtained therefor, and L was to pay $4,000—$1,500 in a note at fifteen months, and $2,500 in bonds and mortgages; and the agreement was upon the conditions, that if no patent should be obtained for the machine, and, if a certain suit pending against S. and others, as to the right to use said machine, should be determined against S., then the bargain and sale should be null and void. L. was to pay the expenses of obtaining the patent, and it

was to issue in his name, but no time was specified in which it was to be obtained, *Held*, that neither of the conditions mentioned were conditions precedent to the right to the money intended to be secured by the said note. *Selden* v. *Prinyle*, 17 Barb., 468.—WELLES, J.; N. Y., 1854.

37. And though an application for a patent was pending at the time of the making such agreement, and afterward a new application was made, upon which a patent was issued to L., *Held*, that it was to be presumed that the patent issued was the one contemplated by the agreement. *Ibid.*, 469.

38. A stipulation in a patent . .it provided a decree should be entered .r the plaintiffs unless the machine used . the defendant was constructed before the date of the application of plaintiffs for his patent, *Held*, that the time when such machine was so "constructed," meant when it was substantially complete in its operative parts, and that it was not necessary that it should be doing work. *Troy Iron & Nail Fac.* v. *Odiorne*, 17 How., 73.—CATRON, J.; Sup. Ct., 1854.

39. An agreement made by a patentee to assign his patent gives no authority to the grantee to grant licenses to use such patent. The patent must first be assigned to him. *Day* v. *Hartshorn*, MS.—PITMAN, J.; R. I., 1854.

40. To enable a party to justify a right or act done under an agreement which required the performance of certain conditions on his part, he must show a performance on his part of such conditions precedent. *Ibid.*

41. An agreement made with a patentee to manufacture his patented machines upon certain conditions, and making and selling such machines under the patentee's title, estops such party, in an action for account brought by the patentee, from alleging the invalidity of the patent. *Kinsman* v. *Parkhurst*, 18 How., 293.—CURTIS, J.; Sup. Ct., 1855.

42. And even if the patent was invalid, it would not have rendered the sales of the machines illegal, so as to release such party from the obligation to account. *Ibid.*, 293.

43. Nor is such agreement, because stipulating that under certain circumstances one party shall cease their manufacture of such machines void, as being in restraint of trade—as such clause is but a provision for the prosecution of the business in a particular mode, and not for its restraint. *Ibid.*, 293.

44. If, however, such a contract was void as against public policy, it would furnish no answer to a claim for an account of profits realized by prosecuting the business. *Ibid.*, 294.

45. An agreement made between a patentee, who is about to apply for a renewal of his patent with another, that in case of renewal he will convey to him such renewed patent in consideration of a certain sum, is valid, and if the patent is renewed, such agreement conveys to the assignee an equitable interest or title to the entire interest of the assignor, which can be converted into a legal title, by paying or offering to pay the agreed consideration. *Hartshorn* v. *Day*, 19 How., 220.—NELSON, J.; Sup. Ct., 1856.

46. An agreement made between a patentee and a third person, as trustee, that the latter should hold the patent and have the control thereof, for the benefit of those who had a right to use the same, without the written consent

of such trustee, transfers the entire interest and ownership, legal and equitable, of the patentee in the patent to such trustee for the benefit of those interested. *Ibid.*, 220.

47. A neglect or omission to pay to such patentee an annuity, provided for in and stipulated by such agreement to be paid by the trustee to the patentee, will not rescind the contract, or remit to the patentee the interest conveyed. The right to such annuity rests in covenant, for a breach of which an action at law will lie. *Ibid.*, 222.

48. A mutual and reciprocal covenant of an agreement respecting a patent having been broken by one party, he cannot obtain the aid of a court of equity to restrain the other covenanter from its violation. *Clum* v. *Brewer*, 11 Mo. Law Rep., 391.—CURTIS, J.; Mass., 1856.

49. Otherwise, where the covenants are independent, or only collaterally connected, though in the same instrument, or where the breach is of such a nature that it may be fully repaired, and one of the conditions precedent for obtaining relief may be such reparation. *Ibid.*, 392.

50. Where the covenant was, by the owners of a patent, that no right to use the invention should be conveyed without the assent and concurrence of all those interested, *Held*, that a party, who had been guilty of a breach thereof, though through a misapprehension of the construction of the agreement, could not maintain a bill for an injunction to restrain the other covenanter from a similar violation. *Ibid.*, 392.

51. A contract for the purchase of a patent may be rescinded for false and fraudulent representations constituting an inducement to it, and whether the party making them knew them to be false or not. *Gatling* v. *Newall*, 9 Ind., 576.—PERKINS, J.; Ind., 1857.

52. But such representation must be as to a fact or facts, and go to a material issue, and must be one on which the party to whom it is made has a right to, and does rely. *Ibid.*, 576.

53. A party, however, who would rescind a contract on the ground of fraud, must offer to do so within a reasonable time after the fraud is discovered. *Ibid.*, 577.

54. 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 appear that some other or different meaning was intended by them. *Day* v. *Cary*, 4 Blatchf., 273.—INGERSOLL, J.; N. Y., 1859.

55. Deeds must speak for themselves, when able to speak clearly and understandingly. But in giving an interpretation to a particular clause of a deed, we must look to every part of it, in order to ascertain whether such interpretation is the true one. *Ibid.*, 276.

56. Though the construction and interpretation of written instruments is for the court, it will nevertheless bring to its aid the testimony of witnesses to explain terms of art, and make itself acquainted with the material with which the contracts deal, and with the circumstances under which they were made; but neither the testimony of witnesses in general, nor of professors, experts, or mechanics, can be received to prove to the court what is the proper or legal construction of any instrument or writing. *Day* v. *Stellman*, 1 Fisher, 491.—GILES, J.; Md., 1859.

# ALIENS.

**A.** RIGHTS AND LIABILITIES OF, IN RESPECT TO PATENTS..... 128
**B.** RIGHTS OF, AS TO INFRINGEMENT OF TRADE-MARKS..... 128

## A. RIGHTS AND LIABILITIES OF, IN RESPECT TO PATENTS.

See also PATENTS, K.

1. Previous to the act of 1800, the authority given by law to grant patents, was confined to citizens of the United States. *Anon.*, 1 Opin., 110.—LINCOLN, Atty. Gen.; 1802.

2. Under the act of 1800, a foreigner, though having resided within the United States for more than two years, could not have a patent for an invention put into operation by him in another country, before he came here. *Duplat's case*, 1 Opin., 332.—WIRT, Atty. Gen.; 1820.

3. As to the rights of a patentee to surrender a defective patent and take out a new one, there is no difference between a citizen and alien. *Shaw* v. *Cooper*, 7 Pet., 315.—MCLEAN, J.; Sup. Ct.; 1833.

4. By the provisions of the patent acts (1793 and 1800), citizens and aliens, as to patent-rights, are placed substantially on the same ground. In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases the right must be tested by the same rule. *Ibid.*, 316.

5. An alien patentee must put and continue on sale to the public, within eighteen months from the date of the patent, the invention or discovery for which the patent issued. *Hildreth* v. *Heath*, MS. (App. Cas.), CRANCH, Ch. J.; D. C., 1841.

6. If a foreign patentee, or his assignees, do not put their invention on sale within eighteen months after the same is obtained, as required by § 15 of the act of 1836, the patent will be void. *Tatham* v. *Loring*, 5 N. Y. Leg. Obs., 208.—STORY, J.; Mass., 1845.

7. The assignee takes only the right of the foreign inventor, and no more, and is subject to the requirements of the alien clause in § 15 of the act of 1836. *Ibid.*, 208.

8. The alien clause in § 15 of the act of 1836, applies only to alien patentees, and not to American patentees who become such as assignees of alien inventors under § 6 of the act of 1837. *Tatham* v. *Lowber*, 2 Blatchf., 51.—NELSON, J.; N. Y., 1847.

9. Under § 15 of the act of 1836, it is not essential that an alien patentee, or his assignee, should take active means for the purpose of putting the patented invention in the market and forcing a sale, within eighteen months after the date of the patent, but only that he should be ready at all times to sell at a fair price, when a reasonable offer is made. *Tatham* v. *Le Roy*, MS. —NELSON, J.; N. Y., 1849.

10. It is a question for the jury to determine, whether the invention was so put and continued on sale. *Ibid.*

11. A patent obtained by an alien upon an oath, ignorantly or inadvertently made, that he is a citizen of the United States, is void, and not voidably only. *Mini's Assignee* v. *Adams*, 3 Wall, Jr.—GRIER, J.; Pa., 1861.

## B. RIGHTS OF, AS TO INFRINGEMENT OF TRADE-MARKS.

1. The fact that the complainant, in

a suit in equity for an injunction to restrain the fraudulent use of a trade-mark, is a subject of another government, does not alter the rights of the parties, or deprive the complainant of the right to the interposition of court. So far as the subject matter of the suit is concerned, there is no difference between citizens and aliens. *Taylor* v. *Carpenter*, 11 Paige, 296.—WALWORTH, Chan.; N. Y., 1844.

2. In an action for a violation of a trade-mark, it makes no difference that the complainants are aliens; in the courts of the United States alien friends are entitled to the same protection in their rights as citizens. *Taylor* v. *Carpenter*, 3 Story, 463.—STORY, J.; Mass., 1844.

3. The fact that the party complaining of a wrongful use of his trade-marks is an alien, or subject of a foreign government, does not alter his rights, *Coates* v. *Holbrook*, 2 Sand. Ch., 595, 596, 598.—SANDFORD, V. Chan.; N. Y., 1845.

4. Aliens can invoke the jurisdiction of a court of chancery to protect them in the use and possession of their trade-marks, as well as citizens; the courts will never recognize a different rule of right and justice between any class of suitors. *Taylor* v. *Carpenter*, 2 Sand. Ch., 614.—LOTT, Sena.; N. Y., 1846.

5. An alien friend can bring in our courts any action for the violation of his trade-marks, which a citizen can. *Taylor* v. *Carpenter*, 2 Wood. & Min., 9.—WOODBURY, J.; Mass., 1846.

6. And is entitled to recover to the extent of his damages by the loss of sales and the profits made by those using them. *Ibid.*, 9, 15.

7. Being a resident abroad makes no difference in his right, or the jurisdiction of our courts, if the subject matter of the action arises here. *Ibid.*, 17.

8. And he is entitled to this extent, though the articles sold as and for his were not inferior in quality to his. *Ibid.*, 21.

9. As to the right to bring an action for the wrongful or fraudulent use of a trade-mark, there is no difference between a citizen or alien. *Coffeen* v. *Brunton*, 4 McLean Rep., 520.—MCLEAN, J.; Ind., 1849.

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## AMBIGUITY IN PATENTS.

As to how invention should be set forth, see also COMPOSITION OF MATTER, B.; IMPROVEMENT, B.; MACHINE, and SPECIFICATION, B.

1. If the description mixes up the old and the new, and does not distinctly ascertain for which in particular, the patent is claimed, it is void. *Lowell* v. *Lewis*, 1 Mas., 188.—STORY, J.; Mass., 1817.

2. What is claimed as new, must appear with reasonable certainty: it is not left to minute inferences and conjectures, as to what was previously known or unknown: the question is, not what was before known but what the patentee claims *as new*. *Ibid.*, 188.

3. If the terms of a patent are so obscure or doubtful that the court cannot 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 Mas., 476.—STORY, J.; Mass., 1818.

4. A general statement that the patented article is in all respects, without

stating what these are, an improvement on an old article, is no specification at all. *Ibid.*, 479.

5. The specification must describe in full, clear, and exact terms, what the improvements are, or the patentee cannot recover for an infringement. *Evans* v. *Hettick*, 3 Wash., 425.—WASHINGTON, J.; Pa., 1818.

6. Where the construction of the patent and specification, as to the subject of the grant, are doubtful, the affidavits, if more precise, may be resorted to, to explain the ambiguity. This is particularly proper to restrain general expressions in the specification. *Pettibone* v. *Deringer*, 4 Wash., 217.—WASHINGTON, J.; Pa., 1818.

7. Thus, when the patent recited the applicant to be the inventor of an improvement in boring muskets by a twisted screw-auger, and the specification described the manner of making the auger, its form, and how to be used, and the affidavit confined the invention to the improvement in *making augers* for boring musket-barrels, *Held*, that the patent extended only to the *auger*, and not to the method of using it. *Ibid.*, 217, 218.

8. A specification which mixes up the new and the old, but does not explain what is the nature or limits of the invention claimed, cannot be sustained. *Evans* v. *Eaton*, 7 Wheat., 434.—STORY, J.; Sup. Ct., 1822.

9. The invention cannot be made out and shown at the trial, or be established by comparing the invention specified in the patent with former ones in use. *Ibid.*, 434, 435.

10. Where the specification does not describe the invention so as to show in what respect the plaintiff's invention or improvement differs from what had been known or used before, the patent is void. *Langdon* v. *De Groot*, 1 Paine, 207.—LIVINGSTON, J.; N. Y., 1822.

11. The specification described the invention "that it essentially consists in attaching the packet to the steamboat with ropes, chains, or spars, so as to communicate the power of the wave from the towing vessel to vessels taken in tow, and kept always at convenient distance, the manner of applying the power varying in some measure with the circumstances, *Held*, that the description of the invention, if any there was, was too vague and uncertain, and bad. *Sullivan* v. *Redfield*, 1 Paine, 450, 451.—THOMPSON, J.; N. Y., 1825.

12. A description, though in some respects obscure, imperfect, or not so intelligible as to fully answer the objects of the law, is good if it enables the court to specify the improvement or invention patented, from the fact of the patent and accompanying papers. *Whitney* v. *Emmett*, Bald., 315.—BALDWIN, J.; Pa., 1831.

13. The patentee must specify his invention clearly and explicitly; any ambiguity affectedly introduced into the specification, or any thing done to mislead the public, will make it void. *Ibid.*, 319.

14. As to the specification nothing is left to construction as to its requisites or purposes, both being so clearly defined by the statute, and in such a manner as to leave no discretion in the courts to presume what was intended, or to alter, add, or diminish. *Ibid.*, 320.

15. If the specification is wholly ambiguous and uncertain, so loosely defined, and so inaccurately expressed, that the court cannot upon fair interpreta-

tion of the words, and without vague conjecture of intention, gather what it is, the patent is void for such defect. *Ames* v. *Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

16. But if the court can clearly see, by a reasonable use of the means of interpretation of the language used, taking the whole in connection, what is the nature and extent of the claim, then the plaintiff is entitled to the benefits of it, however imperfectly and inartificially he may have expressed himself. *Ibid.*, 485.

17. If there be any ambiguity or uncertainty in any 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 Sumn., 520.—STORY, J.; Mass., 1839.

18. Where a patent is obtained for parts of a machine, involved with other parts which may have been used before, it is essential that the *new* parts should be so distinctly pointed out that the claim may not cover any parts that are old. *Blake* v. *Sperry*, 2 N. Y. Leg. Obs., 255.—JUDSON, J.; Ct., 1843.

19. Whether a patent is void for uncertainty or ambiguity in the description, is a matter of fact to be decided upon the evidence of experts. *Washburn* v. *Gould*, 3 Story, 138.—STORY, J.; Mass., 1844.

20. If the meaning of a patent cannot be ascertained satisfactorily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. *Emerson* v. *Hogg*, 2 Blatchf., 6.—BETTS, J.; N. Y., 1845.

21. If the specification is so uncertain as to whether a particular thing is claimed as a part of a new combination, or as a new invention, as to be unintelligible, it is void, but may be surrendered and amended. *Hovey* v. *Stevens*, 1 Wood. & Min., 302.—WOODBURY, J.; Mass., 1846.

22. The patentee in the description of his invention is not to be confined to technical language, but may make use of that which is in popular use, and better understood by all. The fewer technical terms used the better, if the subject is intelligible without them. *Hovey* v. *Stevens*, 3 Wood. & Min., 28.—WOODBURY, J.; Mass., 1846.

23. If the description is so uncertain and obscure as to what was meant, and what is in fact the novelty, that it cannot be determined whether the improvement consists in the combination of the whole, or of all the parts, or only of some of them, and of which—or of an invention of some, and if so, of what—the uncertainty will be fatal, and the patentee will be under the necessity of making a new specification, setting forth his claim with greater certainty, accuracy, and clearness, and disclaiming all not new. *Ibid.*, 30–32.

24. The degree of clearness and freedom from ambiguity required in the specification, under the act of 1793, is to "distinguish the invention from things before known, and to enable any person skilled in the art or science to make and use the same." This is necessary to enable the Commissioner of Patents to judge whether the matter claimed is new or too broad—and to enable the courts, when the patent is afterward contested, to form a like judgment—and also to enable the public to understand what the patent is, and refrain from its use, unless licensed

*Hogg* v. *Emerson*, 6 How., 484.—WOODBURY, J.; Sup. Ct., 1847.

25. But the patentee need not describe particularly, and disclaim all the old parts, and that is especially unnecessary when such disclaimer is manifestly in substance the result of his claiming as new only the portions which he does describe specially. *Ibid.*, 485.

26. If the invention is not described with reasonable certainty and precision, the patentee can claim nothing under his patent. *Parker* v. *Stiles*, 5 McLean, 54.—LEAVITT, J.; Ohio, 1849.

27. Patents should be construed liberally to support the claims of meritorious inventors. But there should not be such a liberality of construction, which is injurious to the public, and permits the inventor to couch his specification in such ambiguous terms that its claims may be expanded or contracted to suit the exigency. *Parker* v. *Sears*, 1 Fisher, 100.—GRIER, J.; Pa., 1850.

28. Where in an improvement in the construction of cars for railroads, the most essential feature of which consisted in the location of the two sets of trucks relatively to each other—as remotely from each other as can be conveniently done for the support of the carriage—and in the near proximity of the two axles of each truck to each other—as near as possible to each other, and prevent their contact with each other, *Held*, that the specification was sufficiently definite without specifying in feet and inches the exact distance from the ends of the car body at which it would be best to arrange the trucks, or the exact distance between the two axles. *Winans* v. *Schenec. & Troy R. R. Co.*, 2 Blatchf., 295, 297.—NELSON, J.; N. Y., 1851.

29. If any thing is included in a patent which is not new, the patent is void. If what is new be mixed up with what is old, the patent is no protection for either. *Holliday* v. *Rheem*, 18 Penn., 469.—BLACK, Ch. J.; Pa., 1852.

30. The specification of an invention for the use of anthracite coal, with a blast, in the common glass furnace, omitted to set forth the peculiar mode of regulating the blast, so as to produce a *diffused* and not a *concentrated* heat, in which consisted the great advantage of the invention. *Held*, that under § 6 of the act of 1836, it was too vague to warrant a patent. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

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## AMOUNT IN CONTROVERSY.

1. In cases arising under the patent laws, the jurisdiction of the Circuit Courts does not depend upon the citizenship of the parties to the action, or the amount in dispute, but upon the subject matter. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

2. Under § 17 of the act of 1836, a writ of error or an appeal may lie to the Supreme Court, under an order of the court, although the judgment is under the sum of $2,000. *Foote* v. *Silsby*, 1 Blatchf., 544. NELSON, J.; N. Y. 1850.

3. The jurisdiction of the Circuit Court embraces all cases, both at law and in equity, arising under the patent laws for infringement of letters patent, without regard to the citizenship of the parties, or the amount in controversy. *Day* v. *Newark I. R. Co.*, 1 Blatchf., 630.—NELSON, J.; N. Y., 1850

4. Where a bill is filed to enforce a specific performance of a contract in relation to a patent, the Supreme Court has no appellate jurisdiction, unless the matter in controversy exceeds the value of two thousand dollars. *Brown* v. *Shannon*, 20 How., 56, 57.—TANEY, Ch. J.; Sup. Ct., 1857.

5. The court may, however, lawfully exercise its jurisdiction, when a far less amount is in dispute, if a party is proceeding in law or equity for the infringement of a patent-right to which he claims to be entitled. *Ibid.*, 56.

6. The amount of the penalty in a bond taken on an injunction in the court below, cannot be referred to, to give jurisdiction. *Ibid.*, 58.

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## ANALOGOUS USE.

See DOUBLE USE; "NEW APPLICATION OR USE."

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## ANALYSIS.

1. Analysis is the only mode by which the human judgment can rest upon absolute certainty. There are but few questions which may be decided by the power of analysis, chemically or mathematically. But where this is done satisfactorily, truth is attained. *Allen* v. *Hunter*, 6 McLean, 312. MCLEAN, J.; Ohio, 1855.

2. The testimony of a chemist, who has analyzed the ingredients of a composition of matter, as to the nature of such composition, is not matter of opinion, but evidence of a fact demonstrated. *Ibid.*, 312.

## ANSWER.

See EQUITY, B. 5.

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## APPEALS.

### IN PATENT CASES.

**A.** TO THE SUPREME COURT..... 133
**B.** TO JUSTICES OF THE CIRCUIT COURT, DISTRICT COLUMBIA.
1. *What is; when lies and when not; when lost*..... 135
2. *Duty of Commissioner of Patents in cases of*..... ..... 137
3. *Jurisdiction of Justices on Appeal*, 138
4. *"Reasons of Appeal," sufficiency of, &c*..... 141
5. *Practice in cases of Appeal*..... 143

### A. TO THE SUPREME COURT.

See also WRIT OF ERROR.

1. Under § 17 of the act of 1836, if a writ of error is allowed by the court, in cases where the amount in dispute does not reach $2,000, and in such as are deemed "reasonable," it must bring up the whole case for consideration, and the court below cannot determine that only particular points shall be taken up. *Hogg* v. *Emerson*, 6 How., 477, 478. —WOODBURY, J.; Sup. Ct., 1847.

2. The word "reasonable" applies to the cases, rather than to any discrimination between the different points in the cases. *Ibid.*, 478.

3. An appeal lies only from a final decree of the court below. A decree for a perpetual injunction, in a patent case, and a reference to a master to report the damage sustained by the plaintiff is not a final decree within the practice

of the court, so that an appeal will lie. *Barnard* v. *Gibson*, 7 How., 657, 658.—McLean, J.; Sup. Ct., 1848.

4. Under § 17 of the act of 1836, an appeal or writ of error lies to the Supreme Court, under an order of the court, although the judgment is under the amount of $2,000. *Foote* v. *Silsby*, 1 Blatchf., 544.—Nelson, J.; N. Y., 1850.

5. The last clause of § 17 of the act of 1836, providing for appeals and writs of error in all other cases "in which the court shall deem reasonable," does not apply to a suit in equity to set aside an assignment of a patent. *Wilson* v. *Sandford*, 10 How., 101, 102.—Taney, Ch. J.; Sup. Ct., 1850.

6. The right of appeal is confined to the cases mentioned in the first part of the section, "to actions, suits, controversies and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries," and was intended to secure uniformity of decision in the construction of the acts of Congress in relation to patents. *Ibid.*, 101.

7. The law gives a party aggrieved an appeal from a final decree of an inferior court. But it does not give a party who is not aggrieved, an appeal from a decree in his favor, because the judge has given no reasons, or insufficient ones for the judgment admitted to be correct. *Corning* v. *Troy Iron and Nail Fac.*, 15 How., 465.—Grier, J.; Sup. Ct., 1853.

8. Where a complainant in a patent suit had a decree in his favor, but not to the extent prayed for in his bill, and the respondent appealed, *Held*, if the complainant desired a more favorable decree, he must enter a cross appeal, that when the decree comes before the appellate court, he may be heard. *Ibid.*, 466.

9. A second appeal lies only when the court below, in carrying out the mandate of the Supreme Court, is alleged to have committed an error. But on an appeal from a mandate, nothing is before the court but the proceedings subsequent to the mandate. *Ibid.*, 466.

10. The defendant, in a suit in equity, took two grounds of defence; the Circuit Court decided against him on one, and dismissed the bill on the other; on appeal to the Supreme Court, the decree was reversed, and the cause remanded. *Held*, that the defendant could not then appeal from the decision of the Circuit Court on the ground originally decided against him. *Ibid.*, 466.

11. An objection to the joinder of an assignor with an assignee, as complainant in a bill, comes too late on appeal. *Livingston* v. *Woodworth*, 15 How., 557.—Daniel, J.; Sup. Ct., 1853.

12. The discretionary power as to granting appeals and writs of error in patent cases, vested in the Circuit Courts by § 17 of the act of 1836, is confined to cases which involve the construction of the patent laws, and the rights of patentees under them; and does not justify the allowance of a writ of error, merely to review a question of costs. *Sizer* v. *Many*, 16 How., 103.—Taney, Ch. J.; Sup. Ct., 1853.

13. A motion to allow an answer to be filed in a patent case made after the bill has been taken *pro confesso*, is addressed to the discretion of the court; and for a refusal to grant such leave, an appeal does not lie to the Supreme Court. *Dean* v. *Mason*, 20 How., 204.—McLean, J.; Sup. Ct., 1857

## B. To Justices' Circuit Court, District Columbia.

### 1. *What is; when lies and when not; when lost.*

1. Whether a second rejection of an application, by the Commissioner, after an appeal to the justices of the Circuit Court, for reasons untouched by the decision of the judge, would be the subject of appeal; *query*. *Arnold* v. *Bishop*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1841.

2. The object of giving an appeal is to correct the error of the Commissioner *in refusing* to grant the patent applied for. His error in *granting* a patent is corrected by the ordinary tribunals of the country, and needs no special tribunal for such purpose. *Pomeroy* v. *Connison*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1842.

3. An appeal is given to a disappointed applicant, because otherwise the decision of the Commissioner would be conclusive against him. It is not given to the patentee, because the decision is not only not conclusive as to him, but does not in any manner affect his legal or equitable rights. *Ibid.*

4. Under the patent laws no appeal can be taken from the decision of the Commissioner of Patents, unless the application for a patent is rejected by him. In no case can an appeal be taken to the granting of a patent. A *patentee* has no right of appeal from the decision of the Commissioner of Patents granting a patent to another person. *Ibid.*

5. This decision approved and followed in *Whipple* v. *Renton*, Morsell, J., 1854; *Hopkins* v. *Barnum*, Morsell, J., 1854; *Kingsley* v. *Horiet*, Morsell, J., 1854; and in *Drake* v. *Cunningham*, Morsell, J., 1855. [But see *post* 18.]

6. Where the decision of the Commissioner of Patents neither affirms nor denies the right of an applicant to the patent (which he claims), upon the merits of the supposed invention, it is not such a decision as is the subject of appeal under § 11 of the act of 1836. *Janney*, *Ex parte*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1847.

7. Therefore the refusal of the Commissioner to revise and revoke a decision of one of his predecessors in office rejecting an application for a patent, is not a ground of appeal. *Ibid.*

8. A party desiring an appeal in such a case should appeal from the decision refusing his application for a patent. *Ibid.*

9. There is no limitation of time as to the appeal from decisions of the Commissioner. *Ibid.*

10. Nothing preliminary to the issuing of a patent is a valid ground of appeal, unless made so by the law authorizing appeals. *Wade* v. *Matthews*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1850.

11. Questions as to the practicability and usefulness of an invention, and the reducing of it to practice, are matters within the discretion of the Commissioner, and are not made the subjects of appeal. *Ibid.*

12. The filing of the "reasons of appeal" is essentially the appeal itself. *Greenough* v. *Clarke*, MS. (App. Cas.)—Morsell, J.; D. C., 1853.

13. Where the reasons of appeal are not filed within the time prescribed by the Commissioner of Patents, the right of appeal is lost. The Commissioner may, however, enlarge the time to file such reasons. *Ibid.*

14. Under §§ 7, 8, of the act of 1836, two classes of cases are provided for. An appeal is given by § 7 to an applicant where there is no opposing party; and by § 8, where there are interfering applications. And there is nothing in the repealing act of 1839 which takes away or impairs such right. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

15. If competent and material evidence is not admitted by the Commissioner, or inadmissible or incompetent evidence is received, objection being made to its reception, such action may be assigned as a reason of appeal, and the Commissioner is bound to answer it, and the judge to decide upon it, and afford relief. *Ibid.*

16. The refusal of the Commissioner of Patents to grant a rehearing, or second interference, is not the subject of appeal. *Rouse, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1854.

17. An appeal lies from a decision of the Commissioner of Patents denying a patent to both applicants, as well as when he denies it to one, and grants it to the other. It is from the decision refusing to grant a patent as applied for that the law allows an appeal. *Carter* v. *Carter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

18. Under § 8 of the act of 1836, a patentee has equal right of appeal from a decision of the Commissioner of Patents in favor of an applicant, that an applicant has from a decision in favor of a prior patentee. *Babcock* v. *Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

19. This decision followed in *Spear* v. *Abbott*, DUNLOP, J., 1859; and *Beech* v. *Tucker*., MORSELL, J., 1860.

20. The language of the statute is broad enough to embrace, and does embrace, "a patentee" who is dissatisfied with the decision of the Commissioner of Patents on the question of priority of right or invention. *Ibid.*

21. It cannot be limited to the case of contending applicants. *Ibid.*

22. The phrase "to determine which or whether either of the applicants," &c., was introduced for the purpose of insuring the examination of the question, in the case of contending applicants, by the judge, whether either of the applicants had brought forward a patentable claim. *Ibid.*

23. Within § 11 of the act of 1839, as to the Commissioner regulating the time of appeals, he may extend the time of appeal; it is a matter within his discretion. *Justice* v. *Jones*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

24. No appeal lies from matters which are within the discretion of the Commissioner of Patents, as extending time to take testimony, &c., unless perhaps for a plain abuse of discretion. *Hopkins* v. *Lewis*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

25. It is not proper matter for the appellate tribunal that the Commissioner of Patents has not given a party such reasons for his decision and made such suggestions as enabled him to judge of the expediency of abandoning or modifying his application. *Spencer, Ex parte*; *Munson, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

26. Though the law requires the Commissioner to aid the inventor by information and suitable references to remedy a defective specification or claim, and to assist his judgment in determining whether he should withdraw or persist in a rejected application

—the manner of doing so, how often, and to what extent, is left to the discretion of the Commissioner, and it is not the subject of review whether this duty is well and sufficiently performed in a given instance. *Chambers, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

27. An appeal cannot be made after the time limited in the notice of appeal. *Linton, W., Ex parte*, MS. (App. Cas.) —MERRICK, J.; D. C., 1860.

28. Upon an application for a reissue under § 5 of the act of 1837, asking for several reissued patents, each division or separate patent asked for is not such a separate case, as to require the payment of $25 on an appeal to the judges; but one appeal carries up the *whole* case, not a part; and, notwithstanding that separate reissued patents may be granted. *Selden, assignee, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

## 2. *Duty of Commissioner of Patents, in cases of.*

1. The Commissioner is bound under § 11 of the act of 1839, to furnish to the judges on appeal the grounds of his decision touching the reasons of appeal. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. On an appeal to the judge under § 11 of the act of 1839, the Commissioner of Patents is required to lay before such judge all the original papers and evidence in the case, together with the grounds of his decision fully set forth in writing touching all the points involved in the reasons of appeal, to which reasons of appeal the revision of the judge is to be confined. *Cundell v. Parkhurst*, MS. (App. Case.)—CRANCH, Ch. J.; D. C., 1847.

3. When the Commissioner has laid before the judge the papers, evidence, &c., with "the grounds of his decision," the case is no longer before the Commissioner, and the litigation is closed as between the appellant and the office. *Aiken, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

4. When a party has given notice of an intention to appeal from the decision of the Commissioner of Patents, by presenting his petition, it is the duty of the Commissioner, and exclusively his duty, to fix a reasonable time for filing the reasons of appeal, within which time all further action is suspended. *Greenough v. Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. The Commissioner may enlarge the time to file such reasons, and rehear the case, and this he may do at any time, not only until the patent issues, but until it is actually delivered. *Ibid.*

6. Under the act of 1839, allowing appeals to the chief justice of the Circuit Court of the District of Columbia, and the act of 1852, authorizing like appeals to the assistant justices of the same court, the Commissioner of Patents had no power to make an order, that on account of the infirmity of the chief justice, appeals should be taken to the assistant justices alone, or in default thereof that a patent should issue to the other party. *Anon.*, 6 Opin. 39.—CUSHING, Atty. Gen., 1853.

7. The Commissioner of Patents is to send to the appellate tribunal the reasons of his decision, in answer to the reasons of appeal, in the case of a single application as well as where there are contesting applications. *Henry, Ex*

*parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1856.

### 3. *Jurisdiction of Justices on Appeal.*

1. The power of the justices of the Circuit Court on appeal from the decision of the Commissioner of Patents, under § 11 of the act of 1839, is confined to the points involved in the "reasons of appeal." *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. The revision of the judge on appeal is confined to the points involved in the reasons of appeal, and he is to revise the decision of the Commissioner only in respect to the points involved in the reasons of appeal. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

3. If the Commissioner did not err in those points, his decision must be affirmed, even though the judge should be of opinion upon the evidence and merits of the whole case that such decision was wrong. *Ibid.*

4. The provision of the statute that "the decision of the judge shall govern the further proceedings of the Commissioner in the case" applies only to so much of the case as is involved in the reasons of appeal; and the appeal itself can only be considered as an appeal to so much of the decision as is affected by such reasons. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

5. If therefore after the judge shall have decided in favor of an applicant upon the points involved in his reasons of appeal, other sufficient reasons remain for rejecting the claim for a patent, untouched by the decision of the judge, it would seem that the Commissioner might still reject it. *Ibid.*

6. The proceedings before the Commissioner of Patents, and before the judges on appeal, are all initiatory; all relating to the question whether a patent shall issue, and cannot affect a patent already issued. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

7. The powers and jurisdiction given by the patent law to the judges on appeal are special and limited, and must be construed and exercised strictly. He can only decide such questions and render such judgment as he is expressly authorized by the statutes to decide and render. *Ibid.*

8. The revision of the judge is to be confined to the reasons of appeal, and the grounds of the Commissioner's decision, required by § 11 of the act of 1839, are to be confined to the points involved in the reasons of appeal. *Smith* v. *Flickinger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

9. The revision of the decision of the Commissioner is to be "confined to the grounds of his decision, touching the points involved in the reasons of appeal." *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

10. The revision of the judge on appeal is limited to the points involved in the reasons of appeal, and the questions must be decided according to the evidence produced before the Commissioner. *Warner* v. *Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846. *Perry* v. *Cornell. Ibid.*—CRANCH, Ch. J.; 1847.

11. The jurisdiction given to the judge under § 8 of the act of 1836, is broad enough to include the question

of *interference*, as well as that of *priority*. And the question of *priority* of right of invention necessarily implies *interference*. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

12. But the interference mentioned in § 8 of the act of 1836, must be an interference in respect to patentable matters, and the claims of the applicants must be limited to the matters specifically set forth as their respective inventions; and what is not claimed is to be considered, for the purpose of such interference, as disclaimed. *Ibid.*

13. The decision of the judges on appeal is confined "to the points involved in the reasons of appeal." *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

14. The supervision of the judge is limited to the points involved in the reasons of appeal. *Aiken, Ex parte* (*Propellers*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

15. It is immaterial what reasons the Commissioner assigns for his decision; his reasons may be insufficient, and yet his decision be correct. *Ibid.*

16. The insufficiency of the Commissioner's reasons for rejecting an application is not in itself evidence that his decision is wrong, and is no cause for reversing it. *Aiken, Ex parte* (*R. R. Car Wheels*).—MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

17. The filing of reasons of appeal in the office of the Commissioner of Patents is a proceeding over which the judge on appeal has no control. *Wade* v. *Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

18. If the Commissioner has received and filed the reasons of appeal, the judge cannot order him to strike them out. They must be heard and decided. *Ibid.*

19. The jurisdiction of the judge on appeal is confined to the reasons of appeal, and however worthy of consideration a proposition or argument may be, if not within such reasons, it must be disregarded. *Burlew* v. *O'Neil*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

20. The question of fraud in granting a patent, will not be passed upon by the judge on appeal, but is to be tried by a jury. *Ibid.*

21. All the conditions prescribed in § 11 of the act of 1839 must be complied with, as prerequisites, before the judge can take jurisdiction by way of appeal from the decision of the Commissioner of Patents. *Greenough* v. *Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

22. His jurisdiction is very special and limited, and all the previous circumstances under which it is given must exist, before it can attach, and no other power or authority can be exercised, except that expressly given, or fairly to be inferred. *Ibid.*

23. The judge can judicially know nothing of the case, until the appealing party presents his petition for a revision, which cannot be done until after a decision has been made against him, and he has declared his intention of appealing, and filed his reasons of appeal. *Ibid.*

24. The provision of § 11 of the act of 1839, requiring the judge to hear and determine appeals from the decisions of the Commissioner, "on the evidence produced before the Commissioner," is to be construed in connection with § 7 of the act of 1836, which provides that reasonable notice shall be given both to the party appealing and

the Commissioner, so "that they may have an opportunity of furnishing them, *i. e.* the board of examiners, with such facts and evidence as they may deem necessary to a just decision." *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

25. There is nothing in the repealing act of 1839—which substituted the judge for the board of examiners—which takes away or impairs that right, but every reason to infer that it was intended to be saved to the fullest extent. *Ibid.*

26. Where in a case, a party has been prevented from producing before the Commissioner his proofs to support his claim, it is the duty of the judge to pursue, by reasonable regulations, similar to those directed by § 12 of the act of 1839, such a course as will afford the party an opportunity to produce such proofs. *Ibid.*

27. In such a case, the judge will make an order authorizing the party to take and file with his appeal, evidence as to the originality and utility of his invention. *Ibid.*

28. By § 11 of the act of 1839, substituting the judge in place of the board of examiners created by § 7 of the act of 1836, the judge succeeded to the same authority that such board possessed to require of the Commissioner of Patents and examiners, "information relative to the subject matter under consideration," and to the full extent. *Seeley's App.*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

29. An examiner may therefore be inquired of as to the nature and features of the invention under consideration, and essential to the right claimed, and which may not be sufficiently set forth in the report of the Commissioner. *Ibid.*

30. If *new references*, as grounds for the rejection of an application for a patent, are made at the trial of an appeal, before the judge, and are such as are material, they will be considered as having deprived the applicant of his right of amendment secured by § 7 of the act of 1836, and in such case the decision of the Commissioner will be reversed, and he will be directed to proceed with the case anew. *Jewett & Root, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

31. The provisions of § 11 of the act of 1839, as to the examination, on appeal, of the Commissioner or examiners of the Patent Office on appeals, must be considered in connection with the provision in § 7 of the act of 1836, as to the powers of the old board of examiners. *Richardson* v. *Hicks*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

32. The language of the statute means that the explanation authorized to be required of the Commissioner and examiners, may be so full and clear an explanation of the *principles* of the thing, as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be limited to a mere exposition of the terms used, and such explanations so given, the judge is bound to respect as a part of the case. *Ibid.*

33. The judge on appeals is only required to examine the *conclusions* which the Commissioner of Patents may have arrived at in any given case, and not the *processes* or reasons by which such conclusions may have been attained. *Spencer, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859. [*Eames* v. *Richards*.—MERRICK, J.; 1859.]

34. On appeal, the judge is not at liberty to look into every error of fact or law which may have been committed

in the case, but only to such as have been *specifically pointed out* by the reasons of appeal. *Laidley* v. *James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

35. The judge on appeal has no power to send a case back to the Patent Office to take proof by competent experts, as to the alleged utility of the invention, or to receive or hear such proof on the appeal. *Sanders, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

36. He is limited by law to the papers and evidence which were before the Commissioner.

37. Neither judge on appeal can review a former decision of another judge, or entertain another appeal, in the same case; the former decision is final and conclusive, upon either of the other judges. *Raymond, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

38. Under § 8 of the act of 1836, the judge on appeal is not confined to the question of priority of invention, but he is to determine whether either party is entitled to a patent. His duty is to inquire into all the facts and circumstances given in evidence, which go to invalidate the claim of either applicant. *Lovcridge* v. *Dutcher*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861. *Dyson* v. *Gambril*, MS. (App. Cas.)—DUNLOP J.; D. C., 1861.

39. The judges of the Circuit Court by law can entertain no appeal except from the decisions of the Commissioner. Under the laws prior to 1861, all the decisions of the office, whether by examiners or the old board of appeals, were *in law* the decisions of the Commissioner, when sanctioned by him. Under that system, when a primary examiner refused a patent, or decided an interference, and the Commissioner approved such decision, an appeal lay directly to one of the judges. *Snowden* v. *Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

40. But under the new law of 1861, the primary examiners and the examiners in chief, are all treated as judicial officers, having power without control, within the sphere of their duty, to the exercise of their independent judgment. Their acts are not the acts of the Commissioner, but their own acts. They are no longer mere organs of the Commissioner, but independent officers. He can only reach and overrule them when their judgments come regularly before him *on appeal*. *Ibid.*

41. The appeal to the judges still exists, but it can now only be exercised after the applicant has gone the rounds of all the tribunals erected by the new law, and after the final decision by the Commissioner. *Ibid.*

42. An applicant must go from the primary examiners by appeal to the examiners in chief, and from them by appeal to the Commissioner, and lastly, from the Commissioner to the judges of the Circuit Court. *Ibid.*

## 4. "*Reasons of Appeal*," *sufficiency, &c.*

1. A reason of appeal should not be vague and unsatisfactory, but should involve some point affecting the decision of the Commissioner. The reason that the decision of the Commissioner was in opposition to a clear apprehension of the merits of the case, is insufficient. *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

2. An alleged reason of appeal, "that the decision of the Commissioner was

inconsistent, as opposed to precedents which have governed before, is also insufficient." *Ibid.*

3. Another reason of appeal was, "that the decision of the Commissioner was adverse to the opinions of skilful and competent, practical, and scientific men, who were peculiarly qualified to judge as to the merits of the particular invention." *Held*, that none of these reasons involved the question of novelty, and that the opinion of such experts could not affect the question of novelty. *Ibid.*

4. A reason of appeal "that there was no evidence of any device or arrangement like that of the applicant," *Held*, to be no ground for reversing the decision of the Commissioner, as the Commissioner might have had other grounds than the evidence offered for the rejection. *Crooker Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

5. An objection to the *opinion* of the Commissioner as to the intention of an invention cited as cause of rejection, is not a good "reason of appeal." Whatever may have been his opinion, his decision may be correct. *Ibid.*

6. A reason of appeal, "that the reasons assigned by the Commissioner for rejecting an application, are irrelevant and do not apply to the subject matter," involves no point material to the case. *Aiken, Ex parte* (*Propeller*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

7. It is immaterial what reasons the Commissioner assigns for his decision; his reasoning may be insufficient, and yet his decision be correct. *Ibid.*

8. Insufficient reasons furnish no grounds for reversing his decision. *Ibid.*

9. The insufficiency of the Commissioner's reasons for rejecting an application for a patent, is not in itself evidence that his decision is wrong, and is no cause for reversing it. *Aiken Ex parte* (*R. R. Car Wheel*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

10. The filing of the reasons of appeal in the office of the Commissioner of Patents, is a proceeding over which the judge on appeal has no control. If the Commissioner has received and filed the reasons of appeal, the judge cannot order him to strike them out. They must be heard, and decided. *Wade* v. *Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

11. No reason of appeal can be considered as valid, which would not justify the Commissioner in refusing a patent. *Ibid.*

12. If competent and material evidence is not admitted by the Commissioner, or inadmissible or incompetent evidence is received, objection being made to its reception, such action may be assigned as a reason of appeal, and the Commissioner is bound to answer it, and the judge to decide upon it. *Fultz Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

13. A reason of appeal, "that the decision of the Commissioner is against evidence and the weight of evidence," is entirely too vague and indefinite, within the provisions of § 11 of the act of 1839, as a substantive reason of appeal, "specifically set forth in writing." *Douglass* v. *Blakinton*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

14. No assignment is sufficiently specific which does not, with reasonable certainty, point out the precise matter of alleged error. *Ibid.*

15. The reasons of appeal should be so expressed that the judge may gather from their language what is meant by

them, but they need not be according to any technical formula. *Laidley* v. *James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

5. *Practice in cases of Appeal.*

1 An objection not taken at the hearing or trial before the Commissioner, cannot be made on appeal from the decision of the Commissioner to the judge. *Smith* v. *Flickenger*, MS. (App. Cas.) —CRANCH, Ch. J.; D. C., 1843.

2. The officer of the Patent Office, who may attend before the judge, on an appeal, under the provisions of § 11 of the act of 1839, is not considered as counsel for the Patent Office, or as an advocate of either of the parties litigant. He only attends for the purpose of explaining the decision of the Commissioner. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

3. When an application is finally rejected, no new oath is necessary to enable a party to appeal. *Crooker, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

4. No reply can be admitted before the judge on appeal, to the "grounds of the Commissioner's decision," laid before the judge; and no reply can be filed in the office of the Commissioner to be recorded with the proceedings." *Aiken's Appeal* (*R. R. Car Wheels*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

5. If contesting applicants, in their proceedings before the Commissioner of Patents, or by stipulation in such proceedings, have admitted any statement of facts, as identity of inventions, they cannot deny such identity by their reasons of appeal, and seek a decision of the judge of appeal thereon. *Wade* v. *Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

6. Whether the decision of the Commissioner is correct or erroneous must depend upon the evidence and proofs before him. *Ruggles* v. *Young*, MS. (App Cas.)—MORSELL, J.; D. C., 1853.

7. The filing of the arguments on appeal, by the respective parties, within the time prescribed, may be dispensed with or excused on reasonable cause shown for the omission. *N. E. Screw Co.* v. *Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

8. On appeal, affidavits cannot be considered which were not taken by the authority of the Commissioner, nor acted upon by him in forming his decision. *Jackson, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

9. If objection is not made to the competency of a witness on his examination, and both parties examine him, it will be too late to raise the objection as to his competency, on appeal. *Allen* v. *Alter*, MS. (App. Cas.)—MORSELL, J.: D. C., 1860.

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## APPLICATION FOR PATENT.

A. WHEN AND BY WHOM MADE; EFFECT OF; EFFECT OF DELAY IN MAKING OR PROSECUTING..... 143

B. POWERS AND DUTIES OF COMMISSIONER OF PATENTS, ON APPLICATION FOR AND IN GRANTING PATENTS..... 149

C. WITHDRAWAL OF; EFFECT OF..... 153

### A. WHEN AND BY WHOM MADE; EFFECT OF; EFFECT OF DELAY IN MAKING OR PROSECUTING.

1. Even without a general use of an

invention, with the knowledge and consent of the inventor, an unreasonable and causeless, or faulty delay in taking out a patent, may justly and upon legal principles be considered as amounting to an abandonment. *Treadwell* v. *Bladen*, 4 Wash., 708.—WASHINGTON, J.; Pa., 1827.

2. Though the discovery of a patentee is new, yet if he is guilty of negligence in procuring his patent, by which the invention has become publicly known and used by any persons, he can have no right of action for its infringement. *Whitney* v. *Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

3. An application cannot be made by one joint inventor upon the assignment of the other, but all concerned in the invention must join in the application. *Newton's Case*, 2 Opin., 571.—TANEY, Atty. Gen.; 1838.

4. Vigilance is necessary to entitle an individual to the privileges secured under the patent law. He must show his right to invention, and secure it in the mode required by law. And if the invention, by fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it. *Shaw* v. *Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

5. The statute does not limit any time in which the inventor must apply for a patent, nor does it declare a forfeiture by reason of any delay. Delay, therefore, is unimportant, unless it amount to evidence of abandonment of the claim, and that is proper matter for the consideration of a jury. *Hildreth* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

6. The right of the first inventor is not lost merely by lapse of time between the invention and application for a patent, unless there has been some intermediate public use by the applicant, or by his consent; and especially, where he has been *bona fide* taking measures to improve or perfect his invention, and to prepare for applying for taking a patent. *Ibid.*

7. There is no act of Congress that makes delay in taking out a patent fatal to the 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. *Allen* v. *Blunt*, 2 Wood. & Min., 141, 143.—WOODBURY, J.; Mass., 1846.

8. An inventor should notify the public of his claim, by a caveat or application filed in the Patent Office. But if such claim, though informal, is followed up with reasonable diligence, and eventually the patent granted, it will prevent any right being acquired by strangers in the mean time. *Sparkman* v. *Higgins*, 1 Blatchf., 208.—BETTS, J.; N. Y., 1846.

9. An applicant for a patent will not be defeated of his right to a patent by reason of the Commissioner or officers of the Patent Office, neglecting or mistaking to give correct information to any one respecting the condition of such application. *Ibid.*, 209.

10. It is wholly immaterial to the validity of the patent, whether an invention was long antecedent to the application for a patent, or directly preceding it. *Wilder* v. *McCormick*, 2 Blatchf., 33.—BETTS, J.; N. Y., 1846.

11. The right of the inventor is protected from the time of his application. The delay which may occur in the Patent Office, in making out a patent, cannot operate to the injury of the appli

cant. *Root* v. *Ball*, 4 McLean, 179.—McLean, J.; Ohio, 1846.

12. Priority of application for a patent does not decide priority of invention. *Perry* v. *Cornell*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1847.

13. Before a patent is granted, there is no law that requires the first inventor to disclose his invention within any limited time, nor is there any limitation unless the lapse of time is sufficient to show an abandonment, which is a question for a jury. *Ibid.*

14. The application may be renewed from time to time, on the same or additional evidence, the previous hearings and decisions creating no bar to a farther investigation. *Gay* v. *Cornell*, 1 Blatchf., 509.—Nelson, J.; N. Y., 1849.

15. If an inventor unnecessarily defer his application for a patent, and suffer his invention to go into use, except for the purpose of perfecting it, and testing its utility by proper experiments, and beyond what he has reason to believe necessary for these purposes, his patent is void. *Winans* v. *Schen. and Troy R. Road*, 2 Blatchf., 291, 300.—Nelson, Conkling, JJ.; N. Y., 1851.

16. If a party, who claims to be the first inventor of a machine, neglect to apply for a patent therefor, with a knowledge that another is making application for a patent for the same invention, such conduct will tend to discredit his testimony, as to priority of invention by him. *McCormick* v. *Ketchum*, MS. (App. Cas.)—Morsell, J.; D. C., 1853.

17. Pecuniary inability is a sufficient excuse to an inventor for not prosecuting his invention, or carrying out an intention to secure letters patent therefor. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—Morsell, J.; D. C., 1853.

18. The pecuniary embarrassments of an inventor will excuse, to some extent, his laches in not applying for a patent. *N. E. Screw Co.* v. *Sloan*, MS. (App. Cas.)—Morsell, J.; D. C., 1853.

19. Mere lapse of time between the making of an invention and the application for a patent, is not an abandonment. *Stephenson* v. *Hoyt*, MS. (App. Cas.)—Morsell, J.; D. C., 1854.

20. Slight circumstances are sufficient to rebut any presumption of abandonment. *Ibid.*

21. Parol evidence is not admissible to show when a patent was applied for. *Wayne* v. *Winter*, 6 McLean, 345.—McLean, J.; Ohio, 1853.

22. The Patent Office contains written evidence of the fact, and it must be proved by such evidence. *Ibid.*

23. Mere lapse of time in applying for a patent does not evince that positive abandonment of which the Patent Office can take notice. *Hunt* v. *Howe*, MS. (App Cas.)—Morsell, J.; D. C., 1855.

24. There is no time limited within which an inventor is to disclose his invention before application for a patent. His right can be affected by no lapse of time short of that which will be sufficient to show an abandonment of his claim, during which time no subsequent inventor, however original or *bona fide*, can deprive him of his priority. *Stephens* v. *Salisbury*, MS. (App. Cas.)—Morsell, J.; D. C., 1855.

25. If an inventor after his invention is perfected unreasonably delay his application for a patent, and others, before such application, actually perfect and apply to practical use the same invention, and give the knowledge thereof to the public, and the former, after a knowledge of such subsequent inven

tion and use fail to make objection and apply without unreasonable delay for a patent, he cannot sustain the patent he may afterward obtain, because he has failed to give to the public that consideration for the grant of exclusive privileges, upon which all valid patents must be based. *Ransom* v. *Mayor, &c.*, 1 Fisher, 272.—HALL, J.; N. Y., 1856.

26. The object of the patent laws being not only to benefit the inventor, but also the public or community at large by the use of the invention, after the monopoly has terminated, it follows that an inventor who designedly and with the view of applying it indefinitely and exclusively for his own profits, withholds his invention from the public, comes not within the policy or objects of the constitution or acts of Congress, and is not entitled to favor if during such concealment another person should find out and bring into use the same invention. *Kendall* v. *Winsor*, 21 How., 328.—DANIEL, J.; Sup. Ct., 1858.

27. But this does not forbid a delay requisite for completing an invention or testing its value or success; nor forbid a discreet and reasonable forbearance to proclaim the theory or operation of an invention during its progress to completion, and preceding an application for protection in such discovery. *Ibid.*, 328, 329.

28. An inventor may also forfeit his rights by a wilful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others. *Ibid.*, 329.

29. No particular time is limited by the statute within which an inventor must make application for a patent, yet it ought to be done within a *reasonable time;* what is or what is not a reasonable time depends on the circumstances of each case. *Ellithorpe* v. *Robertson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

30. Where a person made an invention in 1847 and did not apply for a patent until eleven years after, and a patent had been granted more than four years before to another residing in the same place, *Held*, that the first inventor must suffer from his laches. *Ibid.*

31. A party has a right to keep his inchoate right to an invention concealed as long as he pleases, but when he desires to perfect his right to a patent, he must proceed with vigilance. *Ibid.*

32. Under § 7 of the act of 1839, if an inventor, though he may be the first and original one, neglect to apply for a patent within two years after he knows that another has publicly used and claimed his invention, and interposes no objection or warning, he thereby loses his right to a patent. *Justice* v *Jones*, MS. (App. Cas.)—MERRICK, J. D. C., 1859.

33. A made application for a patent in 1855, and obtained a patent early in 1856. B, who claimed to be the first inventor, and who had knowledge of A's proceedings, remained quiet until 1858 or 1859, when he assigned his invention, and application was made for a patent therefor. *Held*, that it was a clear case of disability to prosecute, under § 7 of the act of 1839, even though B was the first inventor. *Ibid.*

34. Merely withholding an invention from the public can never amount to an abandonment, however it may, in connection with other circumstances, pile up difficulties, if too long continued, in the way of asserting and proving priority over another inventor who applies for

a patent. *Babcock* v. *Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

35. When one inventor has knowledge that another has made application for, and has received a patent for the same invention which has also been reissued, and makes no further claim until after such reissues have been obtained, his want of diligence in prosecuting his application will work a forfeiture of his right to a patent. *Wickersham* v. *Singer*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

36. W. made application for a patent in 1851, and in the same year withdrew his application and received the return fee, and took no further steps till 1858. S. had made application for a patent for the same invention in 1850, and obtained a patent therefor in 1851, which had been re-issued in 1854 and 1856. Of all this W. had knowedge. *Held*, that W. had not pursued due diligence in applying for and prosecuting his application for a patent, and had forfeited his right to a patent. *Ibid.*

37. By an 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 he does not intend to abandon it to the public. *Adams* v. *Jones*, 1 Fisher, 530.—GRIER, J.; Pa., 1859.

38. Where a person has made an application for a patent for his invention, the delay interposed either by the mistakes of the public officers, or the delays of courts, and not by any laches of the applicant, cannot affect his rights. *Ibid.*, 530.

39. Where A made an application for a patent in 1850, which was refused, and an appeal taken to the Circuit Court, which was not decided until 1856, when the decision was affirmed, but the original application was not withdrawn, and the applicant continued to insist upon his right to a patent, and a new Commissioner of Patents perceived his novelty and granted him a patent, *Held*, that by such delay he had not lost his right to a patent. *Ibid.*, 529.

40. Though an applicant may be treated as having abandoned his application, if it be not prosecuted with reasonable diligence, involuntary delays, not caused by his laches, will not work a forfeiture of his patent. *Ibid.*, 530.

41. B. made an invention in 1853, but took no steps to obtain a patent until 1859. In 1858, S. patented the same improvement. *Held*, that B., by his delay, had forfeited his right to a patent. *Spear* v. *Stuart*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

42. The statutory bar (§ 7 of the act of 1839) to the inventor who sells, would seem by analogy properly applicable to the inventor who *secretes*. *Ibid.*

43. If an inventor keep his invention a secret, until another has discovered the same thing, and lie by while such other inventor makes application for a patent, and manufactures and sells the article invented, and neglects to give notice of his claim, or make application for a patent, such first inventor will lose his right to a patent. *Savory* v. *Louth*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

44. S. made an invention in 1854, but did not make application for a patent until September, 1858. L. invented the same thing in January, 1858, and made application for a patent therefor in August, 1858, and had manufactured the articles, and put them in market. An interference was declared between such applicants.

*Held*, that S. had forfeited his right to a patent. *Ibid.*

45. If an inventor suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he forfeits his right to a patent. *Ibid.*

46. The concealment by an inventor of his invention for more than two years, works a forfeiture of his right to a patent, the same as if he had sold it for more than two years before applying for a patent. *Ibid.*

47. There can be no doubt that where a party has made an invention, and buried the secret in his own bosom, he may, after the lapse of years, come forward, and upon making a secret known by an application for a patent, obtain a monopoly. *Berg* v. *Thistle*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

48. But if in the mean time another has made the same invention, and has obtained a patent, and the public has thereby become possessed of the discovery, when the first inventor applies, he will be met with the inquiry whether he has used due diligence in communicating his discovery. In such case the first inventor forfeits his claims. *Ibid.*

49. The doctrine of abandonment by suffering an invention to go into public use for more than two years, is wholly distinct from the doctrine of forfeiture in favor of a junior discoverer, who is a prior patentee. *Ibid.*

50. The policy of the patent laws favors diligence and condemns neglect. It is the duty of an inventor, *without delay*, to patent his perfected invention. He has no right to use it himself, or permit others to use it, for any length of time, and then expect a monopoly from the public. *Marcy* v. *Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

51. Where a party made an invention, and made no application for a patent, and the same thing was patented to another, and used under such patent for eight years, and then such inventor asked for a patent, *Held*, that by reason of his laches he was not entitled to a patent. *Ibid.*

52. Where a patent was granted to A, and the same had been publicly and openly used under circumstances that showed that B must have known it, and without objection from B, and B afterward, and just before the expiration of two years from the time of the granting of the patent to A, applied for a patent for the same thing, *Held*, that B must be presumed to have acquiesced in the use by A, and that such acquiescence was a statutory bar to the claim of B, and notwithstanding B had filed a caveat in 1848, and had renewed it within a year before he made application for a patent. *Beech* v. *Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

53. Decisions in *Ellithorpe* v. *Robertson*, MORSELL, J., 1858, and *Wickersham* v. *Singer*, MERRICK, J., 1859, and *Spear* v. *Stuart*, DUNLOP, J., 1859, as to forfeiture of right to a patent approved. *Stirtevant* v. *Greenough*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

54. Long delay and gross neglect on the part of an inventor to give the public the benefit of his invention, by promptly presenting it, after it is perfected, to the Patent Office, will work a forfeiture of his right to a patent. *Loveridge* v. *Dutcher*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

55. Where an inventor suffered his claim to remain before the office for

more than five years, as a rejected application, without any attempt in the interval to protect his rights, *Held*, that he had forfeited his right to a patent. *Raymond, L. Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1861.

56. A negligence in secreting and failing to patent an invention for more than two years after its discovery, forfeits all right to claim a patent. Even the filing a caveat, if filed more than two years after such discovery, will not save the rights of the inventor. *Snowden* v. *Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

57. And it seems that a neglect to continue experiments, or to use any means to perfect an invention during that period, would be equally fatal, or would not stand in the way of a subsequent original inventor, who had conceived and diligently pursued the same invention and obtained a patent therefor. *Ibid.*

58. Where an inventor, who first conceived the idea of an invention, did not apply for a patent until about a year and a half after another had conceived the same idea, and made application for and obtained a patent for the same invention, *Held*, that the former one by his delay had forfeited all right to a patent. *Walker* v. *Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

## B. DUTIES OF COMMISSIONER ON APPLICATIONS FOR, AND IN GRANTING PATENTS.

1. Under the patent laws patents cannot be withheld on moral considerations, under the act of 1793, if the required allegation and oath have been made, a suitable specification filed, and a model deposited. *McDonald's Case*, 1 Opin., 170.—PINCKNEY, Atty. Gen.; 1812.

2. There is no limitation of time within which a patent must be taken out, after specification filed. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

3. The duty of the Patent Office, and of the secretary of state, is confined to issuing patents in the cases and with the forms prescribed by law, and having done this, their duty is at an end. It is not their duty, nor that of the Attorney-General, as their law adviser, to determine what rights are conferred by the patents granted, or what will amount to a violation of those rights. These are questions to be settled by the courts and juries. *Nourse's Case*, 1 Opin., 575.—WIRT, Atty. Gen.; 1822.

4. The authority to issue patents is a limited one, and the party must bring himself within the terms before he can derive any title to demand or hold a patent. *Pennock* v. *Dialogue*, 2 Pet., 18.—STORY, J.; Sup. Ct., 1829.

5. The department acts rather ministerially than judicially in granting patents. A patent issues upon the representation of the party, without entering into an examination of the question of rights conferred by the patent. All the proceedings are *ex parte*, except in the case of interfering applications. *Anon.*, 2 Opin., 455.—TANEY, Atty. Gen.; 1831.

6. A patent may lawfully issue, when all the forms prescribed by law have been complied with, without inquiring whether it will confer any right on the patentee; that is for the decision of the courts. *Ibid.*, 455.

7. The act of Congress directs patents to be issued on certain conditions; these must be complied with in order to give

action to the special proceedings. *Whitney* v. *Emmett*, Bald., 316.—BALDWIN, J.; Pa., 1831.

8. A patent is a matter of right, on complying with the conditions prescribed by law. *Ibid.*, 318.

9. The party applying for a patent must prove either that he is a citizen of the United States, or that he has resided in the United States for two years. Patents cannot be granted to every applicant, but only to certain applicants, and the party applying must prove that he is within the description specified. *Anon.*, 2 Opin., 511.—TANEY, Atty. Gen.; 1832.

10. Patents cannot be granted to every applicant, but only to such as show themselves to be within the description of the statute, as entitled to receive a patent. *Ibid.*

11. Under the act of 1793, the secretary of state, 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. He can exercise no powers but such as are given him. *Grant* v. *Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

12. The Commissioner is bound to issue a patent in the case, and in the circumstances stated in § 7 of the act of 1836. He has in such a case no discretion. *Hildreth* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

13. The dictum of STORY, J., in *Bedford* v. *Hunt*, 1 Mas., 304 (1817), that "the first inventor who has put the invention in practice, and he only, is entitled to a patent," is wholly inapplicable to the question whether the Commissioner of Patents should issue a patent; Mr. Justice Story was not considering the question whether a patent *should be issued*, but whether it should be invalidated by prior use. *Ibid.*

14. Any matter of defence, which it is the peculiar province of a jury to decide, and which is not in § 7 of the act of 1836 made a ground for the refusal of a patent by the Commissioner, should be left by him to be decided by a jury in an action at law. *Ibid.*

15. § 7 of the act of 1836 refers to § 6, and a patent is to be issued only to the discoverer of some new and useful art or improvement; therefore, upon an application for a patent, the Commissioner is to decide in the first place, whether the invention is new and the proper subject of a patent; if not, he is bound to refuse it, although it may not be liable to the particular objections specified in § 7 of the act of 1836. *Kemper*, *Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

16. The Commissioner of Patents may reject a claim for a patent, even after a decision by the judge, on appeal in favor of the applicant, upon the points involved in his reasons of appeal, if other sufficient reasons for such rejection remain, and which are untouched by the decision of the judge. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

17. The proceedings before the Commissioner of Patents, and before the judges on appeal, are all *initiatory*—all relating to the question whether a patent shall issue: they cannot affect a patent already issued. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

18. When a patent has issued, the jurisdiction of the Commissioner is exhausted. He has no further control over it, except under § 13 of the act of 1836,

when it is inoperative by reason of a defective or insufficient specification. *Ibid.*

19. The authority of the Commissioner of Patents to issue patents is not of the nature of *jurisdiction*, in its common law and technical acceptation. The doctrine appertaining to acts or judgments of inferior tribunals, that he who sets up such judgment must aver and prove that the tribunal had jurisdiction in the matter, does not apply to his acts. *Wilder* v. *McCormick*, 2 Blatchf., 34. —BETTS, J.; N. Y., 1846.

20. Proceedings before the Commissioner of Patents are initiatory. The question is, "whether the patent shall be granted," not "whether it shall be vacated;" and a patent may be granted or refused upon less evidence than would be required to sustain or amend it. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch., J.; D. C., 1847.

21. Some of the provisions of the act of 1836, give a *quasi* judicial character to the action of the Commissioner of Patents in granting a patent; and it has accordingly been generally held, that a patent is to be taken as *prima facie* evidence of the novelty and usefulness of the invention specified in it. *Wilson* v. *Barnum*, 1 Wall, Jr., 349.—KANE, J.; Pa., 1849.

22. The hearing before the Commissioner of Patents, on an application for a patent, is informal and summary, and not final. *Gay* v. *Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

23. The power vested in the Commissioner of Patents, to issue patents for inventions, exists in full force for examination and final decision, until the patent shall have actually issued; and is not controlled or concluded by intervening or interlocutory opinions given in proceedings, as in cases of interference, &c., had or taken during the examination and prior to the final determination and issuance of the patent. *Wade* v. *Matthews*, 5 Opin., 222.—JOHNSON, Atty. Gen., 1849.

24. In deciding upon an application for a patent, the question is not, whether the invention is more useful than others, but whether it is new and sufficiently useful to justify a patent. *Aiken, Ex parte* (*Propellers*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

25. Under § 7 of the act of 1836, upon an examination of an application for a patent, if it appears that the matter for which the patent is claimed, had not been invented or discovered by any person in this country prior to the invention or discovery by the applicant, or had not been patented or described in any printed publication, or had not been in public use, or on sale, with the consent and allowance of the applicant, it is *the duty* of the Commissioner to grant a patent, if, in his opinion, the thing is *sufficiently useful or important*. *Aiken, Ex parte* (*Car Wheels*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

26. Since the act of 1836, the Commissioner of Patents acts *quasi* judicially on the subjects of originality and novelty and utility of invention. He is bound to inquire and decide these questions before granting a patent. Such action, however, being *ex parte*, is not conclusive on those who are not parties to the proceeding. *Goodyear* v. *Day*, MS. —GRIER, J.; N. J., 1852.

27. Upon an application for a patent, the question for the Commissioner to determine is, whether the applicant is the first inventor of the thing for which a patent is sought; and testimony showing that another is the first inventor, is properly received, though such testi-

mony might invalidate the rights of such other party to a patent, if an application by him for a patent was under consideration. *Burlew* v. *O'Neil*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

28. There is nothing in the acts of Congress which requires that a patent should be issued within any given time, after the application is filed, or which forbids the postponement of it for a time, at the suggestion either of the applicant or the office. *O'Reilly* v. *Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

29. It has always been the practice, when a foreign patent is desired, to delay the issuing of a patent here, after application filed, for fear of injuring such foreign application. *Ibid.*, 126.

30. Upon an application for a patent, the applicant is entitled to notice of such information and *references*, as may go to show, that for any of the causes stated in § 7 of the act of 1836, he is not entitled to a patent, so that he may be able to amend his specification so as to include only what is new. *Jewett & Root, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

31. If new references, which are material, are made on the trial of an appeal, they will be considered as having deprived the applicant of his right of amendment secured by § 7 of the act of 1836, and in such case the decision of the Commissioner will be reversed, and he will be directed to proceed with the case anew. *Ibid.*

32. The proceedings before the Commissioner are initiatory, and from the nature of the case, not unlike the practice in the incipient stages of many other allowed cases. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

33. The Commissioner of Patents, up to the moment of issuing a patent, has a discretion to rehear a case, before decided by him, and ought to do so, until he is convinced as to the true inventor, to whom alone the patent ought to be issued. *Rouse, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1854.

34. § 8 of the act of 1836 is, however, satisfied by giving one trial between the same parties, on the same subject. *Ibid.*

35. The jurisdiction of the Commissioner of Patents in determining as to the issuing of a patent is a limited one, but is to be understood, not only from what is expressly stated in the statute, but also from what ought necessarily to be inferred, as absolute within its proper limits as that of a tribunal of general jurisdiction. *Hunt* v. *Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

36. The Commissioner of Patents, in issuing letters patent does not warrant the same, nor does the patent bind the government more than it does private persons; but the validity of such patents is open to inquiry, either in whole or in part, whether at the instance of private persons or of the United States. A patent does not conclude any body. *Morton's Case*, 8 Opin., 277.—CUSHING, Atty. Gen.; 1856.

37. On an application for the issue of a patent, it is the duty of the Commissioner to decide all questions, both of law and fact, which go to establish the right, or the absence of right, in the applicant to a patent. *Marcy* v. *Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

38. A Commissioner must abide by the decision of his predecessor as to any matter adjudicated upon, while that

decision is unreversed by any competent court. *Larowe, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

39. Where a former decision of a Commissioner as to a particular matter is unappealed from and remains unreversed, and the application is not withdrawn, such decision is binding upon a subsequent Commissioner, and he cannot collaterally review and reverse it. *Simpson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

## C. WITHDRAWAL OF APPLICATION; EFFECT OF.

1. A caveator having proceeded to file his description, specifications, drawings, and model, having paid the ten dollars required by statute, in addition to the twenty required on the caveat, is entitled, upon a rejection of his application for a patent, to demand a return of twenty dollars. *Anon.*, 6 Opin., 37.—CUSHING, Atty. Gen.; 1853.

2. The provisions of § 7 of the act of 1836, as to withdrawals, apply to all persons, whether applicants by specification, &c., complete at the outset, or applicants by application incomplete and with caveat, and whether citizens of the United States, aliens having resided one year, and made the oath of intention to become a citizen, or others the subjects of any foreign government. *Ibid.*, 38.

3. Every applicant for a patent has a right to withdraw his application, and demand the restoration of two-thirds of the patent fee, after his application is complete, and as well before an examination has been had on his application, as after it has taken place. *Farrish & Keeler's Case*, 7 Opin., 394.—CUSHING, Atty. Gen.; 1855.

4. There is no law allowing a caveator to withdraw any portion of the fee required in filing his caveat. *Anon.*, MS.—BLACK, Atty. Gen.; 1857.

5. The withdrawing an application and receiving back the allowed part of the patent fee will be considered as a final abandonment of the further prosecution of the claim, and effects an entire extinction of all protection (saving any privileges under § 7 of the act of 1839), and which cannot be revived by any new application. It is not a mere relinquishment of any claim to the model. *Mowry* v. *Barber*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

6. The withdrawal of an application after return of part of the patent fee is not itself an abandonment or dedication of one's invention to the public, but is an equivocal act to be interpreted by surrounding circumstances, and to be affected upon a second application by the subsequent conduct of the party, his diligence or his neglect and delay, in the same manner as his conduct is to be weighed in regard to an original application. *Wickersham* v. *Singer*, MS (App. Cas.)—MERRICK, J.; D. C., 1859.

7. The withdrawal of an application and receiving the fee returnable thereon, and allowing the case then to stand a number of years before further action, will be considered an abandonment of the invention: a subsequent application for a patent for the same invention will be refused on the ground of such abandonment. *Dederick, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

8. If a party, upon a mistaken rejection of his claim by the Patent Office, withdraw his application, and receive the return fee of $20, and acting under such mistake of his rights, occasioned by the error of the Patent Office, suffer

his invention to go into public use, even for several years, and afterward, upon discovering his mistake, apply for and obtain a patent, the withdrawal under such circumstances will not be an abandonment of his right; but the second application, by operation of law, relates back to the date of the first application, so as to cut off the forfeiture which otherwise would have happened by the long intermediate public use. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

9. Where an inventor made an application for a patent for his invention, through an attorney, to whom he gave power to withdraw such application, and the attorney, after a rejection of the application, withdrew such application; and afterward, about two years thereafter, the applicant made a second application for a patent for the same invention, which was rejected on the ground of abandonment, produced by the withdrawal of such first application, *Held*, that the applicant could not overcome such presumption of abandonment, and reinstate his case, on his affidavit that he did not know what authority he gave his attorney, and did not intend to withdraw such application, as such proceeding arose from carelessness. *O'Hara, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

10. A rejected applicant, who has withdrawn his application, may renew it, provided the renewed application is made in a *reasonable* time after withdrawal and return of the fee. *Simpson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

11. If the office has been in error, the *reasonable* time is to be computed, not from the date of the perfected invention, but from the date of the withdrawal, so that the rejected application may be put, *as to time*, upon as good a footing as if the error had not been committed. But such an error does not give an unlimited license as to time. *Ibid.*

12. § 7 of the act of 1839 fixes what is a reasonable time. There is no reason why a renewed application should have more than two years allowed it, computing the time from the date of the withdrawal. Both classes of applications, original and renewed, are applications for patents, and come within the letter and spirit of the statute. *Ibid.*

13. But such renewed application must be made to the Patent Office within such time. Assertions of claim to third persons, or in other ways, will not be sufficient. No one can prevent the bar of limitation attaching by outside continuous claims; he must assert his rights in court, within the prescribed time. *Ibid*

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## ART.

See also EFFECT; PRINCIPLE; PROCESS.

1. A patent may be for a new and useful art; but it must be practical,—it must be applicable and referable to something which may prove it to be useful. *Evans* v. *Eaton*, Pet. C. C., 341.—WASHINGTON, J.; Pa., 1816.

2. Where a patent was for an improvement in the art of making nails, by means of a machine, which cut and headed the nails by one operation, *Held*, that it was not merely a patent for the machine, and therefore that it was of no importance that the machine was composed of parts which had before

been used, but that the patent was for an improvement applied to a practical use, effected by a combination of various mechanical powers to produce a new result. *Gray* v. *James*, Pet. C. C., 400, 401.—WASHINGTON, J.; Pa., 1817.

3. Printing, by copper-plate or letter-press, on both sides of bank-notes, to prevent their counterfeiting, is an art for which a patent will be granted. *Kneass* v. *Schuylkill Bank*, 4 Wash., 12.—WASHINGTON, J.; Pa., 1820.

4. Under § 7 of the act of 1839 are embraced not only patents for machines, manufactures, and composition of matter, but also an invention of a new improvement in an art, as of casting iron, by giving an angular direction to the tube which conducts the metal to the mould, so that the flog or drop will be thrown into the centre, instead of the surface. *McClurgh* v. *Kingsland*, 1 How., 209, 210.—BALDWIN, J.; Sup. Ct., 1843.

5. When art is spoken of as the subject of a patent, it is not an art in the abstract, but it is an art as explained in the specification, and illustrated by a machine, or model, or drawings, when of a character so to be. It means a useful art or manufacture, which must be described with exactness in its mode of operation, and which can be protected only in the mode and to the extent described. *Smith* v. *Downing*, 1 Fisher, 70, 71.—WOODBURY, J.; Mass., 1850.

6. 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 Fisher, 143.—GRIER, KANE, JJ.; Ea. Pa., 1851.

7. A process, *eo nomine*, is not the subject of a patent, under our laws. It is included under the general term "useful art," and an art may require one or more processes or machines in order to produce a certain result or manufacture. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

8. The application of a certain combination and composition of ruled columns in sections to accounts, to show a constant balance thereof, with statements of assets and liabilities on every page of the journal without reference to the ledger, is not an invention of an art, machine, manufacture, or composition of matter, within § 6 of the act of 1836; it is nothing more than a mode of presenting the journal entries of a regular business in a tabular form, and therefore not patentable. *Dixon, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

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## ARTS, LOST.

1. It can hardly be doubted, if any one discovered an art which had been long lost, and it was a useful improvement, that upon a fair construction of the patent laws he would be entitled to a patent. *Gayler* v. *Wilder*, 10 How., 497.—TANEY, Ch. J.; Sup. Ct., 1850.

2. Though not literally the first and original inventor, 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. *Ibid.*, 497.

3. Upon this principle, where an invention—an iron and fireproof safe—had been invented and used by the in-

ventor for years, but no test had been applied to it, and its capacity for resisting heat was not known, and there was nothing to show that any particular value had been placed upon it, and the inventor never made a second one, but used a different one, and the safe itself had disappeared, it was held that it had passed away from the memory of the inventor himself, and of those who had seen it, and that the knowledge of the improvement was as completely lost as if it had never been discovered, and that a subsequent inventor of the same thing, without any knowledge of the former one, was entitled to a patent. *Ibid.*, 498.—(McLean, Daniel, Grier, JJ.; dissenting.)

4. The term lost art is applicable peculiarly to certain monuments of antiquity still remaining, the process of whose accomplishment has been lost for centuries, with all vestige of the archives or records of the nations with whom those arts existed, and the origin or even the identity of which process none can certainly establish. *Ibid.*, 508.—Daniel, J.

5. If a means of producing the effect we see and have among us be discovered, and none can, either by history or tradition, refer to a similar or to the identical process, the inventor of that means may claim the merit of originality, though the work itself may have been produced possibly by the same means. *Ibid.*, 508.

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## ARTICLE OF MANUFACTURE.

See Manufacture.

## ASSIGNEE.

A. Of Copyright and Manuscript..... 156
B. Of Patent
1. *Who is*..... 157
2. *General rights of*..... 157
3. *When patent may issue to*..... 158
4. *When may maintain action*..... 159
5. *Right of, as to disclaimer*..... 160
6. *Right of, in cases of reissue*..... 160
7. *Right of, in extensions*..... 160
C. Of Trade-Marks..... 160

### A. Of Copyright and Manuscript.

1. There can be no doubt but that the rights of an assignee of a manuscript would be protected by a court of equity. *Wheaton* v. *Peters*, 8 Pet., 661.—McLean, J.; Sup. Ct., 1834.

2. An assignee of the exclusive right of acting and representing a drama in certain places, may maintain an action in his own name under the statute, even after a representation by him, for an injunction to prevent its being represented by another within such places. *Roberts* v. *Myers*, 13 Mo. Law Rep., 400, 401.—Sprague, J.; Mass., 1860.

3. And such action may be maintained although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 401. [Contra, 7 *post.*]

4. § 9 of the act of 1831, giving redress for the unauthorized *printing or publishing of manuscripts*, operates in favor of a resident of the United States, who has acquired the proprietorship of an *unprinted* literary composition from a non-resident alien author. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—Cadwallader, J.; Pa., 1860.

5. But this section—and which is the only one enabling a proprietor who de-

rives his title from such an author, to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

6. The only statute that affords redress for unauthorized theatrical representations is the act of August 18, 1856; but this applies only to cases in which copyright is effectually secured under the act of 1831. *Ibid.*, 45.

7. The assignee of a dramatic composition cannot maintain an action for its unauthorized representation by others, unless he has performed all the acts required by law to secure a copyright, including the deposit of a printed copy. The observance and performance of *all* the statutory requirements except the deposit of a *printed* copy, will give no right of action under the statute. *Ibid.*, 45, 46.

## B. Of Patent.

### 1. *Who is, under the Statute.*

1. There are three classes of persons in whom a patentee can invest an interest in the patent. They are an *assignee*, a *grantee* of an exclusive sectional right, and a *licensee*. *Potter* v. *Holland*, 4 Blatchf., 211.—Ingersoll, J.; Nelson, J., concurring; Ct., 1858.

2. An *assignee* is one who has 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 U. S.; and no one unless he has such an interest transferred to him is an assignee. *Ibid.*, 211.

3. A *grantee* is one who has transferred to him in writing the *exclusive* right under the patent, to make and use, and to grant to others to make and use, the thing patented within and throughout some specified portion or part of the United States; and such right must be an *exclusive* sectional right, *excluding* the patentee therefrom. *Ibid.*, 211.

4. A *licensee* is one who has transferred to him in writing, or orally, a less or different interest than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. *Ib.*, 211.

5. The terms *assignee* and *grantee*, as used in the patent law, are not synonymous, but have the separate and distinct meanings above given. *Ib.*, 212.

### 2. *General Rights of.*

1. By § 11 of the act of 1836, a patentee may assign any part of his patent, and the assignment will vest in the assignee the legal right to such part. *Boyd* v. *McAlpine*, 3 McLean, 428.—McLean, J.; Ohio, 1844.

2. An assignee of an invention, takes by his assignment, only the right of the inventor and no more. *Tatham* v. *Loring*, 5 N. Y. Leg. Obs., 208.—Story, J.; Mass., 1845.

3. Where, therefore, the inventors of a certain invention were aliens, but had assigned their invention to citizens of the United States, in whose names the patent was issued, and the invention had not been put on sale as required by § 15 of the act of 1836, *Held*, that the assignees had no title to the invention, because the invention had not been put on sale within eighteen months, and that the patent was also, for that reason, void. *Ibid.*, 209, 210. [Contra, *post* 4.]

4. Assignees of alien inventors, take and hold the patent, which may be issued to them, with all the privileges belonging to American patentees. The alien clause in § 15 of the act

of 1836, as to putting the invention on sale in a certain time, does not apply to such assignees and patentees. *Tatham* v. *Lowber*, 2 Blatchf., 50, 51.—NELSON, J.; N. Y., 1847.

5. But even if such condition attached, they need not prove that they have hawked the patented improvement to obtain a market for it, or that they have endeavored to sell it to any person. *Ibid.*, 51.

6. It rests upon those seeking to defeat the patent to prove that such patentees neglected or refused to sell for reasonable prices, when application was made to purchase. *Ibid.*, 51.

7. As between the right of a person holding a contract for an interest in a future term of a patent not yet *in esse*, and that of a subsequent *bona fide* purchaser, for a valuable consideration, and without notice, of the same interest, the latter must prevail. *Gibson* v. *Cooke*, 2 Blatchf., 150.—NELSON, J.; N. Y., 1850.

8. Where an assignment of a patent is made before application, and a patent is afterward obtained, such a contract will secure to the assignee the right thereby conveyed to him. *Rathbone* v. *Orr*, 5 McLean, 132.—MCLEAN, J.; Ohio, 1850.

9. If, after the assignment of a patent, the patent issue to the inventor, a new assignment is not necessary; the legal right to the monopoly and the property it created is vested by operation of the assignment in the assignee. *Gayler* v. *Wilder*, 10 How., 494.—TANEY, Ch. J.; Sup. Ct., 1850.

10. The purchaser of an exclusive privilege of *making* and *vending* a thing patented buys a portion of the franchise conferred by the patent. He obtains a share in the monopoly which is derived from, and exercised under the protection of the United States, and the interest he acquires necessarily terminates at the time limited for its continuance by the law which created it. *Bloomer* v. *McQuewan*, 14 How., 549.—TANEY, Ch. J.; Sup. Ct., 1852.

11. But the purchaser of the thing for the purpose of *using* it in the ordinary pursuits of life stands on different ground. He exercises no right created by the acts of Congress, nor does he derive title by virtue of the franchise, or exclusive privilege granted to the patentee. *Ibid.*, 549.

12. An assignee of a contract, taking *perdente lite*, or with a knowledge of the state of things existing between the original parties to the contract, is bound by the same equities that existed between such parties. *Kinsman* v. *Parkhurst*, 18 How., 294.—CURTIS, J.; Sup. Ct., 1855.

13. An assignor cannot, after assignment, impeach the title of his assignee. *Wilson, Assignee*, v. *Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

### 3. *When Patent may issue to.*

1. Previous to the act of 1837, § 6, patents could only issue to the inventor, and after they were issued, they were assignable so as to give the assignee, in whole or in part, his legal rights. That act gave the right to the assignee or assignees, to have the patent issued to him or them, and not to the inventor. *Anon.*, 4 Opin., 400.—MASON, Atty. Gen.; 1845.

2. An assignment of an invention before patent issued, is valid under § 6 of the act of 1837, although it is made after the rejection of the assignor's application by the Commissioner, and

after his appeal to the Chief Justice of the Circuit Court of the District of Columbia from such decision. *Gay* v. *Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

3. If an inventor assign all his right in an invention, the assignee may have the patent issued to himself. *Ager's Case*, MS., Opin.—BLACK, Atty. Gen.; 1859.

4. But if the assignment be only partial, though the part excepted is small, the assignee has no legal claim to the patent. It must be issued in the name of the inventor, and be held by him in trust for the use of the assignee, to the extent of the equities he has by virtue of his contract. *Ibid.*

### 4. *When may maintain Action.*

1. Under § 5 of the act of 1793, an assignee of a part of a patent-right cannot maintain an action for a violation of it. *Tyler* v. *Tuel*, 6 Cra., 327.—CURIAM; Sup. Ct., 1810.

2. But if a patentee has sold a moiety of his invention to another, a joint action lies under such § 5 by himself and such assignee, for a violation of the patent. The action is brought by those who have the whole patent in themselves which distinguishes it from the case of *Tyler* v. *Tuel. Whittemore* v. *Cutter*, 1 Gallis., 430.—STORY, J.; Mass., 1813.

3. A patentee cannot maintain an action for an infringement after he has made an assignment of his invention; but the suit must be brought by the assignee. *Herbert* v. *Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

4. And it will make no difference that the assignment was made before patent issued, and the patent afterward taken out in the name of the inventor. *Ibid.*, 15.

5. Whether an assignee of part of a patent, circumscribed as to the interest by local limits, can, in his own name, or with the patentee, maintain a suit at law or not, there can exist no doubt but that he may support a suit in equity to enjoin third persons from infringing the patent, and for an account. *Ogle* v. *Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

6. An assignee of a part interest, which is exclusive, in a patent, may, at law or in equity, maintain a suit for infringement, without joining the patentee. *Brooks* v. *Bicknell*, 3 McLean, 250.—MCLEAN, J.; Ohio, 1843.

7. The assignees of an exclusive right in a patent are the proper persons to maintain an action for a violation of such right. *Washburn* v. *Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1844.

8. The grantee of an exclusive right under a patent, though such right may be limited to the use of a certain number of machines within a certain territory or district, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within that district, under § 14 of the act of 1836. *Wilson* v. *Rosseau*, 4 How., 686, 688.—NELSON, J.; Sup. Ct., 1845.

9. An 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 the patent, or a grant or conveyance of the whole interest within some particular district or territory. *Suydam* v. *Day*, 2 Blatchf., 23. NELSON, BETTS, JJ.; N. Y., 1846.

10. An assignee of an invention, by virtue of an assignment made before

patent issued, may file a bill in his own name, under § 10 of the act of 1839, amending § 16 of the act of 1836, against a patentee to whom a patent issued, upon the interfering application of his assignor and such patentee, for the purpose of annulling the patent issued, and having one granted to himself as assignee. *Gay* v. *Cornell*, 1 Blatchf., 507, 509.—NELSON, J.; N. Y., 1849.

11. And such assignment need not be recorded before suit brought; it will be sufficient if it is recorded at any time before the issuing of the patent. *Ibid.*, 510.

12. In an action of infringement, founded upon the non-performance of the conditions of a license, the original patentee and licensee are properly joined as parties plaintiff with the assignee, notwithstanding the whole beneficial interest is in the assignee, inasmuch as he was a party to the agreement or license, and may be interested in the patent and interested in upholding it. *Woodworth* v. *Cook*, 2 Blatchf., 161.—NELSON, J.; N. Y., 1850.

13. An assignee under § 6 of the act of 1837, by an assignment executed before patent issued, even though the patent is issued to the inventor, has the legal title so as to enable him to maintain an action for an infringement. *Gayler* v. *Wilder*, 10 How., 494.—TANEY, Ch. J.; Sup. Ct., 1850.

14. But to enable an assignee of a sectional interest in a patent to sue in his own name, under § 14 of the act of 1836, he must have the exclusive right, or entire and unqualified monopoly, which the patentee held in the territory specified, excluding the patentee himself, as well as others. *Ibid.*, 494.

15. A patentee or his assignee, in assigning the use of a patent within a particular district, may reserve the right to sue for infringements. But if he afterward assigns all his right in such district, the owner of the patent may sue. *Bicknell* v. *Todd*, 5 McLean, 240.—MCLEAN, J.; Ohio, 1851.

16. The assignees of a patent, though their title accrues to them by several deeds, may all join with the holders of the title in an action for the recovery of damages for an infringement of a patent. *Stein* v. *Goddard*, 1 McAllis 84.—MCALLISTER, J.; Cal., 1856.

### 5. *Right of, as to Disclaimer.*

See DISCLAIMER, C.

### 6. *Right of, in cases of Reissue.*

See REISSUE OF PATENT, E.

### 7. *Right of, in Extensions.*

See EXTENSION, C.

## C. TRADE-MARKS. RIGHTS OF.

1. Where a person has purchased of another the secret of preparing an article, and also the right to use his name, and continued to manufacture and sell such article, under the name of the original manufacturer, whether, under such circumstances, a court of equity would be bound to protect him. *Partridge* v. *Menck*, How. App. Cas., 559, 560.—WRIGHT, J.; N. Y., 1848.

2. Is not such a proceeding a deception upon the public, inducing others to believe they are purchasing an article manufactured by the original manufacturer, when in truth he has no concern in it? *Ibid.*, 559, 560.

3. It is no answer that the complainant obtained the secret from the original manufacturer, or that the article

sold is in all respects equal to that offered by the former proprietor. *Ibid.*, 559.

4. The privilege of deceiving the public, even for its own benefit, is not a subject of commerce. *Ibid.*, 559.

5. The acquiescence of a manufacturer in the use or imitation of his trade-mark by another, may be withdrawn; it is no more than a revocable license. *Amoskeag Manuf. Co.* v. *Spear*, 2 Sand., S. C., 615.—DUER, J.; Sup. Ct., N. Y., 1849.

6. The owner of goods, which he exposes to sale in market in his own right, is entitled to the exclusive use of any trade-mark devised and applied by him to the goods, to distinguish them as being of a particular manufacture or quality, although he is not himself the manufacturer, and although the name of the real manufacturer is used as a part of the trade-mark. *Walton* v. *Crawley*, 3 Blatchf., 448.—BETTS, J.; N. Y., 1856.

7. The assignee of the whole right in such trade-mark, and of the property in the goods to which it is attached, is entitled to the enjoyment of the exclusive right thereto, and may maintain an action in his own name for any wrongful use by others of such trade-mark, to the like extent as the originator thereof. *Ibid.* 448.

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## ASSIGNMENT.

**A.** OF COPYRIGHT AND MANUSCRIPT.. . 161
**B.** OF INVENTION OR PATENT.
1. *What may be assigned, and when; who may make; kinds of* .... 162
2. *Recording of*..... 164
3. *What amounts to; construction and effect of*..... 166
**C.** OF PATENT OR COPYRIGHT BY OPERATION OF LAW..... 169



### A. OF COPYRIGHT AND MANUSCRIPT.

1. An assignment of an interest in a copyright must be in writing to be valid and operative; but an *agreement* to assign may be by parol. *Gould* v. *Banks*, 8 Wend., 565.—NELSON, J.; N. Y., 1832.

2. Where the assignment of a copyright is a precedent performance, the assignment, which is to be made and tendered, must be in writing. *Ibid.*, 566.

3. Where A employed B to compile a school book, and agreed to pay him $500, and B conveyed to A the "copyright," *Held*, that only the usual copyright of fourteen years, then existing or taken out, passed under the contract. *Pierpont* v. *Fowle*, 2 Wood. & Min., 42, 43.—WOODBURY, J.; Mass., 1846.

4. Such an assignment is to be referred to what was then in existence, and not to any future contingency. *Ibid.*, 43, 45.

5. A usage among booksellers to regard the renewed term as passing with the first one does not control the rights of those unacquainted with the usage, or not belonging to the fraternity of booksellers. *Ibid.*, 43.

6. An assignment of a "copyright" should not by construction be extended beyond the first term, unless it seems to be actually so meant by the author, and to include any future contingency. *Ibid.*, 44.

7. Otherwise, if the contract of sale or assignment uses language looking beyond the existing copyright, such as referring to all the *interest* in the matter, or to the *manuscript* or book itself, or using some other expression more comprehensive than the word "copyright." *Ibid.*, 45.

8. An assignment of a copyright, although not recorded, is still valid as between the parties, and as to all persons not claiming under the assignors. *Webb* v. *Powers*, 2 Wood. & Min., 510.—WOODBURY, J.; Mass., 1847.

9. The right of property in a manuscript may be transferred or abandoned, the same as any other right of property. *Bartlett* v. *Crittenden*, 5 McLean, 41.—MCLEAN, J.; Ohio, 1849.

10. An acquiescence in the publication of a manuscript or in the republication of a printed book, authorizes a presumption of assignment or abandonment. *Ibid.*, 41.

11. But a gift of a copy of a manuscript is not a transfer of the right or an abandonment of it, any more than the gift of a copy of a printed book is a transfer or abandonment of the exclusive right to republish it. *Ibid.*, 41.

12. The statute of 1834, sanctioning assignments of copyrights, prescribes only the instrument by which they may be assigned, and the mode of recording, but does not define what interest may be assigned. *Roberts* v. *Myers*, 13 Mo. Law Rep., 401.—SPRAGUE, J.; Mass., 1860.

13. There is no sufficient reason for preventing an author conveying a distinct portion of his right. Divisibility as well as assignability enhances the value of his property. *Ibid.*, 401. [But see *post* 15.]

14. In this case the assignment under which suit was brought was of the exclusive right of acting and representing a certain drama, within the United States, except as to five cities, for the term of one year, *Held*, by the court, that such an assignment was valid under the statute. *Ibid.*, 400, 401.

15. The statutes of the United States for the protection of authors do not, like those for the benefit of inventors, sanction transfers of limited local proprietorships of exclusive privileges. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 46.—CADWALLADER, J.; Pa., 1860.

16. A writing which is in form a transfer by an author of his exclusive right for a designated portion of the United States operates *at law* only as a mere *license*, and is ineffectual as an assignment. *Ibid.*, 46.

17. But in *equity*, a limited local or other partial assignment, if made for a valuable consideration, is carried into effect whether it would be effectual in law or not. *Ibid.*, 47.

## B. OF INVENTION OR PATENT.

### 1. *What may be made; by whom; kinds of.*

1. A patent-right itself is insusceptible of local subdivision. *Whittemore* v. *Cutter*, 1 Gall., 431.—STORY, J.; Mass., 1813.

2. An assignment of an invention is not void by being executed before the invention is patented. It is a good transfer of the right of the patentee immediately upon his obtaining the patent, and he would be estopped to set up any adverse title. *Herbert* v. *Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

3. As a privilege or monopoly, a patent is an entire thing, indivisible, and incapable of apportionment. *Brooks* v. *Byam*, 2 Story, 525, 552.—STORY, J.; Mass., 1843.

4. By § 11 of the act of 1836, a patentee may assign any part of his invention, and the assignment vests in the assignee the legal right to such part. *Boyd* v

*McAlpine*, 3 McLean, 428.—McLean, J.; Ohio, 1844.

5. An administrator, in whose name a patent has been renewed, may grant an assignment of an interest in such patent. *Brooks* v. *Bicknell*, 3 McLean, 441.—McLean, J.; Ohio, 1844.

6. An inventor may sell future improvements as well as those already made, and a second as well as a first patent for them. *Nesmith* v. *Calvert*, 1 Wood. & Min., 41.—Woodbury, J.; Mass., 1845.

7. The subject matter of a patent is not partible, except in respect to territorial assignments. *Suydam* v. *Day*, 2 Blatchf., 23.—Nelson, Betts, JJ.; N. Y., 1846.

8. An assignment of an invention before patent issued, is valid under § 6 of the act of 1837, though made after a rejection by the Commissioner, and after an appeal to the justices of the Circuit Court of the District of Columbia. *Gay* v. *Cornell*, 1 Blatchf., 509.—Nelson, J.; N. Y., 1849.

9. And an assignment of the whole or any part of the interest in a patent, will be valid, although it is at the time the subject of litigation. *Ibid.*, 510.

10. The act of Congress (§ 11, act of 1836), provides but three kinds of assignment: 1st, as to the whole interest; 2d, as to an undivided part, and 3d, an exclusive right in any district. *Blanchard* v. *Eldridge*, 1 Wall, Jr., 339.—Grier, J.; Pa., 1849.

11. This statute renders the monopoly capable of subdivision as to locality, and in no other way. The patentee cannot carve out his monopoly, which is a unity, into a hundred or more, all acting in the same place, and liable to come into conflict. *Ibid.*, 340.

12. An interest in a grant of a future term of a patent, not yet *in esse*, is not the subject of assignment or grant at common law, or within the meaning of § 11 of the act of 1836, and the right for such interest rests only in contract. *Gibson* v. *Cook*, 2 Blatchf., 149.—Nelson, J.; N. Y., 1850.

13. An invention may as well be sold before as after the application for a patent. *Rathbone* v. *Orr*, 5 McLean, 132.—McLean, J.; Mich., 1850.

14. The provision of the law requiring the application for a patent to be made in the name of the inventor, becomes necessarily a part of the contract—the inventor sells his right, and obligates himself to obtain a patent. *Ibid.*, 132.

15. Under the act of 1836, § 11, an assignment of a patent may be made as well before the issuing of the patent as afterward. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates; and when the party has acquired an inchoate right, an assignment of it is legal. *Gayler* v. *Wilder*, 10 How., 493.—Taney, Ch. J.; Sup. Ct., 1850.

16. Mere delay in actually making an assignment of a patent for some years after an agreement to sell, is not of itself evidence of fraud. *Troy Iron & Nail Fac.* v. *Corning*, 14 How., 209.—Wayne, J.; Sup. Ct., 1852.

17. Whether a patented discovery is partible in its nature, so as to enable the patentee to make separate grants of the various particulars included in it; *query*. *Ritter* v. *Serrell*, 2 Blatchf., 383.—Betts, J.; N. Y., 1852.

18. Congress cannot authorize an inventor to recall rights which he has granted to others; or reinvest him with rights of property which he had before

conveyed for a valuable consideration. *Bloomer* v. *McQuewan*, 17 How., 553. —TANEY, Ch. J.; Sup. Ct., 1852.

19. An assignment, though antecedent to the patent, is a valid legal assignment of the invention afterward patented in the name of the inventor. *Rich* v. *Lippincott*, 2 Fisher, 4.—GRIER, J.; Pa., 1853.

20. One tenant in common has as good right to make, use, and sell to third persons to use the thing patented, as the other tenant in common has. *Ibid.* *Clum* v. *Brewer*, 2 Curt., 524. —CURTIS, J.; Mass., 1855.

21. A paper purporting to be an assignment of an expired patent is void as an assignment. *Bell* v. *McCullough*, 1 Fisher, 381.—LEAVITT, J.; Ohio, 1858.

22. 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. *Day* v. *Cary*, 4 Blatchf., 277.—INGERSOLL, J.; N. Y., 1859.

23. A patent gives the patentee no power to parcel out his one monopoly into a thousand sub-monopolies. He may hold a close monopoly of his right, or he may grant out his entire right. But he cannot divide his right into parts, and grant to one man the right to use it in its connection with or application to one thing, and to another in connection with a different thing, to such an extent as that *purchasers* from any of these persons may not use the fabric purchased exactly as they like; and if they please, in violation of what he has supposed were rights not granted by him. *The Washing Machine Co.* v. *Earle*, 2 Fisher, 205.—GRIER, J.; Pa., 1861.

24. Goodyear, the patentee of vulcanized india-rubber, might have prevented any person from using his fabric for any purpose. But if he grants to A the exclusive right to use it to make "wringers" only, and to B the right to make "tubes" only, A cannot restrain C, who has bought tubes, from converting them into wringers by any process whatever that he, C, pleases. Neither can Goodyear. *Ibid.*, 206.

## 2. *Recording of.*

1. It is the business of the assignee of a patent-right to see that the assignment is put on record. *Morrill* v. *Worthington*, 14 Mass., 393.—CURIAM, J.; Mass., 1817.

2. An assignment of a patent, though not recorded in the office of the secretary of state, is still valid, except as against creditors and subsequent purchasers. *Holden* v. *Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

3. The exclusive right of property in an invention is the creature of statutory law, and must be strictly regulated by its provisions. *Higgins* v. *Strong*, 4 Blatchf., 183.—DEWEY, J.; Ind., 1836.

4. Under § 4 of the act of 1793, an assignment is not valid unless it has been recorded in the office of the secretary of state of the United States. *Ibid.*, 183.

5. And a note given to an assignee, whose assignment had not been so recorded, is without consideration and void. *Ibid.*, 183.

6. An assignment of a particular interest in a patent-right, or a conveyance of a right to use an invention within a limited territory, is not required to be recorded. *Stevens* v. *Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

7. Under § 4 of the act of 1793, until an assignment is recorded, the assignee

was not substituted to the rights and responsibilities of the patentee, so as to maintain any suit at law or in equity, founded thereon. *Wyeth* v. *Stone*, 1 Story, 296.—STORY, J.; Mass., 1840.

8. If the assignment of a patent-right be not recorded in the office of the secretary of state, a note given to the assignee for such right is invalid for the want of consideration. *McFall* v. *Wilson*, 6 Blächf. 260.—CURIAM, J.; Ind., 1842.

9. The statute (§ 11, act of 1836), requiring the recording of an assignment within three months, is merely *directory*, and, except as to intermediate *bona fide* purchasers, without notice, any subsequent recording of an assignment will be sufficient to pass the title to the assignee. *Brooks* v. *Byam*, 2 Story, 542.—STORY, J.; Mass., 1843.

10. Three cases only of the recording of assignments are provided for by the statute: 1st, an assignment of the whole patent; 2d, an assignment of an undivided part thereof; and 3d, a grant or conveyance of an exclusive right under the patent, within any specified part or portion of the United States. *Ibid.*, 542.

11. A grant of a right not being exclusive, need not to be recorded. *Ibid.*, 542.

12. The provision of the statute (§ 11 act of 1836), as to the recording of assignments within three months, is merely directory, for the protection of *bona fide* purchasers, without notice, and is not a prerequisite indispensable to the validity of the assignment. *Pitts* v. *Whitman*, 2 Story, 615, 618.—STORY, J.; Me., 1843.

13. And it is immaterial whether the assignment is recorded before or not till after suit is brought. It is like the common case of a deed required to be registered, where it is sufficient if it be registered before the trial, though after the suit is brought. *Ibid.*, 618.

14. The act of 1836 affixes no penalty or condition, on a failure to have an assignment recorded in three months. The assignment takes effect from its date; but if not recorded within three months, the act imposes no forfeiture. *Boyd* v. *McAlpine*, 3 McLean, 429.—MCLEAN, J.; Ohio, 1844.

15. But after the expiration of three months, if no record has been made of the assignment, and another assignment of the same right is made, the last assignment would be valid, and whether he had or had not notice of the previous assignment. *Ibid.*, 429.

16. The act prescribing the time for recording of assignments is only directory. The recording is not necessary to make the transfer operative, but is only essential to enable the assignee to sue in his own name. *Blanchard's Gun-Stock Turn. Co.* v. *Warner*, 1 Blatchf., 271.—NELSON, J.; Ct., 1846.

17. A patent may be assigned in whole or in part, and such assignments are required to be recorded. *Parker* v. *Haworth*, 4 McLean, 371.—MCLEAN, J.; Ill., 1848.

18. The failure to record an assignment of a patent is not essential to its validity as between the parties, and against strangers. *Case* v. *Redfield*, 4 McLean, 527.—HUNTINGTON, J.; Ind., 1849.

19. The recording of an assignment is only necessary by way of notice to purchasers. *Ibid.*, 527.

20. The recording of an assignment of a patent-right, under § 11 of the act of 1836, is no constituent part of the conveyance, and is required only to give

notice. *Peck* v. *Bacon*, 18 Conn., 388.—Ellsworth, J.; Ct., 1847.

21. Where A assigned to B certain parts of a patent-right, stipulating they were free from incumbrance, and it appeared that before the assignment of B was recorded, the same interest had been assigned to others, of which A had actual notice, but such assignment was not recorded until after B's, *Held*, that such notice precluded A from availing himself of such want of recording as a defence against an action by B for fraud in the assignment to him. *Ibid.*, 384, 388.

22. An assignment of an invention before patent issued, made under the provisions of § 6 of the act of 1837, need not be recorded before bill filed under § 16 of the act of 1836, and § 10 of the act of 1837, to set aside or annul a patent granted to another upon an interference with the application of such assignor; it is sufficient if it be recorded at any time before the issuing of the patent. *Gay* v. *Cornell*, 1 Blatchf., 510.—Nelson, J.; N. Y., 1849.

23. The act of Congress requiring assignments to be recorded is merely directory; and except as to intermediate *bona fide* purchasers without notice, any subsequent recording of such assignments is sufficient to pass the title to the assignee. *Olcott* v. *Hawkins*, 2 Amer. Law Jour., N. S., 319.—Miller, J.; Wis., 1849.

24. By § 11 of the act of 1836, the assignment or grant of an exclusive right in a patent must not only be in writing, but must be recorded within three months, to defeat the right of a subsequent purchaser without notice and for a valuable consideration. *Gibson* v. *Cook*, 2 Blatchf., 148.—Nelson, J.; N. Y., 1850.

25. To guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the Patent Office. Within that period he must protect himself as best he can, as an *unrecorded* assignment would prevail; but it must be an assignment in writing, that *may* be recorded within the time limited. *Ibid.*, 148.

26. The chief object of the requiring assignments to be recorded is manifestly the protection of *bona fide* purchasers, though not specially so declared. *Ibid.*, 148.

27. The patent act of 1836, as to the recording of assignments, is merely directory for the protection of *bona fide* purchasers without notice, and the recording is not a prerequisite to the validity of the assignment. *Louden* v. *Birt*, 4 Ind., 568.—Perkins, J.; Ind., 1853.

28. To render the assignment of a patent valid under § 11 of the act of 1836, it is not essential that it should be recorded. *McKernan* v. *Hite*, 6 Ind., 430.—Gookins, J.; Ind., 1855.

29. The act of Congress requiring assignments of patents to be recorded is merely directory, and designed for the benefit of subsequent *bona fide* purchasers. *Hildreth* v. *Turner*, 17 Ill., 185.—Catron, J.; Ill., 1855.

30. It is not essential to the validity of an assignment of a patent that it should be recorded in the Patent Office. *Sone* v. *Palmer*, 28 Mo. (7 Jones), 539.———, J.; Mo., 1859.

3. *What amounts to; Construction of.*

1. A variance, merely nominal, or not calculated to mislead—between the description of a patent in the specification, and in an assignment, does not indicate fraud, or prevent the right from

passing. *Case* v. *Morey*, 1 N. Hamp., 349.—WOODBURY, J.; N. H., 1818.

2. Mere circumstantial differences between the description in the patent and that contained in an assignment, will not render the assignment invalid. *Holden* v. *Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

3. The deed of assignment conveyed "a new and useful improvement called *a threshing machine*," when the patent was for an "*improvement* in the threshing machine." The assignment also gave the date of the patent and the patentee. *Held*, that the misnomer of the invention in the assignment did not render it void, as the deed furnished sufficient means to correct the mistake, and identify the thing conveyed. *Harmon* v. *Bird*, 22 Wend., 115.—BRONSON, J.; N. Y., 1839.

4. But if otherwise, the deed was not a nullity—it might be reformed in equity. *Ibid.*, 115.

5. An assignment may be exclusive, though limited to a certain number of machines. *Washburn* v. *Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1844.

6. The term *exclusive*, in § 11 of the act of 1836, comprehends not only an exclusive right to a whole patent, but an exclusive right to the patent in a particular section of country. *Ibid.*, 131.

7. In interpreting an assignment, we must look to all the provisions of the instrument, and give such effect to it as its obvious objects and designs require, without nicely weighing the precise force of single words. *Ibid.*, 162.

8. The words "license and empower," need not import any thing different from "grant." In their broad and general sense they are used indiscriminately. A mere "license," strictly speaking, passes no interest, but only makes an action lawful, which, without it would have been unlawful; but if the instrument passes an interest then it becomes a "grant." *Ibid.*, 162.

9. Where a grant to license and empower parties to construct and use fifty patented machines within certain territory, with a covenant that the patentee would not license any other persons to use any such machines in such territory for a given period, and reserving, however, the right to the patentee to construct and license such machines elsewhere, *Held*, that the grant was of an exclusive right under the patent. *Ibid.*, 160, 161, 166.

10. The limitation of the number of machines, to be made or used under a patent, is not inconsistent with the grant of an exclusive right in the patent, within such territory. *Ibid.*, 167, 168.

11. A surrender of letters patent renders void all assignments under such patent, so far as those are concerned who assent to such surrender. *Gibson* v. *Richards*, Index Pat. Dec., No. 376.—NELSON, J.; N. Y., 1845.

12. An assignment of an exclusive right to make, use, and vend to others, a patented machine within a certain territory only, does not prohibit the assignee from selling elsewhere, out of the said territory, the products of such machines. *Simpson* v. *Wilson*, 4 How., 711.—NELSON, J.; Sup. Ct., 1845.

13. The restriction in the assignment applies solely to the using of the machine, and is no restriction as to place, of the sale of the product. *Ibid.*, 711.

14. An assignment of all interest in a patent is a dissolution of a partnership for working it. *Parkhurst* v. *Kinsman*, 1 Blatchf., 498.—NELSON, J.; N. Y., 1849.

15. Where a patentee granted to V. the exclusive right to construct and use and vend within a certain territory, ten *planing, tongueing, and grooving* machines, and the grant declared that V. was to enjoy an exclusive use of the patent within said territory, limited to said ten machines; and afterward the patentee granted to K. the exclusive right under the patent of making, using, and vending, within the same territory, *moulding and planing machines*, *Held*, that the grant first made to V. conveyed the entire interest of the patentee, and that the subsequent grant to K. was void. *Ritter* v. *Serrell*, 2 Blatchf., 381, 382.—BETTS, J.; N. Y., 1852.

16. An assignment of an interest in a patent, but reserving to the grantor the whole and sole power of disposal, conveys no legal title, but the assignee is only a *cestui que trust*, to the extent of his interest, in the profits. *Goodyear* v. *Day*, MS.—GRIER, DICKERSON, JJ.; N. J., 1852.

17. An agreement made by the owner of a patent, securing to the grantee the exclusive right to make, use, and sell to others to be used, the machine patented within a certain territory, but reserving to the grantor the right to sell within such territory, machines of his own manufacture, does not operate as an assignment or transfer to the grantee of the right and title secured by the patent within such territory. It is an agreement in the nature of a license to manufacture and sell, but more than a mere technical license. It is a fixed contract right, vested in the grantee, and assignable by him. *Pitts* v. *Jameson*, 15 Barb., S. C., 315.—JOHNSON, J.; N. Y., 1853.

18. Where an agreement was entered into between a patentee and another person, that in case of an extension of the patent such person should have and be entitled to an equal undivided one-fourth part of the rights and benefits that should be secured thereby, on paying a proportional part of the expenses of obtaining such extension; *query*, whether the terms of such an agreement are not words of grant and conveyance, and whether such an agreement would not be a sufficient assignment of the interest, if the condition was performed. *Pitts* v. *Hall*, 3 Blatchf., 204.—HALL, J.; N. Y., 1854.

19. But the offer to pay the proportional part of such expenses will not vest in such person the interest in such extension, although it may entitle him to bring his action and recover damages for the non-performance of the agreement. *Ibid.* 205.

20. If a bill of sale of a patent contains no warranty, but a simple transfer of tit.., the vendee cannot set up a parol warranty, for it is to be presumed that the writing contains the entire contract. *Jolliffe* v. *Collins*, 21 Mo., 341.—SCOTT, J.; Mo., 1855.

21. Where an assignment is in writing, the presumption is that the writing contains the whole contract. All oral negotiations or stipulations between the parties which preceded or accompanied the execution of the instrument, are to be regarded as merged in it. *McClure* v. *Jeffrey*, 8 Ind., 83.—DAVISON, J.; Ind., 1856.

22. Where a warranty is not included in the written contract, it cannot be proved by parol evidence, unless it is also alleged that it was false or fraudulent, and that thereby the vendee was deceived; and then parol proof is only evidence of such representation. *Ibid.*, 83.

23. An agreement made between a patentee and a third person as trustee, that the latter should hold the patent, and have the control thereof for the benefit of those who had a right to use the same, under contracts with the patentee, transfers the entire interest and ownership, legal and equitable, of the patentee in the patent, to such trustee, for the benefit of those interested. *Hartshorn* v. *Day*, 19 How., 221.—NELSON, J.; Sup. Ct., 1856.

24. The conveyance of a patent by A with the written consent of B, in whom the title then was, is equally effective with a conveyance directly from B. *Sherman* v. *Champ. Trans. Co.*, 31 Verm., 175.—REDFIELD, J.; Vt., 1858.

25. A paper purporting to be an assignment of an expired patent is void as an assignment. *Bell* v. *McCullough*, 1 Fisher, 381.—LEAVITT, J.; Ohio, 1858.

26. An assignment of a patent described the improvement as "a patent for an improvement in burning lime, for which letters patent were granted, May 6, 1851." *Held*, that it was a sufficient description of the thing sold, and that the deed need not contain the specifications of the patent. If the purchaser wanted a copy of the specifications, he could get them. *Hill* v. *Thuermer*, 13 Ind., 351, 352.—PERKINS, J.; Ind., 1859.

27. Where a patentee granted to another the exclusive right to make and sell his patented invention, within a certain territory, he to pay a certain sum for each machine so made and sold, but the patentee reserved the right of sending machines of his own manufacture into such territory, *Held*, that such contract was not an assignment of the pateutee's interest in the patent in such territory, but a mere grant or license to make and sell the article therein. *Hussey* v. *Whiteley*, 2 Fisher, 123.—LEAVITT, J.; Ohio, 1861.

## C. OF PATENT OR COPYRIGHT, BY OPERATION OF LAW.

1. The recovery of a verdict by the plaintiff, in an action for the infringement of a patent, does not pass any legal right to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiff's patent. *Whittemore* v. *Cutter*, 1 Gall., 484.—STORY, J.; Mass., 1813.

2. The levy and sale, under an execution, of the *materials* of a patented machine does not convey to the purchaser any right to use the machine in the manner pointed out in the patent. *Sawin* v. *Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

3. The capture from an enemy of a patented machine does not operate as an assignment of a right to use such machine. *Lamb's Case*, 5 Opin., 725.—WIRT, Atty. Gen., 1820.

4. L., an American citizen, obtained a patent in the United States for an invention for producing fresh water from salt. He afterward went to England, and took out a patent there, and one of his machines was put on board the frigate Boxer, which was captured by an American brig in the war of 1812, *Held*, that the United States by such capture acquired no right to use the invention, without the consent of the inventor. *Ibid.*

5. Whether a verdict for a plaintiff, and the assessment of damages for a violation of his patent, entitles the de-

fendant to use the machine subsequently, or transfers to him the right to use it; *query*. *Earle* v. *Sawyer*, 4 Mas., 13.—STORY, J.; Mass., 1825.

6. Such a construction of the law would enable any person to acquire that right, by a forced sale, against the patentee, and compel him to sell, as to persons and places, when it might interfere essentially with his permanent interest; the very attempt of the patentee to enforce his exclusive privilege would involve the necessity of parting with it. *Ibid.*, 13.

7. The court cannot force the defendant to purchase, any more than it can the plaintiff to sell, the patent-right, for the whole period it has to run. *Ibid.*, 14.

8. But where a declaration goes for a user during a limited period, and afterward the party sues for a user during a subsequent period, it seems that a verdict and judgment in the former case would not be a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. *Ibid.*, 14.

9. An author who has obtained a copyright under the act of Congress cannot be deprived, against his will, and in favor of his creditors, of any of the rights secured to him by such acts; and possibly they cannot, against his will, seize and sell the books themselves, the exclusive right of vending which is vested in him. *Cooper* v. *Gunn*, 4 B. Mon. 596.—MARSHALL, J.; Ky., 1844.

10. But this protection does not extend to the proceeds of the sale of his copyright, whether existing in his own hands, or held by another for his use. *Ibid.*, 596.

11. A patented machine, and the right of use attached to it, may pass by sale, devise, or levy of execution, or assignment of an insolvent's effects. *Woodworth* v. *Curtis*, 2 Wood. & Min., 530.—WOODBURY, J.; Mass., 1847.

12. The property acquired by the sale of an engraved plate or stereotype plates, and the copyright of a map, or book secured to the author under the acts of Congress, are altogether different and independent of each other, and have no necessary connection. *Stephens* v. *Cady*, 14 How., 530.—NELSON, J.; Sup. Ct., 1852.

13. The incorporeal right—copyright—secured by the statute to the author, being intangible and secured by grant, is not the subject of seizure or sale by execution—at least at common law. But it may be reached by a creditor's bill, and be applied to the payment of the debts of the author. *Ibid.*, 531.

14. It may, however, be doubted whether a transfer by a sale under a decree of court, would pass the title so as to protect the purchaser, unless by a conveyance in conformity with the requirements of the statute. *Ibid.*, 532.

15. The sale of a copper-plate of a map, on an execution against the owner of the copyright, does not carry with it or pass to the purchaser the right to print and publish the map engraved upon it. *Ibid.*, 532.

16. It may well be doubted whether patents and copyrights, held under the laws of the United States are subject to seizure and sale on execution; such incorporeal rights do not exist in any particular state or district, but are coextensive with the United States. *Stevens* v. *Gladding*, 17 How., 451.—CURTIS, J.; Sup. Ct., 1854.

17. The mere ownership of a copper-plate of a map, by the owner of the

copyright, does not attach to the plate the exclusive right of printing and publishing the map, or any part thereof, held under the act of Congress; but the incorporeal right subsists wholly independent of and separate from the plate, and does not pass with it by a sale of such plate or execution. *Ibid.*, 453.

18. In an action for the infringement of a patent, if the jury adopt as the measure of damages the price of the patent fee, proved in the case, such verdict will operate to vest the title of the patent, to the extent of its use by the defendant complained of, throughout its term. *Sickles* v. *Borden*, 3 Blatchf., 545.—NELSON, J.; N. Y., 1856.

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## ATTACHMENTS IN PATENT CASES.

### A. COMMENCEMENT OF SUITS BY.

1. The right to attach property to compel the appearance of persons can properly be used only in cases in which such persons are amenable to process *in personam*, and in such case also, such an attachment cannot be issued except as part of, or together with process to be served upon his person. *Day* v. *Newark I. R. Co.*, 1 Blatchf., 630, 631.—NELSON, J.; N. Y., 1850.

2. The attachment of the property of a foreign corporation will not confer jurisdiction upon the Circuit Court as against such corporation. *Ibid.*, 633.

3. Where a corporation was created by the laws of New Jersey, and had its place of business in that state, but also had a store in New York, where its goods were sold, and a suit was commenced against it in New York by attachment of its goods, and by service of process on its president, who happened to be in New York, *Held*, that the corporation was not an inhabitant of New York, or found within it at the time of the service of the process, and that the court had no jurisdiction of the action. *Ibid.*, 633.

4. A process of attachment, whether direct or foreign, by which the property of a defendant is attached by virtue of state laws, cannot give the Circuit Court jurisdiction over a person not an inhabitant of, and not found within the district. *Saddler* v. *Hudson*, 2 Curt., 7.—CURTIS, J.; Me., 1854.

5. Process of attachment against the property of a non-resident defendant cannot issue from a Circuit Court, except as part of, or together with process to be served on his person; and no judgment can be rendered against a non-resident defendant who has not been personally served with process, unless he has entered an appearance. *Ibid.*, 7.

6. The attachment of the property of a non-resident defendant cannot confer jurisdiction upon the Circuit Courts of the United States; jurisdiction can only be acquired by service of process upon the defendant personally within the district, if a non-resident. *Chaffee* v. *Hayward*, 20 How., 215, 216.—CATRON, J.; Sup. Ct., 1857.

### B. TO ENFORCE OBEDIENCE TO PROCESS, &c.

1. Where a plaintiff in an injunction suit endeavored to entrap the defendant into a violation of an injunction, *Held*, that the proceeding on the part of plaintiff would not, either in conscience or law, justify an attachment, and that

the plaintiff should be charged with the costs of the application. *Sparkman* v. *Higgins*, 2 Blatchf., 30, 31.—BETTS, J.; N. Y., 1846.

2. Where an injunction was issued against a defendant, restraining him from using a certain machine, and afterward such defendant leased the machine to others, who continued to use, but it had never been in the legal possession of such defendant since he was enjoined, *Held*, on a motion for an attachment, that the defendant could not be regarded as in contempt, and that an attachment would not issue. *Sloat* v. *Patten*, 6 Penn. Law Jour., 189, 190.—KANE, J.; Pa., 1846.

3. Where an order granting an injunction was made, and the writ of injunction issued thereon was not tested till more than six weeks after, and was not served till within a few days of one year after the day of its test, *Held*, that a disobedience of the writ would not be punishable by attachment. *McCormick* v. *Jerome*, 3 Blatchf., 487.—BETTS, J.; N. Y., 1856.

4. In order to warrant an attachment for a breach of an injunction the party to be proceeded against must be a party to the suit, and have had notice of the application for the injunction. *Sickles* v. *Borden*, 4 Blatchf., 18.—HALL, J.; N. Y., 1857.

5. On a motion for an attachment for a violation of an injunction the objection cannot be taken, that the injunction is broader than the order authorizing it; if the injunction served is too broad, the defendants, when served with it, should immediately take means to set it aside for that reason. *Ibid.*, 20.

6. An attachment for a violation of an injunction may issue against the agent and acting officer of the defendant, a foreign corporation, and he is not exempted therefrom on the ground that he is a mere servant of the defendant. *Ibid.*, 20.

7. Where the violation of the injunction was the use of the thing patented on a steamboat, *Held*, that the engineer was properly made a party to the proceeding, and that an attachment would issue against him. *Ibid.*, 21.

8. To warrant an attachment for a violation of an injunction, the service of the writs should not be left in doubt. Where the plaintiff gave evidence of the service of the writs, but the party proceeded against swore positively that he had never been served with any such writs, but only with a copy of the order of the court granting an injunction, *Held*, that there was so much uncertainty as to service, that the writ of attachment should not be granted. *Whipple* v. *Hutchinson*, 4 Blatchf., 191.—NELSON, J.; N. Y., 1858.

9. Where the use complained of was under an agreement with the patentee, made subsequent to the allowance of the injunction, an attachment should not issue. *Ibid.*, 192.

10. An attachment as for a contempt, for disobeying an injunction, issued after verdict, to restrain a defendant from infringing the plaintiff's patent, will not be granted, unless the alleged violation is a use of that actually patented to the plaintiff, or its evident equivalent; the injunction issued can only be as broad as the patent. *Poppenhausen* v. *N. Y. G. P. Comb Co.*, 4 Blatchf., 254.—INGERSOLL, J.; N. Y., 1859.

11. Where, therefore, the plaintiff's patent was for the use of *tinfoil* or its *equivalent*, in the vulcanization of india-rubber and other gums, and an injunction issued against the defendants to

restrain their infringing such patent, and they afterward used *sheets of brass and tin* in a similar way to that in which *tinfoil* was used by plaintiff's patent, *Held*, on a motion for an attachment for violating the injunction, that such plates, though somewhat flexible, could not be considered an equivalent for tinfoil, and that the attachment must be denied. *Ibid.*, 255.

### C. Practice in Cases of.

1. The proper mode of proof, on issues made under interrogations filed on an attachment for a contempt in not obeying an injunction, is by testimony taken orally before a master. *Parkhurst* v. *Kinsman*, 2 Blatchf., 77.—Betts, J.; N. Y., 1848.

2. A plaintiff, in moving for an attachment against a defendant in such a case, must state, in the proofs on which the application is founded, the specific acts of omission or commission on the part of the defendant which constitute the alleged contempt. *Ibid.*, 77.

3. Where, in such a proceeding, the defendant is ordered to answer interrogatories to be filed, such interrogatories must be limited to the particular offences so alleged against him; and it is not competent for the plaintiff to inquire in regard to matters not charged specifically against the defendant in the proofs furnished on the application for the attachment. *Ibid.*, 78.

4. Nor can the plaintiff require the defendant to answer as to particulars charged on the information and belief of the plaintiff or others, and not established by direct evidence. *Ibid.*, 78.

5. Interrogatories unauthorized by law are demurrable, and the defendant is exonerated from answering them; and as to such the defendant will be entitled to costs on the demurrers—but the enforcement of such costs will be stayed until the matters at issue on any interrogatories answered shall be disposed of. *Ibid.*, 78.

6. On a motion for an attachment, affidavits that the patentee is not the first and original inventor of the thing patented, are not admissible, as that question, so far as the injunction is concerned, is settled when the writ was granted. *Whipple* v. *Hutchinson*, 4 Blatchf., 192.—Nelson, J.; N. Y., 1858.

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## AUTHOR.

See also Charts, &c.; Copyright, C.

1. If a musical composition is borrowed from a former one, or is made up of different parts copied from older compositions without material change, and put together into one tune, with only slight alterations or additions, the person so combining is not an author within the meaning of the statute. *Reed* v. *Carusi*, 8 Law Rep., O. S., 411.—Taney, Ch. J.; Md., 1845.

2. It is for the jury to decide upon the whole evidence whether a plaintiff is or is not the author of the thing copyrighted by him. *Ibid.*, 411.

3. A copyright is *prima facie* evidence that the person taking it is the author, and the burden of proof is on the defendant to show the contrary. *Ibid.*, 412.

4. To constitute one an author, he must by his own intellectual labor applied to the materials of his composi-

tion, produce an arrangement or compilation new in itself. *Atwill* v. *Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

5. He may compile or arrange a new production from materials before known, or obtained by others for him, but cannot appropriate by copyright those materials in the state in which they are furnished. *Ibid.*, 46.

6. An author may be said to be the creator or inventor, both of the ideas contained in his book, and the combination of words to represent them. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

7. An author and his assigns are included in the meaning of the general phrase, *literary proprietor*. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 61.—CADWALLADER, J.; Pa., 1860.

8. An author who has obtained a copyright under the statute, cannot be deprived against his will, and in favor of his creditors, of any of the rights secured to him; possibly they cannot, against his will, seize and sell the books themselves, the exclusive right of vending which is vested in him. *Cooper* v. *Gunn*, 4 B. Mon., 596.—MARSHALL, J.; Ky., 1844.

9. The incorporeal right—copyright—being intangible and secured by grant, is not the subject of seizure and sale on execution; but it may be reached by creditor's bill, and be applied to the debts of the author. *Stephens* v. *Cady*, 14 How., 531.—NELSON, J.; Sup. Ct., 1852.

10. It may well be doubted whether patents and copyrights held under the laws of the United States are subject to seizure and sale on execution; such incorporeal rights do not exist in any particular state or district, but are coextensive with the United States. *Stevens* v. *Gladding*, 17 How., 451.—CURTIS, J.; Sup. Ct., 1854.

11. A person who hires another to write a book, and gives him the description and scope of the work, is not the author. The literary man who writes the book and prepares it for publication is the author, and the copyright is intended to protect him, and not the person who employed him. *De Witt* v. *Brooks*, MS.—NELSON, J.; N. Y., 1861.

12. Where the incidents and events of a person's life were furnished by such person to another, who prepared them for publication, and the copyright was taken out in the name of the person so furnishing such facts, *Held*, that he was not the author, and that a party claiming as his assignee could not maintain an action for infringement. *Ibid.*

## BILL IN EQUITY.

See EQUITY; B. 2, 3.

## BILLS OF EXCEPTIONS, IN PATENT CASES.

1. The practice of spreading *in extenso* the judge's charge upon the record, is unnecessary and inconvenient. 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 might need qualification, if they were the direct point in judgment, are

to be understood in such restricted sense. *Evans* v. *Eaton*, 7 Wheat., 427. STORY, J.; Sup. Ct., 1822.

2. Where no exception is taken to the competency or sufficiency of the evidence, it is not properly before the Court, and the putting it on the record is an expensive and unnecessary burden. *Pennock* v. *Dialogue*, 2 Pet., 14, 15.—STORY, J.; Sup. Ct., 1829.

3. Where the charge of the court presented only a general principle of law, and the application of the evidence to it was left to the jury, it is not necessary in a bill of exceptions, to put any part of the evidence upon the record.—*Ibid.*, 15.

4. Exceptions taken to a judge's charge to a jury, should not be to the charge at length, but to the points ruled by the court. *Stimpson* v. *West Chester R. R. Co.*, 4 How., 401.—MCLEAN, J.; Sup. Ct., 1845.

5. Where prayers for instructions to the jury are not complied with by the court, they are to be considered as refused. *Emerson* v. *Hogg*, 2 Blatchf., 7.—BETTS, J.; N. Y., 1845.

6. Exceptions lie to the refusals of the court to give instructions when requested, in like manner as to the instructions actually given. *Ibid.*, 7.

7. Exceptions to the charge of the judge, not taken at the trial, cannot be taken afterward. The point should have been brought to the notice of the court when the mistake, if any, could have been corrected. *Ibid.*, 13.

8. A bill of exceptions, under § 17 of the act of 1836, in order to take a cause to the Supreme Court, where the amount in issue does not exceed the sum of $2,000, and "in cases where the court shall deem it *reasonable*," should not be allowed, unless the exceptions relate to constructions of the patent laws, and involve important and not trifling matters connected with these laws, and questions really doubtful. *Allen* v. *Blunt*, 2 Wood. & Min., 157.—WOODBURY, J.; Mass., 1846.

9. Points must be made and the exceptions taken in the usual way at the trial, in order to entitle the party to the benefit of them on writ of error. *Foote* v. *Silsby*, 1 Blatchf., 544.—NELSON, J.; N. Y., 1850.

10. Where, at the trial, the points and exceptions were taken in the required form to entitle the party to the benefit of them on a writ of error, but no bill of exceptions was settled in form, but the paper book was made up under the direction of the judge at the trial, in the form of a case, to move for a new trial, but without prejudice to the right of the party to make a bill of exceptions, *Held*, that an order in the case, afterward made by the judge, or an allowance of a writ of error, giving leave to make a bill of exceptions, was proper. *Ibid.*, 544.

11. A judgment will not be opened to enable the plaintiff in error to amend the bill of exceptions. After judgment has been pronounced, it is too late to assert that the statements contained in the bill of exceptions were imperfect or erroneous, or to make a new case by the introduction of new evidence, and a new exception. *Gayler* v. *Wilder*, 10 How., 510.—TANEY, Ch. J.; Sup. Ct., 1850.

12. It must appear by the transcript or record, that an exception to instructions was taken while the jury were at the bar, or error cannot be assigned thereon. *Phelps* v. *Mayer*, 15 H., 161. —TANEY, Ch. J.; Sup. Ct., 1852.

13. An objection not taken in the court below, cannot be taken before the Supreme Court on appeal. *Kinsman*

v. *Parkhurst*, 18 How., 295.—CURTIS, J.; Sup. Ct., 1855.

14. In considering the questions raised in the court below, the Supreme Court is confined to the evidence reported in the bill of exceptions; it cannot be known in the appellate court whether the report of the evidence may or may not be incomplete or imperfectly stated. Bills of exception, when properly taken, and duly allowed, become a part of the record, and as such cannot be contradicted. *Chaffee* v. *Bos. Belt Co.*, 22 How., 222.—CLIFFORD, J.; Sup. Ct., 1859.

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## BOOK, AND COPY OF.

1. A book within the statute need not be a book in the ordinary and common acceptation of the word, viz.: a volume made up of many sheets bound together; it may be printed only on one sheet, as the words of a song, or the music accompanying it. *Clayton* v. *Stone*, 2 Paine, 383.—THOMPSON, J.; N. Y., 1828.

2. The literary property intended to be protected by the act is not be determined by the size, form, or shape in which it makes its appearance, but by the subject matter of the work. *Ibid.*, 386, 387.

3. The preliminary steps required by law to secure a copyright cannot be reasonably applied to a work of so ephemeral a character as that of a newspaper. *Ibid.*, 392.

4. It cannot reasonably be presumed that Congress intended to include newspapers under the term book. *Ibid.*, 393.

5. A label, used in the sale of any article is not a book within the provisions of the statute respecting copyrights. *Coffeen* v. *Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind, 1849.

6. A *book* necessarily conveys the idea of thought or conceptions clothed in language, or in characters written, printed or published. Its identity does not consist merely in the ideas, knowledge, or information communicated, but in the same conceptions clothed in the same words, which make it the same composition. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 229.—GRIER, J.; Pa., 1853.

7. A *copy* of a book must be a transcript of the *language* in which the conceptions of the author are clothed. The same conceptions clothed in another language cannot constitute the same composition; nor can it be called a transcript or "*copy*" of the same "*book*." *Ibid.*, 229.

8. A book, within the meaning of the statute, does not include a translation of a work. *Ibid.*, 230.

9. After publication of a book, those only can be called infringers of the author's rights, or pirates of his property, who are guilty of printing, publishing, importing, or vending without his license, "*copies* of his *book*." *Ibid.*, 231.

10. A translation may be called a transcript or copy of the author's thought or conception, but in no correct sense can it be called a *copy* of his book. *Ibid.*, 231.

11. The words, "a copy of a book," found in § 6 of the act of 1831, import a transcript or copy of the entire book. *Rogers* v. *Jewett*, 12 Mo. Law Rep., 340.—CURTIS, J.; Mass., 1858.

12. A book may exist without printing; and such book when made or composed is entitled to copyright. *Roberts* v. *Myers*, 13 Mo. Law Rep., 399.—SPRAGUE, J.; Mass., 1860.

PURPOSE AND EFFECT OF CAVEAT.

13. Any composition, large or small, which includes results of successive mental processes, rationally combined, whether it fill a great volume, or be contained in a single small sheet, is within the legal denomination of a book. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 68, 69.—CADWALLADER, J.; Pa., 1860.

14. But statements, propositions, or sentences, having no connection or mutual dependence would not, by being written or printed in motiveless juxtaposition, be brought within the definition of a book or literary composition. Much less would an isolated statement, proposition, or sentence, though written, be within the definition, as it has been understood for thousands of years. *Ibid.*, 69.

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## BURDEN OF PROOF.

See EVIDENCE, A.

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## CAVEAT.

1. § 12 of the act of 1836, providing for a caveat, was introduced for the benefit of the inventor, but it is not necessary for the preservation of his right; nor does the omission of it impair his title. *Hildreth* v. *Heath*, MS., (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. The caveat only enables the inventor to have notice of any interfering application, but gives no notice to the world, or even to the interfering applicant. It is notice to the Commissioner only. *Ibid.*

3. The fact that a patent is granted to one person, while another has a caveat pending and in force, will not of itself vacate the patent granted, nor authorize the Commissioner to grant a patent to the caveator. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

4. An inventor is bound to notify the public of his claim, by a caveat or application filed in the Patent Office, designating his discovery, and what he means to secure to himself. *Sparkman* v. *Higgins*, 1 Blatchf., 208.—BETTS, J.; N. Y., 1846.

5. A caveat may be resorted to, to assist in construing a patent. *Smith* v. *Downing*, 1 Fisher, 69.—WOODBURY, J.; Mass., 1850.

6. A caveat answers a double purpose; first, to give notice of the inventor's claim, and, second, to prevent a patent from issuing to another for the same thing. *Allen* v. *Hunter*, 6 McLean, 304.—MCLEAN, J.; Ohio, 1855.

7. A caveat is evidence as to an invention, so far as it extends to the *description* of the invention, and the machinery which was then constructed. *Jones* v. *Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

8. There is no law allowing a caveator, as such, to withdraw any portion of the fee required on filing his caveat. *Anon.*, MS.—BLACK, Atty. Gen.; 1857.

9. The caveat is to set forth the "design and purpose" of the invention, and its "principal and distinguishing characteristics," but it is not necessary that it should explain the principle involved, or the modes in which it can be applied, nor how it is distinguished from other inventions. *Ibid.*

10. Nor is it necessary to accompany

the caveat with specimens of ingredients or compounds, or models or drawings, or with an oath of invention or discovery. *Ibid.*

11. The Commissioner can perform no act upon a caveat but filing it, nor in consequence of it, except to give the caveator notice of a conflicting application when made. *Ibid.*

12. A caveat is not conclusive evidence that an invention is not perfected. *Johnson* v. *Root*, 1 Fisher, 367.—SPRAGUE, J.; Mass., 1858.

13. The purpose of a caveat is to save the discoverer of an invention from the effect of the rule of law that gives to the inventor, who first adapts his invention to practical use, the right to the grant of a patent; and if the Commissioner complies with the terms of § 12 of the act of 1836, as to giving the caveator notice of any interfering application, it is to secure him against the effect of the rule. *Phelps, Dodge & Co.* v. *Brown Bros.*, 4 Blatchf., 364. —NELSON, J.; N. Y., 1859.

14. But if the Commissioner accidentally omits to give the caveator the notice required, his rights will not be prejudiced thereby. *Ibid.*, 364.

15. A caveat will directly protect only one of several distinct patentable subjects, falling within its general scope, at the election of the party inventing them. *Woodruff & Cobb*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

16. But connected with other circumstances, it may furnish strong *adminicular* proof in favor of his claim to priority as to another invention in the same line. And when such other invention is very similar to the first, but small additional proof will be necessary in determining the contemporaneous date of the second invention. *Ibid.*

17. A caveat is not required to be specific in its terms, nor is it presumed to describe the whole invention of the party, but is filed in the office rather as a warning that the inventor is in the exercise of due diligence in the pursuit and perfection of his discovery. *Collins* v. *White*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

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## CHARGE OF JUDGE, IN PATENT ACTIONS.

1. 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 of the court upon that point. If he does not it is a waiver of it. The court cannot 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., 15.—STORY, J.; Sup. Ct., 1829.

2. It is no part of the duty of the court to give an instruction as to abstract points, not actually presented by the state of the cause. *Pitts* v. *Whitman*, 2 Story, 619.—STORY, J.; Me., 1843.

3. The court is never bound to give an instruction to the jury, even when pertinent and relevant, precisely in the form and manner in which it is put by counsel. It is only the duty of the court to give such instructions in point of law, as clearly arise upon the evidence, and are proper for the consideration of the jury, in such terms and in such 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. *Ibid.*, 620.

4. The court, though seasonably requested, is not bound to instruct the jury on points not arising in the case, or on abstract or irrelevant propositions, points not raised by the evidence. *Allen* v. *Blunt*, 2 Wood. & Min., 143.—WOODBURY, J.; Mass., 1846.

5. Instructions should always arise out of, and be limited to the facts, or the evidence in the cause; and instructions, which are general, abstract, or not springing from, and pertinent to the facts of the case, are calculated to mislead the jury, and are therefore improper. *Gayler* v. *Wilder*, 10 How., 505.—DANIEL, J. (Dis. Opin.); Sup. Ct., 1850.

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## CHARTS, MAPS, PRINTS, &c.

1. Under the act of 1802, the person intended and described as the proprietor of a copyright in a print is one who shall not only invent *and* design, but who shall engrave, etch, or work the print to which the right is claimed; or who, *from his own works and inventions*, shall cause the print to be designed and engraved, etched or worked. *Binns* v. *Woodruff*, 4 Wash., 51.—WASHINGTON, J.; Pa., 1821.

2. In the first case, the inventor and designer is identified with the engraver, or in other words the entire work, or subject of the copyright is executed by the same person. In the latter, the invention is designed or embodied by the person in whom the right is vested, and the form and completion of the work are executed by another. *Ibid.*, 51.

3. But in neither case can a person claim a copyright for a mere invention, the work of his imagination locked up in his own mind, or existing in a form not visible to others. *Ibid.*, 51.

4. Neither is he so entitled, unless he has not only invented, but also designed or represented the subject in some visible form. *Ibid.*, 51.

5. The phrase *design*, when used as a term of art, means the giving of a visible form to the conceptions of the mind, or in other words, to the invention. *Ibid.*, 52.

6. Where neither the design nor the general arrangement of a print, nor the parts which composed it, were the invention of the plaintiff, but he had employed and paid the artists who had composed and executed it, *Held*, that he was not entitled to a copyright under the provisions of the act of Congress. *Ibid.*, 53.

7. Where a person, at his own expense, has caused a survey to be made of a particular locality, as Nantucket Shoals, which corrected errors in former charts, and made a chart of such survey, *Held*, that though he could not have a copyright in the shoal itself, nor in the original elements of his charts, that he had a right to the result of his labors and surveys. *Blunt* v. *Patten*, 2 Paine, 395.—THOMPSON, J.; N. Y., 1828.

8. Another party might resort to the original materials of the chart and survey for himself, but he could not avail himself, either in whole or in part, of the surveys of the plaintiff. *Ibid.*, 396.

9. And though the plaintiff had deposited one of such charts in the Navy Department, it did not thereby become a public document, which any one had a right to copy. *Ibid.*, 396.

10. The natural objects from which charts are made being, however, ope-

to all, a copyright cannot subsist in a chart, as a general subject, although it may in an individual work, and others may be restrained from copying such work. *Ibid.*, 400, 401.

11. But a right in such a subject is violated only when another copies from the chart of him who has secured the copyright, and thereby availed himself of his labor and skill. *Ibid.*, 402.

12. In all such cases, it is a proper question for a jury, whether the one is a copy of the other or not; if there was some small variance, it would be a proper subject of inquiry, whether the alteration was not merely colorable. *Ibid.*, 402.

13. A subsequent compiler has a right to avail himself of all prior publications, the copyright of which is not secured; and if he compiles his chart from some other publications, it is no infringement of another's copyright, although it may agree with such prior chart. *Ibid.*, 403.

14. A man has a right to a copyright of a map of a state or country which he has surveyed, or caused to be compiled from existing materials, at his own expense, or skill, or labor, or money. *Emerson* v. *Davies*, 3 Story, 781.—STORY, J.; Mass., 1845.

15. Another may, however, publish another map of the same state or country by using the like means or materials, and the like skill, labor, and expense. But he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill, labor, or expense. *Ibid.*, 781.

16. Where, on a bill filed for an alleged violation of a copyright, and an injunction, the alleged infringement consisted in making use of the complainant's map by the defendant; but the answer denied that the defendant had made any use of such map, and alleged that he had obtained his materials from original sources, and also denied any intention or desire to make any reference to complainant's map, *Held*, that an injunction would not be granted, as there was no infringement. *Smith* v. *Johnson*, 4 Blatchf., 252.—INGERSOLL, J.; N. Y., 1858.

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## COLORABLE ALTERATIONS AND VARIATIONS.

See also DOUBLE USE; EQUIVALENT; FORM; INVENTION, E.

1. Mere colorable differences or slight improvements cannot shake the right of an original inventor, or protect an infringer. *Odiorne* v. *Winkley*, 2 Gall., 54.—STORY, J.; Mass., 1814.

2. The right secured to the inventor is founded on considerations of public policy, and is not to be destroyed by open infraction, or mere colorable improvements. *Smith* v. *Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

3. A mere colorable or slight alteration of a machine, or a change in its proportions, gives no ground for a patent; nor can it shelter from the consequences of an infringement. The inquiry always is, whether the principle of the two machines is the same. *Brooks* v. *Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

4. Mere colorable differences in form and structure do not make a difference in principle. *Parker* v. *Stiles*, 5 McLean, 63.—LEAVITT, J.; Ohio, 1849.

5. An unsubstantial or colorable al-

ter-tion in a machine or a compound, as where they are formed on the same principle, though varied in form; or where the ingredients are the same, but combined in a different mode, or there is a substitute of one ingredient having the same qualities, and producing the same result, is an infringement. *Allen* v. *Hunter*, 6 McLean, 313.—McLean, J.; Ohio, 1855.

6. Mere colorable alterations, substantially the same as other inventions, and involving the same principle, afford no ground for a patent. *McCormick* v. *Manny*, 6 McLean, 557.—McLean, J.; Ill., 1855.

7. If the change in a machine consists merely in the employment of an obvious substitute, the discovery and application of which could not have involved the exercise of the inventive faculty in any considerable degree, the change will be treated as merely an unsubstantial, colorable variation, or a double use, and not patentable. *Everson & Ricard, Ex parte*, MS. (App. Cas.)—Morsell, J.; D. C., 1855.

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## COMBINATION.

**A.** What is; what Patentable; Construction of Patents for..... 181
**B.** What an Infringement of, and what not..... 186

### A. What is; what Patentable; Construction of Patents for.

1. If to an old machine, some new combinations be added to produce new effects, the right to a patent is limited to the new combinations. *Whittemore* v. *Cutter*, 1 Gall., 480. Story, J.; Mass., 1813.

2. If different effects have been produced by the *same application* of machinery in several parts, and a person merely combines them together, or adds a new effect, he is not entitled to a patent for the whole machine. *Ibid.*, 482.

3. A machine, or an improvement may be new, and the proper subject of a patent, although the parts of it were before known, and in use. The combination, therefore, of old machines to produce a new and useful result, is a discovery for which a patent may be granted. *Evans* v. *Eaton*, Pet., C. C., 343.—Washington, J.; Pa., 1816.

4. A patent may be for a new combination of machines to produce certain effects, and this whether the machines, constituting the combination, be new or old. *Barrett* v. *Hall*, 1 Mas., 474.—Story, J.; Mass., 1818.

5. If an invention consist in a new combination of machinery, or in improvements upon an old machine, to produce an old effect, the patent should be for the combined machinery, or improvements on the old machine, and not for a mere mode or device for producing such effects detached from the machine. *Ibid.*, 476.

6. If a combination be not wholly new, but up to a certain point has existed before, and the patentee claims the whole as new, instead of his own improvements only, and takes out a patent for the whole machine, his patent is void, for it exceeds his invention. *Moody* v. *Fiske*, 2 Mas., 118.—Story, J.; Mass., 1820.

7. The same patent cannot be for a *combination* of different machines, and for distinct improvements in each. *Ibid.*, 119.

8. 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., 543.—WASHINGTON, J.; Pa., 1825.

9. A combination though simple and obvious, if new, is nevertheless patentable; and it is no objection, that up to a certain point, it makes use of old machinery. *Earle* v. *Sawyer*, 4 Mas., 11.—STORY, J.; Mass., 1825.

10. A patent for a machine, consisting of an entire new combination of all its parts, though each part has been used in former machines, is good if the machine is substantially new in its structure and mode of operation; but if the same combination existed before up to a certain point, and the invention consists in adding some new machinery in some improved mode of operation, or some new combination, the patent must be limited to the improvement. *Whitney* v. *Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

11. Where a patent was for the construction and use of a peculiar cylinder described, and the several parts thereof in combination for the purpose set forth, *i. e.*, making paper, *Held*, that it was not the cylinder alone, or its several parts, which were claimed *per se*, but that they were claimed in their actual combination with the other machinery to make paper. *Ames* v. *Howard*, 1 Sumn., 486, 487.—STORY, J.; Mass., 1833.

12. That is a combination which requires different things, or different contrivances, or different arrangements, to be brought together to accomplish a given purpose. It does not follow, however, that a combination is not, and may not be treated as an entirety. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 446.—STORY, J.; Mass., 1843.

13. Where in a patent for improvements in the ribs of cotton gins, the claim was for increasing the depth between the upper and lower surface of the rib, and also as a part of the same improvement, the sloping up of the under surface so as to leave no shoulder between the two, *Held*, that it was not a claim for two distinct improvements, but for parts of the same improvement—but neither alone as constituting it—as making an entirety. *Ibid.*, 446.

14. If a combination is new, it is patentable, although a part of the apparatus may have been applied to similar purposes in other and different machines. *Pitts* v. *Whitman*, 2 Story, 618, 619.—STORY, J.; Me., 1843.

15. A patent may be taken for a combination of old parts. *Devoll* v. *Brown*, 3 West. Law Jour., 152.—WOODBURY, J.; Mass., 1845.

16. A combination, to be patentable, must be substantially new, not a copy; the parts may have been used before; it is the bringing of them together that constitutes the invention. *Ibid.*, 152.

17. It is not necessary to have any new power or substance; but it is necessary that the combination operate in a new mode or manner; this constitutes the new principle. *Ibid.*, 152.

18. If the new mode is merely a change in equivalents, and there are no new results, it is not enough; but if there is any new mode of operating, then it was new. *Ibid.*, 152.

19. If results are different, it argues a substantial change in the mode, results cannot be different, if the means are the same. *Ibid.*, 153.

20. A new combination, or invention,

may be the result of accident, as well as labor, and is to be alike protected in either case. *Ibid.*, 153.

21. In order to support a claim for a combination, it must differ materially and substantially from former combinations. *Hovey* v. *Henry*, 3 West. Law Jour., 154.—WOODBURY, J.; Mass., 1845.

22. To defeat such a claim, it is not sufficient to show that each part or element of the combination has been known and used before, but that all the parts had been known and used in combination. *Ibid*, 154.

23. It is not a new invention, if all the parts of a combination had been applied to a different object before, and they were now only applied to a new object. *Ibid.*, 155.

24. Where a patent is for a new combination, there is no claim to invention except in regard to the combination, and no parts of the machine need be proved to be new. *Hovey* v. *Stevens*, 1 Wood. & Min., 302.—WOODBURY, J.; Mass., 1846.

25. When a certain particular combination of known mechanical powers or principles produces a new and useful *effect* in a manufacture, that combination becomes the lawful subject of a patent. *Warner* v. *Goodyear*, MS., (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

26. In mechanics, inventions consist, not in the discovery of new principles, but in new combination of old ones. The principles of mechanics are few, simple, and well understood; their combinations are various and inexhaustible. Any new combination, which is of substantial advantage in the arts, comes within the policy and protection of the patent law. *Tyler* v. *Deval*, 1 Code Rep., 31.—MCCALEB, J.; La., 1848.

27. A patent for a combination cannot be supported by evidence of novelty of one of its parts. *Batten* v. *Clayton*, 2 Whart. Dig., 408.—KANE, J.; Pa., 1848.

28. A combination to be patentable must effect a new result, or an old result by a new mode of action; there must be novelty either of product or process. *Ibid.*

29. A combination, in order to be patentable, must bring some new features into the combination, and produce new and beneficial results. If it does that, it is of no matter how slight the change. *Adams* v. *Edwards*, MS.—SPRAGUE J.; Mass., 1848.

30. If there is a novelty in the application and in the machine, and if it produces new and valuable results, it is patentable, whether only the combination is new, or only an important part of it. *Ibid.*

31. If a combination is new, and produces a new and useful result, it is the proper subject of a patent. *Tatham* v. *Le Roy*, MS.—NELSON, J.; N. Y., 1849.

32. Though a mere combination of machinery in the abstract may not be new, yet if used and applied in connection with the practical development of a newly discovered principle, producing a new and useful result, the subject is patentable. *Ibid.* [But see *post* 43, 54.]

33. In a patent for a combination, where the novelty of the invention consists in the combination, it is altogether immaterial whether the elements forming the combination are new or old. *Buck* v. *Hermance*, 1 Blatchf., 404.—NELSON, J.; N. Y., 1849.

34. In order that a new combination may be patentable, the change between

it and any previous combination must be substantial, and not formal; must require mind, ingenuity, labor, time, and expense. The new article must be different from the one on which it is an improvement, not only in its mechanical contrivance and construction, but in its practical operation and effect in producing the useful result. *Ibid.*, 405.

35. If a combination includes new patentable matter with old matter not patentable, it makes a new patentable combination. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

36. And it is not the less patentable because it includes new matter in connection with the old. The lod may not in itself be patentable; but joined to the new, a combination may be formed which may be patented. *Ibid.*

37. Nor is the inventor obliged to take separate patents for each new patentable matter; he may be willing to ask only for a limited use of the new matters, *to wit*, *in combination*, and not for an exclusive use of them for every purpose for which they may be applicable. *Ibid.*

38. Although all the parts going to constitute the plaintiff's invention—a car wheel—may have been known before and developed in prior wheels, if the patentee first brought them together into a whole, and that whole is materially different from any whole that existed before, he is the original and first inventor, and entitled to a patent therefor. *Many* v. *Sizer*, 1 Fisher, 24.—SPRAGUE, J.; Mass., 1849.

39. Where the effect and operation of mechanical contrivances, which are to be determined by experts, enter into the question of the extent of a combination, it is a mixed question of law and fact, and a proper one to be determined by the jury, under instructions from the court. *Foote* v. *Silsby*, 1 Blatchf., 458, 465.—NELSON, J.; N. Y., 1849.

40. One part of a combination being old does not necessarily prevent the combination, itself being new. *Hall* v. *Wiles*, 2 Blatchf., 199.—NELSON, J.; N. Y., 1851.

41. It is immaterial whether the patentee is the inventor of any one or more of the elements of a combination. These may all be old; but if the patentee was the first to combine them, for the purpose specified in his patent, his patent will be good. *Foote* v. *Silsby*, 2 Blatchf., 270.—NELSON, J.; N. Y., 1851.

42. To defeat a claim for a combination, by the existence of a prior combination, such prior combination must have been one of practical utility, and must have embraced all the elements embraced in the plaintiff's combination. *Ibid.*, 275.

43. Where a patentee claims a certain combination of machinery as his invention, his claim can only be sustained by establishing its novelty—not as to its parts, but as to the combination. It will not support the patent to show that a new result is produced. *Le Roy* v. *Tatham*, 14 How., 177.—MCLEAN, J.; Sup. Ct., 1852.

44. A claim for a combination which does not point out and designate the particular elements which compose a combination, but only declares that the combination is made up of so much of the described machinery as effects a particular result, may be sufficient. It is a question of fact, which of the described parts are essential to that result; and to this extent not the construction,

but the application of the claim should be left to the jury. *Silsby* v. *Foote*, 14 How., 226.—CURTIS, J.; Sup. Ct., 1852.

45. The use of a blast in connection with a lime-kiln, being new, as also the feature of generating heat in the same furnace to burn the stone, and produce steam in the boiler to work the blowers, and the arrangement effecting a saving of fuel, *Held*, that such arrangement or combination was patentable. *Seeley*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

46. If the specification, taken as a whole, leaves no reasonable doubt concerning the intention of the patentee to include in his claim a certain part of a combination, though there may be an error in describing it, it will be considered as included. *Kittle* v. *Merriam*, 2 Curt., 479.—CURTIS, J.; Mass., 1855.

47. To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If such parts are so arranged that the successive action of each contributes to produce one result—which result is the product of the simultaneous or successive action of all such parts—a valid claim for combining such elementary parts may be made. *Forbush* v. *Cook*, 10 Mo. Law Rep., 665.—CURTIS, J.; Mass., 1857.

48. Nor is it necessary to include in the claim for the combination, as elements thereof, *all* parts of the machine which are necessary to its action. *Ibid.*, 665.

49. If a combination is new and useful within the meaning of the patent laws, it is the subject of a patent, and it is not important whether it required much or little thought, study, or experiment to make it, or whether it costs much or little expense to devise and execute it. *Ibid.*, 667.

50. The use of new materials in a combination, or a change of form, or the use of one equivalent for another, does not render it new in the sense of the patent law, but some new mode of operation must be introduced. *Ibid.*, 667.

51. And it is decisive, though not the only evidence, that a new mode of operation has been introduced, if either a new effect, or a better effect, or as good an effect more economically attained, is produced by the change. *Ibid.*, 668.

52. If a person invent a new mechanical device or arrangement, to be used in the place of a former device or arrangement which was a part of a certain combination, and which new device is independent of all other similar devices, and is not to be used in conjunction with, or in aid of, or in addition to such old device, which made one of the elements of the old combination, he may have a patent for a combination containing his new device or arrangement, in connection with the remaining parts of the old combination, as such combination constitutes a new machine, and not an improvement merely on the machine, containing the combination of the old elements. *Potter* v. *Holland*, 4 Blatchf., 244.—INGERSOLL, J.; Ct., 1858.

53. But if such new mechanical device is but an improvement on the old or former one, and is to be used in conjunction with, or in aid of, or in addition to, the old one, then, it seems, he could only have a patent for his improvement and not for the whole combination. *Ibid.*, 245.

54. Though a combination of machinery, or a part of it may not be new, when used to produce a new product,

if it is so combined and modified as to produce new results, there is novelty within the patent law. *Le Roy* v. *Tatham*, 22 How., 139.—McLean, J.; Sup. Ct., 1859.

55. One new and operative agency in the production of the desired result gives novelty to the entire combination. *Ibid.*, 139.

56. Although the *elements* of a combination may not be new, yet if the combination and arrangement of parts are new, and produce useful and valuable results, the invention is patentable. *Larowe, Ex parte*, MS. (App. Cas.)—Dunlop, J.; D. C., 1860.

57. In order to make a combination patentable, its constituent parts should be *co-active*, and not dead parts. The connection of a thousand dead parts in one machine having but a single operation, can never be considered a combination. *Berry, Ex parte*, MS. (App. Cas.)—Morsell, J.; D. C., 1860.

58. Though the combination of parts in a machine may be old, yet if the parts differ in construction, and are so made for a specific purpose, and the effect or result produced by such change in construction is valuable, and the combination has never before been applied to such purpose, the arrangement or combination is new and patentable. *Mackay, Ex parte*, MS. (App. Cas.)—Morsell, J.; D. C., 1860.

59. Though all the primary elements of a combination, or all its sub-combinations have existed before in different machines, if they have never before been brought together to constitute one machine, and co-operate to produce one result, the person who so brings them together is entitled to a patent for such combination and arrangement. *Howe* v. *Morton*, MS.—Sprague, J.; Mass., 1860.

60. There are two classes or kinds of combinations which are properly the subject of a patent. *First*, in which all the parts were before known, and where the sole merit of the invention consists in such an arrangement of them as to produce a new and useful result, or where an inventor has succeeded in making such an arrangement of known parts, that they produce a result never before obtained. *Second*, where *some* of the parts or elements of the combination are new, and their invention claimed, but where they are used in combination with parts or elements that were known before. *Lee* v. *Blandy*, 2 Fisher, 93.—McLean, Leavitt, JJ.; Ohio, 1860.

61. Parts of a machine which do not perform any distinctive valuable function, or confer any utility upon the combination, and are in fact useless in their operation, will not make the combination patentable. *Thomas, Ex parte*, MS. (App. Cas.)—Merrick, J.; D. C., 1860.

## B. Infringement of Patent for.

1. An action will not lie by a patentee of an improvement, consisting of a combination of several machines, against a person who has made or used one of the machines, which in part constitutes the discovery. *Evans* v. *Eaton*, Pet., C. C., 343, 344.—Washington, J.; Pa., 1816.

2. The separate parts of a combination may be used without any infringement of the patent, but they cannot be used in their combined state to produce by the same operation the same result. *Gray* v. *James*, Pet., C. C., 401.—Washington, J.; Pa., 1817.

3. If a patent is for a combination of several machines, it is no infringement

of the patent to use any of the machines separately, if the whole combination is not used. *Barrett* v. *Hall*, 1 Mas., 474, 477.—STORY, J.; Mass., 1818.

4. Where a patent is for a *new combination* of existing machinery or machines, and does not specify or claim any improvement or invention, except the combination, unless that combination is substantially violated, the patentee is not entitled to any remedy, although parts of the machinery are used by another. *Moody* v. *Fiske*, 2 Mas., 117.—STORY, J.; Mass., 1820.

5. In such a case, proof that the machines, or any part of their structure, existed before, forms no objection to the patent, unless the combination had existed before. *Ibid.*, 117.

6. Where a patentee, in his patent, claimed three things, not separately, but in combination, and the defendants made use of but two of the three parts, *Held*, that unless the whole combination was substantially used by the defendants, it was not an infringement of the plaintiff's patent, although one or more of the parts may be used by the defendants. *Prouty* v. *Ruggles*, 1 Story, 571.—STORY, J.; Mass., 1841. [Affirmed 1842, *post* 9.]

7. A patent for a combination of A, B, and C cannot be technically or legally deemed at once a combination of A, B, and C, and of A and B alone. *Ibid.*, 572.

8. Where a patent is for an entire process or combination, and not for the several parts of it, and a party does not use the entire process or combination, but only a part, it is not a violation of the thing patented. *Howe* v. *Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

9. If a combination, as claimed and patented, consists of several (three) parts, arranged in a particular manner, with reference to each other and to other parts of the machine or thing, the use of any two of such parts only, or of the two combined with a third which is substantially different in form, or in the manner of its arrangement, or connection with the others, is not an infringement of the thing patented. *Prouty* v. *Ruggles*, 16 Pet., 341.—TANEY, Ch. J.; Sup. Ct., 1842.

10. One combination is not the same with another, if it substantially differs from it in any of its parts. *Ibid.*, 340.

11. A patentee of an improvement in the cotton-gin described and claimed his invention as consisting in a particular form of the rib, for separating the fibre from the seed, and so connecting the lower and upper surfaces of the rib, that *when the rib was inserted in the frame*, there should be no break or shoulder, but a smooth uninterrupted passage upward between the ribs. *Held*, that his patent was for the combination of the form of the rib, of the manner of connecting its upper and lower surfaces, and the manner of fixing or fastening it to the frame as stated; and that if the defendants did not fix or fasten the ribs of their machine against the framework substantially in the manner described in the plaintiff's patent, they were not guilty of any violation of the plaintiff's patent. *Carver* v. *Hyde*, 16 Pet., 518, 520.—TANEY, Ch. J.; Sup. Ct., 1842.

12. The use of any one of certain specified improvements of a combination, included in a patent, of which the patentee was the inventor, without any violations of the others, is sufficient to entitle the patentee or his assigns to an action of infringement. *Pitts* v. *Whit-*

*man*, 2 Story, 621.—STORY, J.; Me., 1843.

13. Where an invention consists in the combination of certain known mechanical structures, the use of any parts essential to such combination, less than the whole, is no infringement. *Brooks* v. *Bicknell*, 3 McLean, 453, 454.—McLEAN, J.; Ohio, 1844.

14. By a change in position in a combined machine, its mechanical action is not affected. *Ibid.*, 455.

15. There is no infringement of a combined machine, unless every part is used. *Brooks* v. *Bicknell*, 4 McLean, 73.—McLEAN, J.; Ohio, 1845.

16. A patent for a combination is not infringed by the use of any part less than the whole of the combination. *Root* v. *Ball*, 4 McLean, 180.—McLEAN, J.; Ohio, 1846.

17. Where a patent is for a new combination, and not for newly invented parts, a violation must extend to the whole. *Aiken* v. *Bemis*, 3 Wood. & Min., 353.—WOODBURY, J.; Mass., 1847.

18. Where an invention consists of a combination of known mechanical powers, the use of a part less than the whole combination, is no infringement. *Parker* v. *Haworth*, 4 McLean, 373.—McLEAN, J.; Ill., 1848.

19. But where the invention consists not only in the combination, but in the improvement of several of the parts of the combination, the violation of one of them is an infringement for which an action will lie. *Ibid.*, 374.

20. Where a patent is for a combination, constructed and operating in a particular way, to constitute an infringement, the defendant must have used the same combination, constructed and operating substantially in the same way. *Gorham* v. *Mixter*, 1 Amer. Law Jour.; N. S., 543.—SPRAGUE, J.; Mass., 1849.

21. If but two of the three elements of combination are used, there is no infringement. Nor is it any infringement if any one or all the elements of combination were constructed and operated substantially different from the plaintiff's. *Ibid.*, 543.

22. Nor do additions or improvements to a combination, or any element thereof, though meritorious, give any right to use or appropriate the original combination. *Ibid.*, 543.

23. In a patent for a new and useful improvement in the mode of forming rails for railroad carriages, for use in cities, &c., "where it is desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction," the patentee claimed the employment of plates or rails having narrow grooves on each side of the track for the flanges of the car wheels to run in, by which they were adapted to the unobstructed passing over them of the various kinds of common carriages, such rails being also sunk to a level with the surface of the street. *Held*, that such patent consisted of the combinations of such grooves with the rail, on both sides of a railroad track, and such combination being depressed to a plane corresponding with the street, and that the use by the defendant, of a double iron rail, with a groove or interval between, large enough for the flange of the wheel, placed on the inner side of a curve, the ordinary flat iron rail being used on the exterior line of the same curve, and the whole constructed on the same plane with the general track of the road, without regard to the convenience of carriages to pass over it, was not an infringement

of such combination, having used but one element of the plaintiff's combination. *Stimpson* v. *Bo. & Sus. R. R. Co.*, 10 How., 343–346.—DANIEL, J.; Sup. Ct., 1850.

24. Where in an action for an infringement of a mill for grinding bark, the novelty of the plaintiff's invention which consisted in the formation of grinding chambers, by the combination of movable conical rings, with stationary cylinders arranged concentrically, and in the consequent multiplication of the grinding chambers, so as to increase the grinding surfaces in a machine of a given size, *Held*, that no one had a right, without the authority of the patentees, to use the combination of such two parts that formed the grinding chambers, and that a change in the shape of the chambers, or the form of the teeth, though the machine might thereby be improved, was only a difference in degree, and not in the thing itself. *Wilbur* v. *Beecher*, 2 Blatchf., 140, 142.—NELSON, J.; N. Y., 1850.

25. A combination, when the patent is for that, is not violated when only parts of it are used, and not all of them, which are material. *Smith* v. *Downing*, 1 Fisher, 83.—WOODBURY, J.; Mass., 1850.

26. If a combination, properly so called, consists of two or more distinct things, and the patent is for combining them in one whole, if all are not used the patent is not infringed. *Foster* v. *Moore*, 1 Curt., 292.—CURTIS, J.; Mass., 1852.

27. A combination may be improved, and a patent taken for such improvement, but at the same time the improvement cannot be used without the consent of the original patentee. *Ibid.*, 292.

28. But even where a strict combination is claimed, if one of the elements of that combination is complex enough to admit of an improvement, without destroying its identity, such improved combination would be an infringement. Though one element is thus improved, the whole combination in the sense of the patent laws would be used. *Ibid.*, 293.

29. The patent was for sawing matches in sheets, so as to leave them united at one end, and then wrapping them in paper in a particular manner, *Held*, that the patent was for the entire and complete mode described, and was not infringed by putting up matches attached at one end, but not wrapped in strips of paper. *Byam* v. *Farr*, 1 Curt., 265.—CURTIS, J.; Mass., 1852.

30. If a combination has three different known parts, and the result is accomplished by the union of all these parts, arranged with reference to each other, the use of two of these parts only, combined with a third, substantially different from the former, is not the same combination, and no interference. *Brooks* v. *Fiske*, 15 How., 219.—CATRON, J.; Sup. Ct., 1853.

31. A patent which claims mechanical powers or things in combination, is not infringed by using a part of the combination. To this rule there is no exception. *McCormick* v. *Many*, 6 McLean, 547.—McLEAN, J.; Ill., 1855.

32. Where the invention consists of a combination of known mechanical powers, the use of less than the whole will be no infringement. *Pitts* v. *Wemple* 6 McLean, 561.—McLEAN, J.; Ill., 1855.

33. If the whole of the combination be taken, though something be added, still it is an infringement. *Ibid.*, 561.

34. Where the right of recovery rests

on a combination, the plaintiff must prove that all those parts substantial to their combination have been used by the defendants. The employment of one or more of those parts less than the whole will not constitute an infringement. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

35. If an invention is an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot 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 improvements cannot invoke the doctrine of equivalents to suppress all other improvements which are not merely colorable invasions of the first. *McCormick* v. *Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

36. A claim for a combination of mechanical devices or parts is not infringed by one who uses a part of the combination. *Ibid.*, 406.

37. In a patent for a combination there is no infringement, unless all the essential parts of the combination are substantially imitated. *Bell* v. *Daniels*, 1 Fisher, 379.—LEAVITT, J.; Ohio, 1858.

38. It is familiar law that there is no infringement of a combination, unless the defendant uses all the parts of which that combination is composed. *Latta* v. *Shawk*, 1 Fisher, 470.—LEAVITT, J.; Ohio, 1859.

39. But there is another kind of combination to which this doctrine does not apply, and that is where the combination is of old and new parts of a machine. In such a case, if a defendant takes the new part only, he infringes. *Ibid.*, 470.

40. Where a patentee claims a part of his mechanical contrivance as an essential element of a combination, but which is really not material to his invention, he may still recover against those who dispense with it while using the rest of the combination. *Vance* v. *Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

41. Where a patent was for a certain combination of machinery designed or intended to effect a certain purpose (dyeing parti-colored skeins of yarn by immersion in a dye, and at the same time gauging or measuring the extent of coloring of the skein), which was not new, *Held*, that in order to establish an infringement, the patentee must show that the defendant is employing substantially the same description of machinery. If the defendant employs machinery of a different description, a different mode of accomplishing the same result, the patentee has no ground of complaint. *Smith* v. *Higgins*, 2 Fisher, 100.—NELSON, J.; N. Y., 1860.

42. In a combination where all the parts have before been known, and the invention consists in a new arrangement of them to produce a useful result, there is no infringement unless a party has used all the elements of such a combination. *Lee* v. *Blandy*, 2 Fisher, 93.—LEAVITT, J.; Ohio, 1860.

43. In a combination where some of the elements are new, and their invention claimed, but they are used in combination with old parts, there will be an infringement by the use of that part which is new, and the invention of the patentee. *Ibid.*, 93.

44. A patent for a combination of old things applied to produce a new and useful result, is not violated, unless all its parts or elements are used. *Dodge* v. *Card*, 2 Fisher, 119.—LEAVITT, J.; Ohio, 1860.

# COMMISSIONER OF PATENTS.

**A.** POWER OF; ON APPLICATIONS FOR, AND IN GRANTING PATENTS..... 191
**B.** POWER OF; ON INTERFERENCES..... 191
**C.** POWER OF; ON SURRENDERS AND REISSUES..... 191
**D.** POWER OF; ON EXTENSIONS..... 191
**E.** POWER OF; IN CASES OF APPEAL.... 191
**F.** ACTION OF; WHEN CONCLUSIVE..... 191
**G.** "ACTING COMMISSIONER;" POWERS OF 193

## A. POWER OF; ON APPLICATIONS FOR, AND IN GRANTING PATENTS.

See APPLICATIONS FOR PATENTS, B.

## B. POWER OF; ON INTERFERENCES.

See INTERFERENCES, A.

## C. POWER OF; ON SURRENDERS AND REISSUES.

See REISSUE OF PATENT, B.

## D. POWER OF; ON EXTENSIONS.

See EXTENSION OF PATENT, B.

## E. POWER OF; IN CASES OF APPEAL.

See APPEAL, B. 2.

## F. ACTION OF; WHEN CONCLUSIVE.

1. The necessary consequence of the ministerial character in which the secretary of state (now Commissioner of Patents) acts, is, that the performance of the prerequisites of the patent—as whether a correct specification and description of the invention has been made, and in such full terms as is required by law—is re-examinable in any action brought upon the patent. *Grant* v. *Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

2. Though the decision of the Board of Commissioners (their power is now vested in the Commissioner of Patents), constituted by § 18 of the act of 1836, to determine as to the extension of a patent, is conclusive within the scope of its authority; it is not, however, conclusive upon the question of law, as to the right of renewal. *Brooks* v. *Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843.

3. Such decision is however entitled to regard, as a practical construction of the law that the heirs of a patentee may procure a renewal of a patent; and such a construction is in accordance with the principle and policy of the law. *Ibid.*, 258, 259.

4. The decision of the Commissioner of Patents upon a reissue is conclusive, unless impeached on account of fraud or connivance between him and the patentee, or unless an excess of authority is manifest upon the very face of the papers. *Allen* v. *Blunt*, 3 Story, 744.—STORY, J.; Mass., 1845.

5. Where a particular authority is confided to a public officer, to be exercised by him in his discretion, upon an examination of facts, of which he is made the appropriate judge, his decision upon these facts, is, in the absence of any controlling provisions, absolutely conclusive as to the existence of those facts. *Ibid.*, 745.

6. The decision of the Commissioner of Patents, in accepting the surrender of an old and granting a new patent, is not re-examinable elsewhere, unless it is apparent from the face of the patent, that he has exceeded his authority, or there is a clear repugnancy between the

old and new patent, or the new one has been obtained by collusion between the Commissioner and the patentee. *Woodworth* v. *Stone*, 3 Story, 753, 754.—STORY, J.; Mass., 1845.

7. The decision of the officers of the government in granting a renewed patent, by reason of a defective or insufficient specification, &c., is *prima facie* evidence that the claim for a renewal was within the statute; and conclusive, except as to fraud. The inquiry as to the surrender, is limited to the fairness of the transaction. *Stimpson* v. *West. R. R.*, 4 How., 404.—MCLEAN, J.; Sup. Ct., 1845.

8. The decision of the ..oard of Commissioners (or the Commissioner of Patents), upon an application for the extension of a patent under § 18 of the act of 1836, is not conclusive upon the question of their jurisdiction. *Wilson* v. *Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

9. The decision of the Commissioner of Patents as to the character of an administrator, when applying for a renewal of a patent, is conclusive, and the letters of administration need not be produced in an action on such renewed patent. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

10. There is no method of pleading by which the courts can be called upon to settle the regularity of the preliminary proceedings in the Patent Office. The question of the regularity of the proceedings in petitioning for, and obtaining the patent, and the correctness of the judgment of the officer in awarding it, cannot be inquired into. *Wilder* v. *McCormick*, 2 Blatchf., 35.—BETTS, J.; N. Y., 1846.

11. The Commissioner is presumed, in issuing new letters patent, to have discharged his duty faithfully and correctly. *Allen* v. *Blunt*, 2 Wood. & Min., 138.—WOODBURY, J.; Mass., 1846.

12. Whether the decision of the Commissioner is binding and conclusive, so as not to be overturned, except for fraud, or error apparent on the patent; *query*. *Ibid.*, 139.

13. The action of the Commissioner of Patents in the reissue of letters patent is not re-examinable elsewhere, unless a clear case of fraud is made out. *Day* v. *Goodyear*, MS.—GRIER, J.; N. J., 1850.

14. The decision of the Commissioner of Patents, upon an application for an extension, where he has jurisdiction, is conclusive, as to the regularity of the proceedings, and cannot be the subject of examination and review elsewhere, except perhaps in the case of fraud, which is an exception to the general rule. *Colt* v. *Young*, 2 Blatchf., 473, 474.—NELSON, J.; N. Y., 1852.

15. The proceedings before the Commissioner of Patents, in the surrender and reissue of a patent, are not open for consideration, except on the ground of fraud. *Battin* v. *Taggert*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854.

16. In respect to an extension, the law makes the Commissioner the judge of the entire merits of the patentee, and the existence of the legal grounds for an extension, and in the absence of fraud, his adjudication is conclusive. *Clum* v. *Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

17. The power and duty of granting a new patent for the original invention, upon a lawful surrender of the old patent, is confided to the Commissioner of Patents. His decision is not re-examinable by the courts, unless it is apparent

upon the face of the patent, that the Commissioner has exceeded his authority, or unless there is a clear repugnancy between the old and the new patent, or unless the new one has been obtained by collusion between the Commissioner and the patentee. *Potter* v. *Holland*, 4 Blatchf., 242.—INGERSOLL, J.; Ct., 1858.

18. The decision of a former Commissioner of Patents, while unreversed, is binding upon a subsequent Commissioner. *Larowe, Ex parte*, MS.—(App. Cas.) DUNLOP, J.; D. C., 1860; *Simpson, Ex parte. Ibid.*, 1861.

## G. "ACTING COMMISSIONER," POWERS OF.

1. A patent is not invalid because it is certified by a person as "*acting*" Commissioner, instead of being certified by the Commissioner himself. *Wilson* v. *Rosseau*, 4 How., 663, 688.—NELSON, J.; Sup. Ct., 1845.

2. The certificate to a patent, made by a person as "acting Commissioner," is legal and sufficient. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

3. The appointment of an acting Commissioner will be presumed to have been duly made, where drawn in question incidentally or collaterally, if it be shown that the person certifying is in the public discharge of those duties. *Ibid.*, 255.

4. The signatures of acting Commissioners carry as much verity and legality on the face of certificates themselves, as those of the Commissioner himself. *Ibid.*, 256.

5. It is questionable whether evidence is admissible in an action between third parties, where the Commissioner is not a party, that an acting Commissioner has not been duly appointed; it is to be presumed he was duly appointed. *Woodworth* v. *Hall*, 1 Wood. & Min., 397, 398.—WOODBURY, J.; Mass., 1846.

6. Under § 2 of the act of 1836, the chief clerk has been considered as the "acting Commissioner," whenever the Commissioner has been unable to discharge his duties from any necessary cause, as well as when a vacancy occurs from death or resignation. *Ibid.*, 392.

7. A patent signed by "an acting Commissioner of Patents," is valid upon its face. The courts will judicially take notice of the persons who preside over the Patent Office, whether permanently or transiently. *The York & Mary. R. R. Co.* v. *Winans*, 17 How., 41.—CAMPBELL, J.; Sup. Ct., 1854.

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## COMPILATION OF A BOOK.

1. To compile is to copy from various authors into one work. *Story's Exrs.* v. *Holcombe*, 4 McLean, 313.—McLEAN, J.; Ohio, 1847.

2. Such a work entitles the compiler, under the statute, to a right of property; which right may be compared to that of a patentee, who, by a combination of known mechanical structures, has produced a new result. *Ibid.*, 314.

3. Between a compilation and an abridgment there is a clear distinction. A compilation consists of selected extracts from different authors; an abridgment is a condensation of the views of the author. *Ibid.*, 314.

4. The former cannot be so extended as to convey the same knowledge as the original work; the latter contains an epitome of the work abridged, and

consequently conveys substantially the same knowledge. The former cannot adopt the arrangement of the works cited; the latter must adopt the arangement of the work abridged. *Ibid.*, 314.

5. The former infringes the copyright, if matter transcribed, when published, shall impair the value of the original book; a fair abridgment, though it may injure the original, is lawful. *Ibid.*, 314.

6. And while a prior compiler cannot monopolize what was not original with himself, and what must be nearly identical in all such works as dictionaries, gazetteers, &c., in a like subject, a subsequent compiler cannot employ so much of a prior arrangement and materials as to show a substantial invasion of the other, and not characterized by enough new or improved to indicate new toil and talent. *Webb* v. *Powers*, 2 Wood. & Min., 513, 514.—WOODBURY, J.; Mass., 1847.

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## COMPOSITION OF MATTER.

**A.** WHAT PATENTABLE..... 194
**B.** HOW SHOULD BE SET FORTH IN SPECIFICATION..... 195
**C.** INFRINGEMENT OF PATENT FOR..... 196

### A. WHAT PATENTABLE.

1. It is not necessary that every ingredient, or that any one ingredient used by the patentee in his invention, should be new or unused before for the purpose intended. The true question is whether the combination of materials used by the patentee is substantially new. *Ryan* v. *Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839.

2. Each of the ingredients may have been in extensive and common use, and some may have been used for the same purpose, but if they have never been combined together in the manner stated in the patent, but the combination is new, the invention of the combination is patentable. *Ibid.*, 518.

3. The patentee is not limited to the same precise ingredients in making his compound. If the same purpose can be accomplished by the substitution in part of other ingredients, he can extend his patent so as to embrace them also, subject to the risk of having his patent defeated if either of the original or substituted combinations have been known or used in the combination. *Ibid.*, 521.

4. It is not every alteration or change in the quantity or quality of a composition which will entitle a person to a patent. The question is not whether the compositions are identical, but, are they substantially the same? *Street* v. *Silver*, Brightly, 100.—ROGERS, J.; Pa., 1846.

5. If a compound is made, not before known, of different ingredients, it is ground for a patent, not for the thing constructed, but for the compounds of which made. *Hotchkiss, Exrs.* v. *Greenwood*, 4 McLean, 461.—MCLEAN, J.; Ohio, 1848.

6. There is a wide difference between the invention of a new method or process by which a known fabric, product, or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance, or manufacture having qualities never found to exist together in any other material. *Goodyear* v. *The Railroads*, 2 Wall, Jr., 360.—GRIER, J.; N. J., 1853.

7. 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. *Ibid.*, 361.

8. If a patentee be the inventor or discoverer of a new manufacture or composition of matter not known or used by others before his discovery thereof, 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. *Ibid.*, 362.

9. Patents are granted "to promote science and useful arts." They are not odious monopolies, or restrictions on the rights of the public; and courts are bound to give the specification a liberal construction, and not annul its benefits by formal or subtle objections. In a patent for a composition of matter, if the patentee has set forth fully the materials, their various proportions and the processes necessary to its production, he has done all that the law requires, and should be entitled to its protection. *Ibid.*, 363, 364.

10. Where an invention was described as a "process," but the description of the "manner and process of making the same" showed clearly that the invention was not merely an improved method or process, but a new product, fabric, or manufacture, it was held in an action for infringement, by using the product, that the patentee had a right to prohibit the sale or use of the composition, as the product and process were both new. *Ibid.*, 365.

11. It is no ground for the rejection of an application for a patent for a composition of matter that the thing invented is an imitation of a real existing substance or material—as an artificial honey. If the artificial is a good and wholesome substitute for the real, and can be made and supplied at a cheaper rate, there is no good reason why it should not be deemed a new and useful invention. *Corbin & Martlett, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

## B. HOW TO BE SET FORTH IN SPECIFICATION.

1. In a patent for a composition of matter, the specification must be so full and clear as to enable one skilled in the art to which it appertains to compound and use the invention without making any experiments of his own. *Wood* v. *Underhill*, 5 HOW., 5.—TANEY, Ch. J.; Sup. Ct., 1846.

2. Where the specification of a new composition of matter gives only the names of the substances to be mixed together, without stating any relative proportion, or where the proportions are stated ambiguously or vaguely, the patent is void, as it would not enable any one to compound and use the invention without experiment. *Ibid.*, 5.

3. But where the patentee gives a certain proportion as a general rule, which on the face of the specification seems generally applicable, the patent will be valid, though some small difference in the proportions may be occasionally required, according to the quality of the materials made use of. *Ibid.*, 5.

4. 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. *Ibid.*, 5.

5. When the specification of a patent honestly sets forth the process and mode of compounding a new and valuable composition of matter, courts should give it a liberal construction. If the patentee has set forth fully the materials, their various proportions, and the processes necessary to the production of such composition, he has done all that the law requires. *Goodyear* v. *Railroad*, 2 Wall, Jr., 363, 364.—GRIER, J.; N. J., 1853.

6. If the specification honestly sets forth the *nature and design* of the invention, it is sufficient. *Ibid.*, 364.

7. The specification must be looked to for the full disclosure of the discovery, and the extent of the inventor's claims. The extent of the patentee's right must be judged from the whole instrument taken together, and not from any one sentence. *Ibid.*, 364, 365.

8. In patents for complicated machines, it is essentially proper that the specification should clearly set forth what the patentee admits to be old, and what he claims to be of his invention. But in anomalous cases, when a product has been discovered, and the process of compounding it or obtaining it is disclosed, the patentee by stating his discovery and revealing his process has done all that he is required to do or can do. The careful separation of new from old, the limitation of claims to particular parts or combinations, cannot be required as a substantial part of the specification. *Ibid.*, 365.

## C. INFRINGEMENT OF PATENT FOR.

1. The using or vending of a patented composition of matter is a violation of the right of the proprietor. *Whittemore* v. *Cutter*, 1 Gall., 433.—STORY, J.; Mass., 1813.

2. The substitution in place of one element in a composition of matter of a mere known equivalent is an infringement, but the patentee is not obliged to embrace equivalents in his claim, and if the specification and claim expressly declare that such equivalent is excluded from the patentee's invention, then its use is not an infringement. *Byam* v. *Farr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

3. Where the old method of making friction matches was, to use a composition of phosphorus, chlorate of potash, sulphuret of antimony and glue, and the invention of a patentee consisted in rejecting the chlorate of potash and sulphuret of antimony, and substituting in their place chalk or some earthy matter, and his claim was "the using a composition of phosphorus and earthy material and a glutinous substance, without the addition of chlorate of potash or of any highly combustible material," and the defendant used a composition consisting of phosphorus, sulphuret of antimony and glue, omitting only the chlorate of potash, *Held*, that the composition used by the defendant was not an infringement of the plaintiff's patent, as his claim expressly excluded the composition used by the defendant. *Ibid.*, 362–364.

4. Where a patent was for an improvement in making friction matches, and the invention was not for a compound of new ingredients, but only a new combination of old materials before in use for that purpose, consisting of a composition formed of phosphorus with the earthy material and glutinous substance only, without chlorate of potash or other like objec-

tionable ingredient, *Held*, that any person might use any one, or all the materials forming the composition, provided he does not use them in the combination patented, or that any one might use them in combination with chlorate of potash as they were formerly used. *Byam* v. *Eddy*, 2 Blatchf., 523, 524.—PRENTISS, J.; Vt., 1853.

5. But a mere colorable difference or slight variation of the combination would not exempt a person from the charge of infringement. *Ibid.*, 524.

6. An infringement consists in making a compound substantially in the same mode as that for which the patent has been obtained. *Allen* v. *Hunter*, 6 McLean, 311.—McLEAN, J.; Ohio, 1855.

7. Where the ingredients in a compound are the same, and the change is merely in the mode of combining them, or there is a substitute of one ingredient having the same qualities and producing the same result, there is an infringement. *Ibid.*, 313.

8. Where a patent is granted for a composition of several ingredients, it covers and embraces known equivalents of each of the ingredients. *Matthews* v. *Skates*, 1 Fisher, 609.—JONES, J.; Ala., 1860.

9. An equivalent of any substance is another substance having similar properties, and producing substantially the same effect. Whether one substance is an equivalent of another is a question for the jury from the evidence. *Ibid.*, 609.

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## CONGRESS.

1. The power of Congress, under the 8th section of the Constitution, "in securing to authors and inventors the exclusive right to their respective writings and discoveries" is limited to authors and inventors only, and does not embrace *introducers* who are not the authors and inventors. *Livingston* v. *Van Ingen*, 9 John., 560, 566, 582.—YATES, THOMPSON, and KENT, JJ.; N. Y., 1812.

2. But such clause does not prevent the several states from exercising the power of securing to persons introducing useful inventions the exclusive benefits of such inventions for a limited period. *Ibid.*, 560, 566, 582.

3. The power of Congress is only to ascertain and define the rights of property in the invention or work; it does not extend to regulating the use of it. This is exclusively of local cognizance. Such property, like every other species of property, must be used and enjoyed within each state according to the laws of each state. *Ibid.*, 581.

4. Congress may renew a patent, or decline to do so. The grant of an exclusive privilege to an inventor 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. *Evans* v. *Eaton*, Pet., C. C., 337. WASHINGTON, J.; Pa., 1816.

5. But even if such was the case, there is nothing in the Constitution of the United States which forbids Congress to pass laws violating the obligations of contracts, though such a power is denied to the states individually. *Ibid.*, 337.

6. Whether Congress can decide the fact that an individual is an inventor or author, without leaving the question of invention, &c., open to investigation, the courts will never presume Congress to have decided that question in a gen-

eral act, the words of which do not render such a construction unavoidable. *Evans* v. *Eaton*, 3 Wheat., 513.—MARSHALL, Ch. J.; Sup. Ct., 1818.

7. A private act of Congress authorizing the issue of a patent to an inventor is to be considered as engrafted on the general acts for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Ibid.*, 518.

8. The power of Congress as to granting patents is general, and it rests in the sound discretion of Congress to say when and for what length of time and under what circumstances a 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 should be the inventor. *Blanchard* v. *Sprague*, 3 Sumn., 541.—STORY, J.; Mass., 1839.

9. Therefore the act of Congress (act of 1839, ch. 14), granting a patent to Thomas Blanchard, is not unconstitutional because it operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. *Ibid.*, 541.

10. An act of Congress passed in general terms ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority, and not only so, but it ought to be construed not to operate retrospectively, or *ex post facto*, unless that construction is unavoidable. *Ibid.*, 542.

11. 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, at their pleasure, the laws respecting patents, so that they do not take away the rights of property in existing patents. *McClurg* v. *Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

12. It is no objection to the validity of the laws respecting patents, that such laws are retrospective in their operation. *Ibid.*, 206.

13. A reservation in favor of assignees in an act of Congress extending a patent, will not make the act unconstitutional, on the ground that Congress is only authorized to confer privileges on *inventors*. The power of Congress to reserve rights and privileges to assignees, is incidental to the general power conferred to promote the progress of the useful arts. *Blanchard's Gun-Stock Co.* v. *Warner*, 1 Blatchf., 271, 276.—NELSON, J.; Ct., 1846.

14. Congress may, by special act, extend a patent even after the expiration of the original patent. *Ibid.*, 274, 276.

15. Congress has the constitutional right to confer a new and further term on the patentee, and that even after the expiration of the first. *Blanchard* v. *Haynes*, 6 West. Law Jour. 83.—WOODBURY, J.; N. H., 1848.

16. Congress has the constitutional power to grant an extension of a patent after it has been once extended under § 18 of the act of 1836. *Bloomer* v. *Stolley*, 5 McLean, 160–162.—MCLEAN, J.; Ohio, 1850.

17. The power of Congress was not exhausted in this respect by the act of 1836. A legislative act does not bind a subsequent legislature. *Ibid.*, 161.

18. Congress may exercise its constitutional power as to granting rights to inventors by special grants, or otherwise by a general system. *Ibid.*, 161.

WHEN MAY BE IMPEACHED, OR RECOVERED BACK.

19. There is no mode by which a legislative act can be made irrepealable, except it assume the form and substance of a contract. But, though no state can impair the obligations of a contract, this inhibition does not apply to the general government. *Ibid.*, 161, 165.

20. A special act in relation to any particular patent, is to be considered as engrafted upon the general acts relating to patents; they are statutes in *pari materia*, and all relate to the same subject, and must be construed together. *Bloomer* v. *McQuewan*, 14 How., 548, 550.—TANEY, Ch. J.; Sup. Ct., 1852.

21. Under the fifth amendment of the constitution, declaring that no person shall be deprived of life, liberty, and property without due process of law, Congress would have no right to pass an act depriving purchasers of a patented article of the right to use such article. Such an act could not be regarded as due process of law. *Ibid.*, 553.

22. Under the authority conferred upon Congress, by article first, § 8th of the constitution, to promote the progress of science and the useful arts, by securing to inventors the exclusive right to their inventions, it does not follow that Congress may authorize an inventor to recall rights which he has granted to others; or reinvest him with rights of property, which he had before conveyed for a valuable consideration. *Ibid.*, 553.

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## CONSIDERATION ON SALE OF PATENTS.

1. A promissory note given for an interest in a patent-right, which was not valid, and had been fraudulently obtained, the patentee knowing at the time of his application that he was not the true inventor, is void as being without consideration, and even though certain things had been furnished by the assignor, and he had given instruction in the art described in the patent. *Bliss* v. *Negus*, 8 Mass., 51.—SEDGWICK, J.; Mass., 1811.

2. Where the title to a patent passes, the consideration money, if paid, cannot be recovered back, unless the contract has been rescinded, or was accompanied by fraud, or with an express warranty, not fulfilled. *Case* v. *Morey*, 1 N. Hamp., 350.—WOODBURY, J.; N. H., 1818.

3. Though the title to a patent fails, the purchaser cannot recover back the consideration paid, if any benefits have been derived from the use of the patent, provided such benefits were equivalent, and the purchaser was not liable for them to any prior patentee. *Holden* v. *Curtis*, 2 N. Hamp., 65.—WOODBURY, J.; N. H., 1819.

4. It seems a party would not be bound by the purchase of a patent-right, which he had supposed to be valid, when in fact it was invalid; but such misconception cannot be taken advantage of on a plea of want of consideration coupled with fraud, but the equity should be spread upon the record. *Bellas* v. *Hays*, 5 Serg. & Rawle, 439–442.—GIBSON, J.; Pa., 1819.

5. If a patentee include in his patent, along with his own invention, the invention of another person previously patented, and sell the whole to a person ignorant of these facts and who supposed he was buying an exclusive right to the whole, the sale is a fraud upon such person, and the vendor cannot recover

a note given for the consideration of the purchase. *Turner* v. *Johnson*, 2 Cra., C. C., 287.—CRANCH, J.; D. C., 1822.

6. If a party sell an interest in a patent-right, making representations that are equivalent to a warranty that the invention is of value, but the title is passed by an ordinary bill of sale or assignment, which contains no words of guaranty, the purchaser cannot go behind such assignment, and prove representations and assertions previous to the execution of the assignment, and thus avoid payment; the presumption of law being that the writing contains the whole contract. *Van Ostrand* v. *Reid*, 1 Wend., 432.—SAVAGE, Ch. J.; N. Y., 1828.

7. It may be made a defence to an action on a note given in consideration of the sale of a patent, that the invention, if not useless, is of far less value than it was represented to be by the vendor at the time of sale. *Burnham* v. *Brewster*, 1 Verm., 90.—HUTCHINSON, J.; Vt., 1828.

8. In an action on a promissory note, given for the purchase of a patent-right, it is not a good defence under the plea of *non assumpsit*, that the invention was of less value than it had been represented, or that the vendor had falsely represented that another party had offered large sums for the right to use the patent. *Williams* v. *Hicks*, 2 Verm., 40, 42.—PADDOCK, J.; Vt., 1829.

9. An assignee of a patent sold the same, and at the time exhibited a machine which he supposed was made according to such patent, but which was afterward found to be different from that patented and described in the specification. *Held*, as the whole transaction was one founded on a mistake, that the deed of assignment, the notes given, and the agreement made between the parties, should be delivered up and cancelled; and that the purchaser was not entitled to recover any damage which he had sustained in consequence of the purchase; but if the vendor had received any thing under the agreement, he might be called upon to refund that so received. *Burrall* v. *Jewett*, 2 Paige, 146, 147.—WALWORTH, Chan.; N. Y., 1830.

10. Where a party sold and conveyed certain machines, a clapboard and shingle machine, and also the "patent-right" for a certain territory, *Held*, that such agreement must be construed to mean a conveyance of the patents for both such machines, and that as such party did not own any patent for the clapboard machine, that nothing passed by the conveyance, and that the vender was liable to refund the consideration paid. *Judkins* v. *Earl*, 7 Greenl., 13, —PARRIS, J.; Me., 1830.

11. In an action to recover on certain notes given in consideration for a patented machine, which was shown to be worthless, and an infringement upon a patent-right granted to another. *Held*, that no recovery could be had on such notes, as there was no good consideration therefor. *Peck* v. *Farrington*, 9 Wend., 44.—SAVAGE, Ch. J.; N. Y., 1832.

12. A promissory note given for the purchase of an interest in a patent, is without consideration if the patent is void, and notwithstanding the seller covenanted that he had good right to sell and convey, and that he would warrant the same against all parties, such covenant will not constitute a valid consideration. *Dickinson* v. *Hall*, 14 Pick., 220.—SHAW, Ch. J.; Mass., 1833.

13. Nor will it make any difference

that the seller, at the time of sale, believed that the patent was valid. *Ibid.*, 220.

14. A *useless* patent-right is no consideration for a promise to pay. *Fallis* v. *Griffith*, Wright, 303.—WRIGHT, J.; Ohio, 1833.

15. But it is no defence to a note given for the purchase of a patent, that the purchaser has not realized as much therefrom as he expected. *Ibid.*, 303.

16. The maker of a negotiable note, appearing on its face to have been given in consideration of a transfer of a patent-right, which proved to be of no value, cannot set up the defence of a want of consideration to an action by a *bona fide* indorser. *Goddard* v. *Lyman*, 14 Pick., 270.—WILDE, J.; Mass., 1833.

17. And the fact that it was indorsed "at the risk and costs" of the indorsees makes no difference in this respect. Such indorsement will be considered as having reference to the possible insolvency of the maker, and will not authorize a jury to infer that the indorsee had any prior knowledge that the patent-right was void, or that there was any reason to suspect such fact. *Ibid.*, 270, 271.

18. Where a note was given in payment for the exclusive right to use a patent within a certain district, it is a good defence to an action on such note, on the ground of failure of consideration, that the patent was void, by reason of non-compliance with the provisions of the acts of Congress authorizing the granting of patents. *Earl* v. *Page*, 6 N. Hamp., 480.—UPHAM, J.; N. H., 1834.

19. To enable a vendor of a patent-right to recover the agreed price, he must have a title in himself, and assign the right or tender it, before he can sue for it. *Edwards* v. *Richards*, Wright, 597.—LANE, J.; Ohio, 1834.

20. In an action to recover on a note given in purchase for an alleged patent-right, *Held*, the thing patented not being new, and the specification also not clearly distinguishing what was new, that the patent was void, and that nothing passed to the purchaser, and therefore that there was no consideration for the note. *Cross* v. *Huntley*, 13 Wend., 386.—NELSON, J.; N. Y., 1835.

21. A plea, that the consideration of certain notes was the sale and conveyance of a certain patent-right, which the payee represented and warranted he was the true and lawful owner thereof, when in fact he was not, sets up a good defence to a suit to recover such notes. *Kernodle* v. *Grant*, 4 Blackf., 61.—STEPHENS, J.; Ind., 1835.

22. There is no implied warranty in the sale of a patent. The vendor, selling in good faith, is not responsible for the goodness of his title, beyond the extent of his covenants. *Hiatt* v. *Twomey*, 1 Dev. & Bat. Eq., 317.—DANIEL, J.; N. C., 1836.

23. Under the act of 1793 an assignment of a patent is not valid, and conveys no title until it has been recorded. And a note given to an assignee, whose assignment has not been so recorded, is without consideration and void. *Higgins* v. *Strong*, 4 Blackf., 183.—DEWEY, J.; Ind., 1836.

24. It is a good defence to an action brought to recover an amount agreed to be paid for an interest in a patent, that the patent is void by reason of its not stating clearly the character and extent of the patentee's invention. *Davis* v. *Bell*, 8 N. Hamp., 503.—RICHARDSON, Ch. J.; N. H., 1837.

25. Where notes had been given for the purchase of a patent-right, and had been paid after the purchaser had full knowledge or means of knowlege of all the facts in relation to the transaction, *Held*, that such payment was voluntary, and that there could not be a recovery back of the sum paid; although the purchaser might have avoided payment of the notes for want of consideration. *Stevens* v. *Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

26. In an action of assumpsit to recover certain notes which were the consideration of the sale of a patent-right, *Held*, as the specification did not particularly describe the whole improvement claimed, but only a part, that the patent was void, not *pro tanto* as to the part not described, but *in toto*, and formed no consideration for the notes, and therefore no recovery could be had. *Head* v. *Stevens*, 19 Wend., 413.—COWEN, J.; N. Y., 1838.

27. A sold to B the right to use and vend a certain machine for two years, and took his note payable at the end of that time. It was agreed that if B could not make the machine profitable, he should return it at the end of the two years, with any avails he might have received, and give up the assignment, and A should give up his note. B made a machine, and did not find it profitable, and sold it to a third party, but never offered to return it, or gave notice of his want of success, or offered to surrender the assignment. *Held*, in an action on the note, that the question of consideration was one for the court, and that B not having complied with the terms of his agreement, could not avoid the note. *Pottle* v. *Thomas*, 12 Conn., 565, 569, 572, 575.—WILLIAMS, Ch. J.; Ct., 1838.

28. In an action of debt on a bond, *Held*, that it was admissible with a plea of *non est factum* to show that it was without consideration, as being given for the assignment of a right to use and sell a certain patent-right, when the vender had no such patent-right, and had no power to sell it. *McDowell* v. *Meredith*, 4 Wharton, 314.—GIBSON, Ch. J.; Pa., 1839.

29. If an improvement is new and valuable at the time of sale, the consideration of a note given for the same cannot be impeached by showing that subsequent improvements have rendered such invention useless. The purchaser takes the risk of any new discovery destroying its value. *Harmon* v. *Bird*, 22 Wend., 115.—BRONSON, J.; N. Y., 1839.

30. Relief in equity will be afforded against the payment of notes given for the purchase of a patent, which is void; and money paid thereon may be recovered back. *Darst* v. *Brockway*, 11 Ohio, 471.—BUCHARD, J.; Ohio, 1842.

31. A note given for a patent-right for a machine that is not new or useful, is without consideration, and void. *Dunbar* v. *Marden*, 13 N. Hamp., 317.—WOODS, J.; N. H., 1842.

32. In an action on a note given for a patent-right, the plaintiff cannot recover if the invention was not new or useful, or if the patent conveyed no right and was of no value, although both parties acted in good faith in giving and receiving the note. *Geiger* v. *Cook*, 3 Watts & Serg., 270.—SERGEANT, J.; Pa., 1842.

33. And the defendant may show these facts though the note is a sealed note, and has been given for a balance due on a former note. *Ibid.*, 270.

34. It is a good defence to an action

to recover on notes given on the sale and conveyance of a patent, and as to which the seller claimed to be the inventor and owner, that such seller was not the first and true inventor. *Mulliken* v. *Latchem*, 7 Blackf., 138.—Sullivan, J.; Ind., 1844.

35. In an action for the price of a patent-right sold without warranty or fraud, the plaintiff is entitled to recover if the patent be of any value. *Vaughan* v. *Porter*, 16 Verm., 267, 270.—Redfield, J.; Vt., 1844.

36. Where an action is on a promise to pay a certain sum for the assignment of a patent, and such assignment was the consideration of the promise, the validity of the patent may be impeached, as a want of consideration in defence of the claim; but such a defence cannot be resorted to when the action is on a sealed instrument, or when another implied covenant of the plaintiff was the real consideration, upon which implied covenant the defendant would have a remedy if he has sustained any damage, or when the defendants have received the proceeds from the articles sold, to recover the agreed proportion of which the action is brought. *Wilder* v. *Adams*, 2 Wood. & Min., 331, 332.—Woodbury, J.; Mass., 1846.

37. A patentee assigned his patent and received in payment certain bonds, and gave a covenant by which he guaranteed that he had good right and title to his letters patent, and that if any one should establish a lawful right to the invention then the said bonds should be null and void. *Held*, in a suit on the bonds, that the obligors could not set up the validity of the patent until that question had been settled elsewhere. *Ball* v. *Murry*, 10 Penn., 113. Rogers, J.; Pa., 1848.

38. It is not a good defence to an action on promissory notes given for the purchase of a patent, that the consideration exceeds the value of the article. The consideration may indefinitely exceed the value of the thing for which it is promised, and still the bargain stand. *Hardesty* v. *Smith*, 3 Ind., 41.—Perkins, J.; Ind., 1851.

39. If the patent, however, was represented of greater value than it is, this may perhaps be set up in mitigation of damages. *Ibid.*, 41.

40. Where, on the sale of an interest in letters patent, the purchaser had the privilege after the trial of the improvement patented for a specified time, if it proved useless or of no value to him, to reassign such interest and receive back the consideration; and after the expiration of the time so specified a reassignment was made and accepted by the vendees, *Held*, that such acceptance was a waiver of the condition requiring a trial of the patent, and entitled the purchaser to a return of the consideration. *Young* v. *Hunter*, 2 Seld., 208.—Watson, J.; N. Y., 1852.

41. In an action on a bond given on the purchase of a patent, in which bond the party does not admit the existence of the patent, or of the right of the party to sell it, which would estop him to deny those facts, it may be shown that there was no such patent, or that it was invalid, or that the party had no right to sell it. *Nye* v. *Raymond*, 16 Ill., 154.—Caton, J.; Ill., 1854.

42. And where the bond was given for the patent and other property, and does not show at what sum the patent was estimated, the contract is not indivisible, and partial failure of consideration may be shown. *Ibid.*, 155.

43. If the assignee of a patent has

derived advantages from it, and then seeks to have the contract of assignment rescinded for fraud, he should aver that the profits received by him were so received prior to his discovery of the fraud, and he should return or offer to return the consideration received by him. *Edmunds* v. *Myers*, 16 Ill., 212.—SCATES, J.; Ill., 1854.

44. The patent was for a "design and configuration of ornaments, forming an ornamental design for a Horological cradle," and the deed of sale was for a Horological cradle, *Held*, that the phraseology did not import that there was machinery about it, and did not imply that the principle, machinery, or mode of operation was the subject of the patent. *Myers* v. *Turner*, 17 Ill., 181, 182.—CATON, J.; Ill., 1855.

45. In an action brought upon a promissory note given for the purchase of a patent, the purchaser is precluded from setting up the want of value in the invention if he has sold the right transferred to him to another for value. *Thomas* v. *Quintard*, 5 Duer., 82.—HOFFMAN, J.; N. Y., 1855.

46. By parting with the patent he has disabled himself from placing the plaintiff, by restoring the thing transferred, in the same situation he was in at the formation of the contract. *Ibid.*, 82.

47. The assignment of an interest in a patent granted for a "design for a Horological cradle" is a sufficient consideration to enable a party to recover on notes given therefor, although the invention may be practically of little or no value. *Myers* v. *Turner*, 17 Ill., 181. *Hildreth* v. *Turner*, 17 Ill., 184.—CATON, J.; Ill., 1855.

48. Where the patent assigned is referred to by date, it may be presumed the purchaser examined it for himself. The maxim *caveat emptor* would apply. *Ibid.*, 181, 183.

49. In a suit on a note given for the conveyance of a patent-right, proof that such patent was void for being an infringement of a prior patent is not admissible, without that fact having been determined by a court of competent jurisdiction. *Elmer* v. *Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855.

50. A note given for a patent that is void by reason of its being useless, is without consideration. *Jolliffe* v. *Collins*, 21 Mo., 343.—SCOTT, J.; Mo., 1855.

51. Where the consideration of a bond was the sale of a patent-right to make, use, and vend a certain medicine, represented to be patented, and no patent had been ever issued for such medicine, *Held*, that the plea of no consideration was sustained by such proof, and that there could be no recovery on the bond. *Brown* v. *Wright*, 17 Ark., 34.—HANLY, J.; Ark., 1856.

52. H. purchased of B. the right to construct and use an alleged patented machine, and covenanted "to receive the said right as good and available to all intents and purposes, and that the same and the transfer shall not be liable to any objection for any supposed defect in, or objection to the said letters patent, if such supposed defect or objection should at any time arise." *Held*, that the vendor in an action for the price was estopped from alleging the invalidity of the patent. *Hielner* v. *Battin*, 27 Penn., 517, 519, 521, 524.—WOODWARD, J., Pa., 1856.

53. And such estoppel applies as well to the objection that the reissued patent was not for the same invention as the original, as to that against the

originality of the invention. *Ibid.*, 524.

54. In an action on a note given as consideration for a patent, the plaintiff cannot recover, if the invention for which patent was granted was not new and useful, or if the patent and specification do not describe the invention so that it can be known in what the improvement consists. *Mc Clure* v. *Jeffrey*, 8 Ind., 82, 83.—DAVISON, J.; Ind., 1856.

55. In contracts in the sale of interests in a patent where there is no fraud, the purchaser must depend, where they prove of no value, upon his covenants. If both parties are equally innocent, and there is no warrant of title, the loss must fall wherever the bargain leaves it. *Cansler* v. *Eaton*, 2 Jones, Eq., 501.—NASH, Ch. J.; N. C., 1856.

56. The defendant sold an interest in a certain patent to the plaintiff, who gave his bonds for the payment of the consideration. The plaintiff afterward found out the same invention had been patented previously to another, and filed his bill praying for an injunction to stay the collection of such bonds and for their surrender to be cancelled. The court refused to interfere, but left the plaintiffs to their remedy at law. *Ibid.*, 502.

57. An assignment contained a warranty that the invention was original, and that no other invention had been patented in the United States on the same principle. In an action of covenant in which breaches were assigned in the terms of the warranty, *Held*, that the patent was not conclusive that the invention was original and upon a new principle, and that upon proof of the breaches assigned the plaintiff could recover. *Wright* v. *Wilson*, 11 Rich. Law, 152.—O'NEALL, J.; S. C., 1857.

58. To enable a vendor of a machine and of the right to use a patented article therewith, to recover the price agreed to be paid, it is not necessary for him to produce evidence of his right under the patent, unless the vendee has been interrupted in the use of the patented article by one whose right is *prima facie* violated by its use. *Buss* v. *Putney*, 11 Mo. Law Rep., 687. N. H., 1858.

59. Where the plaintiff covenanted to improve machinery for manufacturing gas and to obtain a patent therefor and assign defendant the one-half for an agreed sum, and a patent having been obtained or assigned on an action brought to recover the agreed price, *Held*, that the defendant could show that the invention was worthless and had never been reduced to practice, and had been tried and abandoned as worthless before the patent was obtained, and that the patent was not for improved machinery, and that the plaintiff had not performed the conditions on his part. *McDougall* v. *Fogg*, 2 Bosw., 387, 391.—PIERREPONT, J.; N. Y., 1858.

60. A party who seeks to recover upon a contract containing mutual and dependent covenants must show that he has performed his part of the agreement. *Ibid.*, 390.

61. Defendant sold to plaintiff the right to make a certain horse-shoe, alleged to be secured by letters patent. In an action to recover back the money paid, the jury found that the shoe was worthless and was not covered by the patent. *Held*, that the contract was void *ab initio* for want of consideration, and that the money paid could be recovered back, and that the rules as to offer of rescission, notice, demand and

waiver did not apply. *Ibss* v. *Richardson*, 11 Mo. Law Rep., 670.—HUNTINGTON, J.; Mass., 1859.

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## CONSPIRACY AGAINST PATENT.

1. What would be the legal effect of an actual combination to resist a patent is a question of much importance. *Woodworth* v. *Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844.

2. It would seem that a combination of a number of persons to resist a patent approaches very near, if it does not actually reach, a criminal conspiracy. *Ibid.*, 173.

3. In many cases, it is lawful for individuals to do what cannot lawfully be done by a combination. *Ibid.*, 173.

4. An individual patentee may successfully resist an individual when it may be much more difficult to resist the combined force of a great number of persons united to oppose his patent. *Ibid.*, 173.

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## CONSTRUCTION OF PATENT.

See PATENT, P.

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## CONTRACTS AS TO PATENTS.

See AGREEMENTS.

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## COPIES OF PAPERS IN PATENT OFFICE.

1. The officer intrusted to give copies of papers or drawings in patent cases has no concern with the purpose for which asked. The policy of the law rather requires than forbids that copies should be given when applied for. *Anon.*, 1 Opin., 171.—PINCKNEY, Atty. Gen., 1812.

2. Under § 11 of the act of 1793, a defendant in a patent suit has a right to a copy of the plaintiff's specification, from the State Department, upon the payment of the legal fees, and use it the same way as any evidence, and no conditions can be imposed upon the use of such copy. *Anon.*, 1 Opin., 376.—WIRT, Atty. Gen., 1820.

3. Under § 11 of the act of 1793, all persons indiscriminately cannot demand copies of papers respecting patents granted to others. By § 6 a defendant must be considered as having a right to demand such copies, but as to others, it rests in the discretion of the department whether copies shall be furnished or refused. *Anon.*, 1 Opin., 718.—WIRT, Atty. Gen., 1825.

4. But no copies can be furnished at less than the statutory fee, per folio. *Ibid.*, 718.

5. Copies of papers cannot be taken from the Patent Office by third parties. They must be made by the proper officer, and the fees paid therefor. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen., 1831.

6. An exemplification of a specification of a patent is made evidence by § 3 of the act of 1793. The *exemplification* of the patent itself stands upon the common law, as being an exemplification of a record of a public document, and is always to be received as evidence. *Peck* v. *Farrington*, 9 Wend., 44.—SAVAGE, Ch. J.; N. Y., 1832.

7. A certified copy of a patent, surrendered and cancelled, is admissible in

evidence, to show that an improvement subsequently patented, is not original, though it does not specify when it was cancelled, or how, or for what defect. *Delano* v. *Scott*, Gilpin, 496.—HOPKINSON, J.; Pa., 1834.

8. A former and defective certified copy of a patent may be corrected by another full and corrected certified copy, and the defective one cannot affect the one that is complete. *Brooks* v. *Bicknell*, 3 McLean, 434.—MCLEAN, J.; Ohio, 1844.

9. A transcript as to a renewal of a patent need not set forth all the steps of proceedings connected therewith. *Ibid.*, 435.

10. It will be sufficient, if it appear that the subject was before the proper tribunal, and that a decision was made in favor of a renewal. *Ibid.*, 435.

11. Certified copies of assignments of patents on record are competent evidence of the originals, and the production of the originals cannot be compelled. *Ibid.*, 436.

12. Papers or drawings on file in the Patent Office are public records, and certified copies of them must be received in evidence when offered. If they are discordant, one may destroy the effect of another; but they need not concur in every particular. *Emerson* v. *Hogg*, 2 Blatchf., 12.—BETTS, J.; N. Y., 1845.

13. If copies of a patent are erroneous, the Commissioner of Patents has the power and ought to make them conform to the patent itself and to the record. *Woodworth* v. *Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

14. Certified copies of papers in the Patent Office must be received as *prima facie* evidence of the genuineness of the originals on file, and absolute evidence of the correctness of the copies from the record. *Parker* v. *Haworth*, 4 McLean, 371.—MCLEAN, J.; Ill., 1848.

15. The Commissioner of Patents, having in his care and custody the records as to patents, it is his duty to give authenticated copies to any person demanding the same, on payment of the legal fees; and for his refusal, an action will lie against him. *Boyden* v. *Burke*, 14 How., 583.—GRIER, J.; Sup. Ct., 1852.

16. But a demand accompanied by rudeness and insult, is not a legal demand. *Ibid.*, 583.

17. A subsequent and proper demand cannot however be refused on account of prior misconduct, or to enforce an apology. *Ibid.*, 583.

18. A certified copy from the Patent Office of an assignment recorded therein will be received as *prima facie* evidence of the genuineness of the original assignment, and the production of the original may be dispensed with. *Parker* v. *Bigler*, MS.—GRIER, J.; Pa., 1857.

19. A certified copy of an assignment of a patent, from the Patent Office of the United States, is *prima facie* evidence of the genuineness of the original. *Lee* v. *Blandy*, 2 Fisher, 91.—MCLEAN, LEAVITT, JJ.; Ohio, 1860.

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## COPYRIGHT.

**A.** ON WHAT FOUNDED; NATURE OF PROPERTY IN; WHAT INCLUDES..... 208
**B.** SUBJECT MATTER OF..... 209
**C.** WHO ENTITLED TO TAKE AND HOLD.. 210
**D.** HOW ACQUIRED; RIGHT TO; HOW LOST, 212
**E.** SECOND TERM OF; TO WHOM BELONGS, 214
**F.** ABANDONMENT OF..... 215
**G.** ACTIONS RESPECTING..... 215
**H.** AGREEMENTS AS TO..... ..... 215

I. ASSIGNMENT AND TRANSFER OF..... 215
J. AUTHOR, WHO IS..... 215
K. BOOK, WHAT IS..... 215
L. COURTS, JURISDICTIONS IN CASES OF.. 215
M. INJUNCTIONS IN RESPECT TO..... 215
N. PUBLICATION, WHAT IS..... 215
O. TRANSLATION, COPYRIGHT IN..... 215
P. VIOLATION OF..... 215

**A.** ON WHAT FOUNDED; NATURE OF PROPERTY IN; WHAT INCLUDES.

1. Copyright was formerly considered to be founded on common law, but can now only be viewed as part of our statute law. *Clayton* v. *Stone*, 2 Paine, 383.—THOMPSON, J.; N. Y., 1828.

2. The privilege of an author to an exclusive sale of his works for a limited number of years, although a monopoly, is not so in the odious meaning of the term; but is but a proper reward for his labor provided by law, and to which he is as much entitled as to the exclusive enjoyment of any other kind of property. *Blunt* v. *Patten*, 2 Paine, 395.—THOMPSON, J.; N. Y., 1828.

3. In the United States, an author can have no exclusive property or copyright in his published production except under the laws of Congress. *Wheaton* v. *Peters*, 8 Pet., 662.—MCLEAN, J.; Sup. Ct., 1834.

4. The author of a literary composition has, at common law, no exclusive right to print and publish it. *Dudley* v. *Mayhew*, 3 Coms., 12.—STRONG, J.; N. Y., 1849.

5. Copyright is an exclusive right to the multiplication of copies for the benefit of the author or his assigns, disconnected from the plate, or any other physical existence. *Stephens* v. *Cady*, 14 How., 530.—NELSON, J.; Sup. Ct., 1852.

6. Before publication, an author has the exclusive possession of the ideas contained in his book, and the combination of words to represent them. But when he has published his book, and given his thoughts, sentiments, knowledge or information to the world, he can have no longer an exclusive possession in them. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

7. When an author has sold his work, the only property which he reserves to himself, or which the law gives to him, is the exclusive right to multiply the copies of that particular combination of characters which exhibits to the eyes of another the ideas intended to be conveyed. This is what the law terms copy or copyright. *Ibid.*, 228.

8. There is no difference, as respects the character and quality of the right, between the right and property of an author at common law, and under the acts of Congress respecting copyrights, or what is an infringement of them. *Ibid.*, 228, 229.

9. 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 cannot constitute the same composition. A translation in no just sense is a copy or tran script of a book. *Ibid.*, 229, 231.

10. An author's exclusive property in a literary composition, or copyright, consists only in a right to multiply copies of his book, and enjoy the profits therefrom, and not in an exclusive right to his conceptions. *Ibid.*, 229.

11. In questions of infringement of copyright, the inquiry is not whether the defendant has used the thoughts, conceptions, information, and discoveries promulgated by the original, but whether his composition may be con-

WHAT IS. SUBJECT MATTER OF.

sidered a *new work*, requiring invention, learning, and judgment, or only a mere transcript of the whole or parts of the original, with mere colorable variations. *Ibid.*, 229.

12. The case of *Miller* v. *Taylor*, 4 Burr, 2311, has finally settled the question as to the nature of the property which an author has in his works; and it is, that after publication, his property consists in the "right of copy," which signifies "the sole right of printing, publishing, and selling his literary composition or book;" not that he has such a property in his original conceptions that he alone can use them in the composition of a new work, or clothe them in a different dress by translation. *Ibid.*, 230.

13. The distinction taken between works which are *publici juris* and those which are the subject of copyright, has no foundation in fact; if the doctrine of the established cases be true, and the author's property in a published book consists only in a right of copy. *Ibid.*, 231.

14. The words *copyright* and *literary property* are not synonymous. The latter phrase has a more general signification than *copyright*, which signifies the exclusive right of an author and his assigns to print his literary composition, and publish and republish it in print. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

15. The ordinary definition of literary property as the exclusive right to *multiply copies* is, for general purposes, too narrow, because the circulation of copies is not the only specific method in which the subject may be profitably used. *Ibid.*, 63.

16. Literary property may be described as the right which entitles an author and his assigns to all the use and profit of his composition, to which no independent right is, through any act or omission on his or their part, vested in another person. *Ibid.*, 63.

## B. SUBJECT MATTER OF.

See also ABRIDGEMENT; CHARTS; COMPILATION; DICTIONARIES; DRAMATIC COMPOSITIONS; ENGRAVINGS; MAPS; MUSIC; PLAN; REPORTS; REVIEWS; TRANSLATION.

1. The object of the acts of Congress securing to authors the exclusive right to their writings, was the promotion of science. *Clayton* v. *Stone*, 2 Paine, 392.—THOMPSON, J.; N. Y., 1828.

2. But the term science cannot with any propriety be applied to a work of so fluctuating and fugitive a character as a newspaper or price current. Such a publication is not a book, the copyright of which can be secured under the acts of Congress. *Ibid.*, 392, 393.

3. A work may be the subject of a copyright, if the plan, arrangement and combination of its materials are new, though the materials may be drawn from many sources, but are for the first time brought together in such plan, arrangement, and combination. *Gray* v. *Russell*, 1 Story, 17.—STORY, J.; Mass., 1839.

4. The editor of an edition of Adam's Latin Grammar made alterations in, and additions to such work, and collected notes from various sources; *Held*, that as the collection and preparation of such notes required labor and intellectual exertion, and the plan and arrangement and combination of them were new, that he was to be deemed the author of

them in their form and arrangement, and entitled to a copyright accordingly. *Ibid.*, 17.

5. Any new and original plan, arrangement, or combination of materials will entitle the author to a copyright, even though the materials are not new. *Emerson* v. *Davies*, 3 Story, 778.—STORY, J.; Mass., 1845.

6. Every author of a book has a copyright in the plan, arrangement, and combination of his materials, and in his mode of illustrating his subject, if it be new and original in its substance. *Ibid.*, 780.

7. He who by his own skill, judgment, and labor writes a new work, and does not merely copy that of another, is entitled to a copyright therein, if the variations are not merely formal and shadowy from existing works. *Ibid.*, 781.

8. And he who constructs a book by a new plan and arrangement and combination of old materials, has a title to a copyright, which cannot be displaced by showing that some part of his plan, or arrangement, or combination, has been used before. *Ibid.*, 781.

9. And though all the materials of a work, or some parts of its plan and arrangement and modes of illustration may be found separately, or in a different form, or different arrangement in other distinct works, if the plan, arrangement, or combination of these materials in another work is new, or for the first time made, the author, or compiler, or framer of it, will be entitled to a copyright. *Ibid.*, 782.

10. There can be no copyright of a plan distinct from the work itself, any more than there can be of an idea; the words in which an idea is expressed are a subject of property; and so is the classification of the subject discussed. *Story's Exrs.* v. *Holcombe*, 4 McLean, 316.—MCLEAN, J.; Ohio, 1847.

11. A person cannot have an exclusive right or copyright in a label, as it is not a book within the provisions of the statute. *Coffeen* v. *Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind., 1849.

## C. WHO ENTITLED TO TAKE AND HOLD.

1. A person who employs others to design and engrave a composition, as an historical print, and who does not design and invent himself, or cause it to be done from his invention, is not entitled to a copyright for such composition. *Binns* v. *Woodruff*, 4 Wash., 53.—WASHINGTON, J.; Pa., 1821.

2. A "resident" under the copyright act of 1831, to be entitled to a copyright must be a permanent resident of the country. A person temporarily residing here, even though he has declared his intention of becoming a citizen, cannot take or hold a copyright. *Carey* v. *Collier*, 56 Niles Reg., 262.—BETTS, J.: N. Y., 1839.

3. Captain Marryatt, a subject of Great Britain, and an officer under that government, being temporarily in this country, took the required oath of his intention to become a citizen, and then took out a copyright for one of his books, and assigned the same to the plaintiff, *Held*, that he was not a "resident" within the meaning of the act of 1831, so as to be entitled to a copyright for his book. *Ibid.*

4. Whether an author who gives his work, not yet protected by copyright, to the public, by printing and publishing it in a newspaper, can have a copyright in the same work by afterward publishing it in a different form, as in

a volume or book; *query*. *Miller* v. *McElroy*, 1 Amer. Law Reg., 204.—HOPKINSON, J.; Pa., 1839.

5. Whether an author by depositing a title-page in the clerk's office, when the work it is intended for is not printed, nor written, nor the manuscript prepared for printing and publication, although the notes or materials from which the work or book is to be, and afterward actually is composed, are then in the hands of the author, may have a copyright of the work afterward prepared and composed, by affixing it to the title-page so deposited; *query*. *Ibid.*, 204.

6. Whether a notice given in some of the newspapers so publishing such matter that the author had secured a copyright, will help him as to his title; *query*. *Ibid.*, 205.

7. The author or compiler of a musical composition, made up of different parts copied from older compositions without material change, and put together into one tune with only slight alterations or additions, is not entitled to a copyright for such therefor. *Reed* v. *Carusi*, 8 Law Rep., O. S., 411.—TANEY, Ch. J.; Md., 1845.

8. One who gets others to compile a work or engrave a print is not entitled to a copyright. *Pierpont* v. *Fowle*, 2 Wood. & Min., 46.—WOODBURY, J.; Mass., 1846.

9. A person cannot secure a copyright for alterations and improvements in a musical composition made by others for him and at his expense. *Atwill* v. *Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

10. Under the copyright act of 1831, the legal assignee of the author may take out the copyright, and it will make no difference whether he holds it as trustee for the benefit of another, or not. *Little* v. *Gould*, 2 Blatchf., 366.—NELSON, J.; N. Y., 1852.

11. An artist who is employed by the United States to engrave a chart, of which the original manuscript was the property of and furnished by the government, has no pretence of right of copyright in the engraved plates or impressions therefrom. *Siebert's Case*, 7 Opin., 656.—CUSHING, Atty. Gen.; 1856.

12. Where an artist was attached to an expedition sent out by the government, as a master's mate, and as such agreed to perform such duties as should be required of him, but his chief duty was to make sketches and drawings for the government, and he was informed that all the sketches and drawings which should be made by any one were to be the exclusive property of the government, and that no one could appropriate them to his own use, and afterward such artist took out a copyright in his own name for the sketches made by him, *Held*, that he was not such an author and proprietor as to be entitled to an exclusive right in the sketches so made by him. *Heine* v. *Appletons*, 4 Blatchf., 128.—INGERSOLL, J.; N. Y., 1857.

13. Where a person, employed by another as a performer and stage-manager, agreed to write a play, which was to be performed in his, the employer's, theatre as long as it should continue to draw good audiences, *Held*, that the person writing the drama was the proper person to take out the copyright, and that the employer had no right or interest in it, except the privilege of having it performed at his theatre. *Roberts* v. *Myers*, 13 Mo. Law Rep., 400.—SPRAGUE, J.; Mass., 1860.

14. Under the act of 1831, no person

can obtain a copyright, except authors who are citizens or residents of the United States, and proprietors under derivations of title from *such* authors. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

15. The assignee of a work composed by a *non-resident alien*, cannot take a copyright for it. *Ibid.*

## D. HOW ACQUIRED; RIGHT TO; HOW LOST.

1. The provisions of the act of 1790, which require the author to publish the title of his book in a newspaper, and to deliver a copy of the work itself to the secretary of state, are merely directory, and constitute no part of the essential requisites for securing the copyright. *Nichols* v. *Ruggles*, 3 Day, 158; Ct., 1808.

2. The publication in the newspaper is intended as legal notice of the rights secured to the author, but is not necessary where actual notice is brought home to the party. *Ibid.*, 158.

3. The copy to be delivered to the secretary of state, appears to be designed for public purposes, and has no connection with the copyright. *Ibid.*, 158.

4. Under the copyright act of 1790, a copy of a book may be deposited with the department of state after the expiration of six months from the time of its publication, if not done before, and will avail from the time of its being deposited. *Daboll's Case*, 1 Opin., 532. WIRT, Atty. Gen., 1822.

5. Under § 3 of the act of 1790, a proprietor can acquire no title to a copyright for the term of the first fourteen years, unless he shall deposit in the clerk's office a printed copy of the title of the book. *Ewer* v. *Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

6. Under such act the condition upon which the proprietor is to be entitled to the benefit of the act, cannot be extended to the requisition contained in the last sentence of that section, to publish a copy of the record of the title, as prescribed therein. *Ibid.*, 490.

7. If the title of an author depended upon the act of 1790, it would be complete, provided he had deposited a printed copy of the title of the book in the clerk's office, as directed by § 3; and the publication of a copy of the same would only be necessary to enable him to sue for the forfeitures created by that section. *Ibid.*, 490.

8. But by the supplemental act of 1802, no person can be entitled to the benefit of the act of 1790, unless he shall, *in addition* to the requisites enjoined by that act, cause a copy of the record required by that act to be published, to be inserted in the title-page, or in the next page. *Ibid.*, 490.

9. The person, therefore, claiming a copyright, before he can be entitled to the benefits of the act of 1790, must perform the requisites required by the act of 1802 *in addition* to those prescribed in §§ 3 and 4 of the act of 1790, and must perform the whole. The act admits of no other construction. *Ibid.*, 491.

10. The meaning of the act is as if it read, "the proprietor, before he shall be entitled to the benefit of the act of 1790, shall cause a copy of the record of the title to be published, and shall deliver a copy of the book to the secretary of state, as directed by §§ 3 and 4 of that act; and shall also cause a copy of the said record to be inserted at full length in the title-page," &c. *Ibid.*, 491.

11. Under the act of 1790, and particularly when considered in connection with the act of 1802, an author can obtain no exclusive right in his work unless he complies with the requirements of §§ 3 and 4 of the act of 1790, by causing a copy of the record of his copyright to be printed in the newspapers, and delivering a copy of his work to the secretary of state. *Wheaton* v. *Peters*, 8 Pet., 664, 665.—McLean, J.; Sup. Ct., 1834.

12. Where a work consists of a number of volumes, the insertion of the record on the page next following the title-page of the *first volume* of the work, is a sufficient compliance with the statute. *Dwight* v. *Appletons*, 1 N. Y. Leg. Obs., 198.—Thompson, J.; N. Y., 1843.

13. The author may insert the same record in another edition published in a different number of volumes, without impairing the copyright. *Ibid.*, 199.

14. The number of volumes in which it was stated the work would be published, made no part of its title, and may be rejected as surplusage. *Ibid.*, 199.

15. The delivery to the secretary of state of the first volume of the work within six months after its publication, and of the rest of the volumes before the offence complained of is committed, or the action brought, is a sufficient compliance with the law. *Ibid.*, 199.

16. This case distinguished from *Wheaton* v. *Peters*, 8 Pet., 591, as in that case it did not appear that the volumes had been delivered to the secretary of state, at any time. *Ibid.*, 190.

17. The act of Congress of 1831, respecting copyrights, embodies the provisions of the acts of 1790 and 1802 on the subject, and imposes on persons claiming the privilege of copyright the same duties and liabilities which attended the right under the prior statutes. *Baker* v. *Taylor*, 2 Blatchf., 83.—Betts, J.; N. Y., 1848.

18. Under such act, depositing the title-page in the proper clerk's office, publishing a notice according to the act, and delivering a copy of the book, are conditions the performance of which is essential to the title. *Ibid.*, 84.

19. Where the title-page of a book was deposited in 1846, and the notice of the entry, inserted in the book, stated it to have been deposited in 1847, *Held*, that the error created a fatal defect in the plaintiff's title. *Ibid.*, 84.

20. Even if the error arose from mistake, it will make no difference as to the result. *Ibid.*, 84.

21. Under § 4 a person is not entitled to any benefit, under the act, unless he deposits the title-page *before* the publication of his work. *Ibid.*, 85.

22. The publication of a work, without having secured a copyright, is a dedication of it to the public; that having been done, any one may republish it. *Bartlett* v. *Crittenden*, 5 McLean, 37.—McLean, J.; Ohio, 1849.

23. By the provisions of the copyright act of 1831, there are three preliminary steps requisite to the securing a valid copyright. 1. The deposit of a printed copy of the title before publication with the clerk of the district court; 2. Notice to the public, by printing in the place designated the fact of the entry, in the form prescribed by the statute; and 3. The deposit with the clerk of a copy of the book, &c., or musical composition, within three months from the date of publication. *Jollie* v. *Jacques*, 1 Blatchf., 620.—Nelson, J; N. Y., 1850.

24. § 10 of the act of 1846, establishing the Smithsonian Institution, required that authors should within three months from publication deliver one copy of their books, &c., to the librarian of that institution, and to the Congress library; but such delivery is not a pre-requisite to a title to the copyright. *Ibid.*, 620, 622.

25. The provision of the above act as to the delivery of a copy of a book to the librarian of the Smithsonian Institution and of Congress, is now repealed by § 6 of the act of 1859, chap. 22. [Ed.]

26. Until all the things required by § 4, 5, of the act of 1831 are done, the copyright is not secured; but by taking the incipient step, a right is acquired, which chancery will protect, until the other acts may be done. *Pulte* v. *Derby*, 5 McLean, 332.—McLean, J.; Ohio, 1852.

27. The publication of an official report under the direction of Congress, and for the benefit of the public, is a dedication of it, and of what is contained in it, to the public, and any one may reprint it. *Heine* v. *Appletons*, 4 Blatchf., 128.—Ingersoll, J.; N. Y., 1857.

28. The provisions of § 5 of the copyright act of 1831, as to the deposit of the title-page of the book to be copyrighted before publication, and the deposit of a printed volume of the book within three months after publication, must be complied with, in order to enable a party to avail himself of the provisions secured by that act. *Struve* v. *Schwedler*, 4 Blatchf., 24.—Nelson, J.; N. Y., 1857.

29. Where neither of these steps had been taken until nearly two years after the work had been published, *Held*, that the author could not have an injunction to protect his alleged copyright. *Ib.*, 24.

30. The record from the clerk's office, made in the form prescribed by § 4 of the act of 1831, or of the depositing of a title-page, is *prima facie* evidence that a printed title was deposited. *Roberts* v. *Myers*, 13 Mo. Law Rep., 398.—Sprague, J.; Mass., 1860.

31. After such title-page has been deposited, the author can maintain an action for an infringement or violation of his right, even though the work may not have been published, or the printed copy deposited. *Ibid.*, 398.

32. Under the statute, a copy of the book must be deposited within three months after its publication; but the acting or representing a play is not such a publication as is meant by the statute. *Ibid.*, 398.

33. The mere adoption of the measures, as depositing a title-page, by which a copyright may be secured, has no such effect, unless their adoption has been followed or attended by an actual publication in print. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—Cadwallader, J.; Pa., 1860.

## E. Renewed or second Term of; to whom belongs.

1. Where A employed B to compile a school book, and agreed to pay him $500, and B conveyed to A the "copyright," *Held*, that only the usual copyright of fourteen years, then existing or taken out, passed under the contract. *Pierpont* v. *Fowle*, 2 Wood. & Min., 42, 43.—Woodbury, J.; Mass., 1846.

2. Such an assignment is to be referred to what was then in existence, and not to any future contingency. *Ibid.*, 43, 45.

3. The extension of a copyright, by the copyright acts of 1790 and 1831,

is given to the author alone, or to others only who purchase it from him. *Ibid.*, 44.

4. An assignment of a "copyright" should not by construction be extended beyond the first term, unless it seems to be actually so meant by the author, and to include any future contingency. *Ibid.*, 44.

5. Otherwise, if the contract of sale or assignment uses language looking beyond the existing copyright, such as referring to all the *interest* in the matter, or to the *manuscript* or book itself, or using some other expression more comprehensive than the word "copyright." *Ibid.*, 45.

6. The taking out a second term of a copyright is not like the strengthening of a defective title, but rather like a new interest obtained after the general interest had expired. *Ibid.*, 46.

7. A claim under a renewal term necessarily involves the validity of the right under the first as well as the second term. *Wheaton* v. *Peters*, 8 Pet., 663.—McLean, J.; Sup. Ct., 1834.

**F.** Abandonment of.

See Abandonment, A.

**G.** Actions respecting.

See Actions, A.

**H.** Agreements, as to.

See Agreements, A.

**I.** Assignment and Transfer of.

See Assignee, A.; Assignment, A, C.

**J.** Author, who is.

See Author.

**K.** Book, what is.

See Book.

**L.** Courts, Jurisdiction in Cases of.

See Courts, A.

**M.** Injunctions, in Respect to.

See Injunctions, A.

**N.** Publication, what is.

See Publication.

**O.** Translation, Copyright in.

See Translation.

**P.** Violation of.

See Infringement, A.

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## CORPORATIONS.

1. Though, as a general rule, corporations are not liable to be sued in actions of tort, it does not follow that they may not be sued in actions on the case for injuries done to the rights of others, notwithstanding the plea is, not guilty. *Kneass* v. *Schuylkill Bank*, 4 Wash., 14.—Washington, J.; Pa., 1820.

2. Therefore, when a corporate body, acting in its corporate character, directs an act to be done which infringes the rights of another, as the using of his invention, they may be sued in an ac-

tion on the case for such infringement. *Ibid.*, 14.

3. A corporation chartered under the laws of a state, for the purpose of carrying on manufactures by means of a particular invention, has, independently of any general act giving to corporations the right to hold personal estate, power to purchase the patent for the invention, for the working of which it was chartered. *Blanch. Gun-Stock Turn. Fac.* v. *Warner*, 1 Blatchf., 277.—Nelson, J.; Ct., 1846

4. By the common law, corporations have a right to purchase and hold property so far as may be necessary to carry into execution the purposes and objects for which they are created. *Ibid.*, 277.

5. A corporate body created by the laws of one state, has no corporate existence beyond the limits of the territory within which the law creating it can operate, and is not such a person as can be considered an inhabitant of any district, so as to be served with process. *Day* v. *Newark I. R. Co.*, 1 Blatchf., 632.—Nelson, J.; N. Y., 1850.

6. Where, therefore, the defendants were a corporation created by the laws of New Jersey, but had a store in the city of New York, and a process of attachment under the laws of New York was commenced against and levied upon its property in New York, and the summons was also served upon the president of the company who was casually in New York, *Held*, that the Circuit Court had no jurisdiction of the action. *Ibid.*, 633, 634.

7. Under § 11 of the judiciary act of 1789, the Circuit Courts have no jurisdiction in suits instituted against foreign corporations, even in cases where the state practice, if adopted by them, would authorize the institution of such suits by attachment of their goods found within their jurisdiction. *Ibid.*, 634.

8. The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction it manufactures and sells articles which are an infringement of a patent, and its agents who conduct its business of selling such articles, are responsible for such infringement, and will be restrained by injunction. *Goodyear and N. E. Car-Spring Co.* v. *Phelps*, 3 Blatchf., 92.—Nelson, J.; N. Y., 1853.

9. A railroad corporation, created by one state, and owning a road within that state, is liable to an action for the use of a patented improvement on cars run on that road, though another corporation, created by another state, held the stock, furnished and worked the road, but charged to the first corporation the expense of such outlays, and credited it with the earnings. *York & Md. R. R. Co.* v. *Winans*, 17 How., 40.—Campbell, J.; Sup. Ct., 1854.

10. A corporation is liable in damages for infringing a patent, if the patented machines are procured by such corporation, and are used by those employed or paid by it. *Ransom* v. *Mayor, &c.*, 1 Fisher, 274.—Hall, J.; N. Y., 1856.

11. A corporation acts only by those who are in its employ. Where one in the employ of a corporation, in the business of his employment, does an act for their benefit, and which they adopt and approve and take advantage of, the corporation will be deemed to have authorized the act, and will be bound by it as if expressly authorized. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 72.—Ingersoll, J.; N. Y., 1858.

12. The manufacture of articles in violation of a patent, by an agent of a

corporation, and the sale of such articles by and for the benefit of such corporation, makes them liable for the infringement. *Ibid.* 72, 73.

13. The fact that as between themselves parties are connected together as the stockholders, managers, and servants of a corporation, will not exempt them from being enjoined, or being liable to an action for infringement. *Poppenhausen* v. *Falke*, 4 Blatchf., 494.—SHIPMAN, J.; N. Y., 1861.

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## COSTS IN PATENT SUITS.

1. At common law a plaintiff was not entitled to costs in any case; and the statute of Gloucester giving costs gave them only in cases where damages were recoverable at common law. *Knecss* v. *Schuylkill Bank*, 4 Wash., 107.—WASHINGTON, J.; Pa., 1821.

2. It is the act of Congress alone which gives an inventor a right of property in the subject of his invention, consequently an action for an infringement of a patent is not a case in which damages could have been recovered at common law. *Ibid.*, 107.

3. Under § 20 of the judicary act of 1789, if a plaintiff recovers less than five hundred dollars, he cannot recover costs; but at the discretion of the court may be adjudged to pay them. *Ibid.*, 107.

4. In an action for an infringement of a patent the plaintiff recovered *three cents damages*, and at a subsequent term of the court obtained a rule upon the defendants to show cause why the costs should not be trebled. The defendants retorted by a rule on the plaintiffs to show cause why the judgment should not be entered without costs. The court discharged the first rule and made the second absolute. *Ibid.*, 107.

5. A plaintiff is not entitled to recover costs for an infringement of a patent, as to which a disclaimer is filed, unless such disclaimer is filed before suit brought, even if he proves an infringement of a part of the invention not disclaimed. *Reed* v. *Cutter*, 1 Story, 600.—STORY, J.; Mass., 1841.

6. Though the deposition of a witness residing more than one hundred miles from the place of trial has been taken, the witness may be produced on the trial, and if so produced full costs of his personal travel and attendance will be allowed in the costs. *Prouty* v. *Ruggles*, 2 Story, 200.—STORY, J.; Mass., 1842.

7. Postage paid for the transmission of a commission to take testimony should be allowed as part of the costs. *Ibid.*, 202.

8. Where a demurrer could have been taken to a bill in equity, but the defendants instead of demurring filed an answer, and testimony was taken and the bill was dismissed upon the merits, because the plaintiff did not show a sufficient title, *Held*, that the defendants were not entitled to costs. *Brooks* v. *Byam*, 2 Story, 553.—STORY, J.; Mass., 1843.

9. Costs in equity are altogether in the discretion of the court, but this discretion is to be a sound one, exercised on principle, and with a reference to the general rules of practice. *Ibid.*, 553, 554.

10. Where a bill was dismissed on the merits, each party to bear his own costs, but a record had been printed under the order of the court, *Held*, that the costs of the printing such record

was to be equally divided between the parties. *Ibid.*, 554.

11. In the first circuit the plaintiff in patent cases is not required to give security for costs. *Woodworth* v. *Sherman*, 3 Story, 173.—STORY, J.; Mass., 1844.

12. Where neither the laws of a state nor the acts of Congress provide for the allowance of any particular item of costs, it is to be taxed only when relating to the competent evidence in the case, and connected with what is appropriately a matter of cost rather than damages and expenses in preparing a cause. *Hathaway* v. *Roach*, 2 Wood. & Min., 71.—WOODBURY, J.; Mass., 1846.

13. If a case is suspended or postponed by agreement, and not by order of court, except to carry such agreement into effect, the witnesses will not be allowed another travel fee, unless such is the agreement, but their continued attendance until discharged will be allowed. *Ibid.*, 72.

14. In the courts of the United States witnesses are entitled to travel "from the places of their abode" by the act of Congress (act of 1799, ch. 9, § 6, vol. 1 Stat. at Large, p. 626), though beyond the line of the state. *Ibid.*, 73.

15. Copies of assignments, showing plaintiff's interest, and produced and obtained by the defendant, are taxable in defendant's costs, as they are competent and proper evidence, and the plaintiff is not bound to produce them, nor is the defendant bound to ask plaintiff's admission to such assignment. *Ibid.*, 74.

16. But a copy of the plaintiff's patent, procured by the defendant, is not taxable, as the plaintiff is bound by law to offer it in evidence. *Ibid.*, 74.

17. In equity, as a general rule, costs are allowed to the prevailing party. What prevails by law is presumed to be moral, and conscientious, and equitable. But if peculiar circumstances, of an equitable character, exist against a party, they may be withheld; but the burden to show these peculiar circumstances is on the party asserting them. *Hovey* v. *Stevens*, 3 Wood. & Min., 32, 33.—WOODBURY, J.; Mass., 1846.

18. If a long defence is put in by a respondent and fails, and the bill is dismissed on other grounds, he will not be allowed costs. And if the action was not for any wrong of the defendant, but to settle the title of the plaintiff, and he has a decree, he will have no costs as against the defendant. *Ibid.*, 33.

19. The fact that a bill for an injunction failed, on account of a defective specification, is not a failure for any fault of the defendant; nor is it from the want of form in the bill or pleadings, and hence not to be visited by large costs against the plaintiff. But it was a defect in the plaintiff's title. *Ibid.*, 34.

20. Where the course of the defendant was not wholly favorable to his claims in equity, only disbursements and the usual counsel fee were allowed, and he was not permitted to tax the travel and attendance of witnesses, who were in attendance in an action at law, at the same term, between the same parties. *Ibid.*, 36, 37.

21. Where a patent is too broad, the plaintiff in an action for infringement, though he may recover judgment, is not entitled to costs against the defendant, unless a disclaimer shall have been filed before the commencement of the suit. But the question of damages, and

the power of the court to increase the verdict, remain the same as if costs were allowed. *Guyon* v. *Serrell*, 1 Blatchf., 245, 246.—NELSON, J.; N. Y., 1847.

22. Where a patent contains several claims, and the invention embraced by one is not new, or is useless, the patentee under §§ 7 and 9 of the act of 1837 may still maintain an action for an infringement, although he did not, before the commencement of the suit, make a disclaimer of that part of the invention claimed without right; but he will not be entitled to costs. *Hall* v. *Wiles*, 2 Blatchf., 198—NELSON, J.; N. Y., 1851.

23. If, in the progress of the trial, it turns out that a disclaimer ought to have been made as to part of what is claimed, the plaintiff may still recover, but will not be entitled to costs. *Ibid.*, 198.

24. Where a judgment is entered up without the costs having been taxed and inserted in it, it is proper for the court, at a subsequent term, to have the costs taxed and entered *nunc pro tunc* as a part of the original judgment. *Sizer* v. *Many*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

25. Under § 9 of the act of 1837, in an action for infringement, the plaintiff is not entitled to recover costs upon a judgment in his favor, if he has claimed any thing in his patent, of which he was not the first and original inventor, unless before suit brought he has disclaimed such part; and it makes no difference, in this respect, whether the infringement alleged was in respect to the part claimed, but not new, or of some other part claimed in the patent. *Seymour* v. *McCormick*, 19 How., 105.—NELSON, J.; Sup. Ct., 1856.

26. Under the act of Feb. 26, 1853, (10 U. S. Stat., at Large, 162), the item of $2.50 allowed as costs to a solicitor for each deposition taken and admitted in evidence in a cause, is not taxable in an equity suit, except for the deposition when admitted on a final hearing. *Stimpson* v. *Brooks*, 3 Blatchf., 458. —BETTS, J.; N. Y., 1856.

27. The whole provision of that statute, covering taxable proceedings, has direct relation to those which are final in the cause, and not to interlocutory or incidental ones, however necessary they may be in its progress. *Ibid.* 457.

28. In an action at law for the infringement of a patent, the expense of models of the defendant's machines cannot be taxed against him. *Parker* v. *Bigler*, 1 Fisher, 286.—GRIER, J.; Pa., 1857.

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## COUNSEL FEES IN PATENT SUITS.

1. Counsel fees and expenses of witnesses, beyond the taxable costs, are not to be considered as items of actual damage. (So held on the authority of *Arcambal* v. *Wiseman*, 3 Dall., 306.) *Whittemore* v. *Cutter*, 1 Gall., 431, 433. —STORY, J.; Mass., 1813.

2. The jury are at liberty, if they see fit, to allow a plaintiff as part of his "actual damages," any expenditure for counsel fees, or other charges, which were necessarily incurred to vindicate the rights derived under his patent, and which are not taxable in the bill of costs. *Boston Manuf. Co.* v. *Fiske*, 2 Mas., 122.—STORY, J.; Mass., 1820. (So held after a fuller and more careful examination of the case of *Arcambal* v. *Wiseman*, and overruling the decision in *Whittemore* v. *Cutter*.) [But see *post* 3, 5, 8–11.]

3. In an action of infringement, the jury may allow the plaintiff in damages,

his actual costs, which include reasonable counsel fees, as well as any taxable costs he had paid in consequence of the violation of defendant. *Allen* v. *Blunt*, 2 Wood. & Min., 146.—WOODBURY, J.; Mass., 1846.

4. The "actual damages" sustained include all necessary and proper expenses in protecting one's violated rights. Though they should not include "smart-money," they may well embrace every thing really suffered by the wrong. *Ibid.*, 146, 147.

5. Counsel fees, and other expenditures, beyond or in addition to those taxable, cannot be allowed by the jury as a part of the *actual* damages sustained by a plaintiff in an action for an infringement of a patent. *Stimpson* v. *The Railroads*, 1 Wall, Jr., 166, 169.—GRIER, J.; Pa., 1847.

6. In no case is the degree of the defendant's delinquency to be measured by the expenses of the plaintiff in prosecuting his suit. *Ibid.*, 170.

7. Where the circumstances of infringement are of an aggravated character, what are sometimes called vindictive damages, which would include counsel fees, and something more by way of example, to deter others from doing the same thing, may be given. *Parker* v. *Corbin*, 4 McLean, 463.—MCLEAN, J.; Ohio, 1848.

8. In the second circuit the jury are confined to the actual damages sustained by the plaintiff, and cannot include as a part of his damages his expenses and counsel fees. *Blanch. Gun-Stock Manuf. Co.* v. *Warner*, 1 Blatchf., 272 (note).—NELSON, J.; Ct., 1846.

9. Expenses and counsel fees are not to be included in the verdict as actual damages. *Simpson* v. *Leiper*, 2 Whar. Dig., 414.—GRIER, J.; Pa., 1848.

10. The jury are to give compensatory damages, such as will indemnify the plaintiff for the injuries he has directly sustained, but they cannot include the expenses of litigation in their verdict. *Parker* v. *Hulme*, 7 West. Law Jour., 429.—KANE, J.; Pa., 1849.

11. Counsel fees are not a proper element for the consideration of the jury in the estimation of damages, in actions for the infringement of a patent. *Tesse* v. *Huntington*, 23 How., 8.—CLIFFORD, J.; Sup. Ct., 1859.

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# COURTS, JURISDICTION OF.

**A.** IN RESPECT TO COPYRIGHTS AND MANUSCRIPTS..... 220
**B.** IN RESPECT TO PATENTS.
1. *Supreme Court, United States*.. 222
2. *Circuit Courts, United States*... 223
3. *District Courts, U. S., under acts of* 1790 *and* 1793..... 227
4. *State Courts* ..... ..... 228
**C.** AUTHORITY OF DECISIONS OF, IN OTHER COURTS..... ... 230

## A. IN RESPECT TO COPYRIGHTS AND MANUSCRIPTS.

See also ACTIONS, A.; EQUITY, A.; INJUNCTIONS, A.; LETTERS; MANUSCRIPTS.

1. At common law, the author of a manuscript may obtain redress against any one who deprives him of it, or who by improperly obtaining a copy endeavors to realize a profit from its publication. *Wheaton* v. *Peters*, 8 Pet., 657.—MCLEAN, J.; Sup. Ct., 1834.

2. And there can be no doubt that the rights of an assignee of such manuscript would be protected by a Court of Chancery. *Ibid.*, 661.

3. Where a wrong has been commit-

ted in respect to a literary work, but the bill does not ask an injunction to protect the common law right of the author, or the violation of any copyright secured, but only asks an account, redress cannot be sought in a court of equity, but the party must proceed at law for damages. *Monk* v. *Harper*, 3 Edw. Ch., 110, 111.—McCoun, V. Ch.; N. Y., 1837.

4. Under the acts of 1790 and 1819, as to patents and copyrights, the owners of copyrights and patents do not have redress or relief in any cases where they could not before have had relief in some court either of equity or law. *Pierpont* v. *Fowle*, 2 Wood. & Min., 27.—Woodbury, J.; Mass., 1846.

5. These acts merely enabled them to prosecute such claims in the Circuit Court of the United States as they legally had done before, but without going to the state tribunals; the public interest required a uniform construction to be placed by one tribunal on all important questions, questions connected with rights so held. *Ibid.*, 27.

6. At common law, independently of the statute, the author of a manuscript might obtain redress against one who had surreptitiously gained possession of it. *Bartlett* v. *Crittenden*, 4 McLean, 301.—McLean, J.; Ohio, 1847.

7. On general equitable principles, relief may also be given, under like circumstances, by a court of chancery. *Ibid.*, 301.

8. At common law, an author may maintain an action for the damages which he might sustain by his manuscript being surreptitiously printed by others. *Hoyt* v. *McKenzie*, 3 Barb. Ch., 323.—Walworth, Chan.; N. Y., 1848.

9. The common law protects the right of an author to his manuscript only. *Bartlett* v. *Crittenden*, 5 McLean, 38. —McLean, J.; Ohio, 1849.

10. But § 9 of the copyright act of 1831 also protects such right. *Ibid.*, 38.

11. In a suit under the copyright acts, the plaintiff must make out a title to sue under his copyright. The court cannot interfere to prevent the use of a work in fraud of the plaintiff, upon principles relating to the good-will of trades. *Jollie* v. *Jaques*, 1 Blatchf., 627. —Nelson, J.; N. Y., 1850.

12. A suit arising out of an agreement as to the publication of a manuscript, and to determine the rights of the parties under it, is not a suit under the copyright laws, of which the Circuit Court has jurisdiction by reason of subject matter. *Pulte* v. *Derby*, 5 McLean, 336.—McLean, J.; Ohio, 1852.

13. The act of February 15, 1819, so far as it gave cognizance to the courts of the United States in cases of copyrights, still remains in force, and is the only law conferring equitable jurisdiction on these courts in such cases; § 9 of the act of 1831 protects manuscripts only. *Stephens* v. *Gladding*, 17 How., 455.—Curtis, J.; Sup. Ct., 1854.

14. The equity jurisdiction of such courts, as to copyrights, does not extend to the adjudication of forfeitures; a decree therefore cannot be entered for the penalties incurred for a violation of a copyright. *Ibid.*, 455.

15. The jurisdiction of the federal courts, under the acts of Congress, respecting copyrights, has not taken away or diminished the original jurisdiction, which before such acts the state courts exercised, except where the jurisdiction was made exclusive in express

terms, or by the necessary construction of the federal constitution. *Woolsey* v. *Judd*, 4 Duer, 382.—DUER, J.; N. Y., 1855.

16. Where an assignment of a play gave to the assignee the exclusive right to represent the same within a certain territory for a fixed period of time, and only the title-page of such play had been filed, but no printed copy had been deposited, on bill filed by the assignee to protect his right, *Held*, that the court had jurisdiction. *Roberts* v. *Myers*, 13 Mo. Law Rep., 400, 401.—SPRAGUE, J.; Mass., 1860. [But see *post* 21.]

17. Under the act of Congress giving to the Circuit Courts cognizance of cases arising under the laws of the United States, granting to authors the exclusive right to their writings, the citizenship of the parties litigant is immaterial. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

18. And under the statutes which confer and regulate *rights* of literary proprietorship, the citizenship of such parties is also unimportant. It is sufficient if the complainant is a resident of the United States. *Ibid.*, 45.

19. The act of 1831, § 9, giving redress for the unauthorized *printing* or *publishing* of *manuscripts*, gives no redress for an unauthorized theatrical representation of a play. The word *publish* means publish in *print*. *Ibid.*, 45.

20. The only statute which affords redress for unauthorized theatrical representations is the act of August 18, 1856. But this applies only to cases in which copyright is effectually secured under the act of 1831. *Ibid.*, 45.

21. Where a play had never been printed, and consequently a copy thereof could not be deposited with the clerk within the time prescribed after its *publication*, but all the other statutory requirements had been complied with, *Held*, that jurisdiction for an unauthorized publication could not be maintained under such act of 1856. *Ibid.*, 45.

22. But jurisdiction of such a case may be maintained if the parties, plaintiff and defendant, are residents of different states, or if the plaintiff is an alien. *Ibid.*, 45, 46.

## B. IN RESPECT TO PATENTS.

### 1. *Supreme Court United States.*

See also APPEALS, A.; BILL OF EXCEPTIONS; WRIT OF ERROR.

1. The question whether one machine is substantially like another is one of fact, and cannot be certified to the Supreme Court under § 6 of the act of 1802, ch. 31. Such act applies only to questions of law. *Wilson* v. *Barnum*, 8 How., 262.—TANEY, Ch. J.; Sup. Ct., 1849.

2. Where the principles governing a patent cause have been settled by this court, it will decline to hear an argument upon technical questions of pleading arising in another case, under the same patent, and the ruling in respect to which would have no influence upon the ultimate decision of the case. *Smith* v. *Ely*, 15 How., 142.—TANEY, Ch. J.; Sup. Ct., 1853.

3. An objection not taken before the court below cannot be taken before the Supreme Court on appeal. *Kinsman* v. *Parkhurst*, 18 How., 295.—CURTIS, J.; Sup. Ct., 1855.

4. Where a bill is filed to enforce the specific performance of a contract in re-

lation to a patent, the Supreme Court has no appellate jurisdiction, unless the matter in controversy exceeds the value of two thousand dollars. *Brown* v. *Shannon*, 20 How., 56, 57.—TANEY, Ch. J.; Sup. Ct., 1857.

5. The court may, however, lawfully exercise its jurisdiction when a far less amount is in dispute, if a party is proceeding in law or equity for the infringement of a patent-right to which he claims to be entitled. *Ibid.*, 56.

6. The amount of the penalty in a bond taken on an injunction in the court below cannot be referred to to give jurisdiction. *Ibid.*, 58.

### 2. *Circuit Courts United States.*

See also ACCOUNT; EQUITY, B.; INJUNCTION, B.

1. The Circuit Courts, if not inferior in the technical sense of the books, are so considered by the constitution, and are in fact subordinate to the Supreme Court, and their jurisdiction is special and limited, both in regard to the nature of the cases on which they can decide, and the character of the parties who can come into them. *Livingston* v. *Van Ingen*, 1 Paine, 48.—LIVINGSTON, J.; N. Y., 1811.

2. If jurisdiction of cases "arising under the laws of the United States" be not conferred on these courts by an act of Congress, they cannot take cognizance of them. *Ibid.*, 50.

3. By the judiciary act of 1789 the Circuit Courts were not clothed with equity powers in actions between citizens of the same state; and under the act of 1800 they were given jurisdiction in patent cases only in actions on the case. On a bill filed to restrain the infringement of a patent, where all the parties were citizens of the same state, *Held*, that the court could not take cognizance of such a case, and that the bill must be dismissed. *Ibid.*, 52, 54.

4. If, however, under the act of 1800 it became necessary in an action at law regularly before such court, for either party to appeal to its equity side in aid or defence of such action, such application might not be improper. *Ibid.*, 53.

5. A Circuit Court must not only confine itself to the cases defined by Congress, but if by a particular law it is authorized to proceed in a given case as a court of law only, a party must come into it on that side to bring himself within the provisions of it. *Ibid.*, 54.

6. The fact that the subject matter of a contract sought to be enforced is a patent-right, does not *per se* give the courts of the United States jurisdiction; a bill filed for the specific performance of such a contract must contain the proper averments to give such jurisdiction. *Burr* v. *Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

7. Under the acts of 1793 and 1800, the Circuit Courts of the United States alone have jurisdiction of actions brought for damages *for the infringement* of a patent-right; as by those acts *in such actions* the court can declare the patent void. *Burrall* v. *Jewett*, 2 Paige, 145. —WALWORTH, Ch.; N. Y., 1830.

8. But the jurisdiction conferred upon such courts by the act of 1819, "in suits both at law and equity arising under the patent laws," is not, either in terms or by necessary implication, rendered exclusive as to all actions in reference to patents. *Ibid.*, 145, 146.

9. A Circuit Court in a civil suit cannot declare a patent void except for the

cause specified in § 6 of the act of 1793. If the patent is defective for any other cause the verdict must be general for the defendant. *Whitney* v. *Emmett*, Bald., 316, 317, 321.—BALDWIN, J.; Pa., 1831.

10. Under §§ 16 and 17 of the act of 1836, the Circuit Courts of the United States have exclusive cognizance of suits in equity, relative to interfering patents in cases where the court is authorized to adjudge and declare a patent inoperative or void, either wholly or in part, or in any particular portion of the United States. *Gibson* v. *Woodworth*, 8 Paige, 134.—WALWORTH, Ch.; N.Y., 1840.

11. Whether such courts have exclusive jurisdiction of every case in which a right under the patent laws might come in question collaterally; or in cases except where from the nature of the relief, their jurisdiction must necessarily be exclusive; *query*. *Ibid.*, 134.

12. The Circuit Courts have no jurisdiction of an action, as to enforce the specific execution of a contract respecting a patent, where the parties are all citizens of the same state; but where the plaintiffs set up a right under a patent, and allege that the defendants are infringing, citizenship will not oust jurisdiction. *Brooks* v. *Stolley*, 3 McLean, 525.—MCLEAN, J.; Ohio, 1845.

13. But where the court has obtained jurisdiction on the ground of infringement, it may then decide other matters which of themselves would not afford ground for the original exercise of jurisdiction. *Ibid.*, 529.

14. Under § 17 of the act of 1836, the jurisdiction as to subject matter of the Circuit Court does not extend to a bill in equity filed for the specific performance of a contract to transfer a patent, the jurisdiction of such courts being confined to actions under the patent *laws* granting or confirming rights to inventors. *Nesmith* v. *Calvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845.

15. If such a bill is filed against several defendants, some of whom are residents of the same state with the complainants, the bill may still be maintained against the defendants who are residents of another state. *Ibid.*, 37.

16. And if such bill contain a prayer for an injunction against the use of the patent by all, this would be ground, it seems, of jurisdiction over all the defendants as to subject matter. *Ibid.*, 38.

17. Objections to the jurisdiction on account of parties or subject matter, if not made until after answers are put to the merits, replications filed, and the evidence published, will be too late. *Ibid.*, 38.

18. Proceedings by bill in equity, under § 16 of the act of 1836, and § 10 of the act of 1839, against the Commissioner of Patents to compel him to issue a patent, must be commenced in the Circuit Court of the United States for the District of Columbia, and cannot be brought elsewhere. No tribunal out of the district has jurisdiction over the person of the Commissioner of Patents, as such, and the Patent Office. *Prentiss* v. *Ellsworth*, Mir. Pat. Off., 36.—RANDALL, J.; Pa., 1846.

19. Where an owner of an undivided interest in a patent filed a bill against the other joint owner to compel the specific performance of a contract in respect to manufacturing under such patent, and the defendant among other things denied that he was manufacturing under the patent, and set up that

the article manufactured by him was different from that patent, *Held*, that the question raised was one of infringement of a patent-right, of which a state court had no jurisdiction. *Parkhurst* v. *Kinsman*, 2 Halst., Ch., 600-609.—HALSTEAD, Chan.; N. J., 1847.

20. In cases arising under the patent laws, the jurisdiction of the Circuit Courts does not depend upon the citizenship of the parties to the action, or the amount in dispute, but upon the subject matter. The parties may be citizens of the same state, and the amount may be large or small. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

21. The judiciary act of 1789, § 11, requiring one of the parties, plaintiff or defendant, to be an inhabitant of the state where the suit is brought, does not apply to actions arising under the patent laws. *Ibid.*, 486.

22. It is only necessary to give jurisdiction in patent cases, that the process is served personally upon the defendant in the district where the suit is brought, as provided by the latter clause of § 11 of the act of 1789, above referred to. *Ibid.*, 486.

23. To confer jurisdiction, the return of the marshal upon the writ or subpœna should state that the service of such writ or subpœna was made within the district where suit was brought. *Ibid.*, 487.

24. Under § 17 of the act of 1836, the Circuit Courts of the United States have not only *original*, but also *exclusive* jurisdiction of all actions arising under the patent laws. *Dudley* v. *Mayhew*, 3 Coms., 14.—STRONG, J.; N. Y., 1849.

25. Although the jurisdiction of the Circuit Court embraces all cases, both at law and in equity, arising under the patent laws for infringements of letters patent, without regard to the citizenship of the parties or the amount in controversy, the provisions of § 11 of the judiciary act of 1789, as to the commencement of suits, applies to these cases as well as to others—and hence such a suit cannot be brought in any other district than that whereof the defendant is an inhabitant, or in which he shall be found at the time of serving the writ. *Day* v. *Newark I. R. Co.*, 1 Blatchf., 630, 631.—NELSON, J.; N. Y., 1850.

26. A corporate body created by the laws of one state has no corporate existence beyond the limits of the territory within which the law creating it can operate, and is not such a person as can be considered an inhabitant of any district so as to be served with process. *Ibid.*, 632.

27. Where, therefore, the defendants were a corporation created by the laws of New Jersey, but had a store in the city of New York, and a process of attachment under the laws of New York was commenced against and levied upon its property in New York, and the summons was also served upon the president of the company, who was casually in New York, *Held*, that the court had no jurisdiction of the action. *Ibid.*, 633, 634.

28. Under § 11 of the judiciary act, the Circuit Courts have no jurisdiction in suits instituted against foreign corporations, even in cases where the state practice, if adopted by them, would authorize the institution of such suits by attachment of their goods found within their jurisdiction. *Ibid.*, 634.

29. The acts of Congress adopting the state process, adopt the forms and modes of service only so far as the persons are rightfully within the reach of

such process, and do not intend to enlarge the sphere of the jurisdiction of the Circuit Courts. *Ibid.*, 630.

30. A citizen of the state of Connecticut brought suit in New York against a citizen of the state of New Jersey, for the violation of an agreement, the subject matter of which was a patent, and prayed an account. *Held*, that under § 11 of the judiciary act of 1789, the Circuit Court of the United States had no jurisdiction, as neither of the parties was a citizen of the state of New York, and that jurisdiction could not be sustained under the patent acts, as the action was not respecting a patent. *Goodyear* v. *Day*, 1 Blatchf., 566.—NELSON, J.; N. Y., 1850.

31. The purchaser of a patented article for the purpose of *using* it, exercises no rights created by the acts of Congress, nor does he derive title by virtue of the franchise or privilege granted to the patentee. When the machine passes to the hands of the purchaser, it is no longer under the protection of the acts of Congress, but becomes private property, protected by the laws of the state where it is situated. If the right to it is infringed, redress is to be sought in the courts of the state, according to the laws of the state, and not in the courts of the United States, nor under the laws of Congress. *Bloomer* v. *McQuewan*, 14 How., 549.—TANEY, Ch. J.; Sup. Ct., 1852.

32. Under § 17 of the act of 1836, the Circuit Courts have jurisdiction irrespective of the right of the plaintiff to an injunction, or a demand for one. *Nevins* v. *Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

33. Accordingly, where the plaintiff's patent had expired, and a bill in equity filed by him alleged an infringement of the patent, and prayed for a discovery and an account, but not for an injunction, *Held*, on a demurrer to the bill, that the court had jurisdiction. *Ibid.*, 83.

34. A process of attachment, whether direct or foreign, by which the property of the defendant is attached, by virtue of state laws, cannot give the Circuit Court jurisdiction over a person not an inhabitant of, and not found within the district. *Saddler* v. *Hudson*, 2 Curt., 7.—CURTIS, J.; Me., 1854.

35. The proper place to file a bill for an injunction, is the state where the defendant resides. An injunction will not issue out of a court in a state different from that where such defendant resides and carries on his business, on the ground that they would be beyond the process of the injunction, and the issuing of it would be inoperative and useless. *Goodyear* v. *Chaffee*, 3 Blatchf., 270.—NELSON, J.; N. Y., 1855.

36. The power of determining the validity of a patent, is *exclusively* confined to the Circuit Courts of the United States, and the state courts cannot entertain a suit for an infringement, or to declare a patent void. *Elmer* v. *Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855.

37. If a defendant is sued out of his district, he must plead his personal privilege. *Teese* v. *Phelps*, 1 McAllis., 17—McALLISTER, J.; Cal., 1855.

38. Where a person brought an action in a state court, to restrain the use of the word *ambrotype*, as applicable to photographic pictures, and claimed the exclusive right to use such word under an assignment of a patent for a process, in connection with which said word was claimed to have been invented, *Held*, as the right of the plaintiff to use such word depended upon his exclusive right to the process patented, that the exist-

ence and validity of such patent lay at the foundation of his claim, and that the action was therefore founded upon an exclusive right under a patent, of which, under § 17 of the act of 1836, the Circuit Courts of the United States alone had jurisdiction, and that a state court could not take cognizance of it. *Tomlinson* v. *Battel*, MS.—DUER, J.; N. Y., 1857.

39. Questions as to the validity and construction of patents belong to that class which the courts of the United States are alone competent to determine. The act of 1836, § 17, has put an end to any doubts that may formerly have existed on this subject. *Ibid.*

40. The jurisdiction of the Circuit Court is materially different, whether a party is seeking to enforce the specific performance of a contract in relation to a patent, or to prohibit the infringement of a patent belonging to him. *Brown* v. *Shannon*, 20 How., 56. —TANEY, Ch. J.; Sup. Ct., 1857.

41. Under § 11 of the judiciary act of 1789, jurisdiction of the person of a defendant (who is an inhabitant of another state), can only be obtained, in a civil action, by service of process on his person, within the district where the suit is instituted. *Chaffee* v. *Hayward*, 20 How., 215.—CATRON, J.; Sup. Ct., 1857.

42. And this provision is not changed by any of the process acts, or by the act of Congress conferring jurisdiction on the Circuit Courts in patent cases, without regard to citizenship. § 11 of the judiciary act is not affected by the subsequent process acts, and it applies to *all* civil suits. *Ibid.*, 216.

43. A suit brought to enforce the covenants of a license granted under a patent, is not a case arising under a law of the United States, so as to confer jurisdiction upon the Circuit Courts to take cognizance of it. *Judson & Goodyear* v. *Union Rubber Co.*, 4 Blatchf., 66.—INGERSOLL, J.; N. Y., 1857.

44. The non-performance of such covenants would be a violation of the rights of a patentee, as secured by the covenants, but not as secured by any law of the United States. *Ibid.*, 66

45. Nor is an action for fraud in the sale of a patent a case arising under such laws, so as to give jurisdiction thereof to the Circuit Courts. *Ib.*, 70.

46. Under § 17 of the act of 1836, the jurisdiction of the Circuit Courts in patent cases does not depend upon the citizenship of the parties before it. *Ibid.*

47. The Circuit Courts of the United States have equity jurisdiction under the patent laws, by direct grant from Congress; they do not however merely act as auxiliary to a court of law, and therefore do not require the patentee to establish his legal right in a court of law and by a verdict of a jury. *Sanders* v. *Logan*, 2 Fisher, 171.—GRIER, J.; Pa., 1861.

### 3. *District Courts U. S., under acts 1790 and 1793.*

1. The proceedings in a District Court, under § 10 of the act of 1793, upon the rule *nisi*, are not conclusive; and the process, to be awarded upon making the rule absolute, is not final. But the proceedings under such section are in the nature of a *Scire Facias* at the common law to repeal a patent. *Stearns* v. *Barrett*, 1 Mason, 164, 165. —STORY, J.; Mass., 1816.

2. From a judgment in such a pro-

ceeding by the District Court, a writ of error lies to the Circuit Court, if the amount in controversy exceeded fifty dollars. *Ibid.*, 166.

3. The judicial authority intended to be given by § 10 of the act of 1793, is vested exclusively in the district judge, and the proceeding under it was intended to be summary; and neither a *Scire Facias*, or process in the nature of a *Scire Facias*, according to the forms of the common law, were anticipated by Congress. The making of the rule absolute, if sufficient cause is not shown to the contrary, on the return of the rule to show cause, works a repeal of the patent without further proceedings. *Thompson* v. *Haight*, 1 U. S. Law Jour., 85; *McGaw* v. *Bryan*, *ibid.*, 98.—VAN NESS, J.; N. Y., 1822.

4. Under § 10 of the act of 1793, if the judge of the District Court grant a rule to show cause why process should not issue to repeal a patent, and such rule is made absolute, the making of such rule absolute does not *de facto* work a repeal of the patent; but the process to be issued upon making such rule absolute is in the nature of a *Scire Facias* to the patentee to show cause why the patent should not be repealed; and upon such process being returned, the judge is to proceed to try the cause upon the pleadings and the issue joined therein. *Wood & Brundage, Ex parte*, 9 Wheat., 604–615.—STORY, J.; Sup. Ct., 1824.

5. The jurisdiction given to the District Court under § 10 of the act of 1793 applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestions, by some wilful misrepresentation and deception. *Delano* v. *Scott*, Gilpin, 493.—HOPKINSON, J.; Pa., 1834.

6. The hearing, on the return of the rule to show cause, is only initial, and the order of the judge on such hearing cannot be that the patent is invalid, but only that process shall issue for a trial of its validity. It is on such trial that the question of validity is to be determined, and judgment of repeal, if the issue is decided against the patentee. *Ibid.*, 494.

7. A decision against a patentee will repeal and vacate his letters patent, but a decision in his favor gives no strength or confirmation to them, to prevent his right from being contested and tried in any suit he may bring for a violation *Ibid.*, 494.

8. The summary proceeding under § 10 is given to protect the public from manifest frauds, in taking out patents (the fees of office being no check) for known and common things. *Ibid.*, 494.

9. It gives the power to any person to call upon a patentee for an examination of his right, and have it repealed, if it shall be found that he is not entitled to it. *Ibid.*, 500.

10. In a proceeding under § 10 of the act of 1793, the court will not order the United States to be substituted as plaintiffs in the action of *Scire Facias* in the place of the petitioner. *Wood* v. *Williams*, Gilpin, 520–524.—HOPKINSON, J.; Pa., 1834.

### 4. *State Courts.*

1. The courts of a state have no jurisdiction of actions brought for the infringement of patents granted under the laws of the United States. Such cases are only cognizable in the Circuit Courts of the United States. *Parsons* v. *Barnard*, 7 John, 144.—CURIAM; N. Y., 1810.

2. The state courts have no jurisdiction to settle conflicting claims of parties under interfering patents granted by the United States. *Gibson* v. *Woodworth*, 8 Paige, 134.—WALWORTH, Ch.; N. Y., 1840.

3. Though the validity of patents when directly adjudicated upon is exclusively within the jurisdiction of the courts of the United States, yet when they come into question collaterally their validity must become a subject of inquiry in the state courts. *Rich* v. *Hotchkiss*, 16 Conn., 414.—WILLIAMS, Ch. J.; Ct., 1844.

4. Where an owner of an undivided interest in a patent filed a bill against the other joiut owner to compel the specific performance of a contract in respect to manufacturing under such patent, and the defendant among other things denied that he was manufacturing under the patent, and set up that the article manufactured by him was different from that patent, *Held*, that the question raised was one of infringement of a patent-right, of which a state court had no jurisdiction. *Parkhurst* v. *Kinsman*, 2 Halst., Ch., 600–609.—HALSTEAD, Chan.; N. J., 1847.

5. Consent of parties cannot confer jurisdiction, or render the judgment of a tribunal in a matter over which it has not by law any cognizance effectual. *Dudley* v. *Mayhew*, 3 Coms., 12.—STRONG, J.; N. Y., 1849.

6. Where therefore an action for an infringement of a patent was brought in a state court, and the defendant stipulated not to raise the question of jurisdiction, *Held*, that such consent could not confer any authority, and that the bill must be dismissed on the ground that the state courts had no jurisdiction of actions in patent cases. *Ibid.*, 10, 14.

7. The state courts have no jurisdiction of actions respecting patents. *Ibid.*, 14.

8. The purchaser of a patented article, for the purpose of *using* it, exercises no rights created by the acts of Congress, nor does he derive title by virtue of the franchise or privilege granted to the patentee. When the machine passes to the hands of the purchaser, it is no longer under the protection of the acts of Congress, but becomes private property, protected by the laws of the state where it is situated. If the right to it is infringed, redress is to be sought in the courts of the state, according to the laws of the state, and not in the courts of the United States, nor under the laws of Congress. *Bloomer* v. *McQuewan*, 14 How., 549.—TANEY, Ch. J.; Sup. Ct., 1852.

9. The power of determining the validity of a patent is *exclusively* confined to the Circuit Courts of the United States, and the state courts cannot entertain a suit for an infringement, or to declare a patent void. *Elmer* v. *Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855.

10. The state courts have jurisdiction in an action of covenant brought for breaches of covenants in an assignment of a patent. *Wright* v. *Wilson*, 11 Rich. Law, 152.—O'NEALL, J.; S. Car., 1857.

11. When a question as to the construction, and perhaps as to the validity of a patent arises, collaterally, in the progress and upon the trial of a cause, the necessity of its determination will not oust a state court of the jurisdiction which it may have derived from the nature of the action and the state of the pleadings. *Tomlinson* v. *Battel*, MS.—DUER, J.; N. Y., 1857.

12. But where the existence and

validity of a patent lie at the very foundation of the action, a state court cannot entertain jurisdiction. *Tomlinson* v. *Battel*, MS.—DUER, J.; N. Y., 1857.

13. Where a person brought an action in a state court to restrain the use of the word *ambrotype* as applicable to photographic pictures, and claimed the exclusive right to use such word under an assignment of a patent for a process, in connection with which said word was claimed to have been invented, *Held*, as the right of the plaintiff to use such word depended upon his exclusive right to the process patented, that the existence and validity of such patent lay at the foundation of his claim, and that the action was therefore founded upon an exclusive right under a patent, of which, under § 17 of the act of 1836, the Circuit Courts of the United States alone had jurisdiction, and that a state court could not take cognizance of it. *Ibid.*

14. The jurisdiction of a state court is not defeated because the subject matter of the action concerns the *use* of a patent-right, and the action does not necessarily involve any question in regard to the *validity* of the patent. *Sherman* v. *Champ. Trans. Co.*, 31 Verm., 174.—REDFIELD, J.; Vt., 1858.

### C. AUTHORITY OF DECISIONS OF, IN OTHER COURTS.

1. The rule of comity 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. Such decisions amount to authority, which although not conclusive, are operative, whenever the question should be carried up. *Washburn* v. *Gould*, 3 Story, 132, 133.—STORY, J.; Mass., 1844.

2. This rule established by the judges of the Supreme Court, applies to trials at common law before a jury, but 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 Fisher, 33.—SPRAGUE, J.; Mass., 1849.

## DAMAGES, IN PATENT CASES.

See also COUNSEL FEES.

1. In an action for a violation of a patent-right, the plaintiff may recover against one defendant, though no proof is given against the other; for all torts are joint as well as several, and a verdict may be had against one, though the other be acquitted; *aliter*, in contract. *Reutgen* v. *Kanouers*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

2. The mere making of a machine fit for use, and with a design to use it for profit, is an infringement; but if there is no user, or no actual damage proved, the law allows only nominal damage. *Whittemore* v. *Cutter*, 1 Gall., 431, 433, 483.—STORY, J.; Mass., 1813.

3. Only the *actual damages* sustained can be given. By *actual damages* are meant such damages as the plaintiffs can actually prove, and have *in fact* sustained, as contradistinguished to mere imaginary or exemplary damages, which in personal torts are sometimes given. *Ibid.*, 483.

4. In the case of the user of a ma-

chine, the rule of damages should be the value of the use of such a machine during the time of the illegal user. If a *making* of the machine and no *user* is proved, nominal damages should be awarded; but the value of the expense of making such a machine, or the price at which it might be sold, is not a rule for such damages. *Ibid.*, 483.

5. The rule of damages under § 3 of the act of 1800 is the amount of the profits actually received by the defendant, in consequence of his using the plaintiff's invention. *Lowell* v. *Lewis*, 1 Mas., 185.—STORY, J.; Mass., 1817.

6. When treble damages are allowed, the jury find single damages, and the court treble them in awarding judgment. *Ibid.*, 185.

7. Under the act of 1800, if the jury find for the plaintiff, they find the actual damages sustained by the plaintiff, by reason of the use by the defendants of the invention of the plaintiff's. The court will treble the damages. *Gray* v. *James*, Pet. C. C., 403.—WASHINGTON, J.; Pa., 1817; *Evans* v. *Hettick*, 3 Wash., 422.—WASHINGTON, J.; Pa., 1818.

8. Though a patented machine may be so far inferior to other machines of the same kind as to deprive it of all intrinsic value, if another superadds to it something which will remove its defects, it becomes valuable, and it seems that the person so rendering it valuable will be liable in damages for the use of it. *Gray* v. *James*, Pet. C. C., 480.—WASHINGTON, J.; Pa., 1817. [But see *post* 13, 14.]

9. The plaintiff is entitled to be compensated for the *damages he has sustained* by the infringement of his right. *Kneass* v. *Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820.

10. It is difficult to establish any general rule as to damages. The better course is not to lay down any particular rule of damages, but to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. *Parle* v. *Sawyer*, 4 Mas., 14.—STORY, J.; Mass., 1825.

11. The price of the machine, the nature, actual state, and extent of the use of the plaintiff'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. *Ibid.*, 14.

12. A considerable latitude is necessarily given to the jury in estimating what they shall consider to be the actual damage sustained by a patentee by the violation of his right, and the courts have shown no disposition to draw the power of the jury, in this respect, within close and narrow limits. The estimate of a jury must be very extravagant to enable the court to say that they have so disregarded the rule of the law, and so clearly exceeded the limits of their authority, that their verdict cannot be supported. *Whitney* v. *Emmett*, Bald., 325, 326.—HOPKINSON, J.; Pa., 1831.

13. If an invention, which is useless in itself, has been made useful by being combined with something else, or has been so changed in its operation by an invention to which the owner of the worthless machine had no title or claim, the patentee of such worthless machine is not entitled to damages for the use of it. *Ibid.*, 328.

14. A patentee is entitled to recover for the use of his invention only the damages he has actually sustained, and not the value that has been imparted to his invention by a subsequent inventor, nor for the use such inventor has made

of his invention, provided by such use he has not inflicted any loss, injury, or damage upon the patentee. *Ibid.*, 329.

15. A verdict, though giving large damages, if not against evidence, or not supported by the evidence, is not sufficient reason for granting a new trial. *Stanley* v. *Whipple*, 2 McLean, 40.—McLean, J.; Ohio, 1839.

16. Where the evidence sustains the verdict, the court cannot say that the jury should have given greater weight to other parts of the testimony, which would have lessened damages. *Ibid.*, 40.

17. The awarding by the jury greater damages than were anticipated, is not such a gross mistake in the jury as would authorize setting aside their verdict. The question of damages is submitted to their fair judgment. *Alden* v. *Dewey*, 1 Story, 341.—Story, J.; Mass., 1840.

18. In an action for an infringement of a patent, it is the duty of the jury, if they find for the plaintiff, to give him reasonable damages, such as are not covered by any of the costs he will recover, to indemnify him for the necessary and unavoidable expenses of establishing his right. *Washburn* v. *Gould*, 3 Story, 136.—Story, J.; Mass., 1844.

19. Where, however, a patentee fraudulently leads a party to infringe on his right, and then brings an action against him merely to gratify revenge or malice, only nominal damages should be given. *Ibid.*, 137.

20. But no valid patent should go out of court without the jury indemnifying the owner for his reasonable and necessary charges in establishing his right. *Ibid.*, 137.

21. In an action for an infringement of a patent, if the plaintiff establishes the validity of his patent, and that the defendants have violated it, he is entitled to such reasonable damages as shall vindicate his right, and reimburse him for all such expenditures as have been necessarily incurred by him beyond what the taxable costs will repay, in order to establish that right. *Pierson* v. *Eagle Screw Co.*, 3 Story, 410.—Story, J.; R. I., 1844.

22. The jury are at liberty, in the exercise of a sound discretion, to give a plaintiff such damages, not in their nature vindictive, as shall compensate him fully for all his actual losses and injuries occasioned by the violation of the patent by the defendants. *Ibid.*, 410.

23. Where persons, in the employ of another, were guilty of an infringement by making the thing patented, but such persons acted without a knowledge that it had been patented only nominal damages were given for such infringement. *Bryce* v. *Dorr*, 3 McLean, 583.—McLean, J.; Mich., 1845.

24. In cases of wanton and persevering encroachments on the rights of inventors, the court will be justified in trebling the damages, if required for the full indemnity and protection of any wronged patentee. *Allen* v. *Blunt*, 2 Wood. & Min., 147.—Woodbury, J.; Mass., 1846.

25. Damages, in a case submitted to the "fair judgment" of the jury, will not be deemed excessive, because they are more than a witness may have testified to, or slightly more than the court deem proper; the verdict will not be set aside, and a new trial ordered, unless the damages are very excessive and unreasonable. *Ibid.*, 149.

26. *Actual damages*, according to § 14 of the act of 1836, are the sum fixed by the verdict. *Stephens* v. *Felt*, 2 Blatchf., 38.—Betts, J.; N. Y., 1846.

27. A new trial will not be granted because the jury find liberal damages, except in a case of palpable extravagance. Where, in an action for an infringement, it was proved by the plaintiff that sales were highly profitable, and that the defendant had manufactured and sold the article in large quantities, and the defendant offered no proof, limiting the evidence of the plaintiff, or as to the cost or value of the article, *Held*, that the jury were warranted in exercising a liberal discretion, and that a verdict of $2,000 would not be interfered with. *Ibid.*, 38, 39.

28. In such a case, a plaintiff ought not to be held to the most explicit and exact proof of the amount of damages sustained, and the jury are warranted in exercising a liberal discretion. *Ibid.*, 39.

29. If a defendant prefers to leave the matter to general inference and the estimate of a jury, when he might make it reasonably certain by evidence on his part, the finding of the jury should not be interfered with, except in cases of palpable extravagance. *Ibid.*, 39.

30. Damages should be compensatory, not vindictive. The object is not punishment, but full indemnity. The amount of profit which the defendant has derived is one of the elements to be regarded, but the amount of loss and injury which the plaintiff has sustained should be regarded also. *Knight* v. *Gavit*, Mir. Pat. Off., 135.—KANE, J.; Pa., 1846.

31. If the machine made was never used, the damages should be merely nominal, as against the maker; if it has been sold by him and used by others, the verdict should be for the damages actually sustained by the plaintiff, without exclusive reference to the profitableness of the use by the wrong-doer, or the length of time such use may have continued. *Ibid.*, 135.

32. Damages must be plainly exorbitant, or what is sometimes called "outrageous," to require the interference of the court, by way of a new trial. *Aiken* v. *Bemis*, 3 Wood. & Min., 352.—WOODBURY, J.; Mass., 1847.

33. Under § 13 of the act of 1836, it rests in the discretion of the court, whether the damages shall be trebled. Under the act of 1800, the amount of recovery was fixed at three times the actual damages sustained. *Guyon* v. *Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

34. Where a plaintiff filed a disclaimer under § 7 of the act of 1837, after the commencement of his suit, *Held*, that though he was not entitled to costs against the defendant, by § 9 of the same act, that the court nevertheless, under § 14 of the act of 1836, had the power to increase the verdict, in the way of damages. *Ibid.*, 245, 246.

35. Actual damages for an infringement are, however, as a general rule, all that can be claimed. Where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement, the power to increase the verdict, under § 14 of the act of 1836, may be exercised. Each case must, however, stand upon its own circumstances. *Ibid.*, 246.

36. Previous to the act of 1836, the court were compelled to treble the damages. Since that act they are not compelled to do so, but may increase them or not at their discretion, within that limit. In the exercise of that discretion, the court will not increase them if, in their opinion, the jury have already exceeded their proper measure. *Stimp-*

*son* v. *The Railroads*, 1 Wall, Jr., 166.—GRIER, J., Pa., 1847.

37. The court will not grant a new trial on the ground of excessive damages, if the verdict was in accordance with the direction of the court. *Ibid.*, 166.

38. The term "actual damages" cannot be construed to mean exemplary, vindictive or punitory damages, inflicted by way of smart-money, or punishment of the defendant for fraudulent, malicious, or outrageous wrongs. *Ibid.*, 169.

39. The defendant is to suffer the infliction of treble damages only when the court are of the opinion he has acted unreasonably or oppressively. *Ibid.*, 170.

40. The standard for estimating damages for the infringement of a patented machine, is the actual *profits* from the making, using, or selling of the invention by the defendant. The reasonable cost of the labor and materials must be deducted, as the plaintiff himself, if he had made the machines, would have had to pay such expenses. *Parker* v. *Perkins*, MS.—GRIER, KANE, JJ.; Pa., 1848.

41. Where a patent has been infringed without a knowledge of the plaintiff's right, and under such circumstances as to warrant the inference that the defendant was not aware that he was violating the rights of any one, the jury should only give such damages as would compensate the injury done to the plaintiff. *Parker* v. *Corbin*, 4 McLean, 463.—McLEAN, J.; Ohio, 1848.

42. But where the circumstances of infringement are of an aggravated character, vindictive damages, which would include counsel fees, and something more by way of example to deter others from doing the same thing, may be given. *Ibid.*, 463.

43. The rule which governs on the question of damages is, to give actual damages—not vindictive or exemplary damages, but the actual loss sustained, which will be the ordinary profits the patentee derives from the sale of his invention. *Buck* v. *Hermance*, 1 Blatchf., 406.—NELSON, J.; N. Y., 1849.

44. Damages are only to be compensatory; the criterion is indemnity. The jury may take into consideration the loss sustained by the plaintiff, and likewise the profits made by the defendant. *Parker* v. *Hulme*, 7 West. Law Jour., 428.—KANE, J.; Pa., 1849.

45. The question of damages is exclusively with the jury, and if they are of the opinion that the defendant has unlawfully infringed the plaintiff's patent, they ought to award him such sum, as in their judgment, founded upon the evidence, would fully indemnify him for the actual damages he has suffered by reason of such infringement, beyond the taxable costs. *Foote* v. *Silsby*, 1 Blatchf., 459, 466.—CONKLING, NELSON, JJ.; N. Y., 1849.

46. Where the defendants entered upon the violation of the plaintiff's patent, after having been warned of the consequences, and went on with their eyes open, disregarding the claims of the patent, and showing a willingness to avail themselves of the profits of his discovery, and to deprive him of the fruits of his genius, time and expense, *Held*, that the defendants did not stand in a position to entitle themselves to a favorable consideration, and that the jury were warranted in giving liberal damages. *Ibid.*, 467.

47. The jury must find the issues as presented, and assess the damages for the breach, if any, of the thing alleged. It makes no difference that it is an im-

material issue. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1850.

48. In an action for making and selling a machine which is an infringement upon the plaintiff's patent, the plaintiff is entitled as damages, to all the actual profits which the defendant has made, which is the same thing with the damages he has sustained by reason of the use by the defendant; for the law presumes that if the defendant had not put his machines into the market, the demand would have been for the plaintiff, and he would have received the profits. *Wilbur* v. *Beecher*, 2 Blatchf., 143.—NELSON, J.; N. Y., 1850.

49. The difference between the cost and selling price is not, however, all profit. The interest on the capital, the risk of bad debts, and the expenses of selling, must all be taken into the account in arriving at the profits. *Ibid.*, 143.

50. 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., 607.—WOODBURY, J.; Sup. Ct., 1850.

51. The price paid for a license to use a thing patented, may be submitted to the jury as a suitable guide in estimating damages for an infringement, and is the customary one followed for making and selling patent stoves, spokes, lasts, &c., and seems once to have been treated by law as the chief guide in all patent cases. *Ibid.*, 607.

52. But that sum may be mitigated, if the maker of the machine was ignorant of the existence of the patent-right, and did not intend any infringement. *Ibid.*, 607.

53. That however furnishes no reason for allowing no damages when making the machine to be used, and not merely for a model, or for fancy, or philosophical illustration. *Ibid.*, 607.

54. The intent not to injure never exonerates from all damages for the actual injury or encroachment, though it may mitigate them. *Ibid.*, 608.

55. It must be a very extreme case where a judgment will be reversed on account of excessive damages in actions *ex delicto*, when the instructions of the court suggested to the jury the true general rule as to damages, and when, if excessive, a new trial could have been moved in the Circuit Court. *Ibid.*, 608.

56. The rule of law as to damages, when an infringement is made out, is to give to the plaintiff the actual loss which he has sustained, and nothing more. Exemplary or vindictive damages cannot be given. If the damages are insufficient, the court may treble them. *Held*, in this case, that the plaintiff was entitled to the profits on all the machines sold by the defendant. *Hall* v. *Wiles*, 2 Blatchf., 201.—NELSON, J.; N. Y., 1851.

57. The plaintiff in a patent case, when he has established a right to recover, is entitled to all the *actual* damages he has sustained, as contradistinguished from exemplary, vindictive, and punitive damages. These are not to be taken in consideration in a patent case. *Pitts* v. *Hall*, 2 Blatchf., 238.—NELSON, J.; N. Y., 1851.

58. One mode of arriving at such actual damages, is to ascertain the profits which the plaintiff derives from the machines which he manufactures and sells, and which have been made and sold by the defendant. *Ibid.*, 238.

59. Another mode is to ascertain the profits which the party infringing has derived from the use of the invention. This measure of damages is not, how-

ever, controlling; because a party infringing 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 in the process of invention and experiment. Hence the party infringing may well afford to sell at less profits than the patentee. *Ibid.*, 239.

60. The plaintiff is therefore entitled to recover such profits as he would have realized if he had not been interfered with. *Ibid.*, 239.

61. And the plaintiff is also entitled to recover interest on such damages, from the commencement of the suit. *Ibid.*, 239.

62. The general rule of damages is, that the plaintiff, if he has made out his right to recover, is entitled to the actual damages he has sustained by reason of the infringement, and those damages may be determined by ascertaining the profits which in judgment of law he would have made provided the defendant had not interfered with his rights. *McCormick* v. *Seymour*, 2 Blatchf., 256.—NELSON, J.; N. Y., June, 1851. [Overruled, 1853, *post* 76.]

63. This view proceeds upon the principle that if the defendant had not interfered with the patentee, all persons who bought the defendant's machine would necessarily have been obliged to go to the patentee and purchase his machine. *Ibid.*, 256. [Overruled, *post* 76.]

64. There is no distinction, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine. The rule which is to govern is the same, whether a patent covers an entire machine or an improvement on a machine. *Ibid.*, 257. [Overruled, *post* 77.]

65. And the plaintiff will also be entitled to interest on the actual damages as found by the jury, from the commencement of the suit. *Ibid.*, 259.

66. In an action for an infringement of a patent, the rule is to give the actual damage or loss incurred by reason of the infringement, and that is the profits which the plaintiffs would have made if they had not been embarrassed by the interference of the defendants; because the law presumes that the plaintiffs would have had the patronage diverted by the defendants. *Tatham* v. *Le Roy*, 2 Blatchf., 494.—NELSON, J.; N.Y., 1852.

67. The profits which the plaintiffs have lost in consequence of the infringement affords, therefore, a criterion by which to determine the amount of damages they have sustained. *Ibid.*, 494.

68. The jury, also, in estimating the damages, may take into account the interest on the damages, from the time sustained, if they choose, and give it by way of damages. *Ibid.*, 494.

69. In an action for an account of profits which had accrued to the defendant from the use of the machines which were an infringement upon the plaintiff's patent, the defendant is accountable for such profits as he has actually made, and not for such as "with due diligence and prudence" might have been made. *Livingston* v. *Woodworth*, 15 How., 559.—DANIEL, J.; Sup. Ct., 1853.

70. The patent act of 1790, § 4, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, § 5, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. The act of 1800, § 3, provided that an infringer should pay three times the actual damages sustained. *Seymour* v.

*McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

71. The patent act of 1836, § 14, confines the jury to the actual damages sustained by the patentee. The power to increase them, as punitive damages, is committed to the discretion and judgment of the court. *Ibid.*, 489.

72. There cannot be one rule of damages which will equally apply to all cases. The mode of ascertaining these actual damages must necessarily depend upon the peculiar nature of the monopoly granted. *Ibid.*, 489.

73. If a patentee considers or finds it for his interest to retain the entire monopoly of his invention, and competition would destroy its value, the profits of the infringer may be the only criterion of the actual damage of the patentee. *Ibid.*, 489.

74. Where an inventor has found it profitable to exercise his monopoly by selling licenses, he has himself fixed the average of his actual damage, and the price of such licenses may afford a proper measure of damages. *Ibid.*, 490.

75. It is only where from the peculiar circumstances of the case no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. *Ibid.*, 490.

76. *Actual* damages must be proved: what a patentee *would have made* if an infringer had not interfered with his rights, is a question of fact, not a judgment of law. It is not a legal inference that third persons would have bought of the patentee what they bought of an infringer, if the latter had not made and sold the thing patented. *Ibid.*, 490.

77. Nor is it proper to instruct the jury that as to the measure of damages the same rule is to govern, whether the patent covers an entire machine or an improvement on a machine. *Ibid.*, 491.

78. Where a patentee avails himself of his invention, by putting it into market and selling rights under it, in such cases the customary charge for the right to use the invention is the measure of damages which the patentee is entitled to recover, with interest upon the same from the time of the infringement. *McCormick* v. *Seymour*, 3 Blatchf., 224.—NELSON, J.; N. Y., 1854.

79. But if the patentee does not sell rights to others, but uses his invention exclusively himself, and furnishes the products to the community himself out of his own manufactory, in such cases the measure of damages is different. *Ibid.* 225.

80. If the patent is for an entire machine, the patentee is entitled, as damages in case of infringement, to the profits he could have made in constructing and vending his machine over and above the mere profits arising out of its manufacture. The profits that grow out of the exclusive right to manufacturing the invention under the patent belong to the patentee, while the mere mechanical profits are excluded from the damages. *Ibid.* 225.

81. If the invention is for an improvement of a machine, then the patentee is entitled, as a measure of damages, to all the advantages of the use of his patented improvement, excluding the profits of the manufacture, and excluding also the value, if any, of the use of the old machine. *Ibid.* 225.

82. The fact of the use of a patented machine is evidence of utility, and should subject the party using to damages. *Simpson* v. *Mad River R. R.*, 6 McLean, 604.—MCLEAN, J.; Ohio, 1855.

83. In an action of infringement, no plea being filed, and a default entered, one-fourth of the proceeds being estimated as the profits of the machine, the damages were assessed at that amount. *Parker* v. *Bamker*, 6 McLean, 632.—McLean, J.; Ohio, 1855.

84. In estimating the amount of damages, the jury cannot go beyond the sum mentioned in the declaration. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 323 (3d Ser.).—Nelson, J.; N. Y., 1855.

85. In estimating the actual damages the rule is to give the value of the use of the patented thing during the illegal user, or in other words, the amount of profits. *Wintermute* v. *Redington*, 1 Fisher, 251.—Wilson, J.; Ohio, 1856.

86. No fixed and certain rule for damages can be established applicable to all cases, but the statute has fixed the general rule that a patentee is entitled to recover such damages as he has shown by his proofs have actually been sustained in consequence of the use of his invention, without his license and consent. *Ransom* v. *Mayor, &c.*, 1 Fisher, 275.—Hall, J.; N. Y., 1856.

87. In an action against the city of New York for an infringement for the use of an invention in the improvement of fire-engines, *Held*, that the jury might take into consideration the benefits accruing to the corporation, as to damages—as if fifty engines with the improvement were equal to seventy-five without it—and infer that the corporation had saved the cost of the additional number, and would have paid the amount of such cost, or a large portion of it, as the consideration for a license to use the improvement, and that the plaintiff has lost by the infringement what the defendants would have so paid to secure such license. *Ibid.*, 275. [But see *post*, 107.]

88. The general rule is, that the patentee or his assignee in case of an infringement or appropriation of his invention by another without his license, is entitled to the actual damages he has sustained by reason of such infringement. *Smith* v. *Higgins*, 1 Fisher, 543.—Nelson, J.; N. Y., 1856.

89. The theory or principle in respect to damages is, that a third person who adopts, appropriates, or uses the improvement of another, interferes with his custom, his monopoly, or rather, property, and affects the benefits which he would otherwise be entitled to. *Ibid.*, 543.

90. The rule excludes any exaggerated or vindictive damages which are sometimes allowed in cases of wilful trespass. *Ibid.*, 543.

91. If the patentee has an established price in the market for a patent-right, or what is called a patent fee, that sum with the interest constitutes the measure of damages. If there is no such established price for a patent fee, then the jury are to inquire of the loss or injury he has sustained, and the profits which the infringer has made by the use of the invention may be taken as the measure of damages. *Sickles* v. *Borden*, 3 Blatchf., 543.—Nelson, J; N. Y., 1856.

92. If the jury adopt the price of the patent fee, as the measure of damages, it will operate to vest the title of its patent to the extent of its use by the defendant complained of throughout its term. *Ibid.*

93. If, however, they adopt the profits from the use as the measure of damages, the title does not pass. *Ibid.*, 545.

94. In an action for the infringement

of a patent, the rule of damages is the amount of profits received by the unlawful use of the thing patented, not what he might have made by reasonable diligence. The true rule of damages is that laid down in *Livingston* v. *Woodworth*. *Dean* v. *Mason*, 20 How., 203.—McLean, J.; Sup. Ct., 1857. [See *ante*, 69.]

95. But where the wrong has been done under aggravated circumstances, the court has the power, under the statute, to punish it adequately, by an increase of the damages. *Ibid.*, 203.

96. The rule of damages is the profits which have been derived to the defendants from the use of the plaintiff's machine, over any other mode which the defendants had a right to adopt. *Sorrell* v. *Collins*, 4 Blatchf.—Ingersoll, J.; N. Y., 1857.

97. No precise standard by which damages are to be measured is supplied by the law. The statute gives the patentee his actual damages, but these must be proved—they cannot be presumed. If he fails to give evidence to the point, the jury can award no other than nominal damages. *Smith* v. *Higgins*, MS.—Betts, J.; N. Y., 1857.

98. It is exceedingly difficult to give direct evidence of the real amount of damages. Facts, which imply damages, may be regarded as proof of damages, under the restriction that they do not warrant giving presumptive or speculative damages. There must be either positive proof of damages, or facts proved which import the amount proper to be awarded. *Ibid.*

99. The plaintiff is entitled to the actual damage sustained by the use of his improvement, during the term of the illegal user, or the amount of the profits actually received by the defendant, during the time he used the plaintiff's improvement. *Page* v. *Ferry*, 1 Fisher, 316.—Wilkins, J.; Mich., 1857.

100. As to the question of damages, the jury may take into consideration the difference between the cost of manufacturing the article, by the old process and by the new, and also the difference in the value of the articles manufactured. *Waterbury Brass Co.*, v. *N. Y. & B. Brass Co.*, 3 Fisher, 59.—Ingersoll, J.; N. Y., 1858.

101. The object of § 14 of the act of 1836 as to trebling damages, is to remunerate patentees who were compelled to sustain their patents against wanton and persistent infringers. *Bell* v. *McCullough*, 1 Fisher, 382.—Leavitt, J.; Ohio, 1858.

102. But the spirit of the act will not include suits brought upon an expired patent, where the sole object was the recovery of damages. *Ibid.*, 382.

103. When a patent has been violated, it necessarily follows that the plaintiff is entitled to some damages. When the amount of damages is not proved, the rule is that the jury give only nominal damages; if the plaintiff intends to claim more than nominal damages, he must satisfy the jury what his *actual* damages are. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 73.—Ingersoll, J.; N. Y., 1858.

104. There is no unbending or unyielding rule as to damages, but the rule generally recognized as the true one is to give as damages the amount of profits saved by the defendants, by the unlawful use of the plaintiff's invention. *Bell* v. *Daniels*, 1 Fisher, 379.—Leavitt, J.; Ohio, 1858.

105. Where a patent was for heating boilers with the waste heat of a blast furnace, *Held*, in the case of an infringe-

ment by the use of a machine which was the same in principle, that the rule of damages was the price of the coal saved by the use of the improvement. *Bell* v. *Phillips*, MS.—LEAVITT, J.; Ohio, 1858.

106. When ascertainable, the defendant's profits are the proper rule of damages. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

107. In an action for damages for an infringement of a patent, the plaintiffs must furnish evidence by which the jury may estimate actual damages. Actual damages must be *calculated*, not imagined, and an arithmetical calculation cannot be made without *certain* data on which to make it. If the plaintiff rest his case after merely proving an infringement, he is only entitled to nominal damages. *Mayor, &c., of New York*, v. *Ransom*, 23 How., 488.—GRIER, J.; Sup. Ct., 1859.

108. The theory or principle in respect to damages is, that a third person who adopts, appropriates, or uses the improvement of another, interferes with his property, and affects the benefits which he would otherwise be entitled to, and the jury are to look into the case with a view to ascertain the actual damage which the patentee under such circumstances has sustained. The rule excludes any exaggerated or vindictive damage, which is sometimes allowed in cases of wilful trespass. *Smith* v. *Higgins*, MS.—NELSON, J.; N. Y., 1859.

109. Where the injury done to a patentee by infringement of his patent is not in the use of his invention, but in making use of it without compensating the patentee therefor, it being the interest of the patentee that his invention should be used and adopted by all, the measure of "actual damage" is the price or value of a license to use it. *Sanders* v. *Logan*, 2 Fisher, 170.—GRIER, J.; Pa., 1861.

110. In such cases, the measure of damage being a certain sum, an account of profits is not required, and the jurisdiction of a chancellor need not be invoked. *Ibid.*, 170.

111. A court at law may treble a verdict for "actual damage" where the defendant has acted wantonly or vexatiously; but a court of equity can inflict no exemplary or punitive damages as a court of law may. *Ibid.*, 170.

112. If an inventor's profit consist neither in the exclusive use of the thing invented, or in the monopoly of making it for others to use, but in a general use by all who will pay the price of his license, the non-payment of the license fee by an infringer is the only wrong done him. He has fixed his own measure of compensation. *Livingston* v. *Jones*, 2 Fisher, 209.—GRIER, J.; Pa., 1861.

113. The only cases in which the measure of damages is the amount of the infringer's profit, are where the invention is of some new machine, or a new form of any kind of known machine, which, as itself—a distinct species of machine or manufacture—is more valuable, or can be put into market cheaper, so as to supersede or exclude other machines or manufactures of the same genus; and where the profit of the patentee consists in a complete monopoly of the right to make and vend the new machine or manufacture as a unit, and in the exclusion of all other competition. *Ibid.*, 209.

114. Where a patentee's invention has such peculiar characteristics, he has a right to demand that those who have infringed his exclusive right to make

and sell his peculiar invention should refund all the net profits made by such infringement. *Ibid.*, 211.

115. Although a patentee may describe his invention as an improvement of some known machine, yet if the machine constitute a distinct species of machine or scientific article known in the market and having a peculiar value on account of its peculiar form or functions, the measure of damages for infringing the patent is the amount of profit on the *whole* machine. The case of *Seymour* v. *McCormick*, 16 How., 480, distinguished from this. *Ib.*, 212.

116. But if the patent is for some addition or improvement on an old and well-known implement, or some separate part or device thereof of small importance compared with the whole—if the license to use the addition or improvement was sold as separate and distinct from the whole machine, the measure of damage would be the price of a license, and not the profit made by the exclusive right to make and sell the whole machine. *Ibid.*, 211.

117. The federal courts sitting in equity, cannot, under the act of July 4th, 1836, § 14, treble the damages found by them for violating a patent-right, as they may when sitting at law, and on a verdict and judgment. *Ibid.* 210.

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## DECLARATION.

As to declarations of parties and others, see EVIDENCE, D.

As to declaration in pleading, see PLEADING, A.

## DEFENCES IN ACTIONS AND SUITS RESPECTING PATENTS.

See also GENERAL ISSUE; PLEADING, B.; PRIOR USE.

1. § 6 of the act of 1793 does not enumerate all the defences of which the defendant may legally avail himself; he may give in evidence that he never did the act attributed to him, that the patentee is an alien not entitled under the act, or that he has a license or authority from the patentee. *Whittemore* v. *Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813.

2. The title of a patentee may be impeached by showing that he was not the first inventor, and this, whether the patentee was aware of such prior discovery or not. *Evans* v. *Eaton*, Pet. C. C., 342.—WASHINGTON, J.; Pa., 1816.

3. An offer to take a license of a patentee does not take away the right of the person making such offer to deny that the patentee was the original inventor. *Ibid.*, 347.

4. All matters of defence or of objection to a patent are not enumerated in §§ 6 and 10 of the act of 1793. *Lowell* v. *Lewis*, 1 Mas., 186.—STORY, J.; Mass., 1817.

5. But it is not a matter of defence that the invention of the patentee is not of such general utility as to supersede others of the same kind in use. *Ibid.*, 186.

6. It is a good defence to an action for the infringement of a patent-right that the thing secured by the patent was not originally discovered by the patentee, but had been in use, or had been described in some public work an-

terior to the supposed discovery of the patentee. *Bedford* v. *Hunt*, 1 Mas., 304.—STORY, J.; Mass., 1817.

7. It is perfectly immaterial whether the first inventor has taken out a patent or has dedicated the invention to the public or not; for the defendant may stand upon the defence that the plaintiff is not the first inventor who put the invention in use. *Ibid.*, 304.

8. Where two persons as joint inventors of a machine, covenanted with each other that each should have certain states, and that neither should use or sell the machine in the territories of the other, *Held*, in an action for covenant broken, that the defendant could not plead that neither was the inventor, or that separate patents had been granted to each. *Stearns* v. *Barrett*, 1 Pick., 443, 447.—WILDE, J.; Mass., 1823.

9. In an action for an infringement of a patent, where the declaration goes for a user during a limited period, and afterward the party sues for a user during another and subsequent period, a verdict and judgment in the former case is not a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. *Earle* v. *Sawyer*, 4 Mas., 14.—STORY, J.; Mass., 1825.

10. § 6 of the act of 1793 does not enumerate all the defences which a party may make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. *Pennock* v. *Dialogue*, 2 Pet., 23.—STORY, J.; Sup. Ct., 1829.

11. It is not inconsistent with the principle or meaning of such section, that a defence may be made, that although the patentee is the first as well as the true inventor, he has abandoned or dedicated his invention to the public. *Ibid.*, 23.

12. The distinction is well settled between defences, which authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement, and those which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. *Grant* v. *Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

13. If a party is content with defending himself, he may either plead specially or plead the general issue, and give the notice required by § 6 of the act of 1793, of any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defence is complete, and he is entitled to the verdict of the jury, and the judgment of the court. *Ibid.*, 246.

14. But if not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to § 6 of the act of 1793, and "fraudulent intent" must be found by the jury to justify a judgment of *vocatur* by the court; § 6 does not control § 3. *Ibid.*, 247.

15. The defendant is permitted to proceed according to § 6, but is not prohibited from proceeding in the usual manner, so far as respects his defence, except that special matter may not be given in evidence on the general issue, unaccompanied by the notice which § 6 requires. *Ibid.*, 247.

16. It is a good defence to an action for an infringement of a patent, that the

specification does not contain a written description of the invention in such full, clear, and exact terms as to distinguish the same from all things before known, and so as to enable any person skilled in the art to make and use the same. *Ibid.*, 245–248.

17. The case of *Pennock* v. *Dialogue* (2 Pet., 1), affirms the principle that the failure on the part of a patentee in those prerequisites of the act authorizing a patent, is a bar to a recovery in an action of infringement, and the validity of this defence does not depend on the intention of the inventor, but is a legal inference upon his conduct. *Ibid.*, 249.

18. § 6 of the act of 1793 declares the defences that shall be available for a party against whom a patentee has brought suit for the invasion of his right; but no process or means are given for the examination of a patent-right, however false and fraudulent it may be, if the patentee will forbear to bring suit against those using it. *Delano* v. *Scott*, Gilpin, 499.—HOPKINSON, J.; Pa., 1834.

19. In an action for an infringement of a patent, it is no defence that defendant's invention worked better, or was more elegant than the plaintiff's. It does not follow because the defendant has improved the plaintiff's invention, that he can use it. *Alden* v. *Dewey*, 1 Story, 337, 338.—STORY, J.; Mass., 1840.

20. It is a good defence to a bill in equity for an injunction on account of an alleged violation of a patent, that the inventor, before application for letters patent, had allowed his invention to go into public use; but such use must have been with the consent of the inventor, and have been generally allowed or acquiesced in, and not have been merely experimental or temporary. *Wyeth* v. *Stone*, 1 Story, 281.—STORY, J.; Mass., 1840.

21. It is also a good defence to such an action that the patentee, after obtaining a patent, has countenanced or silently acquiesced in the use of his invention by others, such conduct being strong presumption of an abandonment or surrender of his right. *Ibid.*, 282.

22. Under § 9 of the act of 1837, it is a good defence, both at law and in equity, in every suit brought upon a patent, that there has been an unreasonable neglect or delay to file a disclaimer when one is necessary. *Ibid.*, 295.

23. The defence, provided by § 15 of the act of 1836, "that the patentee was not the original and first inventor or discoverer of the thing patented," is complete without showing that the first inventor had put his invention in practice. *Hildreth* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

24. The use of the thing patented prior to the granting of a reissued patent, and during the interval between the original and renewed patent, will not defeat an action for an infringement under the reissued patent. *Stimpson* v. *West Ches. R. R.*, 4 How., 402.—McLEAN, J.; Sup. Ct., 1845.

25. A former verdict or dismissal, on a bill filed for an injunction to restrain the use of a patent, is not a bar to a subsequent suit, unless a judgment was rendered on such verdict against the plaintiff, or the dismissal was on the merits. *Allen* v. *Blunt*, 2 Wood. & Min., 132, 133.—WOODBURY, J.; Mass., 1846.

26. In an action for an infringement, a plea of prior use or sale, under § 7 of the act of 1839, to constitute a bar to the plaintiff's action, must allege such use to have been more than two years

before the application, or an abandonment, so as to show that the patent is invalid, by abandonment or otherwise. *Root* v. *Ball*, 4 McLean, 179.—McLean, J.; Ohio, 1846.

27. Where an action is on a promise to pay a certain sum for the assignment of a patent, and such assignment was the consideration of the promise, the validity of the patent may be impeached, as a want of consideration, in defence of the claim. *Wilder* v. *Adams*, 2 Wood. & Min., 331.—Woodbury, J.; Mass., 1846.

28. But such a defence cannot be resorted to when the action is on a sealed instrument, or when another implied covenant to the plaintiff was the real consideration, upon which implied covenant the defendant would have a remedy, or when the defendants have received the proceeds from the articles sold, to recover the agreed proportion of which the action is brought. *Ibid.*, 332.

29. The defence, authorized by § 15 of the act of 1836, that the patentee had "surreptitiously or unjustly obtained his patent for that which was in fact invented or discovered by another," is only applicable in the case of a patent so obtained while the "first inventor was using reasonable diligence in adapting and perfecting his invention;" and if pleaded, it may be necessary for the defendant to show, in order to vacate the patent, that he was using reasonable diligence when the patent was obtained. *Perry* v. *Cornell*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1847.

30. Under § 15 of the act of 1836, providing, in the case of a patent granted to an alien patentee, that it should be a good defence that such patentee had omitted to put and continue his invention on sale upon reasonable terms, within eighteen months after the patent was granted, it is not essential that such patentee should take active means for the purpose of putting his invention in market, and forcing a sale; but it is a sufficient compliance with the law that he should at all times be ready to sell at a fair price, when a reasonable offer is made. *Tatham* v. *Le Roy*, MS.—Nelson, J.; N. Y., 1849.

31. Where the defence is set up that a prior machine was essentially similar to that of the plaintiff, and the proof relied on is a description of such machine contained in a printed publication, such description must be sufficiently full and precise to enable a mechanic to construct it, and must be, in all material respects, like that covered by or described in the plaintiff's patent. Proof of a previous structure, bearing some resemblance, in some respects, to the plaintiff's improvements, and which might have been suggestive of ideas, or led to experiments in the discovery and completion of his improvement, will not invalidate the patent. *Parker* v. *Stiles*, 5 McLean, 61, 62.—Leavitt, J.; Ohio, 1849.

32. A party setting up a right under a contract for an interest in a future term of a patent, as an equitable defence against an action brought by one having the legal title, must deny that the plaintiff is a *bona fide* purchaser without notice, and the burden of proof is on him, so impeaching the legal title. *Gibson* v. *Cook*, 2 Blatchf., 150, 151.—Nelson, J.; N. Y., 1850.

33. It is a well established rule in equity, that the matter entitling a party to an amendment of his contract may be set up by way of equitable defence against a proceeding involving the rights of the parties under the instrument.

*Woodworth* v. *Cook*, 2 Blatchf., 158, 159.—NELSON, J.; N. Y., 1850.

34. But such defence cannot be set up where the rights of *bona fide* purchasers have intervened, which would or might be seriously prejudiced by allowing the contract to be so reformed. *Ibid.*, 159.

35. Where an action was brought in Louisiana under § 16 of the act of 1836, by the owners of a prior patent against a subsequent patentee, to set aside and have declared inoperative the subsequent patent, and on the hearing the bill was dismissed on its merits, *Held*, that the dismissal of the bill did not necessarily import that the two patents interfered, or that the prior patent was void and inoperative, and that such judgment could not be pleaded in bar to an action on such prior patent in another state against an assignee of an interest in a subsequent patent. *Tyler* v. *Hyde*, 2 Blatchf., 312.—BETTS, J.; N. Y., 1851.

36. To constitute such a judgment a bar to such subsequent action, it should have been direct and affirmative in its terms, and have asserted the interference of the patents, and have declared the patent void in whole or in part, or inoperative and invalid in some part of the United States. *Ibid.*, 313.

37. It is no justification of the infringement of a renewed patent that the infringer had stolen and used the invention with impunity before the patent was amended. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

38. § 7 of the act of 1839 gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Ibid.*

39. The granting of a new license by the owner of a patent to a second person to make and vend a patented article within a certain territory, after he had granted a prior and exclusive license to another person for the same territory, is no bar to an action brought on the first contract or license, to recover the amount agreed by it to be paid for machines manufactured under such contract, but may be available by way of recoupment of damages. *Pitts* v. *Jameson*, 15 Barb., 317.—JOHNSON, J.; N. Y., 1853.

40. In an action for an infringement, if a patent has been granted to the defendant for what he uses, he may put such patent in evidence in justification or defence of such action. *Corning* v. *Burden*, 15 How., 271.—GRIER, J.; Sup. Ct., 1853.

41. If to an action brought in the name of a patentee for the benefit of a licensee, a release from the patentee is set up, the plaintiff may file a replication setting up the license, the bringing of suit for the benefit of the licensee, notice to the defendants of such license and its recording prior to the release, want of power to give the release, and that it was given without the consent and authority of the licensee. *Goodyear* v. *McBurney*, 3 Blatchf., 33.—NELSON, J.; N. Y., 1853.

42. In an action for infringement on a reissued patent, proof of use of the thing patented during the interval between the original and reissued patents will not defeat the action. *Battin* v. *Taggert*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854.

43. The question of diligence, under § 15 of the act of 1836, has application to the case of a prior inventor by way of defence, where a subsequent inventor

DESIGN, WHAT IS, AND PATENT FOR.

has obtained a patent for the same invention surreptitiously, and directly only in such a case, or where it has appeared that analogous principles were involved, and then by an equitable construction of the rule. *Stephens* v. *Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

44. The things specified in § 6 of the act of 1836 are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of a patent may show that they have not been complied with, and in that mode defeat the action of the supposed inventor. *Ransom* v. *Mayor, &c.*, 1 Fisher, 257.—HALL, J.; N. Y., 1859.

45. It is no defence to an action for an infringement of a patent that the machine used by the defendant is a better mode than that invented by the plaintiff; nor does the use of such better mode form any objection to the validity of the plaintiff's patent. *Bell* v. *Daniels*, 1 Fisher, 379.—LEAVITT, J.; Ohio, 1858.

46. If an invention is useless as to the particular thing used by the defendants, they are not liable in damages for its use. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

47. The defence that an invention is wanting in novelty or originality goes to the validity of the patent. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

48. The defence that the patentee had surreptitiously and unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same, does not necessarily imply bad faith on the part of the patentee, against whose patent this defence is set up. The words were intended to be used, and are used in their broadest sense. *Phelps, Dodge & Co.* v. *Brown Bros.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

49. Where therefore A filed a caveat for an invention, and B subsequently filed an application for the same invention and obtained a patent therefor, the Commissioner neglecting to give notice of such application to the caveator, *Held*, that such defence could be set up against B's patent, though there was nothing in the case implicating his good faith. *Ibid.*, 364.

50. It is a good defence to an action for the infringement of a patent that the invention is worthless. *Vance* v. *Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

51. The United States are not precluded by the fact of granting a patent from giving in evidence, or availing themselves of any legal objections that may be brought against any such patent. *Shreeve* v. *U. States*, MS.—LORING, J.; Ct. Claims, 1859.

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## DEMURRER.

See EQUITY, B. 4; PLEADING, E.

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## DEPOSITIONS.

See EVIDENCE, C.

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## DESIGN.

### PATENT FOR, AND INFRINGEMENT OF.

1. The phrase "design," when used

as a term of art, means the giving of a visible form to the conceptions of the mind, or in other words to the invention. *Binns* v. *Woodruff*, 4 Wash., 52.—WASHINGTON, J.; Pa., 1821.

2. It is an infringement of a patent for a design to adopt the design so as to produce substantially the same appearance. It is not necessary to adopt the design in every particular. *Root* v. *Ball*, 4 McLean, 180, 181.—MCLEAN, J.; Ohio, 1846.

3. Where letters patent were issued under the act of 1842, for a "new and ornamental design for figured silk buttons"—the design consisting, 1st, of the configuration of the mould or block, it having radial indentations, and forming the foundation of the button, and capable of being varied in figure as desired; and 2d, of winding such block with silk, in the manner described, so as to make buttons of different hues and combinations of colors; and the claim was for "the radially formed ornaments on the face of the mould of the button, combined with the mode of winding the covering of the same, substantially as set forth," *Held*, that the invention was for "a new and original design for a manufacture," under § 1 of such act—a design for the manufacture of an ornamental button. *Booth* v. *Garelly*, 1 Blatchf., 248, 249.—NELSON, J.; N. Y., 1847.

4. *Held also*, that as the specification did not describe the *process* of winding the silk, that the patent did not cover or embrace such *process*, but was for the arrangement of the different colored threads in the process, so as to produce the radially formed ornaments on the face of the button. *Ibid.*, 249.

5. Whether the sale of such buttons, before the application for a patent, would amount to an abandonment, was held to be a question of fact to be settled by a jury. *Ibid.*, 249.

6. Whether the sale of the manufactured button, before application, amounts to a sale of "the thing invented," within the meaning of § 7 of the act of 1839; *query*. *Ibid.*, 250.

7. If the button be regarded simply as the product of the invention, the sale of it would not be a sale of the invention, for a sale within § 7, must be a sale of the invention or patented article. The "design," however, being worked on the face of the button, might perhaps be said to be sold with it, and a sale of the button would then be a sale of the "design," the thing patented. *Ibid.*, 250.

8. In this case, on a motion for a provisional injunction, the novelty of the invention being denied, and it being admitted that the plaintiff's had sold before his application for a patent, large quantities of the article, in packages marked as imported from Paris, the injunction was denied until the plaintiff should establish his right by a suit at law. *Ibid.*, 250.

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# DISCLAIMER.

**A.** WHEN PROPER; WHAT TO SET FORTH; EFFECT OF..... 247

**B.** EFFECT OF DELAY OR NEGLECT IN FILING..... 249

**C.** ASSIGNEE; RIGHT OF UNDER, AND TO MAKE..... 251

## A. WHEN PROPER; WHAT TO SET FORTH; EFFECT OF.

1. Where two patents are substantially for the same invention, whether a dis-

claimer of all title under the first patent to the material parts of the invention for which it was granted, would not operate as an estoppel to any remedy which might be prosecuted for a violation of that patent; *query*. *Treadwell* v. *Bladen*, 4 Wash, 709.—WASHINGTON, J.; Pa., 1827

2. A disclaimer at the close of a specification, estops the patentee from setting up any privilege to the part disclaimed. *Whitney* v. *Emmett*, Bald., 313.—BALDWIN, J.; Pa., 1831.

3. The disclaimer mentioned in § 7 of the act of 1837, applies solely to suits pending when the disclaimer is filed; and the disclaimer mentioned in § 9 of the same act, applies solely to suits brought after such disclaimer is filed. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

4. *Semble*, That a disclaimer, under § 7 of the act of 1837, should not only disclaim what is not claimed as new, but should also distinctly set forth what part of the invention is still claimed, as it is manifestly designed to act as a new specification. *Lippincott* v. *Kelly*, 1 West. Law Jour., 515.—IRWIN, J.; Pa., 1844.

5. Under § 7 of the act of 1837, the disclaimer must state the interest of the person disclaiming. But where an administrator, in whose name a patent had been extended, entered a disclaimer, stating that he was the patentee, and referring to the patent as showing his interest, it was held sufficient. *Brooks* v. *Bicknell*, 3 McLean, 439.—MCLEAN, J.; Ohio, 1844.

6. §§ 7 and 9 of the act of 1837, authorizing a disclaimer, do not apply where a patent is for a combination of parts. *Batten* v. *Clayton*, 2 Whar. Dig., 413.—KANE, J.; Pa., 1848.

7. A disclaimer must be properly proved before it can be admitted in evidence, either as an original paper or by a certified copy. And if admitted in evidence, it must have given to it the full effect of a disclaimer, under § 7 of the act of 1837. *Foote* v. *Silsby*, 1 Blatchf., 450, 461.—NELSON, CONKLIN, JJ.; N. Y., 1849.

8. Where, therefore, a copy of a disclaimer, indorsed on a patent, but not proved to have been executed by the patentee, was offered in evidence by the defendant, not as a disclaimer, but as a confession that the plaintiff's invention was not new, and that he was not the original inventor of all claimed in his specification, *Held*, that it must be proved, before it could be admitted in evidence; and must be read as a disclaimer, if at all. *Ibid.*, 450, 461.

9. Where a disclaimer was filed by the patentee himself, setting out that it was "to operate to the extent of the interest in said letters patent vested in the patentee," *Held*, that it fairly enough imported on its face that the patentee was the owner of the entire interest in the patent, and if so, there was a substantial compliance with the statute, as to the statement of interest. *Ibid.*, 449, 461. [Affirmed, *post* 12.]

10. A patentee has a right to disclaim any thing which has been claimed through "inadvertence or mistake;" but when a patentee claims any thing as his own, courts cannot reject the claim, though the inventor himself may disclaim it. *Parker* v. *Sears*, 1 Fisher, 99.—GRIER, J.; Pa., 1850.

11. But a disclaimer is necessary only where the thing claimed without right is a material and substantial part of the thing invented. If the part not new is not essential to the machine, and

was not introduced into the patent through wilful default or intent to defraud or mislead the public, the want of a disclaimer affords no ground for invalidating the patent. *Hall* v. *Wiles*, 2 Blatchf. 199.—NELSON, J.; N. Y., 1851.

12. Where, in a disclaimer, the party stated that he was the patentee, and nothing said in respect to a transfer of any part of it, the fair presumption is, that he still owns the whole; and it is a sufficient compliance with the statute as to stating his interest, to say "that such disclaimer is to operate to the extent of his interest therein." *Silsby* v. *Foote*, 14 How., 221.—CURTIS, J.; Sup. Ct., 1852.

13. The law requiring and permitting a patentee to disclaim is not penal but remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construction that would restrict its operation within narrower limits than the words of the law fairly import. *O'Reilly* v. *Morse*, 15 How., 121.—TANEY, Ch. J.; Sup. Ct., 1853.

14. Whether, therefore, a patent is illegal in part because of claiming more than the inventor has described, or more than he has invented, the patentee must in either case disclaim in order to save the portion to which he is entitled; and he is allowed to do this when the error was committed by mistake. *Ibid.*, 122.

15. The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patentee from embracing the part so disclaimed in a reissue of his patent. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

16. Inadvertence and error may occur as well in a disclaimer as in a claim, and whenever such a mistake occurs, it may be cured by a reissue. *Poppenheusen* v. *Falke*, 4 Blatchf., 499.—SHIPMAN, J.; N. Y., 1861.

## B. EFFECT OF DELAY OR NEGLECT IN FILING.

1. Under § 9 of the act of 1837, it is a good defence, both at law and in equity, in every suit brought upon a patent, to secure the rights granted thereby, that there has been unreasonable neglect or delay to file a disclaimer, where one is necessary. *Wyeth* v. *Stone*, 1 Story, 295.—STORY, J.; Mass., 1840.

2. *Semble*, that a court of equity will not interfere to grant a perpetual injunction, whatever may be the patentee's rights and remedy at law, unless the disclaimer, where one is necessary, is filed before suit brought. *Ibid.*, 295.

3. The disclaimer, to be effectual under §§ 7 and 9 of the act of 1837, must be filed before suit brought. If it is filed during the pendency of the suit, the plaintiff will not be entitled to the benefit thereof in that suit. *Reed* v. *Cutter*, 1 Story, 600.—STORY, J.; Mass., 1841.

4. If filed before suit is brought, the plaintiff will be entitled to recover costs, if he establish at the trial that a part of the invention, not disclaimed, has been infringed by the defendant. *Ibid.*, 600.

5. But whether filed before or after suit brought, the plaintiff will not be entitled to the benefit thereof, if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defence to the suit. *Ibid.*, 600.

6. An unreasonable neglect or delay

to enter a disclaimer, under § 9 of the act of 1837, cuts off the patentee from all the benefits of that section, not only that he shall not recover costs, but that he shall have no right of action. *Brooks* v. *Bicknell*, 3 McLean, 449.—McLean, J.; Ohio, 1844.

7. What is an unreasonable delay to enter a disclaimer, is a mixed question of law and fact, to be decided by the jury, under the instruction of the court. *Ibid.*, 449.

8. Less vigilance will be required from an administrator than from the original patentee. *Ibid.*, 450.

9. The filing of the disclaimer authorized by § 7 of the act of 1837, will not affect any action pending at the time of the filing of such disclaimer, except in respect to the question of unreasonable neglect or delay in filing it. *Guyon* v. *Serrell*, 1 Blatchf., 245.—Nelson, J.; N. Y., 1847.

10. But where a disclaimer was filed under such section, after the commencement of the action, *Held*, although under § 9 of the same act the plaintiff was not entitled to costs, yet, that under § 14 of the act of 1836, the court had power to increase the verdict. *Ibid.*, 245, 246.

11. Under § 9 of the act of 1837, the filing of a disclaimer by a patentee who has by mistake, &c., claimed something of which he was not the inventor, is not a condition precedent to obtaining the benefits of such act. He loses that only by an *unreasonable* delay in filing such disclaimer. *Hotchkiss* v. *Oliver*, 5 Denio, 318,—McKissock, J.; N. Y., 1848.

12. Where a patentee has unintentionally and without fraud claimed as a part of his invention something which was not original, but has unreasonably neglected to file a disclaimer of such part, he cannot recover under § 7 of the act of 1837, in an action for infringement, even if the defendant has infringed the parts of his invention which are new. *Parker* v. *Stiles*, 5 McLean, 56.—Leavitt, J.; Ohio, 1849.

13. If a disclaimer is entered before suit instituted, the plaintiff recovers costs in the usual way, independent of any question of disclaimer. But if in the progress of the trial it turns out that a disclaimer ought to have been made as to a part of what is claimed, the plaintiff may recover, but will not be entitled to costs. *Hall* v. *Wiles*, 2 Blatchf., 198.—Nelson, J.; N. Y., 1851.

14. Under § 9 of the act of 1837, the question whether there has been unreasonable negligence or delay in entering a disclaimer, goes to the right of the action; and if the delay shows great negligence, the jury may find the patent void. *Ibid.*, 198, 199.

15. Where a claim has been sanctioned by the Patent Office, and has been held valid by a Circuit Court, the patentee has a right to insist upon it, and not disclaim it, until it has been passed upon by the highest court, and the omission to disclaim will not render the patent void. The delay in entering the disclaimer, under such circumstances, until the decision of such highest court, is not unreasonable. *O'Reilly* v. *Morse*, 15 How., 122.—Taney, Ch. J.; Sup. Ct., 1853.

16. 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 for the residue, as good as if it had originally issued only for the claims which are valid. *McCormick* v. *Sey-*

*mour*, 3 Blatchf., 222.—NELSON, J.; N.Y., 1854.

17. If he omits to disclaim, and brings suit for the violation of his patent, and it appears at the trial that he is entitled to be protected in a portion of his claims, but not in respect to another portion, he is still entitled to damages for the violation of the valid portion of his claims, but he recovers no costs. *Ibid.*, 222.

18. But if the jury are satisfied that there has been unreasonable negligence and delay on the part of the patentee in making a disclaimer as respects the invalid part of his patent, then the whole patent is inoperative. *Ibid.* 222.

19. Where a patentee obtained his patent in 1845, and brought suit for an infringement of it, and there were numerous trials, the last of which was in 1854, upon which a question arose as to the true construction of one of the claims, whether the same was new, but such claim was not one of the issues in controversy, and such claim was held, on error, not to be new, *Held*, that under the circumstances of the case, the patentee was not guilty of unreasonable delay in making the disclaimer, and that such delay was a question of law for the court to decide. *Seymour* v. *McCormick*, 19 How., 106.—NELSON, J.; Sup. Ct., 1856.

20. The granting of a patent for an alleged improvement, and an opinion or decision of a court below maintaining the validity of such patent, will repel any inference of an unreasonable delay in correcting the claim for such improvement, which was in fact not new, by entering a disclaimer thereof, until the highest court to which it could be carried had pronounced its judgment. *Ibid.*, 106.

21. Under the circumstances, the question of unreasonable delay in filing a disclaimer was held to be one of law, for the court to decide. *Ibid.*, 106.

22. Under § 9 of the act of 1837, where a patentee claims more than he has invented or is entitled to, his patent will still be good for what he has invented, provided he enters a disclaimer of what he has included in his patent which he has not invented, without unreasonable neglect or delay. *Silsby* v. *Foote*, 20 How., 387.—NELSON, J.; Sup. Ct., 1857.

23. Where the evidence going to show that the invention was not new was introduced on the trial of a feigned issue in 1851, and the question of novelty had been in controversy from that time to 1857, and no disclaimer had been entered, *Held*, that under the circumstances, there had not been such an unreasonable delay in entering the disclaimer as to bar a recovery, and the plaintiff was allowed to recover damages but not costs. *Ibid.*, 387. (GRIER, J. and DANIEL, J., dissenting.)

24. What is "unreasonable delay" in filing a disclaimer is a question of law for the court. The time, in reference to the question of delay commences from the time when knowledge is brought home to the party that he is not the first inventor, or a court of competent jurisdiction has declared him not to be one. *Singer* v. *Walmsley*, 1 Fisher, 575.—GILES, J.; Md., 1859.

## C. ASSIGNEE, RIGHT OF UNDER, AND TO MAKE.

1. If a patent has been previously assigned in part, and a disclaimer has been filed by the patentee alone, such disclaimer will not operate in favor of the assignee, in any suit, either at law or

equity, unless he has joined in it. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

2. A disclaimer of part of an invention cannot affect a prior grantee under the patent, unless he accepts of it; he may refuse to be affected by it. *Smith* v. *Mercer*, 5 Penn. Law Jour., 531.—KANE, J.; Pa., 1846.

3. Under § 7 of the act of 1837, the owner of a sectional interest in a patent may make a disclaimer of part of the thing patented, which will be considered as a part of the original patent, to the extent of his interest; but the patentee is not compelled to join in such disclaimer, nor will it affect any one except him making it, and those claiming under him. *Potter* v. *Holland*, 4 Blatchf., 216.—NELSON, INGERSOLL, JJ.; Ct., 1858.

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## DICTIONARIES, GAZETTEERS, &c.

1. Some similarities, and some use of prior works, even to the copying of small parts, are tolerated in such books as dictionaries, gazetteers, grammars, maps, arithmetics, almanacs, concordances, cyclopædias, itineraries, guide books, and similar publications, if the main design and execution are in reality novel and improved, and not a mere cover for important piracies. *Webb* v. *Powers*, 2 Wood. & Min., 512.—WOODBURY, J.; Mass., 1847.

2. In compiling such works, the materials of all, to a considerable extent, must be the same, and to such extent are allowable; and the novelty or improvement can be substantial in scarcely any case, unless the matter is abridged, or a material change made in the arrangement, or more modern information added, or errors corrected, or omissions supplied. *Ibid.*, 513.

3. While a prior compiler cannot monopolize what was not original with himself, and what must be nearly identical in all such works, as dictionaries, gazetteers, &c., on a like subject, a subsequent compiler cannot employ so much of a prior arrangement and materials as to show a substantial invasion of the former, and not characterized by enough new or improved to indicate new toil and talent, and new property and rights in the last compiler. *Ibid.*, 514.

4. Thus a material addition is made to a common dictionary, which shall add definitions of a large number of words before omitted; or quotations from authors, who have employed words in the sense adopted; or rules for the proper pronunciation of each word; or the roots from which the word has been derived. *Ibid.*, 514.

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## DISCOVERY.

1. A discovery of some new principle, theory, elementary truth, or an improvement upon it, abstracted from its application, is not a new invention. *Whitney* v. *Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

2. But when such discovery is applied to any practical purpose, in the new construction, operation, or effects of machinery or composition of matter, producing a new substance; or an old one in a new way, by new machinery, or by a new combination of the parts of an old one operating in a peculiar, better, cheaper, or quicker method; a new mechanical employment of principle already known; the organization of a machine embodied and reduced to

practice on something visible, tangible, vendible, and capable of enjoyment; some new mode of practically employing human art and skill—it is a "discovery," "invention," or "improvement," within the acts of Congress. *Ibid.*, 311, 312.

3. If a patent is for a discovery, it must be for something new, not for an improvement only; each item must be a new invention, and the discovery must not fail in a material part. *Ibid.*, 314.

4. Under the constitution and laws of the United States respecting patents, *discovery* is synonymous with *invention*. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

5. 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; or, in other words, to an invention. *Ibid.*

6. The discovery of a new effect of that which existed before, is not the subject of a patent. *Ibid.*

7. The discovery of a fact which existed long before is a mere naked discovery, without any invention, for which a patent cannot be granted. There is no invention—nothing contrived or produced. *Ibid.*

8. He who has discovered some new element or property of matter may secure to himself the ownership of his discovery, so soon as he has been able to illustrate it practically and to demonstrate its value. His patent in such case will be commensurate with the principle which it announces to the world, and may be as broad as the mental conception itself. *Detmold* v. *Reeves*, 4 Amer. Law Jour., N. S., 185.—KANE, J.; Pa., 1851.

9. But the mental conception must have been embodied in some mechanical device or some process of art. The patent must be for a thing, not for an idea merely. *Ibid.*, 188.

10. A new process is usually the result of discovery; a machine of invention. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

11. One may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a labor-saving machine by which the operation or process may be performed, and each may be entitled to a patent. *Ibid.*, 267.

12. The discovery that a refuse or worthless material can be advantageously applied to a new purpose, if that result is owing to the presence in such refuse material of certain ingredients or substances which had before been used, but in a different way, for the same purpose, is not a patentable invention. *Maule, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

13. The mere discovery of a fact, as, in Sickles' invention, deriving power for the tripping of the valve from the eccentric strap, or from any other moving part of the engine not controlled by the lifting rod, does not constitute the subject of a patent, though the idea may be new. The new set of ideas, in order to become patentable, must be embodied into working machinery, and adapted to practical use. *Sickles* v. *Borden*, 3 Blatchf., 538.—NELSON, J.; N. Y., 1856.

14. It is this embodiment and operation of machinery for practical purposes which furnish beneficial results to the public, and render the discovery patentable. *Ibid.* 538

## DOUBLE USE.

See also NEW APPLICATION.

1. The meaning of the rule laid down in *Howe* v. *Abbott*, 2 Story, 194, and in *Winans* v. *Bos. & Prov. R. R.*, 2 Story, 416, that a new application is not entitled to protection, is, that the application of an old machine or old composition of matter, before patented, to a new object, or what is termed a double use, does not entitle one to a patent connected with the new object, because there is no new machinery, or new combination of old parts. *Hotchkiss* v. *Greenwood*, 11 How., 270.—WOODBURY, J.; (Dis. Opin.), Sup. Ct., 1850.

2. But it is entirely different if one apply an old earth, or old mechanical power, or old principle in physics, to a new object. There is then a new form adopted, or a new combination for the purpose—a new shape, consistency, and use given, or a new *modus operandi*, which, if cheaper and better, benefits the world and deserves protection. *Ibid.*, 270.

3. If these are the effects, however small the skill or ingenuity to initate them, they are not excluded from the aid of the laws. They are not mere double uses of a previous composition or machine, but a double or additional form or composition of an article for a new purpose. *Ibid.*, 270.

4. A mere analogous use is not patentable; but where a new or improved manufacture is produced, by new contrivances, combinations, or arrangements, a new principle may be constituted, and the application or practice of old things will be new also. *Smith, H. L., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. Where the change in a machine consists in the employment of an obvious substitute, the discovery and application of which could not have involved the exercise of the inventive faculty in any considerable degree, the change will be treated merely as an unsubstantial, colorable variation, or double use, and not patentable. *Everson & Ricard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

6. Though there may be in a new application some degree of novelty, something may have been discovered or found out that was not known before, yet unless the new occasion on which the principle is applied leads to some kind of new manufacture, or some new result, it will be but a double use. *Blandy, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

7. Where the principle of the alleged invention has been discovered and applied before, the application will be what is called a double use. *Ibid.*

8. Where there is nothing new in the principles involved in an invention, and nothing new in the form or character of the instrumentalities by which it is applied, the new application is but an analogous use, and is not the subject of a patent. *Allen, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

9. The application of substantially the same means to produce the same result, in a different form, as tubes and double walls in a grain bin, the same having been before used in cribs and kilns, is only a double use, and not patentable. *Marsh, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

10. The substitution of a jewel in place of glass in a sewing machine, to

prevent friction in the passage of the thread, is not patentable; it is but the double use of an old contrivance, with no new effect or result. *Berry, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D.C., 1860.

11. The making of an instrument of two different substances, as an hydrometer of india-rubber and silver—the bulb being of hard rubber and the graduated scale of silver or metal—if a useful result or effect is secured thereby, may be the subject of a patent, though such article may have before been made entirely of metal, and also of entirely hard rubber. Such an invention is not a double use. *Adams, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

12. The double use to which an article of manufacture is applied or applicable is not a ground for a patent. *Penders, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

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## DRAMATIC COMPOSITION.

1. There remains in an author, notwithstanding the copyright by statute, a common law title to his works, before publication. *Jones* v. *Thorne*, 1 N. Y. Leg. Obs., 409.—MCCOUN, V. Chan.; N. Y., 1843.

2. To carry off a manuscript, as a drama, with intent to perform the piece on the stage against the author's will, is an infringement of his common law rights. *Ibid.*, 409.

3. Acting or representing a play is not publication within the meaning of the copyright laws. *Roberts* v. *Myers*, 13 Mo. Law Rep., 397—SPRAGUE, J.; Mass., 1860.

4. The act of 1856 was passed to give to the authors of dramatic compositions the exclusive right of acting and representing, which they did not enjoy under the previous statutes. *Ibid.*, 397.

5. The previous acting or representing a play will not deprive the author of the right to afterward take out a copyright. *Ibid.*, 397.

6. Where a person employed by another as a performer and stage manager, agreed to write a play, which was to be performed in his, the employer's, theatre as long as it should continue to draw good audiences, *Held*, that the person writing the drama was the proper person to take out the copyright, and that the employer had no right or interest in it except the privilege of having it performed at his theatre. *Ibid.*, 400.

7. An assignee of the exclusive right of acting and representing a drama in certain places, may maintain an action in his own name, even after a representation by him, for an injunction to prevent its being represented by another within such places. *Ibid.*, 400, 401.

8. And such action may be maintained, although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 401. [Contra, *post* 14.]

9. A legislative enactment securing generally to literary proprietors a copyright for a limited period, but containing no special provision as to theatrical representation, does not, in the case of a dramatic literary composition, include the sole right of representing it. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

10. In the absence of any legislation for the special protection of dramatic literary property, an authorized public circulation of a printed copy of a drama, for which there is no legislative

copyright, is a publication which legalizes a subsequent theatrical representation by any body from such copy. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

11. § 9 of the act of 1831, giving redress for the unauthorized *printing or publishing* of *manuscripts*, operates in favor of a resident of the United States, who has acquired the proprietorship of an *unprinted* literary composition from a non-resident alien author. *Ibid.*, 45.

12. But this section—and which is the only one enabling a proprietor who derives his title from such an author to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

13. The only act which affords redress for unauthorized theatrical representations is the act of August 18, 1856; but this only applies to cases in which copyright is effectually secured under the act of 1831. *Ibid.*, 45.

14. The assignee of a dramatic composition cannot maintain an action for its unauthorized representation by others, unless he has performed all the acts required by law to secure a copyright, including the deposit of a printed copy. The observance and performance of *all* the statutory requirements except the deposit of a *printed* copy, will give no right of action under the statute. *Ibid.*, 45, 46.

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## DRAWINGS.

1. Drawings annexed and referred to in the specification, constitute a part thereof; and they may be resorted to to aid the description, and to distinguish the thing patented from other things known before. *Earle* v. *Sawyer*, 4 Mas. 9.—STORY, J.; Mass., 1825.

2. If the explanations of the specification call for the drawings, and refer to them as a component part in the description, they are just as much a part of the specification as if they were placed in the body of the specification *Ibid.*, 10.

3. Under the patent law of 1793, § 3 requiring drawings with *written references*, drawings when so annexed to the specification become part of the *written* description of the invention. *Ibid.*, 11.

4. The drawings may be referred to and used with the specification to make a machine, but the model cannot be referred to for such purpose. *Grant* v. *Mason*, 1 Law Int. & Rev., 23.—THOMSON, J.; N. Y., 1828.

5. The drawings of a patent may not only be referred to for the purpose of aiding a specification which would otherwise be imperfect, to support the patent, but may also be resorted to by the opposite party to explain any thing doubtful or ambiguous in the written description, or for the purpose of showing that the machine in question is not the same as that for which the patent was granted. *Burrall* v. *Jewett*, 2 Paige, 143.—WALWORTH, Chan.; N. Y., 1830.

6. References to the drawings, mentioned in § 6 of the act of 1836, are not requisite to the validity of a patent, unless they are necessary to an understanding of the invention. *Brooks* v. *Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843.

7. The description of a machine or improvement accompanied by a drawing, may in many cases be understood without references. *Ibid.*, 262.

8. It is not necessary that drawings should be referred to in the specification, and without such references they will be treated as a part of it, and may be referred to to show the nature, character, and extent of the claim, as well as to make a part of the description. *Washburn* v. *Gould*, 3 Story, 133, 138.—STORY, J.; Mass., 1844.

9. Drawings may also be referred to for the purpose of adding something to the specification or claim not specifically contained or mentioned therein—as to describe or show the existence of rollers in a machine, when they are not described in the specification. *Ibid.*, 139.

10. The drawing is a part of the patent, and may be referred to in order to help out the description. But it need not delineate old machinery connected with the new invention, when no change in such old machinery enters into the new invention. *Emerson* v. *Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

11. It is questionable whether under § 3 of the act of 1793, the *specification* must contain *written references* to the drawings. It is sufficient if the patentee puts on file with his specification drawings and written references, without their being mentioned in the specification, and if the references required are written on the drawings, the statute is satisfied. *Ibid.*, 9, 10.

12. Where a patent was obtained in 1834, the original of which and the drawings were destroyed by fire in 1836, and the patentee, under the act of 1837, in 1841 filed a copy of his patent and deposited a drawing, which, however, was not verified, but which he verified in February, 1844, and subsequently in March, 1844, considering such copy imperfect, filed another and a fuller drawing, and commenced suit in May, 1844, *Held*, that a certified copy of such second copy was properly received in evidence in such action. *Ibid.*, 11.

13. The drawing performs in part the office of a model, that may at any time be constructed for the purpose of illustrating and giving application to contrivances which may be obscure or difficult to understand, as described in the specification. *Ibid.*, 12.

14. When such drawings are put on file they become public records, and copies of them must be received in evidence. If they are discordant, one may destroy the effect of the other. But if they concur in essential particulars, they will conduce to prove the original one. *Ibid.*, 12.

15. The drawing forms a part of the specification of a patent, and is to be taken with it, in interpreting the patent. *Knight* v. *Gavit*, Mir. Pat. Off., 133.—KANE, J.; Pa., 1846.

16. Models and drawings are a part of the letters patent, and may be resorted to for clearer information respecting the invention described in the specification. *Hogg* v. *Emerson*, 6 How., 485.—WOODBURY, J.; Sup. Ct., 1847.

17. Drawings annexed to a patent issued under the act of 1837 form no part of the patent, where no drawing was annexed to the original patent. *Wilton* v. *R. Roads*, 2 Whart. Dig. 410.—KANE, J.; Pa., 1848.

18. The drawings, as well as the whole specifications, may be looked to for explanation of any thing obscure in the patent. And the drawings may be restored when burnt, and if appearing in some respects erroneous, may be corrected. *Hogg* v. *Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

19. Where a patent was granted in 1834, to which no drawing was attached, nor any reference made to any drawings, and afterward, on the 7th of June, 1837, such patent was recorded anew, under the provisions of § 1 of the act of 1837, which patent was also extended for seven years on the 25th of September, 1848, and on the 19th day of November, 1838, a drawing of the patentee's invention, accompanied by written references, was filed, with an affidavit of the patentee that such drawing was a true delineation of his invention, *Held*, in an action of infringement, that under § 3 of the act of 1837, a certified copy of such drawing was admissible in evidence in connection with the patent and specification, and that the whole together made *prima facie* evidence of the particulars of such invention. *Winans* v. *Schen. & Troy R. R.*, 2 Blatchf., 284, 298, 299.—NELSON, J.; N. Y., 1851.

20. But such a drawing, as a general rule, will not be effectual to correct any material defect in the specification, unless it should appear that it corresponded with drawings which accompanied the original application for a patent; if none was so filed, in case of discrepancy between the drawings and specifications, the latter must prevail. *Ibid.*, 299.

21. Nor will such a drawing have the same force or effect as if it had been referred to in the specification, or be deemed and taken as a part of it. *Ibid.*, 299.

22. Drawings, however, accompanying an original application for a patent, have the same force and effect as if they are referred to in the specification, and are to be deemed and taken as a part of it. *Ibid.*, 299.

23. The provision of § 6 of the act of 1837, requiring duplicate drawings, has reference, in point of time, to the issuing of the patent, and not to the filing of the petition for it. Duplicate drawings, need not, therefore, be filed at the time of the application; and such is the interpretation of the Patent Office. *French* v. *Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851.

24. The second set of drawings required by § 6 of the act of 1837, are unnecessary until the patent issues, and are not required by law to accompany the application when first made. *O'Reilly* v. *Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

25. Models and drawings are to be considered and taken together, in explanation of the specification of a patent. *Stephens* v. *Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

26. The drawings are a part of the specification. Where, therefore, the specification did not set out that the thing invented, as a part of a pair of shears, was cast with the handle of the shears, but there was a reference to the drawing which showed how such part was made, and that it was in fact cast with the handle, *Held*, that the drawings could be referred to to determine such fact. *Hiemrich* v. *Luther*, 6 McLean, 348.—MCLEAN, J.; Ohio, 1855.

27. Experts may be examined to explain, if necessary, models and drawings. *Winans* v. *N. Y. & E. R. R.*, 21 How., 101.—GRIER, J.; Sup. Ct., 1858.

28. In giving a construction to a patent, the drawings are to be regarded as part and parcel of it. *Judson* v. *Moore*, 1 Fisher, 549.—LEAVITT, J.; Ohio, 1860.

29. The drawings accompanying an application for a patent, may be signed

either by the inventor, or by any person he may authorize to sign them. *Anon.*, MS., Opin.—BLACK, Atty. Gen., 1859.

## EFFECT.

See also PRINCIPLE; PROCESS.

1. A patent can in no case be for an effect only, but for an effect produced in a given manner, or by a peculiar operation. No patent can be obtained for the admeasurement of time, or the expansive operations of steam; but only for a new mode or new application of machinery to produce these effects; and therefore if new effects are produced by an old machine in its unaltered state, no patent can be legally supported, for it is a patent for an effect only. *Whittemore* v. *Cutler*, 1 Gall., 480.—STORY, J.; Mass., 1813.

2. A patent for copper-plate printing on the back of bank-notes for the purpose of securing a particular end, viz.: security against counterfeiting, is not a patent for an *effect*, but for the kind of printing by which that effect is produced. *Kneass* v. *Schuylkill Bank*, 4 Wash., 12.—WASHINGTON, J.; Pa., 1820.

3. A discovery of a new effect of that which existed before is not the subject of a patent. *Kemper*, *Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

4. A mere effect from old means will not justify a patent. *Ibid.*

5. An end to be accomplished is not the subject of a patent; only the new and useful means to accomplish it. *Carver* v. *Hyde*, 16 Pet., 519.—TANEY, Ch. J.; Sup. Ct., 1842.

6. There cannot be a patent for a principle, nor for the application of a principle, nor for an effect. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

7. Two persons may use the same principle, and produce the same effect, *by different means*, without interference or infringement, and each would be entitled to a patent for his own invention. *Ibid.*

8. In determining whether an improvement is the subject of a patent, the jury have a right to take into consideration in connection with the change the result which has been produced; because the result, if greatly more beneficial, reflects back and tends to characterize in some degree the importance of the change. *Hall* v. *Wiles*, 2 Blatchf., 200.—NELSON, J.; N. Y., 1851.

9. 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 such new property. *Foote* v. *Silsby*, 2 Blatchf., 264.—NELSON, J.; N. Y., 1851.

10. Hence, the inventor has a 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. *Ibid.*, 264.

11. Where a change from a patented machine produces an effect, different in kind and highly beneficial, such effect reflects back upon the mechanical arrangement and construction, and may authorize an inference of a substantial change, which the arrangement, disconnected from the new and different effect, would not; and when, without

connecting the new effect with the change, the change might be only formal and unsubstantial. *T'tham* v. *Le Roy*, 2 Blatchf., 492.—NELSON, J.; N. Y., 1852.

12. Such new effect, however, to give materiality and importance to the apparently formal change, must not consist in doing more work in a given time, or with a reduced amount of power, but the new effect must be different in kind. *Ibid.*, 492.

13. The mere fact that a machine constructed and arranged apparently or externally like a previous one, produces a result more beneficial, does not determine that the two are substantially different. The new result must be one derived from a different mechanical operation and effect. *Ibid.*, 493.

14. 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, and would discourage arts and manufactures, and is against the policy of the patent laws. *Le Roy*, v. *Tatham*, 14 How., 175.—MCLEAN, J.; Sup. Ct., 1852.

15. Whoever discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it, provided he specifies the means used so fully and exactly that a skilful person can, by using the means specified, without addition or subtraction, produce the result described. *O'Reilly* v. *Morse*, 15 How., 119.—TANEY, Ch. J.; Sup. Ct., 1853.

16. But a patent cannot be for an effect produced distinct from the process or machinery necessary to produce it. *Ibid.*, 120.

17. It is for the discovery of some practical method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself. *Corning* v. *Burden*, 15 H., 268.—GRIER, J.; Sup. Ct., 1853.

18. A patent may be granted for the use of a known thing, in a known manner, to produce effects already known, but producing those effects so as to be more *economically* or *beneficially* enjoyed by the public. *Seeley*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

19. He who discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means is entitled to a patent for such discovery, provided he sets forth in his specification the means he uses to produce such useful result, so that any one skilled in the art, &c., can, by using the means specified, without any addition or subtraction from them, produce precisely the result he describes. If this cannot be done by the means he describes, the patent is void. *Amer. Pin Co.* v. *Oakville Pin Co.*, 3 A. L. R., 137; 3 Blatchf., 192.—INGERSOLL, J.; Ct., 1854.

20. And it makes no difference whether the effect is produced by chemical agency or combination, or by the application of discoveries or principles in natural philosophy, known or unknown, before his invention; or by machinery acting together upon mechanical principles. *Ibid.*, 137, 192.

21. But every one may lawfully accomplish the same end, and without infringing the patent, if he uses means substantially different from those described. *Ibid.*, 137, 192.

22. The patent does not secure to the

patentee the result or effect produced, only the means described, by which such result or effect is produced. All other means to produce the same effect, and not patented to any one, are open to the public. *Ibid.*, 138, 192.

23. If a patentee is the original inventor of a device to accomplish a particular result, he may claim an exclusive right to the use of it; but otherwise, if he is not such original inventor, but only of a combination of such device with others. *Carr* v. *Rice*, 4 Blatchf., 202.—NELSON, J.; N. Y., 1858.

24. If a new and useful result is produced, 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. *Teese* v. *Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

25. An end or result produced is not secured by the patent, but only the substantial means used and specified to produce the end or result; these, and nothing more. The same end or result may be produced by means other than those substantially described in the specification, without infringing the patent. *Burr* v. *Cowperthwaite*, 4 Blatchf., 167.—INGERSOLL, J.; Ct., 1858.

26. If the result of two machines is the same, and if the essential means to produce a like result are the same, or substantially the same, then the one is a violation of the other. If they are not the same there is no violation, for a defendant may lawfully produce the like result, if he uses means substantially different: results are not patented, but only means used to produce results. *Ibid.*, 170.

27. Where a result is a new and valuable article of manufacture, this will afford ground to presume invention. *Woodruff, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

28. A result or effect is not patentable, but where a result is in a greatly improved manufacture, or development of some new and useful principle, it may become the test of invention, and from which invention may be inferred, or where the result is substantially different from what has been effected before. *Treadwell* v. *Fox*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

29. A purpose is not patentable, yet if the arrangement or thing made effect a beneficial and new result, it is patentable. *Jacobs, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

30. A claim for an effect or function is not patentable. *Sickles* v. *The Falls Co.*, 4 Blatchf., 509.—NELSON, J.; Ct., 1861.

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## ENGRAVINGS.

See title "CHARTS."

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## EQUITY, JURISDICTION OF AND PLEADINGS IN.

**A.** AS TO COPYRIGHTS AND MANUSCRIPTS 262

**B.** AS TO PATENTS.

1. *General Jurisdiction*..... 263
2. *Original Bill; parties to; what to set forth; multifariousness of; amendment and dismissal of*.. 267
3. *Supplemental and Cross Bill; Bill of Discovery*..... 269
4. *Demurrer*..... 270
5. *Answer*..... 270

**C.** AS TO TRADE-MARKS..... 272

## A. As to Copyrights and Manuscripts.

See also Actions, A.; Dramatic Compositions; Injunctions, A.

1. At common law the rights of an assignee of a manuscript would be protected by a Court of Chancery. *Wheaton* v. *Peters*, 8 Pet., 661.—McLean, J.; Sup. Ct., 1834.

2. This is presumed to be the "copyright" recognized in § 1 of the act of 1790, and which was intended to be protected by its provisions, and this protection was given as well to books published under such circumstances, as to manuscript copies. *Ibid.*, 661.

3. Where a wrong has been committed in respect to a literary work, but the bill does not ask for an injunction to protect the common law rights of the author, or the violation of any copyright secured, but only asks an account, redress cannot be sought in a court of equity, but the party must proceed at law for damages. *Monk* v. *Harper*, 3 Edw. Ch., 110, 111.—McCoun, V. Ch., N. Y., 1837.

4. A Court of Chancery assumes jurisdiction to restrain the publication of private letters on no other principle and upon no broader ground than that of copyright in literary productions, or a property in the paper on which they are written, similar to property in stereotype or engraved plates. *Wetmore* v. *Scoville*, 3 Edw. Ch., 527.—McCoun. V. Ch.; N. Y., 1842.

5. It will not exercise the power of preventing the publication of private letters of business on the ground of copyright or literary property, when they possess none of the attributes of literary composition. *Ibid.*, 528.

6. On general equitable principles, relief may be given by a Court of Chancery against one who has surreptitiously gained possession of a manuscript. *Bartlett* v. *Crittenden*, 4 McLean, 301.—McLean, J.; Ohio, 1847.

7. A court of equity will not attempt to restrain the publication of private letters on the ground of protecting literary property, when they possess no attribute of literary composition. *Hoyt* v. *McKenzie*, 3 Barb. Ch.; 325.—Walworth, Chan.; N. Y., 1848.

8. In a suit under the copyright acts, the complainant must make out a title to sue under his copyright. The court cannot interfere to prevent the use of the title of a work in fraud of the plaintiff, upon principles relating to the good-will of trades. *Jollie* v. *Jaques*, 1 Blatchf., 627.—Nelson, J.; N. Y., 1850.

9. The act of February 15, 1819, so far as it gave cognizance to the courts of the United States in cases of copyrights, still remains in force, and is the only law conferring equitable jurisdiction on these courts in such cases; § 9 of the act of 1831 protects manuscripts only. *Stevens* v. *Gladding*, 17 How., 455.—Curtis, J.; Sup. Ct., 1854.

10. The equity jurisdiction of such courts, as to copyrights, does not extend to the adjudication of forfeitures; a decree therefore cannot be entered for the penalties incurred for the violation of a copyright. *Ibid.*, 455.

11. It is doubtful whether, under the act of 1831, as to copyrights, the courts of the United States can exercise jurisdiction, by way of injunction, to prevent the publication of private letters, contrary to the wishes of the writer. *Woolsey* v. *Judd*, 4 Duer, 382.—Duer, J.; N. Y., 1855.

12. A court of equity cannot inter-

fere to prevent the publication of private letters, on the ground that such a publication, without the consent of the writer, is a breach of confidence and honorable feeling, and is dangerous to the peace and morals of the community. *Ibid.*, 383, 384.

13. But the author has such an exclusive right in his manuscript at common law as entitles him to determine for himself whether it shall be published at all; and when this exclusive right is in danger of being violated, a court of equity is bound to prevent the wrong by injunction. *Ibid.*, 385, 393.

14. In equity, a limited local or other partial assignment of a copyright, if made for a valuable consideration, will be carried into effect, whether it would be effectual in law or not. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 47.—CADWALLADER, J.; Pa., 1860.

## B. As to Patents.

### 1. *General Jurisdiction.*

See also, FEIGNED ISSUE; INJUNCTION, B.

1. Under the act of 1800, jurisdiction was given to the Circuit Courts of the United States in patent cases, only "in actions on the case." By the judiciary act of 1789, such courts had no equity powers conferred on them, between citizens of the same state. *Livingston* v. *Van Ingen*, 1 Paine, 48, 52.—LIVINGSTON, J.; N. Y., 1811.

2. Where, therefore, a bill was filed for the infringement of a patent, and the parties were all residents of the same state, *Held*, that the court could not take cognizance of such a case, and that the bill must be dismissed. *Ibid.*, 52, 54.

3. But whether, under such acts, if it became necessary in an action at law to appeal to their equity side in aid or defence of such action, those courts would not have the necessary jurisdiction; *query*. *Ibid.*, 53.

4. The equity jurisdiction exercised by the courts over patents for inventions, is merely in aid of the common law, and in order to give more complete effect to the provisions of the statutes under which the patent is granted. *Sullivan* v. *Redfield*, 1 Paine, 446.—THOMPSON, J.; N. Y., 1825.

5. Whether the complainant's patent is good and valid, so as ultimately to secure to him the rights he claims, is not a question for decision upon the equity side of the court. But the equity jurisdiction should never be exercised but upon the supposition that the applicant for the aid of the court, has a right which has been infringed by the other party. *Ibid.*, 446, 447.

6. The fact that the subject matter of a contract sought to be enforced, is a patent-right, does not of itself give the courts of the United States jurisdiction. A bill filed for a specific performance of such a contract, must contain the proper averments to show that the court has jurisdiction. *Burr* v. *Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

7. If, in an assignment of a patent, the invention or improvement conveyed is misnamed, the deed is not a nullity, if it furnish sufficient means for correcting the mistake, and identifying the thing about which the parties intended to contract. The deed may be reformed in a court of equity. *Harmon* v. *Bird*, 22 Wend., 115.—BRONSON, J.; N. Y., 1839.

8. A court of equity will not inter-

fere in behalf of a patentee, either to grant an injunction, or give him any relief, in respect to an alleged violation of his patent, if after having obtained his patent, he has surrendered or dedicated it to the public, or acquiesced for a long period in the public use thereof, without objection—as his own conduct may be considered as having led to such use or application, or acts of the defendants. *Wyeth* v. *Stone*, 1 Story, 282, 284.—STORY, J.; Mass., 1840.

9. Under §§ 16 and 17 of the act of 1836, the Circuit Courts of the United States have exclusive cognizance of suits in equity, relative to interfering patents, in cases where the court is authorized to adjudge and declare a patent inoperative or void, either wholly or in part, or in any particular portion of the United States. *Gibson* v. *Woodworth*, 8 Paige, 134. WALWORTH, Chan., N. Y.; 1840.

10. Whether such courts have exclusive jurisdiction of every case in which a right under the patent laws might come in question collaterally; or in cases except where, from the nature of the relief, their jurisdiction must necessarily be exclusive; *query*. *Ibid.*, 134.

11. In an action at law, for a breach of a patent, it is indispensable to establish a breach before suit brought. But in equity, 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, 752.—STORY, J.; Mass., 1845.

12. The Circuit Courts have no jurisdiction of an action, as to enforce the specific execution of a contract respecting a patent, where the parties are all citizens of the same state; but where the plaintiffs set up a right under a patent and allege that the defendants are infringing, citizenship will not oust jurisdiction. *Brooks* v. *Stolley*, 3 McLean, 525. —MCLEAN, J.; Ohio, 1845.

13. But where the court has obtained jurisdiction on the ground of infringement, it may then decide other matters, which, of themselves, would not afford ground for the original exercise of jurisdiction. *Ibid.*, 529.

14. Under § 17 of the act of 1836, the jurisdiction, as to subject matter, of the Circuit Courts does not extend to a bill in equity, filed for the specific performance of a contract to transfer a patent—the jurisdiction of such courts being confined to actions under the patent *laws* granting or confirming rights to inventors. *Nesmith* v. *Calvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845.

15. If such a bill is filed against several defendants, some of whom are residents of the same state with the complainants, the bill may still be maintained against the defendants who are residents of another state. *Ibid.*, 37.

16. And if such bill contain a prayer for an injunction against the use of the patent by all, this would be ground, it seems, of jurisdiction over all the defendants as to subject matter. *Ibid.*, 38.

17. Proceedings by bill in equity, under § 16 of the act of 1836, and § 10 of the act of 1839, against the Commissioner of Patents, to compel him to issue a patent, must be commenced in the Circuit Court of the United States for the District of Columbia, and cannot be brought elsewhere. No tribunal out of the district has jurisdiction

over the person of the Commissioner of Patents, as such, and the Patent Office. *Prentiss* v. *Ellsworth*, Mir. Pat. Off., 36.—RANDALL, J.; Pa., 1846.

18. The jurisdiction conferred upon the Circuit Courts, in patent cases, by § 4 of the act of 1836, is the same, in its nature and extent, as the equity jurisdiction in England, from which it is derived. On an injunction bill filed by a patentee, where there is no dispute as to title, the bill having been taken as confessed, such courts have the power to refer the case to a master to take and state an account of the profits made by the defendant by the use of the plaintiff's invention, instead of sending it to a court at law to assess the damages. *Allen* v. *Blunt*, 1 Blatchf., 486, 487.—NELSON, J.; N. Y., 1849.

19. Where it is evident that the legal effect of a contract, as to a patent, according to the terms of it, is different from the actual agreement made at the time, between the parties, a court of equity would probably, upon a proper application, direct the contract to be reformed by the insertion of a clause to the effect claimed. *Woodworth* v. *Cook*, 2 Blatchf., 158.—NELSON, J.; N. Y., 1850.

20. It is a well established rule in equity, that the matter entitling a party to an amendment of his contract, may be set up by way of equitable defence against a proceeding, as to enforce a specific performance, involving the rights of the parties under the instrument, and which would not have been maintainable had the agreement been as was intended. *Ibid.*, 158, 159.

21. But such contract cannot be reformed where rights of a *bona fide* purchaser have intervened, which would or might be seriously prejudiced by allowing such contract to be reformed, or defence set up. *Ibid.*, 159.

22. A suit in equity to obtain an injunction to restrain proceedings in an action at law, will not be sustained when the allegations set up a defence, as fraud, which is a proper case for the consideration of a jury, and when the facts charged are met and denied by the defendant, such denial being sufficient to prevent the issuing of an injunction. *Day* v. *Goodyear*, MS.—GRIER, J.; N. J., 1850.

23. If from the number and character of the assignments and reassignments of a patent, it may be doubtful whether an action at law can be brought so as to obtain relief for an injury complained of, it will afford ground for the exercise of an equity jurisdiction. *Bicknell* v. *Todd*, 5 McLean, 240.—MCLEAN, J.; Ohio, 1851.

24. Upon a bill filed to declare a patent granted by the Commissioner invalid or inoperative, under § 16 of the act of 1836, amended by § 10 of the act of 1839, the hearing is altogether independent of that before the Commissioner, and takes place upon such testimony as the parties may see fit to produce, agreeably to the rules and practice of a court of equity. *Atkinson* v. *Boardman*, MS.—NELSON, J.; N. Y., 1851.

25. The evidence before the Commissioner is not evidence in such a suit, except by consent of parties; nor are the parties to the suit restricted to the testimony used before the Commissioner. Either party is at liberty to introduce additional evidence. *Ibid.*

26. A court of equity will not, in a decree intended to put an end to litigation as to patent interests, attempt to undo what has been done, and set aside what has already been adjudicated between

the parties. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

27. The patent act of 1836, § 17, confers jurisdiction in equity upon the Circuit Courts irrespective of the right of the plaintiff to an injunction, or of his demand for one. *Nevins* v. *Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

28. Accordingly, where the plaintiff's patent had expired, and a bill in equity filed by him alleged an infringement of the patent before it expired, and prayed for a discovery and an account, but not for an injunction, *Held*, on a demurrer to the bill, that the court had jurisdiction. *Ibid*, 83.

29. A court of equity will not proceed against the principles and sureties of an injunction-bond to enforce payment of the damages sustained by reason of the injunction. The defendant must resort to an action at law on the bond. *Merryfield* v. *Jones*, 2 Curt., 306.—CURTIS, J.; Mass., 1855.

30. A mutual and reciprocal covenant of an agreement respecting a patent, having been broken by one party, he cannot obtain the aid of a court of equity to restrain the other covenanter from its violation. *Clum* v. *Brewer*, 11 Mo. Law. Rep., 391.—CURTIS, J.; Mass., 1856.

31. Otherwise, where the covenants are independent, or only collaterally connected, though in the same instrument; or where the breach is of such a nature that it may be fully repaired, and one of the conditions precedent for obtaining relief may be such reparation. *Ibid.*, 392.

32. Where the covenant was, by the owners of a patent, that no right to use the invention should be conveyed without the assent and concurrence of all those interested, *Held*, that a party who had been guilty of a breach thereof, though through a misapprehension of the construction of the agreement, cannot maintain a bill for an injunction to restrain the other covenanter from a similar violation. *Ibid.*, 392.

33. The Circuit Courts of the United States, having jurisdiction in equity of controversies arising under the United States patent laws, do not act as ancillary to a court of law, and therefore do not require the patentee first to establish his legal right in a court of law, and by the verdict of a jury. *Sanders* v. *Logan*, 2 Fisher, 171.—GRIER, J.; Pa., 1861.

34. A court of law may treble a verdict for "actual damage" in a patent suit, where the defendant has acted wantonly or vexatiously, but a court of equity can inflict no exemplary or punitive damages as a court of law may. *Ibid.*, 170.

35. A patentee whose invention is only valuable because used by all who pay a license fee, and who suffers no other wrong than the detention of such fee, needs none of the remedies which it is the duty of the chancellor to give for such protection. *Livingston* v. *Jones*, 2 Fisher, 210.—GRIER, J.; Pa., 1861.

36. A court of law is his proper resort; the only remedy to which he is entitled being a judgment for a given sum of money, with interest; and there he may recover a penalty to the extent of treble damages, if the judge sees fit to inflict it. Penalties and punitive damages can be recovered only in courts of law. *Ibid.*, 210.

37. Although the statute gives original cognizance of patent controversies, equally to courts of equity as to courts

of law, all distinction as to the remedies granted by each tribunal is not abolished; each court will give the remedy peculiar to its own functions. The remedies of a Court of Chancery are by injunction and account, and a court of equity cannot take jurisdiction to enforce a penalty, or merely punitive damages. A court of law cannot issue an injunction, but enforce penalties and punitive damages. *Ibid.*, 210.

2. *Original Bill; parties to; what to set forth; multifariousness of; amendment and dismissal of.*

1. A bill filed for an injunction should set forth that, after the issuing of the patent, the complainant had put his invention into use, or had sold the same for a valuable consideration, and is, at at the time of the filing of the bill, in the exclusive possession of such patent. *Isaacs* v. *Cooper*, 4 Wash., 260, 261.—WASHINGTON, J.; Pa., 1821.

2. A bill for an injunction should be verified by the oath of the party filing it, as to the truth of the allegations contained in it, and that the patentee was, to the best of his knowledge, the true and first inventor of the thing patented, and that the same had not, to his knowledge and belief, been in use or been described before his invention or discovery thereof. *Rogers* v. *Abbot*, 4 Wash., 514.—WASHINGTON, J.; Pa., 1825.

3. Whether an assignee of part of a patent, circumscribed as to the interest by local limits, can, in his own name, or with the patentee, maintain a suit at law or not, there can exist no doubt but that he may support a suit in equity to enjoin third persons from infringing the patent, and for an account. *Ogle* v. *Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

4. A bill filed for the specific performance of a contract respecting a patent-right must contain the proper averments to give jurisdiction to the court, by reason of the *character* of the parties. The fact of the subject matter of the contract being a patent does not give the Circuit Courts jurisdiction. *Burr* v *Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

5. An assignee of a part interest which is exclusive in a patent, may, at law or in equity, maintain a suit for infringement, without joining the patentee. So held, in fact, the bill being filed by the assignee alone. *Brooks* v. *Bicknell*, 3 McLean, 250.—MCLEAN, J.; Ohio, 1843.

6. An assignor who retains an interest in a patent, may be joined as a party complainant with an assignee of the exclusive interest in a certain territory in which such assignor has no interest, in a bill for an injunction to restrain the violation of the patent in that territory. *Woodworth* v. *Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

7. It is not necessary that the bill should allege or specifically describe all the evidence which is to be put in in the case; but the bill must contain allegations broad enough to cover any evidence, before it becomes admissible. *Nesmith* v. *Calvert*, 1 Wood. & Min., 44.—WOODBURY, J.; Mass., 1845.

8. A person interested in a patent but not *within* the particular district where the suit is brought, may be made a party complainant in a bill to restrain an infringement *within* such district, as he is interested in protecting himself against an infringement out of that dis-

trict. *Buck* v *Cobb*, 9 Law Rep., O. S., 347.—CONKLING, J.; N. Y., 1846.

9. Whether in a bill praying for an injunction, a misjoinder of parties as plaintiffs would defeat the prayer for an injunction to use a machine in which any of them are interested. *Woodworth* v. *Hall*, 1 Wood. & Min., 258.—WOODBURY, J.; Mass., 1846.

10. An assignee of an invention by virtue of an assignment made before patent issued, may file a bill in his own name, under § 10 of the act of 1839, amending § 16 of the act of 1836, against a patentee to whom a patent issued, upon the interfering applications of his assignor and such patentee, for the purpose of annulling the patent issued, and having one granted to him as assignee. *Gay* v. *Cornell*, 1 Blatchf., 507, 509.—NELSON, J.; N. Y., 1849.

11. And such assignment need not be recorded before suit brought; it will be sufficient if it is recorded before patent issued. *Ibid.*, 500.

12. An objection to the joinder of an assignor with an assignee, as complainants in a bill, cannot be taken on appeal, it being then too late. It should have been taken by demurrer, before the hearing on the merits. *Livingston* v. *Woodworth*, 15 How., 557.—DANIEL, J.; Sup. Ct., 1853.

13. G. filed his bill against B. for an infringement of a patent, and an injunction was granted thereon. G. afterward moved to amend by adding other parties plaintiff, averring that under an agreement made between himself and such parties, and still in force, they became the owners of an exclusive interest in the patent which B. had infringed, and that B. was aware of their interest in the patent; *Held*, that such amendments could not be allowed, as they would amount to the institution of a new suit, both as to plaintiffs and the right of action, and that that exceeded the power of amendment. *Goodyear* v. *Bourne*, 3 Blatchf., 268.—NELSON, J.; N. Y., 1855.

14. A motion to dismiss the bill of the complainants, filed for an injunction, on the ground that the defendants had parted with all their interest in the suit, will be denied if such assignment has been made after the time when a computation of profits ended. *Dean* v. *Mason*, 20 How., 204.—MCLEAN, J.; Sup. Ct., 1857.

15. A bill is not multifarious because it embraces more than one patent, which it is alleged the defendant infringes; at least, such will not be the case if the defendant's machines infringe all the patents, or contain the improvements embraced in the several patents alleged to be infringed. *Nourse* v. *Allen*, 4 Blatchf., 377.—NELSON, J.; N. Y., 1858.

16. A bill was filed to restrain the infringement of four separate patents, and was demurred to on the ground that the matters set up were distinct and separate and compelled the defendant to unite separate and distinct matters of defence; *Held*, that although the objection to the bill on the ground of multifariousness, in a general sense, might be well founded, yet as all the patents were charged to be infringed by the defendants, they were to that extent connected together, and that the convenience of parties, as well as the saving of expense in the litigation, justified the embracing of all the patents in one suit. *Ibid.*, 377.

17. *Query*, Whether several patents could be embraced in one suit, if the improvement described in one patent had been used in one machine, and as

improvement described in another patent had been used in a different machine. *Ibid.*, 378.

18. It is not necessary that the bill should set forth the deduction of title in the complainant. A simple averment that the title to the patents is in the complainant is sufficient. *Ibid.*, 378.

19. 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 for an infringement, and asking an injunction and an account, the person having the legal title, and the one having the equitable right, should join as complainants. *Stimpson* v. *Rogers*, 4 Blatchf., 337.—INGERSOLL, J.; Ct., 1859.

20. Where an inventor died before application for a patent, and devised his property to A and B, and afterward his executor applied for and obtained a patent for an invention of the devisor, and then sold the patent to C, who afterward sold it again to A, *Held*, in a bill filed against D for an infringement and an account, that B should be made a party complainant with A, as having an equitable title and interest under the will. *Ibid.*, 337.

21. A party who relies upon the verdict of a jury and the judgment of a court of law for the establishment of his title, as a foundation of his claim, to be quieted in the possession and enjoyment of it, and for protecting him against infringement by others, must aver in his bill that such proceedings have taken place. *Parker* v. *Brant*, 1 Fisher, 39.—GRIER, J.; Pa., 1850.

### 3. *Supplemental and Cross Bill; Bill of Discovery.*

1. Where an injunction has been granted on an original patent, and during its existence the patent is surrendered and a new one issued, a supplemental bill, founded on the renewed patent, is necessary, in order to continue such injunction. *Woodworth* v. *Stone*, 3 Story, 750.—STORY, J.; Mass., 1845.

2. Where on an original bill a provisional injunction had been granted restraining the defendant from further making and selling a certain article, and subsequent to the filing of the original bill and the issuance of such injunction, another party had become connected with the subject matter of the suit, and it was alleged that he was doing those things which the court had previously restrained, and a discovery was sought, *Held*, such party was properly brought before the court by a supplemental bill. *Parkhurst* v. *Kinsman*, 2 Blatchf., 73–75.—BETTS, J.; N. Y., 1848.

3. A supplemental bill may be filed at any stage of the cause, even after decree rendered. *Ibid.*, 76.

4. It is essential to a valid bill of discovery, in respect to a patent, that it set forth a title in the party which is sufficient to support or defend a suit, and that it pray a discovery pertinent to that title and nothing beyond. *Young* v. *Colt*, 2 Blatchf., 377. BETTS, J.; N. Y., 1852.

5. A defendant in a suit in equity founded on an infringement of a patent, cannot by a cross bill, which sets up no title in himself, demand a discovery from the plaintiff in the original suit, who has a *prima facie* title, as to the source or validity of that title. *Ibid.*, 377.

6. Where such a bill cannot be sustained as a bill of discovery, it cannot be retained for the purpose of relief, unless the bill makes out a case for re-

lief independently of the discovery sought for. *Ibid.*, 378.

### 4. *Demurrer.*

See also PLEADING.

1. A special demurrer to a bill should point out specifically, by paragraph, page, or folio, or other mode of reference, the parts of the bill to which it is intended to apply, or it will be held insufficient. *Atwill* v. *Ferrett*, 2 Blatchf., 43, 44.—BETTS, J.; N. Y., 1846.

2. An objection to the form of a bill, as that no oath was filed with it, or that it was not supported by evidence, should be made when the respondents appear. It is too late to make it after a hearing and order to file evidence. *Woodworth* v. *Edwards*, 3 Wood. & Min., 124.—WOODBURY, J.; Mass., 1847.

3. On a special demurrer to a bill, the allegations of fact in the bill, will, on the hearing of the demurrer, be considered as true. *Ibid.*, 126.

4. In a general sense, a bill in equity is demurrable on the ground of multifariousness, if it set up matters which are distinct and independent, and which call for separate defences; but where a bill was filed for the infringement of several patents, all of which were infringed by the defendant's machine, *Held*, that to this extent the several patents were all connected together, and that the convenience of parties, as well as a saving of expense in the litigation, justified embracing all the patents in one suit. *Nourse* v. *Allen*, 4 Blatchf., 377.—NELSON, J.; N. Y., 1858.

5. Whether several patents could be embraced in one suit, if one patent was used in one machine, and another in a different machine; *query*. *Ibid.*, 378.

6. It is not a ground of demurrer that such a bill does not contain the deduction of title in the complainant. A simple averment of title is sufficient. *Ibid.*, 378.

### 5. *Answer; what to set forth; when considered only as an affidavit; amendment of.*

See also DEFENCES; GENERAL ISSUE.

1. Exceptions to an answer should state the charges in the bill, and the interrogatory applicable thereto, to which the answer is addressed, and then the terms of the answer, verbatim, so that the court may at once perceive the ground of the exception, and ascertain its sufficiency. *Brooks* v. *Byam*, 1 Story, 300.—STORY, J.; Mass., 1840.

2. In the case of an interrogatory pertinent to a charge in the bill, and requiring the defendant to answer it "as to his knowledge, remembrance, information and belief," it is not sufficient for the defendant to answer as to his knowledge, but he must answer also as to his information and belief. *Ibid.*, 301.

3. An answer to such an interrogatory "that the defendant had no knowledge, information, and belief, that the charge was not true," is liable to exception that it did not state whether the defendant believed it to be true. *Ibid.*, 301.

4. Whenever a defendant does not deny any particular allegation of fact, but states his belief thereof, he either admits that it is true, or that he does not mean to controvert it. But a mere statement by the defendant in his answer that he has no knowledge that the fact is as stated, without any answer as to his belief concerning it, is not such

an admission as can be received as evidence of the fact. *Ibid.*, 302.

5. The defendant in equity is bound to answer in direct and unequivocal terms as to the state of his mind with regard to every fact stated in the bil. to which he is interrogated, either that he does believe, or that he does not believe the matter inquired of, or that he cannot form any belief, or has not any belief concerning the matter; and according as the answer shall be one way or the other, that he calls upon the plaintiff for proof thereof, or that he admits it, or that he waives any controversy about it. *Ibid.*, 304.

6. If a defendant to a bill filed for an infringement of a patent wish to avail himself of the defence of abandonment or acquiescence of the plaintiff in the public use of his invention, he must set forth such defence in his answer, and put it in issue. If the point is not put in issue, any evidence as to it will be irrelevant, and cannot be looked to. *Wyeth* v. *Stone*, 1 Story, 284.—STORY, J.; Mass., 1840.

7. In a motion as to an injunction, the answer of the defendant is to be considered only as an affidavit. *Cooper* v. *Matthews*, 8 Law Rep., O. S., 415.—BALDWIN, J.; Pa., 1842.

8. On a motion for an injunction, if the complainants have called in their bill for the defendants to answer, and they have filed such answer, though voluntarily and before the entry of any rule to answer, it seems that such answer will be treated as an answer, and not merely as an affidavit. *Brooks* v. *Bicknell*, 3 McLean, 254.—MCLEAN, J.; Ohio, 1843.

9. Where an answer is responsive to the bill and under oath, and denies the infringement, something more than the evidence of one witness must be produced to overcome it, and justify an injunction. *Woodworth* v. *Hall*, 1 Wood. & Min., 252.—WOODBURY, J.; Mass., 1846.

10. Where a bill asks for an injunction against the use of a patent and for an account, an answer denying the validity of the patent and the infringement is sufficient for the purpose of obtaining an order for an issue at law to try the validity of the patent, though it does not set out the names of the persons who used the thing patented, or knew it before the patentee, nor the names of the places where known or used. *Orr* v. *Merrill*, 1 Wood. & Min., 378.—WOODBURY, J.; Me., 1846.

11. But the answer, if intended to form an issue to try the validity of a patent, because the thing patented was not original, should set out the names of places and persons where and by whom the thing had been used before the plaintiff's invention. *Ibid.*, 378.

12. If a demurrer is overruled the respondent may still have leave to answer the bill on payment of costs. *Woodworth* v. *Edwards*, 3 Wood. & Min., 130.—WOODBURY, J.; Mass., 1847.

13. In equity, where a bill contains no interrogatories, when they are necessary, the defendant is not bound to answer it, and he cannot legally be in default for not answering, and consequently no decree *pro confesso* can be entered against him. *Wilson* v. *Stolley*, 4 McLean, 274.—MCLEAN, J.; Ohio, 1847.

14. The practice of treating an answer upon a motion for an injunction directly and unequivocally denying the facts set forth in the bill, merely as an affidavit, which might be contradicted by other affidavits, and should not have

the technical effect of precluding contradictory testimony, is a relaxation of the settled rules of practice in English courts of equity, which should be followed, unless changed by the written rules of the Circuit Courts, as established by the Supreme Court or by themselves. *Parker* v. *Sears*, 1 Fisher, 95.—GRIER, J.; Pa., 1850.

15. The affidavit and answer, especially if accompanied with one or two depositions of witnesses, denying the infringement, should be considered as conclusive on motions for preliminary injunctions. *Ibid.*, 96.

16. Even after a trial at law and a verdict for the plaintiff upon his patent, and the denial of a motion for a new trial, and a bill filed for a perpetual injunction, an amendment to the answer will be allowed, where new and important evidence has been discovered affecting the novelty of the plaintiff's invention, and an order granted for a feigned issue. *Foote* v. *Silbsy*, 1 Blatchf., 545, 548.—NELSON, J.; N. Y., 1850.

17. An assertion in an answer to a bill filed for the infringement of a patent, that the defendant had not used the compound in the proportions described in the plaintiff's patent, but has used other and better compounds, is a mere evasion, or rather an admission that he has been attempting to evade while actually infringing the patent. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J.; 1852.

18. A defendant who appears and puts in an answer, waives all objections to the regularity of the service upon him of the subpœna to appear and answer. *Goodyear* v. *Chaffee*, 3 Blatchf., 270.—NELSON, J.; N. Y., 1855.

19. A motion to allow an answer to be filed in a patent case made after the bill has been taken *pro confesso*, is addressed to the discretion of the court. *Dean* v. *Mason*, 20 How., 204.—McLEAN, J.; Sup. Ct., 1857.

## C. JURISDICTION AS TO TRADE-MARKS.

See also INJUNCTION, C.

1. A party has a right to call upon a court of equity to restrain a defendant from fraudulently using the words and devices which he has previously taken for the purpose of distinguishing his property. *Taylor* v. *Carpenter*, 2 Sand., Ch., 612.—BEARDSLEY, J.; N.Y., 1846.

2. A court of equity is not bound to protect the purchaser of another's secret for preparing a specific article, and of the right to use his name as a trade-mark in the sale of such article in the name of the original manufacturer. *Partridge* v. *Menck*, How. App. Cas., 559, 561.—GARDINER, J.; N. Y., 1848.

3. It is no answer that the complainant obtained the secret from the original manufacturer, or that the article sold is in all respects equal to that offered by the original proprietor. *Ibid.*, 559.

4. The privilege of deceiving the public, even for its own benefit, is not the subject of commerce. *Ibid.*, 559.

5. Such a proceeding is a deception upon the public, inducing the belief they are purchasing the goods of the original manufacturer, when in truth he has no concern in it. *Ibid.*, 560.

6. The jurisdiction that courts of equity exercise in respect to trade-marks is of recent origin, but is now established upon just and reasonable grounds. *Amoskeag Manuf. Co.* v. *Spear*, 2 Sand., S.C., 604, 605.—DUER, J.; N. Y., 1849.

7. A party is entitled to the protection of the law in the exclusive use of his trade-mark, and the interests of the public as well as his own require that it should be given. *Ibid.*, 605.

8. A court of equity in refusing to restrain the violation of another's trade-mark would violate the principles upon which a large portion of its jurisdiction is founded. *Ibid.*, 606.

9. A court of equity will restrain a wrongdoer in such cases, on the ground of protecting a party in the exercise of a legal right, the suppression of fraud, and preventing a mischief which might otherwise prove irreparable. *Ibid.*, 606.

10. A complainant cannot claim the protection of a court of equity to restrain a fraudulent use of his trade-mark on the ground either of having an exclusive right as an inventor in the thing manufactured by him, or an exclusive right as author in his label. *Coffeen* v. *Brunton*, 4 McLean, 517.—McLean, J.; Ind., 1849.

11. An intentional fraud is not necessary to entitle a plaintiff to such protection. *Ibid.*, 519.

12. The fact that the use of words as trade-marks, indicating *quality* merely, may to some extent mislead purchasers, or induce them to believe that articles manufactured by one person are those manufactured by another, will not justify the court in affording protection to the use of such names, if such impression is not one which was intended to be derived from them. *Stokes* v. *Landgraff*, 17 Barb., S. C., 612.—Strong, J.; N. Y., 1853.

13. The ground upon which a court of equity exercises jurisdiction in trade-mark cases is the prevention of fraud, and of damages consequent upon it, that might be irreparable. *Gillett* v. *Kettle*, 3 Duer, 626.—Bosworth, J.; N. Y., 1854.

14. Courts of equity do not interfere by injunction in cases of violation of trade-marks, except in aid of a legal right. If the fact of the plaintiffs' right in a trade-mark, or the defendants' interference with it, be doubtful, the plaintiffs will be left to establish their title at law. *Merrimack Manuf. Co.* v. *Garner*, 4 E. D. Smith's Rep., 390.—Daly, J.; N. Y., 1855.

15. It may be that a party would not be permitted to manufacture and vend an inferior article, and put it forth to the public as of the same quality and kind as that of another, but whether he could be restrained by injunction is doubtful. *Ibid.*, 392.

16. When the power of a court of equity has been invoked, it has been to restrain the defendant from making his goods and selling them as and for the goods manufactured by the plaintiff, on the ground that such a fraud was an injury to the plaintiff, and tending to mislead and deceive the public. *Samuel* v. *Berger*, 24 Barb., S. C., 165.—Davies, J.; N. Y., 1856.

17. The plaintiff, a manufacturer of watches, claimed the right, as assignee, to stamp his watches with the name of one Iberson Brindle. The defendants sold watches manufactured by said Brindle himself, and stamped with his name. *Held*, that the plaintiff was not entitled to an injunction to restrain the defendants from selling the original article, and thus protect the plaintiff in selling the simulated. *Ibid.*, 165.

18. A tradesman, to bring his privilege of using a particular mark under the protection of equity, is not bound to prove that it has been copied in every particular by another. It is enough for

him to show that the representations employed bear such resemblance to his as to be calculated to mislead the public generally, who are purchasers of the article, and to make it pass with them for the article sold by him. *Walton* v. *Crawley*, 3 Blatchf., 447.—BETTS, J.; N. Y., 1856.

19. If a plaintiff comes into a court of equity to claim relief against the fraud of others, he must be free himself from the imputation. *Fetridge* v. *Wells*, 13 How. Pr., 389.—DUER, J.; N. Y., 1857.

20. If sales of an article made by a plaintiff are effected, or sought to be, by misrepresentation and falsehood, he cannot be listened to when he complains that by the fraudulent rivalry of others his own fraudulent profits are diminished. An exclusive privilege for deceiving the public is not one that a court of equity will aid or sanction. *Ibid.*, 389.

21. Where the plaintiffs were engaged in manufacturing and selling an article called the "Balm of a Thousand Flowers," and which they represented as "the very balm and extract of healing blossoms," but which in fact was only a liquid soap, and sought to restrain the defendants from doing the same thing, *Held*, that the name was intended to deceive the public, and that the plaintiff could not be protected in such a privilege. *Ibid.*, 390–392.

22. The protection of trade-marks originated with the common law doctrine that he who sold his own ware as another's, was responsible both to the party whose custom he had fraudulently obtained, and to him from whom he drew it away; and it was immaterial in what way he carried on the imposition, whether by verbal representations, or simulations of marks, used to designate the wares, or other *indicia* of ownership. *Corwin* v. *Daly*, Upton on Trade-Marks, 193, 194.—ROBERTSON, J.; N. Y., 1860.

23. Two principles are adhered to in all cases in equity as to restraining the use of trade-marks; first, the intent to pass off the goods of the defendant as those of the plaintiff must exist, though names may be used, equally with other devices, as instruments of such fraud. 2d, that the mere use of the name alone, not indicating any ownership, origin, or manufacture of the article sold, and therefore by itself not instrumental in representing to a purchaser that the goods bought by him, of the supposed pirate, were those of the complainant, and only designating or exaggerating the materials, kind, quality, destined use, or class of customers of the articles sold, cannot be protected, without proof of fraudulent intent in such use. *Ibid.*, 192.

24. A court of equity will not interfere to protect a party in the use of trade-marks which are employed to deceive the public, and to deceive them by fraudulent representations contained in the labels and devices which are claimed to constitute wholly or in part such trade-marks. An intent to deceive the public is not favored. *Hobbs* v. *Francais*, 19 How. Pr., 571.—BOSWORTH, J.; N. Y., 1860.

25. Where the plaintiff manufactured a skin powder called "Meen Fun," which was represented as made in London, and "patronized by her majesty the Queen," when in fact it was made in New York, and the defendant manufactured a like article, representing it as "patronized by her majesty the Empress," *Held*, that the court would not

grant an injunction; not because of any regard for the defendant, but not to assist in deceiving the public. *Ibid.*, 571.

26. Chancery will not interfere by injunction in questions of trade-mark between the venders of patent medicines, being quack medicines; such questions having too little to commend them on either side. *Heath* v. *Wright*, 3 Wall, Jr.—GRIER, J.; Pa.

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## EQUIVALENTS.

See also FORM; INVENTIONS, C.

1. The substitution or application of a known mechanical equivalent, as the endless screw and wheel to the periphery of a quadrant to steering vessels, to which it had never before been applied, is not invention. It is only the application of an ordinary power to an ordinary purpose, and does not entitle the party making the application to a patent. *Cochrane* v. *Waterman*, MS. (App. Cas.) —CRANCH, Ch. J.; D. C., 1844.

2. The substitution of one mechanical power in a machine, as the wheel and axle, in the place of a screw, to accomplish the same result, is a mere formal alteration and no invention. *Blanch. Gun-Stock Fac.* v. *Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

3. So also in Blanchard's machine for turning irregular forms, it was considered immaterial whether the lateral motion was given to the pattern and rough material, or to the cutter and friction wheels, the parts acting upon each other relatively the same. *Ibid.*, 278.

4. A mere change in form or proportion, or a substitution of mechanical means or equivalents, in any one or all the elements of a combination, producing the same results, does not constitute a substantial difference. *Gorham* v. *Mixter*, 1 Amer. Law Jour., N. S., 543. —SPRAGUE, J.; Mass., 1849.

5. By equivalents in machinery is 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 Fisher, 87.—WOODBURY, J.; Mass., 1850.

6. If two machines are equivalents, with slight changes, the one may be made to do what can be performed by the other. *Ibid.*

7. If the same general plan of a machine be taken and applied for the same purpose, although the mode of construction may be varied, it will be substantially the same, and is only what is called a mechanical equivalent, or another way of doing the same thing, by means of mechanical skill, which, however meritorious and creditable, is not an invention. *McCormick* v. *Seymour*, 2 Blatchf., 246, 248.—NELSON, J.; N. Y., 1851.

8. The use of a known equivalent is an infringement; although the patentee has not expressly claimed equivalents, he is understood to embrace them, and in contemplation of law does embrace them, without any express mention. *Byam* v. *Farr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

9. But the patentee is not obliged to embrace equivalents in his claim. He may, if he choose, confine himself to the specific ingredieuts or things, and expressly exclude all others, or expressly exclude some or one other. If he does so, the use of the thing disclaimed is no infringement. *Ibid.*, 263.

10. The doctrine of the use of mechanical equivalents is not confined to those elements which are strictly such in the science of mechanics. There are different well-known devices, any one of which may be adapted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another does not belong to the subject of invention, but of construction. *Foster* v. *Moore*, 1 Curt., 291.—CURTIS, J.; Mass., 1852.

11. A machine, constructed to accomplish a particular object or purpose, may often be materially changed from its original construction, and yet work very well. There are mechanical equivalents by the use of which the whole features may be changed, and a great departure made from the apparent principle and combination of the machine, and yet it may operate well. *Blanchard* v. *Beers*, 2 Blatchf., 419, 420.—NELSON, J.; Ct., 1852.

12. The substitution of a mechanical equivalent is not a substantial change. There are many devices in construction that can be made by a skilful mechanic, differing very much in appearance, but which in the eye of the patent law are regarded as identical. *Tatham* v. *Le Roy*, 2 Blatchf., 486.—NELSON, J.; N. Y., 1852.

13. Any machine which has been constructed may be very materially changed in its mechanical arrangement and construction, and yet it may accomplish the object and purpose for which it was designed. *Ibid.*, 487.

14. When a power is necessary for working a machine, the inventor or proprietor has a right to make his selection of any description of power known to the mechanic arts. It is of no importance whether such power is hand, steam, horse power, electricity, or any other power. The substitution and use of one power, as electricity, in the place of another, as hand power, does not make the machine different, or prevent its infringing on another. The one is but an equivalent of the other. *Crehore* v. *Norton*, MS.—NELSON, J.; N. Y., 1853.

15. The doctrine of mechanical equivalents depends upon the truth that the *identity of purpose*, and not of form or name, is the true criterion of judging of the similarity or dissimilarity of two pieces of mechanism. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

16. Where two devices are capable each of doing the same thing, and in substantially the same way, they must be equivalents of each other, and when one has been used, the other is not patentable. *Boughton, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

17. Whether one thing is a mechanical equivalent for another, is an inference to be drawn from all the circumstances of the case, by attending to the consideration whether the contrivances used by the one party are *used for the same purpose*, performs the *same duties*, or is applicable to the same object as the contrivance used by the other party *Ibid.*

18. The phrase "or the equivalent therefor," in machinery, extends to improvements substantially the same as those described, involving the same principle, and embracing all alterations merely colorable, but does not include a claim to any other invention, equivalent or equal to the one described. This would be to include all modifications or improvements in the machine. *McCor-*

*mick* v. *Manny*, 6 McLean, 557.—McLean, J.; Ill., 1855.

19. The substitution of one mechanical equivalent as a rod in place of an endless chain, to accomplish a like purpose and with like effect, is not the subject of a patent. *Spain* v. *Gamble*, MS. (App. Cas.)—Morsell, J.; D. C., 1855.

20. By an abuse of this doctrine of mechanical equivalents, experts can demonstrate every machine which effects a certain purpose to be substantially the same with every other which effects the same purpose. *Sickles* v. *Glou. Man. Co.*, 1 Fisher, 234.—Grier, J.; N. J., 1856.

21. If the patentee be an original inventor of a machine or thing, he has the right to treat as infringers all who make a like invention operating on the same principles, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement on the original and patented one. *McCormick* v. *Talcott*, 20 How., 405.—Grier, J.; Sup. Ct., 1857.

22. But if his invention be but an improvement on a known machine, he cannot treat another as an infringer who has improved the original machine by using a different form or combination performing the same function. The inventor of a first improvement cannot invoke the doctrine of mechanical equivalents to suppress all other improvements which are not mere colorable invasions. *Ibid.*, 405.

23. The use, in a combination, of one equivalent for another, does not render it new in the sense of the patent laws, but some new mode of operation must be introduced. *Forbush* v. *Cook*, 10 Mo. Law Rep., 664.—Curtis, J.; Mass., 1857.

24 Substantial identity excludes immaterial variations or fraudulent evasions. 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 of a variety of forms, there is an identity of principle, though not an identity of mode. *Page* v. *Ferry*, 1 Fisher, 310.—Wilkins, J.; Mich., 1857.

25. The same principle may be used without an exact identity, by mechanical equivalents or contrivances, and if so there would be a substantial identity, or such an arrangement of mechanism which produces the same service, or produces the same effect in the same way, or substantially in the same way. *Ibid.*, 311.

26. If a change introduced constitute a mechanical equivalent in reference to the means used by another, and besides being such an equivalent accomplishes some other advantages beyond the effect or purpose accomplished by such patentee, such further advantage may make it a patentable subject, or an improvement upon the former invention. *Hibbard*, *Ex parte*, MS. (App. Cas.)—Morsell, J.; D. C., 1857.

27. The substantial equivalent of a thing is the same as the thing itself, so that if two machines do the same work in substantially the same way, and accomplish substantially the same result, they are the same; and so if parts of the two machines do the same work, in substantially the same way, and accomplish substantially the same result, those parts are the same, although they may differ in form or shape; but in both cases, if the 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 Fisher, 420.—CLIFFORD, J.; Me., 1859.

28. Slight differences in degree cannot be regarded as of weight in determining questions of substantial similarity, or substantial difference. One may be longer or shorter, work better or worse, and yet the two be substantially the same; whether the difference in degree constitutes a substantial difference is a question for the jury. Mere difference in degree is, however, entitled to but little weight. *Ibid.*, 420.

29. 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. *Johnson* v. *Root*, 1 Fisher, 363.—SPRAGUE, J.; Mass., 1858.

30. Two things may be equivalent as producing the same results, when they are not the same mechanical means. Mechanical equivalents are spoken of as different from equivalents that merely produce the same results. *Ibid.*, 363.

31. 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, as producing a pressure in a machine by a spring, or by a weight. *Ibid.*, 363.

32. But there may be equivalents to produce the same results, each of which is an independent matter of invention, and in that sense they are not mechanical equivalents, as the invention and use of a pump to raise water instead of drawing the water by a rope and pail. *Ibid.*, 363.

33. However the appearance of a thing may be altered, if the aspect, the form, the appearances presented, are changed only by the use of mechanical equivalents, then it is substantially the same thing. *Ibid.*, 364.

34. And, if an invention is a substitution for the original invention, then it is not substantially the same. *Ibid.*, 364.

35. Whether two things are or are not equivalent is matter of skill and sound judgment (for the determination of the office), which can in no way be limited, or restrained by the admissions or denials of parties. *Hutchinson* v. *Meyers*, MS. (App. Cas.)—MERRICK, J.; D. C., 1861.

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## ESTOPPEL.

1. An offer to take a license from a patentee to use his invention does not take away the right of the person making such offer to deny that the patentee was the original inventor. *Evans* v. *Eaton*, Pet. C. C., 347.—WASHINGTON, J.; Pa., 1816.

2. 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 Mas. 473.—STORY, J.; Mass., 1818.

3. If several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. *Ibid.*, 474.

4. 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. *Odiorne* v. *Amesbury Nail Fac.*, 2 Mas., 31.—STORY, J.; Mass., 1819.

5. In an action of covenant broken, the declaration averred that the parties were *joint* inventors of a machine, and that they covenanted to co-operate to secure the benefit thereof, and that one should have secured to him certain states, and the other certain other states, and that neither should use or sell the machine in the territories of the other; and then alleged covenant broken, *Held*, that the defendant in such action could not plead that neither party was the inventor, or that separate patents had been issued to each. *Stearns* v. *Barrett*, 1 Pick., 443, 447.—WILDE, J.; Mass., 1823.

6. And after having obtained a joint patent, neither party could set up the prior separate patents; and that neither was estopped by the separate patents from asserting that the invention was joint. *Ibid.*, 447.

7. An assignment of an invention before a patent is obtained is a good transfer of the right of the patentee when he obtains a patent, and he would be estopped from setting up any adverse title. *Herbert* v. *Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

8. Whether a disclaimer of all title under a former patent, as to the parts claimed in a subsequent patent, would not operate as an estoppel to any remedy which might be prosecuted for a violation of such former patent; *query*. *Treadwell* v. *Bladen*, 4 Wash., 709.—WASHINGTON, J.; Pa., 1827.

9. A disclaimer, at the close of a specification, estops the patentee from setting up any privilege to the part disclaimed. *Whitney* v. *Emmett*, Bald. Rep., 313.—BALDWIN, J.; Pa., 1831.

10. If a defendant, in an action respecting a patent, has advertised the thing patented, and which had been sold by him as a useful invention, and one that has superseded others, he will not, in any action against him, be allowed to deny its utility. *Stanley* v. *Whipple*, 2 McLean, 39.—McLEAN, J.; Ohio, 1839.

11. Where a party claims to establish his rights merely by an estoppel, the instrument by which the estoppel is supported should be precise, clear, and unequivocal, and not depending on doubtful inference. *Rich* v. *Hotchkiss*, 16 Conn., 418.—WILLIAMS, Ch. J.; Ct., 1844.

12. The taking of a license, to use a patent-right for a time, cannot be considered as an acknowledgment of a right in the licenser beyond the termination of such license. *Ibid.*, 418.

13. Where it was stipulated between A and B, that B should be entitled to use A's patent three days in a week until a given date, and that A would not prosecute any action against B for any former violation, provided B should not use such patent after the specified date, or by any other machine infringe A's right, *Held*, that such proviso, introduced by the plaintiff, and not placing any personal obligation on the defendant, did not operate as an estoppel against B to prevent him showing the truth in regard to the validity of the right of A. *Ibid.*, 419, 420.

14. The bringing of an action for arrears due on a license to use a patent is no waiver of a right to enforce a forfeiture of such license for the non-payment of the price agreed for such use. *Armstrong* v. *Hunlenbeck*, 3 N. Y. Leg. Obs., 45.—BETTS, J.; N. Y., 1844.

15. But the confession of a judgment

in a suit brought to recover such arrears is an admission of such payments being in arrear, and the defendant will not afterward be allowed to go behind such judgment, and prove that there was no default in payment. *Ibid.*, 45.

16. If a licensee or grantee acknowledge, under his hand and seal, the validity of the grantor's title; *query*, Is he not estopped from denying it? *Brooks* v. *Stolley*, 3 McLean, 526.—McLean, J.; Ohio, 1845.

17. If a patentee used certain words in his first specification, and afterward withdraw them in his amended specification in a reissued patent, he is not estopped by the words which have been so withdrawn and cancelled. *Allen* v. *Blunt*, 2 Wood. & Min., 143, 144.—Woodbury, J.; Mass., 1846.

18. K. purchased an interest in a patent, and agreed with the patentee, upon certain conditions, to give his personal attention to manufacturing of machines under the patent; afterward he made a second agreement with the patentee, whereby he, K., agreed to discontinue such manufacture, and the patentee was to carry it on, rendering to K. a certain proportion of the profits; *Held*, that by virtue of such agreements K. was estopped, in an action brought against him by the patentee for continuing such manufacture, and for an account, from setting up the defence that such patentee was not the original and first inventor of the thing patented. *Parkhurst* v. *Kinsman*, 1 Blatchf., 490, 495.—Nelson, J.; N. Y., 1849. [Affirmed, *post* 21.]

19. Declarations on the part of an inventor, that he did not intend to take out a patent, but to let the public have his invention, would estop such party, or any one holding under him, from asserting his right, as by action of infringement, against a person acting on the faith of such declarations, which are equivalent to a license. *Pitts* v. *Hall*, 2 Blatchf., 237, 238.—Nelson, J.; N. Y., 1851.

20. D. having, during the pendency of certain actions against him, brought by G. for the infringement of G.'s patents, made a settlement with G., and having secured the exclusive right to use said G.'s patents, and also consenting that a judgment should be taken against him in one of such suits; *Held*, that D. had thereby admitted the validity of G.'s patents, and that he was estopped from denying their validity in any subsequent suit that might be brought against him by G. *Goodyear* v. *Day*, MS.—Dickerson, Grier, JJ.; N. J., 1852.

21. An agreement made with a patentee to manufacture his patented machines upon certain conditions, and making and selling such machines under the patentee's title, estops such party, in an action for an account brought by the patentee, from alleging the invalidity of the patent. *Kinsman* v. *Parkhurst*, 18 How., 293.—Curtis, J.; Sup. Ct., 1855.

22. H. purchased of B. the right to construct and use an alleged patented machine, and covenanted "to receive the said right as good and available to all intents and purposes, and that the same and the transfer shall not be liable to any objections for any supposed defect in, or objection to, the said letters patent, if such supposed defect or objection should at any time arise." *Held*, that the vendee in an action for the price, was estopped from alleging the invalidity of the patent. *Heilner* v. *Battin*, 27 Penn., 517, 520, 524.—Woodward, J.; Pa., 1856.

23. And such estoppel applies as well to the objection that the reissued patent was not for the same invention as the original, as to that against the originality of the invention. *Ibid.*, 524.

24. An assignment of an interest in a patent precludes the assignor from asserting that what he sold was useless. *Thomas* v. *Quintard*, 5 Duer, 82.—DUER, J.; N. Y., 1855.

25. Where the defendant purchased an interest in a patent, and gave his note for the agreed price, and afterward assigned his interest in the invention and patent, and such assignment recited the assignment to himself of the patent-right, and purported to transfer it as it was transferred to him, *Held*, in an action on such note, against the defendant, that he could not set up that the invention was of no value, but that he was estopped by his own assignment from questioning the patent and invention. *Ibid.*, 82.

26. There is nothing to estop the government of the United States from showing a patent, which it had granted, to have been a nullity *ab initio*, owing to the non-existence of the condition precedent of novelty of the invention. *King* v. *United States*, 10 Mo. Law. Rep., 631. (Ct. Claims, 1857.)

27. Where admissions are made by a party to induce others to act upon them, such admissions do not operate *merely* as presumptive evidence of the actual truth of the facts, which must give way to positive proof of the contrary, but preclude or estop the party, on grounds of policy. *Carroll* v. *Gambrill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

28. If the defendants have used the plaintiff's invention, or something substantially like it, they are estopped from denying its utility, for use implies utility, and it is fair to presume that they would not use it if they thought it of no utility. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

29. The mere taking a license does not estop the licensee denying the validity of a patent. *Mitchell* v. *Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

30. In order to establish a right by estoppel, the instrument in support of the estoppel must be precise and certain, and must cover a range as wide as the effect sought to be given to it. *Ibid.*

31. The use by a defendant of the plaintiff's invention, or something substantially like it, estops him denying the utility of such invention; the use of the thing patented, implies that the party thought it of some utility. *Vance* v. *Campbell*, MS.—LEAVITT, J.; Ohio, 1860.

32. The mere fact that a party is a witness to the application of another for a patent for a particular invention, does not estop such party from afterward claiming to be himself the original inventor of such invention. *Herring* v. *Leffingwell*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

33. It is competent for such party to show that he was deceived as to the character of the paper he was witnessing, and if his signature was obtained by misrepresentation, it will be treated as if it had never been made. *Ibid.*

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## EVIDENCE IN PATENT CASES.

**A.** BURDEN OF PROOF, ON WHOM LIES... 282
**B.** PRESUMPTIONS..... 283.

**C.** DEPOSITIONS
1. *De bene esse, under Acts of Congress* ..... 285
2. *Under Rule of Court or Commission* ..... 287
3. *Under Rules of the Patent Office.* 288
**D.** DECLARATIONS AND ACTS OF PARTIES, AND THIRD PERSONS ..... 290
**E.** PAROL, AND SECONDARY EVIDENCE .... 293
**F.** PUBLIC RECORDS AND PAPERS; VERDICT ..... 294
**G.** WITNESSES
1. *Competency and Credit of*
*a.* Of Witnesses generally ..... 295
*b.* Of Assignor of Invention in Interferences ..... 298
2. *Examination and Impeachment of* ..... 298
3. *Parties, Examination of* ..... 300
**H.** RULES AS TO PARTICULAR FACTS AND ISSUES
1. *Abandonment* ..... 300
2. *Fraudulent Intent* ..... 302
3. *Infringement* ..... 302
4. *Invention, and Originality and Priority of* ..... 304
5. *Invention, Novelty, and Utility of* 307

## A. BURDEN OF PROOF, ON WHOM LIES.

1. In a proceeding under § 10 of the act of 1793, the burden of proof lies upon the plaintiff to show that the patent was obtained surreptitiously, or upon false suggestions. *Stearns* v. *Barrett*, 1 Mas., 175.—STORY, J.; Mass., 1816.

2. In a patent case, the *onus probandi* is on the defendant to show that the proper notice has been given under the statute to enable him to examine witnesses to show that the invention of the plaintiff had been known or used before his invention; and if the notice is not given, such evidence cannot be received. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet., 459.—STORY, J.; Sup. Ct., 1840.

3. Though doubt and uncertainty are fatal to a motion to grant an injunction, they are good cause for continuing it on a motion to dissolve; the burden of proof being on the plaintiff in one case, and on the defendant in the other. *Cooper* v. *Matthews*, 8 Law Rep., 416.—BALDWIN, J.; Pa., 1842.

4. Where the defence is, that the invention is not so described as to enable a skilful mechanic to construct a machine, the burden of proof rests on the defendants to show such to be the case. *Brooks* v. *Bicknell*, 3 McLean, 445, 447.—MCLEAN, J.; Ohio, 1844.

5. So also when the defence is made that the patentee is not the original inventor of the thing patented to him. *Ibid.*, 451.

6. As to whether the defendants have infringed the plaintiff's patent, the burden of proof lies on the plaintiffs. *Ibid.*, 453.

7. If a defence of prior invention is made to an action of infringement, the burden of proof as to such point lies with the defendant. He must satisfy the jury beyond a reasonable doubt, that there was a prior invention, because the plaintiff has a right to rest upon his patent, until its validity is overthrown. *Washburn* v. *Gould*, 3 Story, 142.—STORY, J.; Mass., 1844.

8. The burden of proof is upon the plaintiff to show that there has been an infringement of his right. *Ibid.*, 146.

9. The burden of proof that a combination is not new, is on the party denying that it is new. *Hovey* v. *Henry*, 3 West Law Jour., 154.—WOODBURY, J.; Mass., 1845.

10. If a party set up a sale for more than two years before the application for a patent, the burden of proof lies on the party making such defence, and

he must establish the fact of such sale so as to justify a jury in taking away the property of the plaintiff. *Ibid.*, 155.

11. Where a plaintiff has made out a *prima facie* case of infringement, and the defendant undertakes to make out a special defence, as that the invention had been used at different places before plaintiff's invention, the defendant must render these particulars probable, and must turn the scales in his favor. *Allen* v. *Blunt*, 2 Wood. & Min., 145.—Story, J.; Mass., 1846.

12. If A make a machine for B, at B's request, for his benefit and at his expense, the presumption is, that it was made according to B's directions, and if such fact is denied by A, the burden of proof is on A, to show that it was not made according to B's directions. *Warner* v. *Goodyear*, MS. (App. Cas.) —Cranch, Ch. J.; D. C., 1846.

13. The constructor of a machine is presumed to be the inventor; and the burden of proof is on him who denies the fact and claims to be the inventor. *Atkinson* v. *Boardman*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1847.

14. It rests upon those who seek to defeat a patent granted to an alien, on the ground that it has not been put on sale within the time prescribed by the statute, to show that such a patentee neglected or refused to sell the invention for reasonable prices when application was made to purchase. *Tatham* v. *Lowber*, 2 Blatchf., 51.—Nelson, Betts, JJ.; N. Y., 1847.

15. On the question of infringement, the burden of proof is on the plaintiff. He must show satisfactorily that the defendant has violated his exclusive right. *Parker* v. *Stiles*, 5 McLean, 62. —Leavitt, J.; Ohio, 1849.

16. Where an equitable title to an interest in a patent is set up against a *bona fide* purchaser of and the holder of the legal title, the burden of proof lies with him impeaching the legal title. *Gibson* v. *Cook*, 2 Blatchf., 151.—Nelson, J.; N. Y., 1850.

17. The presumption of law is that a patentee is the first inventor of the thing patented to him, and the burden of proof is on the party denying it to disprove the fact. *Pitts* v. *Hall*, 2 Blatchf., 231.—Nelson, J.; N. Y., 1851.

18. The burden of showing that a patentee was not the first and original inventor, and of the inutility of the patent, rests upon the defendant. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 320.—Nelson, J.; N. Y., 1855.

19. If the defence is set up, that the patentee is not the first and original inventor of the thing patented to him, the burden of proof is on the defendant to show a prior invention, and, if he does not, the verdict must be for the plaintiff. *Cahoon* v. *Ring*, 1 Fisher, 403.—Clifford, J.; Me., 1859.

20. On the question of infringement, the burden of proof is on the plaintiff. *Ibid.*, 403. Also *Johnson* v. *Root*, *Ibid.*, 364.—Sprague, J.; Mass., 1858. And *Latta* v. *Shawk*, *Ibid.*, 469.—Leavitt, J.; Ohio, 1859.

21. It is incumbent upon the plaintiff to make out affirmatively, by proof, that his invention has been infringed, before he can recover. *Judson* v. *Cope*, 1 Fisher, 625.—Leavitt, J.; Ohio, 1860.

## B. Presumptions.

See also Patent, P. 2; Reissue of Patent, C.

1. It is a presumption of law, that

when a patent has been obtained, every man who subsequently takes out a patent for a similar machine, has a knowledge of the preceding patent. *Odiorne* v. *Winkley*, 2 Gall., 55.—STORY, J.; Mass., 1814.

2. It is also a presumption of fact, that every man having within his power the means of information, and desirous of securing to himself the benefit of a patent, will ascertain whether any one on the public records has acquired a prior right. *Ibid.*, 55.

3. It is a presumption of law, that all public officers perform their proper official duties, until the contrary is proved. Where an act is to be done, as a patent to be granted or reissued upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act, or granted the patent, is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet., 458.—STORY, J.; Sup. Ct., 1840.

4. If a person *construct* a machine, in the absence of all evidence to the contrary, the presumption is that he is also the *inventor*, and the burden of proof is thrown upon another claiming to be the inventor, to show that he suggested the idea, or made the invention. *Atkinson* v. *Boardman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

5. It is a presumption of law that a patentee is the first inventor of the thing patented to him. *Pitts* v. *Hall*, 2 Blatchf., 231.—NELSON, J.; N. Y., 1851.

6. It is a presumption of law that what the patentee does not distinctly assert to be his invention was known before. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

7. It is to be assumed, that persons obtaining patents have acquainted themselves with the state of the art in which they are interested, as made known in books, or by machines built and put in use, and evidence is not admissible to prove the contrary; nor is it matter of inquiry whether machines described in printed works were ever practically put to use or not. *Ibid.*

8. The legal presumption is, from the action of the Patent Office, that a reissued patent is for the same invention as the original patent. *Hussey* v. *McCormick*, 1 Fisher, 515.—MCLEAN, J.; Ill., 1850.

9. All persons are bound to take knowledge of the doings of the Patent Office, in relation to inventions. *Marcy* v. *Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

10. The law requiring that an inventor should describe his invention with a accuracy and fulness, and it being the duty of the Commissioner of Patents to see this is done, the presumption is that the patent has been issued upon sufficient foundation; and the court must be well satisfied there is a material insufficiency or defect in the specification, before it will pronounce any patent a nullity and void. *Judson* v. *Cope*, 1 Fisher, 622.—LEAVITT, J.; Ohio, 1860.

11. There is a presumption arising from the patent itself, that an invention is of some degree of utility; but this is not conclusive, and the other party may show that it is useless and worthless. *Lee* v. *Blandy*, 2 Fisher, 95.—MCLEAN, LEAVITT, JJ.; Ohio, 1860.

## C. DEPOSITIONS.

1. In legal language a *deposition* is evidence given by a witness under in-

terrogatories, oral or written, and usually written down by an official person; while an affidavit is the mere voluntary act of the party making the oath, and is generally taken without the acquiescence of the one against whom it is to be used. *Stimpson* v. *Brooks*, 3 Blatch., 456.—BETTS, J.; N. Y., 1856.

2. Deposition is a generic expression, embracing all written evidence, verified by oath, and includes affidavits, but in legal language a distinction is maintained in courts of law and chancery between depositions and affidavits. *Ibid.*, 456.

### 1. *De bene esse.*

1. The act of Congress—judiciary act of 1789—relating to taking of depositions *de bene esse*, must necessarily be so construed, as to confine its operation to depositions taken *within the district* where the witness lives, *more than one hundred miles* from the place of trial; because process to compel attendance could run to any greater distance *within the district*; on that account the deposition is to be *de bene esse*. A subpœna could not at that time run into another district. *Evans* v. *Hettick*, 3 Wash., 417.—WASHINGTON, J.; Pa., 1818.

2. The act of March 2, 1792, which declared that process for the attendance of witnesses in one district might run into another, provided the witnesses did not live more than one hundred miles from the place of trial, does not affect the construction above given of the judiciary act of 1789. *Ibid.*, 417.

3. Depositions may however be taken differently from what the law or rules of court prescribe under the agreement of the parties, or under any special rule of the court, in any particular case. *Ibid.*, 418.

4. A deposition taken *de bene esse* which has been read in evidence without objection, cannot be subsequently objected to and rejected, because the court after it had been so read refused to allow another deposition to be read, on account of an exception which would have applied to and excluded the deposition actually read, had it been taken. *Ibid.*, 419. [Affirmed, *post* 9.]

5. Where a deposition *de bene esse* is offered in evidence, the party offering it must prove that he has used due diligence to procure the attendance of the witness, and particularly that he has made inquiries at the last place of abode of witness, in order to have him served with a subpœna. *Pettibone* v. *Derringer*, 4 Wash., 219.—WASHINGTON, J.; Pa., 1818.

6. It is no objection to reading the deposition of a witness residing more than one hundred miles from the place of trial, that he had been in the place where the court sat during its sitting, it appearing that the fact of the witness being so present was unknown to the party at whose instance the deposition was taken. Whether the case would have been altered if the party had known of the presence of the witness; *query*. *Ibid.*, 219.

7. Depositions taken without a commission or rule of court, in another state, more than one hundred miles from the place of trial, but conforming in all respects to § 30 of the judiciary act of 1789, may be read in evidence. *Ibid.*, 219.

8. A deposition taken under § 30 of the act of 1789 cannot be read, unless the judge certifies that it was reduced to writing, either by himself or by the witness *in his presence*. *Ibid.*, 219.

9. A deposition which has once been

introduced in a cause with the acquiescence and consent of the opposite party, cannot be afterward objected to. *Evans* v. *Hettick*, 7 Wheat., 470.—STORY, J.; Sup. Ct., 1822.

10. No practice, however convenient, can give validity to depositions which are not taken according to law, unless the parties expressly waive the objection, or by previous consent agree to have them taken and made evidence. *Evans* v. *Eaton*, 7 Wheat., 426.—STORY, J.; Sup. Ct., 1822.

11. The act of Congress (act of 1789, ch. 20, § 30, 1 Stat. at Large, 100) as to the taking the testimony of witnesses residing more than one hundred miles from the place of trial by depositions, is not peremptory, that under such circumstances their depositions shall be taken and used, but only that they may be taken and used. It is a mere option given to the party who wishes to use the testimony of the witnesses. The witnesses may be produced and if so produced, full costs of their personal travel and attendance will be allowed in the costs. *Prouty* v. *Ruggles*, 2 Story, 200.—STORY, J.; Mass., 1842.

12. A deposition should not be taken during the sitting of the court at which the cause is to be tried, except by consent of parties or order of the court. *Allen* v. *Blunt*, 2 Wood. & Min., 137.—WOODBURY, J.; Mass., 1846.

13. *Semble*, That if the opposite party had counsel residing where the deposition was taken, and who had acted in a former trial, though such counsel was not entered on the record, if this fact was known to the party taking the deposition, that notice of its taking should have been given to such counsel. *Ibid.*, 137.

14. Whether, if the suit is against two, though only one has been served with process, it will be sufficient if the caption of the suit in the deposition describes the suit as only against the one served; *query*. *Ibid.*, 137.

15. If a deposition is taken without notice, a continuance will be allowed to enable the other party to cross-examine the witness or repel his testimony. *Ibid.*, 138.

16. Where prior to the taking of depositions *de bene esse*, the opposite party had had notice of the names and places of residence of the witnesses intended to be examined, and had also been notified that if they would designate agents at those places, on whom fuller notices could be served of the particular times and places of their examination, but such party refused to appoint any such agents, and declined to take any part in the proceedings, *Held*, that such party was not entitled to a stay to cross-examine such witnesses. *Van Hook* v. *Pendleton*, 2 Blatchf., 94, 95.—BETTS, J.; N. Y., 1848.

17. Under rule 68 in equity it is in the discretion of the court whether the cause shall be stayed to allow a party to cross-examine a witness, or take a new deposition of the witness, whose testimony has been taken *de bene esse*, without notice under § 30 of the judiciary act of 1789. *Ibid.*, 95.

18. Before such discretion will be exercised, facts, as that the testimony of the witness was adverse to such party, or that there are facts within the knowledge of the witness not stated, which may be important in the cause, must be laid before the court showing the necessity or propriety of a further examination of the witness. *Ibid.*, 95.

19. Depositions (in a patent suit) taken under the act of Congress, even

though taken *ex parte*, are recognized as legal testimony by the act of Congress, and are available for either side. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

## 2. *Under Rule of Court, or Commission.*

1. A deposition of a witness residing *within* a district more than one hundred miles from the place of trial, taken under a rule of court, not in conformity with the requirements of § 30 of the act of 1789, cannot be read in evidence. *Evans* v. *Hettick*, 3 Wash., 418; *Evans* v. *Eaton*, 3 Wash., 444.—WASHINGTON, J.; Pa., 1818.

2. Where witnesses live out of a district, and more than one hundred miles from the place of trial, their depositions, if taken, must be under a commission, and will be absolute. *Evans* v. *Hettick*, 3 Wash., 418.—WASHINGTON, J; Pa., 1818.

3. Depositions may be taken differently from what the law or the rules of court prescribe, under the agreement of the parties, or under any special rule of the court, in any particular case. *Ibid.*, 418.

4. Where depositions are taken under an order of court requiring notice to be given to the opposite party, and the notice was so short that the party and his counsel were unable to see each other and confer together before the time arrived, and reach the place of taking them, time will be allowed to such party to take the depositions over again, and cross-examine the witnesses, if desired. *Aiken* v. *Bemis*, 3 Wood. & Min., 351.—WOODBURY, J.; Mass., 1847.

5. An examiner to take testimony is not created or appointed at the instance of suitors, but is an officer of the court, to execute the functions appropriate to his office, however his appointment may be made. *Van Hook* v. *Pendleton*, 2 Blatchf., 90.—NELSON, BETTS, JJ.; N. Y., 1848.

6. The same power which enables the court to name commissioners, suffices for the appointment of masters and examiners. The process acts of 1792 and 1842 gave this power of appointment, to be exercised pursuant to the directions of the Supreme Court. *Ibid.*, 91.

7. Rule 82 in equity sanctions the appointment of standing masters and of masters *pro hac vice*. But the Circuit Courts could, without this rule, have appointed masters *pro hac vice*, in their discretion. *Ibid.*, 92.

8. The language of rule 78 is satisfied by designating in a common order, or by mere notification, the officer before whom the examination is to be taken. This is in effect appointing him examiner in the cause, although he should not be commissioned anew. *Ibid.*, 92.

9. It is a matter of discretion with the court whether there shall be appointed standing examiners, to take depositions, or whether they shall be named as the occasion arises for their services in any cause. *Ibid.*, 934.

10. Where the plaintiff in a suit at equity, after the cause was at issue, proceeded to take his proofs before one of the standing examiners of the court, without his having been specially appointed as examiner iu the cause, *Held*, that the examiner was competent to take the proof. *Ibid.*, 86, 93.

11. An oral examination of a witness before an examiner, without any agreement between the parties to waive written interrogations, is, under rule 67 in equity, Supreme Court rules, irregular. *Ibid.*, 93.

12. And such an agreement ought to be in writing. *Ibid.*, 93.

13. Where a party has had notice that an examination was to be taken, or had been taken, orally, and acquiesced in it, he waives his legal right to require written interrogatories to be filed. *Ibid.*, 93.

14. Where more than ten months had elapsed since an oral examination had been taken, of which the defendant had notice, and more than five months had elapsed since publication, *Held*, that the defendant had been guilty of laches, and that it was too late to raise the objection that the testimony had been taken orally. *Ibid.*, 93, 94.

### 3. *Under Rules of the Patent Office.*

1. Evidence taken under the rules established by the Commissioner of Patents, under the statute, must not only be taken agreeably to those rules, but must be evidence competent in law. *Arnold* v. *Bishop*, MS. (App. Cas.).—CRANCH, Ch. J.; D. C., 1841.

2. After a deposition has been taken under such rules, a revocation of them cannot affect that deposition, and will affect only subsequent proceedings. *Ibid.*

3. Lateness of time of notice of taking depositions under the rules of the Patent Office is no cause for rejecting the depositions taken; but it may, perhaps, be good ground for an application to the Commissioner to allow further time to take other testimony. *Ibid.*

4. But if the magistrate before whom a deposition is taken fails to certify thereon that it was sealed up by him, it is sufficient ground for excluding such deposition from the consideration of the Commissioner. *Ibid.*, 28.

5. A notice of taking depositions at a place four hundred miles distant, served eleven days before the time for taking such depositions, is sufficient. *Smith* v. *Flickenger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

6. Where depositions had been correctly taken, but had not been transmitted in the form required, so that they could, under rule 4, be *considered* by the Commissioner, *Held*, nevertheless, that the Commissioner had a right to postpone the hearing, to allow the parties to cure the informality, if he deemed such action necessary to further the ends of justice. There is nothing in the laws or rules of the Patent Office preventing the Commissioner from so doing. *Ibid.*

7. The rule referred to does not prohibit the Commissioner from *looking into* the deposition informally transmitted, or reading it and ascertaining its contents; but only prohibits him from *considering* it as evidence touching the matter in issue. *Ibid.*

8. By an agreement of parties, the testimony of witnesses otherwise incompetent may be received and considered. *Warner* v. *Goodyear*, MS. (App. Cas.) CRANCH, Ch. J.; D. C., 1846.

9. Depositions, to be used in a matter of interference before the Commissioner of Patents, taken without notice to the opposing party, cannot be used against him, unless he has waived his right to notice, and agreed to admit them to be read in evidence. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

10. And notice given by such party to the opposing counsel to produce such depositions to a Commissioner for examination, and an offer by such counsel to again produce the witnesses for cross-

examination, and a refusal to cross-examine them when produced, is not a waiver of notice. *Ibid.*

11. Affidavits on which to move for an enlargement of the time to take testimony in an interference, on the ground that the moving party could not obtain the attendance of his witnesses at the time appointed to take their examination, should state the names, competency, and materiality of the witnesses to be examined. *O'Reilly* v. *Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

12. Such an application is in the discretion of the Commissioner, and it will be presumed that his decision on it has been soundly exercised. *Ibid.*

13. Depositions taken on the part of A in an interference between the applications of A and B—the latter as assignee of C—may be read in evidence upon a second interference declared between such application of A and B, and a subsequent application of D, of whose application B was also the assignee, and the real party in interest—all such applications being in respect to the same subject. *McCormick* v. *Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

14. It would be unnecessarily oppressive to require the party, merely to gratify form, to take the testimony anew. *Ibid.*

15. Depositions cannot be taken before a magistrate or person who is the attorney or of counsel for either party, or interested in the event of the action. *Nichols* v. *Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

16. The rules of the Patent Office as to the taking of testimony, prescribed under § 12 of the act of 1839, are to be *just and reasonable*, according to the established principles and precedents in like cases. *Ibid.*

17. Where an interference has been declared between certain parties, and testimony taken, and then another application is made by another party, and he is made a party to the interference, but the subject matter of all the applications is the same, the testimony taken on the first interference may be used on the second, without being retaken. *Carter* v. *Carter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

18. It seems that testimony taken on a former interference is admissible on a second one, and this though the second interference is declared after an assignment to another party. *Eames* v. *Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

19. A second interference is only a rehearing of the same case. *Ibid.*

20. The rules and regulations of the Patent Office as to taking testimony in cases of interference, are binding upon the parties, and each is entitled to the benefits of them, and until abrogated, are as binding upon the Commissioner himself, as if enacted by the statute itself. *O'Hara* v. *Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

21. The rules of the Patent Office as to the taking of depositions, give to either of the litigant parties the right to take depositions, *without restraint*, up to the day of hearing fixed by the Patent Office, or to a day near enough to give time for the transmission of the evidence to the Patent Office. *Spear* v. *Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

22. The proceedings in the Patent Office in contested cases, have no resemblance to trials at law; a party cannot be compelled to examine all his wit-

nesses in chief before he closes his opening examination. *Ibid.*

23. The officer before whom testimony is taken, should stand indifferent between the parties, in no such relation to either of them as to bias him in favor of one more than the other; more especially he should not be interested in the questions at issue. *Collins* v. *White*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

24. A stockholder in a company cannot legally act as an officer to take depositions in an interference, in the result of which such company is interested. *Ibid.*

25. If objection is not made to the competency of a witness on his examination, and both parties examine him, it will be too late to raise the objection as to his competency, on appeal. *Allen* v. *Alter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

26. Where no notice of the taking of depositions has been given to the opposite party, but such opposite party or his counsel are present when they are taken, such depositions will not be excluded because of want of notice, and particularly if taken by consent of parties. *Walker* v. *Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

27. The object of notice is to bring the adverse party before the examining officer. Where the party attends before such officer, such notice is mere form, and technicality, which is covered by rule 90. *Ibid.*

## D. DECLARATIONS AND ACTS OF PARTIES AND THIRD PERSONS.

1. The declarations of a party, at a given time, that he had invented a machine afterward patented, and which he then described, may be received in evidence; but they are not proof that he was the inventor, but only that he said he was. *Evans* v. *Hettick*, 3 Wash., 410.—WASHINGTON, J.; Pa., 1818.

2. A witness cannot be called to testify as to what third parties may have stated as to an invention—such being mere hearsay evidence. The parties from whom the witness received the information should have been called. *Ibid.*, 414.

3. The letters of a party to the proper officer of the government applying for a patent for his invention, are admissible as evidence as to the fact of his being the inventor, on a suit brought under his patent. *Pettibone* v. *Derringer*, 4 Wash., 219.—WASHINGTON, J.; Pa., 1818.

4. The fact of making and exhibiting an article never before seen or heard of by the witnesses, is at least *prima facie* evidence of invention on the part of the maker, until other evidence is given to prove that the same article was invented, known, or in use, at a prior time, and that the patentee had only embodied the conceptions and ideas of some other persons. *Pennock* v. *Dialogue*, 4 Wash., 541.—WASHINGTON, J.; Pa., 1825.

5. But if the maker make no claim to being the original inventor, this fact may be opposed to such *prima facie* evidence, and from it may be urged the probability that he did no more than give form and substance to the invention of some other person. *Ibid.*, 542.

6. The testimony of a witness that he suggested an invention to a patentee, is in the nature of confessions, and this is always regarded as an uncertain kind of evidence. *Alden* v. *Dewey*, 1 Story, 339.—STORY, J.; Mass., 1840.

7. The declarations and conversations of a patentee, merely affirming that at some former period he invented that particular machine, are not admissible; but his declarations and conversations, stating that he had made an invention, and describing its details, and explaining its operations, are properly evidence of an assertion of his right, at that time, as an inventor, to the extent of the facts and details made known by him, though not of their existence at an antecedent date. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet., 462.—STORY, J.; Sup. Ct., 1840.

8. 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 fixes its origin, at least, as early as that period. *Ibid.*, 462.

9. The mere declaration of an inventor, that at a certain time he had made the invention, is not evidence. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

10. The declarations of a party, made before a dispute arose, and proving the existence of certain inventions in connection with certain acts before a particular date, may be received, as developing a link in a transaction. *Hovey* v. *Stevens*, 1 Wood. & Min., 292.—WOODBURY, J.; Mass., 1846.

11. In cases of interfering applications, the declarations of the parties themselves in their own favor, in the absence of each other, are not competent evidence for any purpose but to ascertain when and what they respectively claimed to have invented. *Atkinson* v. *Boardman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

12. The declarations of an agent in relation to a business to which his agency extended, are a part of the *res gestæ*, and bind the principal as if made by himself. *Aiken* v. *Bemis*, 3 Wood. & Min., 350, 355.—WOODBURY, J.; Mass., 1847.

13. On this ground, the admissions and declarations of a foreman of the defendant as to the number of articles made which were an infringement on the plaintiff's patent, were held admissible; but it should be made to appear that his agency extended to the particular business, and whether the declarations were made while he was engaged in it, and not afterward. *Ibid.*, 350, 355.

14. The declarations and admissions of an assignor of a patent, after he has parted with his interest in it, are inadmissible either to show a want of title in him, or to affect the quality of the article, or to impair the rights of the purchaser in any respect. *Many* v. *Jagger*, 1 Blatchf., 376.—NELSON, J.; N. Y., 1848.

15. Where in an action for the infringement, the defendant offered to show that one of the patentees of an article, after he had assigned all his interest in the patent, had declared that the thing patented had been abandoned, and had failed, and was worthless, *Held*, that such declarations were inadmissible. *Ibid.*, 376.

16. The declarations of a patentee who had parted with all his interest under the patent, that he had never completed his invention, is only hearsay evidence, and therefore not admissible; but if admissible, are not evidence which would disparage the right or title of those holding under him, without notice of the facts alleged in

such declarations. *Wilson* v. *Simpson*, 9 How., 121, 122.—WAYNE, J.; Sup. Ct., 1849.

17. The declarations of a party describing, at a particular time, an alleged invention, are admissible to show what he knew, or had invented at the time such declarations were made, provided they were made before a dispute or contest had arisen. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

18. The declarations of a third party in an interference that he was a part inventor, are admissible to show that neither of the applicants are entitled to a patent; but such declarations would not be evidence for such party in an application for himself. *Ibid.*

19. It seems that evidence as to the conversations and declarations of an inventor as to his invention, and which referred to a specimen or model of his invention which had been actually made by him, and which was in his possession at the time of such conversations and declarations, cannot be received without the production of such original model or specimen, or without its non-production being accounted for. *Richardson* v. *Hicks*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

20. Nor can an exhibit be introduced in evidence for the purpose of showing that it is like such original model or specimen, but the original must be produced, or its non-production accounted for. *Ibid.*

21. The conversations and declarations of a party as to an invention are evidence of his right at that time only to the extent of the facts and details which he then describes and makes known. *Garrett* v. *Davidson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

22. Admissions or declarations as to an invention made in a way of compromise, and without the admission of any particular facts, are not admissible as evidence; but if made voluntarily, without any pending negotiation, it seems they are admissible. *Gibbs* v. *Johnson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

23. The mere fact that a party is a witness to the application of another for a patent for a particular invention, does not estop such party from afterward claiming to be himself the original inventor of such invention. *Herring* v. *Leffingwell*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

24. It is competent for such party to show that he was deceived as to the character of the paper he was witnessing, and if his signature was obtained by misrepresentation it will be treated as if it had never been made. *Ibid.*

25. Where A, when acting as an agent to sell the patent of another, made an invention of his own in respect to the same article, but thinking that his agency was a bar to his making any effort to introduce his own, and being also poor, made an agreement with B to manufacture such invention and sell it as B's, and did so, representing it in certain places as B's invention, and B afterward applied for a patent for such invention, and set up that such representations estopped A from claiming the invention as his own; *Held*, that under the circumstances such representations of A would have only the effect to give, in such places, the same validity to such sales as if made in A's own name and no further, and did not preclude A from showing that he was in fact the original inventor over B, and

that as such he was entitled to a patent for the said invention. *Ibid.*

## E. Parol and Secondary Evidence.

1. The letters of a party when applying for a patent, are properly admissible in evidence in his own behalf. *Pettibone* v. *Derringer*, 4 Wash., 219.—Washington, J.; Pa., 1818.

2. In an action for infringement of a patent, the minutes of a company of which the plaintiffs were members, and at whose suggestion and expense the subject of the patent was claimed to have been invented, may be read in evidence to prove that the plaintiffs were not the original inventors of the thing patented; but not to show that the plaintiffs had surreptitiously obtained the patent for another's invention, unless notice of such defence and intention had been given to the plaintiffs. *Pennock* v. *Dialogue*, 4 Wash., 545.—Washington, J.; Pa., 1825.

3. But other entries in such book of minutes cannot be read by the plaintiffs to show that the company acknowledged the plaintiffs to be the inventors of the thing patented, the defendants in the suit not being members of such company. *Ibid.*, 545.

4. The books of a party are not evidence as to invention, unless called for by the other party, or their contents inquired of by him. *Stanley* v. *Whipple*, 2 McLean, 39.—McLean, J.; Ohio, 1839.

5. Parol evidence bearing upon written contracts, or papers in respect to patent interests, ought not to be admitted without the production of such contracts or papers to enable the court and jury to see whether the admission of the parol evidence will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet., 461.—Story, J.; Sup. Ct., 1840.

6. A letter of a third party, though sent under cover of one from the inventor to the Commissioner of Patents, is not evidence as to priority of invention. *Cochrane* v. *Waterman*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1844.

7. A deed or documentary exhibit, showing that a witness had parted with all his interest in an invention, may be allowed to be put in evidence in a suit after the general evidence has been published. *Nesmith* v. *Calvert*, 1 Wood. & Min., 42.—Woodbury, J.; Mass., 1845.

8. Parol evidence is not admissible to prove the contents of papers, as a letter and drawings, alleged to have been sent by mail to the plaintiff until proof is furnished to the court that they have been lost, or have gone into plaintiff's custody. If sent by mail they must be shown to have been received, particularly where the party to whom mailed denies on oath that they ever were received. *Allen* v. *Blunt*, 2 Wood. & Min., 130, 131.—Woodbury, J.; Mass., 1846.

9. The mere putting of letters in the post-office is not sufficient evidence of their being received, when such fact of reception is endeavored to be made a ground for the introduction of secondary evidence as to the contents of the letters so sent. *Ibid.*, 131,

10. Oral evidence of the intent and meaning of parties in explanation of a written instrument respecting a patent-right is wholly inadmissible; the agreement being in writing must speak for itself. *Troy Iron & Nail Fac.* v. *Cor-*

*ning*, 1 Blatchf., 472.—NELSON, J.; N. Y., 1849.

11. Certificates of manufacturers and others as to an invention, in order to be received and considered upon an application for a patent should be taken under oath. *Jillson* v. *Winsor*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

12. Copies of original memorandums and drawings are not admissible in evidence as confirmatory of the testimony of the party who made them (see 10 Pet., 438, 439); the originals might have been used to refresh the memory of the witness. *Jones* v. *Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

## F. PUBLIC RECORDS AND PAPERS; VERDICT.

1. An exemplification of a *specification* of a patent is made evidence by § 2 of the act of Congress of 1793. The exemplification of the *patent* itself stands upon the common law, as being an exemplification of a record of a public document, and is always to be received as evidence. *Peck* v. *Farrington*, 9 Wend., 44.—SAVAGE, Ch. J.; N. Y., 1832.

2. A certified copy of a patent, surrendered and cancelled, is admissible in evidence, to show that an improvement subsequently patented is not original, though it does not specify when it was cancelled, or how, or for what defect. *Delano* v. *Scott*, Gilpin, 496.—HOPKINSON, J.; Pa., 1834.

3. A former and defective certified copy of a patent may be corrected by another full and corrected certified copy, and the defective one cannot affect the one that is complete. *Brooks* v. *Bicknell*, 3 McLean, 434.—MCLEAN, J.; Ohio, 1844.

4. Certified copies of assignments of patents on record are competent evidence of the originals, and the production of the originals cannot be compelled. *Ibid.*, 436.

5. Papers or drawings on file in the Patent Office are public records, and certified copies of them must be received in evidence when offered. If they are discordant, one may destroy the effect of the other. But they need not concur in every particular. *Emerson* v. *Hogg*, 2 Blatchf., 12.—NELSON, BETTS, JJ.; N. Y., 1845.

6. A verdict upon an issue ordered by a court of equity is in no just sense final upon the facts it finds, or binding upon the judgment of the court, until a subsequent hearing upon its merits, and a decree rendered thereon by the court. *Allen* v. *Blunt*, 3 Story, 746.—STORY, J.; Mass., 1845.

7. Whether a verdict given in a suit at law is ever evidence of any thing but the fact that it was rendered, unless a judgment has been duly rendered thereon. *Ibid.*, 746.

8. If copies of a patent are erroneous, the Commissioner of Patents has the power, and ought to make them conform to the patent itself and to the record. *Woodworth* v. *Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

9. Whether original letters of the Commissioner of Patents, coming from a public officer, under an official oath, and on official business, are not legal and competent evidence in the light of a public record or document, as to the matters referred to therein; *query*. *Allen* v. *Blunt*, 2 Wood. & Min., 128, 129.—WOODBURY, J.; Mass., 1846.

10. A former verdict of dismissal between the same parties on an issue out

of chancery in a bill asking for an injunction, and upon an original specification, is not admissible in evidence in a suit at law for damages for violation of the patent, with corrected specifications, and in no case is such a verdict a bar to the second action, unless judgment was rendered on such verdict against the plaintiff, or such verdict of dismissal was on the merits. *Ibid.*, 132, 134.

11. A verdict in a patent case and sustaining a patent, can in no case be evidence at law or in equity, and in another action brought by a witness called by the plaintiff on the trial in the former action, and who was interested in the same patent, for the purpose of establishing his title to the patent, as it is a proceeding *inter aliis*. *Buck* v. *Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

12. But such verdict would be admissible on a motion for a provisional injunction, as affording strong evidence of the validity of the patent, and of his title. It is evidence, however, only in cases where his own deposition would be competent; cases in which the application is to the sound discretion of the court. *Ibid.*, 324, 325.

13. Certified copies of papers in the Patent Office must be received as *prima facie* evidence of the genuineness of the originals on file, and absolute evidence of the correctness of the copies from the record. *Parker* v. *Haworth*, 4 McLean, 371.—McLEAN, J.; Ill., 1848.

14. The rendition of a verdict in a patent case in favor of a plaintiff is not conclusive upon the right of such party to an injunction. *Many* v. *Sizer*, 1 Fisher, 43.—WOODBURY, SPRAGUE, JJ.; Mass., 1849.

15. Where a patentee and his assignee brought a suit in equity, in the Circuit Court in Louisiana, under § 16 of the act of 1836, against a junior patentee, to declare such junior patent void, on the ground of its interference with the plaintiffs' patent; and afterward the same plaintiffs brought an action at law in another circuit for an infringement of their patent, against a party who was not a party to the suit in Louisiana, but who had obtained an interest in the junior patent, sought to be set aside by that suit, after the commencement of that suit and before judgment rendered therein; *Held*, that the parties to such suit at law were within the proviso of said § 16, and that their rights would be bound by a decision in the suit in Louisiana, declaring that such patents interfered, or that either of them was valid or invalid. *Tyler* v. *Hyde*, 2 Blatchf., 309, 312.—BETTS, J.; N. Y., 1851.

16. A certified copy from the Patent Office of an assignment recorded therein, will be received as *prima facie* evidence of the genuineness of the original assignment, and the production of the original may be dispensed with. *Parker* v. *Bigler*, MS.—GRIER, J.; Pa., 1857.

17. A certified copy of an assignment of a patent from the Patent Office of the United States, is *prima facie* evidence of the genuineness of the original. *Lee* v. *Blandy*, 2 Fisher, 91.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

## G. WITNESS.

### 1. *Competency and Credit of.*

See also EXPERTS; EVIDENCE, G. 3.

#### *a.* Of Witnesses generally.

1. When a witness offered in a patent suit is sworn on his *voir dire*, no evidence can be given to prove him to be

incompetent, except such as arises from his own acknowledgment. But if it should, in any subsequent stage of the examination, appear by other evidence that he is not a competent witness, the court will set him aside. *Evans* v. *Eaton*, Pet. C. C., 338.—WASHINGTON, J.; Pa., 1816.

2. A person was offered as a witness in behalf of a defendant, in an action for the infringement of a patent, such person being also a defendant in another suit brought for an infringement of the same patent, and such witness had also contributed, with other defendants, to defray his expenses in attending the trial, where he was called as a witness, but there was no agreement between the contributors as to damages or costs. *Held*, that the witness had no interest that was dependent on the event of the suit, and that he was therefore competent. *Evans* v. *Hettick*, 3 Wash., 412, 413.—WASHINGTON, J.; Pa., 1818. [Affirmed 1822, *post* 7.]

3. It is for the jury to say, what credit is to be given to the testimony of opposing witnesses, in determining which, they must take into calculation every circumstance affecting their veracity, whether it concern their moral character, or arise from interest or from feeling favorable to either party. *Ibid.*, 423, 424.

4. Where a fact in controversy may exist, without a violation of probability, and the proof is by witnesses exclusively on one side, there is nothing against which to weigh their credit; if an objection to their credit be worth any thing, it must be to the full extent of rejecting their testimony. The jury cannot compromise the matter. They must decide that the fact is so or is not so. *Ibid.*, 424.

5. A person having an interest only in the question, and not in the event of a patent-suit, is a competent witness. *Evans* v. *Eaton*, 7 Wheat., 425.—STORY, J.; Sup. Ct., 1822.

6. In general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and will not exclude the witness. *Ibid.*, 425.

7. It is no objection to the competency of a witness, that he is sued in another action for an infringement of the same patent. *Evans* v. *Hettick*, 7 Wheat., 468.—STORY, J.; Sup. Ct., 1822.

8. In an action for an infringement, the defendant, to prove that the plaintiff was not the original inventor of the thing patented, gave in evidence a prior patent for an alleged similar machine as that of plaintiff, and then offered the patentee of such prior patent as a witness to prove the priority of his invention, *Held*, that the witness was competent, as he had no interest in the event of the suit. *Treadwell* v. *Bladen*, 4 Wash., 704.—WASHINGTON, J.; Pa., 1827.

9. A workman employed by a person to make articles which are alleged to infringe a patent, is a competent witness to prove such making, as he is not liable, as such workman, to an action for infringement. *Delano* v. *Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

10. If a witness is interested, he is excluded, however small the amount of his interest may be. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

11. But where the interest of the witness in the patent applied for was

the same, whether the patent should be granted to one applicant or to the other, *Held*, that he was a competent witness. *Ibid.*

12. By an agreement of parties, the testimony of witnesses otherwise incompetent may be received and considered. *Warner* v. *Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

13. The fact that a person called as a witness in behalf of the plaintiff is interested in the same patent on which suit is brought, but in other sections of the country, but none in the county where the plaintiff's right is, does not render him an incompetent witness for the plaintiff. *Buck* v. *Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

14. The usual test of the interest of a witness is, whether he is interested in the event of the suit or issue—whether he is to lose or gain by the event—that is, whether he has interest, legal or equitable (if real), which will be secured or continued to him in the event of the success, or lost, in the event of the non-success of the party in whose favor he is called. *Cresler* v. *Custer*, MS. (App. Cas.)—MORSELL, J.; D. C., 1353.

15. Therefore an assignee of an interest in an invention is not a competent witness for the inventor, in an interference on an application for a patent for such invention, such assignee using such improvement with the consent of the inventor and the assignee, regarding that he had bought it. *Ibid.*

16. The presumption of law is that a witness on oath testifies honestly, until the contrary is shown. Credit ought to be given to his testimony, unless it is so grossly improbable as to show that he is not to be trusted. *N. E. Screw Co.*, v. *Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

17. Contradictions and inconsistencies in the testimony of a witness, it not appearing that they proceeded from corrupt motives, and the witness standing unimpeached by extrinsic circumstances, may lessen, but will not entirely destroy his testimony. *Ibid.*

18. The mistake of a witness as to an immaterial fact, as for example who were present at a particular conversation, will not discredit him. The maxim, *falsum in uno, falsum in omnibus*, does not apply. That can only apply where there is wilful, corrupt falsehood in one particular, amounting to perjury, in which case all the other testimony of the witness is to be rejected. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

19. The testimony of a witness, directly or indirectly interested in the patent, or its benefits, is not admissible, in an interference, as to the question of priority of invention. *Ibid.*

20. In considering testimony, weight should be given to it in proportion to the competency of the witness to judge of the matters sworn to. *Allen* v. *Hunter*, 6 McLean, 310, 312.—MCLEAN, J.; Ohio, 1855.

21. The refusal of a witness to answer on his cross-examination, questions which are material and proper, will affect the credit of his testimony. *Cornell* v. *Hyatt*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

22. Where a witness in other respects stands fair and free of suspicion, his statement under oath as to the fact of invention, will not be rejected because he may have made contradictory statements elsewhere; but where the relation in which he stands to the cause is

such as to make it reasonable to suppose he is under a strong bias in favor of one of the parties, the rule is different, especially when he testifies as to things taking place when no one else was present. *Sanders* v. *Parsons*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

23. If objection is not made to the competency of a witness on his examination, and both parties examine him, it will be too late to take the objection afterward. *Allen* v. *Alter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

*b.* Of Assignor of Invention in Interferences.

1. A person who is nominally a party to the proceeding in an application for a patent, cannot be a witness in such case, even though he has parted with all his interest in the matter. *Yearsley* v. *White*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

2. Where, therefore, one of two joint inventors was called as a witness in a case of interference, between such joint inventors, and that of another party, *Held*, notwithstanding that he had assigned all his interest in the invention, that he was not a competent witness. *Ibid.*

3. An inventor who had assigned all his interest in the invention to another, was offered as a witness in favor of his assiguee, upon an interference, to prove priority of invention, and was objected to as being interested, *Held*, although he was not affected by pecuniary interest or advantage to render him incompetent, yet he must in the nature of things be supposed to view most favorably the success of his assignee, and to feel a prejudice against the other side. *O'Rielly* v. *Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. In an interference, a party to the proceeding, as an inventor, cannot be made a witness, even though he has assigned all his interest in his invention to another. *Hill* v. *Dunklee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

5. In an interference case, the testimony of the inventor himself, though he has assigned his invention, cannot be received—he is in form and substance a party to the issue. *Eames* v. *Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

6. The testimony of a party to the record, as of an inventor, though he had actually transferred all his interest in the invention, is not admissible upon an interference. *Gibbs* v. *Johnson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

7. The assignor who has sold his invention, is not competent as a witness for his assignee, to prove priority of invention, upon an interference declared. *Barstow* v. *Swan*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

2. *Examination and Impeachment of.*

1. A witness cannot be asked as to a mere collateral fact, having no relevancy to the issue, in order to draw from him an answer which might, by other evidence, be shown incorrect, and thereby to discredit him. *Odiorne* v. *Winkley*, 2 Gall., 53.—STORY, J.; Mass., 1814.

2. Evidence to discredit a witness of the opposite party, cannot be introduced if the court consider that it cannot have such an effect. *Evans* v. *Eaton*, Pet., C. C., 338.—WASHINGTON, J.; Pa., 1816.

3. Plaintiff's counsel cannot inquire of a witness, whether third persons had offered to take a licence from the plaintiff, for the use of his invention, and pay

for the same, it not having been proved that such persons had used an invention similar to plaintiff's. *Evans* v. *Hettick*, 3 Wash., 413.—WASHINGTON, J.; Pa., 1818.

4. A witness cannot be called to testify as to what third parties may have stated, as to an invention, such being mere hearsay evidence. The parties from whom the witness received the information should have been called. *Ibid.*, 414.

5. Plaintiffs' counsel cannot inquire of witnesses as to acts between plaintiffs and third persons or strangers as to his patent; these ought not to prejudice the defendant. *Evans* v. *Hettick*, 7 Wheat., 469, 470.—STORY, J.; Sup. Ct., 1822.

6. It is incumbent upon those insisting 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; and they are not afterward at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose, not then suggested to the court. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet., 460.—STORY, J.; Sup. Ct., 1840.

7. A party cannot cross-examine a 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. *Ibid.*, 461.

8. If a party is called to prove a fact, as to which he is a competent witness—as the loss of a paper or drawing—and is then cross-examined by the opposing counsel, at large, as if he were a competent witness in chief, his answers are thereby made evidence for himself. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

9. The law gives no color to the practice which not unfrequently appears in judicial proceedings, of besetting a witness with impertinent inquiries, which are not shown to have any legitimate bearing upon the case. *Day* v. *Bost. Belting Co.*, MS.—BETTS, J.; N. Y., 1854.

10. Whether a witness may claim exemption from answering a question, because his knowledge of the matter inquired of was obtained by him as an attorney in such character; *query*. *Ibid.*

11. Whether under any circumstances a witness has a right to refuse to answer a question, on the ground that it would expose his private affairs; *query*. Such a right cannot, however, be claimed, if the witness on his direct examination has referred to the matter inquired of on his cross-examination. *Nichols* v. *Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

12. Upon the cross-examination of a witness, it is not necessary for the party examining him to state the purpose of any particular question, as such rule might defeat the very object had in view by such party. *Ibid.*

13. Upon the re-examination of a witness, it is only proper to question him as to the things inquired of him on his cross-examination; the party re-examining him has no right to go further, and introduce new matter. The witness cannot be examined as to new matter, or substantially on the points he has before been examined upon. *Hill* v. *Dunklee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

3. *Parties, Examination of.*

See also EVIDENCE, G. 1. *a.*

1. A party to an interference is competent to prove the loss of a paper or drawing of his invention. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

2. As a general rule, a party cannot be a witness in his own cause. *Buck* v. *Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

3. Nor will he be permitted to avail himself, by indirect means, of evidence which would be rejected as incompetent if offered directly. *Ibid.*, 324.

4. A party to an interference is a competent witness to prove the loss of a paper, if lost out of his own possession, and not destroyed by fraud, the existence and contents of such paper being proved by other testimony. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. If two persons, from their relationship to each other, have had access to such paper, they should both join in the deposition as to its loss. *Ibid.*

6. Upon a reference to a master, in an equity suit for the infringement of a patent, to take an account, a defendant cannot be examined as a witness in his own favor, if objected to by the plaintiff. *Foote* v. *Silsby*, 3 Blatchf., 508.—HALL, J.; N. Y., 1856.

7. Nor can a defendant be so examined on his own behalf by his own counsel, even though he has been called and examined as a witness by the plaintiff, or was sworn by the master upon the plaintiff's application. *Ibid*, 510.

8. In an action for an invasion of plaintiff's trade-mark, the plaintiff is not privileged from answering a question which may reveal the *secret* of his trade, as such a question may be pertinent to the issue in determining the amount of profits. *Burnett* v. *Phalon*, 19 How. Pr., 531, 532, 535, 536.—HOFFMAN, J.; N. Y., 1860.

9. A defendant cannot be required to testify whether he has used labels or trade-marks like the plaintiff's, if his affirmative answers thereto may tend to convict the witness of an offence punishable by statute. *Byass* v. *Sullivan*, 21 How. Pr., 52.—BONNEY, J.; N. Y., 1860.

10. Where a state law made it a misdemeanor to vend goods with a forged label, *Held*, that the defendant could not be required to testify whether he had sold goods with a label like that of the plaintiff's. *Ibid.*, 52.

11. The judiciary act of September 1789, § 34 (1 Stat. at Large, p. 92), adopting the laws of the several states as rules of decisions in the courts of the United States, embraces laws relating to evidence. *Haussknecht* v. *Claypool*, 1 Black, 431.—NELSON, J.; Sup. Ct., 1861.

12. Where, therefore, under the laws of any state, parties may be examined as witnesses in their own behalf, a plaintiff, in an action in the United States courts, for infringement of his patent, is a competent witness as to the issues raised therein. *Ibid.*, 431.

13. A like decision was also made in *Vance* v. *Campbell*, 1 Black, 427.—NELSON, J.; Sup. Ct., 1861.

## H. As to Particular Issues.

1. *Abandonment.*

See also ABANDONMENT, B.

1. If, before a patent is taken out, the inventor looks on and sees his invention

going into general use, without objection on his part, the court will treat his conduct as equivalent to an abandonment or transfer of his exclusive right to the public. *Treadwell* v. *Bladen*, 4 Wash., 708.—WASHINGTON, J.; Pa., 1827.

2. The question of abandonment does not turn upon the intention of the inventor. Whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent, obtained under such circumstances, protect his right. *Shaw* v. *Cooper*, 7 Pet., 323. MCLEAN, J.; Sup. Ct., 1833.

3. There must be evidence of a distinct character as to abandonment, showing such an intention. The natural presumption is, that a person who has invented a machine would not give it to the world. *Hovey* v. *Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

4. Where it was alleged that a patentee had abandoned his invention, and the lapse of time between the grant of the patent and the commencement of suit was urged as a proof of that fact, *Held*, that the plaintiff was entitled to rebut any presumption of abandonment by showing acts prosecuting or asserting his discovery. *Emerson* v. *Hogg*, 2 Blatchf., 12, 13.—BETTS, J.; N. Y., 1845.

5. Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during his application for a patent, is an abandonment, or such a use as gives it to the public. The inventor may do this without vitiating his claim. *Sparkman* v. *Higgins*, 1 Blatchf., 209.—BETTS, J.; N. Y., 1846.

6. Whether the sale and manufacture for some few months before the application for a patent, of an article, as an ornamental button, for the design of which letters patent had been granted, and which design was apparent on the article itself, would amount to an abandonment, is a question of fact to be settled by the jury. *Booth* v. *Garelly*, 1 Blatchf., 249, 250.—NELSON, J.; N.Y., 1847.

7. Where experiments as to an invention were imperfect and unsatisfactory, and subsequently the inventor threw aside his temporary model, and wholly neglected for years to follow up his experiments, so as to produce a perfect machine, *Held*, that such acts afforded strong and decisive evidence of an abandonment of the thing as a failure. *Parkhurst* v. *Kinsman*, 1 Blatchf., 494. —NELSON, J.; N. Y., 1849.

8. Abandonment or dedication is in the nature of a forfeiture of a right which the law does not favor, and it should be made out beyond all reasonable doubt. *Pitts* v. *Hall*, 2 Blatchf., 238.—NELSON, J.; N. Y., 1851.

9. Those who rely upon the ground that a party has forfeited 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 a party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. *McCormick* v. *Seymour*, 2 Blatchf., 256.—NELSON, J.; N. Y., June, 1851; S. C., MS., Oct., 1851.

10. The question of abandonment must always depend in a great measure on the peculiar nature of the subject

matter. The mere sale of a peculiar manufacture—as vulcanized rubber—which does not, on its face, disclose the nature of the compound, or the mode of producing it, is not such an abandonment. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

11. A patentee, subsequent to his patent, may abandon his invention to the public, and waive the exclusive privileges secured to him; and the jury may infer such an abandonment from an acquiescence in the use of his invention by others—a neglect to assert his claims by suit or otherwise, an omission to sell licenses, a neglect to make efforts to realize any advantage from his patent, and similar circumstances. *Ransom* v. *Mayor, &c.*, 1 Fisher, 273.—HALL, J.; N. Y., 1856.

### 2. *Fraudulent Intent.*

1. The degree of evidence required to prove a fraudulent intent in a defective specification rests with the jury. Positive evidence is not necessary. The intention may be presumed from circumstances—as 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. But such a presumption would be weakened by the testimony of skilful persons that they could not hesitate in supplying the omissions. *Gray* v. *James*, Pet. C. C., 402.—WASHINGTON, J.; Pa., 1817.

2. Under the act of 1793, if a defendant seeks to annul the patent, he must proceed in precise conformity to § 6, and fraudulent intent "must be found by the jury to justify a judgment of *vocatur* by the court." The evidence of fraudulent intent is required only in the particular case and for the particular purpose stated in § 6. *Grant* v. *Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. Under § 9 of the act of 1837, declaring a patent valid, though embracing something not the invention of the patentee, if such excess has been inserted in the specification by mistake, and without any fraudulent intent, the patentee is not bound to prove affirmatively that such excess was inserted by mistake, and without a fraudulent intent, as the law presumes no one to have acted illegally or fraudulently. *Hotchkiss* v. *Oliver*, 5 Denio, 318.—MCKISSOCK, J.; N. Y., 1848.

4. The party charging the wrong and attacking the patent, is bound to prove the fraud, &c. *Ibid.*, 318.

### 3. *Infringement.*

See also COMBINATION, B.; COMPOSITION OF MATTER, C.; INFRINGEMENT.

1. In an action for the infringement of a patent testimony is not admissible on the part of the plaintiff, that the persons of whose prior use defendant had given evidence, had taken licenses from the plaintiff. *Evans v. Eaton*, Pet. C. C., 323.—WASHINGTON, J.; Pa., 1816. [Overruled, *post* 2.]

2. It is competent for the plaintiff to introduce testimony to show that the persons, of whose prior use of the machine defendant had given evidence, had paid the patentee for licenses to use his machine, though such testimony is entitled to but little weight. *Evans* v. *Eaton*, 3 Wheat., 505.—MARSHALL, C. J.; Sup. Ct., 1818.

3. In an action for infringement of a patent, evidence is not admissible on the part of the patentee that third persons had offered to take licenses of him, it not having been shown that such person used a machine similar to that of the patentee. *Evans* v. *Hettick*, 3 Wash., 413.—WASHINGTON, J.; Pa., 1818.

4. Under the plea by the defendant of not guilty, the plaintiff must prove not merely that the defendant had made, used, or sold an article of the same general nature with his patented invention, but that it substantially resembled the one for which he had so obtained a patent. But if the difference between them be only in form, or proportions, they are the same in legal contemplation. *Dixon* v. *Moyer*, 4 Wash., 71.—WASHINGTON, J.; Pa., 1821.

5. The plaintiff must show that the infringement took place after the time of his application, or the date of his patent. But if the defendant attempts to avoid the patent by showing that the patentee was not the original discoverer of the thing patented, the patent will be considered as reverting back to the time of the original discovery. *Ibid.*, 72.

6. In an action for an infringement of a patent, evidence that the invention of the defendant is better than that of the plaintiff is inadmissible, except so far as it goes to show a substantial difference between the two. *Alden* v. *Dewey*, 1 Story, 337.—STORY, J.; Mass., 1840.

7. To show an infringement by the defendant the proof rests upon the plaintiff. *Brooks* v. *Bicknell*, 3 McLean, 453.—MCLEAN, J.; Ohio, 1844.

8. To show an infringement, the burden of proof is upon the plaintiff. To maintain his case he must show that there has been a substantial invasion of his patent by the defendant. *Washburn* v. *Gould*, 3 Story, 146.—STORY, J.; Mass., 1844.

9. Where a plaintiff has made out a *prima facie* case of infringement, and the defendant undertakes to make out a special defence, as that the invention had been used at different places before plaintiff's invention, it is proper to instruct the jury that the defendant, in respect to these particulars, must render them probable, and must turn the scales in his favor. *Allen* v. *Blunt*, 2 Wood. & Min., 145.—WOODBURY, J.; Mass., 1846.

10. In order to make out the fact of infringement, the plaintiff must prove that the defendant has used his invention, either in the precise form in which it is constructed, or in a form and on principles substantially the same. *Parker* v. *Stiles*, 5 McLean, 62.—LEAVITT, J.; Ohio, 1849.

11. It is not, however, necessary that the structure or machine used by the defendant should be the same in appearance, form, or proportions, as that invented and patented by the plaintiff. If the operative principles of the two machines be the same, the substantial identity contemplated by the patent law is established. *Ibid.*, 62, 63.

12. Where the defence that a machine claimed to be essentially similar to that of the plaintiff's is set up, and the proof relied on is a description of such machine, contained in a written publication, such description must be sufficiently full and precise to enable a mechanic to construct it, and must be in all material respects like that covered by, or described in the plaintiff's patent. Proof of a previous structure, bearing some re-

semblance in some respects to the plaintiff's improvements, and which might have been suggestive of ideas, or led to experiments resulting in the discovery and completion of his invention, will not invalidate his patent. *Parker* v. *Stiles*, 5 McLean, 61, 62.—LEAVITT, J.; Ohio, 1849.

13. The burden of proof is upon the plaintiff to show that there has been an infringement. *Johnson* v. *Root*, 1 Fisher, 364.—SPRAGUE, J.; Mass., 1858.

14. It is incumbent upon the plaintiff in an action for an infringement of a patent to make out affirmatively to the satisfaction of the jury that his invention has been infringed, before he is entitled to a verdict. *Judson* v. *Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

### 4. *Invention; and Originality and Priority of.*

1. The declarations of an inventor, at a particular time, that he had discovered and constructed the machine patented, and the parts of which he then described are admissible to prove, not that he was the discoverer, but that he then asserted that he was, and described his invention. *Evans* v. *Hettick*, 3 Wash., 410.—WASHINGTON, J.; Pa., 1818.

2. In an action of infringement letters of the plaintiff to the Patent Office, containing his application for a patent, and enclosing a specification substantially agreeing with his patent afterward issued, and asserting his claim as inventor to the invention described, are properly admissible in evidence to show the existence of such facts. *Pettibone* v. *Derringer*, 4 Wash., 216, 219.—WASHINGTON, J.; Pa., 1818.

3. In an action for a violation of plaintiff's patent, proof that the plaintiff at a certain time had made the thing patented, and which had never before been seen or heard of by the witnesses, is *prima facie* evidence that it was invented by the patentee, until other evidence is given to show it had been previously known. *Pennock* v. *Dialogue*, 4 Wash. 541.—WASHINGTON, J.; Pa., 1825.

4. The silence, however, of such party as to his claim of original invention at such time may be opposed to such evidence, but whether it will be sufficient to outweigh it, the jury are to decide *Ibid.*, 542.

5. The testimony of a witness that he had seen before plaintiff's invention articles resembling those produced by plaintiff's invention, but had no knowledge how they were made, is not sufficient evidence to invalidate plaintiff's patent, on the ground that he was not the original discoverer of the invention, or that the same had been in use before his invention, unless the jury can safely conclude from the appearance of such articles that they were made by an instrument having the improvement, or embodying the principle of plaintiff's patent. *Treadwell* v. *Bladen*, 4 Wash., 706 —WASHINGTON, J.; Pa., 1827.

6. The priority of knowledge and use of an invention is a question of fact, which a jury may decide from one witness; the question is on the credibility and not on the number of witnesses. *Whitney* v. *Emmett*, Bald., 310.—BALDWIN, J.; Pa., 1831.

7. In considering the question of originality the oath of the inventor, made prior to the issue of the letters patent, that he was the first inventor of the thing patented, may be opposed to the oath of a witness, offered to show that the invention was not original. *Alden*

v. *Dewey*, 1 Story, 339, 341.—STORY, J.; Mass., 1840.

8. The declarations and conversations of a patentee, stating that he had made an invention, and describing it and its operations, are evidence of an assertion of his right at that time to the extent of the details made known by him, though not of their existence at any former period. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet., 462.—STORY, J.; Sup. Ct., 1840.

9. The declaration of a party that at a certain time he had invented a certain thing is not evidence. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

10. Upon the question of priority of invention, it is for the defendant to show beyond a reasonable doubt that there was a prior invention, because the plaintiff has a right to rest upon his patent for his invention till its validity is overthrown. If there is a reasonable doubt as to the priority of invention, the patentee is entitled to the benefit of it. *Washburn* v. *Gould*, 3 Story, 142.—STORY, J.; Mass., 1844.

11. The time of the invention of an improvement to a machine must necessarily precede the time when the invention is applied to a machine in operation. *Cundell* v. *Parkhurst*, MS. (App. Cas.) —CRANCH, Ch. J.; D. C., 1847.

12. Priority of application for a patent does not decide priority of invention. *Perry* v. *Cornell*, MS. (App. Cas.) —CRANCH, Ch. J.; D. C., 1847.

13. In a question as to the originality of an invention, where one party has a patent, the proof of want of originality must be specific and decisive to overthrow such patent. *Troy Iron & Nail Fac.* v. *Corning*, 1 Blatchf., 472.—NELSON, J.; N. Y., 1849.

14. When a dispute arises as to priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent at that time. *Parker* v. *Hulme*, 7 West. Law Jour., 424. —KANE, J.; Pa., 1849.

15. Where the patentee discovered, in 1827, that to direct water into a reaction wheel so as to give it circular motion within the wheel in the direction of its rotation, would increase the useful effect, and the application then was to a horizontal wheel, and after, in 1828, an application of this principle was made to a vertical wheel, and the latter arrangement was the one patented, *Held*, that if the difference of time had been material, the discovery of the more important part of the patented improvements would have been referred to the date of 1827. *Ibid.*, 424.

16. Dates in an account book, in which was made a drawing of an invention, are not conclusive evidence that the invention was made at the time of such dates. *Jillson* v. *Winser*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

17. Proof that a drawing of an invention was shown by A at a certain time *before*, as to which, however, the witnesses were not positive, but without any model, and without proof that any articles were manufactured until long *after* the well established invention of the same thing by B, is not sufficient to establish priority of invention in A. *Ibid.*

18. A defendant in a patent suit, using a machine patented to him will have the benefit of a like presumption in his favor, as to the originality of his invention, as the plaintiff has by reason

of his patent. *Corning* v. *Burden*, 15 How., 271.—GRIER, J.; Sup. Ct., 1853.

19. A witness to prove priority of invention need not be an expert—it will be sufficient if he has knowledge and memory to enable him to state truly what he had seen and heard. *N. E. Screw Co.* v. *Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

20. As respects the subjects of novelty and invention, the difference between the English and American cases relates rather to the kind and degree of evidence by which these may be shown or established. *Yearsley*, v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

21. The English cases hold that the *result alone*, when the effects produced are more economical, useful, and beneficial, or a better article, is a conclusive test of novelty and invention; while the American cases go to show that the *result* alone will not be sufficient, but it must appear that the effect was produced by some new process, device, machinery, &c., though where an improved result or effect is produced, slight evidence only of novelty and invention will be required. *Ibid.*

22. But slight evidence of invention is required when it is shown in what the invention consists, and proof is given of its practical utility, this being the main and principal test. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

23. The measure of proof requisite to show the date of an invention, depends upon the nature of the invention, whether complicated or not, the capacity of the witnesses, the distance of time when the facts occurred. *Stephens* v. *Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

24. Verbal descriptions, without models or drawings, may be sufficient for such purpose. *Ibid.*

25. The patent is *prima facie* evidence that the plaintiff was the first and original inventor of the improvement claimed, and of its utility. *Winans* v. *N. Y. & Harlem R. R.*, 31 Jour. Fr. Inst. (3d Ser.), 320.—NELSON, J.; N. Y., 1855.

26. A caveat is evidence as to an invention, so far as it extends to the *description* of the invention, and the machinery which was then constructed. *Jones* v. *Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

27. A patent is *prima facie* evidence of the facts of first and original invention and utility, and must prevail, unless there is other evidence to overcome such *prima facie* presumption; and where there has been a renewal, such renewal is also *prima facie* evidence as to such matters, and of course adds weight to the *prima facie* evidence furnished by the original patent. *Ransom* v. *Mayor &c.*, 1 Fisher, 258.—HALL, J.; N. Y., 1856.

28. The patent raises a presumption of the originality of the invention. *Bell* v. *Daniels*, 1 Fisher, 375.—LEAVITT, J.; Ohio, 1858.

29. The question of priority of invention is for the jury to determine. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

30. The patent is *prima facie* evidence that the patentee is the first and original inventor of the improvements described. *Cahoon* v. *Ring*, 1 Fisher, 403.—CLIFFORD, J.; Me., 1859.

31. Where original drawings of an invention were made, they are the best evidence of such invention, and on the non-production of them, unless le-

gally accounted for as by being lost, the legal presumption is, that if produced they would show the facts to be unfavorable. *Beech* v. *Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

32. The *prima facie* force of a patent, as to priority of invention on the part of the patentee, when once destroyed by evidence of prior invention on the part of another, cannot be restored by the patent itself, but only by specific testimony from witnesses. *Barstow* v. *Swan*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

33. Time, as to an invention, cannot, any more than a straight line be measured by the senses, by regarding its continuity, but is fixed in the memory by the relation or succession of events. When, therefore, a person can affirm that he can and does recall the succession of an event to another, which other is susceptible of independent ascertainment, the certainty of the latter is fully reflected upon the former. *Sherwood* v. *Sherman*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

34. It is not proof of the want of originality or novelty in an invention for which an American citizen has obtained a patent, that it may have been known or used in a foreign country, unless it appears that the invention or improvement was patented in such foreign country, or there described in some public work. *Judson* v. *Cope*, 1 Fisher, 623.—LEAVITT, J.; Ohio, 1860.

35. But to make such a defence available, it must appear that the improvement which has been known in a foreign country has been so clearly and intelligibly described, that the invention could be made or constructed by a competent mechanic. A mere suggestion or imperfect description of an invention would not be sufficient to defeat the American patent. *Ibid.*, 623.

36. Evidence cannot be received of actual use and knowledge of an invention in a foreign country, prior to the time of the invention here, in order to defeat the American patent, but the defendants must be confined to the description of the invention as found in printed publications or patents; they cannot go beyond such publication or patents, because no prior use abroad, unless the invention has been described in a printed publication or has been patented, will affect the validity of the patent in this country. *Ibid.*, 617–18.

37. The mere fact that a party is a witness to the application of another for a patent for a particular invention, does not estop such party from afterward claiming to be himself the original inventor of such invention. *Herring* v. *Leffingwell*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

38. It is competent for such party to show that he was deceived as to the character of the paper he was witnessing, and if his signature was obtained by misrepresentation it will be treated as if it had never been made. *Ibid.*

## 5. *Invention, Novelty and Utility of.*

1. Whether an invention is new or not is a question for the jury. *Park* v. *Little*, 3 Wash., 197.—WASHINGTON, J.; Pa., 1813.

2. Of the novelty and utility of an invention the patent is to be considered only as *prima facie* evidence of a very slight nature. *Lowell* v. *Lewis*, 1 Mas., 185.—STORY, J.; Mass., 1817.

3. Where it becomes a matter of inquiry whether the benefits of an invention are of sufficient consequence to be

protected, it is proper to leave the question of utility to the jury. *Langdon* v. *De Groot*, 1 Paine, 204.—LIVINGSTON, J.; N. Y., 1822.

4. But when the invention on the plaintiff's own showing is not only of no use, but an imposition on the public, it may be doubted whether a court would transcend its powers to consider and decide upon the question of utility as matter of law. *Ibid.*, 204.

5. Where the defendant had advertised the plaintiff's invention as one of the most useful, and had published certificates of its great utility, *Held*, in an action of infringement against him, that he could not deny the utility of the invention, and that it was unnecessary for the plaintiff to introduce evidence other than such admissions. *Stanley* v. *Whipple*, 2 McLean, 39.—McLEAN, J.; Ohio, 1839.

6. To determine whether an invention is new, the jury may inquire whether the machines had been extensively built and used, or whether they had been tried and thrown away; and if they had been extensively used, whether this could happen if their mode of operation was not new. *Davoll* v. *Brown*, 3 West. Law Jour., 151.—WOODBURY, J.; Mass., 1845.

7. The presumption of novelty and usefulness, arising from the *prima facie* character of the patent, may be rebutted by affidavits, on the application for an injunction where the patent is not ancient. *Query*, Whether it may be when the patent has been (reissued) renewed under the act of 1836. *Wickershaff* v. *Jones*, 2 Wharton's Dig., 413.—KANE, J.; Pa., 1848.

8. The oath of the patentee, required upon his application for a patent, constitutes a part of the letters patent, and is in evidence to a jury, and forms a legal ground for the presumption of the novelty and utility of the patentee's claim until the contrary is proved; the burden of proof being on the defendant. *Parker* v. *Stiles*, 5 McLean, 60.—LEAVITT, J.; Ohio, 1849.

9. It is the province of the court to decide what constitutes novelty, and of the jury to determine from the evidence adduced, whether the patentee's invention is new. *Ibid.*, 60.

10. An invention must be to some extent useful. But courts are not rigid or strict on this point. In the absence of proof by the defendant, that the thing patented is absolutely frivolous and worthless, the presumption of utility raised by the patent itself is sufficient to sustain the patent. *Ibid.*, 62.

11. Where in an action for an infringement of plaintiff's patent, it was proved that a machine was constructed before the plaintiff's invention, and identical with it, for a person who lived some distance from the place of construction, and was taken away by him to be put up, and was never afterward seen by the witness, who assisted in its construction, *Held*, that the evidence, if believed, was sufficient to establish the fact of a want of novelty in the plaintiff's invention, though there was no proof to show that the prior machine was ever used. *Parker* v. *Ferguson*, 1 Blatchf., 408.—NELSON, J.; N. Y., 1849.

12. A patentee took a patent for a new process, mode, or method of converting puddler's balls into blooms in rolling mills, which consisted in rolling the ball between reciprocating plates or tables, or between a revolving cylinder, and a stationary curvedsegmental trough. Evidence was given of previ-

ous use of machines for milling and condensing the edges of coin and buttons, precisely like plaintiff's reciprocating tables, and also of other machines for similar uses; and of a machine for making bullets by pressure, which were like the revolving cylinder and curved segmental trough of plaintiff, except that the peripheries of both were grooved; *Held*, that such machines for making bullets and milling buttons and coin did not show a want of novelty in the patentee, because the process used in them, the purpose for which it was used, and the objects accomplished, were substantially different. *Burden* v. *Corning*, MS.—CONKLING, J.; N. Y., 1850.

13. The opinion of experts or scientific and practical men, as to the comparative merits of two inventions, cannot affect the question of their novelty. *Winslow, Ex parte*, MS. (App. Cas.) —CRANCH, Ch. J.; D. C., 1850.

14. It appearing that a mill for grinding bark constructed according to the specification would grind, when in not very rapid operation, a cord of bark an hour, and double the quantity that could be ground by the old mills, *Held*, that it was evidence enough of utility. *Wilbur* v. *Beecher*, 2 Blatchf., 137.—NELSON, J.; N. Y., 1850.

15. The novelty of an invention can be defeated by a prior use only by showing that such prior use accomplished the same result in the same manner. Hence, where a patent was for the application of the principle of the expansion and contraction of a metallic rod to regulate the heat of a stove, *by means of the heat produced by the stove itself*, it will not be defeated by showing a prior application of the expansion and contraction of such a rod, heated *indirectly* by the heat of the furnace, by being immersed in hot water. *Foote* v. *Silsby*, 2 Blatchf., 266, 271.—NELSON, J.; N. Y., 1851.

16. But it is not necessary that such prior application should have been made by the very best apparatus that could be devised. The question does not depend on the *degree of usefulness*. If the application operated successfully, and so as to be practically useful, though it may not have been the very best, it will be sufficient. *Ibid.*, 274.

17. Under the act of 1793, a patent was not even *prima facie* evidence that the invention patented was new or useful; but under the act of 1836, a patent issued after the inquisition or examination, required by that act, is received as *prima facie* evidence of the facts asserted in it. *Corning* v. *Burden*, 15 How., 270, 271.—GRIER, J.; Sup. Ct., 1853.

18. Upon an application for a patent, the applicant cannot be required to furnish evidence of the practical result of his invention. To entitle an inventor to a patent, the invention need not be in use or reduced to actual practice otherwise than by a model, drawings, and specification containing a written description of the invention, and of its manner of operation. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

19. And it is enough if it is capable of use, for some beneficial purpose; the degree of utility, whether larger or smaller, is not a subject of consideration. *Ibid.*

20. According to the American cases, the result alone, when the effects produced are more economical, useful, and beneficial, or a better article, is not conclusive evidence of the novelty of an invention, but it must appear that the re-

sult is produced by some new process, device, or machinery, though in such case but slight evidence of novelty will be required. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

21. Under the English cases, the result alone, under like circumstances, is conclusive evidence of invention. *Ibid.*

22. The jury are to determine from the facts in the case as to the novelty of the invention. *Battin* v. *Taggart*, 17 How., 85.—McLEAN, J.; Sup. Ct., 1854.

23. The fact of the use of a patented invention by a defendant, is evidence of its utility, and will subject such person to damages. *Simpson* v. *Mad. Riv. R. R. Co.*, 6 McLean, 604.—McLEAN, J.; Ohio, 1855.

24. The patent is *prima facie* evidence of the novelty of the thing patented. *Teese* v. *Phelps*, 1 McAllis., 49.—McALLISTER, J.; Cal., 1855.

25. Whether there is any novelty in an invention or arrangement of parts, is a question of fact for the jury to determine, upon a view of all the evidence in the case. *Sickles* v. *Borden*, 3 Blatchf., 540.—NELSON, J.; N. Y., 1856.

26. A patent, when introduced in evidence, whether it be an original or reissued one, is *prima facie* evidence that the thing granted was new and useful, and that the patentee was the inventor or discoverer thereof. *Serrell* v. *Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

27. A foreign patent is only *prima facie* evidence, as a patent granted by our own government, that the invention was of some probable value. *Gatling* v. *Newall*, 9 Ind., 582.—PERKINS, J.; Ind., 1857.

28. The report of a committee of a state fair, as to an invention, is not admissible as to the utility of the invention, as being but hearsay evidence. *Ibid.*, 582.

29. A medal awarded by an incorporated body, as the *American Institute of New York*, is evidence of the same character as to utility. *Ibid.*, 582.

30. A patent is *prima facie* evidence that the thing described in it is new, and must control the question, unless countervailed by the defendant's evidence. *Waterbury Brass Co.* v. *N. Y. & B. Brass Co.*, 3 Fisher, 48.—INGERSOLL, J.; N. Y., 1858.

31. A patent is *prima facie* evidence that the grant of right in it is valid; that the things described in it are new and useful; that they required invention, and that they were the invention of the patentee; and such *prima facie* evidence must have full effect, unless rebutted by sufficient countervailing evidence. *Potter* v. *Holland*, 4 Blatchf., 242.—INGERSOLL, J.; Ct., 1858.

32. A patent is *prima facie* evidence that an invention is new and useful. *Poppenheusen* v. *N. Y. G. P. Comb. Co.*, 2 Fisher, 67.—INGERSOLL, J.; N. Y., 1858.

33. The fact that a defendant has used the thing patented, is very strong evidence as to the utility of the thing patented; if it is not useful, why does he use it? *Ibid.*, 69.

34. The degree of the utility of an invention, is not a matter of consideration. If it was useful at the time the patent was granted, the patent is valid; that it has become useless by the discovery of some other method dispensing with it, gives no other person the right to use it. *Ibid.*, 72.

35. But if the invention is useless as to the particular thing used by defendants, they are not liable. *Ibid.*, 72.

36. The patent raises the presumption

of novelty and utility, but courts will not be very rigid in inquiring as to the *degree* of such utility. *Bell* v. *Daniels*, 1 Fisher, 375.—LEAVITT, J.; Ohio, 1858.

37. The patent itself affords *prima facie* evidence of utility; but the defendant may rebut this presumption by evidence, and if he makes it appear that the invention is utterly worthless, it is a good defence. *Vance* v. *Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

38. There is a presumption arising from the patent itself in favor of the novelty of the invention which it covers. But this presumption may be overcome by showing that the thing had been previously known. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

39. There is a presumption arising from the patent, that the invention is of some degree of utility; but this is not conclusive, and defendant may show that it is useless and worthless. *Lee* v. *Blandy*, 2 Fisher, 95.—LEAVITT, J.; Ohio, 1860.

40. A greater degree of utility being achieved by one machine is evidence, sometimes conclusive, of novelty in the means or instrumentalities used. *Eames* v. *Cook*, 2 Fisher, 149.—SPRAGUE, J.; Mass., 1860.

41. In an action for infringement where there is doubt upon the question of novelty, or where the evidence of the witnesses leave it uncertain, the plaintiff may offer evidence going to show that his invention in its practical operation produces results never before produced, and that it is superior to other inventions of the same character. Such evidence, though perhaps inadmissible if offered by the plaintiff as to the question of *utility*, may still be received, as helping to lead the jury to just conclusions upon the question of *novelty*. *Judson* v. *Cope*, 1 Fisher, 624.—LEAVITT, J.; Ohio, 1860.

42. In other words, if the jury are satisfied that the invention patented produces a result decidedly and clearly different from any which had been produced by the action of former inventions designed for like uses, and that it was decidedly superior in its operation, it would afford ground for the presumption that the thing itself had not been known before. *Ibid.*, 624.

43. As to the point whether an invention furnishes either a new article or a better or *cheaper* one, it seems that the testimony of competent, disinterested witnesses, who are practical persons, and capable of judging as to the matter in issue, will be received, and are entitled to credit as to whether the invention is better or cheaper. *Arthur*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

44. As to the novelty and utility of an invention, the testimony of disinterested, competent witnesses experienced in the invention will be received, and, it seems, will overcome apparent resemblances to other inventions. *Hoyt*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

45. Upon the application for a patent, the testimony of practical men as to the utility of the invention is entitled to consideration. *Hayden*, *Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

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## EXAMINERS OF PATENT OFFICE.

1. The officer of the Patent Office, who may attend before the judge on an

appeal, under the provisions of § 11 of the act of 1839, is not considered as counsel for the Patent Office, or as an advocate of either of the parties litigant. He only attends for the purpose of explaining the decision of the Commissioner. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

2. The examiners in the Patent Office are only the assistants of the Commissioner in the discharge of his duties, and cannot be constituted a "board of examiners," with power to affirm or reverse the decision of the Commissioner. The Commisioner cannot transfer to them his power. *Aiken, Ex parte* (*Propeller*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

3. On an appeal to the justices of the Circuit Court of the District of Columbia, an examiner of the Patent Office may be inquired of as to the nature and features of the invention under consideration, and essential to the right claimed, and which may not be sufficiently set forth in the report of the Commissioner. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. The provisions of § 11 of the act of 1839 as to the examination, on appeal, of the Commissioner or examiners of the Patent Office on appeals, must be considered in connection with the provision in § 7 of the act of 1836, as to the powers of the old board of examiners. *Richardson* v. *Hicks*, MS. (App. Cas.)—MORSELL, J., D. C., 1854.

5. The language of the statute means that the explanation authorized to be required of the Commissioner and examiners may be so full and clear an explanation of the *principles* of the thing as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be limited to a mere exposition of the terms used, and such explanations, so given, the judge is bound to respect as a part of the case. *Ibid.*

6. Previous to the act of March 2d, 1861, all judicial acts done in the Patent Office by the primary examiners or the board of appeals were, in intendment of law, the judicial acts of the Commissioner, and had no legal validity until sanctioned by him. They were the organs of the Commissioner to *inquire and enlighten* his judgment, and till the Commissioner gave validity to their judicial acts by his *fiat*, they had no legal evidence as judgment. *Snowden* v. *Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

7. Under the act of 1861, the primary examiners and examiners in chief are recognized as *judicial officers*, acting independently of the Commissioner, who can *only control them* when their judgment in due course, comes before the Commissioner on appeal. *Ibid.*

8. Their acts are not the acts of the Commissioner, but their own acts. They are no longer *mere* organs of the Commissioner, but independent officers. He can only reach and overrule them when their judgments come regularly before him *on appeal*. *Ibid.*

9. The Commissioner can give no judgment till the appeal reaches him, and this cannot be done till the judgment of the primary examiners has been submitted to the examiners in chief. *Ibid.*

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## EXECUTION, SALE OF PATENTS AND COPYRIGHTS UNDER.

1. The levy and sale, under an execution, of the *materials* of a patented

machine, does not convey to the purchaser any right to use the machine in the manner pointed out in the patent. *Sawin* v. *Guild*, 1 Gall., 487. STORY, J.; Mass., 1813.

2. An author, who has obtained a copyright under the act of Congress cannot be deprived, against his will, and in favor of his creditors, of any of the rights secured to him by such acts; and possibly they cannot, against his will, seize and sell the books themselves, the exclusive right of vending which is ested in him. *Cooper* v. *Gunn*, 4 B. Mon., 596.—MARSHALL, J.; Ky., 1844.

3. But this protection does not extend to the proceeds of the sale of his copyright, whether existing in his own hands or held by another for his use. *Ibid.*, 596.

4. A patented machine, and the right of use attached to it, may pass, by sale, devise, or levy of execution, or assignment of an insolvent's effects. *Woodworth* v. *Curtis*, 2 Wood. & Min., 530. —WOODBURY, J.; Mass., 1847.

5. The incorporeal right, copyright, secured by the statute to the author, being intangible and secured by grant, is not the subject of seizure or sale by execution, at least at common law; but it may be reached by a creditor's bill, and be applied to the payment of the debts of the author. *Stephens* v *Cady*, 14 How., 531.—NELSON, J.; Sup. Ct., 1852.

6. It may however be doubted whether a transfer by a sale under a decree of court would pass the title so as to protect the purchaser, unless by a conveyance, in conformity with the requirements of the statute. *Ibid.*, 532.

7. The sale of a copper-plate of a map, on an execution against the owner of the copyright, does not carry with it, or pass to the purchaser, the right to print and publish the map engraved upon it. *Ibid.*, 532.

8. It may well be doubted whether patents and copyrights, held under the laws of the United States, are subject to seizure and sale on execution; such incorporeal rights do not exist in any particular state or district, but are coextensive with the United States. *Stevens* v. *Gladding*, 17 How., 451.—CURTIS, J.; Sup. Ct., 1854.

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## EXPERIMENTS.

1. It is clearly immaterial whether experiments as to an invention are made by the inventor himself or by others; the question being, who is the original inventor. *Pennock* v. *Dialogue*, 4 Wash., 542.—WASHINGTON, J.; Pa., 1825.

2. A patentee may take a reasonable time to try experiments with his invention, even of a public nature, when its character requires it, without invalidating his patent under § 6 of the act of 1793. *Whitney* v. *Emmett*, Bald., 310. —BALDWIN, J.; Pa., 1831.

3. Whoever first perfects a machine and makes it capable of useful operation, is entitled to a patent, and is the real inventor, though others may have previously had the idea, and made some experiments toward putting it in practice. *Washburn* v. *Gould*, 3 Story, 133. —STORY, J.; Mass., 1844.

4. *Semble*, that he would be entitled to a patent, although the antecedent experiments of others were known to and used by him in perfecting his machine. *Ibid.*, 133.

5. Though others may have had the

idea of a machine, and made experiments toward putting it into practice, the person who finally perfects it, and renders it capable of useful operation, is entitled to a patent. *Ball* v. *Murry*, 10 Penn, 112.—ROGERS, J.; Pa., 1848.

6. Crude and imperfect experiments, equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor, who has perfected his improvement and obtained his patent. *Parkhurst* v. *Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

7. In order to entitle a person to the character of an inventor, and his invention to become the subject of a patent, he must not stop at unsuccessful experiments, but continue until he has brought out a machine producing a useful result, and without this his invention will be worthless to the community, and undeserving the protection of the law. *McCormick* v. *Seymour*, MS.—NELSON, J.; N. Y., 1851.

8. A patentee or an inventor has a right to try his machine, and continue his experiments until he has perfected his improvement. *Ibid.*

9. 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 experiment, 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., 299.—GRIER, J.; N. J., 1852.

10. An imperfect and incomplete invention, resting in mere theory, or an intellectual notion, or in uncertain experiment, and not actually reduced to practice, and embodied in some distinct machinery, apparatus or the like, is not patentable under our laws. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

11. A long course of *mere fruitless* experiments to reduce a principle to practice, will not be sufficient to prevent a subsequent, original inventor, who has perfected his invention, without knowledge of the prior invention, from receiving a patent. *McCormick* v. *Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

12. But where a prior inventor has been using due diligence to perfect his invention, and adapt it to practical use, his right will be preserved and protected, although his success may not be perfect. *Ibid.*

13. 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 end in experiment. 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. *Howe* v. *Underwood*, 1 Fisher, 166.—SPRAGUE, J.; Mass., 1854.

14. If an invention 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 afterward. *Ibid.*, 166.

15. Where a person is engaged in producing some new and useful instru-

ment or contrivance, and has embodied it into a machine, and endeavored to reduce it to practice by experiment—if those trials fail—if he fail in success and abandon it, and give it up, that consideration affords no impediment to another person who has taken up the same idea, or class of ideas, and who has gone on perseveringly in his studies, trials, and experiments, until he has perfected the new idea, and brought it into practical and useful operation. He is the person, the meritorious inventor, who is entitled to the protection of the law. *Winans* v. *N. Y. & Har. R.R.*, 31 Jour. Fr. Inst., 3d Ser., 322.—NELSON, J.; N. Y., 1855.

16. If a person having some vague idea of a principle, make numerous trials and experiments, if those trials and experiments do not result in such a knowledge upon his part as enables him to put in successful practice the idea of which he has such vague notion, he does not become an inventor in the sense of the patent law. *Ransom* v. *Mayor, &c.*, 1 Fisher, 270.—HALL, J.; N. Y., 1856.

17. Such a person 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. *Ibid.*, 270–271.

18. 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. *Ibid.*, 270.

19. The use of a patented invention as a matter of business, and the product of which is thrown into market for the purpose of being sold, cannot be called experimental, but is such a use as will make the party liable. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

20. Experiments made, equivocal in their results, and given up for years, will not be permitted to prevail against an original inventor who has reduced his invention to practice, and has without fraud obtained a patent. *Ellithorpe* v. *Robertson*, 4 Blatchf., 309.—INGERSOLL, J.; N. Y., 1859.

21. An experiment as to the production of a machine, which was unsatisfactory and had been abandoned, is not such an invention as entitles a person to the benefit of the patent laws. *Winans* v. *Danforth*, MS.—NELSON, J.; N. Y., 1860.

22. Where a person has attempted to invent a certain device, and after trial and experiment has in his own judgment failed and abandoned the experiment, this fact removes all impediments in the way of any future inventor who may follow in the same line. *Ibid.*

23. Experiments of another, even if known to a patentee, will not defeat the claims of such patentee to originality of invention, if it appear that such patentee has prosecuted such experiments to success. *Judson* v. *Moore*, 1 Fisher, 555.—LEAVITT, J.; Ohio, 1860.

24. Neither the patent law nor the decisions of our courts have fixed any precise period applicable to the experimental use of new inventions. The period for experiments must depend upon the nature of the invention, and the opportunities of the inventors. *Seeley* v. *Bean*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

25. What would not constitute proper diligence under some circumstances,

when the experiments went over a few months, would not amount to abandonment under other circumstances, though the experiments might have gone over a number of years. *Ibid.*

26. The nature and extent of this right depends on circumstances, and must be used consistently with the policy, spirit, and nature of the patent laws requiring vigilance, and newness at the time of application for a patent. *Ibid.*

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## EXPERTS, TESTIMONY OF.

1. The opinions of skilful persons, whether the principles of two machines are the same, are competent evidence to be introduced in a patent cause. *Barrett* v. *Hall*, 1 Mas., 470.—STORY, J.; Mass., 1818.

2. But although the testimony of witnesses be admissible to prove the identity or diversity of machines in principle, yet, after all, it is but matter of opinion, and its weight must be judged of by all the other circumstances of the case. It is infinitely more satisfactory to ascertain, if it be possible, the precise differences and agreements; and when these can be subjected to the eyes, they almost supersede all the evidence of mere opinion. *Ibid.*, 471.

3. In actions for violation of patents, persons acquainted with the particular art to which the controversy relates, are usually examined for the purpose of pointing out and explaining to the jury the points of resemblance, or of difference, between the thing patented and that which is the alleged cause of the controversy; and the opinions of such witnesses, in relation to the materiality of apparent differences, are always entitled to great respect. But after all, the jury must judge for themselves, as well upon the information so given to them, as upon their own view, where the articles, or models of them, are brought into court. *Dixon* v. *Moyer*, 4 Wash., 71.—WASHINGTON, J.; Pa., 1821.

4. It is competent to show by experts that there are material differences between an original and a reissued patent, and to explain what those differences are. *Phila. & Tren. R. R.* v. *Stimpson*, 14 Pet., 462.—STORY, J.; Sup. Ct., 1840.

5. Whether a patent is void for uncertainty or ambiguity in the description, is a matter of fact to be decided upon the evidence of experts. *Washburn* v. *Gould*, 3 Story, 138.—STORY, J.; Mass., 1844.

6. The opinions of professional men, are evidence as to matters which relate to their profession, and on such subjects only. And this rule applies to mechanics as well as to any other profession or business. *Brooks* v. *Bicknell*, 3 McLean, 447.—MCLEAN, J.; Ohio, 1844.

7. The patent acts look to two classes of persons, not only as competent, but as peculiarly appropriate witnesses, but for different purposes. 1. Artisans, or persons practically engaged in the trade, employment, or business of the particular branch of mechanics to which the patent-right applies, as to whether the specification sufficiently described the invention so that it could be constructed and used. And 2. Persons who, although not practical artisans, are thoroughly conversant with the subject of mechanics as a science, as to the questions of novelty of invention, or identity or diversity of mechanical apparatus,

and contrivances, and equivalents—and as to these questions, scientific mechanics are the very highest witnesses. *Allen* v. *Blunt*, 3 Story, 747–749.—Story, J.; Mass., 1845.

8. The patent act contemplates two classes of persons as peculiarly appropriate witnesses in patent cases. 1st. Practical mechanics, to determine the sufficiency of the specification as to the mode of constructing, compounding, and using the patent; and 2d. Scientific and theoretic mechanics to determine whether the patented thing is substantially new in its structure and mode of operation, or a mere change of equivalents. The second is by far the higher and more important of the two. *Olcott* v. *Hawkins*, 2 Amer. Law Jour., N. S., 321.—Miller, J.; Wis., 1849.

9. Great respect is due to the views and opinions of scientific individuals, and practical mechanics, on the question of the identity of different mechanical structures, as from their acquaintance with the elements of mechanical science, they are enabled satisfactorily to decide this question, while, to others, it might seem to be involved in obscurity and doubt. *Parker* v. *Stiles*, 5 McLean, 64.—Leavitt, J.; Ohio, 1849.

10. The opinion of experts, or scientific and practical men, as to the comparative merits of two inventions, cannot affect the question of their novelty. *Winslow, Ex parte*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1850.

11. The opinions of scientific men upon topics within their own departments of knowledge, are especially desirable in patent cases, and when duly supported by reasonings founded on ascertained fact, are to be valued highly. *French* v. *Rogers*, 1 Fisher, 150.—Grier, Kane, JJ.; Pa., 1851.

12. But it is a mistake to suppose that, even on a question of science, opinion can be dignified with the mantle of authority. Still less, when it assumes contested facts, or volunteers to aid in determining written instruments. *Ibid.*

13. Experts may be examined as to the meaning of terms of art, &c., on the principle of *cuique in sua arte credendum*, but not as to the construction of written instruments. *Corning* v. *Burden*, 15 How., 270.—Grier, J.; Sup. Ct., 1853.

14. Models may be referred to as ocular demonstration of features connected therewith, and such demonstration, or evidence, will be more satisfactory than the opinion of experts in opposition thereto. *Bell* v. *Hill*, MS. (App. Cas.)—Morsell, J.; D. C., 1854.

15. In patent cases, the mere opinions 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, will not afford very satisfactory proof that such opinions ought to be adopted by the Court. *U. S. Annunciator & Bell Tel. Co.* v. *Sanderson*, 3 Blatchf., 186.—Betts, J.; N. Y., 1854.

16. In matters of science, a person cannot be considered as an expert unless he has a knowledge of the science involved. *Allen* v. *Hunter*, 6 McLean, 307, 308, 310.—McLean, J.; Ohio, 1855.

17. In considering testimony, the jury are to give weight to it in proportion to the competency of the witnesses to judge of the matters sworn to. *Ibid.*, 310.

18. The testimony of a chemist, who has analyzed the ingredients of a com-

position of matters, and who testifies as to the result of such analyzation, is not matter of opinion, but of a fact demonstrated. *Ibid.*, 312.

19. Analysis is the only mode by which the human judgment can rest upon absolute certainty. There are but few questions which may be decided by the power of analysis, chemically or mathematically. But when this is done satisfactorily, truth is attained. *Ibid.*, 312.

20. Models are evidence superior to and unaffected by the interests or prejudices of partisans, or by the opinions (the reveries, they may often be called) of a class of men called experts; men as often skilled and effective in producing obscurity and error, as in the elucidation of truth. *McCormick* v. *Talcott*, 20 How., 409.—DANIEL, J.; Sup. Ct., 1857.

21. The statute defines the character of an expert, as one "*skilled in the art or science*" to which his opinion or judgment appertains, or in a business or art most nearly connected with that to which his judgment or opinion is applied. A practical operator, and not a scientific theorist is, properly speaking, such an expert. *Page* v. *Ferry*, 1 Fisher, 306.—WILKINS, J.; Mich., 1857.

22. In medical science, a physician is an expert; in navigation, a sailor. But the judgment of, either, if an expert, may be—*ought* to be—rejected by the jury, if they are satisfied it is unworthy of credence. *Ibid.*, 315.

23. Experts may be examined to explain terms of art, and the state of the art, at any given time, and may explain to the court and jury the machines, models, or drawings exhibited, and may point out the difference or identity of the mechanical devices involved in their constuction. The maxim of "*cuique in sua arte credendum*," permits them to be examined to questions of art or science peculiar to their trade or profession. *Winans* v. *N. Y. & E. R. R. Co.*, 21 How., 100, 101.—GRIER, J.; Sup. Ct., 1858.

24. But they cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may however obtain information from them, if he desire it, on matters which he does not clearly comprehend. *Ibid.*, 101.

25. A witness in order to be competent to testify as to whether a specification contains a sufficient description of the invention, must be one *skilled in the art:* one not so skilled is not a fit person to determine as to the sufficiency of the description. *Poppenhcusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 70.—INGERSOLL, J.; N. Y., 1858.

26. Neither the testimony of witnesses generally, nor of professors, experts, or mechanics, can be received to prove what is the proper or legal construction of a patent. *Day* v. *Stellman*, 1 Fisher, 402.—GILES, J.; Md., 1859.

27. On questions of the mechanical difference of machines, the opinions of experts may be given in evidence; when they are qualified and free from bias, their testimony is entitled to great respect. *Morris* v. *Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858. *Latta* v. *Shawk*, *Ibid.*, 470.—LEAVITT, J.; Ohio, 1859.

28. In general, witnesses testify only as to facts, from which the jury form their opinion. But there are various classes of cases which depend upon the knowledge of a peculiar art or science for their solution, requiring a peculiar knowledge, in order to form a satisfac-

tory judgment of the question involved; in such cases the law allows testimony to be given from those skilful in the particular art, science, or profession, and permits them to give their opinions as results which they arrive at from an examination of the questions of fact that are before the jury. *Johnson* v. *Root*, 1 Fisher, 361.—SPRAGUE, J.; Mass., 1858.

29. The jury should not, however, allow themselves to be bound by such opinions. They are only introduced to aid. The opinion of an expert is to be considered like that of any professional man; reference being had to his ability, the fairness of the opinion, its impartiality, and the reasons assigned for it. *Ibid.*, 361.

30. The testimony of experts is to be received implicitly, only on points of a really scientific kind; and the persons offered as experts must be really men of science. Even in matters which are of a scientific nature, the court and jury will exercise their own intelligence to a certain degree, the matters of science involved not being of a recondite nature. *Livingston* v. *Jones*, 3 Wall. Jr.—GRIER, J.; Pa., 1861.

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## EXTENSION OF LETTERS PATENT.

**A.** WHO MAY APPLY FOR AND OBTAIN; IN WHAT CASES..... 319
**B.** POWER OF COMMISSIONER ON APPLICATION FOR; CONCLUSIVE NATURE OF ACTION OF..... 320
**C.** RIGHTS OF ASSIGNEES AND OTHERS IN EXTENSION..... 321
**D.** AUTHORITY AND FORCE OF EXTENDED PATENT..... 327
**E.** EXTENSION BY SPECIAL LAWS, AND RIGHTS UNDER..... 328

### A. WHO MAY APPLY FOR AND OBTAIN; IN WHAT CASES.

1. Under § 18 of the act of 1836, the Board of Commissioners appointed to grant an extension of a patent, may allow such extension to the legal representatives of a patentee upon their application, in the same manner as though the application had been made in the lifetime of the patentee. *Nyman's Case*, 3 Opin., 446.—GRUNDY, Atty. Gen., 1839.

2. An administrator or executor may make the application for the extension of a patent where the grantee is dead, and the patent may lawfully be extended on such an application. *Van Hook* v. *Scudder*, MS.—THOMPSON, J.; N. Y., 1843. [Cited in 3 Story, 132, and 3 McLean, 438.]

3. If a patentee is dead, his administrator may apply for and obtain an extension of the patent, under the provisions of § 18 of the act of 1836. *Brooks* v. *Bicknell*, 3 McLean, 258–260.—McLEAN, J.; Ohio, 1843.

4. The administrator of a deceased patentee may apply for and obtain a renewal of his patent. *Brooks* v. *Bicknell*, 3 McLean, 436, 438.—McLEAN; J.; Ohio, 1844.

5. An extension of a patent may be taken out by an administrator of a deceased patentee. *Washburn* v. *Gould*, 3 Story, 133, 137.—STORY, J.; Mass., 1844.

6. An administrator is competent to apply for and receive a renewal or extension of a patent. *Woodworth* v. *Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844.

7. The provisions of § 18 of the act of 1836 as to extensions is not limited

to cases of renewals of future patents, but applies to the past also. *Ibid.*, 179, 180.

8. The right of renewal is limited to the patentee, whether he retains or has sold his invention. The provision of renewal extends as well to a case where the patent has been assigned, as where it has not been. *Brooks* v. *Bicknell*, 4 McLean, 66, 69.—McLean, J.; Ohio, 1845.

9. The right of extension under § 18 of the act of 1836, applied to patents granted before the passage of that act, as well as to those thereafter issued. *Wilson* v. *Turner*, 7 Law Rep., 529. —Taney, J.; Md., 1845.

10. The right of extension is given by the law, chiefly with a view to the advantage of the inventor, and not of his assignee or grantee; and the patent, if extended at all, must be extended on the application of the inventor and not of his assignee. *Ibid.*, 531.

11. § 18 of the act of 1836 authorizes the extension of a patent on the application of the executor or administrator of a deceased patentee. *Wilson* v. *Rosseau*, 4 How., 675, 676, 687.—Nelson, J.; Sup. Ct., 1845.

12. And such extension may be applied for and obtained by the administrator, although the original patentee had in his lifetime disposed of all his interest in the then existing patent, having at the time of his death no right or title to, or interest in the original patent. *Ibid.*, 686, 688. 690.

13. An administrator may, under § 18 of the act of 1836, apply for, and take an extension of a patent. *Woodworth* v. *Wilson*, 4 How., 716.—Nelson, J.; Sup. Ct., 1845.

14. The renewal of a patent in the name of an administrator is good, as an invention is personal property. *Woodworth* v. *Hall*, 1 Wood. & Min. 254.—Woodbury, J.; Mass., 1846.

## B. Power of Commissioner on Application for; Conclusive Nature of Action of.

1. Under § 18 of the act of 1836, the notice of an application for an extension of a patent is intended to protect the public, and give all an opportunity to appear and oppose. Where a patent was to expire on the 7th day of December, 1840, and the applicant did not apply until the 21st of November, *Held*, that there was not time sufficient to give the notice required by law. *Gale's Case*, 3 Opin., 594.—Gilpin, Atty. Gen.; 1840.

2. The decision of the Board, upon an application for an extension of a patent, is conclusive within the scope of its jurisdiction, there being no superior supervising tribunal; but it is not conclusive on the question of law, as to the right of renewal by the party applying. *Brooks* v. *Bicknell*, 3 McLean, 258.—McLean, J.; Ohio, 1843.

3. The proceeding before the Board, as to the extension of a patent, is not necessarily *ex parte;* those who contest the right of the applicant have the right to appear and oppose the renewal of the patent. *Brooks* v. *Bicknell*, 3 McLean, 435.—McLean, J.; Ohio, 1844.

4. The function of such Board is, in its nature, judicial: the parties, as well those who oppose the extension of the patent as those who apply for it, are brought before them; and evidence on both sides being heard, the board pronounce judgment. *Ibid.*, 435.

5. The proceeding, therefore, is not like a tax sale, where every step mus

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. *Ibid.*, 435.

6. The decision of the Board, upon an application for an extension of a patent, is not conclusive upon the question of their jurisdiction. *Wilson* v. *Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

7. The extension of a patent to a person as administrator is proof that the Board was satisfied of the fact of his being such administrator, and such decision is conclusive. In an action upon such patent, the letters of administration need not be produced. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

8. The act of 1848, conferring the power of extending patents upon the Commissioner, was not a repeal of § 16 of the act of 1836, providing for the extension of patents, but simply a repeal of so much of it as related to the action of the Secretary of State, and the Solicitor of the Treasury in the matter. It simply devolved upon the Commissioner the whole of the duty which was previously divided with the Secretary and the Solicitor, and directed that he should be governed by the same principles and rules that had governed the board composed of the three. *Colt* v. *Young*, 2 Blatchf., 473.—NELSON, J.; N. Y., 1852.

9. Where an application for an extension of a patent, under § 18 of the act of 1836, was pending at the time of the passage of the act of 1848, which conferred upon the Commissioner of Patents solely the power previously vested in the board created by the act of 1836, *Held*, that it was not necessary to renew the application, but that the Commissioner had the power to go on with the proceedings, as having been already properly instituted, and complete them by granting the extension. *Ibid.*, 473.

10. The decision of the Commissioner as to the regularity of the proceedings before him, on an application for an extension are conclusive, except perhaps in a case of fraud. *Ibid.*, 473, 474.

11. In respect to the entire merits of the patentee, and the existence of the legal grounds for an extension, the law makes the Commissioner the judge, and in the absence of fraud his adjudication is conclusive. *Clum* v. *Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

## C. RIGHTS OF ASSIGNEES AND OTHERS IN EXTENSION.

1. Under the act of 1836, by which "the benefit of a renewal extends to the assignee to the extent of his interest," where an assignment of the whole right has been made by a patentee, whether such patentee could have any interest in the renewal; *query*. *Brooks* v. *Bicknell*, 3 McLean, 257.—MCLEAN, J.; Ohio, 1843.

2. Under the patent laws, prior to 1836, a license or assignment of a patent expired with the limitation of the original patent, unless it was expressly so granted as to be applicable to any renewal of the patent afterward. The licensee's or assignee's right was bounded by the same limits as that of the licenser or assignor, that is, the original term granted.—*Washburn* v. *Gould*, 3 Story, 135.—STORY, J.; Mass., 1844.

3. A renewed patent under those laws was a new grant, and the patentee was entitled to the sole and exclusive benefit thereof, unless the licensees or

assignees had, by their original contract, secured to themselves, by express covenant or grant, a right to the benefit of the renewed patent. *Ibid.*, 135.

4. Previous to the act of 1836 every license and assignment expired with the limitation of the original patent, unless it was expressly, in terms, so granted as to be applicable to any renewal of the patent afterward. The doctrine proceeded upon the ground that a man can pass by grant or assignment only that which he possesses, and which is in existence at the time. His grant, therefore, is limited to what is then in existence, unless he uses other language, importing an intention to grant what is not then possessed or in existence. *Woodworth* v. *Sherman*, 3 Story, 174.—STORY, J.; Mass., 1844.

5. And this doctrine is expressly applicable to licenses and assignments under the act of 1836, the whole design of which is confined to the inventor, and for his benefit, and not for the benefit of his licensee or assignee. *Ibid.*, 175.

6. The word "patentee" in § 18 of the act of 1836 is used as equivalent to "inventor," and the law meant to reward him, and him alone, for his time, ingenuity, and expense in perfecting his invention. *Ibid.*, 176.

7. The clause as to assignees "to the extent of their respective interests therein," does not mean to enlarge the rights of assignees beyond the extent of the interest originally granted to them. If such interest was limited to the original term, they would have no benefit in the extended patent; but if the original assignment conferred, expressly, or by just implication, an interest in the renewed patent, that interest was to be protected. *Ibid.*, 177.

8. Under § 18 of the act of 1836, the renewal of a patent does not inure to an assignee, unless by the assignment of the original patent it is so specified. *Brooks* v. *Bicknell*, 4 McLean, 66, 67.—MCLEAN, J.; Ohio, 1845.

9. The provision that the "benefit of the renewal shall extend to the assignees of the patent to the extent of their interests therein," gives a legal effect to the provision of any assignment, stipulating for an interest in the event of a renewal. Without such provision, the assignment might have been considered an agreement to convey, but it would not have been a legal conveyance of the patentee's right, as he could not convey a legal title to that which was not in existence. *Ibid.*, 68.

10. This is a fair construction of the statute, harmonizing its provisions, and giving effect to the intention of the parties. *Ibid.*, 68.

11. The object of the clause in § 18 of the act of 1836, as to assignees, is to preserve any previous contract of assignment, in the sense in which both parties understood and intended at the time it was made, and to secure to the purchaser the right he had intended to buy, and which the patentee intended to sell. *Wilson* v. *Turner*, 7 Law Rep., 530.—TANEY, J.; Md., 1845.

12. The legislature obviously intended to guard a party who had purchased from the patentee the right to use the invention until the expiration of the exclusive privilege, from the necessity of buying it again. *Ibid.*, 531.

13. The object of the law is to do justice between the inventor, who has failed to obtain a reasonable remuneration within the fourteen years, for the time, ingenuity, and expense bestowed upon his invention, and the public,

while it protects assignees and grantees in the rights previously acquired by them. *Ibid.*, 532.

14. The extension of a patent under § 18 of the act of 1836, does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any exclusive right. But the benefits of such renewal extended to assignees or grantees by such section is limited to those who were in the use of the patented article at the time of the renewal, and saves to such persons the right to use the machines held by them at the time of such renewal "to the extent of their interests," be that interest in one or more machines. *Wilson v. Rosseau*, 4 How., 682, 683.—NELSON, J.; Sup. Ct., 1845. [But see *post* 43 to 47, 1856.]

15. McLEAN and WOODBURY dissented, holding that such an extension would inure to the benefit of such assignees, who had by express agreement secured an interest in the extension. *Ibid.*, 692, 694.

16. WAYNE dissented from such part of the opinion of the court as gave to assignees the right to continue the use of the patented machines in use at the time of the extension. *Ibid.*, 693.

17. A covenant as to a benefit in a "renewal" of a patent must be construed by a reference to the law as it stood at the time of such covenant, and will not embrace any right in a new grant, secured by after legislation. *Ibid.*, 685.

18. Where, in an assignment of a patent, made in 1828, before there was any provision in the patent laws authorizing a renewal, there was a covenant that any "renewal" should inure to the benefit of the assignees, *Held*, that such term "renewal," could be satisfied by a reference to the law as it then stood, and that in a subsequent renewal of the patent, by virtue of subsequent acts of Congress, no right was acquired by virtue of the assignment or covenant. *Ibid.*, 685. 686.

19. If an extension is taken by an administrator of a deceased patentee, it inures to the benefit of such administrator, and to him in that capacity exclusively. *Ibid.*, 685, 687.

20. The assignees and grantees of the right to use a patent, who are by § 18 of the act of 1836, as interpreted by the Supreme Court, to have the benefit of the renewal of a patent, are those holding the right, at the time of the renewal. *Woodworth* v. *Curtis*, 2 Wood. & Min., 530.—WOODBURY, J.; Mass., 1847.

21. A reservation in an act of Congress extending a patent in favor of assignees, does not make the act unconstitutional, but such power of reservation is incidental to the general power conferred to promote the progress of the useful arts. *Blanch. Gun-Stock Co.* v. *Warner*, 1 Blatchf., 260, 271, 275.—NELSON, J.; Ct., 1846.

22. The direct question whether Congress can grant in an extension, rights to assignees, was not involved in the cases of *Wilson* v. *Rosseau*, *Simpson* v. *Wilson*, *Wilson* v. *Turner*, and *Woodworth* v. *Wilson*, 4 How., 646–712, but was discussed and considered as connected with the matters in controversy in those cases, and the right of Congress to reserve rights and privileges to assignees, was conceded as incidental to the general power conferred by the constitution on Congress, to promote the progress of the useful arts. *Ibid.*, 276.

23. A general assignment of an interest in a patent, or a part of a patent, gives the assignee no interest in the re-

newal of the patent. But such an interest may be assigned, if the terms of the assignment clearly embrace the renewed patent. *Phelps* v. *Comstock*, 4 McLean, 355.—McLean, J.; Ind., 1848.

24. But where the assignment is of an interest in letters patent, which "are or may be granted," it embraces any subsequent renewal of the patent whether it should be under the statute, or by act of Congress. *Ibid.*, 355.

25. If the whole of the patent has been assigned, it would seem that, under the decision of the majority of the Supreme Court in *Wilson* v. *Rosseau*, 4 How., 646, 1845, there could be no renewal for the benefit of the patentee. *Ibid.*, 355.

26. The extension of a patent is for the benefit of the original inventor or his representatives, to compensate him for his expenditure, labor, and ingenuity in the invention, and in perfecting it. *Case* v. *Redfield*, 4 McLean, 528.—Huntington, J.; Ind., 1849.

27. An ordinary assignment of a right in a patent will not convey any right in the extended or renewed patent. But such an interest when intended to be assigned, must be expressed. *Ibid.*, 528.

28. Under § 18 of the act of 1836, as construed by the Supreme Court in *Wilson* v. *Rosseau*, 4 How., 682, a licensee may continue to use an invention actually in use by him at the time of an extension, during the term of such extension; but no such right exists under an extension by act of Congress, unless specially provided for. *Bloomer* v. *Stolley*, 5 McLean, 163.—McLean, J.; Ohio, 1850. [But see *post* 33.]

29 If Congress upon an extension imposes no restriction in favor of a licensee, and there is no provision in the contract of license, beyond the term of the patent, none can be implied. *Ibid.*, 164.

30. The right of an assignee to continue to use, during an extension of a patent, machines existing and in use at the expiration of the first term, as declared in *Wilson* v. *Rosseau* (4 How., 646), is derived wholly from the proviso in § 18 of the act of 1836, in favor of assignees. If there had been no such reservation, the rights of assignees acquired during the first term would have expired with its termination, and the exclusive right would have vested in the patentee. *Gibson* v. *Gifford*, 1 Blatchf., 531.—Nelson, J.; N. Y., 1850.

31. To enable an assignee to derive any benefit from an extension by an act of Congress, an express provision should be inserted in the grant or assignment, looking to such a renewal. *Gibson* v. *Cook*, 2 Blatchf., 146.—Nelson, J.; N. Y., 1850.

32. Unless there be such a stipulation, showing that a renewal was contemplated, the court is bound to construe the instrument as relating to the existing right, in respect to which the parties are considered as contracting with each other. *Ibid.*, 146.

33. Under the decision of *Wilson* v. *Rosseau*, 4 How., 688, one in the lawful use and ownership of a patented machine, under a purchase made during the original term of the patent, may continue to use such a machine during an extension of the patent, under the provisions of § 18 of the act of 1836; and is also entitled, within the spirit and intention of the patent laws, to continue to use such machine during an

after extension made by special act of Congress, unless there is something in the language of the act requiring a different construction. *Bloomer* v. *McQuewan*, 14 How., 550.—TANEY, Ch.; Sup. Ct., 1852.

34. The inchoate right of an inventor to an extension of a patent for his invention, is the subject of a contract of sale. *Clum* v. *Brewer*, 2 Curt., 520.—CURTIS, J.; Mass., 1855.

35. The sale of the "invention" does not necessarily carry with it this inchoate right, but the sale of "my invention, and of all rights and property that I may have from any *letters patent* for the same," would include the extended letters patent. *Ibid.*, 521.

36. Where a patentee made an agreement with a person, that in case of the *renewal* of the patent, or of the obtaining of other or further letters patent, after the expiration of the existing patent, such person should have a certain interest in the rights secured by such renewed patent, *Held*, that the parties had in view an extension under § 18 of the act of 1836. *Pitts* v. *Hall*, 3 Blatchf., 204.—HALL, J.; N. Y., 1854.

37. Where an agreement was entered into between a patentee and another person, that in case of the extension of the patent, such person should have and be entitled to the equal undivided one-fourth part of all the rights and benefits that should be secured by such renewed patent, for certain states, on paying the proportional one-fourth part of the expenses of obtaining such extension, which agreement was also recorded; and the patent was extended, and such person endeavored to learn from the patentee the costs of such extension, and expressed himself ready to pay his proportional share thereof, *Held*, that the agreement was a valid executory agreement, entitling such person to the undivided interest in such patent, on the performance of the condition precedent of the payment of the specified portion of such expenses. *Ibid.*, 204.

38. Whether the terms of such an an agreement are not words of grant and conveyance, and whether the agreement itself would not be a sufficient assignment of the interest in the extension, if the condition was performed; *query*. *Ibid*, 204.

39. *Held*, also, that the offer to pay the proportional part of such expenses did not vest in such person the interest in such extension, although it may have enabled him to bring his action and recover damages for the non-performance of the agreement. *Ibid*, 205.

40. Under the provisions of § 18 of the act of 1836, an assignee or person in use of the invention at the time of the expiration of the original patent, has a right to continue, under an extension of such patent, the use of "the thing patented," whether the patent be for a process, and a machine to be used in such process, or for a process alone, or for a machine alone, and whether the identical machinery in use by such person under the extended patent was or was not in existence prior to the renewal of the patent. *Day* v. *Union Rub. Co.*, 3 Blatchf., 491, 504.—HALL, J.; N. Y., 1856.

41. Where, at the expiration of the original term of the patent, A had a right to use the patented invention for the manufacture of certain articles, and continued, during an extension of the patent granted under § 18 of the act of 1836, the use of the invention, to the extent he was entitled a [illegible]e time the original patent expired, *Held*, that he

had the right to continue such use during the extended patent, as against B, an assignee of the original patentee. *Ibid.*, 497.

42. The language of § 18 of the act of 1836, as to the rights of assignees and grantees of an original patent, under an extended term thereof, is broad enough to cover and protect, and was intended to cover and protect, the right to use the patented invention during the extension, whether such right arose from a direct assignment or grant from the patentee, of a limited or unlimited right to use, or from the purchase of a machine. *Ibid.*, 497.

43. The words of this section as to assignees and grantees seem to convey the impression that something more than the mere ownership of existing machines was intended, and that they were intended to embrace all classes of such assignees and grantees and all inventions, whether of machines, processes, or compositions of matter, and to embrace rights and interests which were different in extent, either of time or territory, or both. *Ibid.*, 497.

44. But such right is limited to a right to *use*, although the person holding it may also have held, during the original term, an exclusive right to use, to make and vend. And such right to use is secured only to the extent of the respective interests of the assignees or grantees therein. *Ibid.*, 502.

45. If the right to use before the extension was limited to a single state, county, town, or smaller district, it continues during the extension, subject to the same limitations; and if the right was to use a certain specified number of machines within a particular district, the limit in number and restriction continues. *Ibid.*, 503.

46. If the only right to use was one which resulted from the purchase of a machine, the right to use is co-extensive with the existence of the machine, and expires with it. *Ibid.*, 503.

47. Under § 18 of the act of 1836, the assignees and grantees of a right to use a patented process are continued in the right to use it during an extension of the patent, equally with the assignees and grantees of a right to use a patented machine. *Ibid.*, 503.

48. Though the cases of *Wilson* v. *Rosseau*, 4 How., 646; *Wilson* v. *Simpson*, 9 How., 109; and *Bloomer* v. *McQuewan*, 14 How., 539, appear to decide that by virtue of § 18 of the act of 1836, the right of assignees and grantees of an original patent is limited, under the extended patent, to the use of the particular machines which they had in use at the time of the expiration of the original term, such precise question did not arise in their consideration, and was not necessarily decided in either one of them. *Ibid.*, 491, 493.

49. An agreement made between a patentee, who is about to apply for a renewal of his patent, with another that in case of renewal he will convey to him such renewed patent, in consideration of a certain sum, is valid, and if the patent is renewed, such agreement conveys to the assignee an equitable interest or title, which can be converted into a legal title, by paying or offering to pay the agreed consideration. *Hartshorn* v. *Day*, 19 How., 220.—NELSON, J.; Sup. Ct., 1856.

50. Where a patent had been extended, and the patentee then conveyed all his interest therein to another person, who brought suit against certain parties for an infringement of the patent, and such parties claimed, under a license

from the patentee, under the original patent, *Held*, that it was necessary for the defendants to show a connected chain of title to themselves, in order to justify, under the clause of § 18 of the act of 1836, as to assignees, their use of the improvements secured by the patent. *Chaffee* v. *Bos. Belting Co.*, 22 How., 223, 224.—CLIFFORD, J.; Sup. Ct., 1859.

## D. AUTHORITY AND FORCE OF EXTENDED PATENT.

See also EXTENSION OF PATENT, B.

1. A renewed patent has the same obligation, and confers the same rights with an original patent. The inchoate property, which, vested by the discovery, is prolonged by the renewed patent, as well as by the original patent. *Evans* v. *Jordan*, 1 Brock., 254.—MARSHALL, Ch. J.; Va., 1813.

2. It is not essential to the validity of a renewed patent, that all the proceedings connected with the renewal should be set out at length. *Brooks* v. *Bicknell*, 3 McLean, 435.—MCLEAN, J.; Ohio, 1844.

3. It is sufficient if it appear that the subject was before the proper officer, and that the decision was in favor of a renewal. *Ibid.*, 435.

4. No prior use of a defective patent can authorize the use of the invention, after the emanation of the amended patent under this section. *Stimpson* v. *West Ches. R. R. Co.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

5. In an action by an administrator on a renewed patent, it is not necessary to produce the letters of administration. The patent is proof that the board (or Commissioner) was satisfied that the applicant was an administrator, and it is not competent to go behind their or his decision. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

6. After the extension of a patent, under § 18 of the patent act of 1836, the original patent becomes virtually a patent for the term of twenty-one years. *Gibson* v. *Harris*, 1 Blatchf., 169.—NELSON, J.; N. Y., 1846.

7. Upon the extension of a patent and the proper certificate, under § 18 of the act of 1836, the original patent is treated as for one seven years longer. And so if further extended by special act of Congress. If extended in both ways the original patent becomes one for twenty-eight years. *Woodworth* v. *Edwards*, 3 Wood. & Min., 125.—WOODBURY, J.; Mass., 1847.

8. And it becomes such a patent, for such term, under one and the same original specification. *Ibid.*, 125.

9. There is a marked and well recognized difference between a *renewed* and a *reissued* patent. The former grants a wholly new term, the latter legalizes and confers the right during the continuance of the original term. *McBurney* v. *Goodyear*, 11 Cush., 571.—MERRICK, J.; Mass., 1853.

10. The jury are to determine from the facts in a case, whether a renewed patent is for the same invention as the original patent. *Battin* v. *Taggert*, 17 How., 85.—MCLEAN, J.; Sup. Ct., 1854.

11. If a patentee has established his title under his original patent, he is entitled to a temporary injunction under an extension of such letters patent, without a further trial at law. *Clum* v. *Brewer*, 2 Curt., 517, 518.—CURTIS, J.; Mass., 1855.

## E. Extension by Special Laws, and Rights under.

1. A patentee under the acts of Congress may have the time of his monopoly extended by the legislature of any state beyond the term allowed by the acts of Congress. Congress may secure for a limited time an exclusive right throughout the Union; but there is nothing in the constitution to take away from the states the power to enlarge the privilege within their respective jurisdictions. *Livingston* v. *Van Ingen*, 9 John., 581.—Kent, Ch. J.; N. Y., 1812.

2. Congress may renew a patent-right, or refuse to do so. The grant of an exclusive privilege to an invention for a limited time does not imply a binding and irrevocable contract, that at the expiration of the period the invention shall become public property. *Evans* v. *Eaton*, Pet. C. C., 337.—Washington, J.; Pa., 1816.

3. A private act of Congress, authorizing the issue of a patent, is to be considered as engrafted on the general laws for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Evans* v. *Eaton*, 3 Wheat., 518.—Marshall, Ch. J.; Sup. Ct., 1818.

4. Congress has the right and power, in extending a patent by act of Congress, to modify or control the interests of assignees under the original patent, and to dispose of the whole subject as they think proper. *Blanchard's Case*, Opin., Gilpin's Ed., 1841, p. 1125.—Butler, Atty. Gen., 1837.

5. There is no restriction which limits the power of Congress in extending a patent to cases where the invention had not been known or used by the public. All that is required is, that the patentee should be the inventor. *Blanchard* v. *Sprague*, 3 Sumn., 541.—Story, J.; Mass., 1839.

6. An act of Congress granting a patent is not unconstitutional, because it acts retrospectively to give a patent for an invention which was in public use. *Ibid.*, 541.

7. The extension of a patent, after an extension under § 18 of the act of 1836, by an act of Congress, is as effectual and operative as the extension under that section, and the patent when so extended, becomes a patent for twenty-eight years instead of twenty-one years. *Gibson* v. *Harris*, 1 Blatchf., 169.—Nelson, J.; N. Y., 1846.

8. Congress may by special act extend a patent even after the expiration of the original patent. *Blanch. Gun-Stock Turning Fac.* v. *Warner*, 1 Blatchf., 274, 276.—Nelson, J.; Ct., 1846.

9. Congress has the constitutional right to confer a new and further term on the patentee, and that even after the expiration of the first. *Blanchard* v. *Haynes*, 6 West. Law Jour., 83.—Woodbury, J.; N. H., 1848.

10. Congress has the constitutional power to grant an extension of a patent after it has been once extended under § 18 of the act of 1836. The power of Congress was not exhausted in this respect by the act of 1836. *Bloomer* v. *Stolley*, 5 McLean, 160, 161.—McLean, J.; Ohio, 1850.

11. There is no provision against a second extension. The policy of the law is to compensate the inventor, and if this object be not attained by a first extension, there would seem to be justice in a second. But this can only be done by act of Congress. *Ibid.*, 162.

12. Under an extension granted by

act of Congress, there is no right on the part of an assignee or licensee to continue the use of an invention before used by them, unless such right is specially provided for and secured by the act. *Ibid.*, 163. [But see *post* 16.]

13. If Congress imposes no restriction in favor of a licensee, and there is no provision in the contract of license beyond the then existing term of the patent, none can be implied. *Ibid.*, 164.

14. If there is no reservation in an act of Congress extending a patent in favor of assignees, they have no right under the term thereby created, and they cannot even continue in the use of machines lawfully constructed before such term, and actually existing and in use when the former term expired. *Gibson* v. *Gifford*, 1 Blatchf., 531.—NELSON, J.; N. Y., 1850.

15. To enable an assignee to derive any benefit from an extension by act of Congress, an express provision should be inserted in the grant or assignment, looking to such a renewal. *Gibson* v. *Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

16. One in the lawful use of a machine under a purchase during the original term of the patent, is entitled, within the spirit and intention of the patent laws, to continue such use during an extension made by an act of Congress, unless there is something in the language of the act requiring a different construction. *Bloomer* v. *McQuewan*, 14 How., 550.—TANEY, Ch. J.; Sup. Ct., 1852.

17. A special act in relation to any particular patent is to be considered as engrafted upon the general acts relating to patents; they are statutes *in pari materia*, and all relate to the same subject and must be construed together. *Ibid.*, 550.

## FEIGNED ISSUE IN PATENT ACTIONS.

**A.** WHEN ORDERED, AND PRACTICE ON... 329
**B.** EFFECT OF VERDICT IN..... 331

### A. WHEN ORDERED, AND PRACTICE ON.

1. Where witnesses differ as to the fact of infringement, the question should be submitted to a jury, either by an action at law, or an issue directed by the court. *Brooks* v. *Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

2. Where, on a bill filed to restrain a defendant from infringing a patent-right, the infringement is denied and the evidence is conflicting, the court will send an issue to a jury, or refer the cause to a master to hear further testimony, and make a report as to the points in issue. *Parker* v. *Hatfield*, 4 McLean, 62.—MCLEAN, J.; Ohio, 1845.

3. A feigned issue, directed by the chancery side of a court, is not a mere form, but such issue is sent out to relieve the court, in matter of doubt, or because from the nature of the case, and the conflict of testimony, it is fit for a jury to decide. *Brooks* v. *Bicknell*, 4 McLean, 72.—MCLEAN, J.; Ohio, 1845.

4. In patent cases, involving the structure of complicated machinery, the sufficiency of their description, and their identity in principle with other machines, an issue is appropriately sent to a jury. *Ibid.*, 72.

5 An answer, if intended to form an issue to try the validity of a patent, because not original, should set out the names of places and persons, where and by whom a like invention or thing had been used. *Orr* v. *Merrill*, 1 Wood. & Min., 378.—Woodbury J.; Me., 1846.

6. A trial to test the validity of a patent, is not usually tried by the court in chancery, nor often in issues sent from there to the law side of the court to be settled by a jury, unless requested by the respondent. *Ibid.*, 378.

7. But where issues are sent to be tried at law, it is proper, under those issues, to have all the specific notices given by the defendant in detail of persons and places connected with the former use of the plaintiff's invention. *Ibid.*, 378.

8. On the question of the infringement of a patent, in a suit at equity, a feigned issue will not be awarded, unless the court have doubts as to the identity of the two machines. *Van Hook* v. *Pendleton*, 1 Blatchf., 194.—Nelson, J.; N. Y., 1846.

9. 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 the jury on a question is found to be needed. *Ibid.*, 195.

10. Chancery may order an issue to be tried at law to help itself as to facts, and to be retried, if dissatisfied with the verdict, or may decide facts for itself. *Woodworth* v. *Rogers*, 3 Wood. & Min., 149.—Woodbury, J.; Mass., 1847.

11. If the parties do not agree as to the issue to be tried by a jury in respect to the validity of a patent, the court will direct a suit at law to be tried speedily, to settle the conflicting title. *Ibid.*, 151.

12. In the third circuit, where a feigned issue for the trial of a fact by a jury is ordered by the court, the case can be put on the trial list at once, and the jury be sworn to try in the form and in the words of the order itself. No declaration or pleading of any sort is requisite. *Wilson* v. *Barnum*, 1 Wall, Jr., 343.—Grier, J.; Pa., 1849.

13. After a verdict for the plaintiff, in an action at law for an infringement, and the denial of a motion for a new trial on the ground of surprise in rejecting testimony, the plaintiff filed a bill for a perpetual injunction, and an account. The defendants put in their answer, setting up substantially the matters used on the motion for a new trial. Afterward they moved for leave to put in an amended answer, on the ground of the discovery of new and important evidence, affecting the novelty of the plaintiff's invention—the only question litigated on the former trial being that of infringement—and also moved for a feigned issue to try the question of the novelty of the plaintiff's invention, *Held*, that the originality of the plaintiff's invention being denied, it was a proper case for the granting of an order allowing a feigned issue. *Foote* v. *Silsby*, 1 Blatchf., 545, 546, 548.—Nelson, J.; N. Y., 1850.

14. Where on a bill for an injunction, it appeared that there had been three trials at law, in which there had been a verdict in favor of each party plaintiff and defendant, and a divided jury on the other trial, and originality of invention was denied, *Held*, that the question of originality could not be considered settled, and therefore decision was suspended on the injunction, and an account was ordered, and an issue was sent to be tried before a jury as to the ques-

tion of originality. *Allen* v. *Sprague*, 1 Blatchf., 567, 568.—NELSON, J.; N.Y., 1850.

15. A feigned issue rests in the discretion of the court. A trial at law is ordered to inform the conscience of the court, 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. *Goodyear* v. *Day*, 2 Wall, Jr., 296.—GRIER, J.; N. J., 1852.

16. In the courts of the United States the practice of sending parties to a trial at law is by no means as common as in England, or as it would be if the trouble of trying issues at law devolved upon a different court; and such courts do not always consider it a proper exercise of their discretion to order such issues to be tried at law before granting an injunction. *Ibid.*, 297.

17. Where the court, therefore, after the hearing of a cause on exhibits and proofs, and a careful consideration of the testimony, felt no doubt or difficulty on the questions of the originality of the invention, and of the fact of infringement, and the regularity of the patent, it will not send the case to the jury prior to granting a final injunction; and especially if the questions in the case do not depend so much on the credibility of witnesses, or the weight of oral testimony, as on the application of principles of science and law to admitted facts, and where a jury trial would be long and costly, and more than probable that no verdict would be obtained. *Ibid.*, 298.

18. A feigned issue to try the validity of a patent will not be granted at the request of a defendant, who has been guilty of frequent infringements, and who has before allowed judgments to be taken against him in actions at law, and taken a license under the patent, and when no mistake or misrepresentation is alleged, nor the discovery of new evidence, nor that anybody but himself disputes the validity of the patent. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

19. Where on a bill filed for the infringement of a patent, and for an injunction, the defence was set up that the invention had been known and used prior to the invention thereof by the patentee, but the evidence was so uncertain and insufficient that no satisfactory judgment could be founded upon it, *Held*, that an issue should be ordered to decide, First, whether the patentee was the discoverer or inventor of the thing patented to him, and, Second, whether such invention was known and used by others two years before the application for a patent. *Sickles* v. *Pacific Mail Steamship Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

## B. EFFECT OF VERDICT IN.

1. A verdict upon an issue ordered by a court of equity is in no just sense final upon the facts it finds, or binding upon the judgment of the court. *Allen* v. *Blunt*, 3 Story, 746.—STORY, J.; Mass., 1845.

2. The court may at its pleasure set it aside and grant a new trial, or disregarding it, may proceed to hear the cause and decide in contradiction to the verdict, or it may adopt the verdict *sub modo*, and give it a limited effect only, *Ibid.*, 746.

3. But it can never be known what effect is given to the verdict, or whether any is given to it, until a subsequent

hearing upon the merits, and a decree rendered thereon by the court. *Ibid.*, 746.

4. Whether a verdict in a suit at law is ever evidence of any thing, but the fact that it was rendered, unless a judgment has been duly rendered thereon; *query*. *Ibid.*, 746.

5. A verdict on an issue at law, directed by a court of chancery, will not be set aside on the ground it is against the weight of evidence, unless the preponderance is very clear. *Brooks* v. *Bicknell*, 4 McLean, 72, 74.—McLean, J.; Ohio, 1845.

6. After a jury have passed upon the questions submitted to them on a feigned issue, it is for the court to say whether the verdict is right; and the court may set it aside. *Van Hook* v. *Pendleton*, 1 Blatchf., 195.—Betts, J.; N. Y., 1846.

7. A verdict rendered by the jury on a feigned issue is not necessarily conclusive or controlling upon the court directing such issue; but such verdict may be disregarded, and a decree entered in opposition to it, if the court deem it proper. *Foote* v. *Silsby*, 2 Blatchf., 275.—Nelson, J.; N.Y., 1851. [Affirmed, *post* 10.]

8. Where after a suit at law, determined in favor of the plaintiffs, the plaintiffs filed their bill against the same defendants for an injunction, and a feigned issue was ordered, upon the trial of which a verdict was rendered for the defendants, the court entered a decree for the plaintiffs, notwithstanding such verdict. *Ibid.*, 275.

9. A verdict at law, or a finding in case of a feigned issue, is never conclusive upon a judge sitting in equity. The judgment of the judge upon the law and the evidence must determine his action, and not the judgment of the jury. *Day* v. *Hartshorn*, 3 Fisher, 36.—Pitman, J.; R. I., 1855.

10. The decision of the court in *Foote* v. *Silsby*, 2 Blatchf., 275, affirmed, thus in fact sustaining the position that a court of equity may disregard the finding of a jury upon the trial of feigned issues, and enter a decree in opposition to such finding. *Silsby* v. *Foote*, 20 How., 385.—Nelson, J.; Sup. Ct., 1857.

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## FOREIGN PATENT.

1. The issue of a foreign patent to one American inventor, to affect the issue of a home patent to an alleged prior inventor, on the ground that such foreign patent had been granted more than six months before the application of the latter (acts of 1836, § 8, and 1839, § 6), will be considered as having reference to the time of the original application of such prior inventor. *Wade* v. *Matthews*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1850.

2. Where M. made his first application for a patent in May, 1848, which application was afterward withdrawn, but was instantly renewed, and in the same words, and W. obtained foreign patents for the same invention in July, 1848, and before the date of such second or renewed application, *Held*, that the two applications of M. were to be considered as a continuous application, so that six months had not expired, after the issue of such foreign patents, before M.'s application. *Ibid.*

3. It seems, however, that the foreign patent, to affect the issue of a home patent to the original and first inventor,

must be issued before the American discovery. *Ibid.*

4. A British patent, being authenticated by the great seal, proves itself; but is only *prima facie* evidence, as a patent issued by our own government, that the invention was of some probable value. *Gatling* v. *Newall*, 9 Ind., 582.—PERKINS, J.; Ind., 1857.

5. A foreign patent, in order to defeat an American patent for the same invention, must have been *patented* before the discovery or invention here; and not merely before the application. *Howe* v. *Morton*, 13 Mo. Law Rep., 70. —SPRAGUE, J.; Mass., 1860.

6. An invention is not "patented" in England, within the meaning of the acts of Congress (act of 1836, § 15), until the complete specification has been enrolled, until the invention shall have been made patent to the world. *Ibid.*

7. Where letters patent were granted in England to F. and G. for improvements in sewing machines, in December, 1844, but the specification was not enrolled until June, 1845, and H. completed an invention for a similar improvement or arrangement as that described in F. and G.'s specification, in May, 1845, but his application for a patent was subsequent to June, 1845, *Held*, that F. and G.'s invention was not *patented* until after H.'s invention, and that H. was entitled to a patent under the provisions, and within the meaning of, § 15 of the act of 1836. *Ibid.*

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## FORM.

See also COLORABLE ALTERATIONS.

1. Whether an improvement is on the *principle* of a machine, or on the *form* or *proportions* merely, is a question of fact for the jury. *Rutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. An improvement in the *form* or *proportions* of a machine gives no right to use the original machine. *Ibid.*, 171 Also, *Park* v. *Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

3. A mere change of former proportions will not entitle a party to a patent. *Woodcock* v. *Parker*, 1 Gall., 440.—STORY, J.; Mass., 1813.

4. If a discovery or improvement be only in the form or proportions of a machine, it has not the merit of a discovery which can entitle the party to a patent. *Evans* v. *Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816.

5. A mere change of the form or proportions of any machine cannot, *per se*, be deemed a new invention. *Lowell* v. *Lewis*, 1 Mas., 190.—STORY, J.; Mass., 1817.

6. If the difference between a patented article and the thing made by another be only in form or proportions, they are the same in legal contemplation. *Dixon* v. *Moyer*, 4 Wash., 71.—WASHINGTON, J.; Pa., 1821.

7. Improvements in the form or proportions of an invention, adopted in consequence of the suggestions of the mechanic employed to make the specimen, or of others, are not inventions or improvements for which a patent could be obtained, nor can they invalidate the patent for the thing to which they were applied. *Pennock* v. *Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

8. Suggestions of alterations in the form or proportions of a machine are not such a discovery as will entitle the party making them to a patent therefor.

*Watson* v. *Bladen*, 4 Wash., 582.—WASHINGTON, J.; Pa., 1826.

9. It is not every change of form and proportion which is declared (under the act of 1793, § 2) to be no discovery, but such as is *simply* a change of form and proportion, and nothing more. If, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion, but of change of principle also. *Davis* v. *Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

10. In every case, it is a question for the jury, whether the change of form and proportion in an invention has produced a different effect, and is a new invention. *Ibid.*, 310.

11. A difference in the manner or form of applying an invention, if it be the same in principle, will not justify a patent. *Delano* v. *Scott*, Gilpin, 500.—HOPKINSON, J.; Pa., 1834.

12. A mere formal difference cannot be protected by a patent; the difference must be substantial. *Stanley* v. *Whipple*, 2 McLean, 38.—MCLEAN, J.; Ohio, 1839.

13. A slight alteration in the structure of a machine, or in the improvement of it, will not entitle an individual to a patent. There must be a substantial difference in the principle, and the application of it, to constitute such an improvement as the law will protect. *Smith* v. *Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

14. A machine substantially the same in operation and construction with one patented, though differing somewhat in form and arrangement, is still an infringement upon it. *Wyeth* v. *Stone*, 1 Story, 280.—STORY, J.; Mass., 1840.

15. A mere difference of form will not entitle a party to a patent. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 440.—STORY, J.; Mass., 1843.

16. A change in the manner of attaching several knives, for the purpose of grinding them, on a cylinder, instead of one, or in attaching that one to a flange on the cylinder by screws instead of attaching it to the cylinder by rings at the end; *Held*, not to be a sufficient change in form, or principle, or results, to justify a patent. *Hovey* v. *Stevens*, 1 Wood. & Min., 299, 300.—WOODBURY, J.; Mass., 1846.

17. There must be difference in principle to constitute a patentable difference. A mere change of form will not do, unless form is a part of the thing invented, and is essential to its value. *Many* v. *Jagger*, 1 Blatchf. 386.—NELSON, J.; N. Y., 1848.

18. If, however, the form is a material part of the discovery, and is essential to its value, then a departure from the form would be a substantial departure, because form is essential to the invention. *Ibid.*, 386, 387.

19. There are, however, many new manufactures, where the particular form of the thing is not essential to its utility, and there may be a departure from that form, and still be no substantial change, because the particular form is not essential to the production of the manufacture. *Ibid.*, 386, 387.

20. An improvement in a burring machine consisted of hooked teeth, cut upon rings or plates, and these so arranged upon the cylinder that the wool or cotton, when taken up by the teeth, would be drawn into the interstices between the teeth, leaving the burrs and other foreign substances on the surface, to be knocked off by the beater; *Held*, that the change of form of the teeth from that of gullet teeth, having large slots

at the bottom, to that of the letter V, so as to make the slots at the bottom smaller, to operate better on the cotton, &c., was not a substantial change in the construction, but a modification of form, which was a natural result of working the machine. *Parkhurst* v. *Kinsman*, 1 Blatchf. 491, 497, 498.—NELSON, J.; N. Y., 1849.

21. Form and structure are very important matters in machinery: if they enable the operator to do the work in a better manner, or with more ease, or less expense, or in less time, they are not an interference, but constitute a patentable improvement. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

22. When the application is for a patent for a combination of machinery and materials, form and structure become *substance*. Form and structure constitute the identity of machinery. *Ibid.*

23. A mere difference in form or size is not a difference in principle. *Foote* v. *Silsby*, 1 Blatchf., 459.—NELSON, J.; N. Y., 1849.

24. A formal change in a machine by a defendant, will not distinguish the invention or thing used from that of the plaintiff. That is an evasion. The change must be substantial. It must be a difference in the mechanical structure, in the physical existence of the thing, and also in its practical operation and effect in producing the result. *Buck* v. *Hermance*, 1 Blatch., 406.—NELSON, J.; N. Y., 1849.

25. A mere change in form or proportion, or a substitution of mechanical means or equivalents in any one or all the elements of a combination producing the same results, does not constitute a substantial difference. *Gorham* v. *Mixter*, 1 Amer. Law Jour., N. S., 543.—SPRAGUE, J.; Mass., 1849.

26. 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 patent law, sufficient to support a patent. *Hall* v. *Wiles*, 2 Blatchf., 200.—NELSON, J.; N. Y., 1851.

27. A change in the form of a machine, embodying, however, the principle and substance of a prior invention, and which is only the result of practical experience in the use of such prior invention, is not an improvement upon such former invention. *Tracy* v. *Torrey*, 2 Blatchf., 278.—NELSON, J.; N. Y., 1851.

28. A change in form from the construction of an existing machine, or in its proportions, is not a substantial change, in the eye of the patent law. Such changes require no great ingenuity, and do not call for the exercise of the inventive faculty; they are simply the work of a mechanic. *Tatham* v. *Le Roy*, 2 Blatchf., 485, 486.—NELSON, J.; N. Y., 1852.

29. Under our law, a patent cannot be granted for merely a change of form. § 2 of the act of 1793 so declared in express terms, and though this declaratory law was not re-enacted in the law of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. *Winans* v. *Denmead*, 15 How., 341.—CURTIS, J.; Sup. Ct., 1853.

30. Merely to change the form of a machine is the work of a constructor, not an inventor: such a change cannot be deemed an invention. *Ibid.*, 341.

31. Where a patent was granted for constructing the body of a railroad car in the form of the frustum of a cone, and the claim was for making it in such form whereby certain specified advau-

tages were secured, and a new and useful result produced, and the defendants constructed the body of their car *octagonal*, the effect of which was, however, the same as when made circular, as described in the plaintiff's patent; *Held*, that it was an infringement upon plaintiff's patent, and that the plaintiff's patent, though describing only the form of a frustum of a cone, embraced every such variation of form as substantially embodied his mode of operation, and thereby attained the same result. *Ibid.*, 341–344. (TANEY, Ch. J.; CATRON, DANIEL, and CAMPBELL, JJ., dissenting.)

32. Where a particular geometrical form is alone capable of embodying a patentee's invention, if the form is not used, the invention is not copied, and there is no infringement; otherwise where that particular form is the best, but other forms may and do embody the invention. *Ibid.*, 343.

33. Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. *Ibid.*, 343.

34. Where a patentee describes a machine, and then claims it as described, he is generally understood to claim, and does, by law, actually cover, not only the precise forms he has described, but all other forms which embody his invention. *Ibid.*, 343.

35. There may be cases, as in *Davis* v. *Palmer*, 2 Brock., 309, where the letters patent include only the particular form described and claimed; but the reason why such a patent covers only one geometrical form is not that the patentee has described and claimed that form only, but because such form only is capable of embodying his invention; and consequently, if the form is not copied, the invention is not used. *Ibid.*, 343.

36. Where form and substance are inseparable, it is enough to look at the form alone. 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 no defence that it is embodied in a form not described, and in terms not claimed by the patentee. *Ibid.*, 343.

37. It is a well settled principle of law, that the mere change in the form of machinery (unless a particular form is specified as the means by which the effect described is produced), or an alteration in some of its unessential parts, or in the use of known equivalent powers, not varying essentially the machine, or its mode of operation, or organization, will not make the machine a new invention. *O'Reilly* v. *Morse*, 15 How., 123.—TANEY, Ch. J.; Sup. Ct., 1853.

38. A mere change in the form of machinery, or the means specified by which the result or effect described is produced, or an alteration in some unessential parts, or a substitution or use of known mechanical powers, not varying essentially the machine, or its mode of operation or organization, is not invention. *Amer. Pin Co.* v. *Oakville Co.*, 3 A. L. R., 138; 3 Blatchf., 192.—NELSON, INGERSOLL, JJ.; Ct., 1859.

39. Where in a patent for improvements in cooking stoves, the claim was

"the placing the fire-chamber in the middle of the oven, so that the latter may receive the heat on three sides at once," but there was no peculiarity in the oven or fire-chamber, and the invention appeared to be, that instead of forming three ovens or compartments around the fire-chamber as usual, the inventor removed the partitions behind the fire-chamber, and made a single cooking space instead of three; *query*, whether the change is a patentable discovery. *Wilson* v. *Jones* 3 Blatchf., 229.—BETTS, J.; N. Y., 1854.

40. A change of form merely, or of mechanical structure, the practical effect of which is small, and from which no new or materially improved result is obtained, is not the subject of a patent. *Sargeant* v. *Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

41. A patent for an improvement in apple-paring machines, consisted in so attaching the knife-block to the rod, which moves it, as to allow the knife-block to rotate round the rod at right angles, to accommodate itself to any irregularities in the surface of the fruit. The defendants, instead of making the knife movable in the rod, made the rod movable in its socket, but the knife-block had the same motion; *Held*, that it was only a change of form, and an infringement on the patent. *Ibid.*, 349.

42. If the article produced is substantially the same with the one patented, the variations being in form and not in substance, or where no new or substantial result is produced, it will not affect the right of the patentee, but is an infringement on his rights. *Teese* v. *Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

43. Mere formal changes of machinery do not evade a patent. *Sickles* v. *Borden*, 3 Blatchf., 541.—NELSON, J.; N. Y., 1856.

44. However different apparently the arrangements and combinations of a machine may be from the machine of an inventor, it may in reality embody his invention, and be as much an infringement as if it were a servile copy of the plaintiff's machine. *Ibid.*

45. A change in the forms or proportions of instrumentalities—a substitution of one motive power for another—a different position or gearing of the working apparatus—a superior finish in any other particular, resting in mere mechanical skill or taste, and not involving invention—does not render machines appearing to the eye exceedingly unlike, substantially different in judgment of law. *Smith* v. *Higgins*, MS. —BETTS, J.; N. Y., 1857.

46. Although there may be a difference in form between two devices adopted for a given purpose, yet if there is no substautial difference in principle, a patent will not be granted. *Chatfield & Dutcher*, *Ex parte*, MS. (App. Cas.) —MORSELL, J.; D. C., 1859.

47. Differences in size and proportions, so long as the construction, arrangement, principles, and mode of operation are substantially the same, are entirely immaterial. *Cahoon* v. *Ring*, 1 Fisher, 411.—CLIFFORD, J.; Me., 1859.

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## FRAUD AND FRAUDULENT INTENT IN RESPECT TO PATENTS.

1. If, of two joint inventors of a machine, one of them, without the other relinquishing his interest to a joint interest in the patent-right, obtains a pat-

ent in his own name, he will be deemed guilty of a fraud, and will in equity be considered as a trustee for the other. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. Under § 6 of the act of 1793 no defect or concealment in a specification will avoid a patent unless it arose from an intention to deceive the public. *Whittemore* v. *Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813.

3. In an action for fraud in the sale of a patent-right, it is competent for the party to show that a previous patent had been granted for the same invention as that sold by the defendant. *Bull* v. *Pratt*, 1 Conn., 346.—SWIFT, Ch. J.; Ct., 1815.

4. The refusal of a defendant to submit his claim for a patent to arbitration, under § 9 of the act of 1793, and subsequently obtaining a patent after the plaintiff had obtained his, is not of itself *conclusive* proof, in an action brought under § 10 of the same act, that the patent of the defendant had been obtained surreptitiously or upon false suggestion. *Stearns* v. *Barrett*, 1 Mas., 174.—STORY, J.; Mass., 1816.

5. Under the act of 1793 if a specification is materially defective, it will not invalidate the patent unless the jury are satisfied that the concealment of the circumstances was intended to deceive the public. *Gray* v. *James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817.

6. What degree of evidence will be required to prove such fraudulent intention rests with the jury to decide. Positive evidence can seldom be expected, nor is it necessary. It may be presumed from circumstances, which would be sufficient to authorize the jury to find the fact. *Ibid.*, 402.

7. If the specification is not so full, clear, and exact as to enable a skilful person to compound and use the same, this, under § 6 of the act of 1793, does not avoid the patent, unless the defective concealment or description has been made for the purpose of deceiving the public. *Lowell* v. *Lewis*, 1 Mas., 190.—STORY, J.; Mass., 1817.

8. A patent cannot be said to have been obtained surreptitiously or in fraud of another's right, under § 6 of the act of 1793, if the inventor gave up his right of discovery to the patentee, by expressly or impliedly permitting him to encounter the trouble and expense of obtaining a patent. *Dixon* v. *Moyer*, 4 Wash., 71, 72.—WASHINGTON, J.; Pa., 1821.

9. If a patentee include in his patent along with his own invention the invention of another person previously patented, and sell the whole to a person ignorant of these facts, and who supposed he was buying an exclusive right to the whole, the sale is a fraud upon such person, and the vendor cannot recover a note given for the purchase. *Turner* v. *Johnson*, 2 Cra. C. C., 287.—CRANCH, J.; D. C., 1822.

10. If an inventor suffer his invention to go into general and public use without objection, and assert no title to it for years, and then afterward attempts to gain the exclusive right by a patent, and secure it by a patent, such attempt would operate as a fraud upon the public. *Mellus* v. *Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825.

11. If the public, with the knowledge and tacit consent of the inventor is permitted to use an invention without opposition, it is a fraud upon that public afterward to take out a patent. *Pennock* v. *Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

12. Under the act of 1790, if an inventor allowed his invention to go into public use, it was deemed a fraud in law if after such use he took out a patent, such use being considered as an abandonment. *Whitney* v. *Emmett*, Bald., 309, 310.—BALDWIN, J.; Pa., 1831.

13. Under the act of 1793, evidence of fraudulent intent as to the concealment or addition of something contained in the specification of a patent, is required only in the particular case, and for the particular purpose stated in § 6, that is, to annul the patent. *Grant* v. *Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832.

14. If a party should seek to include several distinct improvements in one patent, so that there should be but one surrender, and the payment of but one fee under § 13 of the act of 1836, and take out several new patents, it would be such a "fraudulent and deceptive intention" as would prevent the issuing of a patent after the surrender. *Anon.*, 3 Opin., 165.—BUTLER, Atty. Gen., 1836.

15. A offered to sell a patent-right to B, who declined to purchase unless C would join with him. A then went to C and agreed with him that he should join with B, and that he, A, would take the notes of each for half the agreed sum; but as soon as the business was closed he would give back to C his note, and pay him for thus inducing B to buy. B was thus induced to buy, but he afterward sold his interest for more than he gave for it. In an action by B against A for the fraud, *Held*, that B had a right to recover against A any damages he might have suffered by not having C as a joint owner to aid or assist in making sales of the patent, and that the fact that he had sold his interest for more than he gave for it, did not show that he had not sustained damage. *Culver* v. *Webb*, 12 Conn., 441, 443.—WAITE, J.; Ct., 1838.

16. An inventor who has first actually perfected his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at the time using reasonable diligence in adapting and perfecting the same. *Reed* v. *Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

17. The defence authorized by § 15 of the act of 1836, that the plaintiff had "surreptitiously or unjustly obtained his patent for that which was in fact invented or discovered by another," is only applicable in the case of a patent so obtained, while the "first inventor was using reasonable diligence in adapting and perfecting his invention;" and if pleaded, it may be necessary for the defendant to show, in order to vacate such patent, that he was using reasonable diligence, when the patent was obtained. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

18. Though the provision rendering a patent valid, notwithstanding too much is claimed in the specification, is limited to cases where the excessive claim was made by mistake and without fraudulent intent, still, as fraud is not to be presumed, the patentee claiming the benefit of the provision, need not prove that he acted under a mistake and from honest motives. Those who attack the patent must establish the fraud. *Hotchkiss* v. *Oliver*, 5 Denio, 318.—McKISSOCK, J.; N. Y., 1848.

19. Where fraud is charged upon a party, in respect to his patent, it must be made out at least *prima facie*. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1850.

20. The fact of procuring a patent for a new and useful machine, under the assumption of a reissue, which was not useful as patented in the surrendered patent, for want of some parts used in the reissued patent, would present a question of fraud, committed on the public by the patentee, by giving his reissued patent date as an original discovery, made at the time of the original patent, and thereby overreaching similar inventions made between the time of the original patent and the time of the reissued patent. *Brooks* v. *Fiske*, 15 How., 220.—CATRON, J.; Sup. Ct. 1853.

21. A question of fraud in the granting of a patent will not be passed upon by the justices of the Circuit Court of the District of Columbia, on an appeal from the decision of the Commissioner of Patents, but such question is to be tried by a jury. *Burlew* v. *O'Niel*, MS. —MORSELL, J.; D. C., 1853.

22. Where a party seeks in equity to have an assignment of a patent rescinded, and the consideration restored to him, on the ground of fraud, but he has acted under such assignment by making sales under it, he should aver that any such proceeds were received by him prior to the discovery of the fraud, and he should return, or offer to return, the consideration received by him. He that asks, must do equity. *Edmunds* v. *Myers*, 16 Ill., 210, 211.—SCATES, J.; Ill., 1854.

23. If fraud has been practised, as in the sale of a pretended patent, a court may rescind the contract, and compel a return of what has been paid; but it will at the same time compel the complainant to account for what he has received, and the profits derived from the use or sale of it. *Ibid.*, 211.

24. Parties defrauded, or those injured by the fraud, can alone take advantage of it, to annul a contract. *Edmunds* v. *Hildreth*, 16 Ill., 215.—SCATES, J.; Ill., 1854.

25. Parties to a fraud cannot avoid the act for the fraud. *Ibid.*, 215.

26. If the party injured acquiesce in, or confirm the contract with a knowledge of the fraud, no one can have a right to annul it for him. *Ibid.*, 216.

27. A contract for the purchase of a patent, may be rescinded for false and fraudulent representations, constituting an inducement to it, and whether the party making them knew them to be false or not. *Gatling* v. *Newall*, 9 Ind., 576.—PERKINS, J.; Sup. Ct., Ind., 1857.

28. But such representation must be as to a fact or facts, and go to a material issue; and must be one on which the party to whom it is made has a right to, and does rely. *Ibid.*, 576.

29. A party, however, who would rescind a contract on the ground of fraud, must offer to do so within a reasonable time after the fraud is discovered. *Ibid.*, 577.

30. The defence that the plaintiff had "surreptitiously and unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same," does not necessarily imply bad faith on the part of the patentee, against whose patent this defence is set up. The injustice relied on is rather injustice in the abstract, than resulting from any intentional wrong of such patentee. The words were intended to be used, and are used in their broadest sense. *Phelps, Dodge & Co.* v. *Brown Bros.*, 4 Blatchf., 364. —NELSON, J.; N. Y., 1859.

# GENERAL ISSUE AND NOTICE OF SPECIAL MATTER.

**A.** EVIDENCE UNDER GENERAL ISSUE..... 341
**B.** WHEN NOTICE REQUIRED; WHAT TO CONTAIN..... 342
**C.** WHEN SPECIAL PLEAS ALLOWABLE.... 346

## A. EVIDENCE UNDER GENERAL ISSUE.

1. There is no limitation of time in which a defendant may not plead the general issue and give in evidence that the plaintiff was not the original inventor of the thing for which the patent was granted. *Evans* v. *Eaton*, Pet. C. C., 348.—WASHINGTON, J.; Pa., 1816.

2. Whether in an action for an infringement of a patent-right under the general issue, the objection can be taken to the validity of the patent, that the thing patented was not useful, and had been abandoned; *query*. The defence is by no means involved in the general issue. *Gray* v. *James*, Pet. C. C., 402.—WASHINGTON, J.; Pa., 1817.

3. The originality of an invention is not in issue on a plea of not guilty. *Evans* v. *Hettick*, 3 Wash., 411.—WASHINGTON, J.; Pa., 1818.

4. Under the plea of the general issue, the defendants may give in evidence the act of Congress without notice; but this permission extends no further than to exempt the defendant from the necessity of pleading the statute specially, which, where it is of a private nature, it would otherwise be necessary to do. *Kneass* v. *Schuylkill Bank*, 4 Wash., 11.—WASHINGTON, J.; Pa., 1820.

5. Matters of a special nature, other than those enumerated in § 6 of the act of 1793, as alienage of the plaintiff, and a license by him to use the patented invention may also be given in evidence under the general issue. *Ibid.*, 11.

6. The defences enumerated in § 6 of the act of 1793, that the specification does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the desired effect, and this with a view to deceive the public, cannot be set up at the trial, unless due notice has been given to the plaintiff. *Ibid.*, 13.

7. But under the general issue without notice, the defence may be made that the patent is broader than the discovery; that it is for an improvement which the specification does not so particularly describe as to distinguish it from the original invention; that the suggestions of the petition are not recited in the patent, and others similar in principle. *Ibid.*, 13.

8. Evidence on the part of the defendant as to whether the machine used by him is like the model of plaintiff's machine, produced in court, is proper under the general issue, and no notice is necessary to authorize such inquiry. *Evans* v. *Hettick*, 7 Wheat., 469.—STORY, J.; Sup. Ct., 1822.

9. Under the plea of the general issue, without a notice to that effect, or special pleas setting up such defence, evidence tending to show a want of novelty in the invention claimed by the plaintiff, is not admissible. *Root* v. *Ball*, 4 McLean, 180.—MCLEAN, J.; Ohio, 1846.

10. A witness cannot be asked whether there are not other machines in use similar to that patented by the plaintiff, unless notice is given, as the statute requires. *Parker* v. *Haworth*, 4 McLean, 371.—MCLEAN, J.; Ill., 1848.

11. Under a plea of the general

issue, evidence may be introduced to show fraud or fraudulent representations on the part of the plaintiff as to the subject matter of the suit. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1850.

## B. WHEN NOTICE REQUIRED; WHAT TO CONTAIN.

1. § 6 of the act of 1793, does not enumerate all the defences of which the defendant may legally avail himself; he may give in evidence that he never did the act attributed to him, that the patentee is an alien not entitled under the act, or that he has a license or authority from the patentee. *Whittemore* v. *Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813.

2. Under § 6 of the act of 1793, in an action for a violation of a patent, if the general issue be pleaded with notice of special matter that the patentee is not the original inventor, it will be sufficient in such notice to state that the plaintiff is not the first inventor, without setting forth who was the inventor, or specifying where the machine had been used. *Evans* v. *Kremer*, Pet. C. C., 215.—WASHINGTON, J.; Pa., 1816.

3. If the notice specify where the machine had been used, evidence may be given of its use in other places than those particularly specified. *Ibid.*, 215.

4. Under a notice of special matter, specifying certain places in which a machine like that of which the plaintiff claimed to be the inventor, had been in use anterior to the supposed discovery of the plaintiff; *Held*, that the plaintiff could give in evidence that such machine had been used in places other than those particularly named in the notice. *Evans* v. *Eaton*, Pet. C. C., 338.—WASHINGTON, J.; Pa., 1816. [Affirmed *post* 11.]

5. All matters of defence or of objection to a patent are not enumerated in §§ 6 and 10 of the act of 1793. *Lowell* v. *Lewis*, 1 Mas., 186.—STORY, J.; Mass., 1817.

6. But it is not a matter of defence that the invention of the patentee is not of such general utility as to supersede others of the same kind in use. *Ibid.*, 186.

7. The object of the statute of 1793, ch. 9, § 6, was to guard against defeating patents by the setting up a prior invention which had never been reduced to practice. If it was the mere speculation of a philosopher or a mechanician, which had never been tried by the test of experience, and never put in actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. *Bedford* v. *Hunt*, 1 Mas., 305.—STORY, J.; Mass., 1817.

8. Although in the statute, § 6 of the act of 1793, a prior patent is not mentioned in the notice of special matter to be given in evidence, this omission does not afford sufficient ground to reject such evidence, but it furnishes a reason to require the defendant to give a satisfactory explanation of the principles of the machine described in such patent, and the manner in which it is operated. *Gray* v. *James*, Pet. C. C., 400.—WASHINGTON, J.; Pa., 1817.

9. The section of the patent act relative to notices of special matter with the general issue, appears to have been drawn on the idea that the defendant would not be at liberty to contest the validity of a patent on the general issue;

and intends to relieve the defendant from the difficulties of pleading, by allowing him to give in evidence matter which affects the patent. Such notice is however for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of the privilege. *Evans* v. *Eaton*, 3 Wheat., 503, 504.—MARSHALL, J.; Sup. Ct., 1818.

10. And such notice need only be given when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course, but may set up the special matter, by special pleas, and then the plea is the only notice the plaintiff can claim. *Ibid.*, 504.

11. Under such notice evidence may be given as to previous use, not only as to the places specified in the notice, but also as to other places not specified. *Ibid.*, 504, 505.

12. Under a notice that evidence would be offered to prove that the patentee was not the original discoverer of the thing patented, but that it had been in use in various places in the *United States*, evidence cannot be given of a prior use in England. *Dixon* v. *Moyer*, 4 Wash., 74.—WASHINGTON, J.; Pa., 1821.

13. No notice is necessary to authorize the inquiry by defendant of a witness on his examination in chief, whether the machine used by defendant was like the model of plaintiff's machine exhibited in court. Such inquiry is perfectly proper under the general issue. *Evans* v. *Hettick*, 7 Wheat., 469.—STORY, J.; Sup. Ct., 1822.

14. If the notice of special matter mention the names of certain persons who had used the invention before plaintiff's patent, evidence may be given of its prior use by persons other than those named. *Treadwell* v. *Bladen*, 4 Wash., 705.—WASHINGTON, J.; Pa., 1827.

15. § 6 of the act of 1793 does not enumerate all the defences which a party may make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. *Pennock* v. *Dialogue*, 2 Pet., 23.—STORY, Sup. Ct., 1829.

16. It is not inconsistent with the principle or meaning of such section that a defence may be made, that, although the patentee is the first as well as the true inventor, he has abandoned or dedicated his invention to the public. *Ibid.*, 23.

17. A party who only seeks to defend himself, may either plead specially or plead the general issue, and give the notice required by § 6 of the act of 1793. If he shows that the patentee has failed in any of the prerequisites on which the authority to issue the patent is made to depend, his defence is complete, and he is entitled to the verdict of the jury and the judgment of the court. *Grant* v. *Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

18. But if not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to § 6 of the act of 1793, and "fraudulent intent" must be found by the jury to justify a judgment of *vacatur* by the court. *Ibid.*, 247.

19. The defendant is permitted to proceed according to § 6, but is not prohibited from proceeding in the usual manner, so far as respects his defence, except that special matter may not be given in evidence on the general issue, unaccompanied by the notice which that section requires. *Ibid.*, 247.

20. Where a defendant in a patent suit relies on the fact of previous invention, knowledge, or use of the thing patented, he must, under § 15 of the act of 1836, give notice of the persons by whom he intends to prove such fact. Without such notice he cannot examine witnesses relative thereto, and the *onus probandi* is on the defendant to show that the notice has been given. *Phil. & Tren. R.R.* v. *Stimpson*, 14 Pet., 459.—STORY, J.; Sup. Ct., 1840.

21. The language of the act of 1836, § 15, requires nothing more than the names and residences of the persons who possessed the prior knowledge of the thing patented, and the names of the places at which it had been used. The names and residences of all the witnesses who are to be summoned need not be given. *Wilton* v. *The Railroads*, 1 Wall, Jr., 195.—GRIER, J.; Pa., 1847.

22. This provision was intended to guard against surprise from such evidence as was given in Whitney's case, the cotton gin; one witness testifying that he had seen such an invention in England, seventeen years before; and another, that he had seen a like machine in Ireland. *Ibid.*, 195.

23. In the notice of special matter, the defendant is only required to give notice of the name of the person having a prior knowledge, and need not give the names of the witnesses by whom such prior knowledge is to be proved. *Many* v. *Jagger*, 1 Blatchf. 376.—NELSON, J.; N. Y., 1848.

24. The defendants, in their notice of special matter, under § 15 of the act of 1836, had given notice that one Baldwin had had prior knowledge of the plaintiff's invention before his patent therefor. On the trial, they called one Fry as a witness to prove that Baldwin had such prior knowledge. The witness was objected to, because his name was not in the notice; but the court held he was a competent witness to prove such fact, and that it was not necessary to insert his name in the notice. *Ibid.*, 376.

25. In the notice of special matter given under § 15 of the act of 1836, reference was made to a certain work as "Ure's Dictionary of Arts, Manufactures, and Mines," the title-page of which read, "A Dictionary of Arts, Manufactures, &c., by Andrew Ure, M. D., &c., London, &c., 1840;" *Held*, that the title was sufficiently correctly indicated in the notice. *Foote* v. *Silsby*, 1 Blatchf., 451, 452.—NELSON, J.; N. Y., 1849.

26. *Held*, however, that no part of the work could be read in evidence, because the notice did not specify any page or heading to which reference would be made. The volume contained 1,334 pages, and was arranged alphabetically. A general reference to a work is calculated to mislead and embarrass a party; there should be a particular reference to the part of the book intended to be relied on. *Ibid.*, 454, 462. [Affirmed *post* 30.]

27. *Held*, also, that under such notice the book was not admissible for the purpose of showing that the invention was previously known to Dr. Ure, the author of the work. *Ibid.*, 454, 462.

28. *Held*, also, in the case of such a defective notice, that it was not competent, with a view to show that the notice was sufficiently explicit and specific and thus allow the book to be read in evidence, to prove by experts and scientific men that they could, in seeking information as to the subject matter of the

plaintiff's patent, without difficulty find the portions proposed to be read, without special reference to them. *Ibid.*, 454, 462.

29. Nor can a public work be read in evidence to show a want of novelty in the plaintiff's invention, the only notice of which volume was given in a special plea, which had, before the trial, been stricken out by the court. *Ibid.*, 454, 462.

30. A general reference, in a notice of special matter with the general issue, to a volume, as "Ure's Dictionary of Arts, Manufactures, and Mines," in which an invention has been described, is not sufficient, but there must be a more particular reference to the part relied on, either by pages, titles, or otherwise. *Silsby* v. *Foote*, 14 How., 222.—CURTIS, J.; Sup. Ct., 1852.

31. Nor can such book, under such a notice, be referred to as evidence of prior knowledge and use, by said Ure, the notice not stating where the thing was used. *Ibid.*, 224.

32. In an action of infringement, a defendant will not be allowed to surprise a patentee by evidence of a prior invention, of which no notice has been given, even though such evidence is contained in a volume of law reports, which are usually cited as of course. *O'Reilly* v. *Morse*, 15 How., 110.—TANEY, Ch. J.; Sup. Ct., 1853.

33. A notice of special matter may be filed, or served, in term-time, but it must be filed full thirty days before trial. *Brunswick* v. *Holzalb*, MS.—LEAVITT, J.; Ohio, 1858.

34. Notices of special matter, in the seventh circuit, as to the prior use of the invention, the places where used must specify the street or factory where the structure was used, which was claimed to be the same as that patented, or the name of the person or owner using it should be given; the name of the city or town is not sufficiently definite as to *place*. *Latta* v. *Shawk*, 1 Fisher, 467.—LEAVITT, J.; Ohio, 1859.

35. It is always presumed from the patent itself that the invention is new, and if a party sued would avail himself of the want of such novelty, it is incumbent upon him to prove it by giving a proper notice to the plaintiff to prevent surprise. *Coleman* v. *Leisor*, MS.—LEAVITT, J.; Ohio, 1859.

36. The provision of the statute requiring notice of the previous use of a patented thing is designed to give the patentee the benefit of an examination into the facts of the supposed prior use. *Ibid.*

37. In the seventh circuit such notice must specify the particular place of such prior use; a reference merely to the county in which such prior use happened is not sufficient. *Ibid.*

38. Under the provision of § 15 of the act of 1836, a defendant may, under the general issue, and with notice as required by that act, give any special matter in evidence, tending to prove that the patentee was not the original and first inventor or discoverer of the thing patented, or a substantial or material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery by the patentee, or had been in public use or on sale, with the consent and allowance of the patentee, before his application for a patent. *Teese* v. *Huntingdon*, 23 How., 7.—CLIFFORD, J.; Sup. Ct., 1859.

39. But whenever the defendant relies on the fact of a previous invention, or knowledge, or use, he must state in

his notice the names and places of residence of those who had such prior knowledge of the thing, and where the same had been used. *Ibid.*, 7.

40. No order of court is necessary to entitle a defendant to serve and file the notice of special matter required in § 15 of the act of 1836. It is only necessary that such notice be in writing, and be served more than thirty days before the trial. *Ibid.*, 10.

41. And if a first notice is defective, or not sufficiently comprehensive to admit the proper defence, the defendant may give other notices to remedy such defect, or supply the deficiency. *Ibid.*, 10.

42. Under such notice, depositions taken before the notice was served, as well as those taken afterward, are admissible, provided the depositions are applicable to the matters thus put in issue. *Ibid.*, 10.

43. In the seventh circuit, in the notice given of the prior use of a patented invention, it is necessary not only to state where and by whom it was so used, but such notice should also set forth the name of the person who had knowledge of such use, and by whom such fact is to be proved. *Judson* v. *Cope*, 1 Fisher, 617.—LEAVITT, J.; Ohio, 1860.

44. Notice of the time when the person possessed the knowledge or use of the invention is not required by the act; the name of the person, and of his place of residence, and the place where it has been used, are sufficient. *Phillips* v. *Page*, 24 How., 168.—NELSON, J.; Sup. Ct., 1860.

## C. WHEN SPECIAL PLEAS ALLOWABLE.

1. The notice mentioned in the statute is required only to be given 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. And a plea would not be defective which did not state the places in which the thing alleged to have been previously used was placed or used. *Evans* v. *Eaton*, 3 Wheat., 504.—MARSHALL, Ch. J.; Sup. Ct., 1818.

2. If the defendant only seeks to defend himself, he may either plead specially or plead the general issue, and give the notice required by § 6 of the act of 1793 of any special matter he means to use at the trial. If he shows that the patentee has failed in any of the prerequisites on which the authority to issue the patent is made to depend, his defence is complete. *Grant* v. *Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. But if he seeks to annul the patent, he must proceed in exact conformity to § 6 of the act of 1793. *Ibid.*, 246.

4. The defendant is permitted to proceed according to § 6, but is not prohibited from proceeding in the usual manner, so far as respects his defence, except that special matter may not be given in evidence on the general issue unaccompanied by the notice which that section requires. *Ibid.*, 247.

5. Instead of pleading the general issue, and giving notice of special matter as authorized by the statute, the defendant may plead special pleas, setting up the matters of which he could give notice. The right to plead the general issue, and give notice, is an enlargement of the defendant's mode of defence, but does not take away his right to plead

specially. *Phillips* v. *Comstock*, 4 McLean, 525.—McLean, J.; Ind., 1849.

6. In an action for the infringement of a patent, the defendants pleaded the general issue, and also numerous special pleas, and also gave notice of special matter under § 15 of the act of 1836. The matters set forth in the special pleas were those of which notice might have been given under § 15. On motion the special pleas were struck with costs. *Wilder* v. *Gayler*, 1 Blatchf., 597, 598. —Nelson, J.; N. Y., 1850.

7. The matters required by § 15 to be set forth in the notice accompanying the general issue, cannot be plead specially as matters of defence. *Ibid.*, 598. [Overruled, 1853, *post* 12, 13.]

8. There may, however, be grounds of defence not specified by § 15, which might be set up in bar of the action, by special plea. *Ibid.*, 598.

9. The defences, mentioned and allowed by § 15 of the act of 1836, to be given in evidence with the general issue, by way of notice, need not, however, be made in such particular manner, but may also be set up by special pleas. *Smith* v. *Ely*, 15 How., 141.—Taney, Ch. J.; Sup. Ct., 1853.

10. A defendant is not limited to the plea of the general issue, even if his defence rests upon matters which may by statute be given in evidence under the general issue, but he may plead those matters specially. *Day* v. *N. E. Car Spring Co.*, 3 Blatchf., 181.—Betts, J.; So. N. Y., 1854.

11. To an action for the infringement of a patent brought by an assignee of the patentee, the defendant, with the general issue, pleaded special pleas, not impeaching the validity of the patent, or denying his use of the patented invention, but setting up a license under the patentee paramount to the right of the plaintiff; *Held*, that such pleas did not amount to the general issue, and should not be stricken out on motion. *Ibid.*, 182.

12. Under the decisions of the Supreme Court, *Evans* v. *Eaton*, 3 Wheat., 504, and *Grant* v. *Raymond*, 6 Pet., 246, in actions at law for the infringement of a patent, a defendant is not limited in his defence to the plea of the general issue, even if his defence rests upon matters which the statute authorizes to be given in evidence under § 15 of the act of 1836, but he may plead those particulars specially. *Ibid.*, 181.

13. The case of *Wilder* v. *Gayler*, 1 Blatchf., 598, in so far as it is in conflict with those cases must be considered erroneous and not a binding authority. *Ibid.*, 181

14. Where notice of special matter is given under the general issue, special pleas cannot also be filed; at least, such seems to be the practice in the seventh circuit. *Latta* v. *Shawk*, 1 Fisher, 467. —Leavitt, J.; Ohio, 1859.

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## GOOD-WILL OF BUSINESS.

1. The good-will of an established trade, the custom of an inn, and the right of a publisher of books, may be injured by acts of deception and piracy; but the injury for which redress is given in such cases results from the imposture practised upon the customers of an existing establishment or upon the public. *Snowden* v. *Noah*, Hop. Ch., 352.—Walworth, Chan.; N. Y., 1825.

2. The good-will of a trade does not survive, but is partnership property. The continuing partners cannot be com-

pelled to take the lease and good-will at a valuation, as that would be compelling them to become purchasers. *Dougherty* v. *Van Nostrand*, 1 Hoff. Ch., 69.—HOFFMAN, V. Ch.; N. Y., 1839.

3. If not disposed of by consent, the good-will must be sold as other partnership property. *Ibid.*, 69.

4. The good-will of a business built up by the several partners belongs equally to all, and is an important and valuable interest, which the law recognizes and will protect. *Williams* v. *Wilson*, 4 Sand. Ch., 380.—SANDFORD, V. Ch.; N. Y., 1846.

5. Unless otherwise arranged between the partners, such good-will will be sold with the lease of the place where carried on, and either of the partners may become purchasers. If neither purchase, all will be restrained from conducting the same business, either directly or indirectly, in the same place. *Ibid.*, 381.

6. It is a well settled rule that the good-will of a partnership business does not survive to a continuing partner. It belongs to a firm as much as the ordinary stock-in-trade, and must be disposed of in some manner for the benefit of the firm. *Howe* v. *Searing*, 19 How. Pr., 17.—HOFFMAN, J.; N. Y., 1860.

7. Good-will resolves itself into reputation. *Ibid.*, 17.

8. The sale of the good-will of a business does not transfer a right to the use of the vendor's *name of trade*. *Ibid.*, 25.

9. Where the plaintiff sold to the defendant's assignor his lease of the premises known as "Howe's Bakery," together with the stock-in-trade, and the "good-will of the business of baking, now or heretofore carried on by me in the city of New York," *Held*, that the plaintiff was entitled to an injunction to restrain the defendant from designating his bakery establishment as "Howe's Bakery," and from otherwise using the name of *Howe* in his business, so as to induce the public to believe that the business carried on by him was carried on by the plaintiff. *Ibid.*, 25.

10. It is a principle of public policy that any business should be transacted under the name of the actual partners doing it, and not under other names. *Ibid.*, 25.

11. The neglect of a party to carry on his business for a number of years does not prevent him from resuming the same, or entitle another to use the name of his business. *Ibid.*, 25.

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## GRANTEE OF PATENT, WHO IS.

See ASSIGNEE, B. 1.

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# IMPROVEMENTS.

**A.** WHAT PATENTABLE; AND TO WHAT EXTENT..... 348
**B.** HOW SHOULD BE SET FORTH..... 352
**C.** PATENT FOR; WHAT SECURED BY; CONSTRUCTION OF..... 355

## A. WHAT PATENTABLE; AND TO WHAT EXTENT.

1. An improvement on the *principle* of a machine is patentable, but an improvement in *form* or *proportions* is not. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. An improvement in the *principle*

of a machine is no invasion of the rights of the inventor and patentee of such machine—otherwise, if it is only an improvement in the *form*. *Park* v. *Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

3. It is difficult to define the cases, where the whole machine may be deemed a new invention, and where only an improvement; the cases often approach very near each other. In the present improved state of machinery, it is almost impracticable not to employ the same elements of motion, and in some particulars, the same manner of operation, to produce any new effect. *Whittemore* v. *Cutter*, 1 Gall., 479.—STORY, J.; Mass., 1813.

4. If a person is not an inventor of the whole machine, but only of an improvement thereof, he is entitled to only a patent for the improvement. *Ibid.*, 479.

5. Where a specific machine already exists, producing certain effects, if a mere addition is made to such machine, *to produce the same effects* in a better manner, a patent cannot be taken for the whole machine, but for the improvement only. *Ibid.*, 480.

6. 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. *Ibid.*, 480.

7. If a machine substantially existed before, and a person has made an improvement only thereon, he is entitled to a patent for such improvement only, and not for the whole machine. *Woodcock* v. *Parker*, 1 Gall., 439.—STORY, J.; Mass., 1813.

8. If a person invent an improvement on a machine, he is entitled to a patent for such improvement only, and not for the original machine. *Odiorne* v. *Winkley*, 2 Gall., 53.—STORY, J.; Mass., 1814.

9. If the discovery be of an *improvement* only, it must be an improvement of the principle of a machine, art or manufacture, before known or in use. If only in the form or proportions, it has not the merit of a discovery which can entitle the party to a patent. *Evans* v. *Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816..

10. A machine or improvement may be new, and the proper subject of a patent, although the parts of it were before known and in use. *Ibid.*, 343.

11. Where an inventor makes an addition or improvement to a combination of machinery, he must confine his patent to the improvement; if he takes a patent for the whole machine as improved, not limiting it to the improvement, it is void, because as so claimed, it is not his invention. *Barrett* v. *Hall*, 1 Mas., 476.—STORY, J.; Mass., 1818.

12. If an invention consist in a new combination of machinery, or in improvements upon an old machine, to produce an old effect, the patent should be for the combined machinery, or improvements on the old machine, and not for a mere mode or device for producing such effects, detached from the machinery. *Ibid.*, 476.

13. The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded together. *Evans* v. *Eaton*, 3 Wheat., 516.—MARSHALL, Ch. J.; Sup. Ct., 1818.

14. If the same combinations existed before, in machines of the same nature, up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of

operating, to the old, the patent should be limited to such improvement. *Evans* v. *Eaton*, 7 Wheat., 430.—STORY, J.; Sup. Ct. 1822.

15. If an improvement is new and useful, and has not been known or used before, it constitutes an invention within the terms and meaning of the patent acts, and the inventor is entitled to a patent. *Earle* v. *Sawyer*, 4 Mas., 7.—STORY, J.; Mass., 1825.

16. A machine, and an improvement on a machine, or an improved machine, must not be confounded; a grant of the exclusive use of an improvement in a machine, principle, or process, is not a grant of the improvement only, but the improved machine: an improvement on a machine and an improved machine, are the same. *Whitney* v. *Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

17. If the same combination existed before, up to a certain point, and the invention consists in adding some new machinery, in some improved mode of operation, or some new combination, the patent must be limited to the improvement. *Ibid.*, 314.

18. A slight alteration in the structure of a machine, or in the improvement of it, will not entitle an individual to a patent. There must be a substantial difference in the principle, and the application of it, to constitute such an improvement as the law will protect. *Smith* v. *Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

19. An improvement, to entitle a person to a patent, must not only be new, but useful; it must be a substantial, material improvement. Mere colorable or slight improvements cannot affect the rights of the original inventors. *Street* v. *Silver*, Brightly, 99, 100.—ROGERS, J.; Pa., 1846.

20. If an improvement be made on an original invention, a patent may be obtained for such improvement. But a substantial part of an original invention cannot be patented as an improvement. *Smith* v. *Ely*, 5 McLean, 88.—MCLEAN, J.; Ohio, 1849.

21. An improvement upon an old contrivance, in order to be the subject of sufficient importance to support a patent, must embody some originality, and something substantial in the change, producing a more useful effect and operation. *Hall* v. *Wiles*, 2 Blatchf., 200.—NELSON, J.; N. Y., 1851.

22. In determining this question, the jury have a right to take into consideration, in connection with the change, the result which has been produced; because the result, if greatly more beneficial than it was with the old contrivance, reflects back, and tends to characterize, to some degree, the importance of the change. *Ibid.*, 200.

23. In an action of infringement, it was objected that the arrangement and combination of the plaintiff's improvement was so simple and obvious, that it was not the subject of a patent; *Held*, that novelty and utility in the improvement was all that the statute required as a condition to granting a patent. *McCormick* v. *Seymour*, 2 Blatchf., 243, 244.—NELSON, J.; N. Y., 1851.

24. A change of construction in a machine, which is only the result of practical experience in the use of such machine, is not, in law, an improvement on it. *Tracey* v. *Torrey*, 2 Blatchf., 278.—NELSON, J.; N. Y., 1851.

25. An improvement of a machine, for which a patent may issue, may consist in the introduction of a new element into an old machine, so as to produce new power or greater facility in

the application of power. *Rheem* v. *Holliday*, 16 Penn., 352.—COULTER, J.; Pa., 1851.

26. *Semble*, that improvements made by workmen, working under the pay of an inventor, and making experiments under his directions, are to be considered for the credit and benefit of such inventor. *Goodyear* v. *Day*, MS.—DICKERSON, J.; N. J., 1852.

27. An improvement on a combination is the subject of a patent, but at the same time the improvement cannot be used without the consent of the original patentee. *Foster* v. *Moore*, 1 Curt., 293.—CURTIS, J.; Mass., 1852.

28. One may discover an improvement in a process, irrespective of any particular form of machinery. *Corning* v. *Burden*, 15 How., 267.—STORY, J.; Sup. Ct., 1853.

29. A patent for an improvement of a machine, is the same as a patent for an improved machine. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

30. Improvement applied to machinery is where a specific machine already exists, and an addition is made to produce the *same effects* in a better manner, or some new combinations are added to produce *new effects*. *Ibid.*

31. Under § 13 of the act of 1836, a patentee may, if he desires it, annex an improvement upon a former invention, already patented, to his former specification, so as to make it from that time a part of the original patent. But there is nothing in the act which forbids him taking out a new patent for the improvement, if he prefers it. *O'Reilly* v. *Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

32. Nor is he bound in his new patent, to refer specially to his former one. All that is required is that he shall not claim as new what is covered by a former invention. *Ibid.*, 122.

33. An improvement upon a machine to constitute it an invention, must be new and useful. *McCormick* v. *Seymour*, 3 Blatchf., 213.—NELSON, J.; N. Y., 1854.

34. There must be novelty in the arrangement of the improved machinery —novelty created by the mind of the person claiming to be the inventor— and in connection with that novelty there must be utility. *Ibid.*, 213.

35. Improvements and discoveries the most important in their consequences and in their beneficial effects on the business interests of the community, are oftentimes among the simplest ideas of the mind; and again, improvements of less magnitude in their consequences and in their beneficial effects, indicate the most laborious and complex exertion of the mind of the inventor. *Ibid.*, 213.

36. An improvement on a combined machine is patentable. *Pitts* v. *Wemple*, 6 McLean, 561.—MCLEAN, J.; Ill., 1855.

37. 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 Fisher, 301. —WILKINS, J.; Mich., 1857.

38. When an alleged invention purports to be an improvement on an existing machine, the inquiry as to what is new and what old, must be, not whether the same elements of motion or the same component parts are used, but whether the given *effect* is produced substantially by the same mode of operation, and the same combination of powers in both machines; or whether some new element, combination, or feature, had been added to the old machine, which produces either the same

effect in a cheaper or more expeditious manner, or an entirely new effect, or an effect in some material respect *superior*, though in other respects similar to that produced by the old machine. *Hibbard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

39. If a change introduced constitute a mechanical equivalent in reference to the means used by another patentee and besides being such an equivalent, accomplishes some other advantages beyond the effect or purpose accomplished by the patentee, such further advantage may make it a patentable subject or an improvement upon the former invention. *Ibid.*

40. If a person invent a new mechanical device or arrangement, to be used in the place of a former device or arrangement, which was a part of a certain combination, and which new device is independent of all other similar devices, and is not to be used in conjunction with, or in aid of, or in addition to, such old device, which made one of the elements of the old combination, he may have a patent for a combination containing his new device or arrangement, in connection with the remaining parts of the old combination, as such combination constitutes a new machine, and not an improvement merely on the machine containing the combination of the old elements. *Potter* v. *Holland*, 4 Blatchf., 244.—INGERSOLL, J.; Ct., 1858.

41. But if such new mechanical device is but an improvement on the old or former one, and is to be used in conjunction with, or in aid of, or in addition to, the old one, then, it seems, he could only have a patent for his improvement, in that element of the combination, and not for the whole combination. *Ibid.*, 245.

## B. How should be set forth.

1. The patentee must 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. If, therefore, the description mixes up the old and the new, and does not distinctly ascertain for which in particular the patent is claimed, it is void. *Lowell* v. *Lewis*, 1 Mas., 188.—STORY, J.; Mass., 1817.

2. It is sufficient, however, if what is claimed as new appear with reasonable certainty on the face of the patent, either expressly or by necessary implication. But it ought to appear with reasonable certainty; for it is not to be left to minute inferences and conjectures as to what was previously known or unknown; since the question is not what was before known, but what the patentee claims *as new*. *Ibid.*, 188.

3. If, however, the invention is described with such reasonable certainty as to distinguish the same from all things before known, but the specification is not in such full, clear, and exact terms as to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same, this, under § 6 of the act of 1793, does not avoid the patent, unless the defective description or concealment has been made for the purpose of deceiving the public. *Ibid.*, 188, 189.

4. If a patent be for an improved machine, or for an improvement on a machine (the terms meaning substantially the same), the patent must state in what the improvement specifically consists,

and it must be limited to the improvement. *Barrett* v. *Hall*, 1 Mas., 476.—STORY, J.; Mass., 1818.

5. A general statement that the patented article is in all respects, without stating what these are, an improvement on an old article, is no specification at all. *Ibid.*, 478.

6. Where a patent is for an improvement the specification must describe in full, clear, and exact terms what the improvement is: 1st, to enable the public to enjoy the full benefit of the discovery when the monopoly is expired, by having it so described on record that it can be constructed, and 2d, to put every citizen on his guard, that he may not through ignorance violate the law, by infringing the rights of the patentee. *Evans* v. *Hettick*, 3 Wash., 425, 426.—WASHINGTON, J.; Pa., 1818.

7. If the improvement be on a patented machine, it may be sufficient to refer to the patent and specification for a description of the original machine, and then to state in what the improvement consists; if, however, the improvement be on a machine not patented, it would be necessary to describe the original machine and also the improvement. *Evans* v. *Eaton*, 3 Wash., 454.—WASHINGTON, J.; Pa., 1818.

8. The nature and extent of the improvement must be clearly and fully stated, or the patent will be void. *Ibid.*, 452, 455.

9. If the patent be for an improvement, the specification should distinguish what is new from what was old and before in use, and point out in what the improvement consists. It is not sufficient that the improvement should be apparent from testimony introduced by the plaintiff, or even for the jury to perceive it by examining the thing patented and comparing it with others before in use. No description of the discovery secured by a patent will fulfill the demands of justice and of law, but such as is of record, and of which all the world may have the benefit. *Dixon* v. *Moyer*, 4 Wash., 73.—WASHINGTON, J.; Pa., 1821.

10. A specification which mixes up the old and the new, but does not explain what is the nature or limit of the improvement, which the party claims, cannot be sustained. *Evans* v. *Eaton*, 7 Wheat., 434.—STORY, J.; Sup. Ct., 1822.

11. A party should describe what his improvement is, and limit his patent to such improvement, and if he does not his patent is defective. *Ibid.*, 435.

12. When the specification does not describe the invention so as to show in what respect the plaintiff's invention or improvement differs from what had been known or used by the patent is void. *Langdon* v. *De Groot*, 1 Paine, 207.—LIVINGSTON, J.; N. Y., 1822.

13. If a patent be for an improvement, it should describe the thing previously in use, so that it can be clearly seen in what the improvement consists. *Sullivan* v. *Redfield*, 1 Paine, 451.—THOMPSON, J.; N. Y., 1825.

14. A patent was taken for an improvement in the mould board of ploughs; *Held*, that a particular description of former mould boards was not necessary. A general reference, either in general terms which are not untrue, or a reference to a particular mould board commonly known, accompanied by such a description of the improvement as will enable a workman to distinguish what is new will be sufficient. *Davis* v. *Palmer*, 2 Brock., 309.—MARSHALL, Ch. J.; Va., 1827.

15. The improvement patented must be the improvement invented. The patentee must show the extent of the improvement, so that a person who understands the subject may know in what it consists. *Whitney* v. *Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

16. When a patent is for an improvement in a machine already in use, the specification need not describe the original machine, unless 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. *Harmon* v. *Bird*, 22 Wend., 14.—BRONSON, J.; N. Y., 1839.

17. If the specification contain such a description of the nature of the invention and the manner in which it is to be performed, as will enable persons of competent skill, by following the directions, to practice the invention without the labor or expense of trial or experiment, the patentee need not go further and describe the original machine. *Ibid.*, 115.

18. To secure the benefits of § 9 of the act of 1837, and save a patent from becoming absolutely void, by reason of the patentee claiming more than he has invented, the specification must state in what the improvement consists. *Peterson* v. *Wooden*, 3 McLean, 249.—McLEAN, J.; Ohio, 1843.

19. In describing an improvement, the structure in detail of the entire and improved machine need not be given. It is only necessary to describe the improvement, by showing the parts of which it consists, and the effects which it produces. *Brooks* v. *Bicknell*, 3 McLean, 261.—McLEAN, J.; Ohio, 1843.

20. In a patent for an improvement, it may not be necessary to describe the machine before it was improved, though it gives greater distinctness to do so; but it is essential that the part improved should be so distinctly stated as to be distinguished from every other part of the machine. It is not enough that the invention can be made apparent at the trial, by a comparison of the new with the old. *Brooks* v. *Bicknell*, 3 McLean, 444.—McLEAN, J.; Ohio, 1844.

21. In a patent for an improvement, the patentee should not only describe the machine, with all its parts, but he should distinguish what is new. Whatever is the particular improvement must be clearly stated; both that the public may know what he claims as new, and that parties may know what they are to defend against. *Hovey* v. *Stevens*, 3 Wood. & Min., 25, 26.—WOODBURY, J.; Mass., 1846.

22. Where a patent was for an improvement on an old and known thing, as for the substitution of double plates in the place of spokes in a car wheel, and the objection was made that the old wheel was not fully described, *Held*, that it was sufficient for the patentee to refer in general terms to the old wheel, as a spoke wheel, as that afforded all the information necessary to a person skilled in that department. *Many* v. *Jagger*, 1 Blatchf., 380.—NELSON, J.; N. Y., 1848.

23. If the specification includes as well the original discovery as the alleged improvement, and does not point out in what the improvement consists, the patent is void. *Street* v. *Silver*, Brightly, 101.—ROGERS, J.; Pa., 1846.

24. Where a patent is for an improvement on an old machine, if the whole of it, the old and the new, is described in the specification, the patentee must distinguish what part he claims, or the pat-

ent will be void for ambiguity. *Wintermute* v. *Redington*, 1 Fisher, 246.—WILSON, J.; Ohio, 1856.

25. If the whole machine, in its improved state, is claimed, the patent will be void for claiming too much. *Ib.*, 246.

26. In specifying an improvement in a machine, 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 to a person of the trade to which it belongs, and if this is not done, the patent fails for obscurity. *Ibid.*, 246.

27. Where an invention consists of an improvement on a machine, the specification should distinguish the new parts from the old; and the claim should exclude the old parts, and claim only the new, by which the old were adapted to the new use, producing the new result. *Phillips* v. *Page*, 24 How., 168.—NELSON, J.; Sup. Ct., 1860.

## C. PATENT FOR; WHAT SECURED BY; CONSTRUCTION OF.

1. If an inventor be not an inventor of the whole machine, but only of an improvement thereof, and the patent is for the whole machine, the patent is too broad and is utterly void. *Whittemore* v. *Cutter*, 1 Gall., 479.—STORY, J.; Mass., 1813.

2. If an inventor obtain a patent for an entire machine, when he is the inventor only of an improvement thereon, his patent is too broad and therefore void. *Odiorne* v. *Winkley*, 2 Gall., 53.—STORY, J., Mass., 1814.

3. If a patent be taken out for an entire machine, when the invention consists only of an improvement on such machine, the whole patent is not void, but the patentee is not entitled to more than his improvement; nor can he make or use the original discovery, nor prosecute any person for using such original discovery without engrafting on it the improvement invented by the patentee. *Goodyear* v. *Matthews*, 1 Paine, 302.—LIVINGSTON, J.; Ct., 1814.

4. The grant can only be for the discovery as recited in the patent and specification. If the patent is for the whole of a machine, and the discovery was only of an improvement, the patent is void. *Evans* v. *Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816.

5. If improvements be made upon an invention which has been patented, by any person other than the inventor or patentee, the inventor of the original thing, and those claiming under him, have no right to use the improvements without a license from the inventor thereof; nor can the inventor of such improvements, or any other person lawfully use the principal machine without the license of the inventor thereof. *Gray* v. *James*, Pet., C. C. 399.—WASHINGTON, J.; Pa., 1817.

6. If the terms of a patent are so obscure or doubtful that the court cannot 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 Mas., 476.—STORY, J.; Mass., 1818.

7. A patent for an improvement in a machine, which had been previously patented to another, cannot protect the subsequent patentee, unless there is a substantial difference in the principle, and in the application of the improvement. *Smith* v. *Pearce*, 2 McLean, 177, 178.—MCLEAN, J.; Ohio, 1840.

8. If a person makes an improvement upon the invention of another, such improvement gives him no author-

ity to use the machine upon which it is an improvement. *Washburn* v. *Gould*, 3 Story 150.—STORY, J., Mass., 1844.

9. It is well settled that no one can make an improvement on a patented machine, and use important parts of the original invention, while the original term, or the remnants of it, exist, without the license of the original patentee, or a purchase from him of the right so to use what belongs to him. *Woodworth* v. *Rogers*, 3 Wood. & Min., 141.—WOODBURY, J.; Mass., 1847.

10. Nor can one, having the right to use the original machine, use an improvement upon it, without a license or purchase from the inventor of such improvement. *Ibid.*, 141.

11. An addition or an improvement of a combination, or of any element thereof, gives no right to appropriate or use the original combination. *Gorham* v. *Mixter*, 1 Amer. Law Jour., 543.—SPRAGUE, J.; Mass., 1849.

12. If an improvement is engrafted on a machine or manufacture before made and patented, it gives no right to use what had been previously patented, without obtaining a license or purchase from the patentee. But if the invention amounts not merely to an improvement, but to more, and constitutes a new and useful combination, the inventor has a right to use it without license from others. *Smith* v. *Downing*, 1 Fisher, 83.—WOODBURY, J.; Mass., 1850.

13. A patent for an improvement in a machine is not void, though it appears from the description or specification that a part of the elements included in the description were not new, but which are claimed to be newly combined with the new elements. *Rheem* v. *Holliday*, 16 Penn., 352.—COULTER, J.; Sup. Ct., Pa., 1851.

14. A combination may be improved, and a patent taken for such improvement, but at the same time the improvement cannot be used without the consent of the original patentee. *Foster* v. *Moore*, 1 Curt. 292.—CURTIS, J.; Mass., 1852.

15. A patent for an improvement embraces nothing more than the improvement described and claimed as new, and any one who afterward discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it. *O'Reilly* v. *Morse*, 15 How., 119.—TANEY, Ch. J.; Sup. Ct., 1853.

16. There may be an improvement upon a useful machine, which entitles the party making it to a patent; but the fact of having made an improvement on an old machine, does not absorb the original machine, nor give any right to the use of it. *Crehore* v. *Norton*, MS.—NELSON, J.; N. Y., 1853.

17. The original inventor has no right to use the improvement without the license of the inventor; neither has the inventor of the improvement a right to use the original machine. *Ibid.*

18. An improvement on a combined machine may be patentable; but in such a case, the patentee cannot use the combined machine without a license, nor can the owner of such machine use the improvement, without a license. *Pitts* v. *Wemple*, 6 McLean, 561.—MCLEAN, J.; Ill., 1855.

19. Where the parts of a combination have been invented, whether such invention be of a new machine, or a combination of mechanical powers, it is protected in its distinctive character. *Ibid.*, 562.

20. If a patentee has invented only

an improvement on a known machine, he cannot treat as an infringer one who has improved the original machine by using a different form or combination, performing the same function. *McCormick* v. *Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

21. The inventor of a first improvement, cannot invoke the doctrine of mechanical equivalents to suppress all other improvements, which are not mere colorable invasions of the first. *Ibid.*, 405.

22. A mere addition to a patented invention, will not justify the use of the invention first patented. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

23. An improvement on a machine gives no right to use the original, but the use of such original machine is an infringement, although with the improvements, the machine may be much more useful than it would be without them. *Howe* v. *Morton*, 13 Mo. Law Rep.—SPRAGUE, J.; Mass., 1860.

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## INFRINGEMENT.

**A.** OF COPYRIGHT..... 357
**B.** OF PATENTS
1. *General principles as to*..... 360
2. *What held to amount to*..... 365
3. *What held not to amount to*..... 370
4. *Actions for, and Defences in*..... 373
5. *Evidence as to, and by whom decided*..... 373
**C.** OF TRADE-MARKS..... 373

## A. OF COPYRIGHT.

1. The question as to the violation of a copyright by an unlawful sale of the books, as to which a copyright has been secured, is not affected by the fact that such books may have been *printed* by one who had an interest in such copyright, and a right to publish and sell them. *Hudson* v. *Patten*, 1 Root, 133.—CURIAM; Ct., 1789.

2. The plaintiffs had purchased of W. his copyright to vend and sell a certain work within the state of Connecticut; C. also purchased of W. a like right for New York. C. employed plaintiffs, who resided in Connecticut, to print for him a number of copies, which they did, and delivered in New York. The defendant bought some copies from C., and then brought them to Hartford, and sold them. *Held*, that such sale was against the statute, and the same as if C. had himself printed them. *Ibid.*, 134.

3. This suit was brought under a copyright law of the state of Connecticut, passed January 8, 1783, and similar in its provisions, as to the term of copyright, to the act of Congress of 1790. Such act, however, gave the power, in case the author of a work put so high a price upon it as to discourage its sale, to the Supreme Court of the state to regulate and fix the price at which the work should be sold. (*Ed.*)

4. The intent with which a work is reprinted cannot be taken into consideration; the act of reprinting is prohibited by the statute. *Nichols* v. *Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

5. Though the original sources of information are open to all, subsequent parties have no right to use and copy the compilation of a former person. Where a person has made original surveys, and prepared a more perfect map therefrom, though he cannot supersede the right of any other person to make similar surveys, no one, without such surveys, has a right to copy the map. *Gray* v. *Russell*, 1 Story, 18.—STORY, J.; Mass., 1839.

6. It is of no consequence, as to the question of infringement, in what form the works of another are used, whether it be by a simple reprint, or by incorporating the whole or a large portion thereof in some other work. *Ibid.*, 19.

7. The incorporation of a treatise in an encyclopædia is just as much a piracy upon a copyright as if it were published in a single volume. *Ibid.*, 19.

8. In many cases of violation of copyright, the question may turn upon the point, not so much of the quantity, as of the value of the selected materials. *Ibid.*, 19.

9. In many cases it is a very nice question what amounts to a piracy, as in a review, whether the extracts are designed *bona fide* for the purpose of criticism, or were designed to supersede the original work, under the pretence of a review. *Ibid.*, 20.

10. The author of an edition of a Latin grammar made alterations and additions in the work, and also collected and prepared notes to it, some of which were not original; such notes were copied and used by a subsequent editor of the same work: *Held*, that such use was an infraction of the copyright as to the notes, which had been first collected together and arranged by the former editor. *Ibid.*, 21.

11. If a copyright can be secured for a work when the author has printed it in a newspaper before he has obtained a copyright, although with notice that he had secured a copyright; *query*, whether, under such circumstances, one can be charged with an infringement upon such right if he has in fact never seen or copied from the book so entered and secured, or in any manner used it in his publication, but has reprinted the same matter, in part or whole, from such newspaper, in which the author had himself published it, and in which paper neither the author nor any other had any copyright. *Miller* v. *McElroy*, 1 Amer. Law Reg., 204, 205.—HOPKINSON, J.; Pa., 1839.

12. To constitute an invasion of copyright, it is not necessary that the whole of a work should be copied, or even a large portion of it, in form or in substance. *Folsom* v. *Marsh*, 2 Story, 115.—STORY, J.; Mass., 1841.

13. If so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially, to an injurious extent, appropriated, that is sufficient, in point of law, to constitute a piracy. *Ibid.*, 115.

14. The entirety of the copyright is the property of the author, and it is no defence that another has appropriated a part and not the whole of such property. *Ibid.*, 116.

15. Nor does it necessarily depend upon the quantity taken, whether it is an infringement of the copyright or not. It is often affected by other considerations, the value of the materials taken and the importance of it to the sale of the original work. *Ibid.*, 116.

16. Where A published a "Life of Washington," in two volumes, containing 866 pages, of which 353 were copied from the last eleven volumes of "Sparks' Life and Writings of Washington," in twelve volumes, 64 pages being *official* letters, and 255 being *private* letters of Washington, and originally published by Sparks, under a contract with the owners of the original papers of Washington, *Held*, that the work of A was an invasion of the copyright of Mr. Sparks. *Ibid.*, 103, 104, 108, 109, 118.

17. Intention cannot be taken into

view in reference to an infringement of a copyright; if a copyright has been invaded, whether the party knew it was copyrighted or not, he is liable to the penalty. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

18. The omission of a word, a line, or paragraph in the book, &c., published in violation of a copyright, cannot change it so as to avoid the statute. *Ibid.*, 240.

19. A defendant may show that the work copyrighted was not original with the author, or that it was an abbreviation or alteration, and the jury can determine whether it is calculated to infringe the copyright or not. *Ibid.*, 240.

20. It is not sufficient, to constitute a piracy of a copyright, to show that one work may have been suggested by another, or that some parts or pages of it have resemblances, either in method, details, or illustrations. It must be further shown that such resemblances are so close, full, uniform, and striking, as to lead to the conclusion that the one is a substantial copy of the other, or mainly borrowed from it. *Emerson* v. *Davies*, 3 Story, 787.—STORY, J.; Mass., 1845.

21. A copy is one thing, an imitation or resemblance is another. *Ibid.*, 787, 788.

22. In many cases it is a very nice question, what degree of imitation constitutes an infringement of a copyright in a particular work. *Ibid.*, 788.

23. If the similitude can be supposed to have arisen from accident, or necessarily from the nature of the subject, the defendant is not liable. *Ibid.*, 791.

24. The true test of piracy or not is, whether the defendant has in fact used the plaintiff's work, with colorable alterations and variations only to disguise the use thereof; or whether his work is the result of his own labor, skill, and use of common materials and sources of knowledge open to all. In other words, whether the defendant's book is, *quoad hoc*, a servile or evasive imitation of the plaintiff's work, or a *bona fide* original compilation from other common or independent sources. *Ibid.*, 793.

25. Similarities and some use of prior works, even to copying of small parts, are tolerated in some kinds of books, as dictionaries, gazetteers, grammars, maps, arithmetics, almanacs, cyclopædias, itineraries, guide-books, and similar publications, if the main design and execution are in reality novel and improved, and not a mere cover for important piracies from others. *Webb* v. *Powers*, 2 Wood. & Min., 512.—WOODBURY, J.; Mass., 1847.

26. Where two books were somewhat similar in design and execution, and the one was to some extent copied from the first, but was smaller and cheaper, and in many respects of a different arrangement, *Held*, that the leading inquiry was, whether the book of the defendant, taken as a whole, was substantially a copy of the plaintiff's; whether it had virtually the same plan and character throughout, and was intended to supersede the other in the market, with the same class of readers and purchasers, by introducing no considerable new matter, or little or nothing new except colorable deviations. *Ibid.*, 514, 515.

27. When the main design in the defendant's book is different in important respects from that of the plaintiff's, and in several things varying in material

details with a view to make it less expensive and to circulate among a different class of readers, rather than be a substitute with the same class, it will be no infringement on the copyright of the plaintiffs. *Ibid.*, 518, 519.

28. If the leading design is truly to abridge a work and cheapen the price, and that by mental labor is faithfully done, it is no ground for a prosecution by the owner of a copyright of the principal work. But it is otherwise if the abridgment or similar work be colorable, or a mere substitute. *Ibid.*, 520.

29. The intent not to be guilty of piracy is not material, if much has been actually copied and the new work is a mere substitute. But if this be doubtful, the intent not to pilfer from another, colorably or otherwise, for the substantial parts of the new work, may be important. *Ibid.*, 524.

30. The infringement of a copyright does not depend so much upon the length of the extracts as upon their value. *Story's Exrs.* v. *Holcombe*, 4 McLean, 309.—McLean, J.; Ohio, 1847.

31. The intention with which extracts from a work are made, has no bearing upon the question of violation. The inquiry is, what effect must the extracts have upon the original work. If they render it less valuable by superseding its use in any degree, the right of the author is infringed; and it can be of no importance to know with what intent this was done. *Ibid.*, 310.

32. A book may in one part of it infringe the copyright of another book, and in other parts be no infringement; in such a case, the remedy will not be extended beyond the injury. *Ibid.*, 315.

33. 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 Amer. Law Reg., 229.—Grier, J.; Pa., 1853.

34. The abridgment of a work, for which a copyright has been secured, and which has been publicly circulated, is not an infringement of the statutory privilege; but such an abridgment would violate the right of the literary proprietor of a book of which the circulation had been private only. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 82.—Cadwallader, J.; Pa., 1860.

## B. Of Patents.

### 1. *General principles as to.*

See also Actions, B.; Invention, E.

1. The general law declares that the right to a patent belongs to him who is the first inventor, even before a patent is granted; therefore, any person, who, knowing that another is the first inventor, yet doubting whether that person will ever apply for a patent, proceeds to construct a machine so invented by another, acts at his peril, and with the full knowledge of the law, that a subsequent patent may cut him out of the use of the machine thus erected; *a priori*, where the party constructing knew that the inventor had obtained a patent, though afterward declared invalid, but under a subsequent act:

Congress a valid patent was secured. *Evans* v. *Weiss*, 2 Wash., 345.—WASHINGTON, J.; Pa., 1809.

2. To constitute an infringement, the making must be with an intent to infringe the patent-right, and deprive the owner of the lawful rewards of his discovery. *Sawin* v. *Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

3. In an action for an infringement the first question for consideration is, whether the machines used by the defendant are substantially, *in their principles and mode of operation*, like the plaintiff's. If so it is an infringement to use them. *Odiorne* v. *Winkley*, 2 Gall., 53, 55.—STORY, J.; Mass., 1814.

4. Mere colorable differences, or slight improvements, cannot shake the right of an original inventor, or protect an infringer. *Ibid.*, 54.

5. It is not the duty of the attorney-general, as the law adviser of the Commissioner of Patents, or of the Secretary of State (now Interior) to determine what rights are conferred by patents granted, or what will amount to a violation of those rights. These are questions to be settled by the courts and juries. *Nourse's Case*, 1 Opin., 576.—WIRT, Atty. Gen.; 1822.

6. Whoever erects or uses a patented machine, does it at his peril. He takes upon himself all the chances of the patent being originally valid; or being afterward made so by a surrender and the grant of a new one. *Ames* v. *Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833.

7. The maker and seller of a patented article intended by the act (1793, § 5) is the principal, the person for whom, by whose direction, and on whose account the articles are made and sold—the person who receives the profits of the sale. The workmen employed by him for stipulated wages have nothing to do with his rights, or with his invasion of the right of another. *Delano* v. *Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

8. The right secured to the inventor is founded on considerations of public policy, and is not to be destroyed by open infraction, or mere colorable improvements. *Smith* v. *Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

9. It is not necessary that two things should be identical in order to make one an infringement of the other. The true question is, are they substantially the same, though not in every minute particular. *Alden* v. *Dewey*, 1 Story, 339.—STORY, J.; Mass., 1840.

10. In an action for an infringement, it is no ground for a recovery that the process used by the defendant is not so good as that patented to the plaintiff. The question is, not which is best or most perfect; but whether the one mode or combination is an infringement of the rights secured by the other mode or combination. *Howe* v. *Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

11. A mere colorable or slight alteration of a machine, or a change in its proportions, gives no ground for a patent, nor can it shelter from the consequences of an infringement. The inquiry always is, whether the principle of the two machines is the same. *Brooks* v. *Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

12. Where witnesses differ as to the fact of infringement, the question should be submitted to a jury, either by an action at law, or an issue directed by the court. *Ibid.*, 262.

13. If the defendant construct and use a machine before the plaintiff ob-

tain his patent, such construction or use will not be protected, if the machine was copied from that of the plaintiff, unless he consented to such construction or use. *Hovey* v. *Stevens*, 1 Wood. & Min., 301.—WOODBURY, J.; Mass., 1846.

14. 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 the infringer. *Parker* v. *Hulme*, 7 West. Law Jour., 426.—KANE, J.; Pa., 1849.

15. If a machine, constructed as described in the patent, will accomplish the end practically and usefully in the way pointed out, the inventor is entitled to the protection granted by the government, and any one using the principle thus embodied is guilty of an infringement, however he may have perfected the machine by superior skill in the mechanical arrangement and construction of the parts. *Parkhurst* v. *Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

16. The inquiry as to infringement is whether the defendant has appropriated to his own use and for his own benefit the machine constructed and put in operation, or the thing invented by the patentees. This question is to be determined by reference to what was in existence at the time of the invention by the patentees. *Wilbur* v. *Beecher*, 2 Blatchf., 139.—NELSON, J.; N. Y., 1850.

17. As to the question of infringement the inquiry is, whether the defendants' machine involves some new idea in its construction not to be found in the plaintiff's, or whether the plan used by the defendants is in substance the same as the plaintiff's, the differences introduced being merely differences in things not material or important; in other words, whether the defendants' plan is in substance and effect a colorable evasion of the plaintiff's rights, or is new and substantially a different thing. *McCormick* v. *Seymour*, 2 Blatchf., 245, 246.—NELSON, J.; N. Y., 1851.

18. If the defendants have taken the same plan and applied it to the same purpose, it is in substance the same thing, although they may have varied the mode of construction. It is then only a mechanical equivalent, which, however meritorious and creditable to the mechanic, is not invention. *Ibid.*, 248.

19. In examining a machine to ascertain whether or not it is an infringement of another, the similarity or dissimilarity of the mechanical construction is not necessarily conclusive or controlling. The structure may be very similar, but the principle, operation, and result, be very different; or the structure and appearance may be very different, and yet the principle be in reality the same. *Blanchard* v. *Beers*, 2 Blatchf., 416, 418.—NELSON, J.; Ct., 1852.

20. No person can appropriate the benefit of the new ideas which another has originated and put into practical use, because he may have been enabled, by superior mechanical skill, to embody them in a form different in appearance, or different in reality. Although he may not have preserved the exterior appearance of the previous machine, he may have appropriated the ideas which give to it all its value. *Ibid.*, 418.

21. Whenever a defendant sets up that he has substantially departed from an existing machine, so as to avoid the consequence of an infringement, he must show that his departure has been such as involves invention, and not mere mechanical skill. There must be mind and inventive genius involved in it, and

not the mere skill of the workman. *Ibid.*, 420.

22. In examining questions of identity and infringement, it is to be first ascertained wherein consists the substantial peculiarity which distinguishes the art or invention patented. Whoever adopts or appropriates such distinctive peculiarity or principle without license of the patentee, appropriates the invention, and infringes the patent, if the specification be correctly drawn. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

23. It is no justification of the infringement of a renewed patent, that the infringer had stolen and used the invention with impunity before the patent was amended. § 7 of the act of 1839, gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Ibid.*

24. On a bill filed for an infringement of a patent, and for an injunction, if the defendants refuse to allow the plaintiffs to examine the machines used by them, the court will order the defendants to run such machines in the presence of some expert, and that the expert be allowed to bring into court specimens of the work produced by such machines. *Sloat* v. *Patten*, 24 Jour. Fr. Inst., 3d Ser., 23.—KANE, J.; Pa., 1852.

25. No person can take the benefit of a patentee's discovery for the production of a new manufacture, and by varying or improving the mode or process of its production, rob the patentee of his franchise. *Goodyear* v. *The Railroads*, 2 Wall., Jr., 361.—GRIER, J.; N. J., 1853.

26. Whether the defendant has constructed, used, or sold the thing patented to the plaintiffs, is a question of fact for the jury. *Winans* v. *Denmead*, 15 How., 338.—CURTIS, J.; Sup. Ct., 1853.

27. It is a familiar rule that to copy the principle or mode of operation described in a patent, is an infringement, although such copy should be totally unlike the original in form or proportions. *Ibid.*, 342.

28. A question of infringement is one of fact, which it is the province of a jury to decide. *Rich* v. *Lippincott*, 2 Fisher, 5.—GRIER, J.; Pa., 1853.

29. The substitution and use of one power, as electricity, in the place of another, as hand power, does not make the machine different, or prevent its being an infringement. *Crehore* v. *Norton*, MS.—NELSON, J.; N. Y., 1853.

30. If a defendant, for a good consideration, covenants not to infringe a patent, he will be enjoined, by a court of equity, from further infringing, unless he shows some equitable reason why the performance of such agreement should not be enforced. *Sargent* v. *Larned*, 2 Curt., 344.—CURTIS, J.; Mass., 1855.

31. The question of infringement has reference to what the patentee *has claimed* in his patent, and not to what he *might have claimed*, if his specification had been more skilfully prepared. *Sickles* v. *Glou. Manuf. Co.*, 1 Fisher, 238.—GRIER, J.; N. J., 1856.

32. As to the question of infringement, it is a standing principle of law, that every person is entitled to the free use of whatever was known and used prior to the patent which attempts to appropriate it as a new discovery: and it is unimportant whether the character and capacities of machinery open to

general use are understood or not by the public at large, or had been used by many; it is sufficient to show the public had free means of access to it, and to employ it, and the law then presumes it was well known and in public use. *Smith* v. *Higgins*, MS.—Betts, J.; N. Y., 1857.

33. If the thing used by a defendant corresponds substantially with that known and in use before the discovery of the patentee, or described in printed works, then his acts are no infringement of any right of a patentee; and if the thing used by the defendants and that patented to the plaintiff, are substantially alike, the question of infringement will still depend upon the further inquiry whether the patentee was the first and original discoverer of the patented invention. *Ibid.*

34. If the patentee be an original inventor of a machine or thing, he has the right to treat as infringers all who make a like invention, operating on the same principles, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement on the original and patented one. *McCormick* v. *Talcott*, 20 How., 405.—Grier, J.; Sup. Ct., 1857.

35. But if his invention be but an improvement on a known machine, he cannot treat another as an infringer who has improved the original machine by using a different form or combination, performing the same function. The inventor of a first improvement cannot invoke the doctrine of mechanical equivalents to suppress all other improvements which are not mere colorable invasions. *Ibid.*, 405.

36. The question of infringement is one for the jury. The true point is, have the defendants used the invention of the plaintiff, or something substantially like it? Do the two structures operate upon the same principle? Are they substantially the same? *Bell* v. *Daniels*, 1 Fisher, 379.—Leavitt, J.; Ohio, 1858.

37. An unpatented invention is not property, nor the subject of exclusive ownership, but is free to the use of all persons, in whatever way they may come to the knowledge of it. *Shreeve* v. *United States*, MS.—Loring, J.; Ct. Claims, 1859.

38. In determining questions of infringement, the jury are not to judge about similarities or differences by the names of things; but are to look to the machines, or their several devices or elements, in the light of what they do, or what office or function they perform, and how they perform it; and to find that a 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 that things are substantially different when they perform different duties, or in a different way, or produce a different result. *Cahoon* v. *Ring*, 1 Fisher, 419.—Clifford, J.; Me., 1859.

39. For the same reason, they are not to judge about similarities or differences merely because things are apparently the same, or 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 they are to look at the mode of operation, or the way the parts work, and at the result as well as the means by which the result is attained. *Ibid.*, 419.

40. The question of infringement of a patent is exclusively a question for the jury. *Judson* v. *Cope*, 1 Fisher, 625.—Leavitt, J.; Ohio, 1860.

2. *What has been held to amount to.*

See also COMBINATION, B.; COMPOSITION OF MATTER, C.; DESIGN.

1. The using of a thing invented by another, and secured by patent, is an offence, and it makes no difference that the thing or machine was made or erected prior to the issuing of the patent. *Evans* v. *Weiss*, 2 Wash., 344.—WASHINGTON, J.; Pa., 1809.

2. The making of a machine fit for use, and with a design to use it for profit, is an infringement of a patent-right, for which an action will lie, even if there is no user and no actual damage. *Whittemore* v. *Cutter*, 1 Gall., 432, 433.—STORY, J.; Mass., 1813.

3. Though as a general rule a patent covers only the improvement precisely described, and is not violated unless the defendant make use of the precise thing described in the patent, yet if the imitation be so nearly exact as to satisfy the jury that the imitator attempted to copy the model, and to make some almost imperceptible variation, for the purpose of evading the right of the patentee, this will be considered a fraud upon the law, and such slight variation be disregarded. *Davis* v. *Palmer*, 2 Brock., 309.—MARSHALL, Ch. J.; Va., 1827.

4. If the machine used by the defendants, in its structure and operation, is substantially the same with the plaintiff's invention as patented, though different somewhat in form and arrangement, it is an infringement of his patent. *Wyeth* v. *Stone*, 1 Story, 280.—STORY, J.; Mass., 1840.

5. And where a patent embraces divers distinct and independent inventions or machines, but each auxiliary or conducive to the accomplishment of the same common or general end, if one of such inventions or machines is wrongfully used, it is a violation of the patent. *Ibid.*, 291, 292.

6. Making, using, or selling a patented machine, is an infringement. *Brooks* v. *Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

7. No prior use of a defective patent can authorize the use of the invention after the emanation of an amended patent, under § 3 of the act of 1832, or § 13 of the act of 1836, which made no material change in the law. *Stimpson* v. *West Ches. R. R. Co.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

8. Any person using an invention protected by a renewed patent, subsequent to the date of the act of 1836 (July 4), is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent. *Ibid.*, 403.

9. It is an infringement of a patent-right to make the thing patented, even though the person actually making was employed by others to do the work. *Bryce* v. *Dorr*, 3 McLean, 583.—MCLEAN, J.; Mich., 1845.

10. Where a patent embraces several machines, the wrongful use of either separate machine is a violation of the pateut, *pro tanto*. *Emerson* v. *Hogg*, 2 Blatchf., 8.—BETTS, J.; N. Y., 1845.

11. If a machine, as made by a defendant, was not an infraction of the plaintiff's patent, the alteration of it by a third party will not make the defendant liable. But if the machine as made by the defendant was intended by him to operate in such a way as to violate the plaintiff's patent, and has in fact so operated, he is guilty of an infringement,

notwithstanding the ingenuity with which he may have sought to disguise his wrong. *Knight* v. *Gavit*, Mir. Pat. Off., 133.—KANE, J.; Pa., 1846.

12. To infringe a patent-right, it is not necessary that the thing patented should be adopted in every particular; if the patent is adopted substantially by the defendants, they are guilty of an infringement. *Root* v. *Ball*, 4 McLean, 180.—McLEAN, J.; Ohio, 1846.

13. If a defendant has arranged his machinery on the same principle as claimed by the plaintiff, he is guilty of infringement. It is not essential that it should be exactly similar in form, but it must work on the same principle. *Parker* v. *Haworth*, 4 McLean, 373.—McLEAN, J.; Ill., 1848.

14. The plaintiff's invention and patent was for a squeezer, so called, for converting puddlers' balls into blooms, and rolled the balls between reciprocating tables or plates, or between a revolving cylinder and a stationary curved segmental trough with stationary flanges. The defendant's machine compressed the ball between a rotating cam and two small rotating cylinders beneath it; *Held*, that plaintiff's patent was for a new process, mode, or method of converting puddlers' balls into blooms by continuous pressure and rotation between converging surfaces, and that the defendant's machine was an infringement upon it, if it converted such balls into blooms by continuous pressure and rotation between converging surfaces, although its mechanical construction and action might be different. *Burden* v. *Corning*, MS.—CONKLING, J.; N. Y., 1850.

15. If a person uses the invention of a patentee, he infringes whatever he may add to it, or with whatever new invention he connects it. *Brooks* v. *Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

16. Where a patentee of an improvement in cultivators, claimed "the arrangement of the teeth in two rows, in combination with a pair of wheels having their treads in a line midway between the points of the two rows of teeth, substantially as described," and the specification described the teeth as seven in number, arranged in two straight rows, three in one row and four in another, the points of the three being in front of the line of the wheels, and the points of the four behind such line, and the tread of the wheels being placed midway between the rows of the teeth to resist any tendency of either row of teeth to cut too deep, and the tread of the wheels between them acting as a fulcrum, so as to relieve the team of any strain arising from either row of the teeth running too low or too shallow, and by which arrangement also the use of guiding handles, or of four wheels, could be dispensed with; and the defendant's machine used but two wheels, and no guiding handles, and had also seven teeth, three in front of the wheels and four behind, but the middle tooth of the forward three was moved forward of the others, and the two middle teeth of the back row were placed behind the others, so that the two rows were not straight, and the axle of the wheels was thrown forward, so that the tread of the wheels was not midway between the rows of the teeth, by which strain on the team was further reduced; *Held*, that the defendant's machine was an infringement upon the plaintiff's, as it used the principle and substance of plaintiff's invention, and was not even an improvement, as it was only the re-

sult of practical experience in the use of plaintiff's machine, and involved no invention. *Tracey* v. *Torrey*, 2 Blatchf., 277, 278.—NELSON, J.; N. Y., 1851.

17. In an action for an infringement of the same patent, referred to last above, where the defendant's machine was like that of Torrey, except that the middle tooth of the forward three was set back, so that two teeth were forward of the wheels and five were back, *Held*, that defendant's machine was an infringement. *Chamberlin* v. *Ganson*, 2 Blatchf., 279 (note.)—NELSON, J.; N. Y., 1851.

18. If a machine is capable of performing several functions, as Blanchard's machine for turning irregular forms, and a person construct a machine to perform but one of such functions, as the turning of wagon spokes, it is an infringement. *Blanchard* v. *Beers*, 2 Blatchf., 415.—NELSON, J.; Ct., 1852.

19. The sure test, and the one the jury should be guided by in all cases, is, whether or not the defendant's machine (whatever may be its form or mechanical construction), has incorporated within it the principle, or the combination, or the novel ideas which constitute the improvement to be found in the plaintiff's machine. If it does, then, no matter what may be its mechanical construction, or its form, it is an infringement. *Ibid.*, 416.

20. The plaintiff's patent was for the curing of caoutchouc or india-rubber by subjecting it to the action of a high degree of artificial heat. The defendants set up the defence that the rubber made by them was made by a process in which *steam* and not *heat* was the chief agent; *Held*, that the plaintiff claimed the vulcanization of rubber and sulphur by artificial heat, however produced, and that the use of steam in the place of heated air was an infringement of his patent. *Goodyear* v. *The Railroad*, 2 Wall., Jr., 358, 361, 362.—GRIER, J.; N. J., 1853.

21. In an action for infringement upon Wells' patent for making hat bodies, the defendants in their machine divided the tunnel or chamber into which the fibres of the fur were thrown, and used a perforated cone of wire gauze, of larger openings than Wells', and put a finer one of grass cloth over it, and used a metallic picker instead of the hair brush to throw the fibres of the fur into the chamber, and also, instead of immersing the bat formed on the cone into warm water to harden it so that it could be removed, discharged jets of steam upon the bat during the process of formation; *Held*, on an application for an injunction, that the machine of the defendants, and their process of making the hat body, was substantially like that of the complainants, the assignees of Wells, and that they were entitled to an injunction. *St. John* v. *Prentiss*, MS.—NELSON, J.; N. Y., 1853.

22. To constitute an infringement, the thing used by the defendant must be such as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree; but it must be the same in kind. *Winans* v. *Denmead*, 15 How., 344.—CURTIS, J.; Sup. Ct., 1853.

23. Where a patent was granted for constructing the body of a railroad car in the form of the frustum of a cone, and the claim was for making it in such

form whereby certain specified advantages were secured, and a new and useful result produced, and the defendants constructed the body of their car *octagonal*, the effect of which was, however, the same as when made circular, as described in the plaintiff's patent; *Held*, that it was an infringement upon plaintiff's patent, and that the plaintiff's patent, though describing only the form of a frustum of a cone, embraced every such variation of form as substantially embodied his mode of operation, and thereby attained the same result. *Ibid.*, 341–344.

24. Where a particular geometrical form is alone capable of embodying a patentee's invention, if the form is not used the invention is not copied, and there is no infringement; otherwise, where that form may be the best, but other forms may and do embody the invention. *Ibid.*, 343.

25. An infringement takes place whenever a party avails himself of the invention of a patentee, without such a variation as will constitute a new discovery. *Rich* v. *Lippincott*, 2 Fisher, 5.—GRIER, J.; Pa., 1853.

26. An infringement consists in constructing a machine, or making a compound substantially in the same mode as that for which the patent has been obtained. *Allen* v. *Hunter*, 6 McLean, 311.—McLEAN, J.; Ohio, 1855.

27. An unsubstantial or colorable alteration in a machine or a compound, as where they are formed on the same principle, though varied in form; or where the ingredients are the same, but combined in a different mode, or there is a substitute of one ingredient, having the same qualities and producing the same result, is an infringement. *Ibid.*, 313.

28. A change of form merely, or of mechanical structure, which produces no new or materially improved result, is not the subject of a patent, and is an infringement of a patent. *Sargent* v. *Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

29. Mere formal changes will not evade a patent. *Sickles* v. *Borden*, 3 Blatchf., 541.—NELSON, J.; N. Y., 1856.

30. According to the patent law, if the machine complained of involves substantial identity with the one patented, it cannot be upheld. *Ibid.*, 541.

31. If the invention of a patentee is a machine, it will be infringed by a machine which incorporates in its structure and operation the substance of the invention; that is, by an arrangement which performs the same service or produces the same effect in the same way, or substantially so. *Ibid.*, 541.

32. The identity that is to be looked to, in an action of infringement, respects that which constitutes the essence of the invention, namely, the application of the principle. If the mode adopted by the defendant 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. *Wintermute* v. *Reddington*, 1 Fisher, 251.—WILSON, J.; Ohio, 1856.

33. But if the defendant has adopted variations which show that the application of the principle is varied, that some other law, or rule of practice or science, is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement. *Ibid.*, 251

34. If a machine is constructed so as to conform in *all* respects to the description in a patent, except as to one particular, or as to one motion and effect, yet is so constructed and *intended*

as to obtain that motion or effect in the usage of the machine, by the action or wearing of the parts, and it *is* so obtained, it is a violation of the patent, a piracy of the principle. If the *principle* is worth any thing, no mere evasion should be countenanced. Perfect identity is not required to demonstrate an infringement of principle. *Page* v. *Ferry*, 1 Fisher, 311.—WILKINS, J.; Mich., 1857.

35. If a licensee use the thing patented beyond the limits of the license or grant, or in a way not authorized thereby, then there is a violation of the rights secured to the patentee. *Judson & Goodyear* v. *Union Rub. Co.*, 4 Blatchf., 65, 66.—INGERSOLL, J.; N. Y., 1857.

36. It is an infringement, if the defendants use the means secured by the plaintiff's patent, although they may have used another device, not patented to the plaintiff. *Waterbury Brass Co.* v. *N. Y. & B. Brass Co.*, 3 Fisher, 52. —INGERSOLL, J.; N. Y., 1858.

37. To constitute an infringement, it is not necessary that the defendant's machine should be exactly like the plaintiff's, but it is an infringement if his device is substantially like that of the plaintiff's. *Ibid.*

38. It is none the less an infringement of a patent, because something is added to the means patented, even though the object or result to be secured by such other means in connection, is better accomplished. *Imlay* v. *Nor. & Worc. R. R. Co.*, 4 Blatchf., 235.—INGERSOLL, J.; Ct., 1858.

39. Where a patent for improvements in the manner of supporting the bodies of railroad cars, &c., was for the use and application of two cylinder plates, one male and the other female, one within the other, the upper one slightly convex in its lower surface, so that it rested only on the centre of the bed-plate, which could thus turn and vibrate under the top plate, and one of such plates attached to the truck and the other to the car, whereby the truck and carriage were combined; and the defendants used to connect their carriages the ordinary king bolt, and side bearings, near the side of the carriage, and also two cylindrical plates, male and female, one within the other, and which were called *guard collars* for the king bolt; *Held*, that the use and application of the two cylinder plates one within the other, as used and applied by the defendants, was in violation of the rights secured by the patent, and even though the inner one should not actually press upon the outer one. *Ibid.*, 237.

40. In order to constitute an infringement, it is not necessary that the arrangement and combination of the party charged with the infringement should be the same to the eye, or in point of fact. If they embody the ideas of the patentee, and the machinery of the defendant operates by such adoption and appropriation, then, though the arrangement may be apparently different, in reality and in judgment of law, an infringement exists. *Smith* v. *Higgins*, 1 Fisher, 541.—NELSON, J.; N. Y., 1856.

41. If a defendant uses that which belongs to another, he is responsible, although he may have added something of his own. It is an infringement, whatever else he may use. *Johnson* v. *Root*, 1 Fisher, 359.—SPRAGUE, J.; Mass., 1858.

42. In the absence of any explanation or suggestion to the contrary, it will be inferred that the use of machinery constructed according to the specification of a patent is without the license or consent of the patentee; and such use will make a *prima facie* case

of infringement. *Chaffee* v. *Bos. Belt. Co.*, 22 How., 222.—CLIFFORD, J.; Sup. Ct., 1859.

43. It is an infringement if a person has used a patentee's improvements or devices substantially the same, in which the same principles are brought into requisition, or in other words, which are alike in their principle of operation. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

44. To constitute an infringement, the thing used must be so near that set forth in the patent as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. *Whipple* v. *Middlesex Co.*, MS.—SPRAGUE, J.; Mass., 1859.

45. An improvement on a machine gives no right to use the original, but the use of such original machine is an infringement, although with the improvements the machine may be much more useful than it would be without them. *Howe* v. *Morton*; 13 Mo. Law Rep., 71–72.—SPRAGUE, J.; Mass., 1860.

### 3. *What has been held not to amount to.*

1. The making of a patented machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects, is not an infringement on the patentee's rights. *Whittemore* v. *Cutter*, 1 Gall., 432.—STORY, J.; Mass., 1813.

2. The levy and sale, under an execution, of the *materials* of patented articles, as the materials of machines for cutting brad-nails, is not such a sale under the patent acts as makes the sheriff liable to an infringement of the patent-right. To constitute such an infringement, the sale must be not of the materials of a machine, either separate or combined, but of a complete machine with the right, express or implied, of using the same in the manner secured by the patent. It must be a tortious sale, not for the purpose of merely depriving the owner of the materials, but of the use and benefit of his patent. *Sawin* v. *Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

3. If an invention is an improvement in the *principle* of a machine for which a patent has been granted, it is not a violation of the patent. *Park* v. *Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

4. A contract to purchase articles manufactured in violation of a patent is not of itself an infringement of such patent. *Keplinger* v. *De Young*, 10 Wheat., 365.—WASHINGTON, J.; Sup. Ct., 1825.

5. The exclusive grant in a patent is the construction and use of the thing patented. The patent law protects the thing patented, and not the product. The right of an assignee of a patent right for a particular district, is not infringed upon by the sale within such district of the products of the same patent-right, manufactured by a party holding an interest in the same patent in another district. *Boyd* v. *Brown*, 3 McLean, 296, 297.—MCLEAN, J.; Ohio, 1843.

6. Whether if the manufacturer in the second district was actually engaged in selling such articles within the district held by the other, it would not be a violation of the right of such other person; *query*. *Ibid.*, 296.

7. The sale of the thing manufactured, or the product of a patented machine, is not a violation of the exclusive right to use, construct, or sell the machine.

*Boyd* v. *McAlpine*, 3 McLean, 429.—McLean, J.; Ohio, 1844.

8. A purchaser, for his own account, of articles manufactured by a patented machine, though purchased with a full knowledge that they were manufactured in violation of the patent, cannot be enjoined, or held liable in any other way. *Anon.*, 3 West. Law Jour., 144.—N. Y., 1845.

9. A purchase from the defendants of a patented article by an agent of the patentee, and for the purpose of entrapping the defendant, is not such a sale as will render them liable. *Sparkman* v. *Higgins*, 2 Blatchf., 30, 31.—Betts, J.; N. Y., 1846.

10. If a machine, as made by the defendant, was not an infraction of the plaintiff's patent, the alteration of it by a third party will not make the defendant liable. But if the machine, as made by the defendant, was intended by him to operate in such a way as to violate the plaintiff's patent, and has in fact so operated, he is a party to the infringement, notwithstanding the ingenuity with which he may have sought to disguise his wrong. *Knight* v. *Gavit*, Mir. Pat. Off., 133.—Kane, J.; Pa., 1846.

11. If the machine used by the defendant differs materially from that described in the patent, there is not an infringement. *Aiken* v. *Bemis*, 3 Wood. & Min., 353.—Woodbury, J.; Mass., 1847.

12. Where a patentee claimed a hammer in a saw-set, of wrought-iron faced with steel, alleging that he found upon experiment that all steel hammers were much more liable to break, and wrought-iron ones more durable, and therefore confined his specification to wrought-iron ones with steel points, *Held*, in an action for infringement against a person using a hammer wholly of steel, that it was matter of doubt whether the use of an inferior material for the hammer, when the patent covered only a superior one, was a violation of the patent. If the patentee covers the material of which a part of his machine is made, he endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. Had nothing been said about materials it would have been different. *Ibid.*, 350, 354.

13. Where A and B agreed with C to purchase of the latter all of a certain article, lead pipe, which he should make, A and B agreeing to furnish the lead and pay C a given price for manufacturing, and C used in such manufacture a machine patented to plaintiff's assignor, *Held*, in an action for infringement against A, B, and C, that if A and B had no connection with the manufacture, except to furnish the lead and pay a given price, that they were not liable for infringement. *Tatham* v. *Le Roy*, MS.—Nelson, J.; So. N. Y., 1849.

14. But if the agreement was only colorable, and entered into for the purpose of securing the profits of the business without assuming the responsibility for the use of the invention, then they would be liable. Aiding and assisting a person in carrying on such a business and in operating the machinery will implicate the parties so engaged. *Ibid.*

15. One machine or manufacture is not a violation of another, within the purview of the patent system, unless it is substantially the same. It need not be identical, but it must be similar in the principle, or mode of operation. *Smith* v. *Downing*, 1 Fisher, 83.—Woodbury, J.; Mass., 1850.

16. When their results differ favorably and considerably, it is considered that there must be an improvement, or this could not happen. So when the mode of operation is unlike in material respects, the author is not guilty of any mechanical piracy. *Ibid.*

17. A sale of a patented article, to an agent of the patentee, employed to make the purchase, by him and on his account, is not, *per se*, an infringement of his patent. *Byam* v. *Bullard*, 1 Curt., 102.—CURTIS, J.; Mass., 1852.

18. Such a sale, however, accompanied by other circumstances, may warrant a jury in finding an infringement. *Ibid.*, 102.

19. The means specified in a patent to produce a result or effect, and nothing more, are patented, or secured, and there is no infringement, unless the defendant uses substantially the same means as those described by the patentee. *Amer. Pin Co.* v. *Oakville Co.*, 3 Blatchf., 192; 3 A. L. R., 137.—INGERSOLL, J.; Ct., 1854; NELSON, J., concurring.

20. Where a vessel was built and rigged in France, and had in use gaffs which had been patented in the United States, *Held*, as the gaffs were placed on the vessel when she was built, and as part of her original equipment, in a foreign country, by persons not within the jurisdiction of our patent laws, that such use was not within the application of our patent laws, but was excepted therefrom. *Brown* v. *Duchesne*, 2 Curt., 375–377.—CURTIS, J.; Mass., 1855. [Affirmed *post* 22.]

21. The right of property and exclusive use which a patentee has in his invention, is derived from the acts of Congress, and cannot extend beyond the limits to which the law itself is confined. The use of his invention outside of the jurisdiction of the United States, is not an infringement of his rights, and he has no claim to any compensation for the profit or advantage the party may derive from its use. *Brown* v. *Duchesne*, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.

22. The exclusive use granted to a patentee does not extend to a foreign vessel lawfully entering our ports; and the use on such vessel of an improvement patented in this country, is not an infringement of the rights of the American patentee, provided it was placed upon such vessel in a foreign port, and authorized by the laws of the country to which she belongs. *Ibid.*, 198.

23. An infringement will not have taken place, unless the invention can be practised 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 *every thing* 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 Fisher, 309.—WILKINS, J.; Mich., 1857.

24. If the defendant's machine, in its original structure, was in fact and in truth no infringement, no piracy on the plaintiff's machine, and was not intended to be so, neither accident nor usage, as the natural wear of the material of which composed, 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. *Ibid.*, 312.

25. Where, therefore, in a patent for improvements in portable circular-saw mills, the patent covered merely a com-

bination of the use of rollers, or their equivalents, for guiding the circular saw, with a saw which had *free end play*, so as not in any case to have an end bearing against a shoulder in its ordinary revolutions, *Held*, that if the defendant's machine was originally constructed and *designed* with the *saw tight to the shaft*, so as to operate *without* end play, and by its usage, and by the wear of the metal of which the shaft was made, such free action or end play was undesignedly produced, that such free end play would not amount to an infringement of the plaintiff's patent. *Ib.*, 312.

26. There is no violation of the rights of a patentee, under the laws of the United States, giving to him an exclusive right to use the thing patented, provided the use of the thing patented by a third person is under a license or grant from the patentee, and such person covenanting to do certain things on his part, in consideration of such license. *Judson & Goodyear* v. *Union I. R. Co.*, 4 Blatchf., 66.—INGERSOLL, J.; N. Y., 1857.

27. If an invention be but an improvement on a known machine, the inventor cannot treat another as an infringer, who has improved the original machine by using a different form or combination, performing the same function. *McCormick* v. *Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

28. The inventor of a first improvement, cannot invoke the doctrine of mechanical equivalents to suppress all other improvements, which are not mere colorable invasions of the first. *Ibid.*, 405.

29. The use of a patented invention, as a matter of business, and the product of which is thrown into market for the purpose of being sold, cannot be called experimental, but is such a use as will make the party liable. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

30. Where two machines produce the same result, but the means used by each to effect or produce such result are different, the two machines are not alike in principle, and the one is not an infringement upon the other. *Burr* v. *Cowperthwaite*, 4 Blatchf., 172.—INGERSOLL, J.; Ct., 1858.

31. A patent for making bonnet frames is not infringed by making simply the crown of a bonnet, without the tip. A bonnet frame includes both the crown and tip. *Kidd* v. *Spence*, MS.—INGERSOLL, J.; N. Y., 1859.

4. *Actions for, and Defences in.*

See ACTIONS, B. 1, 3; EQUITY, B. 1; DEFENCES.

6. *Evidence as to, and by whom determined.*

See EVIDENCE, H. 3.

## C. OF TRADE-MARKS.

See also EQUITY, C.

1. The making and sale of medicines, under the name of medicines prepared and sold by the plaintiff, and selling them as and for those of the plaintiff, is a fraud upon the plaintiff, and an injury to his rights, for which the law will presume damage. *Thomson* v. *Winchester*, 19 Pick., 216.—SHAW, Ch., J.; Mass., 1837.

2. And the plaintiff, such a case being proved, will be entitled to recover nominal damage, at least, and more, if he shows he has sustained it. *Ibid.*, 216.

3. The fact that others have imitated the trade-mark and labels of the plain-

tiff, rather aggravates than excuses a violation, unless done with the consent or acquiescence of the plaintiff. *Taylor* v. *Carpenter*, 3 Story, 464.—STORY, J.; Mass., 1844.

4. A person has no right, and will not be allowed to use the names, letters, marks, or symbols, of another, to palm off upon buyers the article he is selling as the manufactures of such other person. *Coats* v. *Holbrook*, 2 Sand., Ch., 594.—SANDFORD, V. Chan., N. Y., 1845.

5. It makes no matter that the imitated article is as good as the original. *Ibid.*, 595.

6. The court will hold any imitation of a trade-mark colorable, which requires a careful inspection to distinguish its marks and appearance from those of the manufacture imitated. *Partridge* v. *Menck*, 2 Sand. Ch., 625.—SANDFORD, V. Chan., N. Y., 1846.

7. But it will not interfere, where ordinary attention will enable a purchaser to discriminate. It does not suffice to show that persons incapable of reading the labels might be deceived. It must appear that the ordinary mass of purchasers, paying that attention which such persons usually do, would probably be deceived. *Ibid.*, 625.

8. There can be no harm done to the owner of a trade-mark, of which he has a right to complain, unless his label or trade-mark be appropriated without change, or unless it is simulated in such a manner as probably to mislead his customers or patrons, inducing them to suppose that in purchasing the article marked they are purchasing that manufactured or sold by such owner. *Partridge* v. *Menck*, How. App. Cas. 559, 560.—WRIGHT, J.; N. Y., 1848.

9 One who affixes to his own goods an imitation of an original trade-mark by which those of another are distinguished and known, commits a fraud upon the public, and upon the true owner of the trade-mark. *Amoskeag Manuf. Co.* v. *Spear*, 2 Sand., S. C., 605, 606.—DUER, J.; N. Y., 1849.

10. In the case of the owner there is a fraud coupled with damage, which may be such as not to admit of compensation in damages, and which may be irreparable. *Ibid.*, 606.

11. In all cases where a trade-mark is imitated, the essence of the wrong consists in the sale of the goods of one manufacturer or vender, as those of another; and it is only when this false representation is directly or indirectly made, and only *to the extent in which* it is made, that a party can have a title to relief. *Ibid.*, 607.

12. The imitation of an original trade-mark need not be exact or perfect. It may be limited or partial. It may embrace variations that a comparison would instantly disclose, yet a resemblance may exist that was designed to mislead the public, and the effect may have been produced. *Ibid.*, 607.

13. It is not necessary, to render the imitation of a trade-mark culpable, that it should contain any forgery of the name of the owner of the original mark. Though the name of the proprietor is omitted, and that of the imitator substituted, if the peculiar device is copied, and so copied as to manifest a design of misleading the public, the omission or variation will be disregarded and an injunction issue. *Ibid.*, 608.

14. Under § 2 of the act of 1845, (New York) making it penal to sell any merchandise having on it any forged or counterfeited label or trade-mark, the vender cannot recover the price of the

goods sold, provided he knew that the labels or trade-marks were forged or counterfeited. *Rudderow* v. *Huntington*, 3 Sand., S. C., 256.—SANDFORD, J.; N. Y., 1849.

15. But where the vender had no knowledge that the labels or trade-marks were forged or fraudulent, and there was no warranty by him, nor any representation to such effect, he is entitled to recover. *Ibid.*, 256.

16. The original crime or fraud in the preparation of the counterfeit trade-marks does not attach itself to the goods in the hands of an owner ignorant of the offence, and fasten upon him the penalty of a wrong of which he is innocent. *Ibid.*, 256.

17. Where goods were sold by an auctioneer, as being a particular article, but they proved to be spurious, and the label to be counterfeit, but there was no proof that the auctioneer knew them to be counterfeit, and there were no representations as to their genuineness, nor any warranty, *Held*, that it was no defence to an action on a note given for such purchase that such goods were counterfeits. *Ibid.*, 256.

18. If a person has adopted the same mark which is well known and approved of, and which will cause his article to be taken for another in the market, it is an injury which the law will redress. *Coffeen* v. *Brunton*, 4 McLean, 519.—MCLEAN, J.; Ind., 1849.

19. In commercial dealings the utmost good faith should be observed, and no one is permitted to go into the market with a deception of this character, so as to profit by the ingenuity, good faith, or established reputation of another. *Ibid.*, 519.

20. Where a right is invaded by a fraudulent act, as by the wrongful use of another's trade-mark, nominal damages are recoverable, though no specific injury is proved. *Ibid.*, 520.

21. The adoption of the same trade-mark as the plaintiff's, or of one so like it as to deceive the public, is actionable. Mere colorable alterations will not protect the defendant. *Davis* v. *Kendall*, 2 R. I., 569.—GREENE, Ch. J.; R. I., 1853.

22. But if the defendant state on his label or trade-mark that the article which he sells is made by himself, although he calls it by the same name as the plaintiff, he will not be liable. *Ibid.*, 569.

23. And though the defendant without fraud use the trade-mark of the plaintiff, he is still liable; if the right be violated, it matters not whether it be by fraud or mistake. *Ibid.*, 570.

24. The question is, whether the defendant's label is liable to deceive the public and to lead them to suppose they are purchasing an article manufactured by the plaintiff, instead of the defendant. *Ibid.*, 579.

25. The wrong for which remedies for violation of trade-marks are given, consists in misrepresenting to the public, by the use of that trade-mark, goods or wares of another person as having been manufactured by the true proprietor of that mark, and thereby depriving him, to a greater or less extent, of the benefit of the good-will of his establishment, and the reputation of his articles. *Stokes* v. *Landgraff*, 17 Barb., S. C., 609.—STRONG, J.; N. Y., 1853.

26. If the article sold under the forgery of a trade-mark is inferior to that made by the true owner, he is injured in reputation; and if it be of a similar quality and kind, its sale goes so far to diminish the sale of his own article, and thus works a pecuniary damage. *Le-*

*moine* v. *Gauton*, 2 E. D. Smith, 348.—DALY, J.; N. Y., 1854.

27. The wrong and injury consists in the sale of the article falsely purporting and declared to be his manufacture; and it makes no difference whether that object was effected by counterfeiting the trade-mark which he uses at present, or one that he formerly used. *Ibid.*, 348.

28. Where a party was a manufacturer of steel pens, which he put up in boxes for sale, such boxes bearing particular numbers or labels which indicated the character of the article, and another removed from the inferior pens the number appropriate to them, and placed upon them the label of a superior kind, such acts are a fraud upon the public and the true owner, for which he may have an action. *Gillott* v. *Kettle*, 3 Duer, 626, 627.—BOSWORTH, J.; N. Y., 1854.

29. In the imitation of trade-marks, the essence of the wrong consists in the sale of the goods of the manufacturer or vender as those of another; and it is only to the extent in which such a false representation is made that a party can have a title to relief. *Samuel* v. *Berger*, 24 Barb., S. C., 164.—DAVIES, J.; N. Y., 1856.

30. The mere fact that names used on a trade-mark are fictitious will not authorize the use of it by strangers. *Stewart* v. *Smithson*, 1 Hilton, 121.—BRADY, J.; N. Y., 1856.

31. The question to be determined is, whether the mark used by the party claiming the protection of the court is owned by him, without regard to its form, which such party has a right to design according to his judgment or his fancy. *Ibid.*, 121.

32. To render a person liable for false representations by the use of false signs or trade-marks, the sign or mark must be false in fact, and be so known to the party using it, and have been used with *the intention to deceive*, and be of such a character as would mislead a person using ordinary caution. *Peterson* v. *Humphrey*, 4 Abb. Pr., 395, 396.—MITCHELL, J.; N. Y., 1857.

33. An imitation of a trade-mark, with partial differences such as the public would not observe, does the party entitled thereto the same harm as an entire counterfeit. *Clark* v. *Clark*, 25 Barb., S. C., 79.—MITCHELL, J.; N. Y., 1857.

34. Though the wholesale buyer who is most familiar with the marks may not be misled, if the small retailer or consumer is, the injury is the same in law, and differs only in degree. *Ibid.*, 79.

35. If a defendant has adopted a device or name so differing from that adopted by the plaintiff as in nowise to deceive the public or do injury to the plaintiff, then he is not liable. *Burnett* v. *Phalon*, 12 Mo. Law Rep., 221.—PIERREPONT, J.; N. Y., 1859.

36. When one intentionally closely imitates the trade-mark of another, as using the word "cocoine" instead of "cocoaine," the law presumes it to have been done for the purpose of inducing the public to believe that the article is that of him whose trade-mark is imitated, and for the purpose of supplanting him in the good-will of his trade and business. *Ibid.*, 223.

37. In an action for the infringement of a trade-mark, the plaintiff is not entitled to recover, as a part of his damages caused by the infringement, the costs of obtaining an injunction in the case. *Burnett* v. *Phalon*, 12 Abb. Pr., 189; 21 How., Pr., 102.—MONCRIEF, J.; N. Y., 1861.

# INJUNCTIONS.

A. In Respect to Copyrights..... 377
B. In Respect to Patents.
1. *General Principles applicable to all kinds of*..... 379
2. *Preliminary or Provisional*
*a.* Allowance or Refusal of..... 381
*b.* Right to, from exclusive Possession or former Recoveries; Character of such exclusive Possession.... 388
*c.* Security in place of, or on granting 396
*d.* Practice on Motions for..... .... 998
*e.* Continuance or Dissolution of..... 401
3. *Final or Perpetual*..... 404
4. *Violation of*..... 407
C. In Respect to Trade-marks..... 409

## A. In Respect to Copyrights.

As to when injunctions will issue to prevent publication of letters and manuscripts, see Letters and Manuscripts.

See also, Equity, A.

1. If the author of a book has not a copyright secured according to law, he is not entitled to an injunction to restrain the publishing and vending of the work by another. He can have no remedy of any kind. *Ewer* v. *Coxe*, 4 Wash., 490, 491.—Washington, J.; Pa., 1824.

2. If it is doubtful whether or not there has been an infringement, an injunction will not be granted in the first instance; but the parties will be sent to a trial at law. *Blunt* v. *Patten*, 2 Paine, 403, 404.—Thompson, J.; N. Y., 1828.

3. If there appears a reasonable doubt as to the plaintiff's right, or the validity of his title, an injunction will be refused, and he will be required to try his title at law. *Miller* v. *McElroy*, 1 Amer. Law Reg., 205.—Hopkinson, J.; Pa., 1839.

4. It is no objection to an injunction to restrain the infringement of a copyright, that if it goes to part of the work it may render the other part, which is original, wholly without value, or injuriously diminish its value. *Emerson* v. *Davies*, 3 Story, 796.—Story, J.; Mass., 1845.

5. If a person chooses, in any work, to mix with his own literary matter which belongs to another, he will be restrained from publishing that which does not belong to him; and if the parts cannot be separated, and by that means the injunction prevents the publication of his own matter, he has only himself to blame. *Ibid.*, 796.

6. Before granting an injunction on a charge of an infringement of a copyright, the court will generally refer the matter to a master, with instructions to report the extent of the infringement, if any, that the court may act in the case. *Story's Exrs.* v *Derby*, 4 McLean, 160, 161.—Curiam, Ohio, 1846.

7. A court of equity can restrain a future violation of a copyright, as well as require an account for a past one; and such remedy is often better than damages, which alone can be had at law. *Pierpont* v. *Fowle*, 2 Wood. & Min., 35. —Woodbury, J.; Mass., 1846.

8. In respect to copyrights, the course has been so liberal as to enjoin, if an equitable or clear title exists; and if the title be free from doubt, the court will always enjoin. *Ibid.*, 39.

9. Though small in value, an imitation or appropriation of another's invention or copyright may be actionable, and the subject of an injunction, perhaps, if easily separated from the rest. But where the appropriation is small, and pervades the whole work, and no permanent injunction can issue without destroying the whole, such a remedy would be disproportionate, unsuited to

the case, and therefore unjust. *Webb* v. *Powers*, 2 Wood. & Min., 521, 523. —WOODBURY, J.; Mass., 1847.

10. The damages sustained may be obtained in a suit at law, without destroying the whole work, and such would be the most equitable relief. *Ibid.*, 523.

11. But where a violation is clear, and the part copied can readily be separated, an injunction issues against such part. Where a party wilfully mixes the property of another with his own with a bad motive, he may be required at times to lose the whole. *Ibid.*, 521, 522.

12. An injunction in copyright cases chiefly runs against the specific parts copied. It is usually issued to work substantial justice between the parties, rather than destroy the whole book of the defendant for a small infringement, if otherwise it is novel and unexceptionable, and useful to the community. *Ibid.*, 523.

13. Whether the purchase and sale by the plaintiffs of the defendant's book, and the delay of plaintiffs to prosecute, should bar an application for an injunction; *query*. *Ibid.*, 523.

14. Where, on a motion for an injunction to restrain the alleged violation of a copyright, the evidence is conflicting, and not full enough to enable the court to determine on which side the truth lies, a decision on the injunction will be suspended, and an issue at law directed, and the defendants ordered to keep an account of their sales, and report to the court. *Jollie* v. *Jaques*, 1 Blatchf., 626. —NELSON, J.; N. Y., 1850.

15. There may be cases in which an equitable title in a copyright is sufficient to entitle its possessor to protection by injunction. *Little* v. *Gould*, 2 Blatchf., 181.—CONKLING, J.; N. Y., 1851.

16. Where, under an agreement between the plaintiffs and certain officers of the state designated by law for that purpose, and the reporter of the Court of Appeals, it was stipulated that, upon the terms mentioned therein, the plaintiff should have the exclusive right to the publication of the decisions of the said Court of Appeals prepared by said reporter, for a period of five years, and the defendants during that time published and sold such decisions, *Held*, that the plaintiffs, though not the assignees of the entire privilege or copyright, had a perfect title to the beneficial interest therein during the stipulated term of five years, and that it was such a title as the court was bound to take cognizance of. *Ibid.*, 181, 183.

17. Where, however, such reporter, after his removal from the said position of reporter, prepared a volume of the decisions of said court, on his own account, and in his individual or private capacity, such volume containing, however, some decisions that came into his hands while he held the official position of reporter—and sold the same to the defendants, who published the same, *Held*, on a bill filed by the plaintiffs for an injunction, and claiming title to such volume, by virtue of the agreement referred to in the case last above named, that the plaintiffs could not be considered as the legal owners of the volume, for the purposes of the contract under the copyright laws, and that they were not entitled to an injunction to prevent its publication and sale. Whatever obligation may arise under such contract as to such volume, is founded on the failure of the reporter to furnish the manuscripts to the plaintiff. *Little* v. *Hall*, 18 How., 172.—MCLEAN, J.· Sup. Ct., 1855.

18. Where, on a motion for an injunction to restrain the alleged violation of a copyright, it appeared that neither the title-page nor a volume of the printed book had been deposited until more than two years after the work had been published, *Held*, that the plaintiff was not entitled to an injunction, as he had no valid copyright. *Struve* v. *Schwedler*, 4 Blatchf., 24.—NELSON, J.; N. Y., 1857.

19. Where a person claimed to have secured his copyright in June, 1856, but before that time had assisted in the preparation for publishing of a volume, and in the selection of matter therefor, which he afterward insisted was included in his copyright, but at such time made no claim to copyright on his part, and subsequently was also employed by the publisher of the first work, at a stipulated price, to reduce for another work the drawings which were the subject of the assumed copyright, *Held*, that such person would not be permitted to stop the sale of the work, even if he had a valid copyright therein. By aiding in the publication, he agreed to it, and by assenting that the work might be published, he agreed that it might be sold. *Heine* v. *Appletons*, 4 Blatchf., 128.—INGERSOLL, J.; N. Y., 1857.

20. On a motion for an injunction for the infringement of a copyright, a reference will not be made to a master to examine the map or book of the complainant, and also that of the defendant, and report the facts, with his opinion on the question of the infringement of right. Such motions must be disposed of on the moving papers of the complainants and the affidavits on the part of the defendants in opposition thereto. *Smith* v. *Johnson*, 4 Blatchf., 252.—INGERSOLL, J.; N. Y., 1858.

## B. IN RESPECT TO PATENTS.

### 1. *General Principles applicable to all kinds of.*

1. A judge of the court in vacation can allow a writ of injunction in those cases only where it may be granted by the Supreme or a Circuit Court. *Livingston* v. *Van Ingen*, 1 Paine, 47.—LIVINGSTON, J.; N. Y., 1811.

2. Where, therefore, a suit was commenced on the equity side of the Circuit Court for the infringement of a patent, and praying for an injunction, and the parties were residents of the same state, *Held*, that the court had no jurisdiction of the case, as under the judiciary act the court could take jurisdiction only as between citizens of different states, and the act of 1800 conferred jurisdiction in patent cases only in actions at law, and that the injunction must be refused. *Ibid.*, 48, 54.

3. In the exercise of its 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, 448.—THOMPSON, J.; N. Y., 1825.

4. The jurisdiction exercised by a court of equity in granting an injunction is in aid of the common law, and should not be asserted when the right is doubtful. The court in granting the injunction acts upon the assumption that the right has been infringed, or that little or no doubt exists on that point. *Thomas* v. *Weeks*, 2 Paine, 97.—THOMPSON, J.; N. Y., 1827.

5. A bill will lie for an injunction, if the patent-right has been established, or

is admitted, 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, 752.—STORY, J.; Mass., 1845.

6. Bills for injunctions are usually brought after the title to a patent has been established, and the expectation is that the only questions agitated will be the amount to be accounted for, and the restrictions for the future. *Orr* v. *Merrill*, 1 Wood. & Min., 378.—WOODBURY, J.; Me., 1846.

7. Injunctions being prohibited in the courts of the United States (by § 5 ch. 22, of the act of 1793, 1 Stat. at Large), without notice first to the opposing party, it follows that all of them must be regarded as special, rather than some of them as common or matter of course, and therefore when resisted under such notice, whether the hearing comes on before or after an answer, no injunction can be granted unless special and sufficient cause is clearly shown. *Perry* v. *Parker*, 1 Wood. & Min., 281.—WOODBURY, J.; Mass., 1846.

8. An injunction cannot properly issue in a patent case, except on a bill of complaint regularly filed. *Morse* v. *O'Reilly*, MS.—CATRON, J., at Chambers; D. C., 1849.

9. An injunction cannot issue out of a state court to restrain a defendant from infringing a patent; such courts have no jurisdiction over the subject matter. *Dudley* v. *Mayhew*, 3 Coms., 19.—STRONG, J.; N. Y., 1849.

10. Proceedings to restrain the unlawful use of a machine are instituted against the owner or party concerned in the infringement, who is personally liable for the violation, and may be brought in the district where he lives, or is found at the time of serving the writ, even though the machine is in another district. But where it might become necessary to proceed directly against the machine itself, as in cases of controversy, or fraudulent contrivance to evade an injunction, the proceedings should be instituted in the district in which the machine is located. *Wilson* v. *Sherman*, 1 Blatchf., 541.—NELSON, J.; N. Y., 1850.

11. The stringent directions in the act of 1836 as to injunctions, copied from the act of 1819, seem to be designed to remove all doubts as to the authority of the courts of the United States to employ that process in patent cases to the same extent it is used in courts of general jurisdiction. *Nevins* v. *Johnson*, 3 Blatchf., 81.—BETTS, J.; N. Y., 1853.

12. If a defendant for a good consideration covenants not to infringe a patent, he will be enjoined by a court of equity from further infringing, unless he shows some equitable reason why the performance of such agreement should not be enforced. *Sargent* v. *Larned*, 2 Curt., 344.—CURTIS, J.; Mass., 1855.

13. A bill for an injunction should be filed in the state where the defendant resides. An injunction will not issue out of a court in a state different from that where such defendant resides and carries on his business, on the ground that they would be beyond the process of the injunction, and the issuing of it would be inoperative and useless. *Goodyear* v. *Chaffee*, 3 Blatchf., 270.—NELSON, J.; N. Y., 1855.

14. A writ of injunction 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, in order to warrant an attachment for its violation. *Whipple* v. *Hutchinson*, 4 Blatchf., 192.—NELSON, J.; N. Y., 1858.

15. Where the writ of injunction referred to the complaint for the description of the thing enjoined, such description may be sufficient, so far as the defendant, who has been already served with the complaint, is concerned, but as to all other persons it would not be sufficient. *Ibid.*, 192.

16. The writ of injunction is a remedial writ, in the nature of a prohibition —to prevent the commission of injuries in future, not to redress injuries that are past. It acts as a remedy against a threatened wrong by preventing the commission of such wrong. *Poppenhusen* v. *N. Y. G. P. Comb Co.*, 4 Blatchf., 187.—INGERSOLL, J.; N. Y., 1858.

17. It is not necessary before such a writ to prevent a wrong, issue, that the wrong should have been actually committed. When the rights of a party have been established, and an infringement of such rights is threatened, or where they have been infringed, and the party has good reason to believe they will continue to be infringed, an injunction will issue. *Ibid.*, 187.

18. The remedy by injunction, though necessary in certain cases to do complete justice, is nevertheless one which should always be cautiously granted, especially where demanded before decree on final hearing on the merits. *Goodyear* v. *Dunbar*, 1 Fisher, 474.—GRIER, J.; N. J., 1861.

19. If the defendant shows a belief that he has a just defence, and is not a wilful pirate of the plaintiff's invention, it should be a case of evident mistake of law or fact, or both, in his defence, which will justify the court in using their *festinum remedium*. *Ibid.*, 474.

## 2. *Preliminary or Provisional.*

### *a.* Allowance and Refusal of.

See also INJUNCTIONS, B. 2. *d.*

1. Where it appeared that the thing patented was the result of the suggestion of another, *Held*, that it threw so much doubt upon the patentee's right as the first and sole inventor, as to render it improper to grant an injunction until his right has been tried at law. *Thomas* v. *Weeks*, 2 Paine, 102.—THOMSON, J.; N. Y., 1827.

2. A court of equity will not interfere in behalf of a patentee, either to grant an injunction, or to give him any relief in respect to an alleged violation of his patent, if, after having obtained his patent, he has surrendered or dedicated it to the public, or acquiesced, for a long period, in the public use thereof without objection, as his own conduct may be considered as having led to such use or application, or acts of the defendants. *Wyeth* v. *Stone*, 1 Story, 282, 284.—STORY, J.; Mass., 1840.

3. The granting of an injunction is a matter resting in the sound discretion of the Court. *Ibid.*, 295.

4. In awarding an injunction, a very delicate and highly responsible power is used, which ought not to be exerted where there is reasonable doubt as to the existence of any fact on which the application is founded. *Cooper* v. *Matthews*, 8 Law Rep., 415.—BALDWIN, J.; Pa., 1842.

5. In asking an injunction, the plaintiff seeks either to interrupt the course

of the common law, or to ask for some relief he cannot 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 the courts of equity, and proper for its exercise. *Ibid.*, 416.

6. There should be a certainty as to all the material facts, for doubt and uncertainty are fatal to a motion to grant an injunction, though it is good cause for continuing it on a motion to dissolve, the burden of proof being on the plaintiff in one case, and on the defendant in the other. *Ibid.*, 416.

7. An injunction will be granted only when the plaintiff has used due diligence in asserting his rights. If he acquiesces, or is inactive while the danger exists, or the mischief is done, it negatives the necessity of action in equity, unless the inaction is accounted for. *Ibid.* 417.

8. The inquiry is not whether the plaintiff had notice of the violation of his right by the defendant, but whether his improvement has come into public use during his inaction, or a state of things of which he might have had notice by the use of due diligence, or where the law of equity deems negligence to be the same as notice. *Ibid.*, 418.

9. A court of equity frequently refuses an injunction where it acknowledges a right, when the conduct of the party had led to a state of things which occasions the application, and therefore will refuse or dissolve an injunction, without saying in whom the right is. *Ibid.*, 419.

10. An injunction will not be granted to restrain a party who has been in possession any length of time claiming by a title adverse, till the right is first settled by law. An injunction is a proper remedy to protect a possession until it appears to be against right, but is never used to disturb a possession under claim and color of right. *Ibid.*, 419.

11. The rule on which courts of equity act by an injunction in the first instance, is to leave the parties in the same position it finds them when the application for relief is made, by protecting the plaintiff in the same possession which he had before enjoyed, and when the possession of the defendant had been unmolested, leaving the right of possession to be settled at law. *Ibid.*, 419.

12. No cases come before a court of equity in which a greater degree of diligence is required than applications for injunctions; their nature and effect are such as to produce the most irreparable injury when improvidently granted. *Ibid.*, 419.

13. Equity acts on different principles in protecting the possession of the plaintiff, or declining to disturb the defendant; it leaves the right of the parties as they stand at law. *Ibid.*, 420.

14. The refusal of an injunction to a plaintiff does not impair his right or remedy at law. Nor does the granting of an injunction interfere with the defendant contesting, at law, the right of the plaintiff to the same extent as if equity had not interfered. *Ibid.*, 420.

15. Courts of equity exercise this part of their jurisdiction, granting injunctions with great caution, always declining it in a doubtful case, and one not brought forward by a party who was vigilant, and not clearly within the established rules and principles of equity jurisprudence. *Ibid.*, 421.

16. In most cases a court will not enjoin, until the complainant has established his right at law. But where the

injury would be irreparable, an injunction will issue. *Brooks* v. *Bicknell*, 3 McLean, 262.—McLean, J.; Ohio, 1843.

17. For a reference to and examination of many of the cases in reference to granting injunctions, see *Orr* v. *Littlefield*, 1 Wood. & Min., 13.—Woodbury, J.; N. H., 1845.

18. It is within the sound discretion of the court whether to issue an injunction or refuse it; or if issued, to dissolve or retain it. *Ibid.*, 19.

19. The rule is well settled, that in cases of infringement involving points to be decided by the testimony of experts, and as to which there is a great diversity of opinion, an injunction will not be decreed unless the right is clear, or has been established by an action at law. *Brooks* v. *Bicknell*, 4 McLean, 72.—McLean, J.; Ohio, 1845.

20. A patentee will not be deemed to have acquiesced in the use of his invention, so as to deprive him of the right to an injunction, &c., because he first proceeded against only the more palpable and obvious violations of his patent, or because he has not brought suit against all infringing upon it. *Van Hook* v. *Pendleton*, 1 Blatchf., 191.—Nelson, Betts, JJ.; N. Y., 1846.

21. *Semble*, that a workman on a machine, though not interested in it, is liable to be restrained in order to prevent evasions. *Woodworth* v. *Hall*, 1 Wood. & Min., 252.—Woodbury, J.; Mass., 1846.

22. So if a person does not himself 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*; or if he hire one to work on such a machine. *Ibid.*, 252.

23. An injunction will not be granted against a person restraining him from using a machine, unless it is shown that he actually used it, or received profit from it. *Ibid.*, 253.

24. Slight and unimportant alterations in a machine—alterations which the description of the invention would naturally, if not necessarily, suggest without the aid of much ingenuity or skill, will not be sufficient to prevent the issuing of an injunction to restrain the use of such a machine. *Gibson* v. *Harris*, 1 Blatchf., 170, 172.—Nelson, J.; N. Y., 1846.

25. An injunction will be granted as well against an agent, who merely sells the article which infringes a patent, as against the manufacturer, as both are joint trespassers, and they may be sued jointly. *Buck* v. *Cobb & Hermance*, 9 Law Rep., 547.—Conkling, J.; N. Y., 1846.

26. Where an inventor had manufactured and put on sale his invention for some time before his application for a patent, and had also sold large quantities of the article invented, an ornamental button, in packages marked as imported from Paris, thereby affording an implication that he was not the original inventor, *Held*, in an action for infringement, and the novelty of the invention being denied, that he was not entitled to a provisional injunction, until his right should have been established at law. *Booth* v. *Garelly*, 1 Blatchf., 250.—Nelson, J.; N. Y., 1847.

27. Where one person runs a machine which others own, and which machine is a violation of a patent, an injunction will issue against all for the violation. *Woodworth* v. *Edwards*, 3 Wood. & Min., 133.—Woodbury, J.; Mass., 1847.

28. If an injunction has been issued against a person, restraining him from the use of an alleged invention, which injunction remains in full force, and the grounds of which are in no way overturned, the use of such alleged invention will not be permitted by third persons, claiming from such person, but they will also be enjoined. *Ibid.*, 133.

29. An injunction is never issued in hostility to what seem to be the legal rights of parties, but in aid and protection of them. And whenever a trial is had, showing that the rights at law are with the party enjoined, the injunction, as a matter of course, will be dissolved. *Woodworth* v. *Rogers*, 3 Wood. & Min., 150.—WOODBURY, J.; Mass., 1847.

30. Where a bill was filed for an injunction, to restrain the running of a machine in violation of the plaintiff's rights, and the defendants justified under a license, which the complainant alleged had been abandoned, but there was no issue of abandonment made in the pleadings, *Held*, that no evidence of abandonment could be received, and therefore an injunction could not issue. *Wilson* v. *Stolley*, 4 McLean, 276.—MCLEAN, J.; Ohio, 1847.

31. The grant of a patent by the patent office, is not of itself, or in virtue of § 7 of the act of 1836, a bar to an interlocutory injunction, in favor of a person claiming to be a prior patentee of the same thing; and particularly as such person had no notice to appear and be heard at the patent office, and the court being satisfied on a hearing before it that the last granted patent was an interference with the one previously granted. *Wilson* v. *Barnum*, 1 Wall, Jr., 349, 350.—KANE, J.; Pa., 1849.

32. Where the court is itself satisfied that the defendants are infringing the plaintiff's right, although the majority of experts, called as witnesses, were of the opinion that there was no infringement, it is its duty to grant an injunction to restrain such infringement. *Ibid.*, 351, 352.

33. An injunction will be granted against a licensee to restrain him from the use of a machine, in violation of the conditions of his license, if applied for during the time of such violation. *Wilson* v. *Sherman*, 1 Blatchf., 540.—NELSON, J.; N. Y., 1850.

34. But where it appears that the violation has been under a misapprehension of his rights, and he has discontinued the violation, an injunction will not be granted. *Ibid.*, 540.

35. An injunction will be granted in favor of the holder of the legal title of a patent, against the holder of an equitable interest therein, if it appear that the holder of the legal title was a purchaser for a valuable consideration, and without notice of the equitable interest; and the burden of proof lies on him impeaching the legal title. *Gibson* v. *Cook*, 2 Blatchf., 145, 151.—NELSON, J.; N. Y., 1850.

36. The chief object of issuing writs of injunction before the final hearing of a cause, is to prevent irreparable mischief; not to give the complainant the means of coercing a compromise from the injury the defendants may suffer from being restrained. *Parker* v. *Sears*, 1 Fisher, 101.—GRIER, J.; Pa., 1850.

37. The issuing of an interlocutory injunction is always a matter of discretion with the court, and depends upon the peculiar circumstances of each case. *Ibid.*, 102.

38. 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. *Parker* v. *Sears*, 1 Fisher, 96.—GRIER, J.; Pa., 1850.

39. Where, however, the answers or affidavits are equivocal and evasive, or disclose a state of facts which show that the conclusions drawn from them are clearly erroneous, and founded on a mistake of 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 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 mistake of law, an injunction will issue, as such cases are exceptions to the general rule. *Ibid.*, 96.

40. The object of granting a preliminary injunction is simply to keep the parties in *statu quo* until the legal rights can be ascertained. One material question always is, whether the defendants are responsible. *Day* v. *Boston Belting Co.*, 6 Mo. Law Rep., 330, 331.—SPRAGUE, J.; Mass., 1853.

41. The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction articles are manufactured which are an infringement of a patent, and the agents who conduct the business of selling such articles, are responsible for such infringement, and may be restrained by injunction. *Goodyear & Union Rubber Co.* v. *Phelps*, 3 Blatchf., 93.—NELSON, J.; N. Y., 1853.

42. One tenant in common has as good right to use and license others to use a thing patented, as another tenant in common. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract between them. None such existing, one tenant in common cannot enjoin the other from such use or sale. *Clum* v. *Brewer*, 2 Curt., 524.—CURTIS, J.; Mass.; 1855.

43. A court of equity upon a bill filed by a legal owner of a patent cannot enjoin the equitable owner from using it. *Ibid.*, 523, 524.

44. In acting on applications for temporary injunctions to restrain the infringement of letters patent, there is much latitude of 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. *Forbush* v. *Bradford*, 11 Mo. Law Rep., 471.—CURTIS, J.; Mass., 1856.

45. The state of the litigation, where the plaintiff's title is denied, the nature of the improvement, the character and extent of the infringement complained of, and the comparative inconvenience which will be occasioned to the respective parties, by allowing or disallowing the motion, must all be considered in determining whether it should be allowed or refused; and if at all, whether absolutely or upon some and what conditions. *Ibid.*, 471.

46. Where the defendants were only using in their own business a certain number of the patented invention, looms for weaving, and were not making and selling, the court ordered an injunction, unless the defendants should within a certain number of days give a bond to keep an account of the cloth made on each of the looms, and file the

same under oath once in three months, and to pay the amount of any final decree in the cause. *Ibid.*, 472, 473.

47. If a defendant has been making and selling a thing patented for more than two years before the application for a patent by the patentee, an injunction will not issue to restrain him from doing that which he was accustomed to do at the time of the granting of the patent. *Gebberd* v. *Bagot*, MS.—INGERSOLL, J.; N. Y., 1857.

48. Where by granting an injunction there is more danger of producing an irreparable injury to the defendant than preventing it on the part of the complainant, it should not be granted. *Ibid.*

49. Every man who stands upon a patent has a *prima facie* title, which upon a preliminary question will not be pronounced good for nothing. *Cong. Rub. Co.* v. *Amer. Elas. Cloth Co.*, MS.—GRIER, J.; Pa., 1857.

50. Where on a motion for a preliminary injunction, the defendants claimed to act under a patent regularly issued from the Patent Office, *Held*, that the court would not on such a motion decide against such a patent, and grant the injunction prayed for. *Ibid.*

51. It is not a sufficient reason against granting an injunction that its issue will put the defendant to considerable expense, that he is not making any profits by its use, that he is willing to pay for its use when it shall have been legally established, and that he is able to respond in any damages which may be recovered against him. *Sickles* v. *Mitchell*, 3 Blatchf., 552.—INGERSOLL, J.; N. Y., 1857.

52. A defendant cannot insist upon having the privilege of using a patented invention for the reason that he is able to pay any damages which may be awarded against him at the end of a protracted litigation. *Ibid.*, 552.

53. Where the plaintiff's invention was in use upon one of a line of ocean steamers, and it was claimed that the issuing of an injunction to restrain its further use would be a great public calamity, and that it would be impossible to remove the invention without an enormous expense and a consumption of several months of time, *Held*, that these were not sufficient reasons for refusing an injunction, and that for such results the defendant had no one to blame but himself. *Ibid.*, 551–2.

54. Where the defendants set up that they were manufacturing the thing claimed to be an infringement of the plaintiff's patent, under and by virtue of another patent, and it appeared that they had been so manufacturing such article for a number of years with the knowledge of the plaintiffs, and without suits or molestation from them, *Held*, that the right to an injunction was not so clear of reasonable doubt as to warrant its issue. *North* v. *Jones*, 4 Blatchf., 73.—INGERSOLL, J.; N. Y., 1857.

55. Where on a motion for an injunction the only question raised was as to the fact of infringement, as to which the affidavits were contradictory, and the defendants denied that their machine was intended to, or did perform, the functions of the plaintiff's, and for which a patent had been obtained, though a slight change would give to the defendants' machine the benefit of the patentee's arrangement, the court denied the motion, but with liberty to renew it upon further evidence. *Singer* v. *Wooster*, MS.—NELSON, J.; N. Y., 1857.

56. An injunction will not be granted to restrain the use of a patented inven-

tion after the patent has expired. *Imlay* v. *Nor. & Wor. R. R.*, 4 Blatchf., 237.—INGERSOLL, J.; Ct., 1858.

57. An interlocutory injunction will not be granted when the defendant has letters patent for the same invention, as the plaintiff's, which are *prima facie* valid. *Sargent* v. *Carter*, 11 Mo. Law Rep., 652.—CURTIS, J.; Mass., 1858.

58. To authorize an injunction it is not necessary that *all* the grants of right in the plaintiff's patent should have been infringed. All that is required is that some of them should have been. *Potter* v. *Holland*, 4 Blatchf., 251.—INGERSOLL, J.; Ct., 1858.

59. Under the practice and decisions of the seventh circuit an injunction will be refused in a patent case, if upon the facts presented there is a fair doubt whether the defendant has infringed. *Dodge* v. *Card*, 2 Fisher, 117.—LEAVITT, J. · Ohio, 1860.

60. Upon a motion for a preliminary injunction, the defendant justified his acts under an outstanding adverse patent, which however was alleged to have been irregularly issued, *Held*, that the court would not ignore the rights of parties under such instrument, because there may have been some irregularity in its issue, and assume it to be a nullity. *Mitchell* v. *Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

61. The granting or refusal of an injunction in a patent case rests in the sound discretion of the court. A rash or indiscreet exercise of such power may be very oppressive, as of no use to the complainant and ruinous to the defendant. *Sanders* v. *Logan*, 2 Fisher, 170.—GRIER, J.; Pa., 1861.

62. As a remedy it should be administered only for prevention and protection. Where it is not necessary for these purposes, it is merely vindictive, injuring one party without benefit to the other. *Ibid.*, 170.

63. The issue of an injunction to stop a mill or a manufactory, locomotive or steam-engine, because in their construction some patented device or machine has been used, would be an act of *more than doubtful discretion*. *Ibid.*, 170.

64. Stopping the mill or engine might *inflict irreparable injury*, but could not benefit the inventor. *Ibid.*, 170.

65. Where the injury done to the patentee, by the use of his invention, exists not in using his invention, but in using it without paying compensation therefor, it being his interest that his invention should be used by all, provided he is paid the price of a license; and the measure of "actual damage" is a sum certain—the value of a license—and neither protection nor prevention is sought or required, but only compensation, the jurisdiction of a chancellor is not required, and an injunction is not the proper remedy; the issue of it would be an abuse of power. *Ib.*, 170.

66. An injunction is never granted vindictively, but only when it is necessary to protect the rights of the complainant. *Livingston* v. *Jones*, 2 Fisher, 210.—GRIER, J.; Pa., 1861.

67. Where a patentee has fixed a license fee as the consideration for the use of his invention, and suffers no other wrong for such use than the detention of his fee, an injunction would do him no good. *Ibid.*, 210.

68. Where a defendant is acting under apparent legal authority, *prima facie* good—as under a patent granted by the proper authorities—a preliminary injunction will not issue against him at the suit of an older patentee, claiming that his patent covers the same process.

The defendant, by virtue of his patent, has a *prima facie* legal right to manufacture under it. *Goodyear* v. *Dunbar*, 1 Fisher, 473.—GRIER, J.; N. J., 1861.

69. Wherever a defendant presents, by answer or otherwise, a case which shows a *bona fide* issue in fact or law, or a *prima facie* right to continue his manufacture, founded on a decree of the Patent Office, and a consequent public grant, the court will rarely give a preliminary injunction. This kind of process being, in fact, an execution before judgment, is to be used cautiously. *Ibid.*, 474.

70. Where an alleged infringement of a patented invention consists in the use of some improvement in expensive machinery, which has been adopted in good faith by a defendant, and where the profit of the patentee consists, not in the monopoly of selling his machine, but in the price of licenses given to others to use it, it being the interest of the patentee that all persons should use his improvement, provided they pay him for a license; and the injury being, not in their using his invention, but in their not paying him for using it; this court sitting in chancery, though it does not necessarily in such capacity act as auxiliary to a court of law, but may render a final decree on a patent, will not, before a right is established at law, grant a preliminary injunction, except in a clear case, since it might ruin the defendant without doing any corresponding benefit to the patentee, and since the main object of an injunction can be obtained by making the defendant keep an account until the right is decided at law. *Batten* v. *Silliman*, 3 Wall, Jr.—GRIER, J.; Pa., 1861.

71. This case, distinguished from the case of a medicine where the patentee's profit consists in a monopoly of sale, and the defendant has been at little or no expense, while his competition might be highly injurious to the complainant. An injunction might (the medicine not being a "quack" medicine) be granted in the latter case, when it would be refused in the former. *Ibid.*

72. The fact that, as between themselves, parties are connected together as the stockholders, managers, and servants of an incorporated company, will not exempt them from being enjoined, or being liable to an action for infringement. *Poppenheusen* v. *Falke*, 4 Blatchf., 494.—SHIPMAN, J.; N.Y., 1861.

*b.* Right to, from exclusive Possession or former Recoveries; Character of such exclusive Possession.

1. If the bill states an exclusive possession of the invention or discovery for which the plaintiff has obtained a patent, an injunction is granted, though the court may feel doubts as to the validity of the patent. *Isaacs* v. *Cooper*, 4 Wash., 260.—WASHINGTON, J.; Pa., 1821.

2. But where the patent is modern, and objections are made to the specification, or to the validity of the patent, the court will not, from its own notions of the matter in dispute, act on the presumed validity or invalidity of the patent, and will not grant an injunction until the plaintiff has established the validity of his patent at law. *Ibid.*, 260.

3. The rule in the English Court of Chancery, as to granting injunctions—and there are no American decisions at variance therewith—is, that where a patent has been granted, and there has been an exclusive possession of some

duration under it, the court will interpose its injunction without putting the party previously to establish the validity of his patent at law. *Sullivan* v. *Redfield*, 1 Paine, 449.—THOMPSON, J.; N. Y., 1825.

4. Where the patent is recent, and, upon an application for an injunction, it is endeavored to be shown, in opposition thereto, that there is no good specification, or, otherwise, that the patent ought not to be granted, the court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a court of law, before it will give him the benefit of an injunction. *Ibid.*, 449.

5. In *Hill* v. *Thompson* (3 Meriv. 622), in which Lord Eldon adopted the rule before referred to, the patentee had had his patent-right in operation for about eighteen months; but this was considered too short a period to justify a continuance of the injunction. *Ibid.*, 452.

6. If the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit, and if the plaintiff has been in possession of it by having used it or sold it, in part or in whole, the court will grant an injunction, and continue it till the hearing or further order, without sending the plaintiff to law to try his right. *Ogle* v. *Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

7. Where a patent was granted in 1818, and was on its face free from all exception, and six years thereafter the patentee sold the right for Pennsylvania for $700, and bill was filed in 1826 for an injunction to restrain an infringement, *Held*, that the injunction would be retained until the invalidity of the patent, or the want of title in the plaintiff, should be established by law. *Ibid.*, 585.

8. Where there has been an exclusive possession for some considerable time, of a patent-right, the court will sometimes, on the ground of possession, grant an injunction, without requiring the party previously to establish the validity of the patent at law. *Thomas* v. *Weeks*, 2 Paine, 97.—THOMPSON, J.; N. Y., 1827.

9. But where the patent is recent, and any real doubts are entertained of its validity, the court will require that it be established at law before it will grant the patentee the benefit of an injunction. These principles are well settled in this country, and are founded on the soundest rules of justice and equity. *Ibid.*, 97.

10. The sale of an invention, and its use by the inventor and his vendors, is sufficient evidence of an exclusive possession by claim and color of title, so that equity will protect in the continued enjoyment, whatever doubts may exist as to the validity of the patent. *Cooper* v. *Matthews*, 8 Law Rep., O. S., 419.—BALDWIN, J.; Pa., 1842.

11. The doctrine laid down by Lord Eldon in *Hill* v. *Thompson*, 3 Meriv. R. 622, as to granting injunctions in patent cases, stated in *Sullivan* v. *Redfield* (*ante*, 3 and 4), is the true doctrine, and is indispensable to the repose of titles, and the security of patentees. *Washburn* v. *Gould*, 3 Story, 170.—STORY, J.; Mass., 1840.

12. In motions for an injunction, the fact that the plaintiffs have for some considerable time enjoyed their rights,

is important, and cannot be disregarded. *Brooks* v. *Bicknell*, 3 McLean, 263.—McLean, J.; Ohio, 1843.

13. Where there had been possession for some considerable length of time under a patent—the patent having been extended—and a judgment in an action at law had been recovered against another defendant for the use of a machine substantially the same as that used by the defendant in the action, *Held*, that after the lapse of so much time, the affidavit of a single witness that the patentee was not the first inventor, would not outweigh the oath of the patentee, and the general presumption arising from the grant of the letters patent. *Woodworth* v. *Sherman*, 3 Story, 171, 172.—Story, J.; Mass., 1844.

14. The obtaining a verdict by a patentee in a suit at law against a person infringing his patent, is sufficient cause for granting an injunction till the hearing, against another infringer. *Orr* v. *Badger*, 7 Law Rep., 468.—Sprague, J.; Mass., 1844.

15. It is not enough that a party has taken out a patent, and thus obtained a public grant; he must furnish further evidence of a probable right, something stronger than the mere issue, as an *exercise and use* of his right. Such use and exercise for some years, without its being disturbed, strengthens the probability that his patent is good, and renders it so likely, as alone often to justify the issue of an injunction in aid of it. *Orr* v. *Littlefield*, 1 Wood. & Min., 15, 16.—Woodbury, J.; N. H., 1845.

16. The time to be regarded for such use is what has elapsed since the original issue. *Ibid.*, 16.

17. The court will not refuse an injunction on account of the shortness of time after the grant, however brief, if long enough to permit articles or machines to be constructed by the patentee, and to be sold publicly and repeatedly, and they have been so sold and used under the patent without dispute. *Ibid.*, 17.

18. Another kind of evidence, besides the issue of the patent itself, and long use and possession under it, so as to render it probable the patent is good, and justify an injunction, is the fact that if the patent has been disputed, the patentee has prosecuted for a violation of his rights, and has recovered. And it makes no difference that the judgments have been given on verdicts and defaults under agreements, if rendered without collusion or fraud. *Ibid.*, 17, 18.

19. Where a complainant has made out not merely a grant of the patent, but possession, and use, and sale under it for some time, undisturbed, and also a recovery, the courts have invariably held that such a strong color of title shall not be deprived of the benefit of an injunction till a full trial on the merits counteracts or annuls it. *Ibid.*, 19, 20.

20. Long possession and use under one patent, and recoveries upon it, will not inure in favor of another patent, as to which an injunction is asked, even though the two patents are very useful and necessary for each other, unless there is some connection in law between them, or one is auxiliary to or a part of the other. *Hovey* v. *Stevens*, 1 Wood. & Min., 295, 296.—Woodbury, J.; Mass., 1846.

21. An injunction, when asked before the trial and resisted, is never to issue as a matter of course till the trial. There must, 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 under 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. *Ibid.*, 303.

22. Where possession for some years has existed, or there have been numerous sales or recoveries, the court will not refuse an injunction, or dissolve it, on a denial of the validity of the patent by a defendant, either through affidavits, or an answer, or other pleadings. *Ibid.*, 304, 305.

23. If none of these fortifying circumstances exist, courts will not only refuse an injunction, but will dissolve one previously allowed, if the validity of the patent is denied or brought into doubt. *Ibid.*, 304.

24. Where plaintiffs have endeavored to obtain the verdict of a jury as to their patent—there having been two trials at law, at which the juries had disagreed—and have by reason of such suits lost opportunity of selling rights in their patent, and half of the term of the patent had expired, and the defendants were undoubted infringers, *Held*, that an injunction would issue, as the patent itself must be held *prima facie* evidence of all the plaintiffs claimed under it. *Buck* v. *Hermance*, 9 Law Rep., 547.—CONKLING, J.; N. Y., 1846.

25. Where there has been a possession for some years under a patent, and also numerous recoveries for infringements of it, and sales have been extensive, an injunction will issue. *Woodworth* v. *Hall*, 1 Wood. & Min., 253.—WOODBURY, J.; Mass., 1846.

26. Recoveries under an original patent are evidence after the issue of new letters with a new specification, to strengthen the title of the plaintiff so as to obtain an injunction. *Ibid.*, 257.

27. On a motion for a provisional injunction, where a patent has been frequently made the subject of legal actions, and decisions have been made in the Circuit and in the Supreme Court, in which the originality of the invention, and the validity of the patent have been examined and confirmed, the patent will be considered as established. *Van Hook* v. *Pendleton*, 1 Blatchf., 191.—NELSON, BETTS, JJ.; N. Y., 1846.

28. Though a plaintiff by repeated recoveries on his patent, and long possession under it, may be entitled to a temporary injunction against those infringing, yet, if the defendants deny the validity of the plaintiff's invention, the injunction, if granted, will only be until the validity of the patent can be determined by a trial at law, and will be dissolved if such suit is not brought before the next term of the court. *Woodworth* v. *Edwards*, 3 Wood. & Min., 133.—WOODBURY, J.; Mass., 1847.

29. The rendition of a verdict in a patent case in favor of a plaintiff is not conclusive upon the right of such party to an injunction. *Many* v. *Sizer*, 1 Fisher, 43.—WOODBURY, SPRAGUE, JJ.; Mass., 1849.

30. Where the plaintiff's machine has been in use for a long time, and the right to its enjoyment has been established by the judicial tribunals, if the court is satisfied that the defendant's machine is substantially identical with it, the court is bound to grant an injunction, and the defendants cannot give security for the damages that may be found against them on a trial at law. *Gibson* v. *Van Dressar*, 1 Blatchf., 536.—NELSON, J.; N. Y., 1850.

31. Where a bill was filed for an infringement of a patent, and an injunc-

tion was prayed and the originality of the invention was denied, and many affidavits read in support of such denial, and it also appeared that there had been three trials at law upon the question, in which there had been a verdict in favor of each party, plaintiff and defendant, and a divided jury on the other trial, *Held*, that the question of originality could not be considered as settled, and therefore the court suspended decision on the motion for an injunction, and directed an account to be kept by the defendants, and that an issue should be made up and presented for trial before a jury on the question of originality and infringement. *Allen* v. *Sprague*, 1 Blatchf., 567, 568.—NELSON, J.; N. Y., 1850.

32. An injunction will be refused if the verdicts establishing the complainant's title have been obtained on such inconsistent and contradictory claims, or have left the plaintiff's title in such a doubtful shape that the court cannot say with certainty what is, and what is not an infringement of the patent. *Parker* v. *Sears*, 1 Fisher, 97.—GRIER, J.; Pa., 1850.

33. An injunction will also be refused where possession is very vaguely stated in the bill, and is met and avoided by allegations and proof of a more peaceable and exclusive possession by the defendants. *Ibid.*, 97.

34. On a motion for an injunction, based upon prior adjudications in favor of his patent, the defendant may show that the title was not fairly in controversy in the cases which professed to try it—or that some material fact was then unknown, or some opposite argument overlooked—and the court, if satisfied that such was in truth the case, would not hold itself concluded by the former adjudications. *Parker* v. *Brant*, 1 Fisher, 61.—KANE, J.; Pa., 1850.

35. But the considerations which would justify a judge in renewing the discussion of a patentee's title after solemn hearing and judgment at law, should be such as, if presented to his view after a trial at law, would have induced him to set aside the verdict. *Ibid.*, 61.

36. Where the evidence shows that the defendants are infringing some of the claims of a patent, and the plaintiff has had a verdict at law upon his patent sustaining such claims, an injunction will be granted before final hearing, although it may be a question whether another claim in the same patent, the novelty of which is disputed, is valid. *Colt* v. *Young*, 2 Blatchf., 472, 474.—NELSON, J.; N. Y., 1852.

37. When a patent has been granted and there has been an exclusive possession of some duration under it, the court will enjoin, without putting the party previously to establish his right at law. *Foster* v. *Moore*, 1 Curt., 286.—CURTIS, J.; Mass., 1852.

38. It is not possible, however, to fix any precise number of years during which exclusive possession must have continued. *Ibid.*, 286.

39. And the acquiescence of the public is entitled to more or less weight, according to the degree of the utility of the machine, and the number of persons whose trade or business are affected by it. *Ibid.*, 286.

40. An exclusive possession of about eight years, under a patent for a useful machine, which affects the trade and business of large numbers of persons, and many of which machines had been constructed and put in operation in different states, is sufficient to justify

granting an injunction, before requiring the plaintiff to bring an action at law. *Ibid.*, 286, 287.

41. Upon a motion for a preliminary injunction, a verdict in favor of the plaintiffs in another action, but against different defendants, sustaining the originality of their invention, though not conclusive, is entitled to great consideration, and if the machine used by the defendants is substantially like that of the plaintiff, an injunction will issue. *St. John* v. *Prentiss*, MS.—NELSON, J.; N. Y., 1853.

42. Although on a motion for an injunction, it appears that on a trial at law as to the question of infringement there had been a verdict in favor of the plaintiff, the court is not bound to adopt the verdict of the jury, so found, but will examine the whole case, including the evidence given before the jury, and will grant or withhold the injunction, according to its own judgment therein. *Sickles* v. *Youngs*, 3 Blatchf., 297.—NELSON, J.; N. Y., 1855.

43. In this case, notwithstanding the verdict of the jury in favor of the plaintiff, the court decided that the defendant did not infringe, and refused the injunction. *Ibid.*, 303.

44. If a patentee has established his title under his original letters patent, he is entitled to a temporary injunction under an extension of such letters patent, without a further trial at law. *Clum* v. *Brewer*, 2 Curt., 517, 518.—CURTIS, J.; Mass., 1855.

45. Though, strictly speaking, there can be no possession of an exclusive right to an invention before the date of the patent—because the patent grants that right, yet, under our patent laws, the inventor may make and sell his invention for two years before his patent, and the public may acquiesce in his claim during such period, and such acquiescence may be entitled to weight, in considering his right to a temporary injunction. *Sargent* v. *Seagrave*, 2 Curt., 555.—CURTIS, J.; R. I., 1855.

46. To make a *prima facie* title, without a judgment at law, the patentee must have had such an exclusive possession, as with his claim and the acquiescence of the public lays a reasonable foundation for the presumption of the validity of his patent. *Ibid.*, 556.

47. An unsuccessful attempt to interrupt a possession strengthens the presumption which arises from it. *Ibid.*, 556.

48. It is not possible to fix any term of years during which the exclusive possession must have continued. Each case must depend upon its own circumstances, *i. e.*, the extent of the use or sales by the patentee, the degree of the utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right, and the completeness of the acquiescence under it. *Ibid.*, 557.

49. Where sufficient possession is established, a doubt concerning the validity of the patent will not necessarily prevent an injunction. The court will look to the particular circumstances of the case, to see what degree of inconvenience will be occasioned to either party by granting or withholding the injunction, and whether the defendant has voluntarily placed himself in the position to be subject to that inconvenience. *Ibid.*, 557, 558.

50. As respects the effect of a verdict upon a motion for a temporary injunction, a verdict and judgment, where

there is a bill of exceptions and a writ of error sued out, cannot be distinguished from a verdict where there is a motion for a new trial. Either may be disregarded by the judge, if his conscience is satisfied, though ordinarily neither should be. *Day* v. *Hartshorn*, 3 Fisher, 32, 36.—PITMAN, J.; R. I., 1855. [Stated as the opinion of CURTIS, J.]

51. A verdict at law, or finding in case of a feigned issue, is never conclusive upon a judge sitting in equity, on an application for an injunction. *Ibid.* 34. [Stated as the opinion of NELSON, J.]

52. The obtaining a verdict in favor of a plaintiff on a trial at law, is not necessarily conclusive as to the right of such party to have an injunction against the defendant. On a motion for an injunction, the judgment of the judge upon the law and the evidence must determine his action, and not the judgment of the jury. *Ibid.* 32.

53. Where the plaintiff's title has been finally established at law, he is entitled to an injunction, whatever may be the effect upon the defendants as to stopping their works, and throwing their employees out of employment. *Forbush* v. *Bradford*, 11 Mo. Law Rep., 472.—CURTIS, J.; Mass., 1856.

54. But where litigation is not in fact terminated, but a bill of exceptions has been taken upon a trial, resulting in favor of the plaintiff, and the result may be adverse to the plaintiff's title, it is necessary for the court to contemplate that as a possible result, and look at the consequences, in that event, of allowing or refusing the injunction. *Ibid.*, 472.

55. Where a patent has not been established by a trial at law, nor its use been acquiesced in by the public, to authorize the issue of a provisional injunction, the right of the plaintiff must be clear and free from doubt, and the violation on the part of the defendant must be equally clear. *North* v. *Jones*, 4 Blatchf., 72.—INGERSOLL, J.; N. Y., 1857.

56. In order to justify the issuing of an injunction to restrain the infringement of a patent, it is not necessary that the validity of the patent should have been established in a trial at law; the chief use of it having been so established is to show, where the defendant denies the invention of the patentee, or claims that the invention was known and used more than two years before the date of the application, that there is no foundation for such denial or claim. *Sickles* v. *Mitchell*, 3 Blatchf., 552.—INGERSOLL, J.; N. Y., 1857.

57. Where the patent has been in use a number of years, and there is no denial of the invention of the patentee, nor any proof that it had been used for more than two years before the application for a patent, an injunction will be granted without such trial. *Ibid.*, 552.

58. Where upon a trial in a former suit between the plaintiff and another defendant it had been determined that the invention used by the defendant in that suit was an infringement of the plaintiff's patent, although such use was under a patent, and the thing used by the defendant in the present suit was admitted to be the same as that used by the defendant in such other suit, *Held*, that the former adjudication as to the question of infringement was conclusive, and that an injunction would issue to restrain such use. *Ibid.*

59. Where a patentee had failed to sustain his patent in actions at law brought under both the original patent and its reissue, and the patent had not

been acquiesced in by the public, but the right of the patentee was contested by different persons, *Held*, that under such circumstances an injunction would not issue before a trial at law; but the defendants were required to be ready for trial at the next term, or that injunction should then issue. *Serrell* v. *Collins*, 4 Blatchf., 62.—INGERSOLL, J.; N. Y., 1857.

60. Where a trial at law has been had, resulting in a verdict in favor of the patentee, in which the right to the thing patented has been established to the satisfaction of the court, and the infringement made clear, such trial is sufficient without any other proof to authorize a court to grant an injunction to prevent any future violation of right. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 4 Blatchf., 187.—INGERSOLL, J.; N. Y., 1858.

61. Where a patentee has had quiet enjoyment under his patent for a considerable time, and has had verdicts in his favor in suits at law, the judgments in which were obtained without collusion, though the validity of the patents was not contested; and the novelty of his invention is strongly sustained by affidavits of competent persons, his patent will be considered valid and he will be entitled to a preliminary injunction against a defendant using substantially the thing patented to him. *Potter* v. *Holland*, 4 Blatchf., 250.—INGERSOLL, J.; Ct., 1858.

62. On a bill filed for an injunction within three months after issuing of the patent, the defendants denying that the patentee was the inventor of the thing claimed by him, and also denying infringement, *Held*, that there was no proof of such a public acquiescence of the exclusive right of the patentee, as to justify the assumption that his claim was well founded, and there being also some doubt as to the sufficiency of the specification of the patent, the injunction was refused, and the parties sent to an action at law. *Muscan Hair Co.* v. *Amer. Hair Manuf. Co.*, 4 Blatchf., 178.—HALL, J.; N. Y., 1858.

63. Where there has been no adjudication as to the validity of a patent under which a party claims, such party must show that he has had exclusive possession and enjoyment for some time before a preliminary injunction will be granted in his favor. *Mitchell* v. *Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

64. The possession and enjoyment of a patent, which will justify a court in granting a preliminary injunction, previous to a trial at law establishing the validity of the patent, must be something more than the mere holding of the parchment, or muniment of title, or experimenting with the patented article. If it is a machine or tool it must be brought into use—if a process, it must be put in execution—if a composition of matter or patented article, it must be put on sale. This is the true doctrine both in England and in this country. *Ibid.*

65. The bare holding of a patent and an infringement alone constitute no complete ground of relief, at least by preliminary injunction. *Ibid.*

66. Relief by injunction is never granted as a matter of course, nor on merely filing a bill and producing a patent. The patent itself, though in a certain sense *prima facie* evidence of the validity of the grant, is never sufficiently strong *per se* to warrant relief by injunction. *Toppan* v. *National Bank Note Co.*, 4 Blatchf., 511.—SHIPMAN, J.; N. Y., 1861.

67. In order to obtain such relief the title of the patentee must always be strengthened by exclusive possession for some period of time, or by an adjudication in which the validity of the patent has been sustained. *Ibid.*, 511.

68. The principle that exclusive possession for a time strengthens the title of a patentee, is founded on the idea that as it is a claim of right adverse to the public, and the public acquiesce in that claim, such acquiescence raises a presumption that the claim is good. *Ibid.*, 512.

69. But the use must have been a *public* use, under an avowed claim of 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, away from the eye of the public, sweeps away the ground of exclusive possession and acquiescence of the public. *Ibid.*, 512.

### c. Security on Granting, or in Place of.

1. If an injunction will lead to serious injury in suspending the works of the defendant, the court may require security of the complainant, to indemnify for such loss, if the patent is avoided, or can make an order to expedite a final hearing and decision. *Orr* v. *Littlefield*, 1 Wood. & Min., 20.—WOODBURY, J.; N. H., 1845.

2. Where an injunction had been granted against a person for an infringement of a patent, and while such proceedings were being taken, a third party, with full knowledge of all the circumstances connected with such injunction, became the assignee of all the rights and interests of the person first enjoined, *Held*, that such assignee stood in the light of the other's substitute, and that he could not be allowed, by giving security and keeping an account, to continue the business till final hearing, but that an injunction would issue against him. *Parkhurst* v. *Kinsman*, 2 Blatchf., 81, 82.—BETTS, J.; N. Y., 1848.

3. Where an application was made for an injunction to restrain the use of certain telegraph instruments, in use upon an extended line of telegraph, *Held*, that if any prudential proceedings were necessary, that the working of the line should not be stopped (as that might seriously and wrongfully injure the defendants), but that security should be required to indemnify the plaintiff, in case the suit should ultimately result in his favor. *Morse* v. *O'Reilly*, MS.—CATRON, J., at Chambers; D. C., 1849.

4. Where the judges of the court differed as to the question of infringement, and the jury had failed to agree, the court directed an injunction already granted to be dissolved, upon the defendant giving proper security to keep an account; or, on failure so to do, ordered it to remain, upon the plaintiff giving proper security. *Wilson* v. *Barnum*, 1 Wall., Jr., 354, 355.—GRIER, KANE, JJ.; Pa., 1849.

5. Where a patent has been in use a long time, and the right to its enjoyment has been established by the judicial tribunals, and it is evident that the defendant is infringing upon it, he will not be permitted to give security for the damages that may be found against him, but he will be enjoined. *Gibson* v. *Van Dresar*, 1 Blatchf., 536.—NELSON, J.; N. Y., 1850.

6. Where an infringement is clear, and the right to an injunction manifest, an injunction will not be stayed on the

defendants, giving security, and rendering a periodical account of their sales, even though the defendant is a person of pecuniary responsibility. *Tracy* v. *Torrey*, 2 Blatchf., 279.—NELSON, J.; N. Y., 1851.

7. When a bill was filed for an injunction, founded on long possession, and an allegation of infringement by the defendant's machine, but it appeared that the defendant had only constructed one machine for his own use, and it was not suggested that he was about to construct any other machine, the court required the defendant to keep an account, and file a bond with sufficient sureties to pay such sums as should finally be decreed against him, or that injunction should issue. *Foster* v. *Moore*, 1 Curt., 293.—CURTIS, J.; Mass., 1852.

8. If the plaintiff is made secure of receiving all the profits, which may arise from the use of the machine until a final hearing, he is sufficiently protected in case the infringement is proved. *Ibid.*, 293.

9. Where a plaintiff, upon bill filed, asked a preliminary injunction against the defendants, restraining the use of plaintiff's machine, and the defendants justified their use under certain agreements of the patentee, but omitted to show that they had performed, on their part, the conditions of such agreements, the court granted a modified injunction, that the defendants should be enjoined from using the machines, unless within a certain number of days, they gave security to keep and render an account of the profits arising from the use of the machines, and to pay over the same according to the order of the court. *Day* v. *Hartshorn*, MS.—PITMAN, J.; R. I., 1853.

10. Where a defendant was a *bona fide* purchaser of an invention, without notice that it was claimed to be an infringement of another patent, prior in time to the patent which had been granted for the invention so purchased, and his invention was constructed in conformity with the patent granted for it, and it appeared that a peremptory injunction, if granted, would have the effect to close the business of the defendants, the court, although the defendant did not contest the validity of the plaintiff's patent, or the title of the plaintiff as assignee, and its validity had been sustained by verdicts and judgments in two suits, withheld the injunction on condition that the defendant should give bonds in $5,000 to abide the final decision of the case. *U. S. Annunciator & Bell Tel. Co.* v. *Sanderson*, 3 Blatchf., 187.—BETTS, J.; N. Y., 1854.

11. Upon applications for injunctions there is much latitude of 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. *Forbush* v. *Bradford*, 11 Mo. Law Rep., 471.—CURTIS, J.; Mass., 1856.

12. Where the defendants were *using*, but not making, certain looms having a patented improvement, and an injunction would stop their whole business, *Held*, that they might be allowed to give security to keep and render an account. *Ibid.*, 472.

13. It is common, in case of a bill filed for an infringement, and motion made for a preliminary injunction, where the question of infringement is not manifest, and enjoining the defendant would produce serious hardship and inconvenience of his business, to withhold the injunction on the defendants, keeping

an account or giving security for damages accruing. *Tatham* v. *Lowber*, 4 Blatchf. C. C., 87.—NELSON, J.; N. Y., 1857.

14. Where a defendant was manufacturing under a patent, which was claimed to be an infringement of another and an older patent, the court refused to grant a preliminary injunction, but ordered the defendant to keep an account of all that he manufactured and sold. *Goodyear* v. *Dunbar*, 1 Fisher, 474.—GRIER, J.; N. J., 1861.

*d.* Practice on Motions for.

1. The practice of the court in equity upon motions for an injunction, is to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state a clear right, and is verified by affidavit. *Isaacs* v. *Cooper*, 4 Wash., 260.—WASHINGTON, J.; Pa., 1821.

2. If the bill states an exclusive possession of the invention for which the plaintiff has obtained a patent, an injunction is granted, although the court may feel doubts as to the validity of the patent. *Ibid.*, 260.

3. But if the defects in the patent or specification are so glaring that the court can entertain no doubt as to that point, the court will not restrain the defendant from using a machine, or other thing which he may have constructed, until a decision at law can be had. *Ibid.*, 260.

4. Where a patent was for an *improvement* on the horizontal wheel for gaining power to propel boats, but the specification did not state the nature of the original invention upon which it was an improvement, nor whether it had been patented, or give any information respecting it, an injunction was refused. as the nature of the improvement was altogether unintelligible. *Ibid.*, 261.

5. In an application for an injunction made by a patentee to restrain the infringement of a patent, it should appear by the bill, or by affidavit, that the complainant believes himself to be the original inventor of what he claims under his patent, and the bill must be sworn to. The oath taken by the patentee of originality of invention at the time of his application for a patent, is not sufficient. The question is, not whether the plaintiff believed himself to be the first inventor at the time he applied for a patent, but whether he believes it at the time he asks for the relief sought. *Sullivan* v. *Redfield*, 1 Paine, 445, 446.—THOMPSON, J.; N. Y., 1825.

6. 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 right, but in order to warrant an interference by injunction, there ought to be but little if any doubt in the minds of the court as to the validity of the patent, especially where the case rests entirely upon the complainant's own showing, without any opposing testimony. *Ibid.*, 447.

7. Upon a motion for an injunction, the plaintiff should subjoin to his bill a special affidavit to the truth of the allegations therein, and that he was the original and first inventor, as he believed, of the thing patented, and that the same had not been in use or described anterior to his invention. *Rogers* v. *Abbott*, 4 Wash., 514.—WASHINGTON J.; Pa., 1825.

8. On a motion for an injunction, the plaintiff must rest on the case stated in the bill, though he may, by affidavits,

state any matters which it sets forth with more particularity, and a reference to collateral matters which explain, or which tend to support and strengthen it; he may also, in the same way, contradict any statements made by the defendant in his affidavit, and either party may take and read the affidavits of other persons. *Cooper* v. *Matthews*, 8 Law Rep., 415.—BALDWIN, J.; Pa., 1842.

9. No affidavit of the defendant—and his answer in this stage of the case is to be considered only an affidavit—unsupported by other testimony, is to be considered as evidence to overthrow any averment in the bill. *Ibid.*, 415.

10. If there appears, from the affidavits of the parties or witnesses, such a repugnancy in point of fact as makes it necessary to decide on the relative truth of their conflicting statements, or the credibility of the affirmants, no prudent judge will undertake so dangerous an inquiry in the first stage of the cause. *Ibid.*, 415.

11. If the bill or affidavits state any facts not denied by the defendant, or if the plaintiff, in his counter affidavits, does not deny the statements of the defendant, such facts are assumed as a safe basis for a decision of the motion, though they may be open to inquiry at a subsequent state of the case. *Ibid.*, 416.

12. On a motion for an injunction, the exhibition of models on which their parties construct their respective machines, will not suffice to turn the scale either way, without an examination into the detail of the construction, combination, and operation of all their parts, by competent mechanics. *Ibid.*, 417.

13. The loss of a patent issued under the act of 1793, and which is required to be recorded, is no excuse for delay in applying for an injunction for its infringement; a copy would be as full evidence of the patentee's right, as the original, or as a new patent issued under the act of 1837. *Ibid.*, 418.

14. On a motion for an injunction, if the complainants have called in their bill for the defendants to answer, and they have filed such answer, though voluntarily and before the entry of any rule to answer, it seems that such answer will be treated as an answer, and not merely as an affidavit. *Brooks* v. *Bicknell*, 3 McLean, 254.—McLEAN, J.; Ohio, 1843.

15. From § 5, ch. 22, of the act of 1793, and the 55th rule in equity, it seems a hearing of both parties is contemplated on an application for an injunction. *Ibid.*, 254, 255.

16. And affidavits may be read, on the part of the plaintiff, in support of the bill, and in contradiction of the answer. *Ibid.*, 255.

17. Where the answer is responsive to the bill and under oath, and denies the infringement, something more than the evidence of a single witness must be produced to overcome it, and justify an injunction. *Woodworth* v. *Hall*, 1 Wood. & Min., 252.—WOODBURY, J.; Mass., 1846.

18. Where a bill was filed asking for an injunction against the use of a patent but lately issued, and the answer denied the use of it, and also the originality of the invention, and such answer was also supported by several affidavits, the injunction was refused until the trial of an issue at law to determine such matters. *Hovey* v. *Stevens*, 1 Wood. & Min., 292, 305.—WOODBURY, J.; Mass., 1846.

19. On an application for a preliminary injunction for an infringement of a pat

ent which had been reissued, and had been frequently adjudicated upon and sustained, *Held*, that the court would not, on such motion, entertain any questions as to the originality of the invention, or as to the validity of the reissued patent. *Gibson* v. *Betts*, 1 Blatchf., 164.—NELSON, J.; N. Y., 1846.

20. A court will not, on an application as to an injunction, examine critically the correctness or even sufficiency of the application for a patent, if it was made to all appearance in good faith, and was an attempt to make known and secure the claim. *Sparkman* v. *Higgins*, 1 Blatchf., 208.—BETTS, J.; N. Y., 1846.

21. Under the act of 1793, ch. 22, § 5, requiring "reasonable previous notice to the adverse party or his attorney of the time and place of moving for an injunction," it is usual to give a reasonable time for the preparation of the answer, and the taking of affidavits. *Wilson* v. *Stolley*, 4 McLean, 273.—MCLEAN, J.; Ohio, 1847.

22. Such notice was designed to enable the defendant to resist the application for the injunction; and this resistance can be most effectually made by permitting the defendant to file his answer. *Ibid.*, 273.

23. Affidavits may be heard in behalf of both parties, especially in patent cases. This enables the judge to act upon the motion with a better knowledge of the equitable rights of the parties. *Ibid.*, 273.

24. The defendant may be permitted to show, as preliminary to the motion for an injunction, that the bill upon its face is materially defective. *Ibid.*, 273.

25. But the court is not bound, on motions for injunctions, to decide doubtful and difficult questions of law, or dispute questions of fact, nor exercise this high and dangerous power, if exercised rashly, in doubtful cases, before the offender shall have an opportunity of a full and fair hearing. *Parker* v. *Sears*, 1 Fisher, 96.—GRIER, J.; Pa., 1850.

26. The nature of an application for a preliminary injunction is peculiar. It is not a final settlement of the legal rights of the parties; nor do they come into court with what are strictly to be called legal proofs, but with affidavits alone, upon which neither party has the right of cross-examination. *Day* v. *Bos. Belt. Co.*, 6 Mo. Law Rep., 330.—SPRAGUE, J.; Mass., 1853.

27. In moving for a preliminary injunction, the practice is, that the complainant must file the affidavits upon which he relies by a certain day, and then the defendant files his affidavits in reply by another appointed day, and this closes the evidence. The complainant is not entitled, as a matter of right, to file further affidavits in answer to those of the defendants. *Ibid.*, 331.

28. Whether, in a case of entire surprise, the complainant might not have an opportunity to reply; *query*. *Ibid.*, 331.

29. A mere denial, by an answer, of the equity of the bill will not prevent the court—at least in the first circuit, since the decision of *Poor* v. *Carleton*, 3 Sumn., 70—from looking into the law and the facts of the case, on a motion for a special injunction, and granting or refusing it, according to its discretion. *Clum* v. *Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

30. If the right to a temporary injunction depends on the construction of a deed, the court will construe it and act accordingly, whatever view of the question the answer may have presented. *Ibid.*, 519.

31. Under rule 107 in equity, and the amendatory rule of May, 1846, the court, or a judge out of court, has power to permit the plaintiff, on a motion for an injunction, where the defendants set up a license in defence, to put in proofs in rebuttal of the proofs put in by the defendant. *Day* v. *N. E. Car Spring Co.*, 3 Blatchf., 157.—BETTS, J.; N. Y., 1854.

32. But the defendant cannot reply to such rebutting proof by further proofs on his part. *Ibid.*, 159.

33. On a motion for a preliminary injunction to restrain the infringement of a patent, the court will not look further into the case than to ascertain whether or not, upon established principles of equity, to prevent an irreparable injury, the interference of the court is necessary, pending the litigation. *Sickles* v. *Youngs*, 3 Blatchf., 296.—NELSON, J.; N. Y., 1855.

34. Unless the right is clear upon the papers and proofs presented, in favor of the plaintiffs, the injunction will be refused. *Ibid.*, 296.

*e.* Continuance, or Dissolution of.

1. Though doubt and uncertainty are fatal to a motion to grant an injunction, they are good cause for continuing it on a motion to dissolve; the burden of proof being on the plaintiff in one case and on the defendant in the other. *Cooper* v. *Matthews*, 8 Law Rep., 416.—BALDWIN, J.; Pa., 1842.

2. The continuance or dissolution of an injunction is entirely within the sound discretion of the court. Because the right of the patentee may be questioned and even appear doubtful to the court from the evidence offered, an injunction will not necessarily be dissolved. *Orr* v. *Badger*, 7 Law Rep., 467.—SPRAGUE, J.; Mass., 1844.

3. Where, therefore, a patentee had been in quiet possession for some years, and had received considerable sums for sales under his patent, and had obtained a judgment in a suit at law, though the affidavits offered by the defendant were sufficient to render the result of a trial doubtful, a temporary injunction was continued to the hearing, it also appearing to the court that the plaintiff would suffer great injury from a dissolution of it. *Ibid.*, 468.

4. An injunction granted on an original patent, will not be continued as to the amended patent, issued on the surrender of the original patent, without a supplemental bill. *Woodworth* v. *Stone*, 3 Story, 750.—STORY, J.; Mass., 1845.

5. Where an injunction had been granted on a bill filed for an infringement of an original patent, and pending the proceedings the patent had been surrendered and a new or reissued patent taken, to which proceedings the parties to the suit had consented, and it was moved upon a supplemental bill to continue the injunction as to the new patent, *Held*, that the injunction already granted (supposing both patents to be for the same invention) was *prima facie* evidence of an intended violation, if not of an actual violation, and the injunction was ordered to stand continued as to the new patent. *Ibid.*, 753, 755.

6. Where the bill or affidavits of the complainant did not state with certainty the infringement of the defendant, and the complainant did not swear at the time of the filing of the bill that he believed he was the original and true inventor of the thing patented to him, and the defendant denied on oath that

the patentee was the original inventor, and also denied the novelty and utility of the invention, the preliminary injunction was dissolved. *Wilson* v. *Curtius*, 2 West. Law Jour., 511.—McCaleb, J.; La., 1845.

7. But the injunction may be revived on further affidavits setting forth the particulars of the infringement complained of, and alleging priority of invention in the patentee. *Ibid.*, 511.

8. It is not a matter of course to dissolve an injunction on the coming in of an answer denying the equity of the bill, if the complainant has produced auxiliary presumptions in favor of his right. *Orr* v. *Littlefield*, 1 Wood. & Min., 19.—Woodbury, J.; N. H., 1845.

9. It is within the sound discretion of the court whether to issue an injunction or refuse it, or if issued, to dissolve or retain it. *Ibid.*, 19.

10. In order to obtain an injunction in advance of a trial at law, there must be proof not only of a patent, but also of some length of use under it, or some considerable sales under 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 Wood. & Min., 303.—Woodbury, J.; Mass., 1846.

11. But where possession for some years has existed, or there have been numerous sales or recoveries, the court will not refuse an injunction, or dissolve it on a denial of the validity of the patent by the defendant, either through affidavits or an answer, or other pleadings. *Ibid.*, 304.

12. If none of these fortifying circumstances exist, courts will not only refuse an injunction, but will dissolve one previously allowed, if the validity of the patent is denied or brought into doubt. *Ibid.*, 304.

13. An injunction issued on a bill filed to restrain the use of a patent, and alleging long possession and sales under the patent, and that the validity of the patent had been supported by several trials, will not be dissolved on an answer denying generally the originality of the patent, and the use of it by the respondent, unless the denial is justified by something else, or the claim strengthened by some evidence. *Orr* v. *Merrill*, 1 Wood. & Min., 376, 378.—Woodbury, J.; Me., 1846.

14. But such an answer is sufficient to justify the court to direct an action at law to test the patent, with instructions that if such action is not brought by the plaintiff within a given time, the injunction will be dissolved. *Ibid.*, 378, 379.

15. A common injunction will be dissolved on an answer denying title, &c., but a special one will not, unless the denial is justified by something else, or the claim is strengthened by something else. In special injunctions a motion to dissolve depends on the sound discretion of the court, after affidavits as to merits, if required, and on the nature of the case. *Ibid.*, 378.

16. Though it may be true to a certain extent, that doubts as to the validity of a patent, when such doubts relate to the merits, are to be favorably considered against granting an injunction; an injunction once granted should not be disturbed for such doubts, when they relate to some technicality of form, and not to any neglect or wrong of the patentee, and especially when the trial on the merits is near. *Woodworth* v. *Hall*, 1 Wood. & Min., 400.—Woodbury, J.; Mass., 1846.

17. On a motion to dissolve an injunction granted on a bill of complaint, unless the proof offered overcome the equity of the bill and the evidence supporting it, the motion will be denied. The motion must depend on what is then presented to the court. *Sparkman* v. *Higgins*, 1 Blatchf., 207, 208.—BETTS, J.; N. Y., 1846.

18. Where the defendants deny the validity of the plaintiff's patent, a temporary injunction, if granted, will only be till the validity of the patent can be tried at law, and will be dissolved if such suit at law is not brought before the next term. *Woodworth* v. *Edwards*, 3 Wood. & Min., 133.—WOODBURY, J.; Mass., 1847.

19. On a motion to dissolve a special injunction, the main point is not whether an injunction should be granted at all, but having been already granted, until the contrary is shown, it will be presumed that the injunction was rightly granted. *Woodworth* v. *Rogers*, 3 Wood. & Min., 143.—WOODBURY, J.; Mass., 1847.

20. Such presumption may be overcome by new matter or evidence, arising since the injunction was imposed, though generally not by matter then existing, which the party neglected to present to the consideration of the court. *Ibid.*, 143.

21. Such new matter is usually a subsequent answer, denying the originality of the patent, or its validity, and supported by *prima facie* proof, or by showing a trial at law and a judgment against the patent. *Ibid.*, 144.

22. The presumptions arising from the answer may be disproved by evidence on the part of the plaintiff, and then counter testimony is admissible by the respondent to sustain the answer. *Ibid.*, 144.

23. It is 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, the injunction ought to be dissolved or not. *Ibid.*, 145.

24. If the preponderance is in favor of the plaintiff, the injunction will be retained until the legal right has been determined by a feigned issue, or a trial at law. And when the parties do not agree as to the issue to be tried, the court will direct a suit at law to be brought at the next term of the court, or the injunction will be dissolved. *Ibid.*, 146, 151.

25. A common injunction is usually dissolved, as a matter of course, on the coming in of an answer denying merits, or a legal title in the plaintiffs, and without any inquiring into the truth of the allegations—otherwise, in the case of a special injunction. *Ibid.*, 147.

26. An injunction is never issued in hostility to what seem to be the legal rights of parties, but in aid and protection of them. And whenever a trial is had, showing that the rights at law are with the party enjoined, the injunction, as a matter of course, will be dissolved. *Ibid.*, 150.

27. Nor does an injunction delay or retard a trial by jury, but only makes the *prima facie* title prevail till then. *Ibid.*, 150.

28. Where a bill was filed against K., and an injunction was granted against him, and afterward a supplemental bill was filed to bring in the assignee of K., and new charges were inserted in regard to K., so as to embrace transactions of his not covered by the injunction originally awarded against him, *Held*, that as the transactions of K. set forth in the supplemental bill, were of

the same character with those before enjoined, they came within the scope of the former injunction, and that it must be extended to include them. *Parkhurst* v. *Kinsman*, 2 Blatchf., 79. —BETTS, J.; N. Y., 1848.

29. It appearing also that G. had been clerk of K. and knew his transactions, in respect to the patent, and of the granting of the injunction against K., and that on the very day of the hearing for the injunction, he became the assignee of K., *Held*, on a motion for an injunction against G., that he stood before the court chargeable with the liabilities of K., and took the subject matter assigned to him with no other or higher rights as respected the plaintiff than K., and did not stand before the court as an independent infringer. *Ibid.*, 80, 81.

30. Where a bill was filed for an infringement of a patent, on which a preliminary injunction was allowed, and the answer, which was supported by affidavits, denied the infringement, and also set up that the acts of the defendant were done under a license from the plaintiff, the injunction was dissolved. *Goodyear* v. *Bourne*, 3 Blatchf., 268.—NELSON, J.; N. Y., 1856.

31. Where an injunction has been granted in a patent case by a circuit judge, a district judge, as a judge of the Circuit Court, will not review or set aside such action, by dissolving the injunction. At least the reasons that would justify such a course must be peculiar and stringent. *Hussey* v. *Whiteley*, 2 Fisher, 125.—LEAVITT, J.; Ohio, 1861.

### 3. *Final or Perpetual; when granted and when not.*

See also INJUNCTIONS, B. 1.

1. If a state grant to the possessor or introducer of an invention an exclusive privilege to use the same for a limited period, such act or grant is constitutional, and the grantees are entitled to an injunction against those infringing such privileges. *Livingston & Fulton* v. *Van Ingen*, 9 John., 507, 562.—YATES, J.; 1812. *Ibid.*, 571.—THOMPSON, J. *Ibid.*, 585 to 589.—KENT, Ch. J., N. Y. [Overruled in fact by *Gibbons* v. *Ogden*, 9 Wheat. 1824, as interfering with the general laws regulating the coasting trade.—*Ed.*]

2. An acquiescence of a patentee in the known user by the public, without objection or qualification, of his invention, is sufficient ground to justify a court in refusing him an injunction against such user. *Wyeth* v. *Stone*, 1 Story, 284.—STORY, J.; Mass., 1840.

3. A court of equity will refuse an injunction, even where the legal right and title of the party are acknowledged, when his own conduct has led to the very act of application of the defendants of which he complains, and for which he seeks redress. *Ibid.*, 283.

4. If a patentee neglects to file a disclaimer, where he ought to take such proceedings, until after suit is brought, a court of equity will not interfere to grant a perpetual injunction, whatever may be his right and remedy at law. *Ibid.*, 295.

5. Where a party was the owner of a patent-right for a certain district, and articles under the same patent were manufactured in another district but sold in the first district, *Held*, that the court would not enjoin such sale, as the exclusive right was confined to the things patented, and not to the products. *Boyd* v. *Brown*, 3 McLean, 296, 297. —MCLEAN, J.; Ohio, 1843.

6. Whether, if the party manufacturing in the second district was actually engaged in selling within the district owned by the other, it would not be such a violation of the right of such person that an injunction would issue. *Ibid.*, 296.

7. The sale of the products of a patented machine by a person not connected with or interested in the manufacture is not such an infringement as will be enjoined; but if the person who sells is connected with the use of the machine, he is responsible for damages, and may be enjoined. *Boyd* v. *McAlpine*, 3 McLean, 429, 430.—McLean, J.; Ohio, 1844.

8. And though the structure and use of the machine may be beyond the jurisdiction of the court, if the court have jurisdiction of the person of the defendant, the court may restrain him from using the machine and selling the product. *Ibid.*, 430.

9. Where a party has a license under a patent, and the patentee reserves the power, upon default of payment of the agreed price for the privilege, to claim and take back the interest, and an action was brought to recover the arrears, the patentee may still have an injunction to restrain the licensee from further use of the privilege, the action for the arrears and a judgment thereon being no waiver of the forfeiture. *Armstrong* v. *Hanlenbeck*, 3 N. Y. Leg. Obs., 45.—Betts, J.; N. Y., 1844.

10. Where a party has a license to use a patented machine, upon certain conditions, he may be enjoined from using it except upon those conditions; but a failure to perform such conditions is not necessarily a forfeiture of his license, so as to entitle the plaintiff to an absolute injunction against all use of the machine. The defendant may be enjoined according to the conditions of his license. *Brooks* v. *Stolley*, 3 McLean, 529.—McLean, J.; Ohio, 1845.

11. A reference being ordered to a master to take testimony as to an infringement, and to report thereon, and the report of such master being in favor of the plaintiff, and that the defendant had infringed his patent, the court granted an injunction as prayed for. *Parker* v. *Hatfield*, 4 McLean, 64.—McLean, J.; Ohio, 1845.

12. A purchaser, for his own account, of articles manufactured by a patented machine, though purchased with a full knowledge that they were manufactured in violation of the patent, cannot be enjoined, or held liable in any other way. *Anon.*, 3 West. Law Jour., 144.—N. Y., 1845.

13. If, from the evidence in the case, it appears that the defendant has infringed the right of the complainant, an injunction will be granted restraining the defendant from further infringement. *Buck* v. *Gill*, 4 McLean, 174, 177.—McLean, J.; Ohio, 1846.

14. In particular cases, as where the patent is for a machine to make some article of manufacture, and a source of profit arises from the monopoly of such articles, a court would issue an injunction in the last month or week of the patent's life, to restrain the sale of articles piratically manufactured in violation of the patent while it was in force. But where the plaintiff can be compensated in damages, it seems an injunction will not, under ordinary circumstances, be granted during the last few weeks of a patent. *Parker* v. *Sears*, 1 Fisher, 102.—Grier, J.; Pa., 1850.

15. The rule that a court of equity will not grant a final and perpetual in-

junction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided, is not absolute or universal. It is a practice founded more on convenience than necessity, and always rests in the sound discretion of the court. *Goodyear* v. *Day*, 2 Wall, Jr., 296.—GRIER, J.; N. J., 1852.

16. In the courts of the United States the practice of sending the parties to an action at law is by no means as general as in England, and there are many cases in which a final injunction has been decreed without a verdict to establish the patents, thus showing that the courts of the United States 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. *Ibid.*, 297, 298.

17. One of a number of joint tenants in a patent cannot come into a court of equity and assert a superior equity as against another. Nor can one tenant in common enjoin the other from the use or sale of the patent. *Clum* v. *Brewer*, 2 Curt., 524.—CURTIS, J.; Mass., 1855.

18. The plaintiff was the assignee of the Maynard patent for locks and primers, which the defendants, a company organized for the manufacture of Sharp's rifle, applied to their guns without the license or consent of the plaintiff, though with his knowledge; as to the compensation for such use some negotiations had also been had between the parties, but without any satisfactory result. The defendants had contracted to furnish the British government with six thousand of such rifles, fitted with the Maynard lock. The plaintiff now filed his bill for the infringement of his patent, asking an account, and that the defendants pay the damages the plaintiff had sustained, and also that the defendants be enjoined from completing their contract with the British government, until they should pay a reasonable compensation for the use of the patent. The defendants, in their answer, did not deny the validity of the patent, or the plaintiff's title, but admitted the use, setting up the negotiations as to compensation, their willingness to pay a reasonable price, and the fact that the contract with the British government was entered into pending such negotiations, and offered to pay twenty-five cents per lock, used by them, or the profits which an accounting should show they actually made upon such locks; *Held* by the court, that the defendants should be enjoined from further use of the plaintiff's patent, without first paying for the use of the same, or obtaining the plaintiff's consent, except as to the contract with the British government, which they should be allowed to complete, and further that the defendants should not be permitted to withdraw their offer as to the amount they were willing to pay for their use of the plaintiff's patent. *Smith* v. *Sharp Rifle Co.*, 3 Blatchf., 548.—INGERSOLL, J.; Ct., 1857.

19. G., the inventor and patentee of a new process for vulcanizing india-rubber, in 1844, gave to the Naugatuck I. R. Co. a license to use, with a few exceptions, his whole right, granted by such patent, upon the payment of a stipulated tariff. G. also covenanted not to license any other person to use such patent, but reserved the privilege to sell the right, under such patent, for any particular subject of manufacture for a sum in gross, the said company, however, to have the refusal to become the purchasers of said right at the stipulated sum offered by others, and any

such sale could not be made to any other parties, except on the refusal or neglect of the company for sixty days after the offer had been made to them, to become the purchasers, nor then, except the one-fourth part of the stipulated sum should be paid to such company. The place of manufacture of such company was at Naugatuck, Connecticut, but they had a place of business in the city of New York, where their treasurer was to be found, and who was the agent of the company. There was no regular time or place prescribed for the meeting of the directors of such company, who met sometimes at Hartford, sometimes at Naugatuck, and sometimes at New York. Subsequently, in 1847, G. had an offer for the purchase of the right, under his patent, to manufacture car springs. He gave notice of such offer to the treasurer of the said company, at his office in New York, and after the expiration of sixty days from such notice, sold such right to E. & C., for the agreed price, one-quarter of which was paid to said company, through their said treasurer, who received the same, with a knowledge on what account paid, and carried it to the credit of such company. E. & C. afterward assigned their right to the plaintiffs. The Naugatuck I. R. Co., about the same time, assigned all their right under the patent to the defendants, who, under it, commenced to manufacture and sell car springs. The plaintiffs filed their bill, asking an injunction to restrain such manufacture. The defendants insisted that their grantors, the Naugatuck I. R. Co., had never assented to the sale of G. to E. & C., and that G. had not performed the conditions which entitled him to make such sale. *N. E. Car Spring Co.* v. *Union Rub. Co.*, 4 Blatchf., 6.—INGERSOLL, J.; N. Y., 1857.

20. *Held*, 1st. That the payment to the treasurer of such company, of the one-fourth of the sum received by such sale, and the receipt of it by him, and his applying it to the benefit of such company, was a legal and sufficient payment thereof to the company. *Ibid.*, 7.

2d. That such treasurer or agent was the proper person to receive notice from G. of any intended sale, and that G. was not bound to give personal notice to the directors, and that the agreement not requiring written notice, a verbal notice was sufficient, and that such notice could be given at any time. *Ibid.*, 7.

3d. That it was the duty of the directors of such company to inform themselves of the transactions of said company and the acts of their agent, and that the defence could not be set up that the corporation had no knowledge of the purpose for which said money, the one-fourth of proceeds, was paid, and were not bound by it, or that their agent had neglected to inform them in respect thereto. *Ibid.*, 8.

4th. That the transfer to E. & C. by G., was a legal and valid license or assignment, and that from and after its date the Naugatuck I. R. Co. had no right to use the patent for the purposes for which conveyed to E. & C., and that the plaintiffs were entitled to an injunction, as prayed for, to restrain the defendants. *Ibid.*, 9, 14.

### 4. *Violation of, and Attachment on.*

1. Where a plaintiff in an injunction suit endeavored to entrap the defendant into a violation of an injunction, *Held*, that the proceeding on the part of plaintiff would not, either in con-

science or law, justify an attachment, and that the plaintiff should be charged with the costs of the application. *Sparkman* v. *Higgins*, 2 Blatchf., 30, 31.—BETTS, J.; N. Y., 1846.

2. Where an injunction was issued against a defendant restraining him from using a certain machine, and afterward such defendant leased the machine to others, who continued to use it, but it had never been in the legal possession of such defendant since he was enjoined, *Held*, on a motion for an attachment, that the defendant could not be regarded as in contempt, and that an attachment would not issue. *Sloat* v. *Patten*, 6 Penn. Law Jour., 189, 190.—KANE, J.; Pa., 1846.

3. Where a person had been enjoined not to use a machine substantially like the one mentioned in the complainant's bill, *Held*, that he was guilty of a contempt, by the purchase and use of a machine which had been enjoined against in a neighboring circuit as being also substantially like the plaintiff's. *Woodworth* v. *Rogers*, 3 Wood. & Min., 142.—WOODBURY, J.; Mass., 1847.

4. He may, however, purge himself of such contempt by showing that he was ignorant of such injunction against the machine so used by him. *Ibid.*, 143.

5. An injunction in a patent case does not extend beyond what is the right of the plaintiff; unless there has been a violation of the right held by the plaintiff under his patent, there can have been no disobedience of the injunction. *Byam* v. *Eddy*, 2 Blatchf., 524.—PRENTISS, J.; Vt., 1853.

6. Where a defendant some months before the service of an injunction upon him, had made his bond, acknowledging the validity of the plaintiff's patent, and of his right to all that was granted by it, *Held*, that such bond was no evidence of a breach of such injunction, any further than the recital in it that the defendant had infringed the patent, might have a tendency to establish such breach, and that such inference or presumption arising from it could be overcome by credible positive testimony proving no infringement. *Ibid.*, 527.

7. An injunction after it has been once served continues its action until withdrawn by order of the court. *McCormick* v. *Jerome*, 3 Blatchf., 487.—BETTS, J.; N. Y., 1856.

8. Where an order granting an injunction was made, and the writ of injunction issued thereon was not tested till more than six weeks after, and was not served till within a few days of one year after the day of its test; *Held*, that a disobedience of the writ would not be punishable by attachment. *Ibid.*

9. After such a lapse of time the plaintiff should, before using the writ, have applied to the court for authority to do so. *Ibid.*, 488.

10. In order to warrant an attachment for a breach of an injunction, the party to be proceeded against must be a party to the suit, and have had notice of the application for the injunction. *Sickles* v. *Borden*, 4 Blatchf., 18.—HALL, J.; N. Y., 1857.

11. On a motion for an attachment for a violation of an injunction the objection cannot be taken that the injunction is broader than the order authorizing it; if the injunction served is too broad, the defendants, when served with it, should immediately take means to set it aside for that reason. *Ibid.*, 20.

12. An attachment for a violation of an injunction may issue against the agent and acting officer of the defend-

ant (a foreign corporation), and he is not exempted therefrom on the ground that he is a mere servant of the defendant. *Ibid.*, 20.

13. Where the violation of the injunction was the use of the thing patented on a steamboat, *Held*, that the engineer was properly made a party to the proceeding, and that an attachment would issue against him. *Ibid.*, 20, 21.

14. The operation or restraints of an injunction cannot be extended beyond the precise limits indicated by it. *Ibid.*, 17.

15. Whether an injunction will embrace the servants, agents, workmen, and employees of the defendant, unless specially named therein; *query*. *Ibid.*, 18.

16. To warrant an attachment for a violation of an injunction, the service of the writs should not be left in doubt. Where the plaintiff gave evidence of the service of the writs, but the party proceeded against swore positively that he had never been served with any such writs, but only with a copy of the order of the court granting an injunction, *Held*, that there was so much uncertainty as to service, that the writ of attachment should not be granted. *Whipple* v. *Hutchinson*, 4 Blatchf., 191.—NELSON, J.; N. Y., 1858.

17. Where the use complained of was under an agreement with the patentee, made subsequent to the allowance of the injunction, an attachment should not issue. *Ibid.*, 192.

18. An attachment as for a contempt for disobeying an injunction, issued after verdict to restrain a defendant from infringing the plaintiff's patent, will not be granted unless the alleged violation is a use of that actually patented to the plaintiff, or its evident equivalent; the injunction issued can only be a broad as the patent. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 4 Blatchf., 254.—INGERSOLL, J.; N. Y., 1859.

19. Where, therefore, the plaintiff's patent was for the use of *tin-foil*, or its *equivalent*, in the vulcanization of india-rubber and other gums, and an injunction issued against the defendants to restrain their infringing such patent, and they afterward used *sheets of brass and tin*, in a similar way to that in which *tin-foil* was used by plaintiff's patent, *Held*, on a motion for an attachment for violating the injunction, that such plates, though somewhat flexible, could not be considered an equivalent for tin-foil, and that the attachment must be denied. *Ibid.*, 255.

## C. IN RESPECT TO TRADE-MARKS.

See also EQUITY, C.; TRADE-MARKS, A.

1. If there is any question whether the acts of the defendant are a fraudulent interference with the rights of the plaintiff as to the good-will of his business, it should be left to a trial by jury in the ordinary course of law. An injunction will not be allowed in such a case. *Snowden* v. *Noah*, Hopk. Ch., 353.—WALWORTH, Chan.; N. Y., 1825.

2. Where a person intentionally pirates a trade-mark of another for the fraudulent purpose of inducing the public, or those dealing in the article, to believe it was in fact the article manufactured by the one originally using such mark, and with the intention of supplanting him in the good-will of his trade and business, a perpetual injunction will issue, restraining such use, and the party so using will also be liable to damages. *Taylor* v. *Carpenter*, 11 Paige, 298.—WALWORTH, Chan.; N. Y., 1844.

3. And it is wholly immaterial whether the simulated article is or is not of equal goodness and value with the real article. *Ibid.*, 298.

4. Where the complainants, subjects of Great Britain, were manufacturers of a certain thread, labelled "Taylor's Persian Thread," and the defendants in America manufactured and sold thread stamped, labelled, and enclosed in envelopes resembling those made use of by the complainants, *Held*, that it was an infringement of the rights of the complainants, for which equity would give relief by a perpetual injunction. *Taylor* v. *Carpenter*, 3 Story, 459, 463.—STORY, J.; Mass., 1844.

5. Equity will decree a perpetual injunction to restrain the use of another's trade-marks, and will decree an account as to damages, with the costs of suit. *Coats* v. *Holbrook*, 2 Sand. Ch., 595, 596.—SANDFORD, V. Chan.; N. Y., 1845.

6. A commission merchant, who sells on commission an article which he knows to be an imitation, is liable to suit, and will be enjoined from a further sale of the imitated article, and will be subjected to the costs of suit. *Ibid.*, 597, 598.

7. A party has a right to call upon a court of equity to restrain a defendant from fraudulently using the words and devices which he has previously taken for the purpose of distinguishing his property. *Taylor* v. *Carpenter* (in Court of Errors), 2 Sand. Ch., 612.—BEARDSLEY, J.; N. Y., 1846.

8. In cases of doubt, whether the complainant's sign or trade-mark has been actually pirated in such a manner as to be likely to deceive and impose upon others, the court will not grant or sustain an injunction, until the cause is heard upon pleadings and proofs, or the complainant has established his right by an action at law. *Partridge* v. *Menck*, 2 Barb., Ch., 103.—WALWORTH, Chan.; N. Y., 1847.

9. But where the court see that the complainant's trade-marks are simulated in such a manner as probably to deceive his customers, or patrons of his trade or business, the piracy will be stopped at once by injunction. *Ibid.*, 103.

10. A court of equity in refusing to restrain the wrongdoer by injunction, would violate the principles upon which a large portion of its jurisdiction is founded. *Amoskeag Manuf. Co.* v. *Spear*, 2 Sand., S. C., 605.—DUER, J.; N. Y., 1849.

11. Equity will restrain a wrongdoer by injunction, on the grounds of protecting a party in the exercise of a legal right, the suppression of fraud, and preventing a mischief which otherwise might prove irreparable. *Ibid.*, 606.

12. An injunction to restrain the unauthorized use of a trade-mark should be granted with great caution, and is not to be exercised where the legal right is disputed and doubtful, or so as to create a monopoly unjust toward others or injurious to the public. *Ibid.*, 606.

13. An injunction ought to be granted whenever the design—whether apparent or proved—of a person who imitates a trade-mark, is to impose his own goods upon the public as those of the owner of the mark, and the imitation is such that the success of the design is a probable or even possible circumstance, and must be granted whenever the public is in fact misled, whether intentionally or otherwise, by the imitation. *Ibid.*, 609.

14. But an injunction need not necessarily be granted whenever there exists

such a resemblance between trade-marks as may induce a belief that they belong to and designate the goods of the same trader or manufacturer. The resemblance must amount to a false representation, express or implied, designed or accidental. *Ibid.*, 609.

15. A complainant cannot claim the protection of a court of equity to restrain a fraudulent use of his trade-mark, on the ground either of having an exclusive right as an inventor in the thing manufactured by him, or an exclusive right, as author, in his label. *Coffeen* v. *Brunton*, 4 McLean, 517.—McLean, J.; Ind., 1849.

16. But relief by way of injunction is granted because of the use of a mark or label, which recommends an article to the public to the injury of the complainant; the fraud arises from the false representation that the article is the same. *Ibid.*, 517.

17. An intentional fraud is not necessary to entitle a plaintiff to protection for a wrongful use of his trade-mark; but where the same mark or label is used which recommends the article to the public by the established reputation of another, who sells a similar article, and the spurious cannot be detected from the genuine one, an injunction will be granted, although there was no intentional fraud. *Ibid.*, 519.

18. The plaintiff was a manufacturer of steel pens, which were put up for sale in boxes, the labels on which, and the number they bore, indicated the quality of the pens. The defendant removed from the boxes containing inferior pens the label properly belonging on such boxes, and put upon them the label and number designating a better and higher priced article, and sold them as the superior article; *Held*, that such acts were a fraud upon the public and the plaintiff, and being a fraud coupled with damage, the court would restrain the defendant. *Gillott* v. *Kettle*, 3 Duer, 626, 627.—Bosworth, J.; N. Y., 1854.

19. The remedy by injunction is invariably granted when the nature of the injury is such that a preventive remedy is indispensable, and should be permanent. *Ibid.*, 627.

20. In such cases, if the injured party is obliged to seek redress by actions to recover damages, there will be no end to litigation, and certain and adequate relief would be unattainable. *Ibid.*, 627.

21. Courts of equity do not interfere by injunction in cases of violation of trade-marks, except in aid of a legal right; if the fact of the plaintiffs' right in a trade-mark, or the defendant's interference with it, be doubtful, the plaintiffs will be left to establish their title at law. *Merrimack Manuf. Co.* v. *Garner*, 4 E. D. Smith's Rep., 390.—Daly, J.; N. Y., 1855.

22. It may be that a party would not be permitted to manufacture and vend an inferior article, and put it forth to the public as of the same quality and kind as that of another; but whether he could be restrained by injunction is doubtful. *Ibid.*, 392.

23. Where the plaintiffs' trade-mark consisted of the words "Merrimack Prints, Fast Colors, Lowell, Mass.," enclosed in a floral wreath, and the defendants marked their goods "English Free Trade, Merrimack Style, warranted Fast Colors," and also enclosed in a floral wreath, but lighter and more open than in the other, *Held*, on a motion for an injunction, that though there was an undoubted resemblance between the

two, that the court could not say that the ordinary mass of purchasers would be deceived by the defendants' label, and that an injunction ought not to be granted in the first instance; but the parties should be left to try the question of actual imitation. *Ibid.*, 392, 393.

24. Where an injunction is asked to restrain a defendant from selling articles with a particular trade-mark, the right to use which is claimed by the plaintiff, it must appear that the defendant is seeking to sell the articles manufactured by *him* as those manufactured by the person who established the original trade-mark, and the plaintiff's right to use the trade-mark must be clear. *Samuel* v. *Berger*, 24 Barb., S. C., 164.—DAVIES, J.; N. Y., 1856.

25. An injunction is never to be granted in the first instance, if the exclusive title of the plaintiff is denied—unless upon grounds clearly frivolous—or if it is disputed. *Ibid.*, 165.

26. The plaintiff, a manufacturer of watches, claimed the right, as assignee, to stamp his watches with the name of one Iberson Brindle. The defendants sold watches manufactured by said Brindle himself, and stamped with his name, *Held*, that the plaintiff was not entitled to an injunction to restrain the defendants from selling the original article, and thus protect the plaintiffs in selling the simulated. *Ibid.*, 165.

27. Where the power of a court of equity has been invoked, it has been to restrain the defendant from making his goods and selling them as and for the goods manufactured by the plaintiff, on the ground that such a fraud was an injury to the plaintiff, and tending to mislead and deceive the public. *Ibid.*, 165.

28. It is well established that a court will grant an injunction against the use by one tradesman of the trade-mark of another; and such protection will be extended to enterprises undertaken for the purpose of affording amusement or recreation to the public. *Christy* v. *Murphy*, 12 How. Pr., 77, 78.—CLERKE, J.; N. Y., 1856.

29. The plaintiff organized a band of performers of negro minstrelsy, and named them, after himself, "Christy's Minstrels;" *Held*, that he was entitled to the exclusive use of that name, and that the assumption and use of that name by others without a license would be perpetually restrained by injunction. *Ibid.*, 78, 79.

30. A tradesman, to bring his privilege of using a particular mark under the protection of equity, is not bound to prove that it has been copied in every particular by another. It is enough for him to show that the representations employed bear such resemblance to his as to be calculated to mislead the public generally, who are purchasers of the article, and to make it pass with them for the article sold by him. *Walton* v. *Crawley*, 3 Blatchf., 447.—BETTS, J.; N. Y., 1856.

31. If the *indicia* or signs used tend to that result, the party aggrieved will be allowed an injunction, staying the aggression until the merits of the case can be ascertained. *Ibid.*, 447.

32. The mere affidavit of the defendant, without a formal answer, denying that the trade-mark claimed was the original device of the plaintiff's assignor, or was first adopted by him, it seems will not be sufficient to bar the equity of the plaintiff, arising from long undisturbed possession and use of such trade-mark, and particularly if such right had been corroborated by after acts and declarations of the defendants. *Ibid.*, 447.

33. The principles of the rules upon which injunctions are granted, to suppress violations of trade-marks, and the extent to which the relief is carried, are discussed and settled in 2 *Kent. Com.*, 2*d ed.*, 473 *and notes—Eden on Injunctions*, by Waterman, 271 and notes. 2 Story, Eq., 951. *Ibid.*, 448.

34. A label or trade-mark, which, from its general resemblance to that of the plaintiff, is calculated to mislead the public, by inducing the belief that the articles to which it is affixed are in reality prepared or manufactured by the plaintiff, and where the imitation is so close, minute, and exact, as to show that it was framed with such design, may, in a proper case, be restrained by injunction. *Fetridge* v. *Wells*, 13 How. Pr., 386, 387.—DUER, J.; N. Y., 1857.

35. A variation must be regarded as immaterial which it requires a close inspection to detect, and which can scarcely be said to diminish the effect of the *fac-simile* which the simulated label in all other respects is found to exhibit. *Ibid.*, 387.

36. But if a plaintiff comes into a court of equity to claim relief against the fraud of another, he must be free himself from the imputation. *Ibid.*, 389.

37. Where the plaintiffs were engaged in manufacturing and selling an article called the "Balm of a Thousand Flowers," and which they represented as "the very balm and extract of healing blossoms," but which in fact was only a liquid soap, and sought to restrain the defendants from doing the same thing, *Held*, that the name was intended to deceive the public, and that the plaintiff could not be protected in such a privilege, and that the court would not enjoin the defendant. *Ibid.*, 390–393.

38. It is well settled that where a party uses his trade-mark for the purpose of palming off upon the public articles of his own manufacture or composition for those of another, who has obtained celebrity or notoriety, the court will not protect him in such use. *Fetridge* v. *Merchant*, 4 Abb. Pr., 157. —HOFFMAN, J.; N. Y., 1857.

39. But the conduct of the person infringing such a trade-mark, has a materterial influence. If he has deliberately, without any previous connection with the particular business, but simply to break in upon the trade and profit by the notoriety obtained by another, adopted his emblems and appellations, the question should be judged of solely as between the immediate parties, and the public should be left to its own guardianship; when such is the case, an injunction should be granted to restrain the violation. *Ibid.*, 157.

40. Where the title of the plaintiff to appropriate a particular name to himself is not clear, but considerable doubt exists respecting it, an injunction should not be granted in the first instance; but the defendants may be required to execute a bond to keep and render an account of their sales. *Ibid.*, 161.

41. An imitation of a trade-mark, which will be enjoined against, embraces not merely names, but the manner of putting up the articles; and even including the wrappers and envelopes employed by the person entitled to the trade-mark. *Williams* v. *Johnson*, 2 Bosworth, 7.—WOODRUFF, J.; N. Y., 1857.

42. Whether the name given to an article can or cannot be made the subject of protection as a trade-mark, the court will enjoin and restrain the use thereof in combination with labels, handbills, or devices, in imitation of

those used by another, and calculated to deceive the public, or create the belief that the simulated article sold is that made or sold by those entitled to such labels and devices. *Ibid.*, 9.

43. An injunction will be granted, at the suit of a former partner, against the other partner, restraining the continued use of the signs containing the old firm name, without removing the name of the retiring partner, or making alteration or addition, as to give notice of the change in the firm. *Peterson* v. *Humphrey*, 4 Abb. Pr., 395.—MITCHELL, J.; N. Y., 1857.

44. The old signs would be holding out to the world that the old partnership was continued, and might make the retired partner as a continuing partner, if he sanctioned its continuance. *Ibid.*, 395.

45. A party will be restrained from using a trade-mark which had been previously used by another, and from any imitation of it with only colorable differences. *Clark* v. *Clark*, 25 Barb., S. C., 79.—MITCHELL, J.; N. Y., 1857.

46. Any false name that is assumed in imitation of a prior true name, is in violation of the right of the holders of the latter, and the use of it should be restrained by injunction. *Brooklyn W. L. Co.* v. *Masury*, 25 Barb., S. C., 418. —MITCHELL, J.; N. Y., 1857.

47. The plaintiffs were, and had been for more than twenty years, manufacturers of white lead, and marked their kegs "Brooklyn White Lead Company," or "Co." The defendants subsequently established the same business, and marked their kegs "Brooklyn White Lead and Zinc *Company*." *Held*, that this was an imitation of plaintiffs' mark, with only a colorable difference, and was adopted to make their paint pass as the plaintiffs'; and that the defendants should be restrained from using the words *Company* or *Co.*, but that they could continue to use the title "Brooklyn White Lead & Zinc." *Ibid.*, 418.

48. Where the defendants connected themselves with the plaintiffs in the business of manufacturing, advertising and selling pills by a particular name, "Dr. Morse's Indian Root Pills," and induced the plaintiffs to expend large sums of money in advertising, &c., such pills, and then, without notice, severed their connection with them, and set up the same business for themselves, *Held*, that such defendants would be restrained from using the same name or designation in selling such pills, as was used by the plaintiffs, and from using any labels or marks so much like those used by the plaintiffs, as to be likely to be easily mistaken for them. *Comstock* v. *Moore*, 18 How., Pr., 425, 426.—SUTHERLAND, J.; N. Y., 1860.

49. A court of equity will not interfere to protect a party in the use of trade-marks which are employed to deceive the public, and to deceive them by fraudulent representations contained in the labels and devices, which are claimed to constitute wholly or in part such trade-marks. *Hobbs* v. *Francais*, 19 How. Pr. Rep., 571.—BOSWORTH, J.; N. Y., 1860.

50. Where the plaintiff manufactured a skin powder called "Meen Fun," which was represented as made in London, and "Patronized by Her Majesty the Queen," when in fact it was made in New York; and the defendants manufactured a like article, representing it as "Patronized by Her Majesty the Empress," *Held*, that the court would not grant an injunction; not out of any

regard for the defendant, but not to assist in deceiving the public. *Ibid.*, 571.

51. Where the plaintiff sold to the defendant's assignor his lease of the premises known as "Howe's Bakery," together with the stock-in-trade, and the "good-will of the business of baking, now or heretofore carried on by me, in the city of New York." *Held*, that the plaintiff was entitled to an injunction to restrain the defendant from designating his bakery establishment as "Howe's Bakery," and from otherwise using the name of *Howe* in his business, so as to induce the public to believe that the business carried on by him was carried on by the plaintiff. *Howe* v. *Searing*, 19 How. Pr. 25.—HOFFMAN, J.; Sup. Ct., N. Y., 1860.

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## INSPECTION OF MACHINES.

1. On a bill filed for an infringement of a patent and for an injunction, if the defendants refuse to allow the plaintiffs to examine the machines used by them, the court will order an inspection of them as to whether they are an infringement upon the plaintiff's invention. *Sloat* v. *Patten*, 24 Jour. Fr. Inst., 3d Ser., 23.—KANE, J.; Pa., 1852.

2. In this case the court ordered the defendants to run their machines, in the presence of some expert, and that such expert be allowed to bring into court specimens of the work produced. *Ibid.*, 23.

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## INTENT.

A. PATENTABILITY OF..... 415

B. BEARING OF, AS TO ABANDONMENT, INFRINGEMENT, ETC..... 415

### A. PATENTABILITY OF.

See PURPOSE.

### B. BEARING OF, AS TO ABANDONMENT, INFRINGEMENT, ETC.

1. The intent with which a work is reprinted, cannot be taken into consideration, as the act of reprinting is prohibited by the statute. *Nichols* v. *Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

2. To constitute an infringement the making must be with an intent to infringe the patent-right, and deprive the owner of the lawful reward of his discovery. *Sawin* v. *Guild*, 1 Gall., 487. —STORY, J.; Mass., 1813.

3. No man is to be permitted to lie by for years, and then take out a patent. If he has been practising his invention with a view to improve it, that will not prejudice. But it should always be a question for the jury, what was the intent of the delay of the patent, and whether the allowing the invention to be used without a patent should not be considered an abandonment. *Morris* v. *Huntington*, 1 Paine, 354.—THOMPSON, J.; N. Y., 1824.

4. Though the inventor may not have intended to give the benefits of his discovery to the public, and may have supposed that by giving permission to a particular individual to manufacture the thing, he could not be presumed to have given his invention to the public, it matters not. It is not a question of intention, but of legal inference, resulting from the conduct of the inventor, and affecting the interests

of the public. *Pennock* v. *Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

5. The question of abandonment does not turn upon the intention of the inventor. Whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent, nor will a patent obtained under such circumstances protect his right. *Shaw* v. *Cooper*, 7 Pet., 323.—MCLEAN, J.; Sup. Ct., 1833.

6. Intention cannot be taken into view in reference to an infringement of a copyright; if a copyright has been invaded, whether the party knew it was copyrighted or not, he is liable to the penalty. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

7. The intent not to be guilty of piracy is not material, if much has been actually copied, and the new work is a mere substitute. But if this be doubtful, the intent not to pilfer from another, colorably or otherwise, for the substantial parts of the new work, may be important. *Webb* v. *Powers*, 2 Wood. & Minn., 524.—WOODBURY, J.; Mass., 1847.

8. The intention with which extracts from a work are made, has no bearing upon the question of violation. The inquiry is, what effect must the extracts have upon the original work. If they render it less valuable by superseding its use, in any degree, the right of the author is infringed; and it can be of no importance to know with what intent this was done. *Story's Exrs.* v. *Holcombe*, 4 McLean, 310.—MCLEAN, J.; Ohio, 1847.

9. 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 the infringer. *Parker* v. *Hulme*, 7 West. Law Jour., 426.—KANE, J.; Pa., 1849.

10. An intentional fraud is not necessary to entitle a plaintiff to protection for a wrongful use of his trade-mark. *Coffeen* v. *Brunton*, 4 McLean, 519.—MCLEAN, J.; Ind., 1849.

11. The intent not to injure in the infringement of a patent, as the making of a machine by a person ignorant of the existence of a patent, never exonerates from all damages for the actual injury or encroachment, though it may mitigate them. *Hogg* v. *Emerson*, 11 How., 608.—WOODBURY, J.; Sup. Ct., 1850.

12. The mere use or sale of the invention, however, within the two years, will not alone or of itself work an abandonment. The use or sale must be accompanied by some declarations or acts going to establish an intention on the part of the inventor to give to the public the benefit of the improvement. *Pitts* v. *Hall*, 2 Blatchf., 237.—NELSON, J.; N. Y., 1851.

13. The mere expression of an intention not to take out a patent, or the mere declaration of an intention to dedicate an invention to the public, cannot be regarded as equivalent to an actual dedication. *Ibid.*, 238.

14. The use by a defendant of a trademark belonging to the plaintiff, even without fraud, renders him liable; it matters not whether such use be by fraud or mistake. *Davis* v. *Kendall*, 2 Durffee, R. I., 570.—GREENE, Ch. J.; R. I., 1853.

15. If a machine is constructed so as to conform in *all* respects to the de-

scription in a patent, except as to one particular, or as to one motion and effect, yet is so constructed and *intended* as to obtain that motion or effect in the usage of the machine by the action or wearing of the parts, and it *is* so obtained, it is a violation of the patent, a piracy of the principle. If the *principle* is worth any thing, no mere evasion should be countenanced. Perfect identity is not required to demonstrate an infringement of principle. *Page* v. *Ferry*, 1 Fisher, 311.—WILKINS, J.; Mich., 1857.

16. The right of a plaintiff to maintain an action for a violation of a trade-mark does not depend upon the intention of the defendant to appropriate such trade-mark (violate it), it is enough if it is made to appear that he has done so. *Dale* v. *Smithson*, 12 Abb. Pr., 238.—HILTON, J.; N. Y., 1861.

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## INTERFERENCES ON APPLICATIONS FOR PATENTS.

**A.** WHEN ARISE, AND GENERAL NATURE OF..... 417
**B.** PRACTICE IN CASES OF, AND EVIDENCE IN..... 418

### A. WHEN ARISE, AND GENERAL NATURE OF.

See also, as bearing on this title, EQUIVALENTS; INVENTION, E.

1. A filed a description of an alleged invention in 1802, as required by § 3 of the act of 1793, and took no further step till 1814. In that year B made application for a patent for the same invention, without knowledge of A's invention; *Held*, that there was no limitation of time within which a patent must be taken out, after specification filed, and that the facts made a case of interference, to be arbitrated under § 9 of the act of 1793. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

2. The Commissioner has authority to permit one of two competing applicants for a patent for a similar invention, to withdraw his application, after decision upon an interference, and refile his application, and to declare a second interference between such last application and the competing one. *Wade* v. *Mathews*, 5 Opin., 224.—JOHNSON, Atty. Gen.; 1849.

3. The permission to withdraw an application in such a case, will be granted or not, as the Commissioner may be satisfied. The matter is in his discretion, to be exercised when in his opinion the spirit of the law demands it. *Ibid.*, 224.

4. The question of priority of right of invention necessarily implies *interference*. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

5. The interference mentioned in § 8 of the act of 1836 must be an interference in respect to patentable matters, and the claims of the applicants must be limited to the matters specifically set forth as their respective inventions; and what is not claimed, is to be considered, for the purpose of such interference, as disclaimed. *Ibid.*

6. A patentable improvement is not an interference. *Ibid.*

7. There can be no interference between applications, unless there is a substantial identity of the things for which a patent is sought. If there are *material* and *substantial* differences between the two things, there can be no identity, and no interference. *Tyson* v. *Rankin*, MS. (App. Cas.)—MORSELL, J.; 1853.

8. Where two separate applications for patents for improvements upon the same thing were generally similar in form, and in some respects nearly identical in construction, but the principal object and design of each was unlike that of the other, and the end to be attained or effect intended was wholly different, *Held*, notwithstanding their general similarity, that the two inventions were not substantially the same, and that there was no interference between them. *O'Rielly* v. *Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

9. An interference will lie between two applications, if the same invention is substantially described in the two applications or specifications, though the *claim* in one case may not be as broad as the specification. The oath as to invention is to be considered as extending to *all* described in the schedule. *King* v. *Gedney*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

10. An interference may be declared between a pending application and an application for a reissue of an existing patent, but the omission to do so at that time does not take away the right of the Patent Office to declare such an interference subsequently. *Hicks* v. *Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

11. An interference will be declared, between an existing patent, and an application for a *reissue*, as well as an *original* application. *Snowden* v. *Pearce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

## B. PRACTICE IN CASES OF.

As to depositions in cases of interference, see EVIDENCE, C. 2.

As to declarations of parties as to invention, see EVIDENCE, D. and E.

As to competency of witnesses, and of assignor of invention, see EVIDENCE, G.

1. The rule established by the Commissioner of Patents, under § 12 of the act of 1839, to be used in contested cases, are as binding upon the Commissioner as upon the contesting parties, and while they remain unabrogated, are as binding as the law itself, and the Commissioner cannot dispense with them at pleasure. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. There is nothing in the laws relating to the Patent Office, or in the rules adopted by the Commissioner, to prevent him from postponing the hearing of an interference, if, in his opinion the justice of the case should require it, and especially for the correcting of an irregularity in matters of form. *Smith* v. *Flickenger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

3. Where, therefore, depositions in an interference had been correctly taken, but had not been transmitted in the form required, so that they could be *considered*, by the Commissioner, *Held*, that the Commissioner had a right to postpone the hearing to allow the parties to cure the informality, if he should deem such action necessary to further the ends of justice. *Ibid.*

4. Affidavits on which to move for an enlargement of the time to take testimony in an interference, on the ground that the moving party could not obtain the attendance of his witnesses at the time appointed to take their examination, should state the names, competency, and materiality of the witnesses to be examined. *O'Reilly* v. *Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. Such an application is in the discretion of the Commissioner, and it will

be presumed that his decision on it has been soundly exercised. *Ibid.*

6. Where an interference has been declared between certain parties, and testimony taken, and then another application is made by another party and he is made a party to the interference, but the subject matter of all the applications is the same, the testimony taken on the first interference may be used on the second without being retaken. *Carter* v. *Carter*, MS. (App.) Cas.)—Morsell, J.; D. C., 1855.

7. In cases of interference it is not enough that the appellant shows that the opposite party is not entitled to a patent, but he must show that he himself has a right to it. *Lilly* v. *Kelsey*, MS. (App. Cas.)—Morsell, J.; D. C., 1858.

8. The proceedings in contested cases in the Patent Office, have no resemblance to trials at law—a party cannot be compelled to examine all his witnesses in chief before he closes his opening examination. *Spear* v. *Abbott*, MS. (App. Cas.)—Dunlop, J.; D. C., 1859.

9. It seems that testimony taken on a former interference is admissible on a second one, and this though the second interference is declared after an assignment to another party. *Eames* v. *Richards*, MS. (App. Cas.)—Merrick, J.; D. C., 1859.

10. A second interference is only a rehearing of the same case. *Ibid.*

11. After the closing the time for taking testimony in an interference, the Commissioner of Patents may admit another party to the interference, and open the further taking of testimony. *Laidley* v. *James*, MS. (App. Cas.)—Merrick, J.; D. C, 1860.

## INTRODUCER OF INVENTION.

1. The power of Congress under § 8 of the constitution in securing to authors and inventors the exclusive right to their respective writings and discoveries, is limited to authors and inventors only. Such 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 and inventors), for exclusive benefit of such inventions for a limited period; a power no less instrumental in promoting the progress of science and the useful arts. *Livingston & Fulton* v. *Van Ingen*, 9 John., 560, 566, 582.—Yates, Thompson, Kent, JJ.; N. Y., 1812.

2. This power is not granted to Congress by the clause as to authors and inventors, and as it is not taken away by any other part of the constitution, it must of course be retained by the respective states, to be exercised by them until it interferes with the laws of the United States, passed to secure the author and inventor. *Ibid.*, 561, 566, 582.

3. *Held*, therefore, that the acts of 1798, 1803, 1807, and 1808, granting to Livingston & Fulton *as possessors* of a mode of applying the steam engine to propel boats, the exclusive right to navigate the waters of the state of New York, were constitutional; and that they were entitled to an injunction against those infringing those rights. *Ibid.*, 562, 566.

4. There cannot be any aid or encouragement, by means of an exclusive right, under the laws of the United States, to importers from abroad of any useful invention or improvement. Such

persons must resort to the patronage of the state governments in which the power to reward their expensive and hazardous exertions was originally vested, and in which it still remains. *Ibid.*, 583.

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## INVENTION.

A. WHAT IS; WHEN PATENTABLE..... 420
B. PERFECTING, OR REDUCING TO PRACTICE 424
C. ORIGINALITY AND PRIORITY OF..... 429
D. NOVELTY AND UTILITY OF..... 429
E. IDENTITY OF..... 435

### A. WHAT IS; WHEN PATENTABLE.

See also, COLORABLE VARIATIONS; COMBINATION; COMPOSITION OF MATTER; DISCOVERY; DOUBLE USE; EFFECT; FORM; IMPROVEMENTS; INVENTOR, A.; MACHINES; MANUFACTURE, ARTICLE OF; MATERIAL; MECHANIC, SKILL OF; NEW APPLICATION; PATENT, D.; PRINCIPLE; PURPOSE; SUGGESTIONS.

As to evidence in respect to invention, see EVIDENCE, H. 4.

1. Whether the mere substitution of one material for another be an invention within the sense of the patent law, may well be questioned; but there being room for doubt, a patent was recommended. *Seely's Case*, 2 Opin., 52.—WIRT, Atty. Gen.; 1827.

2. A discovery of some new principle, theory, elementary truth, or an improvement upon it, abstracted from its application, is not a new invention. *Whitney* v. *Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

3. But when such discovery is applied to any practical purpose, in the new construction, operation, or effects of machinery, or composition of matter, producing a new substance, or an old one in a new way, by new machinery, or by a new combination of the parts of an old one, operating in a peculiar, better, cheaper, or quicker method, a new mechanical employment of principle already known, the organization of a machine embodied and reduced to practice on something visible, tangible, vendible, and capable of enjoyment; some new mode of practically employing human art and skill—it is a "discovery," "invention," or "improvement," within the acts of Congress. *Ibid.*, 311, 312.

4. A change in the position of the operating powers, or in the thing on which the effect is produced, is of no importance. Such a modification does not rise to the dignity of an invention. *Brooks* v. *Bicknell*, 3 McLean, 262.—McLEAN, J.; Ohio, 1843.

5. The substitution of a known mechanical equivalent, is not an invention within the patent law. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

6. The application of the endless screw and lever, which is a common mechanical power, to a machine to which it had never before been applied—as to the periphery of a quadrant to move and hold the rudder of a vessel—would not be an invention, although it might make the machine better. *Ibid.*

7. The substitution of one mechanical power for another, as a wheel and axle instead of a screw, is a mere formal alteration and not an invention. *Blanchard's Gun-Stock Turning Co.* v. *Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

8. The arranging a number of rollers,

acting in pairs, for a particular purpose, may be patentable, though a single pair could not be. *Knight* v. *Gavit*, Mir. Pat. Off., 132.—KANE, J.; Pa.; 1846. [Cited in *Parker* v. *Hulme*, 7 West. Law Jour., 422.]

9. In mechanics, inventions consist not in the discovery of new principles, but in new combinations of old ones. The principles of mechanics are few, simple, and well understood; their combinations are various and inexhaustible. Any new combination, which is of substantial advantage in the arts, comes within the policy and protection of the patent law. *Tyler* v. *Deval*, 1 Code Rep., 31.—MCCALEB, J.; La., 1848.

10. A duplication of parts (as the arrangement of wheels in pairs on a horizontal shaft, in a water-wheel, a single wheel having before been used), if it produce a new and useful result, is invention and may be the subject of a patent. *Parker* v. *Hulme*, 7 West. Law Jour., 421.—KANE, J.; Pa., 1849.

11. Perfecting an invention by superior skill in the mechanical arrangement and construction of the parts, is but the skill of the mechanic, not the genius of an inventor. *Parkhurst* v. *Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

12. Invention, as it respects machines, is any *new arrangement or combination* of machinery, whether of old or new parts or materials, producing in its arrangement and combination a useful result. *McCormick* v. *Seymour*, MS. —NELSON, J.; N. Y., 1851.

13. If the same general plan of a machine be taken and applied for the same purpose, although the mode of construction may be varied, it will be substantially the same; and is only what is called a mechanical equivalent, or another way of doing the same thing, by means of mechanical skill, which, however meritorious and creditable, is not an invention. *McCormick* v. *Seymour*, 2 Blatchf., 246, 248.—NELSON, J.; N. Y., 1851.

14. The doctrine of the use of mechanical equivalents is not confined to those elements which are strictly known as such in the science of mechanics. There are different well-known devices, any one of which may be adapted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another does not belong to the subject of invention, but of construction. *Foster* v. *Moore*, 1 Curt., 291.—CURTIS, J.; Mass., 1852.

15. There is a wide difference between the invention of a new method or process by which a known fabric, product, or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance, or manufacture, having qualities never found to exist together in any other material. *Goodyear* v. *The Railroads*, 2 Wall, Jr., 360.—GRIER, J.; N. J., 1853.

16. 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. *Ibid.*, 361.

17. The discovery that a refuse or worthless material can be advantageously applied to a new purpose, if that result is owing to the presence in such refuse material of certain ingredients or substances which had before been used, but in a different way, for the same purpose, is not a patentable invention. *Maule, Ex parte*, MS. (App. Cas.) —MORSELL, J; D. C., 1853.

18. It is a well settled principle of law that the mere change in the form of machinery (unless a particular form is specified as the means by which the effect described is produced), or an alteration in some of its unessential parts, or in the use of known equivalent powers, not varying essentially the machine, or its mode of operation or organization, will not make the machine a new invention. *O'Rielly* v. *Morse*, 15 How., 123.—TANEY, Ch. J.; Sup. Ct., 1853.

19. The substitution of one mechanical equivalent, as a rod in place of an endless chain, to accomplish a like purpose and with like effect, is not the subject of a patent. *Spain* v. *Gamble*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

20. Where the utility of a change, and the consequences resulting therefrom (in a machine) are such as to show that the inventive faculty has been exercised, though in point of fact the change was the result of accident, the requisite test of a sufficient amount of invention may exist. *Everson & Ricard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

21. Whether an invention is patentable 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 McAllis., 19.—MCALLISTER, J.; Cal., 1855.

22. If the invention required no more skill or ingenuity than that possessed by an ordinary mechanic skilled in the business, there is an absence of inventive faculty, and the patent is invalid. *Ibid.*, 52.

23. An accidental combination of parts, or invention, but under such circumstances that the public obtained no knowledge of the principle or result or effect of such combination, and the parties themselves who made it not understanding such principle, does not make invention. The invention is not made until the parties contriving, or those observing, discovered how it could be made available for its particular purpose. *Ransom* v. *Mayor, &c.*, 1 Fisher, 265.—HALL, J.; N. Y., 1856.

24. Before a patent can issue, the thing patented must appear to be of such a character as to involve or require "invention" for its production, require the exercise of the genius of an inventor as contradistinguished from the ordinary skill of a mechanic in construction. *Ibid.*, 258.

25. If, with the knowledge had by the public, it required no invention, but simply the ordinary skill and ingenuity of the mechanic to produce the result effected; in other words, if the inventive faculty was not put into action, and was not needed to produce the alleged invention, then the patent is void, because there is no invention to be secured to the patentees. *Ibid.*, 264.

26. 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. *Ibid.*, 265.

27. The right to an invention dates from the time of discovery, and the patentee is secure with his patent, if his machine or manufacture was not in public use at the time he made his application. *Wintermute* v. *Redington*, 1 Fisher, 244.—WILSON, J.; Ohio, 1856.

28. The mere discovery of a fact, as in Sickles' invention, deriving power for the tripping of the valve from the eccentric strap, or from any other moving part of the engine not controlled by the

lifting rod, does not constitute the subject of a patent, though the idea may be new. The new set of ideas, in order to become patentable, must be embodied into working machinery and adapted to practical use. *Sickles* v. *Borden*, 3 Blatchf., 538.—NELSON, J.; N. Y., 1856.

29. It is this embodiment and operation of machinery for practical purposes which furnish beneficial results to the public, and render the discovery patentable. *Ibid.*, 538.

30. It is not important whether an invention required much or little thought, study, or experiment to make it, or much or little expense to devise and execute it. If it is new and useful, it is not a legitimate subject of inquiry at what cost to the patentee it was made. *Forbush* v. *Cook*, 10 Mo. Law Rep., 667. —CURTIS, J.; Mass., 1857.

31. Whenever the change in the arrangement of a machine or invention, and its consequences taken together are considerable, there is sufficiency of invention to support a patent. When the change, *however minute*, leads to consequences and results of great practical utility, this condition is satisfied—but not when the *consequences* are inconsiderable, and the change also inconsiderable. *Walsh*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

32. The application of a certain combination and composition of ruled columns in sections to accounts, to show a constant balance thereof, with statements of assets and liabilities on every page of the journal without reference to the ledger, is not an invention of an art, machine, manufacture, or composition of matter, within § 6 of the act of 1836; it is nothing more than a mode of presenting the journal entries of a regular business in a tabular form, and therefore not patentable. *Dixon*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

33. The remedying of defects in a machine by practical men is the work of the mechanic, of the intelligent operator, and has no connection with invention or discovery. *Winans* v. *Danforth*, MS.—NELSON, J.; N. Y., 1860.

34. An experiment as to the production of a machine, which was unsatisfactory and had been abandoned, is not such an invention as entitles a person to the benefit of the patent laws, and such abandonment removes all impediment in the way of any future inventor who may follow in the same line. *Ibid.*

35. The enlargement of the organization of a machine, compared with a former one, does not afford any ground in the sense of the patent law for a patent. *Phillips* v. *Page*, 24 How., 167.—NELSON, J.; Sup. Ct., 1860.

36. The manner of folding and fastening the sides of an envelope to the back, or the back down to the sides, is not a patentable subject. There is no exercise of the inventive faculty—it is a mere matter of neatness and finish. *Arnold* v. *Potter*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

37. It is difficult to determine where ordinary mechanical skill ends, and invention begins. The best *practical principle* is, that where the combination of known elements produces new and useful results to the public, not before attained, then the person who discovers and applies the combination is an inventor, within the true intent and meaning of the patent laws. *Smith*, *Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

**B.** PERFECTING, OR REDUCING TO PRACTICE; WHAT IS; NECESSITY OF; DUE DILIGENCE IN.

1. The first inventor is entitled to the benefits of his invention if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent, oust the first inventor of his right, or maintain an action against him. *Woodcock* v. *Parker*, 1 Gall., 439.—STORY, J.; Mass., 1813.

2. Until an invention is perfected and adapted to use, it is not patentable. *Reed* v. *Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

3. 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 cannot be patentable under the patent laws. *Ibid.*, 599.

4. He is the first inventor in the sense of the patent act, 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. *Ibid.*, 599.

5. 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. *Ibid.*, 599, 600.

6. An inventor who has first actually perfected his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that which was, in fact, first invented by another, unless the latter was at the time using reasonable diligence in adapting and perfecting the same. *Ibid.*, 599.

7. None of the patent laws require that an invention should be in use, or reduced to actual practice before the issuing of a patent, otherwise than by a model, drawings, and specification, containing a written description of the invention, and how made and used. *Hildreth* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

8. The right of a patentee or applicant does not depend upon the fact of the invention being reduced to actual practice, except in the case of an alien patentee failing to put within eighteen months his invention on sale. *Ibid.*

9. The expression "reduced to practice" does not import bringing an invention into use, but means reducing it into such form that it may be used, so as not to be a mere theory. *Ibid.*

10. The doctrine that he who first communicates an invention to the public, and puts it in practice, *and he only*, is entitled to a patent, is not supported to its fullest extent by the cases, and does not apply to a first inventor who is using reasonable diligence in adapting and perfecting his invention, whose right is saved by § 15 of the act of 1836. *Ibid.*

11. Whoever first perfects a machine and makes it capable of useful operation is entitled to a patent, and is the real inventor, though others may have previously had the idea, and made some experiments toward putting it in practice. *Washburn* v. *Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

12. *Semble*, that he would be entitled to a patent, although the antecedent experiments of others were known to and used by him in perfecting his machine. *Ibid.*, 133.

13. Reducing an invention to practice differs from bringing it into use. There is no law requiring an applicant to reduce his invention to actual use before he can obtain a patent. On the other hand, the use of an invention before obtaining a patent is one of the reasons for refusing it. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

14. An inventor has reduced his invention to practice when he has so described it on paper, with such drawings and model as to enable any person *skilled in the art* to make and use it. *Ibid.*

15. He must show his invention to be practicable, and the manner in which it may be used, but he need not do this until his invention is perfected, and he is ready to apply for a patent. He may have conceived the idea years ago, but is not obliged to furnish drawings or model until he makes his application. *Ibid.*

16. Whoever finally perfects a machine, and renders it capable of useful operation, is entitled to a patent, though others may have had the idea and made experiments toward putting it into practice—and although all the component parts may have been known under a different combination, or used for a different purpose. *Ball* v. *Murry*, 10 Penn., 112.—ROGERS, J.; Sup. Ct., Pa., 1848.

17. It is not enough to conceive the idea of a new manufacture, or of a new and useful instrument. The new idea must be reduced to some practical use before it can become the subject of a patent, or be set up and relied on to defeat a patent. An abortive experiment is not sufficient. *Many* v. *Jagger*, 1 Blatchf., 383.—NELSON, J.; N. Y., 1848.

18. The idea or suggestion of an application of a principle to produce an effect, is not sufficient to entitle a party to a patent; but the one who first reduces the idea to practical application and use is entitled to a patent. *Foote* v. *Silsby*, 1 Blatchf., 464.—NELSON, J.; N. Y., 1849.

19. 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, cannot prevail against an original inventor, who has perfected his improvement and obtained a patent. *Parkhurst* v. *Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

20. The law allows an inventor a reasonable time to perfect his invention, and ascertain its utility before, in order to secure to himself its exclusive use, it obliges him to take out a patent. It is the duty of the jury to take into consideration the nature of the invention and the circumstances of the case. *Winans* v. *Schnec. & Troy R.R.*, 2 Blatchf., 291, 300.—NELSON, CONKLING, JJ.; N. Y., 1851.

21. In the case of an improvement in the construction of cars for railroads, *Held*, that such experiments could not be made except by putting the car into the service of lines of railroads, and that the use of cars, for such purpose, from 1831 to 1834 did not render the patent obtained in 1834 void. *Ibid.*, 291.

22. But if an inventor unnecessarily defers his application for a patent, and suffers his invention to go into use, except for such purposes and beyond what he has reason to believe necessary for such purposes, his patent is void. *Ibid.*, 291, 300.

23. In order to entitle a person to the character of an inventor, and his invention to become the subject of a patent, he must not stop at unsuccessful experiments, but continue until he has brought out a machine producing a useful result, and without this his invention will be worthless to the community, and undeserving the protection of the law. *McCormick* v. *Seymour*, MS.—NELSON, J.; N. Y., 1851.

24. 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., 299.—GRIER, J.; N. J., 1852.

25. Where an invention is not of a mere philosophical speculation, abstraction, or theory, but of something corporeal, to be manufactured, the applicant need not show that he has reduced it to practice, otherwise than by a description, and drawings, and a model, if the case admits of a drawing and models. *N. E. Screw Co.* v. *Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

26. The patent laws do not require that an invention should be reduced to actual practice before the issuing of the patent, otherwise than by a model, drawings, and specifications, so describing the invention that a skilful person could make and use it, and verified by the oath of the party. *Seeley*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

27. An imperfect and incomplete invention, resting in mere *theory*, or in *intellectual notion*, or in uncertain experiment, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not patentable under our laws. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

28. He is the first inventor in the sense of the patent acts, and entitled to a patent, who has first perfected and adapted the invention to use, and until the invention is so perfected and adapted to use, it is not patentable. *Ibid.*

29. But this position is subject to the qualification that he who *invents* first shall have the *prior* right, if he is using reasonable diligence in adapting and perfecting the same, although the *second inventor* has in fact *first perfected* the same and reduced it to practice in a positive form. *Ibid.*

30. Therefore if A first conceived an invention, and used reasonable diligence to perfect it, and did perfect it, though subsequent to B, A is entitled to a patent, even if B, a subsequent and original inventor, *first* perfected it, and reduced it to use. *Ibid.*

31. A long course of *mere fruitless* experiments to reduce a principle to practice, will not be sufficient to prevent a subsequent original inventor, who has perfected his invention, without knowledge of the prior invention, from receiving a patent. *McCormick* v. *Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

32. But where a prior inventor has been using due diligence to perfect his invention and adapt it to practical use, his right will be preserved and protected, although his success may not be perfect. *Ibid.*

33. A machine in order to anticipate any subsequent discovery must be per

fected, that is, made so as to be of practical utility, and not be merely experimental, and end in experiment. *Howe* v. *Underwood*, 1 Fisher, 166.—SPRAGUE, J.; Mass., 1854.

34. The making of a drawing of an invention sufficiently plain to enable a skilful person to make the thing from the drawing, is sufficiently reducing the invention to practice. *Stephenson* v. *Hoyt*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

35. An invention is complete when it is capable of successful operation. It is not necessary that the best mode or manner of carrying out or applying the principle should have been determined, or that the inventor should be aware of the full value of his invention. *Burrows* v. *Wetherill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

36. There is no express requirement in the statute that the applicant shall reduce his invention to actual use before he can obtain a patent. *Stephens* v. *Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

37. It is not the person who has only produced the idea, that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine, and reduced it to practice. He who has first done that, is the inventor who is entitled to protection. *Winans* v. *N. Y. & H. R. R.*, 31 Jour. Fr. Inst., 322.—NELSON, J.; N. Y., 1855.

38. Where two persons are both inventors of the same thing, the one who perfected his invention first, is protected by the law. *Allen* v. *Hunter*, 6 McLean, 322.—MCLEAN, J.; Ohio, 1855.

39. If an inventor does not use reasonable diligence to perfect his invention, after the idea of it is conceived, and in the mean time another conceives the idea, and perfects the invention, and practically applies it to use, the latter is the first and original inventor, and a patent granted to the former will be void, as not issued to the first inventor. *Ransom* v. *Mayor, &c.*, 1 Fisher, 272.—HALL, J.; N. Y., 1856.

40. Although an invention has not been reduced to actual practical use, yet if it appears to be capable of being so reduced, it will be sufficient (other things not opposing), to entitle a party to a patent. *Chandler* v. *Ladd*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

41. Although an inventor and patentee may not have reduced to practical use and operation his invention, before the time the same thing may have been invented by another, if at the time of such subsequent invention, the first inventor was using reasonable diligence (§ 15 of the act of 1836) in adapting and perfecting the same, and did afterward in a reasonable time adapt and perfect the same, such subsequent invention will not deprive him of the benefits secured by his patent. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

42. The person who is the first to conceive and give expression to the idea of an invention, in such clear and intelligible manner that a person skilled in the business could construct the thing, is entitled to a patent, provided he uses reasonable diligence in perfecting it. *Eames* v. *Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

43. By being *perfected*, in the eye of the law, it is not meant that an invention should be carried to a point where there could not be any subsequent improvement, but that it should 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 low degree—and has been completed so as to be of practical utility, then it may be said to be perfected in the eye of the law. *Johnson* v. *Root*, 1 Fisher, 366.—SPRAGUE, J.; Mass., 1858.

44. But it is not sufficient that some part incorporated into an invention should have been thus perfected, unless that part could be a machine, so as to be of some practical utility. It must be embodied and connected with a machine, which, as a whole, taking that part, must be of some practical utility, in order to prevent others coming afterward from having the benefit of an invention which embraces that. *Ib.*, 366.

45. To constitute a perfected machine, which will entitle a party to a patent, it is not necessary that he should have actually constructed the machine which is the subject of his invention. If having conceived a valuable idea, he has manifested it before the world in any form which evidences the completeness of the idea, and which is sufficient when communicated to others, to enable those skilful in the particular art to reproduce his invention, he has done enough to entitle himself to a patent, and this whether such evidence consists of written description, drawings, models, or a complete machine. *Farley* v. *Nat. Stm. Guage Co.*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

46. And it will make no difference that the inventor was not fully aware of the extent of the value of his invention. *Ibid.*

47. Though drawings of a machine or invention are made, from which machines could be constructed, or even if models are made such as may be capable of operation for the purpose of experiments, yet, unless a machine, which is capable of being used and operated as an actual working machine, is constructed, then as matter of law, such invention is not completed. *Cahoon* v. *Ring*, 1 Fisher, 408.—CLIFFORD, J.; Me., 1859.

48. The making of drawings of conceived ideas is not such an embodiment of such conceived ideas, into practical and useful form, as will defeat a patent which has been granted. *Ellithorpe* v. *Robertson*, 4 Blatchf., 309.—INGERSOLL, J.; N Y., 1859.

49. An invention is not patentable until it is perfected and adapted to use. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed position, and practical form, has a priority of right to a patent. *Ibid.*, 309–310.

50. Where A conceived the idea of an invention in 1847, and made a drawing thereof, but did nothing further toward reducing his invention to a practical and useful form, and made no application for a patent until 1858; and in the mean time B had invented the same thing, and had obtained a patent therefor in 1854, but not in fraud of A, *Held*, that such alleged prior invention of A would not defeat B's patent. *Ibid.*, 308–310.

51. Where an inventor describes his invention to a mechanic, and directs him to construct it, he is entitled to a reasonable time for making experiments in order to perfect his invention, and such description and experiments, if successful, will be considered as sufficient evidence of an assertion of his right at the time he made them, although a subsequent inventor may first perfect the invention and obtain a pat-

ent therefor; and such prior inventor will be entitled to a patent. *Dietz* v. *Burnham*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859; *Gibbs* v. *Johnson*. *Ibid.*, 1860.

52. Such descriptions may be oral, and need not necessarily be in writing, or accompanied by a drawing. *Ibid.*

53. The leading rule is that a person who is entitled to a patent and to be protected in his property, must not only conceive the idea of an invention, but must embody it in a machine or in some working arrangement, by which it may be shown that his new idea is adapted to practical and successful use. *Winans* v. *Danforth*, MS.—NELSON, J.; N. Y., 1860.

54. The party who first conceives the idea or conception of an invention is entitled to a patent, provided he pursues his idea or conception and reduces it to practice within a reasonable time, though another may have first actually reduced the invention to practice. *Bev. Rub. Co.* v. *Wing*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

55. The first inventor is entitled to a reasonable time, to be judged of according to the circumstances of the particular case, in which to perfect his invention, without impairing his claim to priority. If he is using reasonable diligence, he will not lose his right, though another first making a working invention. *Appletons* v. *Chambers*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

56. An inventor who first perfects an invention, and applies for and obtains a patent for it, will not be deprived of his right to such patent by a more tardy and negligent inventor, who may have first conceived the idea of the invention, but did nothing toward reducing it to practice, or applying for a patent for it. *Walker* v. *Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

57. Where A conceived the "idea" of an invention, but made no drawing of it for six or seven months, and in the mean time B had conceived the same invention, and had made a model of it, thus giving *physical form and shape* to his conception, *Held*, that B was to be considered as having first perfected his invention. *Ibid.*

58. If a person, after having the conception of an invention, is using due diligence to perfect it and reduce it to practice, he will still be deemed the first inventor, though another, who conceived the idea later, may have first perfected the idea by manufacturing the thing invented. *Hicks* v. *Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

## C. ORIGINALITY AND PRIORITY OF.

See also INVENTOR, B.; PRIOR KNOWLEDGE.

As to evidence in respect to originality, see EVIDENCE, H. 4.

## D. NOVELTY AND UTILITY OF.

As to evidence in respect to novelty and utility, see EVIDENCE, H. 5.

1. If the principles of a machine are new, either to produce a new or an old effect, the inventor is entitled to the exclusive right of the whole machine. *Whittemore* v. *Cutter*, 1 Gall., 480.—STORY, J.; Mass., 1813.

2. The intrinsic difficulty is to ascertain in complicated cases the exact boundaries between what was known and used before, and what is new in the *mode of* operation. *Ibid.*, 481.

3. The discovery must not only be useful but new, and must not have been known or used before in any part of the world. And the title of the patentee may be impeached by showing that he was not the first inventor, and this too whether the patentee was aware of such prior discovery or not. *Evans* v. *Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816. [Affirmed, *post* 8.]

4. If an invention, in the form in which it came from the inventor's hands, was so inferior to other machines as to deprive it of all intrinsic value, yet if another person can superadd to it something which will remove its defects and render it useful, it becomes valuable, because of its capacity to receive such improvements; and the inventor of such improvements has no right to avail himself of the original discovery on which to engraft his own. *Gray* v. *James*, Pet., C. C., 480.—WASHINGTON, J.; Pa., 1817. [But see *post* 21.]

5. The patent law requires an invention to be new and useful, but all that the law requires is that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. The word "useful" is used in contradistinction to mischievous or immoral. Whether the invention be more or less useful is a circumstance of no importance to the public. *Lowell* v. *Lewis*, 1 Mas., 186.—STORY, J.; Mass., 1817.

6. By useful invention is meant such a one as may be applied to some beneficial use in society, in contradistinction to an invention which is injurious to the morals, the health, or the good order of society. But it need not be of such general utility as to supersede all other inventions in practice to accomplish the same purpose. The law does not look to the degree of utility. *Bedford* v. *Hunt*, 1 Mas., 303.—STORY, J.; Mass., 1817.

7. An invention to entitle the inventor to a patent, must not only be useful, but it must also be new; it is a good defence in an action of infringement that the thing patented was not originally discovered by the patentee, but had been before discovered and put in actual use. *Ibid.*

8. If the thing patented had been in use, or described in a public work, anterior to the supposed discovery of the patentee, his patent is void; and this although the patentee had no knowledge of such previous use or previous description; the law supposes he may have known it. *Evans* v. *Eaton*, 3 Wheat., 514.—MARSHALL, Ch. J.; Sup. Ct., 1818.

9. In respect to the utility of an invention, the law only requires that an invention should not be frivolous or injurious to the well-being, good policy, and sound morals of society. The word *useful* in the act is used in contradistinction to mischievous or immoral. *Kneass* v. *Schuyl. Bank*, 4 Wash., 12.—WASHINGTON, J.; Pa., 1820.

10. An invention or improvement, for which a patent has been obtained, must be useful within the meaning of the patent law, or the patent will be void *Langdon* v. *De Groot*. 1 Paine, 204-206.—LIVINGSTON, J.; N. Y., 1822.

11. To what extent an invention must be useful to render it the subject of a patent, will depend upon 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. *Ibid.*, 204.

12. An invention for folding thread or

cotton in a more ornamental manner, by which the article would sell quicker, and at a higher price, but which made no change in the article, is not a useful invention within the patent laws, though beneficial to the patentee. *Ibid.*, 205.

13. The thing patented must be new and not before known or used; that is, the party must have found out, created, or constructed some art, machine, &c., or improvement on some art, machine, &c., which had not been previously found out, created or constructed by any other person. *Earle* v. *Sawyer*, 4 Mas., 6.—STORY, J.; Mass., 1825.

14. It is of no consequence whether the thing be simple or complicated, whether it be by accident or by long laborious thought, or by an instantaneous flash of mind, that it is first done. The law looks to the fact, and not to the process by which it is accomplished. *Ibid.*, 6.

15. An invention must be useful, that is, not noxious or mischievous, but capable of being applied to good purposes; and perhaps it may also be a just interpretation of the law, that it meant to exclude things absolutely frivolous and foolish. *Ibid.*, 6.

16. The question is, whether the thing has been known before. In case of a machine, whether it has been substantially constructed before; in case of an improvement of a machine, whether that improvement has ever been applied to such a machine before, or whether it is substantially a new combination. *Ibid.*, 6, 7.

17. The word "useful" in the patent law is well settled as being used in contradistinction to frivolous inventions or improvements, or such as are injurious to the public. *Whitney* v. *Emmett*, Baldwin, 309.—BALDWIN, J.; Pa., 1831.

18. The want of utility may be a good reason for not issuing a patent, but is no cause for avoiding it. *Ibid.*, 309.

19. The novelty of an invention is either the manufacture produced, or the manner of producing an old one; if the patent is for the former, it must be for something substantially new, different from what was known before; if the latter, the mode of operation must be different, not a mere change of the form and proportions. If both are the same in principle, structure, mode of operation, and produce the same result, they are not new, though there may be a variance in some small matter for the purpose of evasion, or as a color for a patent. *Ibid.*, 311.

20. The invention must be new as to all the world, not the abstract discovery, but the thing invented, not the secret principle, but the manufacture resulting from it. *Ibid.*, 311.

21. The ingenious reasoning of the learned judge in *Gray* v. *James*, Pet., C. C., 480, is not satisfactory. It is not evident how the owner of a thing which is worthless, and which has been thrown away as useless, can sustain any damage by the use of such thing made useful only by being combined with something else, or so changed in its operation by an invention to which the owner of the worthless thing had no claim or title. *Ibid.*, 328.

22. An invention, in order to be the subject of a patent, must be useful for some beneficial purpose, in contradistinction to *pernicious* or *injurious*. *Dickinson* v. *Hall*, 14 Pick., 220.—SHAW, Ch. J.; Mass., 1833.

23. Under the provisions of §§ 6 and 7 of the act of 1836, a patent is to be issued only to a person who has discov-

ered or invented some *new* and useful art, &c., or some new and useful improvement on an art, &c. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

24. As to the utility of an invention, the question is not whether the invention is useful beyond all others for effecting the objects for which it was designed, but whether it is capable in some degree of beneficial use, or would in some degree subserve the purpose of its design; or whether, on the contrary, it was merely mischievous and injurious, or pernicious, or frivolous and worthless. *Dunbar* v. *Marden*, 13 N. Hamp., 319.—WOODS, J.; N. H., 1842.

25. A machine or apparatus, or other mechanical contrivance, in order to give a party a claim to a patent therefor, must in itself be substantially new. If it is old, and applied only to a new purpose, that does not make it patentable. The machine must be new, not merely the purpose to which applied. *Bean* v. *Smallwood*, 2 Story, 411.—STORY, J.; Mass., 1843.

26. 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. *Ibid.*, 411.

27. It is not a new invention, if all the parts of a combination had been applied to a different object before, and they were now only applied to a new object. *Hovey* v. *Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

28. A combination which has any new mode of operation, is to be considered as new; to determine this, it is better to look at results than to the opinions of witnesses. If the results are different, it argues a substantial change in the mode of operation; the results could not be different if the means are the same. *Davoll* v. *Brown*, 3 West. Law Jour., 151.—WOODBURY, J.; Mass., 1845.

29. It is not necessary, to maintain a patent, or the right of the inventor, that the thing invented should be the very best article for the use to which it can be applied. If it is at all valuable, if its use for the purpose for which it is constructed is practicable, that is sufficient to sustain it as a useful invention. *Many* v. *Jagger*, 1 Blatchf., 381.—NELSON, J.; N. Y., 1848.

30. A novelty in principle may consist in a new and valuable mode of applying an old power; affecting it not merely by a new instrument or form of the machine, or any mere equivalent, but by something giving it a new or greater advantage. *Hovey* v. *Stevens*, 1 Wood. & Min., 297, 298.—WOODBURY, J.; Mass., 1846.

31. To be patentable, an invention must be useful. But in ascertaining the usefulness of an invention, it is not important that it should be more valuable than any 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, 566.—MCLEAN, J.; Mich., 1849.

32. The right of the inventor does not depend upon the question whether the machine is more or less perfect, or whether slight modifications in the arrangement of the machinery, or in the finishing of the parts composing it, may or may not better accomplish the end sought to be attained; but upon the question whether the machinery, con-

structed as described in the patent, will or will not accomplish the end practically and usefully in the way pointed out. *Parkhurst* v. *Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

33. An invention, to be patentable, must not only be one that can be reduced to practice, but must be one of some utility. But as to the utility of an invention, the question is not whether it is the best one known to the public, nor whether it does its work better or faster than any other machine in the same department of labor, but if it be to a certain degree useful, it is sufficient. *Wilbur* v. *Beecher*, 2 Blatchf., 137.—NELSON, J.; N. Y., 1850.

34. In deciding upon an application for a patent, the question is not whether the invention is more useful than others, but whether it is new and sufficiently useful to justify a patent. *Aiken, Ex parte* (Propellers), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

35. Under § 7 of the act of 1836, upon an examination of an application for a patent, if it appears that the matter for which the patent is claimed had not been invented or discovered by any person in this country prior to the invention or discovery by the applicant, or had not been patented or described in any printed publication, or had not been in public use, or on sale, with the consent and allowance of the applicant, it is *the duty* of the Commissioner to grant a patent, if in his opinion the thing is *sufficiently useful or important. Aikens, Ex parte* (Car Wheels), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

36. But the degree of usefulness or importance is not described or limited by the statute; nor is it material if the matter interferes with no prior right or claim, and is in itself innocent. If good may be the result of granting a patent, and evil cannot, it ought to be granted. *Ibid.*

37. Novelty and utility in an invention are all that the statute requires as a condition for granting a patent. It is not, therefore, a good objection to a patent that the arrangement and combination claimed was so simple and obvious as not to be subject of a patent. *Mc Cormick* v. *Seymour*, 2 Blatchf., 243, 244.—NELSON, J.; N. Y., 1851.

38. As to the question of novelty, the inquiry is, whether the alleged prior machines are identical with those of the plaintiff, or whether, he has made a different one, involving a new operation, and producing a new effect. *Ibid.*, 245.

39. Any degree of utility is sufficient to support a patent, the word *useful*, in the patent law being used in opposition to *frivolous or noxious;* it is not necessary that the thing invented should be the best of its kind—as that an improvement in the structure of railroad cars should render them entirely safe for passengers. *Winans* v. *Schenec. & Troy R. R.*, 2 Blatchf., 290, 291.—NELSON, CONKLING, JJ.; N. Y., 1851.

40. The degree of the utility of an invention is not a subject of consideration in determining whether an invention is patentable. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

41. A machine, in order to anticipate any subsequent discovery, must be perfected, that is, made so as to be of practical utility, and not be merely experimental, and end in experiment. 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. *Howe* v. *Underwood*, 1 Fisher, 166.—SPRAGUE, J.; Mass., 1854.

42. Where, in a patent for improvements in cooking stoves, the claim was "the placing the fire chamber in the middle of the oven, so that the latter may receive the heat on three sides at once;" but there was no peculiarity in the oven or fire chamber, and the invention appeared to be, that instead of forming three ovens or compartments around the fire chamber, as usual, the inventor removed the partitions behind the fire chambers, and made a single cooking space instead of three; *query*, Whether the change is a patentable discovery. *Wilson* v. *Jones*, 3 Blatchf., 229.—BETTS, J.; N. Y., 1854.

43. If a new and useful result is produced, 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. *Teese* v. *Phelps*, 1 McAllister, 50.—MCALLISTER, J.; Cal., 1855.

44. The patentees need not prove their 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 any other known methods; that renders the discovery useful, within the meaning of the patent laws. *Carr* v. *Rice*, 1 Fisher, 202.—BETTS, J.; N. Y., 1856.

45. The word "useful," in § 6 of the act of 1836, and as used in § 1 of the act of 1793, is not used for the purpose of establishing general utility as the test of a sufficiency of invention to support the patent. It is used merely in contradistinction to what is frivolous or mischievous to the public. It is sufficient if the invention has any utility. *Wintermute* v. *Redington*, 1 Fisher, 245.—WILSON, J.; Ohio, 1856.

46. The utility of an invention is an essential requisite to the validity of the patent. A useless invention, even if patented, is not and will not be of any profit to the public. But a general utility is not prescribed by the statute as the test of the sufficiency of the invention. The word is used in contradistinction to what is frivolous, or what is mischievous to the public. *Page* v. *Ferry*, 1 Fisher, 305.—WILKINS, J.; Mich., 1857.

47. An invention not obnoxious to these objections, whether more or less useful, if it be of *any* use, is embraced within the spirit of the law. A slight improvement of an old machine is a useful improvement. *Ibid.*, 305–6.

48. It is not necessary that the utility of an invention should be great, it is sufficient if the invention is an improvement at all. If it is of a different construction from former articles of the same kind, and of any use, that is sufficient. *Chandler* v. *Ladd*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

49. In the allowance of a patent the question of novelty should not be too rigorously questioned, but the benefit of any doubt should be given to the applicant, as if his application is rejected, and his invention have real patentable novelty, irremediable injury would be produced, but if a patent is allowed, the novelty can still be inquired into by a jury. *Cole, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1857.

50. It is no ground for the rejection of an application for a patent for a composition of matter, that the thing invented is an imitation of a real, existing substance, or material—as an artificial honey. If the artificial is a good and wholesome substitute for the real,

and can be made and supplied at a cheaper rate, there is no good reason why it should not be deemed a new and useful invention. *Corbin & Martlett, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

51. The degree of the utility of an invention, is not a matter of consideration. If it was useful at the time the patent was granted, the patent is valid. But if it has become useless since, by the discovery of some other thing, which dispenses with it, that gives no right to others to use it. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

52. It seems that where an alleged invention, upon received and well established principles, is in fact wholly incapable of answering, practically, the purpose for which intended, or claimed, that the Commissioner of Patents will be justified in refusing the application on the ground of want of utility. *Cushman*, S. D., *Ex parte*, MS. (App. Cas.) —MORSELL, J.; D. C., 1858.

53. An invention must be of some utility; a patent cannot be granted for a thing altogether frivolous, but the presumption on the face of the patent is that it is of some utility, for the applicant is obliged to swear that the invention is useful before the securation of the patent. *Coleman* v. *Liesor*, MS. —LEAVITT, J.; Ohio, 1859.

54. The statute makes utility essential to the validity of a patent, but whether it exists in a given case is to be decided by the jury upon the evidence subject to the decision of the court upon the law. *Vance* v. *Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

55. In regard to utility, it is well settled that 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 be useful in any degree, and not absolutely worthless, the patent will be sustained. *Ibid.*, 485.

56. The degree of utility in an invention is not important. If the invention is useful, though it does not require great inventive power, it will entitle the inventor to a patent. *Leach, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

57. If an invention be both new and useful, it cannot be impeached because it does not accomplish all that a sanguine inventor has claimed for it. *Eames* v. *Cook*, 2 Fisher, 151.—SPRAGUE, J.; Mass., 1860.

## E. IDENTITY OF.

See also COLORABLE VARIATIONS; EQUIVALENTS; FORM; INTERFERENCES.

1. If the same effects are produced by two machines, by the same mode of operation, the principles of each are the same. 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 Gall, 481.—STORY, J.; Mass., 1813.

2. The same elements of motion, and the same powers, must be employed in almost all machines. The material question therefore is not whether the same elements of motion, or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers in both machines. Mere colorable differences, or slight improvements, cannot shake the right of the original inventor. *Odiorne* v. *Winkley*, 2 Gall., 54.—STORY, J.; Mass., 1814.

3. What constitutes a difference in principle between two machines, is frequently a question of difficulty, more especially if the difference in form is considerable, and the machinery complicated. *Gray* v. *James*, Pet., C. C., 397.—WASHINGTON, J.; Pa., 1817.

4. As a general rule, where machines are substantially the same, and operate in the same manner, to produce the same result, they must in principle be the same; *substantially*, in order to exclude all formal differences; and by the same result is meant the same in kind, though it may differ in extent; the result is the same, if one machine produces more articles, as in machines for the manufacture of nails, in a given space of time than the other. *Ibid.*, 398.

5. In two machines for making nails, the one used a vice with two jaws, the lower one permanent and the upper one movable, and the two compressed by a lever of the first order, acting upon a toggle joint, connected with the moving jaw; the other also used a vice with two jaws, the upper one of which was fixed, and the two were compressed together by a lever of the second order, embracing the jaws with a friction roller fixed between the forks of the lever, and acting on an inclined surface of the moving jaw. But it was proved that the differences as to the lever and the friction roller were the necessary consequences of the machine being inverted. *Held*, that if their operation was the same, the difference in form did not amount to an invention. *Ibid.*, 398.

6. If two machines be substantially the same, and operate in the same manner, to produce the same result—though they may differ in form, proportions, and utility, they are the same in principle; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted to any one; because he cannot be considered as the original inventor of the machine. *Evans* v. *Eaton*, 3 Wash., 449.—WASHINGTON, J.; Pa., 1818.

7. The opinion of skilful persons is allowable in a patent case, as to whether the principles of two machines are the same. But care should be taken to distinguish what is meant by a principle, the true legal meaning of which is the peculiar structure or constituent parts of a machine. *Barrett* v. *Hall*, 1 Mas., 470.—STORY, J.; Mass., 1818.

8. The principles of two machines may be the same, although the form or proportion may be different. They may substantially employ the same power in the same way, though the external mechanism be different. On the other hand, the principles of two machines may be very different, although their external structure may have great similarity in many respects. *Ibid.*, 471.

9. The jury are to judge, by an inspection of the models, and from the evidence, whether two machines differ in principle. *Smith* v. *Pearce*, 2 McLean, 179.—MCLEAN, J.; Ohio, 1840.

10. If the principle on which the machinery works is the same, and the effect is similar in both, in contemplation of law the machines are identical. *Brooks* v. *Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

11. There must be an essential difference in the application of the mechanical power, to make the machines dissimilar. *Ibid.*, 262.

12. Science alone is able to answer the question, whether or not a particu-

lar machine is substantially in its mode of operation new, or identical with another, although with apparent differences of form and structure, which might mislead the unscientific mind. *Allen* v. *Blunt*, 3 Story, 748.—STORY, J.; Mass.; 1845.

13. The very highest witnesses to ascertain and verify the novelty of an invention, and the identity or diversity of mechanical apparatus and contrivances, and equivalents, are, beyond all question, all other circumstances being equal, scientific mechanics. *Ibid.*, 740.

14. It is the province of the jury to determine whether there is a substantial variation or difference between the machine used by the defendants, and that of the plaintiffs, or whether the difference is a mere formal alteration. *Blanch Gun-Stock Manuf. Co.* v. *Warner*, 1 Blatchf., 278, 279.—NELSON, J.; Ct., 1846.

15. The question of identity or difference of two articles—railroad car wheels—is, whether there is a substantial difference between the two in their mechanical structure, and whether the defendant's involved any thing which required mind and ingenuity over and beyond that of the plaintiff. The question of identity is one of fact. *Many* v. *Jagger*, 1 Blatchf., 386.—NELSON, J.; N. Y., 1848.

16. A change of form will not be sufficient, unless *form* is a part of the thing invented, and is essential to its value. There must be a substantial difference, and the one claimed to be different must embody a different principle from the other. *Ibid.*, 386.

17. It does not constitute an identity of invention between two machines, or make one an encroachment on the other, that their general object is the same. *Smith* v. *Downing*, 1 Fisher, 84.—WOODBURY, J.; Mass., 1850.

18. In cases of reissue, the action of the Commissioner has more than *prima facie* influence in finally deciding the question of identity of invention. *French* v. *Rogers*, 1 Fisher, 130.—GRIER, KANE, JJ.; Pa., 1851.

19. In examining questions of identity or infringement, it is to be first ascertained wherein consists the substantial peculiarity which distinguishes the art or invention patented. Whoever adopts or appropriates such distinctive peculiarity or principle without license of the patentee, appropriates the invention, and infringes the patent, if the specification be correctly drawn. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

20. In examining a machine, to ascertain whether or not it is an infringement of another, the similarity or dissimilarity of the mechanical construction is not necessarily conclusive or controlling. *Blanchard* v. *Beers*, 2 Blatchf., 416, 418.—NELSON, J.; Ct., 1852.

21. Its structure may be apparently very similar in form, and yet its principle, operation, and result may be very different. So on the other hand, its structure and appearance may be very different to the eye, and in point of fact, and yet it may in reality and in principle be the same as the previous machine. *Ibid.*, 416.

22. The mere mechanical construction and form of a machine are not, therefore, always a test of its identity or want of identity with another. The principle embodied in a machine, and which gives it all its utility, may be put in successful operation by different mechanical contrivances, depending more on the skill of the mechanic than the

genius of the inventor. It is unsafe to rely upon the mere difference in the mechanical construction. *Ibid.*, 416.

23. The sure test, and the one the jury should be guided by in all cases, is whether or not the defendant's machine (whatever may be its form or mechanical construction), has incorporated within it the principle or the combination, or the novel ideas which constitute the improvement to be found in the plaintiff's machine. If it does, then, no matter what may be its mechanical construction, or its form, it is an infringement. *Ibid.*, 416.

24. No person can appropriate the benefit of the new ideas which another has originated and put into practical use, because he may have been enabled by superior mechanical skill to embody them in a form different in appearance, or different in reality. Although he may not have preserved the exterior appearance of the previous machine, he may have appropriated the ideas which give to it all its value. *Ibid.*, 418.

25. The questions of identity between two opposing machines are frequently exceedingly difficult, and often the most difficult questions involved in patent cases. They are ultimately questions of fact for the jury to determine. *Tatham* v. *Le Roy*, 2 Blatchf., 485.—Nelson, N. Y., 1852.

26. A change in form or proportions from the construction of an existing machine, is not a substantial change in the eye of the patent law. So also the substitution of a mechanical equivalent in the construction of a machine is not a substantial change. Formal and mechanical changes are nothing. *Ibid.*, 485, 486.

27. Any machine may be very considerably changed in its mechanical arrangement and construction, the description of it may be very much departed from in the construction, and yet it may accomplish the object and purpose for which it was designed. *Ibid.*, 487.

28. A difference in the mechanical arrangement and construction of two machines is not necessarily a test by which to determine that they are not identical. They may be apparently different externally, and still embrace the same substantial identity in principle and mode of operation. So, on the other hand, the converse of the proposition is equally true. They may be very similar externally, and still in principle and mode of operation be very different. *Ibid.*, 488.

29. The question is, 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. *Ibid.*, 488.

30. Where a change from a patented machine produces an effect different in kind and highly beneficial, such effect reflects back upon the mechanical arrangement and construction, and may authorize an inference of a substantial change, which the arrangement, disconnected from the new and different effect, would not; and when, without connecting the new effect with the change, the change might be only formal and unsubstantial. *Ibid.*, 1852.

31. Such new effect, however, to give materiality and importance to the apparently formal change, must not consist in doing more work in a given time,

or with a reduced amount of power, but the new effect must be different in kind. *Ibid.*, 492.

32. The mere fact that a machine, constructed and arranged apparently or externally like a previous one, produces a result more beneficial, does not determine that the two are substantially different. The new result must be one derived from a different mechanical operation and effect. *Ibid.*, 493.

33. The jury are to determine whether two machines are identical, or are constructed and act upon different principles. *Battin* v. *Taggart*, 17 How., 85.—McLean, J.; Sup. Ct., 1854.

34. The identity that is to be looked to, in an action of infringement, 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 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. *Wintermute* v. *Redington*, 1 Fisher, 251.—Wilson, J.; Ohio, 1856.

35. But if the defendant has adopted variations which show that the application of the principle is varied, that some other law or rule of practice or science is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement. *Ibid.*, 251.

36. The question of identity is one of fact to be determined by the jury upon the evidence, under the instructions of the court, as to what in law constitutes a substantial identity. *Smith* v. *Higgins*, MS.—Betts, J.; N. Y., 1857.

37. One machine need not be a perfect transcript of the other, nor correspond exactly in arrangements, manner of action, or results. But a patentee is protected against any use of his invention by the employment of means apparently dissimilar to his own, if they possess the same functions, are employed for the same purpose, and embody a common principle. *Ibid.*

38. A change in the forms or proportions of instrumentalities—a substitution of one motive power for another—a different position or gearing of the working apparatus—a superior finish in any other particular, resting in mere mechanical skill or taste, and not involving invention—does not render machines, appearing to the eye exceedingly unlike, substantially different in judgment of law. *Ibid.*

39. Nor is the substantial identity of two machines established by proof that they bring out the same products, and use the same mechanical powers, and have other resemblances. But, in such case the evidence must show that the two are of the same nature and character, and constructed and operated upon a common principle, and to the same purpose. *Ibid.*

40. "Substantial identity" excludes immaterial variations or fraudulent evasions. 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 of a variety of forms, there is an identity of principle, though not an identity of mode. *Page* v. *Ferry*, 1 Fisher, 310.—Wilkins, J.; Mich., 1857.

41. The same principle may be used without an exact identity by mechanical equivalents or contrivances; and if so, there would be a substantial identity, or such an arrangement of mechanism

which produces the same service, or produces the same effect in the same way, or *substantially* the same way. As a question of fact, it sufficeth if the principle has been violated. *Ibid.*, 311.

42. As to the question of identity, models are not a living, but a sure and true witness—dumb, but yet, like Balaam's beast, speaking eloquently, as you may interpret the language they employ. To each part a voice potential is given. *Ibid.*, 313.

43. Where, in two devices, the end to be accomplished is the same, and the substantial means to accomplish the end are the same, the two devices are identical, though one may accomplish the end more effectually than the other. *Imlay* v. *Nor. & Wor. R. R.*, 4 Blatchf., 237.—INGERSOLL, J.; Ct., 1858.

44. On the subject of the identity of two machines, we are not concluded by their mere form or appearance; the question is, are they the same in substance? Is the machine used by the defendant a mechanical equivalent for that patented by the plaintiff? *Morris* v. *Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858.

45. Any machine got up by the patentee, or those claiming under him, whose construction, arrangement, principles, and mode of operation, are substantially the same as the one described in the specification, though differing in size and proportions, is as much within the protection of the patent as the structure therein described. *Cahoon* v. *Ring*, 1 Fisher, 411.—CLIFFORD, J.; Me., 1859.

46. In determining questions of infringement, the jury are not to judge about similarities or differences, by the names of things; but are to look to the machines, or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it; and to find that a 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 that things are substantially different when they perform different duties, or in a different way, or produce a different result. *Ibid.*, 419.

47. For the same reason they are not to judge about similarities or differences, merely because things are apparently the same, or 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 they are to look at the mode of operation, or the way the parts work, and at the result, as well as the means by which the result is attained. *Ibid.*, 419.

48. Although two machines may be similar in appearance and arrangement, if the conditions under which they are to act are not alike—if the same service is not to be performed—if their *purpose* is different, and there is no identity of object or effect, they are not identical. *Emery, Ex parte*, MS. (App. Cas.)—MORSELL, J., D. C., 1859.

49. On the question of identity the law regards substance and not form, and the real question is whether the machine used by the defendants is in *principle* the same as that patented to the plaintiff. *Latta* v. *Shawk*, 1 Fisher, 470.—LEAVITT, J.; Ohio, 1859.

50. The identity of machines does not depend upon form or proportion, so much as upon the principle of action, and the operation of the two things. *Judson* v. *Moore*, 1 Fisher, 557.—LEAVITT, J.; Ohio, 1860.

51. As to identity it is not a question as to the precise form or size of two

machines; the point is whether the principle of the two things is the same. The patentee is protected against any other device which involves substantially the same principle. *Lee* v. *Blandy*, 2 Fisher, 94.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

52. But if another party produces the same result by means different in principle and operation, there is no infringement, for it would be absurd to say that the granting of a patent covers all possible ways of producing the same result. *Ibid.*, 94.

53. If the jury find a substantial identity, the defendants cannot say that the machine they use is of no utility, as the mere fact that they have appropriated it is evidence that they regarded it as of utility. *Ibid.*, 95.

54. The object and purpose of two inventions may be taken into consideration in determining the question of identity between them. Where their object and purpose are entirely different, and material advantages result from one invention, it is patentable, though it has some resemblances to a former one. *Barstow, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

55. The purpose or object had in view by an invention may be considered in determining the question whether it is identical with another. *Hoyt, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C. 1860.

56. In determining the question of identity, the jury are not to inquire whether the two things are identical in structure, form, or dimensions, but whether they involve substantially the same principles. *Judson* v. *Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

57. In determining whether the mechanism of one machine is the same as that of another, we may not only look at the mechanism itself, that is, the devices and the arrangement of them, but also at their mode of operation, and their effects or results. *Eames* v. *Cook*, 2 Fisher, 148.—SPRAGUE, J.; Mass., 1860.

58. If the mode of operation be different, it is evidence that the mechanism is different. If the result be different, reasoning from effects to causes, we may presume that some new instrumentality has been introduced, although the mechanism may apparently be substantially the same. *Ibid.*, 149.

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## INVENTOR.

**A.** WHO IS; AND RIGHTS OF, AS SUCH... 441
**B.** FIRST AND ORIGINAL; SUBSEQUENT: RIGHTS OF..... ..... 444

### A. WHO IS; AND RIGHTS OF, AS SUCH.

1. The constitution and the law together give to the inventor, from the moment of discovery, 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, and no right can be acquired in it, without the consent of the inventor. *Evans* v. *Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

2. Whenever then any person, previous to a patent, constructs a machine discovered by another, he constructs it subject to the right of that other. His right to use it is qualified by the paramount right of the inventor to prescribe the conditions on which he shall use it. *Ibid.*, 252.

3. The right secured to the inventor, is founded on considerations of public policy, and is not to be destroyed by open infraction, or mere colorable im-

provements. *Smith* v. *Pearce*, 2 McLean, 178.—McLean, J.; Ohio, 1840.

4. Whoever first perfects a machine and makes it capable of useful operation, is entitled to a patent, and is the real inventor, though others may have previously had the idea and made some experiments toward putting it into practice. *Semble*, that he would be entitled to a patent, although the antecedent experiments of others were known to and used by him in perfecting his machine. *Washburn* v. *Gould*, 3 Story, 133.—Story, J.; Mass., 1844.

5. At any rate, he is the inventor, and is entitled to a patent, who first brought the machine to perfection, and made it capable of useful operation. *Ibid.*, 133.

6. If a combination, the effect of which had been ascertained by A, is reduced to practice by a machine built by B, but at the request or by the order, and at the expense of B, it is in fact A and not B who reduced the combination or invention to practice. *Warner* v. *Goodyear*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1846.

7. To constitute an inventor, it is not necessary he should have the manual skill and dexterity to make the drafts of his invention. If the ideas are furnished by him for producing the result aimed at, he is entitled to avail himself of the mechanical skill of others to carry out practically his contrivance. *Sparkman* v. *Higgins*, 1 Blatchf., 209.—Betts, J.; N. Y., 1846.

8. Where the plaintiffs devised designs for oilcloths, which were carried out by another, *Held*, that the plaintiffs, and not the pattern-maker, were the inventors. *Ibid.*, 209.

9. If a person *construct* a machine, in the absence of all evidence to the contrary, the presumption is, that he is also the *inventor*, and the burden of proof is thrown upon another claiming to be the inventor, to show that he suggested the idea, or made the invention. *Atkinson* v. *Boardman*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1847.

10. He who first discovers that a law of nature can be applied to produce a particular result, and having devised machinery to make it operative, introduces it to the knowledge of his fellow men, is a discoverer and inventor of the highest grade; and this title as a discoverer he may assert and secure by letters patent, 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*, 7 West. Law Jour., 423.—Kane, J.; Pa., 1849.

11. This is not to patent an abstraction, but is to patent the invention as the inventor has given it to the world, and to secure to the inventor the exclusive right to the discovery he imparted to the public. *Ibid.*, 423.

12. The right of an inventor does not depend upon the question whether the machine is more or less perfect, or whether slight modifications in the arrangement of the machinery, or in the finishing 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 granted by the government; and any one using the principle thus embodied is guilty of an infringement, however he may have perfected the ma-

chinery 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. *Parkhurst* v. *Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

13. In order to entitle a person to the character of an inventor, he must not stop at unsuccessful experiments, but continue until he has brought out a machine producing a useful result. *McCormick* v. *Seymour*, MS.—NELSON, J.; N. Y., 1851.

14. A person to be entitled to the character of an inventor, must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius, and not of another. *Pitts* v. *Hall*, 2 Blatchf., 234. —NELSON, J.; N. Y., 1851.

15. But in order to invalidate a patent on the ground that the patentee did not conceive the idea embodied in the improvement, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement. In other words, the suggestions must have been sufficient to enable him to construct a complete and perfect machine. *Ibid.*, 234.

16. If they simply aided him in arriving at the useful result, and if, after all the suggestions, there was something left for him to devise and work out by his own skill and ingenuity, then he is, in contemplation of law, to be regarded as the first and original discoverer. *Ibid.*, 234.

17. On the contrary, if the suggestions and communications of another go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another. *Ibid.*, 234.

18. *Semble*, that improvements made by workmen, working under the pay of an inventor, and making experiments under his direction, are to be considered for the credit and benefit of such inventor. *Goodyear* v. *Day*, MS.—DICKERSON, J.; N. J., 1852.

19. 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 experiment—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., 299.—GRIER, J.; N. J., 1852.

20. Where a person is engaged in producing some new and useful instrument or contrivance, and has embodied it into a machine and endeavored to reduce it to practice by experiment—if those trials fail—if he fail in success and abandon it, and give it up, that consideration affords no impediment to another person who has taken up the same idea or class of ideas, and who has gone on perseveringly in his studies, trials, and experiments, until he has perfected the new idea and brought it into practical and useful operation. He is the person—the meritorious inventor—who is entitled to the protection of the law. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d. Ser., 322.—NELSON, J.; N. Y., 1855.

21. If a person having some vague idea of a principle make numerous trials and experiments, if those trials and

experiments do not result in such a knowledge upon his part as enables him to put in successful practice the idea of which he has such vague notion, he does not become an inventor in the sense of the patent law. *Ransom* v. *Mayor, &c.*, 1 Fisher, 270.—HALL, J.; N. Y., 1856.

22. Such a person 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. *Ibid.*, 270–271.

23. If a person conceives the result embraced in the invention, or the general idea of a machine upon a particular principle, and in order to carry his conception into effect, it is necessary to employ manual dexterity, or even inventive skill in the mechanical details and arrangements requisite for carrying out the original conception, in such cases, the first person will be the inventor, and the other the mere instrument through which be realizes the idea. *Wellman* v. *Blood*; *King* v. *Gedney*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

24. In order to constitute a man an inventor, it is *generally* necessary that he must have exercised some inventive faculty or exertion of his own, though there may be cases in which an invention may be the result of pure accident. *Mathews* v. *Skates*, 1 Fisher, 607.—JONES, J.; Ala., 1860.

25. But the fact that an inventor may have received some ideas, hints or suggestions on the subject from others, will not prevent him from being considered an inventor, and entitled to a patent as such. To have that effect it must appear that the invention was substantially communicated to him by some other person, so that without the exercise of any inventive power of his own he could have applied it to practice. *Ibid.*, 607.

26. Though others may have had similar ideas, and may have experimented upon them, the person who first perfected the idea and made it capable of practical use, is the inventor and entitled to a patent. *Ibid.*, 607.

## B. FIRST AND ORIGINAL; SUBSEQUENT; RIGHTS OF.

1. The right to a patent belongs to him who is the first inventor, even before a patent is granted. *Evans* v. *Weiss*, 2 Wash., 345.—WASHINGTON, J.; Pa., 1809.

2. If an inventor suffer his invention to be used by the public, his patent will not be protected on the ground that he was the first inventor. *Whittemore* v. *Cutter*, 1 Gall., 482.—STORY, J.; Mass., 1813.

3. The first inventor is entitled to the benefit of his invention, if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent, oust the first inventor of his right, or maintain an action against him. *Woodcock* v. *Parker*, 1 Gall., 439.—STORY, J.; Mass., 1813.

4. The original inventor of a machine is exclusively entitled to a patent for it. *Odiorne* v. *Winkley*, 2 Gall., 53.—STORY, J.; Mass., 1814.

5. The first inventor is entitled exclusively to a patent-right, though a subsequent person may have also been an original inventor. The law gives the right, as among inventors, to him who is first in point of time. *Lowell* v. *Lewis*, 1 Mas., 190.—STORY, J.; Mass., 1817.

6. The first inventor who has put the invention in practice, and he only, is en-

.itled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent-right upon proof of such prior invention being put in use. The law adopts the maxim, *Qui prior est in tempore, potior est in jure*. *Bedford* v. *Hunt*, 1 Mas., 304. STORY, J.; Mass., 1817. (But see *post* 24, 25.)

7. To entitle a person to obtain a patent as a first inventor, it is not necessary for him to establish that he has put his invention into general use, or that he has made it generally known to artisans engaged in the same business. *Ibid.*, 305.

8. The intent of the statute, declaring it to be a good defence to an action for an infringement of a patent-right, that the thing secured by the patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, was to guard against defeating patents by the setting up of a prior invention, which had never been reduced to practice. *Ibid.*, 304, 305.

9. If such prior invention was the mere speculation of a philosopher, a mechanician, which had never been tried by the test of experience, and never put in actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents in putting it into practice, of the rewards due to his ingenuity and enterprise. *Ibid.*, 305.

10. But if a first inventor reduced his theory to practice, and put his machine or other invention into use, the greater or less use of it, or the more or less widely the knowledge of it might circulate, does not constitute a criterion by which to decide upon the validity of any subsequent patent for the same invention. *Ibid.*, 305.

11. It is clearly immaterial whether experiments as to an invention are made by the inventor himself or by others; the question being, who is the original inventor? *Pennock* v. *Dialogue*, 4 Wash., 542.—WASHINGTON, J.; Pa., 1825.

12. Construing § 1 by § 6 of the act of 1793, the true meaning is, that 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 Mas., 111.—STORY, J.; Mass., 1825; *Treadwell* v. *Bladen*, 4 Wash., 708.—WASHINGTON, J.; Pa., 1827.

13. Under the language of § 6 of the patent law of 1793, a patentee can sustain his patent only on the ground of his being the original inventor. *Thomas* v. *Weeks*, 2 Paine, 99.—THOMPSON, J.; N. Y., 1827.

14. From an examination of the various provisions of the patent law, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest an exclusive right in the inventor only, on condition that his invention was not known or used by the public. *Shaw* v. *Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

15. Under our patent laws, 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. *Reed* v. *Cutter*, 1 Story, 596, 598.—STORY, J.; Mass., 1841.

16. A subsequent inventor, though an original inventor, is not entitled to

any patent, and no subsequent inventor has a right to deprive an original inventor of the right to use his own prior invention. *Ibid.*, 596, 597.

17. And 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 the knowledge and use thereof limited to a few persons, or even to the first inventor himself. *Ibid.*, 596, 598.

18. The decision in *Dolland's case*, (2 H. Black. R., 487), that he was entitled to a patent, as an inventor of the thing patented, though there was a prior invention thereof by another who kept it secret so that the public had no benefit thereof, though perhaps a correct exposition of the statute of monopolies, is not applicable to the patent laws of the United States. *Ibid.*, 598.

19. He is the first inventor in the sense of the patent law, 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. *Ibid.*, 599.

20. In the race of diligence between two independent inventors, he who first reduces his invention to a fixed position and practical form, would seem to be entitled to a priority of right to a patent therefor. *Ibid.*, 599, 600.

21. But this right is qualified by § 15 of the act of 1836, which provides that in such cases the first inventor shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has in fact first perfected the same and reduced the same to practice in a positive form. *Ibid.*, 600.

22. The right of the first inventor is not lost merely by lapse of time between the invention and application for a patent, unless there has been some intermediate public use by the applicant, or by his consent; and especially where he has been *bona fide* taking measures to improve or perfect his invention, and to prepare for applying for taking a patent. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

23. A patent issued to second inventor, before the application for a patent by the first inventor, which will bar the issuing of a subsequent patent to the first inventor, must be, comparing § 7 with §§ 6, 8, and 15 of the act of 1836, a patent issued prior to his *invention*, and not merely prior to his *application*. *Ibid.*

24. The dictum of STORY in *Bedford* v. *Hunt*, 1 Mas., 304, *ante* 6, that "the first inventor who has put the invention in practice, *and he only* is entitled to a patent," was founded on the words "*but had been in use*," in § 6 of the act of 1793, but these words have been carefully excluded from § 15 of the act of 1836. *Ibid.*

25. But the doctrine that he who first communicates an invention to the public and puts it in practice, and *he only*, is entitled to a patent, is not supported to its fullest extent by the cases, and does not apply to a first inventor who is using reasonable diligence in adapting and perfecting his invention, whose right is saved by § 15 of the act of 1836. *Ibid.*

26. If an invention be the mere speculation of a philosopher or mechanician in his closet, and he takes no step toward securing a patent, but keeps his invention a secret, and another person, who is also an original but subsequent inventor of the same thing, obtain

a patent for it and bring it into use, the patentee in a suit at law will be considered the first inventor. *Ibid.*

27. Whoever first perfects a machine and makes it capable of useful operation, is entitled to a patent, and is the real inventor, though others may have had the idea, and made some experiments toward putting it in practice. *Washburn* v. *Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

28. The fact that a party made a machine, is *prima facie* evidence that he was the first inventor of it. *Warner* v. *Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

29. Such an inference is however rebutted by the facts that in making the machine he was working in his trade as a machinist in the employ and for the benefit of another, for wages, and that he did not claim for some time to be the inventor of such machine, and stood by and saw his employer apply for and obtain a patent for it without objection. *Ibid.*

30. If A make a machine for B at B's request, for his benefit and at his expense, the presumption is that it was made according to B's directions, and the burden of proof is on A to show that it was not made according to B's directions. *Ibid.*

31. The first inventor is entitled to a patent, and will prevail over a subsequent one, though the subsequent invention may be made and used before letters patent are taken out for the first. *Allen* v. *Blunt*, 2 Wood. & Min., 140.—WOODBURY, J.; Mass., 1846.

32. If a patentee is not the first or original inventor, in reference to all the world, he is not entitled to a patent, even although he had no knowledge of the previous use or previous description of the invention. *Street* v. *Silver*, Brightly, 98.—ROGERS, J.; Pa., 1846.

33. The provisions of §§ 6 and 15 of the act of 1836, introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity, by the existence of a secret invention or discovery abroad—that is, a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty. Gen., 1848.

34. A *bona fide* inventor in this country, and who believed himself to be the original and first inventor, at the time of his application, and did not know or believe his invention had before been known or used, is entitled to a patent for his invention, though the same invention may have been known and used in a foreign country, provided it had not been patented or described in any printed publication. *Ibid.*

35. In such a case the American inventor is, in contemplation of law, under the provisions of the act of Congress, the original and first inventor. The fact that an invention, not patented or described in any printed publication, has been before known and used in any foreign country, is immaterial, except so far as it may have come to the knowledge of the American inventor, and conflict with the oath he is required to take as an original inventor. *Ibid.*

36. If the applicant is an original inventor, and is in a condition to take the oath required, the act requires the Commissioner to issue the patent, the courts to declare it valid, and establish the American right, to the exclusion of the foreign discovery, which has not, in either of the modes indicated by the

act of Congress, been communicated to the public. *Ibid.*

37. Crude and imperfect experiments, equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor, who has perfected his improvement and obtained his patent. *Parkhurst* v. *Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

38. The patentee must be the original and first inventor. The invention must be original with him, and not known to others. The only exception exists in the case of a party obtaining a patent, believing himself to be the original inventor, and his invention is shown to have been *known* in a *foreign* country, but not patented there, or described in any printed publication. *Parker* v. *Stiles*, 5 McLean, 61.—LEAVITT, J.; Ohio, 1849.

39. Although all the parts going to constitute the plaintiff's invention—a car wheel—may have been known before, and developed in prior wheels, if the patentee first brought them together into a whole, and that whole is materially different from any whole that existed before, he is the original and first inventor, and entitled to a patent therefor. *Many* v. *Sizer*, 1 Fisher, 21.—SPRAGUE, J.; Mass., 1849.

40. The presumption of law is that a patentee is the first inventor of the thing patented to him, and the burden of proof is on the party denying it, to disprove the fact. *Pitts* v. *Hall*, 2 Blatchf., 231.—NELSON, J.; N.Y., 1851.

41. The question as to who is the first inventor, is, not who constructed the first machine, but who conceived, and gave practical form and effect to the arrangement which constitutes the improvement. *Ibid.*, 235.

42. It is not necessary, to protect a patentee as the first inventor, that he should have been the first one to suggest the possibility or probability of such discovery or invention. He may have profited by the experiments of others; but it gives them no right to claim a share of the honor or profits of the successful inventor. *Goodyear* v. *Day*, 2 Wall, Jr., 299.—GRIER, J.; N. J., 1852.

43. If A, claiming to be an inventor of a certain invention, stand by and hear another make claim to the same invention without asserting his own claim to such invention, the inference will be warranted that the principles of such invention were not, at that time, known to A. *Ruggles* v. *Young*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

44. He is the first inventor, who has first perfected and adapted the invention to use; but this position is subject to the qualification, that he who *invents* first shall have the *prior* right, if he is using reasonable diligence in perfecting and adapting the same, although the *second* inventor has in fact *first perfected* the same, and reduced it to practice in a positive form. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

45. A long course of mere fruitless experiments to reduce a principle to practice, will not be sufficient to prevent a subsequent original inventor, who has perfected his invention without knowledge of the prior invention, from receiving a patent. *McCormick* v. *Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

46. But where a prior inventor has been using due diligence to perfect his invention and adapt it to practical use, his right will be preserved and protect-

ed, although his success may not be perfect. *Ibid.*

47. Under the proviso of § 15 of the act of 1836, an original inventor is entitled to receive a patent for his invention, even though he may not be a first discoverer in respect to such invention having been known in a foreign country, provided he believed himself to be the first inventor, and such foreign invention had not been patented, or described in any printed publication. *O'Rielly* v. *Morse*, 15 How., 110.—TANEY, Ch. J.; Sup. Ct., 1853.

48. The mere speculation of a philosopher or mechanic, never put into practice or operation, will not deprive a subsequent inventor, who has employed his labor and talents in putting it into practice, of the reward due to his ingenuity and enterprise. *Rich* v. *Lippincott*, 2 Fisher, 7.—GRIER, J.; Pa., 1853.

49. But if the first inventor reduced his theory to practice, and put his invention into use, the greater or less use of it, or the more or less widely the knowledge of its existence may circulate, will not constitute the criterion by which to decide upon the validity of any subsequent patent for the invention. *Ibid.*, 7.

50. The circumstance that a person has had an idea of improvement in his head, or has sketched it upon paper—and then gives it up—does not, in judgment of law, constitute or have the effect to constitute him the first and original inventor. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 322.—NELSON, J.; N. Y., 1855.

51. It is not the person who has only produced the idea that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine, and reduced it to practice. He who has first done this, is the inventor who is entitled to protection. *Ibid.*, 322.

52. If the idea involved in the patented article had occurred to others, or had come to the patentee from others, still, if the patentee had been the first to give to that idea a useful and practical form, he will be considered the first inventor. *Teese* v. *Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

53. When two persons are both inventors of the same thing, the one who perfected his invention first is protected by the law. *Allen* v. *Hunter*, 6 McLean, 322.—MCLEAN, J.; Ohio, 1855.

54. If an inventor does not use reasonable diligence to perfect his invention after the idea of it is conceived, and in the mean time another not only conceives the idea but perfects the invention, and practically applies it to public use, the latter is the first and original inventor, and a patent granted to the former will be void, as he is not the first and original inventor. *Ransom* v. *Mayor, &c.*, 1 Fisher, 272. HALL, J.; N. Y., 1856.

55. The cardinal principle upon which patent laws rest is, that an individual is only entitled to appropriate to his exclusive control that which he has by his original invention or discovery first made known and rendered useful. *Carr* v. *Rice*, 1 Fisher, 200.—BETTS, J.; N. Y., 1856.

56. To determine his exclusive title, it is necessary to ascertain what was before known to the public, and whether what he assumes to be his is really made so by being distinct from any thing before publicly used in that condition, and applicable to like purposes, and is rendered by means of his invention useful. *Ibid.*, 201.

57. He who first makes known sufficiently an invention, by describing it in words or drawings, will be considered the first inventor, and vested with an inchoate right to its exclusive use, which he may embody, perfect, and make absolute by proceeding to mature it in the manner which the law requires. *Hill* v. *Dunklee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

58. In determining the question, under § 15 of the act of 1836, whether a patentee believed himself to be the first inventor of the thing patented, notwithstanding the actual existence of such thing in a foreign country, which however had not been patented or described, the defendant may give evidence that the patentee knew of the existence of the thing abroad, and in considering the fact whether he *believed* himself to be the first inventor, it is material to determine whether he was in fact the original inventor. *Forbush* v. *Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

59. The first inventor is not he who made or perfected the first machine or instrument, but he who first conceived the idea, and so described it by words or drawings as to enable a skilful workman to bring it into useful, practical operation. *Davidson* v. *Lewis*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

60. Such a person will be protected against the claim of a subsequent inventor, who may have first made a machine or instrument, provided such first discoverer has been using due diligence in effecting the same end, and although he may have been unsuccessful in some of his experiments, if by following them up he at length succeeds. *Ibid.*

61. Although an inventor and patentee may not have reduced to practical use and operation his invention, before the time the same thing may have been invented by another, if at the time of such subsequent invention, the first inventor was using reasonable diligence (§ 15 of the act of 1836) in adapting and perfecting the same, and did afterward in a reasonable time adapt and perfect the same, such subsequent invention will not deprive him of the benefits secured by his patent. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., Apr., 1859.

62. The true meaning of § 7 of the act of 1836 is, that a patent shall issue to an applicant and be valid, if he is the originator and author of a new invention or discovery, unless the thing invented by him has, prior to his alleged discovery or invention, been invented, or discovered, or used by some one else in this country; or unless the invention has been patented or described in some printed publication in this or some foreign country, prior to the alleged invention or discovery of the applicant; or unless said invention of the applicant had been in public use, or on sale with his consent and allowance, prior to his application for a patent, for more than two years. *Bartholomew* v. *Sawyer*, 4 Blatchf., 351. —INGERSOLL, J.; N. Y., Sept., 1859.

63. Though a machine is made and completed prior to the invention of another, and though such prior machine embodies the improvements or principles contained in the other, the inquiry for the jury is, whether the former was in point of fact 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; and unless it appear that such machine was actually used as a

working machine, the jury are warranted in presuming that it is a mere experiment, and if so, it will not invalidate a patent, obtained by the other or subsequent inventor, provided such patentee was an original inventor, without knowledge of the former machine, and did not derive any of his invention from such other person. *Cahoon* v. *Ring*, 1 Fisher, 409.—CLIFFORD, J.; Me., 1859.

64. To entitle any person to an exclusive right, by virtue of a patent, he must be the first as well as the original inventor. *Johnson* v. *Root*, 1 Fisher, 364.—SPRAGUE, J.; Mass., 1859.

65. The person who clearly suggests an invention, or describes it, so that it can be practically applied, is entitled to a patent therefor, and not the one who first actually puts it in operation. *Stearnes* v. *Davis*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

66. The person who is the first to conceive and give expression to the idea of an invention, in such clear and intelligible manner that a person skilled in the business could construct the thing is entitled to a patent, provided he uses reasonable diligence in perfecting it. *Eames* v. *Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

67. Where an inventor describes his invention to a mechanic, and directs him to construct it, he is entitled to a reasonable time for making experiments in order to perfect his invention, and such description and experiments, if successful, will be considered as sufficient evidence of an assertion of his right at the time he made them, although a subsequent inventor may first perfect the invention and obtain a patent therefor; and such prior inventor will be entitled to a patent. *Dietz* v. *Burnham*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859; *Gibbs* v. *Johnson*. *Ibid.*, 1860.

68. Mere conversations about the practicability of an improvement, or suggestions as to the manner in which it might be carried out or accomplished, will not of themselves defeat the claims to originality of him who perfects the idea and secures a patent. *Judson* v. *Moore*, 1 Fisher, 555.—LEAVITT, J.; Ohio, 1860.

69. Neither will experiments defeat, even if known to the patentee, if it appear that *he* has prosecuted such experiments to final success. *Ibid.*, 555.

70. But any information to a patentee sufficient to enable him to construct the thing itself, would destroy the originality of the invention. Such knowledge, however, must be definite and tangible, and sufficient of itself to enable the party to whom imparted to construct the thing. *Ibid.*, 555.

71. If an inventor who has obtained a patent is not the first to have conceived the ideas he claims, and to have adapted them to practical use, his patent is void. An invention belongs to the prior inventor, whether he has obtained a patent or not. *Winans* v. *Danforth*, MS.—NELSON, J.; N. Y., 1860.

72. The party who first conceives the idea or conception of an invention is entitled to a patent, provided he pursues his idea or conception and reduces it to practice within a reasonable time, though another may have first actually reduced the invention to practice. *Bev. Rub. Co.* v. *Wing*, MS. (App. Cas.)—DUNLOP, J.; *D. C.*, 1860.

73. The first inventor is entitled to a reasonable time, to be judged of according to the circumstances of the particular case, in which to perfect his invention, without impairing his claim to priority. If he is using reasonable dili-

gence, he will not lose his right through another first making a working invention. *Appletons* v. *Chambers*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

74. An inventor who first perfects an invention, and applies for and obtains a patent for it, will not be deprived of his right to such patent by a more tardy and negligent inventor, who may have first conceived the idea of the invention, but did nothing toward reducing it to practice, or applying for a patent for it. *Walker* v. *Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

75. Where A conceived the "idea" of an invention, but made no drawing of it for six or seven months, and in the mean time B had conceived the same invention, and had made a model of it, thus giving *physical form and shape* to his conception, *Held*, that B was to be considered as having first perfected his invention. *Ibid.*

76. If a person, after having the conception of an invention, is using due diligence to perfect it and reduce it to practice, he will still be deemed the first inventor, though another, who conceived the idea later, may have first perfected the idea by manufacturing the thing invented. *Hicks* v. *Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

## JOINT INVENTION AND PATENT.

1. If, of two joint inventors of a machine, one of them, without the other relinquishing his interest to a joint interest in the patent right, obtains a patent in his own name, he will be deemed guilty of a fraud, and will in equity be considered as a trustee for the other. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. A joint patent may well be granted for a joint invention. An invention may be the result of the combined mental operations of two persons acting together. As neither could claim to be the sole inventor, the invention is joint, and they are jointly entitled to a patent. *Barrett* v. *Hall*, 1 Mas., 472.—STORY, J.; Mass., 1818.

3. A joint patent cannot be sustained upon a sole invention of either of the patentees, for the patent act gives no right to a patent except to the inventor. *Ibid.*, 473.

4. A joint patent for an invention is utterly inconsistent with several patents for the same invention by the same parties. No person can be at the same time the joint and sole inventor of the same invention. *Ibid.*, 473.

5. If several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint; but the former patents are very strong evidence against the joint invention. *Ibid.*, 474.

6. Where two persons obtained several patents, and afterward obtained a joint patent for the invention patented in the several patents, and afterward covenanted together as to a division of their interests under such joint patent, *Held*, to an action of covenant brought by one of such joint patentees, that the other could not plead that neither was the inventor, or that separate patents had been issued to each. *Stearnes* v. *Barrett*, 1 Pick., 443, 447.—WILDE, J.; Mass., 1823.

7. And that after having obtained a joint patent, neither party could set up the prior separate patents, and neither was estopped by the separate patents from asserting that the invention was joint. *Ibid.*, 447.

8. If the circumstances are such as to show that two parties contributed to an invention, so as to make them joint inventors, a joint patent should be taken out. *Thomas* v. *Weeks*, 2 Paine, 103.—THOMPSON, J.; N. Y., 1827.

9. The man who reduces to practice the theory of another, who assists in the reduction of it to practice, cannot be considered as the sole inventor of the machine. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

10. If one suggest the mode of operation or the principle of a machine, and another reduces it to practice, neither can be considered as the sole inventor, but the invention is joint. *Ibid.*

11. One of two or more joint inventors is not *the* inventor, within the meaning of § 5 of the act of 1836, and if he applies for a patent, the Commissioner is bound to refuse it. *Ibid.*

12. Patents for inventions cannot, under § 6 of the act of 1837, issue jointly to the inventor as such, and to the assignee of a partial interest; but may issue to the assignee or assignees of the whole interest. *Anon.*, 4 Opin., 401.—MASON, Atty. Gen.; 1845.

13. A partial assignment before issue does not entitle the partial assignee to have the patent issued to him to the extent of his interest. *Ibid.*, 401.

14. If a patent is issued to two as their joint invention, such patent is *prima facie* evidence that the invention was joint, though the fact may be disproved at the trial. *Hotchkiss* v. *Greenwood*, 4 McLean, 462.—MCLEAN, J.; Ohio, 1848.

15. A joint interest in a patent does not make those interested partners. Some agreement becomes necessary to enable them to work the invention at their joint expense and for their joint benefit. *Parkhurst* v. *Kinsman*, 1 Blatchf., 496.—NELSON, J.; N.Y., 1849.

16. Proof of the declarations of a party claiming to be a joint inventor of an invention, and asserting such inventorship, made in the presence of the other joint inventor, and not denied, or impliedly admitted by him, will be sufficient to prevent the issuing of a patent to such other inventor, on an application without joining the former. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

17. The relation of copartners between joint patentees does not result from their connection as joint patentees, or between one of two joint patentees and the assignee of the other. The parties are simply joint owners or tenants in common, of the rights and property secured by the patent; and their rights, powers, and duties as respects each other are substantially those of the joint owners of a chattel. *Pitts* v. *Hall*, 3 Blatchf., 206.—HALL, J.; N. Y., 1854.

18. One joint owner of a patent can legally grant, assign, license, or sell only in respect to his own share or right; he cannot sell and give good title to his co-owner's right; and if he appropriates any portion of the exclusive right or common property to his separate use or benefit, either by a sale or use of the patented machine, it is in principle the same as a conversion, by destruction or sale, of the joint property by a tenant in common, and for which the other

tenant in common could maintain trover. *Ibid.*, 207, 208.

19. No satisfactory reason exists why the part owner of a patent-right cannot, like the part owner of a chattel, have his remedy by an action on the case against his coproprietor, for the exclusive appropriation of the joint property, in the same form as though the plaintiff were the sole owner and the defendant a stranger. *Ibid.*, 208.

20. In such an action against his coowner for an infringement of the patent, he can recover his actual damages according to his interest in the patent, without regard to the amount which his coproprietor has received by means of the infringement. *Ibid.*, 208.

21. One tenant in common has as good a right to use and to license third persons to use the thing patented as the other tenant in common has. *Clum* v. *Brewer*, 2 Curt., 524.—CURTIS, J.; Mass., 1855.

22. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract between them. None such existing, one tenant in common cannot enjoin the other from such use or sale. *Ibid.*, 524.

23. If the invention patented, as in a joint patent, is the sole invention of one of the patentees, and not the joint invention of both, the patent is void. *Ransom* v. *Mayor, &c.*, 1 Fisher, 269. —HALL, J.; N. Y., 1856.

24. A joint patent may be taken out by two persons for an improvement in a machine, the object of which is to produce a given effect, though such improvement may consist of two distinct and separate parts, and such parties may have separately invented such parts, the one inventing one part and the other the other. *Wilson, Assignee of Aiken and Felthousen*, v. *Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

25. But held by NELSON, J., in reference to this same patent, that of Aikens and Felthousen, that if each was an inventor of a distinct part, separate patents ought to have issued to each, and not a joint patent to the two; and that if so issued, the patent was void. *Potter* v. *Wilson*, 2 Fisher, 107.—NELSON, J.; N. Y., 1860.

## JURISDICTION

Of Courts, see COURTS; EQUITY.

Of Justices of Circuit Court of District of Columbia, see APPEALS, B. 3.

## JURY.

As to how far the jury may construe Patents, see PATENT, P. 4.

1. The jury are to determine whether the patentee is the first inventor; whether the defendants are using his invention; and whether improvements in a machine are in the principle, or form, or proportions of it. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. Whether an invention is new and useful is a question for the jury. *Park* v. *Little*, 3 Wash., 197.—WASHINGTON, J.; Pa., 1813.

3. It is for the jury to decide whether there has been any dedication, by the inventor, of his invention to the public. *Whittemore* v. *Cutter*, 1 Gall., 482.—STORY, J.; Mass., 1813.

4. It is a question for the jury, whether the machine used by the defendant is substantially the same as that of the plaintiff; and whether the plaintiff's

patent has been surreptitiously obtained. *Odiorne* v. *Winkley*, 2 Gall., 55.—STORY, J.; Mass., 1814.

5. Where it becomes a matter of inquiry, whether the benefits of an invention are of sufficient consequence to be protected, it is proper to leave the question of utility to the jury. *Langdon* v. *De Groot*, 1 Paine, 204.—LIVINGSTON, J.; N. Y., 1822.

6. But if, on the plaintiff's own showing, the invention is useless, it may be doubted whether the court would transcend its limits, in deciding such question. *Ibid.*, 204.

7. The intent of the delay in applying for a patent, and whether the allowing an invention to be used without a patent, should not be considered an abandonment, is a question which should always be submitted to a jury. *Morris* v. *Huntington*, 1 Paine, 354.—THOMPSON, J.; N. Y., 1824.

8. In every case, it is a question for the jury, whether the change of form and proportion in an invention has produced a different effect, and is a new invention. *Davis* v. *Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

9. The question 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, is one of fact rather than law. But when the facts are given, there does not seem any reason why the court may not state the legal conclusions deducible from them. *Pennock* v. *Dialogue*, 2 Pet., 16.—STORY, J.; Sup. Ct., 1829.

10. Priority of knowledge and use is a question of fact, which a jury may decide on the evidence of one witness. *Whitney* v. *Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

11. The knowledge of an inventor, or his acquiescence in the public use of his invention, may be presumed from circumstances; but this is a fact for the jury. *Shaw* v. *Cooper*, 7 Pet., 321.—McLEAN, J.; Sup. Ct., 1833.

12. The jury are to judge, by an inspection of the models, and from the evidence, whether two machines differ in principle. *Smith* v. *Pearce*, 2 McLean, 179.—McLEAN, J.; Ohio, 1840.

13. The question of the forfeiture or abandonment of an invention, is a question of fact for a jury on a trial at law. *Hildreth* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

14. Objections to a patent, that the specification does not sufficiently describe the invention—or that the invention is not new—that a renewed and the original patent are not for the same invention—or that the patent was obtained with a fraudulent intent—all involve matters of fact, which belong to the province of the jury, upon the evidence. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 441.—STORY, J.; Mass., 1843.

15. Where witnesses differ as to the fact of infringement, the question will be submitted to a jury, either by an action at law, or an issue directed by chancery. *Brooks* v. *Bicknell*, 3 McLean, 262.—McLEAN, J.; Ohio, 1843.

16. The question of the unreasonableness of the delay to enter a disclaimer, is a mixed question of law and fact, and must be decided by a jury, under the instruction of the court. *Brooks* v. *Bicknell*, 3 McLean, 449.—McLEAN, J.; Ohio, 1844.

17. Whether a reissued patent is substantially for a different invention from the first patent, is a question of fact for a jury; but as by § 13 of the act of

1836, the Commissioner of Patents is authorized to issue a renewed patent, the inquiry afterward in regard to the surrender is limited to the fairness of the transaction—to the question of fraud in the surrender. *Stimpson* v. *West Chester R. R.*, 4 How., 404.—McLean, J.; Sup. Ct., 1845.

18. Whether the sale of an article before application for a patent will amount to an abandonment of invention, is a question for a jury in a trial at law. *Booth* v. *Garelly*, 1 Blatchf., 249, 250.—Nelson, J.; N. Y., 1847.

19. It is a question of fact for the jury whether a departure, in a defendant's machine, from the arrangement of parts in a machine described in the plaintiff's patent, constitutes a material variation from the patentee's arrangement. *Blanch. Gun-Stock Co.* v. *Warner*, 1 Blatchf., 278, 279.—Nelson, J.; Ct., 1846.

20. It is for the court to decide whether the patent, in all substantial particulars, conforms to the requirements of the law; and it is for the jury to decide, whether, from the evidence, the description of an invention in a patent, is sufficiently full, clear, and exact to enable a skilful mechanic to construct the thing described. *Parker* v. *Stiles*, 5 McLean, 55.—Leavitt, J.; Ohio, 1849.

21. It is the province of the court to decide what constitutes novelty, and of the jury to determine, from the evidence adduced, whether the patentee's invention is new. *Ibid.*, 60.

22. It is a question for the jury to determine, whether an alien patentee has put and continued on sale, the invention patented to him within eighteen months from the date of the patent. *Tatham* v. *Le Roy*, MS.—Nelson, J.; N. Y., 1849.

23. The question of identity between two opposing machines, is ultimately one of fact to be determined by the jury. *Tatham* v. *Le Roy*, 2 Blatchf., 485.—Nelson, J.; N. Y., 1852.

24. The question of fraud in the granting of a patent, will not be passed upon by the judge on appeal, but is to be tried by a jury. *Burlew* v. *O'Niel*, MS. (App. Cas.)—Morsell, J.; D. C., 1853.

25. Whether the defendant has constructed, used, or sold the thing patented to the plaintiffs, is a question of fact for the jury. *Winans* v. *Denmead*, 15 How., 338.—Curtis, J.; Sup. Ct., 1853.

26. A question of infringement is one of fact, which it is the province of the jury to decide. *Rich* v. *Lippincott*, 2 Fisher, 5.—Grier, J.; Pa., 1853.

27. The jury are to determine as to the novelty of the invention; and whether a renewed patent is for the same invention as the original patent; and whether an invention has been abandoned to the public; and whether two machines are identical, or are constructed and act on different principles. *Battin* v. *Taggert*, 17 How., 85.—McLean, J.; Sup. Ct., 1854.

28. It is the province of the jury, under the instruction of the court as to what the invention is, to determine whether such invention is new and useful. *Wintermute* v. *Redington*, 1 Fisher, 248.—Wilson, J.; Ohio, 1856.

29. Whether there is any novelty in an invention or arrangement of parts, is a question of fact for the jury to determine upon a view of all the evidence in the case. *Sickles* v. *Borden*, 3 Blatchf., 540.—Nelson, J.; N. Y., 1856.

30. Whether a reissued patent is for

the same invention as the original one, is a question of fact for a jury.—*Heilner* v. *Battin*, 27 Penn., 521, 524.—WOODWARD, J.; Pa., 1856.

31. The jury are to consider that the patent grants that which the court determines it to grant. *Serrell* v. *Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

32. The question of identity is one of fact, to be determined by the jury upon the evidence before them, under the instructions of the court as to what in law constitutes a substantial identity. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

33. And it is exclusively the province of the jury to ascertain and determine whether the patentee is the original inventor of the invention described in the patent, and whether the patent embraces the thing used by the defendants. *Ibid.*

34. The question as to the materiality of any part of a combination is one for the determination of the jury upon the evidence. *Vance* v. *Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

35. It is a question of fact for the jury whether the defendants have infringed the patent of the plaintiff. *Waterbury Brass Co.* v. *N. Y. & Brook. Brass Co.*, 3 Fisher, 52.—INGERSOLL, J.; N. Y., 1858.

36. The question of priority of invention is for the jury to determine. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

37. Whether an inventor has abandoned or surrendered his invention and whether this is sought to be proved from his declarations or acts, or from a forbearance or neglect to act or speak, is an inquiry or conclusion of *fact* for the jury to decide. *Kendall* v. *Winsor*, 21 How., 331.—DANIEL, J.; Sup. Ct., 1858.

38. The question of infringement is exclusively for the jury. *Judson* v. *Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

## LECTURES.

1. The author of lectures has a right of property therein, which is entitled to protection. Lectures may be taken down *verbatim*, and the person taking them down has a right to their use; but he may not print them. *Bartlett* v. *Crittenden*, 4 McLean, 304.—MCLEAN, J.; Ohio, 1847.

2. Any use of such lectures, which should operate injuriously to the lecturer would be a fraud upon him for which the law would give him redress. *Ibid.*, 304.

3. The author cannot claim any vested right in the ideas he communicates, but the words and sentences in which they are clothed belong to him. *Ibid.*, 304.

4. Lectures, oral or written, cannot be published without the consent of the author, though taken down when delivered. *Bartlett* v. *Crittenden*, 5 McLean, 42.—MCLEAN, J.; Ohio, 1849.

## LETTERS.

See also MANUSCRIPT.

1. The receiver of a letter has no right to publish it without the writer's consent. *Denis* v. *Le Clerc*, 1 Martin, 302.—MARTIN, J., La., 1811.

2. Unless there be a most unequivocal dedication of private letters and papers by the author, either to the public or some private person, the author has a

property therein and the copyright belongs exclusively to him. *Folsom* v. *Marsh*, 2 Story, 109.—STORY, J.; Mass., 1841.

3. *Semble*, that there is no distinction between letters of business, or of a mere private or domestic character, and letters which from their character and contents are to be treated as literary property. *Ibid.*, 109.

4. The author of any letters (and his representatives), whether literary compositions, or familiar letters, or letters of business, possess the sole and exclusive copyright therein; and no persons, neither those to whom they are addressed, nor other persons, have any right or authority to publish the same upon their own account or for their own benefit. *Ibid.*, 110.

5. But consistently with this right, the persons to whom they are addressed possess the right to publish such letters upon such occasions as require or justify the publication or public use of them—as to establish a personal right, or vindicate his character—but this right is strictly limited to such occasions. *Ibid.*, 110, 111.

6. In respect to official letters addressed to the government, or any of its departments, by public officers, the government may, perhaps, from principles of public policy, withhold them from publication, or give them publicity; but private persons have no right to publish them without the sanction of the government. *Ibid.*, 113.

7. A Court of Chancery assumes jurisdiction to restrain the publication of private letters on no other principle, and upon no broader ground than that of a copyright in literary productions, or of property in the paper on which they are written, similar to property in stereotype or engraved plates. *Wetmore* v. *Scoville*, 3 Ed. Ch., 527.—McCOUN, V. Chan.; N. Y., 1842.

8. It will not exercise the power of preventing a publication of private letters of business on the ground of copyright or literary property, when they possess none of the attributes of literary composition. *Ibid.*, 528.

9. Nor because they were written in confidence and their publication might wound the feelings. *Ibid.*, 529.

10. A court of equity will restrain the publication of letters written by the complainant, if such letters are in fact of any value to him as literary productions, or if his right to multiply copies is worth any thing to him. *Hoyt* v. *McKenzie*, 3 Barb. Ch., 324.—WALWORTH, Chan.; N. Y., 1848.

11. But otherwise as to such letters as have been written *to* him by other persons without any authority, express or implied, to publish them; as to such the right belongs to the writer. *Ibid.*, 324.

12. A letter cannot be considered of any value to the author, for the purpose of publication, which he would not consent to have published, either with or without a copyright. *Ibid.*, 324.

13. A court of equity will not attempt to restrain the publication of private letters, on the ground of protecting literary property, when they possess no attribute of literary composition. *Ibid.*, 325.

14. The writer of private letters has a right of property in them, and their publication may be enjoined. They can only be used by the receiver for the purposes for which they were written, or in justification or defence. *Bartlett* v. *Crittenden*, 5 McLean, 42.—McLEAN, J.; Ohio, 1849.

15. It is doubtful whether under the act of 1831, as to copyrights, the courts of the United States can exercise jurisdiction, by way of injunction, to prevent the publication of private letters contrary to the wishes of the writer. *Woolsey* v. *Judd*, 4 Duer, 382.—DUER, J.; N. Y., 1855.

16. A court of equity cannot interfere by way of injunction to prevent the publication of private letters, *merely* on the ground that such a publication, without the consent of the writer, is a breach of confidence and honorable feeling, and is dangerous to the peace and morals of the community. *Ibid.*, 383, 384.

17. Such an injunction cannot be granted, unless it appears that the personal legal rights of the party seeking the aid of the court are in danger of violation. *Ibid.*, 384.

18. The writer of letters, though written without any purpose of publication or profit, or any idea of literary property, possesses such a property in them that they can never be published without his consent, unless the purposes of justice, civil or criminal, require the publication. *Ibid.*, 390, 391.

19. The receiver of letters has only a special or qualified property, confined to the material on which they are written, and not extended to the letters as expressive of the mind of the writer. *Ibid.*, 393.

20. Neither the receiver of letters, nor any other person, has any right to publish such letters, without the consent of the writer. *Ibid.*, 393.

21. The property which the writer retains gives him an exclusive right to determine whether the letters shall be published or not; and when he forbids their publication, makes it the duty of a court of equity to aid and protect him by an injunction. *Ibid.*, 393.

22. The receiver of a letter may publish it when its publication is shown to be necessary for the vindication of his rights or conduct; but this license has never been extended to a person whose possession of a letter, or of the copy of a letter, as acquired without the consent of the writer or receiver, is wholly unlawful. *Ibid.*, 406, 407.

23. But if a receiver attempts to publish such a letter, or any part thereof, against the wishes of the writer, and upon occasions not justifiable, a court of equity is bound to prevent such publication by an injunction. *Ibid.*, 406.

24. As against a stranger who has possessed himself of private letters, or copies thereof unlawfully, the right to restrain their publication is absolute—such person having no right to publish for any purpose whatever. *Ibid.*, 406.

25. Letters written by one person to another, either of business or friendship, and aside from the question whether they have any literary value, are property. *Eyre* v. *Higbee*, 22 How. Pr., 200.—MULLEN, J.; N. Y., 1861.

26. The property of the receiver of such letters is not absolute in them, but only special. Such letters will pass to the administrator of the person receiving them, but they are not assets, and cannot be made the subject of sale by him. *Ibid.*, 202, 202.

27. As regards private letters, the right of publication as one of literary property, remains for a reasonable length of time (to allow its assertion by publication) in the writer and his personal representatives. After such a period has elapsed, that there ceased to be a probability that such right to publish was treated as a legal right, any one

may publish who can obtain copies. *Ibid.*, 207.—GOULD, J.

28. Whatever property there is in such letters rests in the writer, and not in the receiver. *Ibid.*, 208.—INGRAHAM, J.

29. The administrator of the receiver may however retain them, as he would a receipt or an account, to aid him in the settlement of the estate, if they had any bearing upon that subject. *Ibid.*, 208.

30. And if such letters are of such a character as in his opinion would be productive of injury (if published) to the writer or others, he may destroy them, and no one can call him to account therefor. *Ibid.*, 208.

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## LICENSE.

**A.** WHAT CONSTITUTES; RIGHTS UNDER; EFFECT OF TAKING..... 460
**B.** RECORDING OF, AND TRANSFER OF... 464
**C.** FORFEITURE OF; ACTIONS ON..... 466

### A. WHAT CONSTITUTES; RIGHTS UNDER; EFFECT OF TAKING.

See also ASSIGNMENT, B.; EXTENSION OF PATENT, C.

1. Where A erected on his own premises and at his own expense a machine, the invention of B, and B then leased of A for a term of years the machine, covenanting to deliver the same to A at the end of the term, *Held*, that this amounted to a license or a consent in writing, under § 4 of the act of 1790, to use the machine after the end of such term. *Reutgen* v. *Kanowrs*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

2. An offer to take a license from a patentee to use his invention, does not take away the right of the person making such offer to deny that the patentee was the original inventor. *Evans* v. *Eaton*, Pet. C. C., 347.—WASHINGTON, J.; Pa., 1816.

3. A patentee by an instrument agreed to "grant, bargain, sell, assign, and transfer to B., his executors, administrators, and assigns the right and privilege of making, using, and selling friction matches," as patented, to have and to hold "the right and privilege of manufacturing the said matches, and to employ in and about the same six persons, and no more, and to vend said matches in any part of the United States." A proviso followed that nothing therein contained should prevent or restrict the patentee from "making and vending the same, or of selling and conveying similar rights and privileges to others." And B. was not to manufacture in certain places. *Held*, that such a conveyance was an authority or license coupled with an interest in its execution; but 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, 543, 551.—STORY, J.; Mass., 1843.

4. Under the patent acts, if an inventor allow another to use his invention for a considerable time before applying for a patent therefor, and a patent is afterward obtained, such permission and allowance will justify the jury in presuming a license or grant from the patentee, and such person is not liable to an action of infringement for the continued use after the patent is granted. *McClurg* v. *Kingsland*, 1 How., 208.—BALDWIN, J.; Sup. Ct., 1843.

5. Under § 7 of the act of 1839, the person who has had the use of an in-

vention prior to the application of a patent therefor, is on the same footing as if he had a special license from the inventor, which, if given before the application for a patent, would justify the continued use after it issued, without liability. *Ibid.*, 209.

6. But the use of an invention before an application for a patent, must be the specific improvement then invented and used by the person who had purchased, constructed, and used the machine to which the invention is applied. *Ibid.*, 210.

7. Where a patentee assigned and released all his right, title, and interest in the letters patent, so far only as the exclusive right of manufacturing and vending for a term of years for a weekly consideration, and in case of default of payment, that the patentee was to have the right to claim and take back the interest, *Held*, that the agreement conveyed no interest in the patent-right, but that the grant amounted to a mere *license*, with a limitation or condition as to its continuance. *Armstrong* v. *Hanlenbeck*, 3 N. Y. Leg. Obs., 45.—BETTS, J.; N. Y., 1844.

8. The words "license and empower" need not import any thing different from "grant." In their broad and general sense they are used indiscriminately. A mere "license," strictly speaking, passes no interest, but only makes an action lawful, which without it would have been unlawful; but if the instrument passes an interest, then it becomes a "grant." *Washburn* v. *Gould*, 3 Story, 162.—STORY, J.; Mass., 1844.

9. Where a grant to license and empower parties to construct and use fifty patented machines within certain territory, with a covenant that the patentee would not license any other persons to use any such machines in such territory for a given period, and reserving, however, the right, to the patentee to construct and license such machines elsewhere, *Held*, that the grant was of an exclusive right under the patent. *Ibid.*, 160, 165, 166.

10. The limitation of the number of machines to be made or used under a patent, is not inconsistent with the grant of an exclusive right in the patent within such territory. *Ibid.*, 167, 168.

11. The taking of a temporary license to use a patent-right cannot be considered as an acknowledgment of a right in the licensor beyond the termination of such license. *Rich* v. *Hotchkiss*, 16 Conn., 418.—WILLIAMS, Ch. J.; Ct., 1844.

12. Where it was stipulated between A and B that B should be entitled to use A's patent three days in a week until a given date, and that A would not prosecute any action against B for any former violation, provided B should not use such patent after the specified date, or by any other machine infringe A's right; *Held*, that such proviso, introduced by the plaintiff, and not placing any personal obligation on the defendant, did not operate as an estoppel against B to prevent him showing the truth in regard to the validity of the right of A. *Ibid.*, 419, 420.

13. If a licensee or grantee acknowledge, under his hand and seal, the validity of the grantor's title, *query*, is he not estopped from denying it? *Brooks* v. *Stolley*, 3 McLean, 526.—MCLEAN, J.; Ohio, 1845.

14. Where a party has an interest in only a part of a patent, as a license to use the invention patented, only in the manufacture of a particular kind of goods, he cannot maintain an action for

an infringement. *Suydam* v. *Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

15. A license to run *one* machine will not be construed to mean an identical particular machine, unless it is so limited in express terms. *Wilson* v. *Stolley*, 4 McLean, 278.—MCLEAN, J.; Ohio, 1847.

16. A license or grant of an exclusive right to use a patented machine for a specified purpose, as a right to use Blanchard's patent for turning irregular forms, to turn lasts—does not convey any legal title to the patent. *Blanchard* v. *Eldridge*, 1 Wall, Jr., 339, 341. —GRIER, J.; Pa., 1849.

17. An agreement made by a patentee, and conveying to the grantee the exclusive right to make and vend the thing patented within a certain territory, but reserving to the grantor the right to make and sell within the same territory, is not an assignment of an exclusive interest in the patent, but is only a license. *Gayler* v. *Wilder*, 10 How., 495.—TANEY, Ch. J.; Sup. Ct., 1850.

18. The right to make a machine is distinct from that of using it. *Bicknell* v. *Todd*, 5 McLean, 238.—MCLEAN, J.; Ohio, 1851.

19. The right to use implies a right to repair, but not to construct. It also implies a right to purchase, when the one in use is worn out or destroyed. *Ibid.*, 239.

20. Declarations on the part of an inventor that he does not intend to take out a patent, but to let the public have his invention, are equivalent to a license, and such party or any one holding under him will be estopped from asserting his right as against a person acting on the faith of such declarations. *Pitts* v. *Hall*, 2 Blatchf., 237, 238.—NELSON, J.; N. Y., 1851.

21. An agreement made between B. and C. and others, providing for the settlement of various matters, the discontinuance of certain suits, and also as to the manufacture of a certain article, as follows: "that the said parties may each hereafter manufacture and vend spike of such kind and character as they see fit, notwithstanding their conflicting claims to this time," must be construed with reference to the situations of the parties to it; and B. having claimed that he had the exclusive right, under his patent, to make such spikes, which right the defendant C. was infringing, but the defendant claiming that he did not infringe such patent, but made such spikes by an entirely different method; *Held*, that such agreement did not give C. a license to make such spikes after B.'s patent, but only a right to make them by the same process or machinery he had been before using. *Troy Iron and Nail Fac.* v. *Corning*, 14 How., 213.—WAYNE, J.; Sup. Ct., 1852. [Overruling same case below, 1849; 1 Blatchf., 470.]

22. An agreement made by the owner of a patent, securing to the grantee the exclusive right to make, use, and sell to others to be used, the machine patented, within a certain territory, but reserving to the grantor the right to sell within such territory machines of his own manufacture, does not operate as an assignment or transfer to the grantee of the right and title secured by the patent within such territory. *Pitts* v. *Jameson*, 15 Barb., 315.—JOHNSON, J.; N. Y., 1853.

23. It is an agreement in the nature of a license to manufacture and sell, but more than a mere technical license; it is a

fixed contract right, vested in the grantee, and assignable by him. It is, however, a chose in action, not in possession, and the grantee and his assigns can retain the right only so long as the business is prosecuted under it. *Ibid.*, 315.

24. Whenever the business is abandoned, the rights secured by the contract revert to the grantor. Then, but not till then, the grantor can sell rights to third persons to make, sell, and use the patented machine in such territory, without being responsible to the grantee or his representatives for damages. *Ibid.*, 316.

25. The reservation by the grantor is also a mere personal privilege, and not transferable to others. *Ibid.*, 316.

26. Upon the death of the grantee, the contract and the rights under it go to his administrators as assets. *Ibid.*, 316.

27. But though they had no right, as administrators, to carry on the business of making machines under the contract, they could sell and transfer the right, and the purchaser would acquire all the rights secured to the intestate during his lifetime, if the business is carried on. *Ibid.*, 316.

28. G. made an agreement with B. as follows: "In consideration of one dollar, I engage to grant to B. license to manufacture, under my patents and improvements, india-rubber hose, in general, except that made of pure gum. In the event of the right of said hose being disposed of, said B. is to receive one-half the bonus obtained therefor, it being optional with him to retain, if he prefers it instead, a half right to manufacture;" *Held*, that such agreement embraced a reissued patent; and that B. obtained an immediate right to manufacture, and not merely an obligation for a future right; and that B. could recover of G. one-half of any sales made by G. of the right to make such hose, and that B. became entitled to such moiety, immediately upon any such disposal. *McBurney* v. *Goodyear*, 11 Cush., 571, 572.—MERRICK, J.; Mass., 1853.

29. Under § 14 of the act of 1836, an action at law is properly brought in the name of the patentee, in behalf of a licensee who is damaged by the infringement. *Goodyear* v. *McBurney*, 3 Blatchf., 33.—NELSON, J.; N. Y., 1853.

30. A party has no authority to grant licenses under a patent upon a mere agreement with the patentee to assign such patent. The patent must be actually assigned to such party before he can grant licenses. *Day* v. *Hartshorn*, MS.—PITMAN, J.; R. I., 1854.

31. One tenant in common in a patent has as good a right to use, and to license others to use the thing patented as the other tenant in common has. *Clum* v. *Brewer*, 2 Curt., 524.—CURTIS, J.; Mass., 1855.

32. A licensee under a patent is one who has transferred to him, in writing or orally, a less or different interest in such patent than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. *Potter* v. *Holland*, 4 Blatchf., 211.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1858.

33. A licensee has no legal right, as an assignee, to surrender a patent, and a surrender without his concurrence is valid. *Ibid.*, 209.

34. Nor can a mere licensee bring an action at law for a violation of the patent. *Ibid.*, 211.

35. A licensee is, however, entitled to the same right under a reissued that he had under the old patent; but he can-

not be compelled to take under the new, and give up his right under the old one. *Ibid.*, 214.

36. A contract of license is like every other contract, and depends upon a fair construction of the acts of the parties. *Bell* v. *McCullough*, 1 Fisher, 381.—LEAVITT, J.; Ohio, 1858.

37. The sale of a machine, and the right to use a patented article with it, imports a license to use the article patented; and such license is not within the provisions of § 11 of the act of 1836, which require an assignment or grant to be in writing. *Buss* v. *Putney*, 11 Mo. Law Rep., 687.— ———, J.; N. H., 1858.

38. A licensee may bring, for his own benefit, an action in the name of the patentee, but the nominal plaintiff can require indemnity for costs. *Goodyear* v. *Bishop*, 4 Blatchf., 439.—NELSON, J.; N. Y., 1860.

39. The mere taking a license does not estop the licensee denying the validity of a patent. *Mitchell* v. *Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

40. Covenants in a license as to the use or disposal of the products of a patented machine or process, are binding only upon the parties to it, and the public, or a purchaser of the products, cannot be compelled to notice or regard such agreements, or the rights conferred or reserved by them. *The Washing Machine Co.* v. *Earle*, 2 Fisher, 205.—GRIER, J.; Pa., 1861.

41. A stranger purchasing the product from one licensed to use the process, need look no further, and may use it for his own purposes without inquiring for or regarding any private agreement of licensers not to compete with one another. *Ibid.*, 206.

42. Where a patentee granted to another the exclusive right to make and sell his patented invention, within a certain territory, for which he was to pay a certain sum for each machine so made and sold, but the patentee reserved the right of sending machines of his own manufacture into such territory, *Held*, that such contract was not an assignment of the patentee's interest in the patent in such territory, but a mere grant or license to make and sell the article therein; and that an action was rightly brought in the name of the patentee, and not in the name of the grantee. *Hussey* v. *Whiteley*, 2 Fisher, 123.—LEAVITT, J.; Ohio, 1861.

## B. RECORDING, AND TRANSFER OF.

1. An assignment of a particular interest in a patent-right, or a conveyance of a right to use an invention within a limited territory, is not required to be recorded. *Stevens* v. *Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

2. Under § 11 of the patent act of 1836, a mere license, or a grant of a right or privilege under a patent, to be used concurrently with the patentee, or any other grantees under him, and which is not an exclusive right, need not be recorded. *Brooks* v. *Byam*, 2 Story, 541, 542.—STORY, J.; Mass., 1843.

3. And it is not necessary that a subsequent purchaser of the patent should have notice of such a license. *Ibid.*, 543.

4. Whether the entirety of a license or privilege is capable of being assigned, even though the word "assigns" may be used, if it was intended as a personal privilege; *query*. *Ibid.*, 544. [And see *post* 15.]

5. But though a right or license may be transmissible, it seems not to be ap-

portionable, unless it is very clear from the instrument that such was the intent and meaning of the parties. *Ibid.*, 544, 551.

6. Every conveyance of such sort must, however, be decided upon its own terms and objects, according to the true intent and meaning of the parties to it. *Ibid.*, 550.

7. In this case, *Held*, that the license was an entirety, and incapable of division, or of being broken up into parts, in the possession of different persons. If assignable, the assignment must be of the entirety of the license to the assignee, and it cannot be apportioned among different persons in severalty. B. could not, therefore, sell to C. a right to manufacturing matches, to the amount of *one* right, embracing *one* person. *Ibid.*, 552.

8. The right or license to use a machine is assignable to a third person. *Woodworth* v. *Curtis*, 2 Wood. & Min., 527.—WOODBURY, J.; Mass., 1847.

9. A machine, and the right to use it, is personal property more particularly than a mere patent-right; and has all the incidents of personal property, making it subject to pass by sale. *Ibid.*, 527.

10. Where a machine, or right to use a machine, is sold before the original patent has expired, the use of such machine then in operation, may be continued until it is worn out or destroyed. *Ibid.*, 528.

11. The right to use such particular machine, and the machine, after the term expires, may pass by sale, devise, levy, or assignment of an insolvent's effects. *Ibid.*, 530.

12. Where one licensed to run a patented machine, sells such machine, the license to run does not necessarily pass with such machine. *Wilson* v. *Stolley*, 4 McLean, 278.—McLEAN, J.; Ohio, 1847.

13. A license to use a patented machine may be assigned, it not being a mere personal privilege. *Wilson* v. *Stolley*, 5 McLean, 2.—McLEAN, J.; Ohio, 1849.

14. In such case the assignee is bound to perform the conditions of the license; and the same rule applies to the assignee of the licensee. *Ibid.*, 2.

15. The difference is well understood, between licenses which may be assigned or used for others, and those which the licensees could only personally use without being transmissible by them to others. *Troy Iron & Nail Factory* v. *Corning*, 14 How., 216.—WAYNE, J.; Sup. Ct., 1852.

16. A mere license to a party, without having his assigns, or equivalent words to them, showing that it was meant to be assignable, is only a grant of a personal power to the licensees, and is not transferable by him to another. *Ibid.*, 216.

17. 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, which obligation is the consideration upon which the license is granted, the licensee or his assigns must perform such obligations, and if he will not, an injunction will be granted to restrain him from any further right to use the patent. *Goodyear* v. *Day & Congress Rub. Co.*, 3 Blatchf., 455.—INGERSOLL, J.; N. Y., 1856.

18. Where D. had an exclusive license to use the patent of G. for a particular purpose, covenanting not to use it for other purposes, and to pay a speci-

fied tariff for such use, and C. took an assignment of such license, *Held*, 1. That C. took the license subject to the obligation to pay the specified tariff on what he should make under it; and 2. That the bill was sufficient to compel C. to pay to G. the tariff due for his use of the license, or be enjoined from its use. *Ibid.*, 455.

## C. Forfeiture of; Actions respecting.

1. A person agreed with a patentee to pay him a certain sum on every patented article manufactured by him. The patentee brought his action for money had and received; *Held*, that the jury might infer the receipt of money from the fact of the sale of the article. *Stanley* v. *Whipple*, 2 McLean, 43.—McLean, J.; Ohio, 1839.

2. And although the contract was special, yet if it appear to be executed, and not open and subsisting, it is a well settled principle that the plaintiff may recover on the general count for money had and received. *Ibid.*, 44.

3. The bringing of an action to recover the arrears due under a license to use a patent, does not reaffirm the license after default and notice of the termination of the license. *Armstrong* v. *Hanlenbeck*, 3 N. Y. Leg. Obs., 45.—Betts, J.; N. Y., 1844.

4. And the patentee may have an injunction to restrain the further use of the privilege, notwithstanding such action and a judgment thereon, as it is not a waiver of the forfeiture. *Ibid.*, 445.

5. The non-payment of the agreed consideration, as stipulated, works a forfeiture of the license. *Ibid.*, 445.

6. Under the laws prior to 1836, a license or assignment expired with the limitation of the original patent, unless it was expressly in terms so granted as to be applicable to any renewal of the patent afterward. *Washburn* v. *Gould*, 3 Story, 135.—Story, J.; Mass., 1844.

7. If a license to use a patented machine be conditional, such conditions must be performed, or there is no right to the use. *Brooks* v. *Stolley*, 3 McLean, 526, 528.—McLean, J.; Ohio, 1845.

8. The use of the machine under such circumstances is an infringement, and may be enjoined. *Ibid.*, 528.

9. An alleged violation of the contract of license by the patentee or complainant does not give any right of use to the defendant. *Ibid.*, 527.

10. To entitle a licensee to the benefit of the license, it is incumbent on him to do all which he is bound to do; but if he fail in the strict performance by reason of the act of the licenser, he will be equally entitled to the use of the machine as if he had literally and fully performed his part of the contract. *Ibid.*, 528.

11. But if the licensee has failed to perform the conditions of the license, he has no pretence of right to the use of the thing, and has no claim in law or equity either to its use or for damages. *Ibid.*, 528.

12. Where a license was granted to construct and use a patented machine for the consideration of certain notes given by the licensee, with the agreement that in case such notes were not paid, the license should be void; *Held*, that it was optional with the grantor to enforce the collection of the notes, or treat the rights of the licensee as forfeited under the stipulation, and an injunction was granted to restrain the

further use, unless the notes were paid. *Woodworth* v. *Weed*, 1 Blatchf., 165, 166.—NELSON, J.; N. Y., 1846.

13. The stipulation is to be treated as a double security given by the licensee to the grantor for the payment of the consideration money. *Ibid.*, 166.

14. To an action of covenant upon an agreement which granted a license to make and vend a patented article, the licensee agreeing to keep an account of the articles manufactured, and to pay a fixed price per pound on those sold, it is no defence that the patent is invalid. *Wilder* v. *Adams*, 2 Wood. & Min., 331.—WOODBURY, J.; Mass., 1846.

15. But if the covenant was against public policy, or where the plaintiff had acted fraudulently in taking out the patent, it seems such a defence would be admissible. *Ibid.*, 332, 336.

16. A forfeiture of a license may be enforced according to its terms by reason of the abandonment or neglect of the licensee. *Wilson* v. *Stolley*, 5 McLean, 2.—MCLEAN, J.; Ohio, 1849.

17. Where the license contains a provision that a failure to act under it for a certain time should be an abandonment, a formal notice from the licenser is not necessary, that he considers such a failure an abandonment. *Ibid.*, 2.

18. A contract to use a patented machine during the continuance of the patent, and to pay therefor a fixed proportion of the value of the fuel saved thereby, will not support an action until the expiration of the patent. *Wash., Alex., &c., Steam Pack. Co.* v. *Sickles*, 10 How., 441.—GRIER, J.; Sup. Ct., 1850.

19. It is an entire contract; but if the defendants had agreed to pay by instalments at the end of certain times, an action would lie for every breach, as occurring. *Ibid.*, 441.

20. If the conditions of a license are violated, strictly all right and title under it are forfeited, and an injunction will issue to restrain the further use of the thing granted, if such injunction is applied for during the violation. *Wilson* v. *Sherman*, 1 Blatchf., 538, 540.—NELSON, J.; N. Y., 1850.

21. But such an injunction will not be granted if the violation has been discontinued, and if it appears the licensee was guilty of the violation under misapprehension of his rights under the license. *Ibid.*, 540.

22. Upon the breach of the conditions of a license, the patentee or licenser has a right to avoid the contract and be remitted to his original rights, and prosecute the licensee for an infringement of the patent. *Woodworth* v. *Cook*, 2 Blatchf., 160.—NELSON, J.; N. Y., 1850.

23. In such case also the licensee is remitted to his original rights and position, as the contract must be avoided altogether, if at all. It cannot be obligatory upon one party and not upon the other. *Ibid.*, 160.

24. Where the party had the right to use two machines under a right acquired during the original term, and afterward took a license under an extended term, and upon an alleged non-performance of the conditions of such license, an action for an infringement was brought by the patentee, or his assignee, *Held*, that the licensee, under the decision on *Wilson* v. *Rosseau*, 4 How., 646, could set up a right to continue the use of such two machines, as having been in use when the first term of the patent expired. *Ibid.*, 161.

25. Where a patentee, G., gave to a person, D., an exclusive right or license

to use his, G.'s, patented invention, for a certain consideration or tariff, G. agreeing, however, to take up and cancel all other licenses granted by him, and there being a covenant between G. and D., that in the event of others claiming grants and using such invention, and thereby impairing the profits which would accrue to D. that then such tariff should cease, *Held*, in an action of covenant for non-payment of such tariff, and other non-compliances, that it was a good defence that others used the invention and impaired the right of D., and that it was of no consequence whether G. was unable to restrain other parties from such use, or whether it was to his advantage or not to do so. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1850.

26. The granting of a new license by the owner of a patent, to a second person to make and vend a patented article within a certain territory, after he had granted a prior and exclusive license to another person for the same territory, is no bar to an action brought on the first contract or license, to recover the amount agreed by it to be paid for machines manufactured under such contract, but may be available by way of recoupment of damages. *Pitts* v. *Jameson*, 15 Barb., 317.—JOHNSON, J.; N. Y., 1853.

27. Where a licensee undertakes to use a patent without paying for it the amount specified in the license, equity will so far enjoin him—whether the license thereby becomes voidable at law or not—that unless he will pay he shall not be allowed to use. *Day* v. *Hartshorn*, 3 Fisher, 42.—PITMAN, J.; R. I., 1855.

28. G., a patentee gave an exclusive license to D., to use his patent for a specified purpose only, D. covenanting not to use it for any other purpose, and to pay a specified tariff for such use. D. used the patent for other purposes. G. then sued D. in New Jersey to restrain such use, and obtained a decree and an order for an accounting. After such decree was rendered, C. with a knowledge of it took from D. an assignment of his license and went on making the article permitted by it, but refused to pay to G. what was due from D. on account of tariff fees under the license, or what was due by D. for violating the patent. G. then filed a bill against D. and C. to set aside the assignment of the license as void, or that it be permitted to stand only on the condition that C. pay to G. what D. owed for tariff fees, and for the breach of the covenants of the license. *Held*, on demurrer: 1. That G. had no lien on the agreement or license to secure the tariffs stipulated therein, and that therefore the bill set up no title or equity as against C. as respects the amount due from D. at the time of the assignment of the license. 2. That the unpaid tariffs due from D. to G. afforded no ground for enjoining C. from acting under the license, and that it was not material as respects G. whether the assignment was fraudulent or not, and that the bill could not be sustained as against C. to aid in enforcing the decree against D., or to collect from D. the amount of tariff which was due from him at the time of the assignment of the license to C. *Goodyear* v. *Day & Cong. Rub. Co.*, 3 Blatchf., 453.—INGERSOLL, J.; N. Y., 1856.

29. A suit brought to enforce the covenants of a license granted under a patent is not a case arising under a law of the United States, so as to confer jurisdiction upon the Circuit Courts to take cognizance of it. *Ibid.*, 454.

30. The mere performance of such covenants would be a violation of the rights of a patentee as secured by the covenants, but not as secured by any law of the United States. *Ibid.*, 454.

31. If a licensee use the thing patented beyond the limits of the license or grant, or in a way not authorized thereby, then there is a violation of the rights secured to the patentee. *Ibid.*, 454.

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## LIMITATIONS.

**A.** Of Applications for Patents..... 469
**B.** Of Appeals to Justices' Circuit Court..... 469
**C.** Of commencing Actions..... 469

### A. Applications for Patents.

1. The statute does not limit any time in which the inventor must apply for a patent, nor does it declare a forfeiture by reason of any delay. Delay therefore is unimportant, unless it amounts to evidence of abandonment of the claim, and that is proper matter for the consideration of a jury. *Hildreth* v. *Heath*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1841.

2. There is no act of Congress that makes delay in taking out a patent fatal to the 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. *Allen* v. *Blunt*, 2 Wood. & Min., 141.—Woodbury, J.; Mass., 1846.

3. It is wholly immaterial to the validity of the patent, whether an invention was long antecedent to the application for a patent, or directly preceding it. *Wilder* v. *McCormick*, 2 Blatchf., 33.—Betts, J.; N. Y., 1846.

4. Before a patent is granted, there is no law that requires the first inventor to disclose his invention within any limited time, nor is there any limitation unless the lapse of time is sufficient to show an abandonment, which is a question for a jury. *Perry* v. *Cornell*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1847.

5. If an inventor unnecessarily defer his application for a patent, and suffer his invention to go into use, except for the purpose of perfecting it, and testing its utility by proper experiments, and beyond what he has reason to believe necessary for these purposes, his patent is void. *Winans* v. *Schenec. & Troy R. R.*, 2 Blatchf., 291, 300.—Nelson, Conkling, JJ.; N. Y., 1851.

6. No particular time is limited by the statute, within which an inventor must make application for a patent, yet it ought to be done within a *reasonable time*. What is or what is not a reasonable time, depends on the circumstances of each case. *Ellithorpe* v. *Robertson*, MS. (App. Cas.)—Morsell, J.; D. C., 1858.

### B. Of Appeals to Justices' Circuit Court.

1. There is no limitation of time as to an appeal from a decision of the Commissioner of Patents to the justices of Circuit Court. *Janney's Appeal*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1847.

### C. Of commencing Actions.

1. There is no act of Congress limiting the time in which a suit may be brought for an infringement of a patent-right. *Parker* v. *Hallock*, MS.—Grier, J.; Pa., 1858.

2. The *two* years' limitation in which to bring suits for penalties, prescribed in the Crimes act of 1790, is repealed by implication by § 4 of the act of 1839, which enacts that suits for penalties or forfeitures must be brought within *five* years from the time when the penalty or forfeiture accrued. *Stimpson* v. *Pond*, 2 Curt., 503, 504.—CURTIS, J.; Mass., 1855.

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## LOST ARTS.

See ARTS, LOST.

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## MACHINE.

**A.** WHEN PATENTABLE; PRINCIPLES OF; IDENTITY OF..... 470
**B.** PRINCIPLES OF, AND MODES OF APPLICATION; HOW EXPLAINED AND DESCRIBED 472

### A. PATENTABILITY OF; PRINCIPLES OF; IDENTITY OF.

See also FORM; IMPROVEMENT; INVENTION; A., E.

1. If the principles of a machine are new, either to produce a new or an old effect, the inventor is entitled to the exclusive right of the whole machine. The intrinsic difficulty is to ascertain in complicated cases, the exact boundary between what was known and used before, and what is new in the *mode of operation*. *Whittemore* v. *Cutter*, 1 Gall., 480, 481.—STORY, J.; Mass., 1813.

2. By the principles of a machine (as these words are used in the statute) is not meant the original, elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar manner or device of producing any given effect. *Ibid.*, 481.

3. The opinions of skilful witnesses, whether the principles of two machines are the same, are competent evidence in a patent cause. But care should be taken to distinguish what is meant by a principle, the true, legal meaning of which, in respect to a machine, is, the peculiar structure or constituent parts of such machine. And in this view the question may be very properly asked, in cases of doubt and complexity, of skilful persons, whether the principles of two machines be the same or different. *Barrett* v. *Hall*, 1 Mas., 470.—STORY, J.; Mass., 1818.

4. The principles of two machines may be the same, although the form or proportions may be different. They may substantially employ the same power in the same way, though the external mechanism be apparently different. On the other hand, the principles of two machines may be very different, although their external structure may have great similarity in many respects. *Ibid.*, 471.

5. The meaning of the terms "an improved machine," or "an improvement on a machine," is substantially the same. *Ibid.*, 476.

6. The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded together. *Evans* v. *Eaton*, 3 Wheat., 516.—MARSHALL, Ch. J.; Sup. Ct., 1818.

7. There is no substantial difference between a patent for an improvement on a machine, or a patent for an improved machine. *Ibid.*, 517.

8. A machine, and an improvement

on a machine, or an improved machine, must not be confounded: a grant of the exclusive use of an improvement in a machine, principle, or process, is not a grant of the improvement only, but the improved machine: an improvement on a machine and an improved machine are the same. *Whitney* v. *Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

9. Principle, in machines, is not a new mechanical power—none such have been discovered for centuries. That is a principle, which applies, modifies, or combines mechanical powers to produce a certain result. *Smith* v. *Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

10. When a patent is obtained for *parts* of a machine involved with other parts which may have been used before, it is essential that the *new parts* should be so distinctly pointed out that the claim may not cover any parts that are old. *Blake* v. *Sperry*, 2 N. Y. Leg. Obs., 255.—JUDSON, J.; Ct, 1843.

11. A machine, in order to give a party a claim to a patent therefor, must be substantially new. The machine must be new, not merely the purpose to which it is applied. *Bean* v. *Smallwood*, 2 Story, 411.—STORY, J.; Mass., 1843.

12. The principle of a machine means the operative cause by which a certain effect is produced. If a machine is formed by a combination of certain mechanical powers, such combination of these powers is the principle of the machine. When a similar effect is produced by a combination of the same mechanical powers, though the machines may be somewhat different in their structure, in principle they are the same. *Brooks* v. *Bicknell*, 3 McLean, 451.—MCLEAN, J.; Ohio, 1844.

13. A machine is patentable only when it is substantially new. *Tyler* v. *Deval*, 1 Code Rep., 30.—MCCALEB, J.; La., 1848.

14. The mere application of an old machine to a new process is not patentable. *Ibid.*, 30.

15. The word *principle* means the operative cause, by which a certain effect is produced; the combination of certain mechanical powers; the mode of operation. Upon this question of principle we may arrive at a correct conclusion by ascertaining what is the result which the invention is designed to produce. Whatever is essential to produce the appropriate result of a machine, independent of its mere form, is a matter of principle. *Olcott* v. *Hawkins*, 2 Amer. Law Jour., N. S., 329.—MILLER, J.; Wis., 1849.

16. The word principle, as applied to mechanics, is where two machines or things are made to operate substantially in the same way, so as to produce the same result; as where any of the mechanical powers, the lever, screw, wheel, &c., are used to accomplish certain purposes, the same powers being used in a somewhat different form, to do the same thing, will not be a difference in principle. *Roberts* v. *Ward*, 4 McLean, 566.—MCLEAN, J.; Mich., 1849.

17. Whether the mechanical instruments be larger or smaller, whether their action be horizontal or vertical, the principle is the same. *Ibid.*, 566.

18. Machines may be regarded merely as devices, by the instrumentality of which the laws of nature are made applicable and operative to the production of a particular result. *Parker* v. *Hulme*, 7 West. Law Jour., 422.—KANE, J.; Pa., 1849.

19. The principle of a machine is the particular means of producing a given result by a mechanical contrivance.

Mere colorable differences in form and structure do not make a difference in principle. *Parker* v. *Stiles*, 5 McLean, 63.—LEAVITT, J.; Ohio, 1849.

20. Invention, as it respects machines, is any *new arrangement or combination* of machinery, whether of old or new parts or materials, producing in its arrangement and combination a useful result. *McCormick* v. *Seymour*, MS. —NELSON, J.; N. Y., 1851.

21. 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. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

22. A new process is usually the result of discovery; a machine of invention. *Ibid.*, 268.

23. One may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a labor-saving machine, by which the operation or process may be performed, and each may be entitled to a patent. *Ibid.*, 268.

24. A patent cannot be for the function or abstract effect of a machine, but only for the machine itself. *Ibid.*, 268.

25. 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. In such a case, the patent is not for an abstract principle, but for the particular application of the principle which the patentee professes to have made. *Wintermute* v. *Redington*, 1 Fisher, 247.—WILSON, J.; Ohio, 1856.

26. By the term "principle" of a machine is understood its mode or manner of operation, and hence there may be two structures widely different in appearance or dimensions, and yet identically the same in principle. *Latta* v. *Shanck*, 1 Fisher, 470.—LEAVITT, J.; Ohio, 1859.

27. Principle is often applied to a machine to describe its movements and effects. *Le Roy* v. *Tatham*, 22 How., 139.—MCLEAN, J.; Sup. Ct., 1859.

28. A new machine, which accomplishes the same end as a former one, but by substantially different means, is patentable. *Eames* v. *Cook*, 2 Fisher, 151.—SPRAGUE, J.; Mass., 1860.

29. The principle of a machine has reference to its mode of operation, not to any abstract principles involved in its proportions or motion. *Judson* v. *Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

## B. PRINCIPLES OF AND MODES OF APPLICATION, HOW EXPLAINED AND DESCRIBED.

1. The patent act of 1793 does not limit the inventor to one single mode or one single set of ingredients to carry into effect his invention. He may claim as many modes as he pleases, provided always that the claim is limited to such as he has invented, and as are substantially new. *Ryan* v. *Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

2. And § 3 of the act requires, in the case of a machine, that the inventor shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions. And the same enactment exists in § 6 of the act of 1836. *Ibid.*, 521.

3. This section seems clearly to show that a patentee may lawfully unite in

one patent all the modes of applying his invention contemplated, and all the different sorts or modifications of machinery by which it may be applied, and if such were new, the patent would reach them all. *A fortiori*, this rule is applicable where each of the machines is but an improvement or invention conducing to the accomplishment of the same general end. *Wyeth* v. *Stone*, 1 Story, 292.—STORY, J.; Mass., 1840.

4. Under § 6 of the act of 1836, requiring the inventor "to explain the several modes in which he has contemplated the application of the distinguishing principle or character of his invention," it is not incumbent to suggest all the possible modes by which the invention may be varied and yet the effect produced. It is sufficient to state the modes which he contemplates to be the 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, 440, 441.—STORY, J.; Mass., 1843.

5. Where, therefore, an inventor, in a patent for "a new and useful improvement in the ribs of the cotton gin," claimed "the increasing the depth or space between the upper and lower surface of the rib, whether this be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the form," *Held*, that there was no want of accuracy or sufficiency of description, nor any claim broader than the invention. *Ibid.*, 433, 435, 441.

6. The act of Congress (act of 1836, § 6) not only requires the patentee to "particularly specify and point out his invention and discovery," but also to explain the several modes of its application. The court does not require as strict a compliance in these respects as was once the practice, but the claim to novelty must be clearly described somewhere in the specification, and it must be made in such plain terms that it can be readily understood with "reasonable certainty." *Hovey* v. *Stevens*, 3 Wood. & Min., 27, 28.—WOODBURY, J.; Mass., 1846.

7. Whether the discoverer of a new and important truth can secure to himself all the mechanical means of carrying it into effect, he can only do so in a case in which he clearly sets forth and claims such new truth to be his discovery and exclusive right. *Brooks* v. *Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

8. When a patent is for a machine, the specification must explain the principle of it, and also the several modes in which the inventor has contemplated the application of that principle. *Sickles* v. *Glen. Manuf. Co.*, 1 Fisher, 238.—GRIER, J.; N. J., 1856.

9. Under § 6 of the act of 1836, it is the duty of an inventor to describe in his specification the several different modes, or devices, or modifications known to him of his invention. *Sargent* v. *Carter*, 11 Mo. Law Rep., 655.—CURTIS, J.; Mass., 1858.

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## MANUFACTURE.

1. A new manufacture, as the use of a new composition, as porcelain to form knobs for doors, &c., and which results in a new and useful article, is the proper subject of a patent, though the means (the shank and spindle) employed to adapt the new composition to a useful purpose are old or well known. *Hotch-*

*kiss* v. *Greenwood*, 11 How., 265.—NELSON, J.; Sup. Ct., 1850.

2. But if porcelain knobs were not new, and the same kind of shanks and spindles had been used with other knobs, the use or substitution of porcelain instead of other material in a combination with such shanks, &c., will not entitle the manufacturer to a patent, even though such material may be better adapted for the purpose. *Ibid.*, 266.

3. A new property discovered in matter, when practically applied in the construction of a useful article of commerce or manufacture, is patentable; but the process through which the new property is developed and applied must be stated with such precision as to enable a mechanic to construct and apply the necessary process. *Le Roy* v. *Tatham*, 14 How., 175.—MCLEAN, J.; Sup. Ct., 1852.

4. Where the subject matter is a manufacture, the question as to infringement will be, whether in reality and substance the defendant has availed himself of the invention of the patentee; a mere colorable variation in the process or application should not be allowed to protect a defendant. *Rich* v. *Lippincott*, 2 Fisher, 5.—GRIER, J.; Pa., 1853.

5. A *mere* analogous use is not patentable; but where a new or improved manufacture is produced by new contrivances, combinations, or arrangements, a new principle may be constituted, and the application or practice of old things will be new also. *Smith, H. L., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

6. In the result the usual test is, whether the production of the article is as good in quality at a *cheaper rate*, or better in *quality* at the same rate or with both these consequences *partially combined*. *Ibid.*

7. The discovery that a refuse or worthless material can be advantageously applied to a new purpose, if that result is owing to the presence in such refuse material of certain ingredients or substances, which have before been used for the same purpose, is not a patentable invention. It is not a new manufacture. *Maule, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

8. There is a wide difference between the invention of a new method or process by which a known fabric, product, or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance, or manufacture, having qualities never found to exist together in any other material. *Goodyear* v. *The Railroads*, 2 Wall., Jr., 360.—GRIER, J.; N. J., 1853.

9. 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. *Ibid.*, 361.

10. If a patentee be the inventor or discoverer of a new manufacture or composition of matter, not known or used by others before his discovery thereof, 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. *Ibid.*, 362.

11. Where an invention was described as a "process," but the description of the "manner and process of making the same" showed clearly that the invention was not merely an improved method or process, but a new product, fabric, or manufacture; it was held, in an action

for infringement by using the product, that the patentee had a right to prohibit the sale or use of the composition, as the product and process were both new. *Ibid.*, 365.

12. Where a result is a new and valuable article of manufacture, this will afford ground to presume invention. *Woodruff, Ex parte*, MS. (App. Cas.) —MORSELL, J.; D. C., 1859.

13. Where a patent was claimed for an alleged combination of certain parts in a new article of manufacture, tinted envelopes, but there was no new principle in the combination itself, and it was admitted that there was nothing new in the means or process, and there was nothing in the results very valuable to commerce or trade, it was held that there was not sufficient evidence of invention to warrant the granting of a patent. *Orr, Ex parte*, MS. (App. Cas.) —MORSELL, J.; D. C., 1859.

14. A result or effect is not patentable, but where a result is in a greatly improved manufacture, or development of some new and useful principle—or where the result is substantially different from what has been effected before, it may become the test of invention, and from which invention may be inferred. *Treadwell* v. *Fox*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

15. Where the claim was for a *method* of forming hoop-skirts by applying the hoops and tapes to each other while they are supported in the relative positions they are to occupy in the finished skirt, for which purpose a *former* for each shape of skirt was necessary, *Held*, that the claim was not for the *former*, or apparatus as such, but that the inventor had a right to claim the use of the apparatus as incidental and subsidiary to the practical purpose of the idea constituting his invention, and that therefore it was immaterial that the apparatus or *former* was old. *Mann, R. J., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

16. A party cannot claim a patent for a new manufacture, merely because he has applied an existing manufacture to a new use. He must have invented a *new* fabric or manufacture of merchantable value. *Pender, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

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## MANUSCRIPTS.

See also LETTERS.

1. 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., 657.—MCLEAN, J.; Sup. Ct., 1834.

2. There can be no doubt that the rights of an assignee of a manuscript would be protected by a Court of Chancery. *Ibid.*, 661.

3. This is presumed to be the "copyright" recognized in § 1 of the act of 1790, and which was intended to be protected by its provisions. And this protection was given, as well to books published under such circumstances, as to manuscript copies. *Ibid.*, 661.

4. Congress, by the act of 1790, did not legislate in reference to existing rights. Instead of sanctioning an existing right, it created it. *Ibid.*, 661.

5. There remains in an author, notwithstanding the copyright by statute, a common law title to his works before

publication. *Jones* v. *Thorne*, 1 N. Y. Leg. Obs., 409.—McCoun, V. Chan.; N. Y., 1843.

6. At common law, independently of the statute, the author of a manuscript might obtain redress against one who had surreptitiously gained possession of it. *Bartlette* v. *Crittenden*, 4 McLean, 301.—McLean, J.; Ohio, 1847.

7. On general equitable principles, relief may also be given, under like circumstances, by a Court of Chancery. *Ibid.*, 301.

8. Students or others who have been permitted to take copies of manuscripts, have no right to a use which was not in the contemplation of the author and themselves when such consent was given. Nor can they, by allowing others to copy them, give a greater license than was vested in themselves. *Ibid.*, 303.

9. They have therefore no right, either of themselves or by a sale to others, to print such manuscripts; and an injunction will lie to prevent such act. *Ibid.*, 303, 305.

10. An author's rights in a manuscript will be protected, though they may not be complete for publication. *Ibid.*, 305.

11. At common law, the author of a book or other literary property, as letters, has a right to property therein; at least until it has been published with his assent. *Hoyt* v. *McKenzie*, 3 Barb. Ch., 322, 323.—Walworth, Chan.; N. Y., 1848.

12. An author has a common law right in his manuscript, until he relinquishes it by contract or some equivocal act. *Bartlette* v. *Crittenden*, 5 McLean, 36.—McLean, J.; Ohio, 1849.

13. There is a difference in principle between the right to republish a printed work, and the exclusive right of an author to publish his own manuscript *Ibid.*, 37.

14. Manuscripts cannot, without the consent of the author, be seized by his creditors as property. *Ibid.*, 37.

15. The common law protects the right of an author to his manuscript only. *Ibid.*, 38.

16. § 9 of the copyright act of 1831, also protects such right. *Ibid.*, 38.

17. A surreptitious publication of an important part of a manuscript, is equally within the statute as if the manuscript was complete, and the whole of a manuscript need not be printed. *Ibid.*, 39, 40.

18. No length of time will authorize the publication of an author's original manuscript without his consent. *Ibid.*, 42.

19. An author may license the publication of his manuscript. But unless a copyright is secured, the first publication of it will abandon it to the public. *Pulte* v. *Derby*, 5 McLean, 332.—McLean, J.; Ohio, 1852.

20. An author may be said to be the creator or inventor, 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. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 228.—Grier, J.; Pa., 1853.

21. When he has published his book and given his thoughts to the world, he can have no longer an exclusive possession of them. The author's conceptions have become the common property of the public. *Ibid.*, 228.

22. At common law, an author has a right to his unpublished manuscripts the same as to any other property he

may possess; and the act of February 3d, 1831, gives him a remedy by injunction, to protect this right. *Little* v. *Hall*, 18 How., 170.—McLean, J.; Sup. Ct., 1855.

23. The author of an unpublished manuscript has an exclusive property therein, at common law—a right which entitles him to determine for himself whether the manuscript shall be published at all; when this exclusive right is in danger of being violated, a court of equity is bound to prevent the wrong, by an injunction. *Woolsey* v. *Judd*, 4 Duer, 385.—Duer, J.; N. Y., 1855.

24. Such common law right has not been taken away or abridged by the statutes which have been passed for the protection of copyright. Its existence is prior to these statutes, and independent of their provisions. *Ibid.*, 385.

25. The exclusive right of an author in a manuscript yet unpublished, rests upon the same foundation as that which sustains every other species or description of property, as that of a manufacturer, or an artist. *Ibid.*, 386.

26. The exclusive right is a right of property in the words, thoughts, and sentiments, which in their connection, form the written composition which his manuscript embodies and preserves. *Ibid.*, 387.

27. The right to control the publication of a manuscript remains in the author and his representatives, even when the material property has, with his own consent, been vested in another. The gift of a manuscript, unless by express agreement, carries with it no license to publish. *Ibid.*, 387.

28. § 9 of the act of 1831, giving redress for the unauthorized *printing or publishing of manuscripts* operates in favor of a resident of the United States, who has acquired the proprietorship of an *unprinted* literary composition from a non-resident alien author. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—Cadwallader, J.; Pa., 1860.

29. But this section—and which is the only one enabling a proprietor who derives his title from such an author, to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

30. The sole proprietorship of an author's manuscript and of its incorporeal contents, wherever copies exist, is, independently of legislation, in himself and his assigns until he publishes it.—*Ibid.*, 78.

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## MATERIAL OF INVENTION.

1. Whether the mere substitution of one material for another be an invention within the sense of the patent law, may well be questioned; but there being room for doubt, a patent was recommended. *Seeley's Case*, 2 Opin., 52.—Wirt, Atty. Gen.; 1827.

2. The specification need not state of what material, whether wood or iron, every part of a machine should be made. *Brooks* v. *Bicknell*, 3 McLean, 261.—McLean, J.; Ohio, 1843.

3. It is a matter of doubt whether the use of an inferior material for a machine when the patent covers only a superior one, is a legal violation of it. *Aiken* v. *Bemis*, 3 Wood. & Min., 354.—Woodbury, J.; Mass. 1847.

4. Where a patent extends only to the form or parts of the machine as set out, and made of any kind of materials, or saying nothing as to materials, the

right would be violated by a machine of like form. *Ibid.*, 354.

5. But if the patentee chooses to go further, and cover the material of which a part of his machine is made, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. *Ibid.*, 354.

6. Where a patentee claimed a hammer, in a saw-set of wrought iron faced with steel, alleging that he found, upon experiment, that all steel hammers were much more liable to break, and wrought iron ones more durable, and therefore confined his specification to wrought iron ones with steel points, *Held*, in an action for infringement against a person using a hammer wholly of steel, that it was a matter of doubt whether the use of such a hammer was a violation of the patent. *Ibid.*, 354.

7. The use of a material not before used in the same structure or article, as the use of potter's clay in the making of door-knobs, similar knobs having been before made of metal, glass, wood, &c., gives no claim for a patent, even though the article be more valuable than any other of the kind. *Hotchkiss* v. *Greenwood*, 4 McLean, 461.—McLean, J.; Ohio, 1848.

8. But if the material be new, as a compound not before known, made of different ingredients, that may be the subject of a patent. *Ibid.*, 461.

9. The substitution of one material for another, as clay for wood, or metal, in the construction of door-knobs, the spindle and shank being the same as in common use, and the mode of connecting them requiring only ordinary mechanical skill, is not patentable. *Hotchkiss*, v. *Greenwood*, 11 How., 265, 267.—Nelson, J.; Sup. Ct., 1850.

10. The use or employment in an invention or machine, of materials better adapted to the purpose for which it is used than the materials of which before made, and thus producing merely a better and cheaper article, cannot entitle the manufacturer to a patent. *Maynard Exparte*, MS. (App. Cas.)—Merrick, J.; D. C., 1857.

11. The use of new materials in a combination, or a change of form, or the use of one equivalent for another, does not render it new in the sense of the patent law, but some new mode of operation must be introduced. *Forbush* v. *Cook*, 10 Law Rep., 664.—Curtis, J.; Mass., 1857.

12. The making of an instrument of two different substances, as an hydrometer of india-rubber and silver—the bulb being of hard rubber, and the graduated scale of silver or metal—if a useful result or effect is secured thereby, may be the subject of a patent, though such article may have before been made entirely of metal, and also entirely of hard rubber. Such an invention is not a double use. *Adams, Ex parte*, MS. (App. Cas.)—Morsell, J.; D. C., 1860.

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## MECHANICS.

See also Suggestions.

1. The suggestions of the mechanic employed to make the machine, or of others, as to the form or proportions, are not inventions or improvements for which a patent could be obtained, nor can they invalidate the patent for the thing to which they are applied. *Pennock* v. *Dialogue*, 4 Wash., 544.—Washington, J.; Pa., 1825.

2. The suggestions of a mechanic of alterations in the form or proportions of a machine, as designed by the inventor, will not be sufficient to deprive the inventor of the merit of the invention, or affect the validity of the patent, if incorporated within it; nor would it be as to such alterations a discovery which would entitle the mechanic to take out a patent for them. *Watson* v. *Bladen*, 4 Wash., 582.—WASHINGTON, J.; Pa., 1826.

3. 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 mechanician who constructs the machine. *Ibid.*, 582.

4. To constitute an inventor, it is not necessary that he should have the manual skill and dexterity to make the invention. If the ideas are furnished by him, he is entitled to avail himself of the mechanical skill of others, to carry out practically his contrivance. *Sparkman* v. *Higgins*, 1 Blatchf., 209.—BETTS, J.; N. Y., 1846.

5. The exercise in the construction of any article of ingenuity and skill, which is no more than that of an ordinary mechanic acquainted with the business, is not the subject of a patent. *Hotchkiss* v. *Greenwood*, 4 McLean, 461.—MCLEAN, J.; Ohio, 1848.

6. The employment or substitution of one mechanical power in place of another, to accomplish a certain result, is the mere skill of the mechanic, and is not invention. *Blanch. Gun-Stock Fac.* v. *Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

7. Perfecting an invention by superior skill in the mechanical arrangement and construction of the parts, is but the skill of the mechanic, not the genius of an inventor. *Parkhurst* v. *Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

8. The substitution of a mechanical equivalent is not a substantial change. There are many devices in construction that can be made by a skilful mechanic differing very much in appearance, but which are regarded as identical; as producing a result by the use of a lever, or a screw, or obtaining power by a spring, or a weight, or a pulley. *Tatham* v. *Le Roy*, 2 Blatchf., 486.—NELSON, J.; N. Y., 1852.

9. And any change or alteration which is suggested to the skilful operator from the working of a machine, and in the course of its operation—any useful change that may be the result of the practical working of the machine—is clearly a change that belongs not to the operator, but to the original inventor. *Ibid.*, 487.

10. In order to ascertain and determine whether a change in the arrangement and construction of a machine is to be considered as a substantial change or not, the jury must ascertain and determine 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 more than mere mechanical skill and ingenuity. *Ibid.*, 488.

11. A change in 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 invention that is the proper subject of a patent. *Ibid.*, 488.

12. If the invention required no more

skill or ingenuity than that possessed by an ordinary mechanic skilled in the business, there is an absence of inventive faculty, and the patent is invalid. *Teese* v. *Phelps*, 1 McAllis., 52.—McAllister, J.; Cal., 1855.

13. Before a patent can issue, the thing patented must appear to be of such a character as to involve or require "invention" for its production—require the exercise of the genius of an inventor, as contradistinguished from the ordinary skill of a mechanic in construction. *Ransom* v. *Mayor*, &c., 1 Fisher, 258.—Hall, J.; N. Y., 1856.

14. If, with the knowledge had by the public, it required no invention, but simply the ordinary skill and ingenuity of the mechanic to produce the result effected—in other words, if the inventive faculty was not put into action, and was not needed to produce the alleged invention, then the patent is void, because there is no invention to be secured to the patentees. *Ibid.*, 264.

15. If a person conceives the result embraced in the invention, or the general idea of a machine upon a particular principle, and in order to carry his conception into effect, it is necessary to employ manual dexterity, or even inventive skill in the mechanical details and arrangements requisite for carrying out the original conception, in such cases, the first person will be the inventor, and the other the mere instrument through which he realizes the idea. *Wellman* v. *Blood*; *King* v. *Gedney*, MS. (App. Cas.)—Morsell, J.; D. C., 1856.

16. After a principle has been discovered, after a new set of ideas have been struck out by genius and thought, their embodiment in machinery, their adaptation to the working out of practical results contemplated by the inventor, is very much the work of the skilful mechanic. *Sickles* v. *Borden*, 3 Blatchf., 541.—Nelson, J.; N. Y., 1856.

17. In carrying out an 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. *Judson* v. *Moore*, 1 Fisher, 548.—Leavitt, J.; Ohio, 1860.

18. It is difficult to determine where ordinary mechanical skill ends and invention begins. The best *practical principle* is, that where the combination of known elements produces new and useful results to the public not before attained, then the person who discovers and applies the combination is an inventor, within the true intent and meaning of the patent law. *Smith, Ex parte*, MS. (App. Cas.)—Dunlop, J.; D. C., 1860.

19. The remedying of defects in a machine by practical men is the work of the mechanic, of the intelligent operator, and has no connection with invention or discovery. *Ibid.*

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## MEDICINES.

1. An inventor of a newly patented medicine cannot give it the name of an already existing and popular article, but his patent will be withheld until he changes the name; so held, where the inventor of a new medicine desired to call it Anderson's Cough Drops, which was already well known. *Bacon's Case*, 2 Opin. 109.—Wirt, Atty. Gen.; 1828.

2. The fact that a party has a patent giving him the exclusive right to make, and use, and vend a particular medicine,

does not confer upon him the right to practise as a physician, and use such medicines in any particular state, except in conformity with the laws of such state. *Jordan* v. *Overseers Poor*, 4 Ohio, 310.—LANE, J.; Ohio, 1831.

3. A patent authorizing the patentee to make, construct, use, and vend a newly discovered compound of medicine, gives such patentee no right to practice as a physician, even though only administering such patented medicine, without complying with the regulations established by the laws of any state. *Thompson* v. *Staats*, 15 Wend., 396.—NELSON, J.; N. Y., 1836.

4. An inventor of a medicine is not entitled to the exclusive right of compounding and vending it, unless he has obtained a patent therefor; without a patent, the right to make and sell is common to all. *Thompson* v. *Winchester*, 19 Pick., 216.—SHAW, Ch. J.; Mass., 1837.

5. If another person makes such invention of an inferior quality, and sells it and by this means brings the thing into disrepute, the inventor can maintain no action, as there is no infringement of his right, nor recover damages unless the person so making and selling passes off the thing sold as made by the plaintiff. *Ibid.*, 217.

6. Imposition and fraud on the part of such person in passing off his medicines as those of the plaintiff, would be the only ground of action. *Ibid.*, 217.

7. An exclusive right, as an inventor, in a composition, as a medicine, can only be obtained under the patent law, by a compliance with its provisions. *Coffeen* v. *Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind., 1849.

8. The inventor of an unpatented medicine has no exclusive right to make and vend it; but if others make and vend it, they have no right to sell it as the manufacture of the inventor, nor to adopt his label or trade-mark. *Davis* v. *Kendall*, 2 R. I., 569.—GREENE, Ch. J.; R. I., 1853.

9. The discovery of a fact that a given natural substance will, in appropriate methods of administration, produce a particular physiological or pathological effect on the human body, is not a thing patentable under any existing statute. *Morton's Anæsthetic Patent*, 8 Opin., 272.—CUSHING, Atty. Gen.; 1856.

10. The capacity of chemical agents to act medically on the nerves, stomach, or other parts of the body, in such manner, is not patentable. *Ibid.*, 272.

11. The suggestion of the practicability of performing surgical operations under insensibility of the patient produced by anæsthetic agents, is not a patentable invention. *Ibid.*, 272.

12. A medicament capable of being administered in various forms and in different doses, which have to be measured and selected with professional skill, in reference as well to the quantity of the agent as the condition of the patient, so as to produce a particular physiological condition, without collateral injurious consequences, is not a thing patentable, either as a discovery or invention. *Ibid.*, 272.

13. Neither principles, nor abstract philosophical ideas, or the natural functions either of the human body or of matters of nature, are patentable. *Ibid.*, 272.

14. The classification of substances capable of producing insensibility to pain, under the head of *anæsthetic*, as distinguished from narcotic, is not a new discovery. *Ibid.*, 273.

15. The combination of agents of this

class with surgical operations, whether by inhalation or by any other form of administration, internal or external, is not a modern discovery, but is a universal fact, coeval with historic knowledge. *Ibid.*, 273.

16. The production of insensibility in the human system, by anæsthetic agency or otherwise, and the performance of surgical operations during such insensibility, cannot be considered patentable as an art, in contradistinction to a principle, function, or quality of matter. *Ibid.*, 274.

17. No one can have an exclusive right to the manufacture and sale of a medicine, without a patent from the government. *Comstock* v. *Moore*, 18 How., Pr., 422.—SUTHERLAND, J.; N. Y., 1860.

18. Chancery will not interfere by injunction in questions of trade-mark between the venders of patent medicines, being quack medicines; such questions having too little to commend them on either side. *Heath v. Wright*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

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## MISTAKES IN PATENTS.

See also REISSUES OF PATENT.

1. An error of expression, apparent on the face both of the patent and specification, by which no person could be misled, will not invalidate a patent. *Kneass* v. *Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa. 1820.

2. In issuing patents, the Secretary of State, under the act of 1793, 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; and he can exercise no powers but such as are expressly given him. But he must act, in construing the patent laws, in the spirit in which these are made. Hence, if a mistake should be committed in the department of state, it may be corrected, and a new patent be issued, correcting the error, even though such act is not expressly authorized by law. The emanation of the new patent is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States to the inventor. The same step may be taken for the same purpose, if a mistake has been innocently committed by the inventor, and he desires to surrender his patent and have a corrected one issued. *Grant* v. *Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. Where a mistake occurs in the copy of a patent, the Commissioner has the power, and ought to correct it so that it will conform to the patent itself, and the record. *Woodworth* v. *Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

4. It would be the duty of the Commissioner of Patents, to correct a mistake in the letters patent when applied to, and to minute the correction on them, but it is not necessary for him to resign and reseal them; as the signing and sealing are done by the same officer making the correction. *Ibid.*, 260.

5. But it would seem to be necessary to have the Secretary of State sign anew, or assent to the amendment, as he is a distinct officer, and without signing anew or assenting, does not authenticate the amended letters. *Ibid.*, 261.

6. *Semble*, that a patent amended in a

material mistake, cannot operate as to third persons against whom prosecutions were pending, but only for causes accruing after the correction. It may be different if the mistake is entirely clerical. *Ibid.*, 261.

7. If the new letters have been so altered as to become void, whether the surrender of the original letters, and the extensions of them, would not become also void? If so, perhaps the party might amend his bill, and recover on the former letters patent, if not too defective. *Ibid.*, 261.

8. It is not however absolutely necessary that the Secretary should assent to an amendment by actually resigning the patent, or by an entry on the patent itself. But his assent or ratification made afterward and in writing, as by letter, is sufficient. *Woodworth* v. *Hall*, 1 Wood. & Min., 398.—WOODBURY, J.; Mass., Oct., 1846.

9. If the corrections in a patent are merely clerical, it seems they will relate back to the date of the letters patent, unless as to third persons, who had acquired rights as the patent stood before it was corrected; but if new matter is inserted, not originally contemplated, or corrections made not merely clerical, it is questionable whether they could relate back to the date of the letters patent. *Ibid.*, 399.

10. If the correction is such as to render the patent void, the surrender of the former patents would be considered void also: *Query*, Whether in such case recoveries may not be had on the original patent. *Ibid.*, 399.

11. The power to correct mistakes in letters patent, does not belong to the courts, but is confided to the Commissioner of Patents, under § 13 of the act of 1836. The court can only construe the specification and claim as they stand, and determine the legal effect of the claim. *Kittle* v. *Merriam*, 2 Curt., 478. CURTIS, J.; Mass., 1855.

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## MODE, METHOD, OR PROCESS.

See also EFFECT; PRINCIPLE.

1. A patent may be for a mode or method of doing a thing: mode, when referred to something permanent, means an engine or machine: when to something fugitive, a method, which may mean engine, contrivance, device, process, instrument, mode and manner of effecting the purpose. A patent for a method of producing a new thing may apply to the mechanism, a new method of operating with old machinery, or producing an old substance. A patent for a mode or method detached from all physical application, would not refer to an engine or machine, but when referred to the mode of operation, so as to produce the effect, would be considered as for an engine or machine. The words used as mode or method, are not the subject of the patent, it is the thing done by the invention. *Whitney* v. *Emmett*, Bald., 312.—BALDWIN, J.; Pa., 1831.

2. In a patent for an improvement in looms, the claim was for the "connection of the reed with the yard beam, and the communication of the motion from the one to the other, *which may be done as specified*," *Held*, that the invention was limited to the specific machinery and mode of communicating the motion specially described in the specification. If it included *all* modes of communicating the motion, it would be void, as being an attempt to patent an abstract princi-

ple, or for all possible and probable modes whatever of such communication, though invented by others, and substantially different from the mode described by the patentee. *Stone* v. *Sprague*, 1 Story, 271, 272.—STORY, J.; R. I., 1840.

3. He who produces an old result by a new mode or process, is entitled to a patent for the mode or process. But he cannot have a patent for a result merely, without using some new mode or process to produce it. *Howe* v. *Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

4. But the application of an old process to the manufacture of an article to which it had never before been applied, is not a patentable invention. There must be some new process, or some new machinery used, to produce the result. *Ibid.*, 194.

5. A patent cannot be for a principle, but must be for the machine, mode, or manufacture to carry out the principle, and reduce it to practice. The principle thus becomes the *modus operandi*, and rests in the mode adopted to accomplish certain results. *Smith* v. *Downing*, 1 Fisher, 70.—WOODBURY, J.; Mass., 1850.

6. It is well settled that a patent cannot cover a new principle, without reference to any mode or method of enforcing it. *Ibid.*, 70.

7. The plaintiff's invention and patent was for a squeezer, so called, for converting puddler's balls into blooms, and rolled the balls between reciprocating tables or plates, or between a revolving cylinder and a stationary curved segmental trough with stationary flanges. The defendant's machine compressed the ball between a rotating cam, and two small rotating cylinders beneath it; *Held*, that plaintiff's patent was for a new process, mode, or method of converting puddler's balls into blooms, by continuous pressure and rotation between converging surfaces, and that the defendant's machine was an infringement upon it, if it converted such balls into blooms by continuous pressure and rotation between converging surfaces, although its mechanical construction and action might be different. *Burden* v. *Corning*, MS.—CONKLING, J.; N. Y., 1850.

8. An exclusive right cannot exist in a new power, should one be discovered, as steam, electricity, or any other power of nature. In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. The right of the inventor is secured against all who use the same mechanical power, or one substantially the same. *Le Roy* v. *Tatham*, 14 How., 175, 176.—MCLEAN, J.; Sup. Ct., 1852.

9. A process *eo nomine*, is not the subject of a patent, under our laws. It is included under the general term "useful art." And an art may require one or more processes of machines in order to produce a certain result or manufacture. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

10. The term *machine* includes every mechanical device or combination of mechanical powers, or devices, to perform some function, and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes,

methods, or operations, are called *processes*. *Ibid.*, 267.

11. A new process is usually the result of discovery; a machine, of invention. *Ibid.*, 267.

12. The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, &c., are usually carried on by processes, as distinguished from machines. *Ibid.*, 267.

13. One may discover a new and useful improvement in such a process, irrespective of any particular form of machinery, or mechanical device. And another may invent a labor-saving machine, by which the operation or process may be performed, and each be entitled to a patent. *Ibid.*, 268.

14. It is when the term process is used to represent some means or method of producing a result that it is patentable, and it will include all means or methods which are not effected by mechanism or mechanical combinations. *Ibid.*, 268.

15. The term process is often used, however, in a more vague sense, as when we say a board is undergoing the process of being planed, grain of being ground, iron of being hammered or cooled, in which it cannot be the subject of a patent. *Ibid.*, 268.

16. In this use of the term, it represents the function of a machine, or the effect produced by it on the material subjected to its action. *Ibid.*, 268.

17. It is by not distinguishing between the primary and secondary sense of the term "process" that error is likely to arise. *Ibid.*, 268.

18. A patentee cannot have a patent for an exclusive use of a process, as "the motive power of electro-magnetism, *however developed*, for marking characters at a distance." His patent must be confined to the manner and process described and invented by him. *O'Reilly* v. *Morse*, 15 How., 112–120.—TANEY, Ch. J.; Sup. Ct., 1853.

19. A patent cannot be for an effect produced distinct from the process or machinery necessary to produce it. *Ibid.*, 120.

20. There is 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 and better way, and the discovery of a new compound, substance, or manufacture. 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. *Goodyear* v. *Railroads*, 2 Wall, Jr., 360, 361.—GRIER, J.; N. J., 1853.

21. The question of infringement would depend also upon different conditions. Where only the process was protected, every other person would be at liberty to devise any different process for effecting the same purpose; where both process and product were protested, no one could, by varying or improving the mode or process of production, rob the patentee of his franchise. *Ibid.*, 361.

22. A patent for a discovery of a new and improved process, grants nothing but the exclusive right to use the process; and the sale or use of the product is no violation of such exclusive right. *Ibid.*, 362.

23. In order to constitute patentable novelty or utility in a *process*, it must appear that the result produced was an improvement in the trade and for the public good or advantage, by the manufacture either of a new article, or a better article, or a cheaper article to

the public, than that produced by the old method. *Jones* v. *Wetherill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

24. The terms "*improvement in the trade*," as applicable to the law of patents, should be considered in a commercial sense, and as meaning, of the article, as good in quality, and at a cheaper rate, or better in quality at the same rate, or with both these consequences partially combined, leading to a cheaper production. *Ibid.*

25. In this class of cases, *result* is considered *all* important; there must, however, be evolved a principle such as will *regularly*, not merely *occasionally*, produce a like effect. *Ibid.*

26. A patent may be granted for a new method or means of producing an old result. *Heinrich* v *Luther*, 6 McLean, 348.—MCLEAN, J.; Ohio, 1855.

27. Where any new contrivances, combinations, or arrangements are made use of in machinery, although the chief agents are known, such contrivances, combinations, or arrangements may constitute a new principle, and then the application or practice will be new also. In such 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 Fisher, 246.—WILSON, J.; Ohio, 1856.

28. Under § 18 of the act of 1836, the assignees and grantees of a right to use a patented process are continued in the right to use it during an extension of the patent, equally with the assignees and grantees of a right to use a patented machine.—*Day* v. *Union Rub. Co.*, 3 Blatchf., 503.—HALL, J.; N. Y., 1856.

29. Where the claim was for a *method* of forming hoop-skirts by applying the hoops and tapes to each other, while they are supported in the relative positions they are to occupy in the finished skirt, for which purpose a *former* for each shape of skirt was necessary, *Held*, that the claim was not for the *former*, or apparatus, as such, but that the inventor had a right to claim the use of the apparatus as incidental and subsidiary to the practical purpose of the idea constituting his invention, and that therefore it was immaterial that the apparatus or *former* was old. *Mann. R. J., Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

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## MODELS.

1. It seems a model cannot be referred to and used in connection with the specification and drawings, to make a machine, and thus determine the sufficiency of the patent. *Grant* v. *Mason*, 1 Law Int. & Rev., 23, 25.—THOMPSON, J.; N. Y., 1828.

2. Under the word patent, used in reference to the description of the thing patented, is included the patent, the specification attached to it, and the model and drawing, all of which are to be taken together, as making up the description. *Whitney* v. *Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

3. On a motion for an injunction, the exhibition of models like which the parties constructed their respective machines, will not suffice to turn the scale either way, without an examination into the detail of the construction, combination, and operation of all their parts by competent mechanics. *Cooper* v. *Matthews*, 8 Law Rep., 417.—BALDWIN, J.; Pa., 1842.

4. In an action of infringement, the plaintiff is not bound to produce models

of his patented articles. The defendant may, however, properly obtain them, and they are competent evidence. *Hathaway* v. *Roach*, 2 Wood. & Min., 73.—Woodbury, J.; Mass., 1846.

5. Models and drawings are a part of the letters patent, and may be resorted to for clearer information respecting the invention described in the specification. *Hogg* v. *Emerson*, 6 How., 485.—Woodbury, J.; Sup. Ct., 1847.

6. Models and drawings are to be considered and taken together in explanation of the specification of a patent. *Stephens* v. *Salisbury*, MS. (App. Cas.) —Morsell, J.; D. C., 1855.

7. Models are a species of evidence of all others best calculated to conduct to the truth—evidence superior to and unaffected by the interests or prejudices of partisans, or by the opinions (the reveries they may often be called) of experts. *McCormick* v. *Talcott*, 20 How., 409.—Daniel, J. (Dis. Opin.); Sup. Ct., 1857.

8. No witnesses can testify so clearly and so impartially as do the subjects (though mute) concerning which a controversy about identity or dissimilarity is pending. *Ibid.*, 409.

9. As to the question of identity, models are not a living, but a sure and true witness—dumb, but speaking eloquently, as you may interpret the language it employs. To each part a voice potential is given. *Page* v. *Ferry*, 1 Fisher, 313.—Wilkins, J.; Mich., 1857.

10. Experts may be examined to explain, if necessary, models and drawings. *Winans* v. *N. Y. & E. R. R.*, 21 How., 100.—Grier, J.; Sup. Ct., 1858.

11. Models of machines, about which there is a question, is a kind of evidence which is entitled to the highest credibility, and which, like figures, cannot lie. *Morris* v. *Barrett*, 1 Fisher, 463. —Leavitt, J.; Ohio, 1858.

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## MUSIC.

1. If a musical composition is borrowed from a former one, or is made up of different parts copied from older compositions without material change, and put together into one tune, with only slight alterations or additions, the person so combining is not an author within the meaning of the statute. *Reed* v. *Carusi*, 8 Law Rep., 411.—Taney, Ch. J.; Md., 1845.

2. But the circumstances of its corresponding with older musical compositions, and belonging to the same style of music, does not constitute it a plagiarism, provided it is in its main design and in its material and important parts *the effort of his own mind*. *Ibid.*, 411.

3. The composition of a new air or melody is entitled to protection; and the appropriation of the whole or of any substantial part of it, without the license of the author, is piracy. *Jollie* v. *Jaques*, 1 Blatchf., 625.—Nelson, J.; N. Y., 1850.

4. A musical composition, to be the subject of a copyright, 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 experience and skill could readily make. *Ibid.*, 626.

5. In a copyright of a musical composition, the right secured is the property in the piece of music, and not in the mere name. In that there need be no novelty or originality, nor need it even be the production of the author.

The title or name is an appendage to the book or piece of music, and if the copyright of the latter fails to be protected, the title goes with it. *Ibid.*, 627.

6. In the case of a valid copyright of such work, and an infringement of the title, whether the court would not be required to secure the title from piracy to protect the work; *query*. *Ibid.*, 627, 628.

## NAME, PROPERTY IN.

See TRADE-MARK.

## NEW APPLICATION OR USE.

1. The application of an *old* thing to a *new* use, without any other invention, is not a patentable contrivance. *Ames* v. *Howard*, 1 Sumn., 487.—STORY, J.; Mass., 1833.

2. Where a patent was for an improvement in the application of palm-leaf to stuffing beds, &c., but the same process had been used in preparing hair for like uses, *Held*, that there was no invention of any new process, but only a new application of an old process, and that it was not a patentable invention. *Howe* v. *Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

3. The application of an old thing to a new purpose is not patentable. 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, 411.—STORY, J.; Mass., 1843.

4. A new adaptation and *arrangement* of applying and using old articles for a certain purpose—as using old parts of a castor with and their adaptation to furniture, in a manner before unknown—may be the subject of letters patent. *Blake* v. *Sperry*, 2 N. Y. Leg. Obs., 255.—JUDSON, J.; Ct., 1843.

5. Where a patentee described his invention as an "improvement in the construction of the axles and bearings of railway and other wheeled carriages," and it was shown that the invention had been before applied to other carriages, although not to railway carriages, *Held*, that the invention was only a new application of an old invention, and therefore the patent could not be maintained. *Winans* v. *Bos. & Prov. R. R.*, 2 Story, 412, 415.—STORY J.; Mass., 1843.

6. The application of a known mechanical equivalent, as the endless screw and lever to a machine to which it had never before been applied, as to the periphery of a quadrant, to move and hold the rudder of a vessel with more ease, is not invention, although it might make the machine better. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

7. It is not a new invention, if all the parts of a combination had been applied to a different object before, and they were now only applied to a new object. *Hovey* v. *Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

8. The application of a known thing to a new purpose, as the use of rivets to fasten parts of a shoe instead of sewing, though such particular parts of the shoe had never before been so fast-

ened, is not the subject of a patent. *Hazard* v. *Green*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

9. The mere application of an old machine to a new purpose is not patentable. *Tyler* v. *Deval*, 1 Code Rep., 30.—MCCALEB, J.; La., 1848.

10. The use of a material not before used in the same structure or article, as the use of potter's clay in the making of door-knobs, similar knobs having been before made of metal, glass, wood, &c., gives no claim for a patent, even though the article be more valuable than any other of the kind. *Hotchkiss* v. *Greenwood*, 4 McLean, 461.—MCLEAN, J.; Ohio, 1848. [Affirmed, *post* 15.]

11. A new application of a known principle to a new and useful purpose, by new mechanical contrivances and apparatus, as the application of the principle of the expansive and contracting power of a metallic rod, by different degrees of heat, to regulate the action of the damper and the heat of a common stove, is the subject of a patent. *Foote* v. *Silsby*, 1 Blatchf., 463, 464.—NELSON, J.; N. Y., 1849.

12. Although the principle had before been applied to the regulation of heat, and the idea of the application of such principle to the regulation of stoves had been before suggested, without such application having been made, it is not material; the person who first reduces the idea to practical application and use is entitled to the patent. *Ibid.*, 464.

13. It is not a claim for a discovery of a natural property of the metallic rod, but for a new application of it by means of mechanical contrivances, which is always the subject of a patent. *Ibid.*, 464.

14. Though a combination of machinery is not new in the abstract, yet if used and applied in connection with the practical development of a newly discovered principle, producing a new and useful result, the subject is patentable. *Tatham* v. *Le Roy*, MS.—NELSON, J.; N. Y., 1849.

15. The substitution of one material for another, as clay for wood or metal, in the construction of door-knobs, the spindle and shank being the same as in common use, and the mode of connecting them requiring only ordinary mechanical skill, is not the subject of a patent. *Hotchkiss* v. *Greenwood*, 11 How., 266.—NELSON, J.; Sup. Ct., 1850.

16. The meaning of the rule laid down in *Howe* v. *Abbott*, 2 Story, 194, and in *Winans* v. *Bos. & Prov. R. R.*, 2 Story, 416, that a new application is not entitled to protection, is that the application of an old machine or old composition of matter, before patented, to a new object, or what is termed a double use, does not entitle one to a patent, connected with the new object; because there is no new machinery or new combination of old parts. *Ibid.*, 270.—WOODBURY, J.; Dis. Opin.

17. But it is entirely different if one apply an old earth, or old mechanical power, or old principle in physics, to a new object. There is then a new form adapted, or a new combination for the purpose—a new shape, consistency, and use given, or a new *modus operandi*, which, if cheaper and better, benefits the world, and deserves protection. *Ibid.*, 270.

18. 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 such new property. *Foote* v. *Silsby*, 2 Blatchf., 264.—NELSON, J.; N. Y., 1851.

19. But in order to entitle himself to a patent for a new application of a property of nature to a useful purpose, he must not only have conceived the idea, but must by some means, have successfully given application to the new property; but it is not necessary that the application should be made by the very best apparatus that can be devised. *Ibid.*, 273, 274.

20. The application of a thing already known, to a new and useful purpose, may be the subject of a patent, provided the new use is not analogous to the old, and requires the exercise of the inventive faculties. *Winans* v. *Schenec. & Troy R. Road*, 2 Blatchf., 293.—CONKLING, J.; N. Y., 1851.

21. The discovery that a refuse or worthless material can be advantageously applied to a new purpose, if that result is owing to the presence, in such refuse material, of certain ingredients or substances which have before been used for the same purpose, is not a patentable invention. *Maule*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

22. A patent may be granted for the use of a known thing, in a known manner, to produce effects already known, but producing those effects so as to be more *economical* or *beneficially* enjoyed by the public. *Seeley*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

23. Though there may be in a new application some degree of novelty, something may have been discovered or found out that was not known before, yet unless the new occasion on which the principle is applied leads to some kind of new manufacture, or some new result, it will be but a double use. *Blandy*, *Ex parte*, MS. (App Cas.)—MORSELL, J.; D. C., 1858.

24. An invention or arrangement of parts, though already used for a particular purpose, if in the new use it performs any new function, or an old function in a better manner, or makes a better and cheaper manufacture, is patentable. *Newman*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

25. The mere use of a mechanical structure, before applied to a particular purpose (as a valve used on railway locomotives), for a different purpose, is not patentable; but if the valve be so changed as to be applicable to *all* engines, and producing a new and useful result, it is a patentable subject. *Judson* v. *Moore*, 1 Fisher, 556.—LEAVITT, J.; Ohio, 1860.

26. Where there is nothing new in the principles involved in an invention and nothing new in the form or character of the instrumentalities by which it is applied, the new application is but an analogous use, and is not the subject of a patent. *Allen*, *Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

27. The application of substantially the same means to produce the same result in a different form, as tubes and double walls in a grain bin, the same having been before used in cribs and kilns, is only a double use, and not patentable. *Marsh*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

28. The mere new application of an old arrangement of parts to a new purpose, or in connection with a different machine, is not patentable. *Rawson*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

29. The application of an old contri-

vance to a new purpose, as making mirrors for hats self-adhesive, so that they can be placed in any hat, or removed from one hat to another, is not invention. *Wheeler, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

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## NEW TRIALS IN PATENT CASES.

1. Where a verdict is void for repugnancy or uncertainty, a new trial must be ordered. *Stearns* v. *Barrett*, 1 Mas., 172.—STORY, J.; Mass., 1816.

2. In cases of surprise at the trial by new matters, forming a ground important to either party, and clearly made out, the cause will be postponed or continued. But if the party interested makes no such application, but elects to go on with the cause, he is understood to waive the matter of surprise; he cannot be permitted to take his chance with a jury; and, if unsuccessful, then to move the matter as a ground for a new trial. *Ames* v. *Howard*, 1 Sumn., 489, 490.—STORY, J.; Mass., 1833.

3. A new trial will not be granted upon mere cumulative evidence, where there is no other ground of objection to the verdict. *Ibid.*, 490.

4. A party moving on affidavits, for a new trial or the like, cannot put in new rebutting evidence to the affidavits of the other party, offered in reply to those first offered by the moving party. *Ibid.*, 491.

5. A verdict, though giving large damages, if not against evidence, or not supported by the evidence, is not sufficient reason for granting a new trial. *Stanley* v. *Whipple*, 2 McLean, 40.—McLEAN, J.; Ohio, 1839.

6. The awarding by the jury greater damages than were anticipated, is not such a gross mistake in the jury as would authorize setting aside their verdict. The question of damages is submitted to their fair judgment. *Alden* v *Dewey*, 1 Story, 341.—STORY, J.; Mass., 1840.

7. In an action for a violation of a patent, a new trial will not be ordered for surprise on account of new evidence, if by reasonable diligence the information might have been obtained beforehand. *Washburn* v. *Gould*, 3 Story, 157.—STORY, J.; Mass., 1844.

8. A verdict on an issue at law, in a patent case, directed by a court of equity, will not be set aside and a new trial ordered, on the ground that such verdict was against the weight of evidence, unless the preponderance of evidence is very clear. *Brooks* v. *Bicknell*, 4 McLean, 72, 74.—McLEAN, J.; Ohio, 1845.

9. On a motion for a new trial, the fact that the same issues had been submitted to a former jury, who were discharged because they could not agree, cannot be entirely overlooked. *Ibid.*, 72, 73.

10. A new trial will not be granted for the reason that the court construed the specification, instead of leaving the jury to determine its meaning. Written instruments are to be construed from the language of such instruments themselves, and it is the duty of the court to construe the language used in the specification. *Davoll* v. *Brown*, 1 Wood. & Min., 55, 56.—WOODBURY, J.; Mass., 1845.

11. If the court refuse to decide upon the construction of the patent or specification, and leave such point to the jury, such ruling is erroneous, and is sufficient cause for a new trial. *Emer-*

*son* v. *Hogg*, 2 Blatchf., 6.—BETTS, J.; N. Y., 1845.

12. A new trial will not be granted because the jury find liberal damages, except in a case of palpable extravagance. Where in an action for an infringement, it was proved by the plaintiff that sales were highly profitable, and that the defendant had manufactured and sold the article in large quantities, and the defendant offered no proof, limiting the evidence of the plaintiff, or as to the cost or value of the article, *Held*, that the jury were warranted in exercising a liberal discretion, and that a verdict of $2,000 would not be interfered with. *Stephens* v. *Felt*, 2 Blatchf., 38, 39.—BETTS, J.; N. Y., 1846.

13. A new trial will not be granted, because of the admission in evidence of a letter of the Commissioner of Patents, acknowledging the receipt of an application for a patent, and introduced to show plaintiff's invention at the time of its date, though doubts may be entertained of its admissibility, if other evidence is subsequently offered, proving plaintiff's invention earlier than the date of such letter. *Allen* v. *Blunt*, 2 Wood. & Min., 128, 129.—WOODBURY, J.; Mass., 1846.

14. Nor will a new trial be granted because parol evidence was refused, going to prove the contents of a letter, alleged to have been mailed to the opposite party, it not having been shown that such letter was lost, or had been actually received by such party. The affidavits of the parties may be received to prove or disprove such facts. *Ibid.*, 130, 132.

15. If one of the jury, before retiring, ask the clerk as to a fact appearing from the records, and no objection is made to the question at the time, nor any pretence made that the answer did not correspond with the record, it cannot, after verdict, be taken advantage of on a motion for a new trial. *Ibid.*, 149.

16. A new trial should not be granted for a cause existing at the trial, but which was not stated or excepted to then. *Ibid.*, 149.

17. Damages, in a case submitted to the fair judgment of the jury, will not be deemed excessive because they are more than a witness may have testified to, or slightly more than the court deem proper; the verdict will not be set aside and a new trial ordered, unless the damages are very excessive and unreasonable. *Ibid.*, 149.

18. Where a motion for a new trial is not made until some weeks after the trial, and the counsel of the parties differ as to what was done or omitted, it is for the court to decide on these differences, and the court will not award a new trial if it is apparent that no injustice will be likely to happen from the verdict as rendered. *Ibid.*, 151.

19. Nor will the court order a new trial because of the neglect of the court to charge as to certain points, as requested, where the counsel furnished no written list of such points to the court, nor verbally called attention, before the jury went out, to any point omitted. *Ibid.*, 151, 152.

20. It is no ground for a new trial that the court omitted to charge on some points, unless the omission influenced or changed the verdict; but it is too late to remind the court of the omission after the jury have retired. *Ibid.*, 152.

21. It is the general rule not to disturb the verdict if it is according to the justice of the case, and the ruling is

only doubtful in point of law—though if the ruling be clearly wrong, it will be good ground for a new trial. *Ibid.*, 152.

22. Though generally it will be a ground for a new trial if illegal testimony is admitted—or there was any misdirection on the law to the jury—yet if the illegal testimony has not prejudiced the case, or the objection was merely technical, or the evidence became immaterial, or the verdict can be justified without it, or the rejection was right, though on different grounds, or the incompetent evidence was not material, or no injustice was done by it, or cumulative, or not controverted, or the fact was otherwise proved, or if the misdirection was on an immaterial point, or did not affect the verdict, and justice appears to have been done, or if the point was frivolous, a new trial will not be ordered. *Ibid.*, 152, 154.

23. On a motion for a new trial in an action for the infringement of a patent on the ground of excessive damages, the sum given must be plainly exorbitant, or what is sometimes called "*outrageous*," to require the interference of the court. *Aiken* v. *Bemis*, 3 Wood. & Min., 352.—WOODBURY, J.; Mass., 1847.

24. Where a new trial is asked because the verdict is against the weight of evidence, the finding of the jury, where evidence existed on both sides and had to be compared and weighed, will not be disturbed, even though the court might have come to a different conclusion, unless the presumption is very strong that the jury either wantonly abused their powers, or made some inadvertent mistake. *Ibid.*, 353.

2 A new trial will not be granted on the ground of the admission of the declarations of an agent in relation to the business in which he was engaged, and made while he was so engaged, as such declarations are a part of the *res gestæ*. *Ibid.*, 355.

26. A new trial will be granted on the ground of newly discovered evidence, if there is no ground for imputing negligence in not obtaining it for the former trial, and if it is material, and not merely cumulative. And evidence will not be deemed cumulative if it is as to some point or fact not before agitated or gone into. *Ibid.*, 355–358.

27. If a new trial is however granted on the ground of newly discovered evidence, it is only on payment of the costs of the former trial. *Ibid.*, 359.

28. The court will not grant a new trial on the ground of excessive damages if the verdict was in accordance with the direction of the court. *Stimpson* v. *The Railroads*, 1 Wall., Jr., 166.—GRIER, J.; Pa., 1847.

29. The rule of law that a verdict of a jury will not be set aside where there has been evidence on both sides of a question of fraud, and no misdirection as to the law, applies with like strictness to all cases of tort, as to an infringement of a patent. *Blanch. Gun-Stock Turning Fac.* v. *Jacobs*, 2 Blatchf., 71.—BETTS, J.; N. Y., 1847.

30. Where, in such a case, it was submitted as a question of fact for the jury to find whether the defendant was concerned with another in using an infringing machine, or was merely a purchaser from such person of articles manufactured under it, and the court instructed the jury that the action could not be maintained against the defendant if he was no more than a purchaser, and the jury gave a verdict for the plaintiff; *Held*, there being evidence on both

sides of the question, and it not appearing that the verdict was clearly against the weight of the evidence, that it must stand. *Ibid.*, 70, 71.

31. A new trial will not be granted in any case, unless the verdict is clearly without evidence, or against the weight of evidence; nor for the purpose of introducing new evidence to points before in controversy. *Ibid.*, 71.

32. A new trial will be granted if a witness has been improperly rejected. *Buck* v. *Hermance*, 1 Blatchf., 322, 325.—NELSON, J.; N. Y., 1848.

33. A new trial will not be granted on account of surprise caused by the rejection of evidence, when insufficient or informal notice had been given of the intention of introducing such evidence, or when such evidence, if introduced, would not, in the judgment of the court, have constituted a defence, or varied the result. *Foote* v. *Silsby*, 1 Blatchf., 466.—NELSON, J.; N. Y., 1849.

34. In the third circuit, where a jury cannot agree and are discharged, there cannot be a second trial at the same term of the court, by a new jury selected out of the same panel, except by the consent of parties. *Wilson* v. *Barnum*, 1 Wall., Jr., 353.—GRIER, J.; Pa., 1849.

35. It must be a very extreme case where a judgment will be reversed by the Supreme Court on account of excessive damages in actions *ex delicto*, when the instructions of the court suggested to the jury the true general rule, and the leaving ground for mitigation, as well as against excess, and when, if excessive, a new trial could have been moved in the Circuit Court. *Hogg* v. *Emerson*, 11 How., 608.—WOODBURY, J.; Sup. Ct., 1850.

## NEWSPAPER.

1. A newspaper establishment is a subject of property, and so far as the rights of such an establishment are private and exclusive, this species of property, like any other, is entitled to the protection of the laws. *Snowden* v. *Noah*, Hopk. Ch., 351.—WALWORTH, Chan., N. Y., 1825.

2. The good-will of an established trade, the custom of an inn, and the right of a publisher of books may be injured by acts of deception and piracy; but the injury for which redress is given in such cases, results from the imposture practised upon the customers of an existing establishment, or upon the public. *Ibid.*, 352.

3. The acts of Congress, in respect to copyright, are for the encouragement of learning, and were not intended for the encouragement of mere industry, unconnected with learning, and the sciences. *Clayton* v. *Stone*, 2 Paine, 392.—THOMPSON, J.; N. Y., 1828.

4. A newspaper or price current, is not such a publication as falls under the protection of the copyright laws. *Ibid.*, 293.

5. A court of equity has power to issue an injunction to restrain a defendant, if he has assumed the name of the complainant's newspaper, for the fraudulent purpose of imposing on the public, and supplanting him in the good-will of his established paper, by simulating its name and address. *Bell* v. *Locke*, 8 Paige, 76.—WALWORTH, Chan.; N. Y., 1840.

6. But the simulation must be such as to injure the circulation and patronage of the complainant's paper, by deceiving the public and inducing the be-

lief that it is in reality the same paper. *Ibid.*, 77.

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## NONSUIT.

1. It is not a foundation for a nonsuit that the declaration for an infringement of a patent, does not lay the act complained of to be *contra formam statuti.* This is matter of form, the want of which will be cured by verdict. *Tryon* v. *White*, Pet. C. C., 97.—WASHINGTON, J.; N. J., 1815.

2. But if the declaration in an action for the infringement of a patent, professes to set forth the specification as a part of the grant, according to its tenor, the slightest variation, as *wheel* for *whirl*, is fatal, for which a nonsuit will be granted. *Ibid.*, 97. [In this case the judge ordered a nonsuit, but the question does not appear to have been raised as to the power of the court to order it; and a rule was subsequently granted to show cause why the nonsuit should not be set aside. *Ed.*]

3. The courts of the United States have no authority to order a nonsuit, without the consent of the plaintiff, on the trial of a cause before a jury. *Foote* v. *Silsby*, 1 Blatchf., 450, 461.—NELSON, J.; N. Y., 1849.

4. It has been repeatedly decided that the courts of the United States have no power to order a peremptory nonsuit, against the will of the plaintiff. *Silsby* v. *Foote*, 14 How., 222.—CURTIS, J.; Sup. Ct., 1852.

5. The Supreme Court have also held to same effect, in *Elmore* v. *Grymes*, 1 Pet., 469, 1828; *De Wolf* v. *Raybaud*, 1 Pet., 476, 1828; *Crane* v. *Morris*, 6 Pet., 59, 1832.

## OATH OF INVENTION.

1. The taking of the oath by the inventor is but a prerequisite to the granting of a patent, and in no degree essential to its validity. If, therefore, not conformable to the statute, it is no objection to the patent. *Whittemore* v. *Cutter*, 1 Gall., 433.—STORY, J.; Mass., 1813.

2. Where the construction of the patent and specification, as to the subject of the grant, are doubtful, the affidavit, if more precise, may be resorted to to explain the ambiguity. It seems particularly proper to do so for restraining general expressions in the specification. *Pettibone* v. *Derringer*, 4 Wash., 217, 218.—WASHINGTON, J.; Pa., 1818.

3. Thus, where the patent recited the applicant to be the inventor of an improvement in boring muskets by a twisted screw-auger, and the specification described the manner of making the auger, its form, and how to be used, and the affidavit confined the invention to the improvement in *making augers* for boring musket-barrels, *Held*, that the patent extended only to the auger, and not to the method or peculiar manner, as described, of using it. *Ibid.*, 218.

4. The oath of originality of invention made by a patentee at the time of his application for a patent, cannot be considered or accepted, in an application for an injunction for infringing such patent. Such motion must be accompanied by an affidavit that he then believes himself to be such original inventor. *Sullivan* v. *Redfield*, 1 Paine, 445.—THOMPSON, J.; N. Y., 1825.

5. The taking of the oath in due form in an application for a patent, is not a

condition precedent to the validity of the patent. *Dyer* v. *Rich*, 1 Met., 191.—SHAW, Ch. J.; Mass., 1840.

6. The statute is directory to the officer superintending the issuing of letters patent, but is not a condition to the validity of the patent. *Ibid.*

7. The oath of first invention required by law of the patentee prior to the issue of a patent, is in the case of an action for an infringement of the patent, and the jury are entitled to judge of its force, and may take it into consideration, or weigh it against the oath of a witness, that he, such witness, communicated the invention to the patentee—there is oath against oath. *Alden* v. *Dewey*, 1 Story, 339, 341.—STORY, J.; Mass., 1840.

8. Under § 6 of the act of 1836, the oath required in an application for a patent cannot be taken before a consul. Nor can the "declaration," admitted under the English patent act, be substituted in place of the oath. *Anon.* 3 Opin., 532.—GILPIN, Atty. Gen., 1840.

9. The oath of the patentee is to be considered as extending to all the schedule or specification, no less than the title of his invention. *Hogg* v. *Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

10. The oath, forming a part of the letters patent, is in evidence to the jury, and forms a legal ground for the presumption of the novelty and originality of the patentee's claim, until the contrary is proved. *Parker* v. *Stiles*, 5 McLean, 60.—LEAVITT, J.; Ohio, 1849.

11. Under § 7 of the act of 1836, an applicant is required to make oath anew only when he persists in his application, after having been informed of the errors or defects of his specification. This happens before his claim is rejected. *Crooker, Ex parte* (*Propeller*), MS. (App Cas.)—CRANCH, Ch. J.; D. C., 1850.

12. Where the application is finally rejected, though upon a first examination, no new oath is necessary to enable a party to appeal to the judges of the Circuit Court of the District of Columbia. *Ibid.*

13. There is no act that requires the *jurat* to an application for a patent to be dated. *French* v. *Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851.

14. The oath of an applicant to his application, though not in itself *sufficient*, is *some* evidence of the novelty, invention, and usefulness of the thing for which patent is sought. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

15. A patent issued, grounded on the oath of the patentee, is *prima facie* evidence, in an action of infringement of such patent. *Ibid.*

16. The oath accompanying an application for a patent is evidence on a trial of a *prima facie* character, and is the foundation of the *onus probandi* thrown upon the defendant. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

17. The oath of the inventor accompanying his application for a patent is to be considered as extending to all described in the specification. *King* v. *Gedney*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

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## OYER AND PROFERT.

See PLEADING, C.

## PARTIES.

### Parties to Actions.

See Actions, B. 3; Equity, B. 2.

### Parties, Declarations of.

See Evidence, D.

### Parties, Examination of.

See Evidence, G. 1, *b*. 3.

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## PARTNERSHIP IN PATENTS.

1. A joint interest in a patent, does not make the parties partners; some agreement is therefore necessary to enable such parties to work the invention at their joint expense, and for their joint benefit. *Parkhurst* v. *Kinsman*, 1 Blatchf., 496.—Nelson, J.; N. Y., 1849.

2. The assignment of all interest in a patent by one joint owner, is a dissolution of a partnership for working it. *Ibid.*, 498.

3. One partner in the manufacture and sale of a patented article, cannot acquire, as assignee, an outstanding right or claim of a third person, as an inventor of the same thing, and set it up against his joint partner, and particularly if he entered into such partnership with a knowledge of such alleged title. *Kinsman* v. *Parkhurst*, 18 How., 294.—Curtis, J.; Sup. Ct., 1855.

4. The relation of copartners between joint patentees does not result from their connection as joint patentees, or between one of two joint patentees and the assignee of the other. The parties are simply joint owners or tenants in common, of the rights and property secured by the patent; and their rights, powers, and duties as respects each other are substantially those of the joint owners of a chattel. *Pitts* v. *Hall*, 3 Blatchf., 206.—Hall, J.; N. Y., 1854.

5. One joint owner of a patent can legally grant, assign, license, or sell, only in respect to his own share or right; he cannot sell and give good title to his co-owner's right; and if he appropriates any portion of the exclusive right or common property to his separate use or benefit, either by a sale or use of the patented machine, it is in principle the same as a conversion, by destruction or sale, of the joint property by a tenant in common, and for which the other tenant in common could maintain trover. *Ibid.*, 207, 208.

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## PATENTS.


**A.** Subject Matter of..... 498
**B.** Right to, how lost or forfeited.. 498
**C.** Grant, or Issue of; by and to whom 498
**D.** What granted or secured by.
1. *General Nature of the Grant*..... 498
2. *Whether may include more than one Invention*..... 501
**E.** What embraced in the "Letters Patent"..... 504
**F.** Application for Patent..... 504
**G.** Interfering Applications..... 504
**H.** Term of; Date of; when begins to run ..... 505
**I.** Territorial Extent of..... 506
**K.** Name and Title of..... 506
**L.** Prior and subsequent, for same Invention..... 507
**M.** Surrender and Reissue of..... 507

**N.** RENEWAL AND EXTENSION OF..... 508
**O.** MISTAKES IN CORRECTION OF..... 508
**P.** CONSTRUCTION OF
1. *General Principles of Construction*.... 508
2. *Prima Facie Authority of*..... 513
3 *How far construed by the Court*..... 517
4 *How far construed by the Jury*..... 519
5. *Claim in, Force and Construction of*... 521
**Q.** VIOLATION OF..... 525
**R.** WHEN VOID..... 525
**S.** TRANSFER OF..... 530

## A. SUBJECT MATTER OF.

See ART; COLORABLE ALTERATIONS; COMBINATION, A.; COMPOSITION OF MATTER, A.; DISCOVERY; DOUBLE USE; EFFECT; EQUIVALENT; EXPERIMENTS; FORM; IMPROVEMENTS, A.; INTENT; INVENTION, A.; MACHINES, A.; MANUFACTURE, ARTICLE OF; MATERIAL; MEDICINE; MECHANIC, SKILL OF; MODE, METHOD, OR PROCESS; NEW APPLICATION; PRINCIPLE; PROCESS; PURPOSE; SUGGESTIONS; THEORY.

As to when an invention is reduced to practice, so as to be patentable, see INVENTION, B.

As to the necessary novelty and utility of a patentable subject, see INVENTION, D.

## B. RIGHT TO, HOW LOST OR FORFEITED.

See titles ABANDONMENT, B.; APPLICATION FOR PATENT, A.; PRIOR USE BY INVENTOR.

See also in connection herewith, PRIOR KNOWLEDGE OR INVENTION.

## C. GRANT OR ISSUE OF; BY AND TO WHOM.

See APPLICATION, B.; INTRODUCER; INVENTOR, A., B.; JOINT INVENTOR.

See also INVENTION, D.

## D. WHAT GRANTED OR SECURED BY.

### 1. *General Nature of the Grant.*

As to construction of Patents, see PATENT, P.

1. The general law declares that the right to a patent belongs to him who is the first inventor, even before a patent is granted; therefore any person, who, knowing that another is the first inventor, yet doubting whether that person will ever apply for a patent, proceeds to construct a machine so invented by another, acts at his peril, and with a full knowledge of the law, that a subsequent patent may cut him out of the use of the machine thus erected. *Evans* v. *Wiess*, 2 Wash., 345.—WASHINGTON, J.; Pa., 1809.

2. The power of Congress is only to ascertain and define the rights of property in the invention or work; it does not extend to regulating the use of it. This is exclusively of local cognizance. Such property, like every other species of property, must be used and enjoyed within each state according to the laws of such state. *Livingston* v. *Van Ingen*, 9 John., 581.—KENT, Ch. J.; N. Y., 1812.

3. The constitution and the law together give to the inventor, from the moment of discovery, 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, and no right can be acquired in it without the consent of the inventor. *Evans* v. *Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

4. A patent is a bargain with the pub-

lic in which the same rules of good faith prevail as in other contracts. *Whitney* v. *Emmett*, Baldwin, 310.—Baldwin, J.; Pa., 1831.

5. If a patent is valid, it gives to the patentee a right of property in the thing patented, which is entitled to full protection in the courts. *Ibid.*, 322.

6. The fact that a party has a patent giving him the exclusive right to make, use, and sell, a particular medicine, does not confer upon him the right to practise as a physician, and use such medicine in any particular state, except in conformity with the laws of such state. *Jordan* v. *Overseers of Poor*, 4 Ohio, 310.—Lane, J.; Ohio, 1831.

7. A party has not necessarily a right to use an invention in any state, merely because he has a patent for it under the United States. *Vannani* v. *Paine*, 1 Harrington, 68.—Robinson, J.; Del., 1833.

8. Where V. had a patent for a plan for constructing and drawing lotteries, and had obtained a patent therefor, but there was a state law prohibiting lotteries, except under certain conditions, which the plaintiff and his associates had not complied with, *Held*, that V. was not entitled to any relief by way of injunction or otherwise, for any alleged use of his invention in the state. *Ibid.*, 69.

9. From an examination of the various provisions of the patent law, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest an exclusive right in the inventor only—and that on condition that his invention was neither known nor used by the public before his application for a patent. *Shaw* v. *Cooper*, 7 Pet., 319.—McLean, J.; Sup. Ct., 1833.

10. Every discoverer should realize the benefits resulting from his discovery for the period contemplated by law. But these can only be secured by a substantial compliance with every legal requisite. His exclusive right does not rest alone upon his discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed. *Ibid.*, 320.

11. A patent authorizing the patentee to make, construct, and use a newly discovered compound of medicine, gives such patentee no right to practise as a physician, even though only administering such medicine, without complying with the regulations established by the laws of any state. *Thompson* v. *Staats*, 15 Wend., 395.—Nelson, J.; N. Y., 1836.

12. The right secured to the inventor is founded on considerations of public policy, and is not to be destroyed by open infraction, or mere colorable improvements. *Smith* v. *Pearce*, 2 McLean, 178.—McLean, J.; Ohio, 1840.

13. The exclusive grant of a patent is the construction and use of the thing patented. *Boyd* v. *Brown*, 3 McLean, 297.—McLean, J.; Ohio, 1843.

14. Where the right was in certain instruments to make a particular kind of bedstead, the exclusive right of making, using, and selling such instruments is that which is secured, and not the bedstead, which is the product. *Ibid.*, 297.

15. The subject matter of a patent is not partible except in respect to territorial assignments. *Suydam* v. *Day*, 2 Blatchf., 23.—Nelson, Betts, JJ.; N. Y., 1846.

16. At common law an inventor has no exclusive right to make and vend his

invention, after he has published it to the world. Such exclusive right is the creature of the statute, which also prescribes the remedy for its violation. *Dudley* v. *Mayhew*, 3 Coms., 13–17.—STRONG, J.; N. Y., 1849.

17. An exclusive right in a composition of matter, as a medicine, can only be obtained under the patent law by a compliance with its provisions. *Coffeen* v. *Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind., 1849.

18. A patent-right is insusceptible of local subdivision. As a privilege or monopoly, it is an entire thing, and incapable of apportionment. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 339.—GRIER, J.; Pa., 1849.

19. The monopoly is capable of subdivision in the category of its locality, and in no other way. The patentee cannot carve out his monopoly, which is a unity, into a hundred or more, all acting in the same place, and liable to come in conflict. *Ibid.*, 340.

20. The contract of the public is not with him who has discovered, but him who also makes his discovery usefully known. If he has discovered much and discloses little, communicates to the world only one or more of the derivative and secondary truths of the principle he has discovered, he patents no more than he has proclaimed. *Detmold* v. *Reeves*, 4 Amer. Law Jour., N. S., 189.—KANE, J.; Pa., 1851.

21. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, to expand into a general expression what was before limited in a particular form, and argue that he had described the whole by implication from the first. *Ibid.*, 189.

22. It is for the parts *claimed* as the invention of the patentee, and as such particularly pointed out, that the patent issues. It covers no more; and the patentee is not bound to prove the originality of what is *not* in it to make it a protection for what is in it. *Holliday* v. *Rheem*, 18 Penn., 469.—BLACK, Ch. J.; Pa.; 1852.

23. Whether a patented discovery is partible in its nature so as to enable the patentee to make separate grants of the various particulars included in it, *query*. *Ritter* v. *Serrell*, 2 Blatchf., 383.—BETTS, J.; N. Y., 1852.

24. It is a reasonable presumption that the intention of the inventor was to obtain, and of the government to concede to him the exclusive right of what he had invented. *Kittle* v. *Merriam*, 2 Curt., 479.—CURTIS, J.; Mass., 1855.

25. The Commissioner of Patents in issuing letters patent does not warrant the same, nor does the patent bind the government more than it does private persons; but the validity of such patent is open to inquiry, either in whole or in part, whether at the instance of private persons or of the government. A patent does not conclude any body. *Morton's Anæsthetic Patent*, 8 Opin., 276.—CUSHING, Atty. Gen.; 1856.

26. A patent when granted becomes to a certain extent a contract on the part of the government with the patentee, that they will, through their courts, and in the ordinary course of the administration of justice, protect him in the exercise of the exclusive privileges which his patent gives him. *Ransom* v. *Mayor, &c.*, 1 Fisher, 259. —HALL, J.; N. Y., 1856.

27. A patent is a compact—an executory contract—rather than a deed of property. Its vitality consists in the

making good by the patentee of certain provisions which are of the character of conditions subsequent, as that he is the first inventor; that the invention is useful; and that there is a sufficient description and representation of it in the specification and drawings. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

28. A patent may be considered in the light of a deed from the government, and the patentee is bound to communicate his invention in so full and clear a manner that it shall be within the comprehension of the public at the expiration of the term. The exclusive privilege granted by a patent is not merely as the reward of genius, and for the encouragement of useful inventions and improvements in arts and manufactures, but also embraces the public benefit. *Page* v. *Ferry*, 1 Fisher, 306, 307.—WILKINS, J.; Mich., 1857.

29. The limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting and securing that monopoly. *Kendall* v. *Winsor*, 21 How., 327, 328.—DANIEL, J.; Sup. Ct., 1858.

30. This was at once the equivalent given by the public for benefits bestowed by the genius, and meditations, and skill of individuals, and the incentive to further efforts for the same important objects. *Ibid.*, 328.

31. Letters patent issue subject to all legal objections that may be brought against them. *Shreeve* v. *United States*, MS.—LORING, J.; Ct. Claims, 1859.

32. An inventor has no legal rights or immunities under a patent, except such as are conferred by the statute. With whatever solemnity or observance of legal form it may have issued, if wanting in any substantial statutory requisite it is a nullity. *Moffitt* v. *Garr*, 1 Fisher, 612.—LEAVITT, J.; Ohio, 1860.

33. A patentee may hold a close monopoly of his right, or he may grant out his entire right; but he cannot divide his right into parts and grant to one man the right to use it in its connection with, or application to one thing, and to another in connection with a different thing, to such an extent as that *purchasers* from any of these persons may not use the fabric purchased exactly as they like; and if they please in violation of what he has supposed were rights not granted by him. *The Washing Machine Co.* v. *Earle*, 2 Fisher, 205.—GRIER, J.; N. J., 1861.

34. Goodyear, the patentee of vulcanized india-rubber, might have prevented any person from using his fabric for any purpose. But if he grants to A the exclusive right to use it to make "wringers" only, and to B the right to make "tubes" only, A cannot restrain C, who has bought tubes, from converting them into wringers by any process whatever that he, C, pleases. Neither can Goodyear. *Ibid.*, 206.

## 2. *Whether may include more than one Invention.*

1. Whether, under the general patent laws, improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of these machines in combination, *query*. *Evans* v. *Eaton*, 3 Wheat., 506.—MARSHALL, Ch. J.; Sup. Ct., 1818.

2. A patent cannot embrace various and distinct improvements or inventions; but in such case the party must take out separate patents. Nor can the same patent be for each one of several machines, each capable of a distinct operation, and for their combination, to produce a connected result. *Barrett* v. *Hall*, 1 Mas., 475.—STORY, J.; Mass., 1818.

3. Where a plaintiff claims several distinct and independent improvements in the *same* machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements so patented, notwithstanding there has been no violation of the other improvements. *Moody* v. *Fiske*, 2 Mas., 115, 119.—STORY, J.; Mass., 1820.

4. But though several distinct improvements in one machine may be united in one patent, it does not follow that several improvements in *two different* machines, having distinct and independent operations, can be so included. *Ibid.*, 119.

5. Nor can the same patent be for a *combination* of different machines, and for distinct improvements in each. *Ibid.*, 119.

6. A single patent cannot embrace two machines which are wholly independent of each other, and distinct inventions for unconnected objects; nor for several distinct improvements upon different machines, having no common connection or common purpose. This was the meaning of the court in *Barrett* v. *Hall*, 1 Mas., 447, and *Moody* v. *Fiske*, 2 Mas., 115. *Wyeth* v. *Stone*, 1 Story, 288.—STORY, J.; Mass., 1840.

7. But a single patent may be taken for several inventions or improvements, though each is a distinct and independent invention or improvement, and capable of a distinct use and application, if they conduce to the accomplishment of one and the same general end. *Ibid.*, 291, 292.

8. A patent may be maintained for a machine combining several distinct improvements, if each is the invention of the patentee, and also include a right to each of the 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. This doctrine was maintained in *Wyeth* v. *Stone*, 1 Story, 291 (Mass., 1840), and it is confirmed by the obvious intent of § 9 of the act of 1837, which gives to the patentee a right of action for the piratical use of any one of his invented improvements, which is distinctly stated in his patent, although he may have included something of which he was not the inventor. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Me., 1843.

9. The doctrine intimated by the court in *Evans* v. *Eaton*, 3 Wheat., 506 (*ante* 1), whether improvements on different machines can be comprehended in the same patent, must be accepted as put hypothetically—as the special statute (6 *U. S. Stat. at Large*, 70) furnished a rule in that case—and as not being laid down as a settled principle to govern the construction of specifications. *Emerson* v. *Hogg*, 2 Blatchf., 7.—BETTS, J.; N. Y., 1845.

10. The case of *Barrett* v. *Hall*, 1 Mas., 475 (*ante* 2), attempts a generalization of the doctrines of the patent law; but in *Moody* v. *Fiske*, 2 Mas., 118 (*ante* 3), that case is explained. *Ibid.*, 8.

11. The suggestions in all these cases were by way of caution, and were designed to avoid the conclusion that the court had prejudged or was committed on that question. *Ibid.*, 8.

12. In *Wyeth* v. *Stone*, 1 Story, 288, the court reviews these cases, and holds that a patent for several machines, each being a distinct and independent invention, is valid where they have a common purpose, and are auxiliary to the same common end. *Ibid.*, 8.

13. The principle seems to be, that the inventions should be capable of being used in connection, and to subserve a common end. But their actual employment together is not required to sustain the validity of the patent in which they may be united. The wrongful use of either separate machine is a violation of the patent *pro tanto*. *Ibid.*, 8.

14. Where a patent contained three claims: (1) a mode of converting the reciprocating motion of a piston into a continuous rotary motion; (2) a spiral propelling wheel; and (3) the application of a revolving vertical shaft to the turning of a capstan on the deck of a vessel; and the specification showed that the three were contrived to be used conjointly and for a common end; *Held*, that they could be embraced in one patent, and that the fact that they were capable of being used separately and independently of each other, did not prevent them being so embraced in one patent. *Ibid.*, 8.

15. Two inventions cannot be united in the same patent when they relate to two distinct machines. *Root* v. *Ball*, 4 McLean, 179, 180.—McLean, J.; Ohio, 1846.

16. But the same patent may include a patent for a combination, and an invention of some of the parts of which the combination consists. *Ibid.*, 180.

17. As a general rule, two patents cannot be united in the same letters. But it is a well established exception, that patents may be united if two or more included in one set of letters relate to a like subject, or are in their nature and operation connected together. *Hogg* v. *Emerson*, 6 How., 483.—Woodbury, J.; Sup. Ct., 1847.

18. A patent for more than one invention is not void if they are connected in their design and operation. *Hogg* v. *Emerson*, 11 How., 606.—Woodbury, J.; Sup. Ct., 1850.

19. It is competent for a patentee to embrace two improvements on the same machine in the same patent; and if a person uses either or both of the improvements, he is an infringer. *Morris* v. *Barrett*, 1 Fisher, 463.—Leavitt, J.; Ohio, 1858.

20. There may be a claim for two inventions in the same patent if they both relate to the same machine or structure; and an action can be sustained for the infringement of either one or the other of these separate inventions, where claimed as separate and distinct in their character. *Lee* v. *Blandy*, 2 Fisher, 92.—McLean, Leavitt, JJ.; Ohio, 1860.

21. A party may unite as many improvements, having relation to the same thing, in one patent, as he pleases, but he may make each improvement the subject of a separate patent of he chooses. *Hayden, Ex parte*, MS. (App. Cas.)—Merrick, J.; D. C., 1860.

22. Where the features of novelty are numerous, prudence suggests that the danger of making a patent too broad by uniting questionable with plainly novel claims be avoided by taking separate patents. *Ibid.*

## E. What embraced in the "Letters Patent."

1. Under § 1 of the act of 1790, the allegations and suggestions of the petition must be substantially recited in the patent. *Evans* v. *Chambers*, 2 Wash., 126.—Washington, J.; Pa., 1807.

2. The schedule is to be considered as a part of the letters patent, so far as it is descriptive of the machines, but no farther. *Evans* v. *Eaton*, Pet. C. C., 341.—Washington, J.; Pa., 1816.

3. Merely describing in the specification the parts of a thing, or the *modus operandi*, and as to which no claim is made, does not make such things a part of the patent. *Kneass* v. *Schuyl. Bank*, 4 Wash., 14.—Washington, J.; Pa., 1820.

4. 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, 450.—Livingston, J.; N. Y., 1825.

5. In using the word *patent*, in reference to the description of the thing patented, it is to be understood as including the patent, the specification attached to it, with the model and drawing in the Patent Office, all of which are to be taken together. *Whitney* v. *Emmett*, Bald., 314.—Baldwin, J.; Pa., 1831.

6. The specification constitutes a part of the letters patent. *Pitts* v. *Whitman*, 2 Story, 614.—Story, J.; Me., 1843.

7. The drawing is a part of the patent, and may be referred to in order to help out the description. *Emerson* v. *Hogg*, 2 Blatchf., 9.—Betts, J.; N. Y., 1845.

8. The drawing forms a part of the specification of a patent, and is to be taken with it in interpreting the patent. *Knight* v. *Gavit*, Mir. Pat. Off., 133.—Kane, J.; Pa., 1846.

9. The schedule or specification annexed to the letters patent is, under our laws and practice, to be regarded as a component part of the letters patent, and may be referred to to explain or add to the title of the patent. *Hogg* v. *Emerson*, 6 How., 478, 482.—Woodbury, J.; Sup. Ct., 1847.

10. Models and drawings are a part of the letters patent. *Ibid.*, 485.

11. Drawings annexed to a patent issued under the act of 1837, form no part of the patent where no drawing was annexed to the original patent. *Wilton* v. *Railroads*, 2 Whart. Dig., 410.—Kane, J.; Pa., 1848.

12. Under the act of 1793, the specification was not necessarily made a part of the letters patent, but the inventor had a right, if he pleased, to advise the Patent Office to incorporate it into the letters as a part of them, by express terms of reference. *Hogg* v. *Emerson*, 11 How., 604.—Woodbury, J.; Sup. Ct., 1850.

13. The specification, when thus voluntarily annexed, became a part of the patent by general principles, as clearly as it does since by the words of the law. *Ibid.*, 605.

## F. Patent, Application for.

See Application for Patent.

## G. Interfering Applications.

See Interferences.

## II. TERM OF; DATE OF; WHEN BEGINS TO RUN.

As to extension of term, see EXTENSION OF PATENT.

1. A patent may be issued for a less term of years than fourteen. The restriction is on the *maximum* only, not on the *minimum*. *Sullivan's Case*, Opin. Atty. Gen., 168, Gilpins' Edit.—WIRT, Atty. Gen.; 1818.

2. Where two patents are issued to the same person, but on different specifications, their dates should conform to the times of the two applications. It is illegal to antedate the last patent to the time of the first application, as it might overreach intermediate improvements made by others. *Blanchard's Case*, 5 Opin., 722.—WIRT, Atty. Gen.; 1820.

3. The date of a patent may be altered to correspond with that of a foreign patent previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. *Detmold's Case*, 4 Opin., 335.—NELSON, Atty. Gen.; 1844.

4. Under § 6 of the act of 1839, if a party apply for and obtain a patent for an invention, for which he has previously obtained a foreign patent, his home patent must be limited to fourteen years from the date of such foreign patent. *Smith* v. *Ely*, 5 McLean, 78.—McLEAN, J.; Ohio, 1849.

5. If such domestic patent purports to give an exclusive right for fourteen years from its date, instead of from the date of the foreign patent, such patent is void, as issued in violation of law. *Ibid.*, 79. [But see *post* 10.]

6. The limitation of the exclusive right, is a material part of the patent, and must be truly stated. *Ibid.*, 80.

7. But the error is not fatal to the rights of the patentee, and may be corrected on application to the Patent Office. *Ibid.*, 80.

8. The provisions of § 8 of the act of 1836, and of § 6 of the act of 1839, as to the obtaining of patents, after foreign patents have been secured, and as to the date of the home patent, in such case, relates only to such patents as are *applied for* here *after* the issue of the foreign patent. *French* v. *Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851.

9. Where therefore an application for a patent for an invention was made in April, 1838, and acted on in that month, but a patent was not actually issued until June 20, 1840, at which time it was dated, and a foreign patent was obtained in August, 1838. *Held*, as the application here was before the foreign patent, that the grant of the patent here was under the general enactments of the law of 1836, and its term runs properly from its date. *Ibid.*, 135, 136.

10. A patent is not void because, on its face, it does not bear the same date with a previous foreign patent, taken out by the patentee for the same invention; the monopoly however is limited to fourteen years from the date of the foreign patent. *O'Reilly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

11. When a patent has expired, whatever of invention it contained belongs to the public, and may be used by any one. *McCormick* v. *Manny*, 4 Amer. Law Reg., 286.—McLEAN, J.; Ill., 1855.

12. A patentee, under § 5 of the act of 1836, is not obliged to claim the whole fourteen years. He may waive his claim to a part of the term in favor

of the public, by antedating it; or he may take a patent for a term less than fourteen years; or he may seek protection against strangers, for six months previous to the issue, if in that time he has made application and is seeking in good faith and with reasonable diligence to perfect his specifications. *Cushman, W. M. C., Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.

## I. TERRITORIAL EXTENT OF.

1. The grant of the exclusive right conferred by letters patent, includes every use of the thing patented, by all persons within the territory of the United States. *Brown* v. *Duchesne*, 2 Curt., 371.—CURTIS, J.; Mass., 1855.

2. Such grant however, and the exclusive rights conferred by it, are creatures of the municipal law of the country; and however comprehensive are its terms, cannot be construed to include either persons or things, not within the jurisdiction of the patent laws. *Ibid.*, 371.

3. Where a vessel was built and rigged in France, and had in use gaffs which had been patented in the United States, *Held*, as the gaffs were placed on the vessel when she was built, and as part of her original equipment, in a foreign country, by persons not within the jurisdiction of our patent laws, that such use was not within the application of our patent laws, but was exempted. *Ibid.*, 375, 377.

4. The patent laws were not intended to apply to, and do not extend over foreign vessels visiting our ports, so as to effect the structure or equipment they bring hither. *Ibid.*, 376, 377.

5. The power granted by the patent laws is domestic in its character, and necessarily confined within the limits of the United States. The patent acts do not, and were not intended to operate beyond the limits of the United States—and the patentee's right of property and exclusive use cannot extend beyond the limits to which the law itself is confined. *Brown* v. *Duchesne*, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.

6. The rights of property and exclusive use granted to a patentee, do not extend to a foreign vessel lawfully entering our ports; and the use on such vessel of an improvement, patented in this country, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs. *Ibid.*, 198.

## K. NAME AND TITLE OF.

1. An inventor has a right to call his invention or patented article what he pleases, provided he do not assume an already existing and popular name, to the prejudice of those who have preoccupied the name. *Bacon's Case*, 2 Opin., 109.—WIRT, Atty. Gen.; 1828.

2. Where the inventor of a newly patented medicine, desired to give it the name of *Anderson's Cough Drops*, which was already well known, the patent was ordered to be withheld until he should assume for it another name. *Ibid.*

3. The title or description given to an invention in the grant, is never expected to be specific, but only to indicate the nature and design of the invention. The specification must be searched for the exact description of what the patentee claims. *Sickles* v. *Glou. Man. Co.*, 1 Fisher, 229.—GRIER, J.; N. J., 1856.

4. A patentee is not controlled by

the *title* of his patent, but by all the papers—the patent, the specification and drawings, taken together. *Bell* v. *Daniels*, 1 Fisher, 374.—LEAVITT, J.; Ohio, 1858.

## L. PRIOR AND SUBSEQUENT, FOR SAME INVENTION.

1. It is a presumption of law that when a patent has been obtained, every man who subsequently takes out a patent for a similar machine, has a knowledge of the preceding fact. *Odiorne* v. *Winkley*, 2 Gall., 55.—STORY, J.; Mass., 1814.

2. It is also a presumption of fact that every man, having within his power the means of information, and desirous of securing to himself the benefit of a patent, will ascertain whether any one on the public records has acquired a prior right. *Ibid.*, 55.

3. 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 Mas., 473.—STORY, J.; Mass., 1818.

4. Whether, when a patent is once granted to any person for an invention, he can legally acquire any right under a subsequent patent for the same invention, unless his first patent be repealed for some original defect, so that it might truly be said to be a void patent; *query*. *Ibid.*, 473.

5. If several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. *Ibid.*, 474.

6. A patentee cannot have in use at the same time two valid patents for the same invention. The first, while it remains unrepealed, is an estoppel of any future patent for the same invention. *Odiorne* v. *Amesbury Nail Factory*, 2 Mas., 30, 31.—STORY, J.; Mass., 1819.

7. Where two parties obtained several patents for an invention, and afterward applied for and obtained a joint patent therefor, *Held*, that neither party could set up the prior separate patents, and that neither was estopped by the separate patents from asserting that the invention was joint. *Stearnes* v. *Barrett*, 1 Pick., 447.—WILDE, J.; Mass., 1823.

8. A prior patent must be got rid of before a second can be taken out. If a prior patent is not surrendered, repealed, or declared void, it is a good defence to an action on the second patent. *Morris* v. *Huntington*, 1 Paine, 354.—THOMPSON, J.; N. Y., 1824.

9. Nor will a verdict of a jury in an action on the second patent avoid the first one. *Ibid.*, 356.

10. A person cannot have two subsisting valid patents at the same time for the same invention. But where a patentee had taken out a patent for an *original* invention, and upon an action for an infringement thereof, it was proved that as to a part of the invention he was not the *first* inventor, and therefore the court held that his patent was void, as being too broad, and afterward he took out another patent for those parts of his invention not known before, *Held*, that the two patents were not for the same invention. *Treadwell* v. *Bladen*, 4 Wash., 709.—WASHINGTON, J.; Pa., 1827.

11. But if such patents were substantially for the same invention, *query*, whether a disclaimer of all title under the first patent to the material parts of the invention for which granted, would not operate as an estoppel to any remedy for a violation of that patent. *Ibid.*, 709.

12. If a person has obtained a patent for a thing which he claims to have invented, he cannot at any future time claim another patent for a substantial part of the same thing. *Smith* v. *Ely*, 5 McLean, 88.—McLean, J.; Ohio, 1849.

13. A patentee cannot take out a subsequent patent for a portion of his first invention, and thereby extend his monopoly beyond the period limited by law. *O'Reilly* v. *Morse*, 15 How., 114.—Taney, Ch. J.; Sup. Ct., 1853.

14. But the validity of a patent cannot be impeached upon the ground that it is an improvement upon a former invention, for which the patentee has already obtained a patent. *Ibid.*, 122.

15. No subsequent patent can take away rights secured by a prior patent. *Sickles* v. *Tileston*, 4 Blatchf., 110.—Ingersoll, J.; N. Y., 1857.

16. Where an invention is substantially described and claimed in one patent, it cannot be made the subject of a claim in a subsequent one. *Sickles* v. *The Falls Co.*, 4 Blatchf., 509.—Nelson, J.; Ct., 1861.

**M.** Surrender and Reissue of.

See title Reissue of Patent.

**N.** Renewal and Extension of.

See title Extension of Patent.

**O.** Mistakes in Correction of.

See title Mistakes in Patent.

**P.** Construction of.

1. *General Principles of Construction.*

See also Ambiguity; Patent, D.; Specification, A.

1. The patent determines the nature and extent of the thing granted and secured to the patentee, and the plaintiff can claim no right which is not included in the patent, even though the patent is issued under a special act of Congress, and is not as broad as the law under which it was issued. His right is under the patent, and not under the law. *Evans* v. *Eaton*, Pet. C. C., 340.—Washington, J.; Pa., 1816.

2. The grant can only be for the discovery as recited in the patent and specification. *Ibid.*, 342.

3. The doctrine of patents may truly be said to constitute the metaphysics of the law. The difficulty lies, not so much in the general principles, as in the minute and subtle distinctions which arise occasionally in the application of those principles. *Barrett* v. *Hall*, 1 Mas., 472.—Story, J.; Mass., 1818.

4. Though the construction of the patent must certainly depend on the words of the instrument, where the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit us to explore, are entitled to great consideration. Therefore a special act may be referred

to, as well as the patentee's petition, and such a construction should be given to the grant as will make it, with such documents forming a part of it, not contradictory with itself. *Evans* v. *Eaton*, 3 Wheat., 506, 512.—MARSHALL, Ch. J.; Sup. Ct., 1818.

5. The patent and specification are connected together and dependent upon each other for support. The specification should maintain the title of the patent; the latter should not indicate one thing, and the former describe another, as the subject of the grant. *Sullivan* v. *Redfield*, 1 Paine, 450.—THOMPSON, J.; N. Y., 1825.

6. In deciding on the sufficiency of a patent, the court inspect the whole description as one paper, which they assume to be true in fact, and if found to be in conformity with the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention consists, though the description may be somewhat obscure, or imperfect, or defective, in form or mode of explanation, as claimed by the patentee, they will adjudge it sufficient. *Whitney* v. *Emmett*, Bald. Rep., 315.—BALDWIN, J.; Pa., 1831.

7. Where the invention is substantially new, is useful to the public, and the disclosure by the specification and other papers is made in good faith, and fairly communicated in terms intelligible to men who understand the subject, juries ought to look favorably on the right of property, and to find against a patentee or plaintiff only for some substantial defect in his title papers or proof. *Ibid.*, 322.

8. Patents for inventions are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor as *strictissimi juris*. *Ames* v. *Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

9. The Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be to promote the progress of science and the useful arts, an object as truly national, and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any over-nice and critical refinements. *Ibid.*, 485.

10. If the court can clearly see what is the nature and extent of the claim, by a reasonable use of the means of interpretation of the language used, then the patentee is entitled to the benefit of it, however imperfectly and unartificially he may have expressed himself; and for this purpose particular phrases are not to be singled out, but the whole is to be taken in connection. *Ibid.*, 485.

11. It is a clear rule of our law in favor of inventors, and to carry into effect the obvious object of the constitution and laws, to give a liberal construction to the language of all patents and specifications, *ut res magis valeat quam pereat*, so as to protect, and not to destroy, the rights of real inventors. *Ryan* v. *Goodwin*, 3 Sumn., 520.—STORY, J.; Mass., 1839.

12. Under the laws of the United States, patents for inventions are treated as a just reward to ingenious men, and as highly beneficial to the public. They are therefore clearly entitled to a liberal construction, since they are not

granted as restrictions upon the rights of the community, but are granted "to promote science and the useful arts." *Blanchard* v. *Sprague*, 3 Sumn., 539, 540.—STORY, J.; Mass., 1839.

13. Every patent is a monopoly, and nothing can justify it but the natural right of property which a man has in the products of his own labor and ingenuity. It is in derogation of common right, and should be strictly confined to the case excepted. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

14. In "patents" the court looks through the whole patent and specification, in order to ascertain what is the thing claimed and patented in it. There is no artificial or universal rule of interpretation of such an instrument beyond that which common sense furnishes, which is to construe the instrument as a whole, and extract from the descriptive words and the claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 446, 447.—STORY, J.; Mass., 1843.

15. In construing a patent we are not to look alone to the descriptive words contained in the letters patent, but we are to construe those words in connection with the specification which is always annexed to and made part of the letters patent. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Me., 1843.

16. Therefore, where in the specification the patentees began by saying that they "have invented a new and improved combination of machinery for separating grain from the straw and chaff as it proceeds from the threshing machine," *Held* that this showed that the patentees claimed the entire combination of the machinery. *Ibid.*, 622.

17. In the summing up of their invention, they also claimed four distinct improvements in the machinery, *Held*, the two being construed together (as they should be), that the patentees not only claimed the entire machinery in combination, but also the four improvements enumerated. *Held*, also, that if they are their invention, there is no objection in point of law to their claim. *Ibid.*, 621, 622.

18. A patent must be construed and passed upon according to the laws in force at the time of the granting of it. The subsequent repeal of such acts cannot impair the right of property existing in a patentee. *McClurg* v. *Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

19. The patent law gives a monopoly, but not in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefit. To remunerate inventors for "their time, ingenuity, and expense," the law gives them the exclusive right of selling their invention for a limited period; and to secure them this remuneration, a liberal construction should be given to the law. *Brooks* v. *Bicknell*, 3 McLean, 437.—MCLEAN, J.; Ohio, 1844.

20. A liberal construction is to be given to a patent, and inventors sustained, if practicable, without a departure from sound principles. *Davoll* v. *Brown*, 1 Wood. & Min., 57.—WOODBURY, J.; Mass., 1845.

21. Sometimes the preamble, even, may be resorted to for ascertaining the object of the specification, sometimes the body of the specification, sometimes the summing up, and sometimes

the formal clause at the end of the specification. Generally, all of them are examined together, unless the formal clause seems explicitly to exclude the rest. *Ibid.*, 59.

22. Matters described therein should be considered in a practical manner, and not be decided on mere metaphysical distinctions. *Ibid.*, 60.

23. One patent, though very useful and economical in the manufacture or use of another invention, before patented, cannot be treated as a part and parcel of such other patent, so as to render available in an action upon one of such patents, long possession under and recoveries upon such other patent, where the several patents and specifications do not refer to each other as being auxiliary to one another; but each patent must stand upon its own merits. *Hovey* v. *Stevens*, 1 Wood. & Min., 295, 296.—WOODBURY, J.; Mass., 1846.

24. A patent is to be construed or tested by the acts in force at the time of its issue. *Hogg* v. *Emerson*, 6 How., 479.—WOODBURY, J.; Sup. Ct., 1847.

25. The true rule of construction in respect to patents and specifications, is to apply to them plain and ordinary principles, and not to yield to subtleties and technicalities unsuited to the subject, and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate and unskilled in business as men of genius and inventors usually are. *Ibid.*, 485.

26. The description of an invention by the patentee in his own language, as contained in the specification, is the highest evidence of the thing or instrument which he claims to have discovered. *Many* v. *Jagger*, 1 Blatchf., 377.—NELSON, J.; N. Y., 1848.

27. Patents, securing to inventors the just reward of their labor and industry, are to be construed liberally. These exclusive rights are not to be viewed in the light of odious monopolies, but as the result of a policy at once beneficent and wise. *Parker* v. *Stiles*, 5 McLean, 54.—LEAVITT, J.; Ohio, 1849.

28. The whole instrument—that is, the patent, embracing the specification and drawings—is to be taken together; and if from these, the nature and extent of the claim can be perceived, the court is bound to adopt that interpretation, and give it full effect. *Ibid.*, 57.

29. A patent-right is not a monopoly in the general sense of that term. The inventor takes nothing from society,—he confers upon it a benefit by his labor and ingenuity, and the law designs to give him nothing more than a compensation therefor. *Bloomer* v. *Stolley*, 5 McLean, 162.—MCLEAN, J.; Ohio, 1850.

30. In construing a patent, regard may be had to what is contained in a caveat in the first specification, and in the original patent, and a broader construction should not be put on the language of the patentee than the whole subject matter, and description, and nature of the case seem to indicate as designed. No fancied construction travelling too far on a new and doubtful road, is to be adopted; but rather what is natural and clear, considering what already exists on the same subject. *Smith* v. *Downing*, 1 Fisher, 69.—WOODBURY, J.; Mass., 1850.

31. The drawings as well as the whole specifications may be looked to for explanation of any thing obscure in the patent. And the drawings may be restored when burnt, and if appearing in some respects erroneous, may be cor-

rected. *Hogg* v. *Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

32. The opinion of experts cannot be received as to the construction of a patent. Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum;* but not as to the construction of written instruments. *Corning* v. *Burden*, 15 How., 270.—GRIER, J.; Sup. Ct., 1853.

33. Patents are granted "to promote science and useful arts." They are not odious monopolies or restrictions on the rights of the public; and courts are bound to give the specification a liberal construction, and not annul its benefits by formal or subtle objections. *Goodyear* v. *Railroads*, 2 Wall., Jr., 363.—GRIER, J.; N. J., 1853.

34. 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. The description ought not to be repugnant to the specification, but if it honestly sets forth the *nature and design* of the patent, it is sufficient. *Ibid.*, 364.

35. The specification must be looked to for the full disclosure of the discovery and the extent of the inventor's claims. The extent of the patentee's rights must be judged from the whole instrument taken together, and not from any one sentence. *Ibid.*, 364, 365.

36. The construction to be given to a specification should not be too strict and technical, but the proper inquiry is, has the inventor communicated to the public the manner of carrying his invention into effect, so that a skilful workman can carry it into execution. *Stephens* v. *Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

37. A patent is not a monopoly. A monopoly takes from the public what belongs to it, and gives it to the grantee, whereas the right of a patentee rests entirely on his own invention or discovery of that which was useful, and which was not known before. The law gives him the exclusive right and use of the thing invented or discovered as a compensation for his ingenuity, labor, and expense in producing it. *Allen* v. *Hunter*, 6 McLean, 306.—MCLEAN, J.; Ohio, 1855.

38. The words of the specification are to be taken together, and they are to be so construed as to give effect to the meaning and intention of the persons using them. Words are not to be distorted, so as to affect what may be supposed to have been the intention of the one using them; but they are to have a reasonable construction, as connected with the sentence in which used. *Ibid.*, 307.

39. A specification as to a chemical compound, is not addressed to those who are not acquainted with chemistry. *Ibid.*, 307, 310.

40. Courts will always construe specifications favorably to the patentee, but they cannot make a new specification with more extensive claims than the original, or stop the course of inventors by a fanciful application of the doctrine of equivalents. *Sickles* v. *Glou. Man. Co.*, 1 Fisher, 238.—GRIER, J.; N. J., 1856.

41. It is a presumption of law that what a patentee does not distinctly assert to be his invention was known before. *Smith* v. *Higgins;* MS.—BETTS, J.; N. Y., 1857.

42. In the construction of a patent, the entire specification is to be taken together, as embracing the particular description which the law requires of

the discovery, the manner of construction, and the claim of the patentee. They emanate from the same pen—the one cannot contradict the other. *Page* v. *Ferry*, 1 Fisher, 302.—WILKINS, J.; Mich., 1857.

43. The intention of the inventor, so as to effect the object designed, is to govern the construction of the language employed. 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. *Ibid.*, 302.

44. Patents are to be construed liberally—the rights secured are to be protected against any substantial violation. Formal and subtle differences are to be disregarded. *Imlay* v. *N. & W. R. R.*, 4 Blatchf., 237.—INGERSOLL, J.; Ct., 1858.

45. Patents are to be construed liberally, and not rigidly interpreted; and it is to be presumed that the Commissioner of Patents has done his duty, and not granted a patent when he ought not to have granted one. *Potter* v. *Holland*, MS.—INGERSOLL, J.; Ct., 1858.

46. A patentee is not controlled by the *title* of his patent, but by all the papers, the patent, the specification, and drawings taken together. *Bell* v. *Daniels*, 1 Fisher, 374.—LEAVITT, J.; Ohio, 1858.

47. In construing the patent—the specifications and drawings—the court will examine them with a liberal spirit, so as to give to the patentee all that, as an inventor, he is fairly entitled to, though nothing more. *Ibid.*, 374.

48. All exclusive rights in the nature of patents are created and must be controlled by statutory provisions, and therefore it must appear that all the essential requisites of the law have been complied with. In deciding this question, the patent, specification, and drawings are to be looked to, and are to be construed in a liberal spirit. *Latta* v. *Shawk*, 1 Fisher, 488.—LEAVITT, J.; Ohio, 1859.

49. Specifications should be construed according to their spirit, and so that they shall receive an interpretation that will, if practicable, effect the end and object designed. *Judson* v. *Moore*, 1 Fisher, 550.—LEAVITT, J.; Ohio, 1860.

## 2. *Prima Facie Authority of.*

1. Of the novelty and utility of an invention, the patent is to be considered merely *prima facie* evidence of a very slight nature. *Lowell* v. *Lewis*, 1 Mas., 184.—STORY. J.; Mass., 1817.

2. Upon a trial at law, a patent is *prima facie* evidence of a right; but it is not a matter of course, to grant an injunction upon the mere exhibition of a patent, and an allegation that it has been infringed. *Sullivan* v. *Redfield*, 1 Paine, 447.—THOMPSON, J.; N. Y., 1825.

3. As a patentee is required to make oath that he is the true inventor of the thing patented, before he can obtain a patent, the patent is regarded by the courts of the United States as *prima facie* evidence that he has made the invention. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet. 459.—STORY, J.; Sup. Ct., 1840.

4. In an action of infringement, the patent is *prima facie* evidence in the case—the patent recites and also includes the oath, and the oath throws the *onus probandi* on the defendants. *Alden* v. *Dewey*, 1 Story, 341.—STORY, J.; Mass., 1840.

5. A patent gives to the patentee a *prima facie* right, unless the defendants show it to be invalid, or that it can-

not operate against them. *Brooks* v. *Bicknell*, 3 McLean, 440.—McLean, J.; Ohio, 1844.

6. A patent issued under the patent acts (since 1836), requiring an examination of skilful persons into the specification and the subject of the claim, affords more evidence of the originality of the invention, than when granted as a matter of course, under the former acts, and only supported by the oath of the patentee. *Orr* v. *Badger*, 7 Law Rep., 467.—Sprague, J.; Mass., 1844.

7. The patent itself is sufficient evidence that all the preliminary steps required by law in reference to the grant or issuing of it, were properly taken. *Wilder* v. *McCormick*, 2 Blatchf., 34. —Betts, J.; N. Y., 1846.

8. A joint patent is *prima facie* evidence that the invention was joint, but such fact may be disproved at the trial. *Hotchkiss* v. *Greenwood*, 4 McLean, 462.—McLean, J.; Ohio, 1848.

9. The presumption of novelty and usefulness, arising from the *prima facie* character of the patent, may be rebutted by affidavits on the application for an injunction, where the patent is not ancient. Whether it may be when the patent has been renewed under the act of 1836; *query*. *Wickershaff* v. *Jones*, Whart. Dig., vol. 2, p. 413.—Kane, J.; Pa., 1848.

10. The provisions of the act of 1836, give a *quasi*-judicial character to the action of the Commissioner of Patents; and it has accordingly been generally and justly held, that the patent itself is to be taken as *prima facie* evidence of the novelty and usefulness of the invention specified in it. *Wilson* v. *Barnum*, 1 Wall., Jr., 349.—Kane, J.; Pa; 1849.

11. The patent is *prima facie* evidence that the patentee is the original inventor or discoverer of the thing patented, and that the same is new and useful. *Goodyear* v. *Day*, MS.—Grier, J.; N. J., 1852.

12. A patent issued, grounded on the oath of the patentee, is *prima facie* evidence in an action of infringement of such patent. *Fultz*, *Ex parte*, MS. (App. Cas.)—Morsell, J.; D. C., 1853.

13. Under the act of 1790, a patent was made *prima facie* evidence; that act was repealed by the act of 1793, and that provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, but the plaintiff was bound to prove these facts, in order to make out his case. But the act of 1836, introduced a new system, and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of the facts asserted in it. *Corning* v. *Burden*, 15 How., 270, 271.—Grier, J.; Sup. Ct., 1853.

14. A defendant in a patent suit, using a machine patented to him, should have the benefit of a like presumption, in his favor, arising from an investigation of the originality of his invention, as the plaintiff has by reason of his patent. *Ibid.*, 271.

15. Though ordinarily a patent is *prima facie* evidence that the discovery claimed is new and useful, if it is apparent from the specification that the patent is for an invention which is manifestly frivolous, and which cannot be sustained, it is competent for the court to declare it to be inoperative for such cause. *Wilson* v. *Jones*, 3 or 4 Blatchf. —Betts, J.; N. Y., 1854.

16. Under the patent laws, the claim of a patent, before a patent is issued, being subjected to a thorough examina-

tion, made by examiners appointed for that purpose, gives to the patentee a *prima facie* right to the invention or discovery claimed. He who disputes such right, must produce evidence to counterbalance that legal presumption. *Allen* v. *Hunter*, 6 McLean, 304, 305. —McLean, J.; Ohio, 1855.

17. The *prima facie* right of a patentee in a patent is derived from the examination of the invention, before patent is issued, by one or more examiners, and a comparison of it with the patents issued in this and other countries; if found to be new and useful, and the applicant swears he is the first and original inventor, the patent issues. *Heinrich* v. *Luther*, 6 McLean, 346.—McLean, J.; Ohio, 1855.

18. The patent is *prima facie* evidence that the plaintiff was the first and original inventor of the improvement claimed, and of its utility. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 320.—Nelson, J.; N. Y., 1855.

19. The patent itself is *prima facie* evidence of novelty, and this *prima facie* evidence is strengthened by the fact of renewal of the patent. *Wintermute* v. *Humphrey*, MS.—Wilson, J.; Ohio, 1856.

20. The patent is *prima facie* evidence of the novelty of the thing patented. *Teese* v. *Phelps*, 1 McAllis., 49. —McAllister, J.; Cal., 1855.

21. A patent is *prima facie* evidence of the facts of first and original invention and utility, and must prevail, unless there is other evidence to overcome such *prima facie* presumption; and where there has been a renewal, such renewal is also *prima facie* evidence upon these questions, and of course adds weight to the *prima facie* evidence furnished by the original patent. *Ransom* v. *Mayor*, &c., 1 Fisher, 258. —Hall, J.; N. Y., 1856.

22. A patent when introduced in evidence, whether it be an original or reissued one, is *prima facie* evidence that the thing granted was new and useful, and that the patentee was the inventor or discoverer thereof. *Serrell* v. *Collins*, MS.—Ingersoll, J.; N. Y., 1857.

23. A foreign patent is only *prima facie* evidence as a patent granted by our own government, that the invention was of some probable value. *Gatling* v. *Newall*, 9 Ind., 582.—Perkins, J.; Ind., 1857.

24. The patent is *prima facie* evidence that the thing patented was new, and the invention of the patentee at the time the patent was granted. *Gibberd* v. *Bagot*, MS.—Ingersoll, J.; N. Y., 1857.

25. Since the act of 1836 patents stand upon a different footing from that upon which they stood formerly. Upon an application for a patent, the officers of the Patent Office give their judgment, and that judgment is *prima facie* a good one; when one party contests that, and offers another patent in opposition to it, both parties stand upon an equal footing. *Cong. Rub. Co.* v. *Amer. Elas. Cloth Co.*, MS.—Grier, J.; Pa., 1857.

26. A patent when produced in evidence, is *prima facie* evidence that the patentee was the inventor, that the thing patented was new and useful, and that in the specification there is 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. And such *prima facie* evidence must control until it is rebutted by countervailing evidence. *Poppenheusen* v. *N. Y. G. P. Comb Co.*

2 Fisher, 67.—INGERSOLL, J.; N. Y., 1858.

27. The patent itself is *prima facie* evidence of all facts upon which it is founded, and requires no support until it is impeached, or attempted to be impeached. *Sherman* v. *Champ. Trans. Co.*, 31 Verm., 176.—REDFIELD, J.; Vt., 1858.

28. A patent is *prima facie* evidence that the thing described in it is new, and must control the question unless countervailed by the defendant's evidence. *Waterbury Brass Co.* v. *N. Y. & Brooklyn Brass Co.*, 3 Fisher, 48.—INGERSOLL, J.; N. Y., 1858.

29. A patent is *prima facie* evidence that the grant of right in it is valid, that the things described in it are new and useful, that they required invention, and that they were the invention of the patentee; and such *prima facie* evidence must have full effect unless rebutted by sufficient countervailing evidence. *Potter* v. *Holland*, 4 Blatchf., 241.—INGERSOLL, J.; Ct., 1858.

30. The patent raises a presumption of the originality of the invention. *Bell* v. *Daniels*, 1 Fisher, 375.—LEAVITT, J.; Ohio, 1858.

31. The patent is *prima facie* evidence that the patentee is the first and original inventor of the improvements described. *Cahoon* v. *Ring*, 1 Fisher, 403.—CLIFFORD, J.; Me., 1859.

32. The patent is *prima facie* evidence that the patentee was the first inventor of the thing patented, which will control in determining the question of fact unless there is evidence to rebut this presumption. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

33. There is a presumption arising from the patent itself in favor of the novelty of the invention which it covers. But this presumption may be overcome by showing that the thing had been previously known. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

34. The patent itself affords *prima facie* evidence of utility; the defendant may rebut this presumption, and if it appear that the invention is utterly worthless, it is a good defence. *Vance* v. *Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

35. The patent is *prima facie* evidence of the right of the plaintiff to all that is contained in it. *Johnson* v. *Root*, 1 Fisher, 354.—SPRAGUE, J.; Mass., 1859.

36. It is always presumed from the patent itself, that the invention is new, and if the party sued would avail himself of the want of such novelty, it is incumbent upon him to prove it by giving a proper notice to the plaintiff, to prevent surprise. *Latta* v. *Shawk*, 1 Fisher, 468.—LEAVITT, J.; Ohio, 1859.

37. There is a presumption arising from the patent itself, that an invention is of some degree of utility; but this is not conclusive, and the other party may show that it is useless and worthless. *Lee* v. *Blandy*, 2 Fisher, 95.—MCLEAN, LEAVITT, JJ.; Ohio, 1860.

38. The *prima facie* force of a patent, as to priority of invention, on the part of the patentee, when once destroyed by evidence of prior invention on the part of another, cannot be restored by the patent itself, but only by specific testimony from witnesses. *Barstow* v. *Swan*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

39. The granting of a patent affords *prima facie* evidence of the novelty, as well as utility of the invention. *Judson* v. *Moore*, 1 Fisher, 551.—LEAVITT, J.; Ohio, 1860.

CONSTRUCTION OF; BY THE COURT.

3. *How far construed by the Court.*

1. Whether an invention be specifically described with reasonable certainty is a question of law upon the construction of the patent. *Lowell* v. *Lewis*, 1 Mas., 188.—STORY, J.; Mass., 1817.

2. Though the question as to the utility of an invention is one for the jury, if, on the plaintiff's own showing, the invention appears to be useless, and an imposition on the public, it may be doubtful whether the court would transcend its limits in deciding that the invention was not useful. *Langdon* v. *De Groot*, 1 Paine, 294.—LIVINGSTON, J.; N. Y., 1822.

3. It is the province of the court to construe every written instrument offered in evidence, and therefore to construe a patent and determine whether it is so uncertain in its terms as to have no meaning. *Davis* v. *Palmer*, 2 Brock., 308.—MARSHALL, Ch. J.; Va., 1827.

4. The court decides whether there is in the patent a substantial description of the thing patented; the papers will be looked at in the same light as a declaration in a suit at law. The court, looking at the specification as a statement of the patentee's right and title, will overlook all defects in the mode of setting it out, if it contains a substantial averment of such matter as suffices in law to make out a cause of action. The court does not look beyond the patent and papers. *Whitney* v. *Emmett*, Bald., 315.—BALDWIN, J.; Pa., 1831.

5. Whether the invention is sufficiently described in the patent is a question of law for the court, it being the construction of a written instrument. *Brooks* v. *Bicknell*, 3 McLean, 442.—McLEAN, J.; Ohio, 1844.

6. But if technical terms are used, evidence may be heard in explanation of those terms, and in such case a jury may be necessary. *Ibid.*, 442.

7. As a general rule, the court is to determine the invention claimed by the patentee, so far as the construction of the words of the patent and specification are concerned; but as to the meaning of words of art, and technical phrases in commerce and manufactures, which may materially affect, enlarge or control the meaning of the words of the patent and specification, the jury are to judge. *Washburn* v. *Gould*, 3 Story, 157, 158.—STORY, J.; Mass., 1844.

8. It is the duty of the court to give the legal construction of the specification of a patent, when such construction does not depend, which seldom is the case, on facts to be proved by parol, or when it does, if those facts are proved or admitted, and are without dispute. *Davoll* v. *Brown*, 1 Wood. & Min., 56. —WOODBURY, J.; Mass., 1845.

9. It is a question for the court, and not the jury, whether the specification can be read and construed intelligibly in a particular way. *Ibid.*, 60.

10. It is the province and duty of the court to settle the meaning of the patent, and if that cannot be satisfactorily ascertained upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. *Emerson* v. *Hogg*, 2 Blatchf., 6.—BETTS, J.; N. Y., 1845.

11. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented to support or defeat the patent are to be examined and applied as if the construction fixed by the

court had been incorporated in the specification. *Ibid.*, 6.

12. Where, therefore, the court held that the question of ambiguity was a mixed question of law and fact, and left a fact to be found by the jury, indicating the rule of law that would govern when that fact should be ascertained, *Held*, that such action or ruling of the court was erroneous, and was cause for ordering a new trial. *Ibid.*, 6.

13. The sufficiency of a description in a specification is, in general, in patents for a composition of matter, as well as in patents for machines, a question of fact for the jury; but when the specification of a new composition of matter gives only the names of the substances to be mixed together, without stating any relative proportion, it is the duty of the court to declare the patent void. *Wood* v. *Underhill*, 5 How., 5.—TANEY, Ch. J.; Sup. Ct., 1846.

14. The question whether the patent is sufficiently clear and certain in its description of the invention is one of law only in part, or so far as regards the construction of the written words used. *Hogg* v. *Emerson*, 6 How., 484.—WOODBURY, J.; Sup. Ct., 1847.

15. It is for the court to decide whether the patent, as to the description of the invention, conforms to the requirements of the law.—*Parker* v. *Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849.

16. What a patentee claims as his invention is a question of law, and one to be determined by the court, in order to give to the jury a guide to apply to the facts in the case. *Buck* v. *Hermance*, 1 Blatchf., 401.—NELSON, J.; N. Y., 1849.

17. The interpretation of the specification of a patent is a matter exclusively for the court, who must explain it. The import of the instrument is purely a question of law. *Parker* v. *Hulme*, 7 West. Law Jour., 419.—KANE, J.; Pa., 1849.

18. What is the thing patented, is a question of law, to be determined by the court from the letters patent, and the description of the invention and claim annexed to them. *Winans* v. *Denmead*, 15 How., 338.—CURTIS, J.; Sup. Ct., 1853.

19. The construction of the specification of a patent, so far as the language is concerned, is a question for the court. *Teese* v. *Phelps*, 1 McAllis., 49.—McALLISTER, J.; Cal., 1855.

20. It is the business and duty of the court to construe the patent and specifications for the purpose of determining what the claim of the discovery or invention is. *Wintermute* v. *Redington*, 1 Fisher, 247.—WILSON, J.; Ohio, 1856.

21. The construction of the claims of a patent is a question of law, exclusively for the court, and not for the determination of a jury, unless there may be technical terms, or terms which need explanation by the evidence given before the jury. *Ransom* v. *Mayor, &c.*, 1 Fisher, 260.—HALL, J.; N. Y., 1856.

22. The question, what is the grant which a patent purports to make, is a question of law, and must be determined by the court; and the jury are to consider that the patent grants that which the court determines it to grant. *Serrell* v. *Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

23. It belongs to the court to construe the patent, and declare what the discovery or invention is which the patentee describes and claims. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

24. So far as the patent and specification are concerned, the interpretation of the language employed by the patentee is with the court. *Page* v. *Ferry*, 1 Fisher, 301.—WILKINS, J.; Mich., 1857.

25. It is a question of law, to be decided by the court, what the patent purports to grant. *Waterbury Brass Co.* v. *N. Y. & Brooklyn Brass Co.*, 3 Fisher, 47.—INGERSOLL, J.; N. Y., 1858.

26. In the trial of a suit for the violation of a patent-right, the court cannot be compelled to receive the testimony of experts as to the proper or legal construction of the patent. A judge may, however, obtain information from them if he desire it, on matters which he does not clearly apprehend. *Winans* v. *N. Y. & E. R. R. Co.*, 21 How., 101. —GRIER, J.; Sup. Ct., 1858.

27. The court determines what the patent purports to grant. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

28. The construction of a patent falls to the court as a matter of law, depending sometimes, perhaps, upon the technical use of terms, if there be such, which have a use different from the usual and ordinary acceptation of them, and thus far may be matters of fact for the jury. *Johnson* v. *Root*, 1 Fisher, 354.—SPRAGUE, J.; Mass., 1858.

4. *How far construed by the Jury.*

See also JURY.

1. Whether the specification contains the whole truth, and, if not, whether the concealment was with intent to deceive, and whether it is as to a material point, are questions for the decision of a jury. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. Whether a concealment in a patent arose from any fraudulent intent, is a question for the jury. *Gray* v. *James*, Pet., C. C., 401.—WASHINGTON, J.; Pa., 1817.

3. It is for the jury to decide whether the specification is so uncertain as not to enable a skilful workman to understand the improvement, and carry into execution the plan of the inventor. In deciding such question, however, the jury will give a liberal, common sense construction of the directions contained in the specification. *Davis* v. *Palmer*, 2 Brock., 308.—MARSHALL, Ch. J.; Va., 1827.

4. The court decide, as to the sufficiency of a patent, whether the statements are sufficient in law; it is a question for the jury to decide whether the statements are true in fact. The court does not look beyond the patent and other papers, but the jury decide from the papers, the evidence of the witnesses, an inspection of the old and new machine, and the models, to ascertain whether in point of fact the specification, as made out at the trial, is sufficient. *Whitney* v. *Emmett*, Bald., 315. —BALDWIN, J.; Pa., 1831.

5. Objections to a patent, that the specification does not sufficiently describe the invention; or that the invention is not new; that a renewed and the original patent are not for the same invention; or that the patent was obtained with a fraudulent intent; all involve matters of fact which belong to the province of the jury, upon the evidence. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 441.—STORY, J.; Mass., 1843.

6. It is a question of law for the court whether the invention is sufficiently described in the patent. But if technical

terms are used, evidence may be given in explanation of such terms, and in such a case a jury may be necessary. *Brooks* v. *Bicknell*, 3 McLean, 442.—McLean, J.; Ohio, 1844.

7. It is a question of fact for the jury, whether the description is so particular as to enable a mechanic to construct the thing in question. *Ibid.*, 442.

8. The court is bound to state what in law is the invention claimed, so far as the construction of the patent and the specification is concerned. But the jury are to judge of the meaning of words of art, and technical phrases in commerce and manufactures, and of the surrounding circumstances, which may affect, enlarge, or control the meaning of the words of the patent and specification. *Washburn* v. *Gould*, 3 Story, 157, 158.—Story, J.; Mass., 1844.

9. The sufficiency of the description in a specification is, in general, in patents for a composition of matter, as well as in patents for machines, a question of fact for the jury. *Wood* v. *Underhill*, 5 How., 4.—Taney, Ch. J.; Sup. Ct., 1846.

10. It is for the jury to decide, whether from the evidence, the description of an invention in a patent is sufficiently full, clear, and exact, to enable a skilful mechanic to construct the thing described. *Parker* v. *Stiles*, 5 McLean, 55.—Leavitt, J.; Ohio, 1849.

11. Where the effect and operation of mechanical contrivances, which are matters of skill, and to be determined by experts, enter into the question of the extent of a patented combination, the question is a mixed one of law and fact, and proper to be determined by the jury under the instruction of the court. *Foote* v. *Silsby*, 1 Blatchf., 458, 465.—Nelson, J.; N. Y., 1849.

12. Where the question as to the extent of a combination as patented, was treated by the defendants as a question of fact, and was accordingly submitted as such to the jury, the defendant cannot afterward object to such action of the court, on the ground that the court should have determined the nature and extent of the combination, as a matter of law, from the specification. *Ibid.*, 465.

13. Where a claim was for a combination which did not point out and designate the particular elements which composed the combination, but only declared that the combination was made up of so much of the described machinery as effected a particular result, *Held*, it was a question of fact which of the described parts were essential to that result; and to this extent, not the construction, but the application, of the claim should be left to the jury. *Silsby* v. *Foote*, 14 How., 226.—Curtis, J.; Sup. Ct., 1852.

14. The jury are to determine from the facts in a case, whether the specifications, including the claim, are so precise as to enable any skilful person to make the thing described. *Battin* v. *Taggert*, 17 How., 85.—McLean, J.; Sup. Ct., 1854.

15. The application of the facts to the specification or patent, as construed by the court, is for the jury. *Teese* v. *Phelps*, 1 McAllis., 49.—McAllister, J.; Cal., 1855.

16. It is a question of fact for the jury, whether the description in the patent is so vague or uncertain that a competent workman, in the particular business covered by the patent, could not, from the specification and drawing, construct the machine. *Page* v. *Ferry*, 1 Fisher, 301, 302.—Wilkins, J.; Mich., 1857.

17. It is exclusively the province of the jury to ascertain and determine whether the patentee is the original inventor of the thing patented, and whether it embraces the thing used by the defendants. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

18. Whether the description in a specification is sufficiently full, clear, and exact, to enable a person skilled in the art to construct the invention, is a question of fact for the jury. *Judson* v. *Moore*, 1 Fisher, 547.—LEAVITT, J.; Ohio, 1860.

### 5. *Force and Construction of Claim.*

1. In all cases where the patentee claims any thing as his own invention, in his specification, courts of law cannot reject the claim; and if included in the patent, and found not to be new, the patent is void, however small and unimportant such asserted invention may be. *Moody* v. *Fiske*, 2 Mas., 118.—STORY, J.; Mass., 1820.

2. Where a patentee in his specification states and sums up the particulars of his invention, and his invention covers them, he is confined to such summary, and cannot afterward be permitted to sustain his patent by showing that some part which he claims in his summing up as his invention, though not in fact his invention, is of slight value, or importance in his patent. *Ibid.*, 118.

3. The summing up of the invention in a specification is a limitation to the thing patented. *Whitney* v. *Emmett*, Bald., 313.—BALDWIN, J.; Pa., 1831.

4. If the court, taking the whole patent together, can perceive the nature and extent of the claim, it is bound to adopt such interpretation, and give it effect. *Ryan* v. *Goodwin*, 3 Sumn., 520.—STORY, J.; Mass., 1839.

5. Where a patentee disclaimed the mechanical powers by which the movements of his invention were obtained, and claimed "as his invention the method or mode of operation in the abstract explained in the second article," and in such second article described a machine of a particular structure, whose modes of operation were pointed out, to accomplish a particular purpose or end, *Held*, by the court, that the invention was of a particular machine, constituted in the way pointed out, for the accomplishment of a particular end or object, and that the patent was for a machine, not a function or principle detached from machinery. *Blanchard* v. *Sprague*, 3 Sumn., 536, 537, 540.—STORY, J.; Mass., 1839.

6. In order to ascertain the true construction of the specification, as to what is granted by the patent, we must look to the summing up of the invention, and the claim therefor asserted in the specification; for 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 rights and title. *Wyeth* v. *Stone*, 1 Story, 285.—STORY, J.; Mass., 1840.

7. The patentee must describe, with reasonable certainty, in what his invention consists, and what his particular claim is. *Ibid.*, 286.

8. Resort can be had to the introduction of the specification, as well as the summing up at the close, to ascertain the true extent of the claim. *Hovey* v. *Stevens*, 1 Wood. & Min., 294.—WOODBURY, J.; Mass., 1846.

9. Where there is a summary setting out the claim to some particular novelty, that is to govern; but if it 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. *Hovey* v. *Stevens*, 3 Wood. & Min., 21.—WOODBURY, J.; Mass., 1846.

10. The claim in a specification was, that any irregular surface or form could be turned by the machine like the model, but in fact a square shoulder could not be turned; *Held*, that it was too remote and extreme a defect to vitiate the patent. *Blanchard's Gun-Stock Turning Co.* v. *Warner*, 1 Blatchf., 280.—NELSON, J.; Ct., 1846.

11. If a patentee chooses to cover the material of which a part of his machine is made, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. *Aiken* v. *Bemis*, 3 Wood. & Min., 354.—WOODBURY, J.; Mass., 1847.

12. Where a patentee claimed a hammer in a saw-set, of wrought iron faced with steel, alleging that he found upon experiment that all steel hammers were much more liable to break, and wrought iron ones more durable, and therefore confined his specification to wrought iron ones with steel points, *Held*, in an action for infringement against a person using a hammer wholly of steel, that it was a matter of doubt, whether the use of such a hammer was a violation of the patent. *Ibid.*, 354.

13. The claim is the most material part of the specification. It 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 a patent. *Many* v. *Jagger*, 1 Blatchf., 378.—NELSON, J.; N. Y., 1848.

14. If an inventor sums up the particulars of his invention, he is confined and held to such summary, and his patent must stand or fall by it. *Parker* v. *Sears*, 1 Fisher, 99.—GRIER, J.; Pa., 1850.

15. The claim or summing up is not to be taken alone, but in connection with the specification and drawings. The whole instrument is to be contrued together; but the other parts are to be looked to only for the purpose of correctly interpreting the claim. *Brooks* v. *Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

16. Where the claim does not point out and designate the particular elements which compose a combination, but only declares 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 that result; and to this extent, not the construction, but the application of the claim should be left to the jury. *Silsby* v. *Foote*, 14 How., 226.—CURTIS, J.; Sup. Ct., 1852.

17. The use of a known equivalent is an infringement; although the patentee has not expressly claimed equivalents, he is understood to embrace them, and in contemplation of law does embrace them, without any express mention. *Byam* v. *Farr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

18. But the patentee is not obliged to embrace equivalents in his claim. He may, if he choose, confine himself to the specific ingredients or things, and expressly exclude all others; or expressly exclude some or one other. If he does so, the use of the thing disclaimed is no infringement. *Ibid.*, 263.

19. It is for the parts *claimed* as the invention of the patentee, and as such particularly pointed out, that the patent issues. It covers no more; and the

patentee is not bound to prove the originality of what is *not* in it to make it a protection for what is in it. *Holliday* v. *Rheem*, 18 Penn., 469.—BLACK, Ch. J.; Pa., 1852.

20. The claim, or summing up, is not to be taken alone, but in connection with the specification and drawings; the whole instrument is to be construed together. But the latter are to be looked to only for the purpose of enabling the court correctly to interpret the claim. *Brooks* v. *Fiske*, 15 How., 215.—CATRON, J.; Sup. Ct., 1853.

21. A patentee may so restrict his claim as to cover less than he invented, or may limit it to one particular form of machine, excluding all other forms, though they embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise. *Winans* v. *Denmead*, 15 How., 341.—CURTIS, J.; Sup. Ct., 1853.

22. Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. *Ibid.*, 343.

23. A patentee may limit his claim in his specification to one particular form of machine, and exclude all others. In such a case he is secured only to the particular form claimed. The patent law was intended to secure to the inventor his whole invention or discovery, but not unless he claimed to be secured in the whole. If he claims only a part, such part is only secured to him. *Amer. Pin Co.* v. *Oakville Pin Co.*, 3 Blatchf., 193; 3 A. L. R., 138.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1854.

24. No more can be secured by the patentee than he has invented or discovered; and no more can be secured than is claimed to be secured in the specification. *Ibid.*, 138.

25. The phrase "or the equivalent therefor," in machinery, extends to improvements substantially the same as those described involving the same principle, and embracing all alterations merely colorable, but does not include a claim to any other invention equivalent or equal to the one described—this would be to include all modifications or improvements in the machine. *McCormick* v. *Manny*, 6 McLean, 557.—MCLEAN, J.; Ill., 1855.

26. In construing a claim we must look at the entire specification and drawings, and view each part by the light thrown on it by the whole; and though there is an erroneous description as to how a certain part enters into a combination, if there is enough left clearly and certainly to correct the mistake, the patent will be sustained. *Kittle* v. *Merriam*, 2 Curt., 479, 480.—CURTIS, J.; Mass., 1855.

27. Formerly a strict construction was given, in this country and in England, to the claims of a patentee, but a more favorable and liberal view is now taken of his claim. He must describe it within the law; but courts do not go beyond the law for technical objections to defeat it. *Allen* v. *Hunter*, 6 McLean, 311.—MCLEAN, J.; Ohio, 1855.

28. When a patentee claims several distinct improvements, he must establish his right to each, to sustain an action. *Heinrich* v. *Luther*, 6 McLean, 346.—MCLEAN, J.; Ohio, 1855.

29. Patentees should not, in their claim, confound *specific* with *generic* description, and so set up a claim to a

great class of things, when their true claim is only to a limited variety of the class. *Evans' Case*, 7 Opin., 134.—CUSHING, Atty. Gen.; 1855.

30. All such over-broad pretensions avail nothing against the public, and impair the strength of whatever there may truly be of original in the particular patent. *Ibid.*, 134.

31. When the exact nature and extent or essence of the claim can be perceived, the court is bound to adopt that interpretation of the patent, and to give it full effect. *Winternute* v. *Redington*, 1 Fisher, 249.—WILSON, J.; Ohio, 1856.

32. In determining the construction of the claims of a patent, the court should refer to the whole specification, and consider the whole in connection, although the claim at the end of the specification is usually intended to define and limit the extent of the claim made by the patentee. *Ransom* v. *Mayor, &c.*, 1 Fisher, 260.—HALL, J.; N.Y., 1856.

33. The construction of the claims of a patent is a question of law exclusively for the court, and not for the determination of a jury, unless there may be technical terms or terms which need explanation by the evidence given before the jury. *Ibid.*, 260.

34. Where a claim may be open to objection of any kind, it is the duty of the court in construing it, to so construe it, if it can be done, without doing violence to the language used, as not to affect the claim of the patentee, but to give him what and all he has actually invented—in other words, to make the claim commensurate with the invention actually made. *Ibid.*, 262.

35. While it is true that the summing up is to be looked at to discover the *parts* of the machine the patentee claims as his invention, still if any thing is needed to give the proper meaning of expressions used in the claim, the previous portions of the specification may be referred to for such explanations as may be necessary to understand the office and purpose of that which is claimed as new. *Morris* v. *Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858.

36. If by an examination of the specification and applying it to the then existing state of the art, it can be learned what the invention was, then the claim, which is designed to be a condensed summary of the invention, is to be construed so as to be coextensive with the invention, if that can be done without doing violence to its language. *Whipple* v. *Middlesex Co.*, MS.—SPRAGUE, J.; Mass., 1859.

37. In construing the claim of a patent, the court take into view the whole of what precedes it in the patent, and also such extraneous facts presented by the evidence as may aid in giving the true construction to the patent, particularly documents from the Patent Office which preceded the granting of the patent itself. *Johnson* v. *Root*, 1 Fisher, 355.—SPRAGUE, J.; Mass., 1858.

38. Where there is any doubt as to the extent and meaning of the invention of an applicant, the whole specification should be taken together in construction, and not confined to the mere words of the claim. The phraseology of a claim "*for the purposes set forth*," embraces the whole specification. *Sprague, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

39. Where necessary to explain any ambiguity in the summing up or claim of a specification, resort should be had to the body of the specification, that the whole may be taken together, that

in support of the claim a liberal and not a strict construction should prevail. *Tillman, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860

40. But there should not be given any forced construction to the body of the specification, so as to *extend* the claim of the patentee; on the contrary, only such a construction ought to be made as, consistently with the fair import of language, will make the claim coextensive with the actual discovery. *Ibid.*

## Q. VIOLATION OF.

See ACTIONS, A.; COMBINATION, B.; COMPOSITION OF MATTER, B.; DESIGNS; FORM; INFRINGEMENT, B.

## R. WHEN VOID.

See also in connection herewith, ABANDONMENT, B.; DEFENCES; PRIOR KNOWLEDGE; PRIOR USE.

1. Under § 1 of the act of 1790, if the allegations and suggestions of the petition are not substantially recited in the patent, the patent is void. *Evans* v. *Chambers*, 2 Wash., 126.—WASHINGTON, J.; Pa., 1807.

2. If an inventor be not an inventor of the whole machine, but only of an improvement thereof, and the patent is for the whole machine, the patent is too broad and is utterly void. *Whittemore* v. *Cutter*, 1 Gall., 479.—STORY, J.; Mass., 1813.

3. If an inventor obtain a patent for an entire machine, when he is the inventor only of an improvement thereon, his patent is too broad, and therefore void. *Odiorne* v. *Winkley*, 2 Gall., 53. —STORY, J.; Mass., 1814.

4. If a patent be taken out for an entire machine, when the invention consists only of an improvement on such machine, the whole patent is not void, but the patentee is not entitled to more than his improvement; nor can he make or use the original discovery, nor prosecute any person for using such original discovery without engrafting on it the improvement invented by the patentee. *Goodyear* v. *Matthews*, 1 Paine, 302. —LIVINGSTON, J.; Ct., 1814.

5. The grant can only be for the discovery as recited in the patent and specification. If the patent is for the whole of a machine, and the discovery was only of an improvement, the patent is void. *Evans* v. *Eaton*, Pet. C. C., 342.—WASHINGTON, J.; Pa., 1816.

6. If 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. *Lowell* v. *Lewis*, 1 Mas., 187.—STORY, J.; Mass., 1817.

7. If a patentee include in his patent any thing already known, the patent will be broader than the invention, and consequently void. *Ibid.*, 188.

8. An invention, to entitle the inventor to a patent, must not only be useful, but it must also be new. It is a good defence in an action for infringement, that the thing patented was not originally discovered by the patentee. *Bedford* v. *Hunt*, 1 Mas., 304.—STORY, J.; Mass., 1817.

9. If the terms of a patent are so obscure or doubtful that the court cannot 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 Mas., 476. —STORY, J.; Mass., 1818.

10. And if it covers more than the improvement, it is void for the reason

that it is broader than the invention. *Ibid.*, 476.

11. The nature and extent of the improvement must be clearly and fully stated, or the patent will be void. *Evans* v. *Eaton*, 3 Wash., 452, 455.—WASHINGTON, J.; Pa., 1818.

12. If a combination be not wholly new, but up to a certain point has existed before, and the patentee claims the whole as new, instead of his own improvements only, and takes out a patent for the whole machine, his patent is void, for it exceeds his invention. *Moody* v. *Fiske*, 2 Mas., 118.—STORY, J.; Mass., 1820.

13. A specification which mixes up the old and the new, but does not explain what is the nature or limit of the improvement which the party claims, cannot be sustained. *Evans* v. *Eaton*, 7 Wheat., 434.—STORY, J.; Sup. Ct., 1822.

14. Where the specification does not describe the invention so as to show in what respect the plaintiff's invention or improvement differs from what had been known or used before. the patent is void. *Langdon* v. *De Groot*, 1 Paine, 207.—LIVINGSTON, J.; N. Y., 1822.

15. If a patentee include in his patent an original patent known to have been previously patented to another person, with his own improvement for which he is entitled to a patent, the patent is void. *Turner* v. *Johnson*, 2 Cra. C. C., 287.—CRANCH, J.; D. C., 1822.

16. The specification described the invention "that it essentially consists in attaching the packet to the steamboat with ropes, chains, or spars, so as to communicate the power of the engine from the towing vessel to vessels taken in tow, and kept always at convenient distance; the manner of applying the power varying in some measure with the circumstances;" *Held*, that the description of the invention, if any there was, was too vague and uncertain; the patent void. *Sullivan* v. *Redfield*, 1 Paine, 450, 451.—THOMPSON, J.; N. Y., 1825.

17. If a patent embraces the discovery of another person, besides or with the invention or discovery of the patentee, it is too broad, and is void. *Watson* v. *Bladen*, 4 Wash., 582, 583.—WASHINGTON, J; Pa., 1826.

18. If a patent covers what was in use before, and what belonged to the public, it is void. *Davis* v. *Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

19. If a party suggest an idea as to an invention, which is indispensable to its operation, and which in reality constitutes its whole value, and another adopts such suggestion and takes out a patent therefor, the patent is void, as not being the invention of the patentee. *Thomas* v. *Weeks*, 2 Paine, 102.—THOMPSON, J.; N. Y., 1827.

20. A patent must not be broader than the invention, or it will be void, not only for so much as had been known or used before the application, but also for the improvement really invented. *Whitney* v. *Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

21. A patent can be declared void by a Circuit Court, in a civil suit, only for the reasons and causes mentioned in § 6 of the act of 1793. *Ibid.*, 316, 317.

22. It has been the uniform construction of the law in the Circuit Courts, that a patent can be declared void for no other defect in the specification than fraudulent concealment or addition. *Ibid.*, 321.

23. The expression "the patent is void," used by the courts in civil actions at common law, is to be understood not as meaning that it becomes void by a judgment in favor of the defendant, but only that it is voidable in chancery, and in a court of law, void as a legal foundation for an action of damages. *Ibid.*, 318.

24. If the specification is wholly ambiguous and uncertain, so loosely defined and so inaccurately expressed that the court cannot, upon a fair interpretation of the words, and without vague conjecture of intention, gather what it is, the patent is void for such defect. *Ames* v. *Howard*, 1 Sumn., 485.—Story, J.; Mass., 1833.

25. But if the court can clearly see, by a reasonable use of the means of interpretation of the language used, taking the whole in connection, what is the nature and extent of the claim, then the plaintiff is entitled to the benefit of it, however imperfectly and inartificially he may have expressed himself. *Ibid.*, 485.

26. If a patent is for an entire machine, but the patentee is the inventor of only a part thereof, the patent is void, as a party cannot entitle himself to a patent for more than his own invention. *Cross* v. *Huntly*, 13 Wend., 386, 387.—Nelson, J.; N. Y., 1835.

27. In a patent for improvement in cider mills, the claim was for improvements in the box enclosing the cylinder, and the teeth or brads set in the cylinder, but the specification did not show any improvement in such teeth or brads; *Held*, that as the specification was defective in part, the patent was void, and not only *pro tanto*, but *in toto*. *Head* v. *Stevens*, 19 Wend., 412.—Cowen, J.; N. Y., 1838.

28. A patent is void and inoperative if the specification claims more than the patentee has invented. *Stanley* v. *Whipple*, 2 McLean, 36.—McLean, J.; Ohio, 1839.

29. A claim broader than the actual invention of the patentee, is, for that very reason, utterly void, and the patent is a nullity. *Wyeth* v. *Stone*, 1 Story, 286.—Story, J.; Mass., 1840.

30. Prior to the act of 1836, if a patentee claimed more than he had invented, his patent was void. But under § 9 of the act of 1837, the patent is not absolutely void because the patentee claims more than he has invented, but is valid for so much as is truly and *bonâ fide* his own; but in the specification he must state in what his improvement consists. *Peterson* v. *Wooden*, 3 McLean, 248, 249.—McLean, J.; Ohio, 1843.

31. If the invention is not so described as to be known, in the language of the statute, from every other thing, the patent is void. *Brooks* v. *Bicknell*, 3 McLean, 442.—McLean, J.; Ohio, 1844.

32. If an invention patented is the same in principle with one before in use, the patent is void. *Ibid.*, 451.

33. If a foreign patentee, or his assignees, do not put their invention on sale within eighteen months after the same is obtained, as required by § 15 of the act of 1836, the patent will be void. *Tatham* v. *Loring*, 5 N. Y. Leg. Obs., 208.—Story, J.; Mass., 1845.

34. If the meaning of the patent cannot be satisfactorily ascertained upon the face of the specification, it is insufficient for uncertainty and ambiguity. *Emerson* v. *Hogg*, 2 Blatchf., 6.—Betts, J.; So. N. Y., 1845.

35. When the specification of a new composition of matter gives only the names of the substances to be mixed

together, without stating any relative proportion, or where the proportions are stated ambiguously or vaguely, the patent is void, as it would not enable any one to compound and use the invention without experiment. *Wood* v. *Underhill*, 5 How., 45.—TANEY, Ch. J.; Sup. Ct., 1846.

36. But where the patentee gives a certain proportion as a general rule, which on the face of the specification seems generally applicable, the patent will be valid, though some small difference in the proportions may be occasionally required, according to the quality of the materials made use of. *Ibid.*, 5.

37. If a specification includes as well the original discovery as the alleged improvement, and does not point out in what the improvement consists, the patent is void. *Street* v. *Silver*, Brightley, 101.—ROGERS, J.; Pa., 1846.

38. If the specification is so uncertain, as to whether a particular thing is claimed as a part of a new combination, or as a new invention, as to be unintelligible, it is void, but, *semble*, it may be surrendered and amended. *Hovey* v. *Stevens*, 1 Wood. & Min., 302.—WOODBURY, J.; Mass., 1846.

39. If a patent embraces and claims as a part of the improvements described in it, something which is not new, but was invented by another, it is void, the claim being broader than the invention. *Tyler* v. *Deval*, 1 Code Rep., 30.—MCCALEB, J.; La., 1848.

40. In order to render a patent valid, under § 9 of the act of 1837, which contains more than is the invention of the patentee, it must appear that the part really invented was "a material and substantial part of the thing patented, and was distinguishable from the parts claimed without right." *Hotchkiss* v. *Oliver*, 5 Denio, 320.—MCKISSOCK, J.; N. Y., 1848.

41. If an invention is not described with reasonable certainty and precision, the patentee can claim nothing under his patent. *Parker* v. *Stiles*, 5 McLean, 54.—MCLEAN, J.; Ohio, 1849.

42. If a patentee claims any thing as a material part of his combination, as new and original with him, which is proved to have been discovered prior to the emenation of his patent, it is fatal to it. *Ibid.*, 55.

43. Where a foreign patent has been obtained for an invention previous to the issue of the home patent, the home patent must be limited to fourteen years from the date of the foreign one. If the domestic patent purports to give an exclusive right for fourteen years from its date, it is void; but the error is not fatal, it may be corrected. *Smith* v. *Ely*, 5 McLean, 78, 79, 80.—MCLEAN, J.; Ohio, 1849.

44. Prior to the act of 1836, a patent was void if the claim extended beyond the invention. Under § 6 of that act, it was void if a substantial part had been patented or described in a printed publication. § 15 saved the patent from being void if the patentee believed himself to be the first inventor. § 9 of the act of 1837 enlarged the right of the patentee, providing, notwithstanding § 15 of the act of 1836, that the patent should not be void, where he had acted in good faith, if through mistake or inadvertence he had claimed more than he had invented, and that he might maintain suit on the part actually invented by him, provided he filed within a reasonable time a disclaimer of the parts not invented by him. *Ibid.*, 84, 85.

45. If a patentee claims something

which is not his invention, his patent claims too much, and its validity may be assailed on that ground, even though the part illegally claimed may be of slight value or importance. *Parker* v. *Sears*, 1 Fisher, 99.—GRIER, J.; Pa., 1850.

46. The avoidance of patents for claiming too much is of frequent occurrence, and needs no explanations as to the reasons of it, when an applicant is so improvident or unjust to others, as to claim for himself more than he invented, and the credit and profit of which belong to others. *Smith* v. *Downing*, 1 Fisher, 70.—WOODBURY, J.; Mass., 1850.

47. If the suggestions or communications of another go to make up a complete and perfect machine, embodying all that is embraced in a patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another. *Pitts* v. *Hall*, 2 Blatchf., 234.—NELSON, J.; N. Y., 1851.

48. If an inventor unnecessarily defers his application for a patent, and allows his invention to go into use, except for the purposes of perfecting his invention and testing its utility, and beyond what he has reason to believe necessary for such purposes, his patent is void. *Winans* v. *Schenec. & Troy R. R.*, 2 Blatchf, 291, 300.—NELSON, CONKLING, JJ.; N. Y., 1851.

49. If any thing is included in a patent which is not new, the patent is void. If what is new be mixed up with what is old, the patent is no protection for either. *Holliday* v. *Rheem*, 18 Penn., 469.—BLACK, Ch. J.; Pa., 1852.

50. A patent is not void because, on its face, it does not bear the same date with a previous foreign patent, obtained by the patentee for the same invention; the monopoly however is limited to fourteen years from the date of the foreign patent. *O'Rielly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

51. He who discovers that a certain useful result will be produced in any art, machine, manufacture or composition of matter, by the use of certain means, is entitled to a patent for such discovery, provided he sets forth in his specification the means he uses to produce such useful result, so that any one skilled in the art, &c., can, by using the means specified, without any addition or subtraction from them, produce precisely the result he describes. If this cannot be done, by the means he describes, the patent is void. *Amer. Pin Co.* v. *Oakville Pin Co.*, 3 Blatchf., 192; 3 A. L. R., 137.—INGERSOLL, J.; Ct., 1854.

52. If the invention required no more skill or ingenuity than that possessed by an ordinary mechanic, skilled in the business, there is an absence of inventive faculty, and the patent is invalid. *Teese* v. *Phelps*, 1 McAllis., 52.—McALLISTER, J.; Cal., 1855.

53. If, with the knowledge had by the public, it required no invention, but simply the ordinary skill and ingenuity of the mechanic, to produce the result effected; in other words, if the inventive faculty was not put into action, and was not needed to produce the alleged invention, then the patent is void, because there is no invention to be secured to the patentee. *Ransom* v. *Mayor*, &c., 1 Fisher, 264.—HALL, J.; N. Y., 1856.

54. If an inventor, after his invention is perfected, knowingly allow it to be used in public for more than two years before application for letters patent, it is conclusive evidence of a dedication of

such invention to the public, and the patent is void. *Ibid.*, 273.

55. And if an inventor, after his invention is perfected, acquiesce in its use in public, for a less term than two years, without applying for a patent, and the jury are satisfied from this acquiescence and other facts in the case, that the inventor in fact abandoned his invention, concluding not to patent it, but to dedicate it to the public, he cannot recall such dedication, or defeat such abandonment by a subsequent application for a patent, and any such patent will be void. *Ibid.*, 273.

56. And if an inventor does not use reasonable diligence to perfect his invention after the idea of it is conceived, and in the mean time another conceives the idea and perfects the invention, and practically applies it to use, the latter is the first and original inventor, and a patent granted to the former will be void. *Ibid.*, 272.

57. If the invention patented as in a joint patent, is the sole invention of one of the patentees, and not the joint invention of both, the patent is void. *Ib.*, 269.

58. Where a specification endeavors to include an idea, or a function of the human system, or a quality of objects in nature, instead of a particular instrumentality, or concrete form of applying that idea, or function, or quality in use, such patent is void for being too general, unless that defect be cured by disclaimer in the manner of the statute. *Morton's Anæsthetic Patent*, 8 Opin., 276.—CUSHING, Atty. Gen.; 1856.

59. There is nothing to estop the government of the United States from showing a patent, which it has granted, to have been a nullity *ab initio*, owing to the non-existence of the condition precedent of novelty of the invention. *King* v. *United States*, 10 Mo. Law Rep., 631; Ct. Claims, 1857.

60. An inventor has no legal rights or immunities under a patent, except such as are conferred by the statute. With whatever solemnity or observance of legal form it may have issued, if wanting in any substantial statutory requisite, it is a nullity. *Moffitt* v. *Garr*, 1 Fisher, 612.—LEAVITT, J.; Ohio, 1860.

## S. TRANSFER OF.

See ASSIGNMENT, B., C

## PARTICULAR PATENTS.

Apple-Paring Machine.....531
Augers for boring Muskets.....531
Bank-Note printing.....531
Bark Mills.....532
Bran Duster.....532
Brass Kettles.....533
Brick Machine.....533
Burring Machine.....533
Buttons, Designs for.....534
Cars, supporting Bodies of.....534
Cars for Coal.....535
Carriages for Railways, &c.....535
Cars, Eight-Wheeled.....535
Car Wheels.....536
Castors for Bedsteads.....537
Cotton Gin, Ribs of.....537
Cotton Speeder.....537
Cultivators.....538
Dyeing Parti-Colored Yarn.....538
Dyeing and finishing Silk Goods.....539
Electric Telegraph.....539
Fire-Engines.....542
Glass Knobs.....542
Grain-cleaning Machine.....543
Grinding Tools.....543
Gun Locks,.....544
Harvesting Machines.....544
Hat Bodies, making.....546
Ice, cutting,.....547
India-rubber.....547

Irregular Forms, turning..... 550
Lead Pipe Machinery..... ..... 552
Locomotives, Variable Exhaust of. ..... 553
Looms..... 554
Matches, Friction..... 554
Mill Stones, regulating, &c..... 555
Mouldings, making of. .... ..... 555
Nails, Manufacture of..... 555
Palm-Leaf, preparing ..... 556
Paper, Manufacture of..... 556
Planing Machines..... 557
Ploughs. ..... 560
Puddlo Balls, rolling..... 561
Rails for Railroad Carriages..... 561
Rocking Chairs..... 562
Saddles..... 562
Saw-Mills, Circular..... 562
Saw-Mills, Portable, Circular..... 563
Sewing Machines..... 563
Sowing Seed..... ..... 568
Steam-Engines, Improvement in..... 568
Steam Generators..... 569
Stoves..... 569
Straw-Cutter..... 570
Tailors' Shears..... 571
Thread packing, &c..... 571
Valves..... 571
Water Closets ..... 573
Water Wheels..... 573
Wheels, Horizontal..... 575
Wood-Bending Machino..... 575

## APPLE-PARING MACHINE.

PRATT'S PATENT.

*Issued October 4th*, 1853.

1. The patent was for "a new and useful improvement in machines for paring apples."

*Held*, that the improvement patented consisted in so attaching the knife-block to the rod which moves it, as to allow it to rotate round the rod at right angles therewith, and thus the knife accommodates itself to any irregularity in the surface of the vegetable to be pared. *Sargent* v. *Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

2. Making the rod movable in the socket instead of the knife on the rod, *Held* to be a mere change in form or mechanical structure, and an infringement, as the knife-block had the same motion; in the one it was around the rod, in the other it was with the rod. *Ibid.*, 349.

## AUGER FOR BORING MUSKETS.

PETTIBONE'S PATENT.

*Issued February 12th*, 1814.

This patent was for "a new and useful improvement in boring muskets, pistols, and rifles, by an auger called the spiral groove or twisted screw auger." The specification described the manner of making the auger, its form, and how used, and the affidavit stated that the patentee "believed himself to be the first inventor of the improved method of making augers or bits for boring muskets, pistols, and rifle-barrels."

*Held*, that the patent extended only to the auger described in the specification, and not to the method of using it. *Pettibone* v. *Derringer*, 4 Wash., 215, 218.—WASHINGTON, J.; Pa., 1818.

## BANK-NOTE PRINTING.

KNEASS' PATENT.

*Issued April 28th*, 1815.

The patent was for "a new and useful improvement in printing on the back or reverse side of bank-notes, as an additional security against counterfeiture."

*Held*, that the improvement was for printing copper-plate on both sides of the note or bill—or copper-plate on one side and letter-press on the other—or

letter-press on both sides, and that the patent was not for an effect, but for the kind of printing by which that effect is produced; and that the printing on the back of such notes with *steel plates*, was an infringement. *Kneass* v. *Schuylkill Bank*, 4 Wash., 12, 14.—WASHINGTON, J.; Pa., 1820.

## BARK MILLS.

MONTGOMERY & HARRIS' PATENT.

*Issued August 12th*, 1840.

1. The patent was for "an improvement in the mill for breaking and grinding bark," and the claim was for combining together the stationary cylinders and the movable conical rings, concentrically, there being teeth on the sides of both, and sustaining that combination by the cross bars, to which the movable and stationary parts are severally attached.

*Held*, that the invention covered by the patent was the multiplication of the grinding chambers, and apparatus or machinery in a mill of a given size, and which may still be driven by the same power as heretofore. *Wilbur* v. *Beecher*, 2 Blatchf., 136.—NELSON, J.; N. Y., 1850.

2. And that there was evidence enough of utility, if the new machine would do double the work of the old mill in a given time. *Ibid.*, 137.

3. Though the claim was for the combination of *one* or *more* movable conical nuts with the stationary cylinders, *Held*, also, that the description was sufficiently particular to enable a mechanic to construct a mill with more chambers than three, the number mentioned in the specification. *Ibid.*, 137, 138.

4. And that a mill with six grinding chambers and twelve grinding surfaces, but produced by the multiplication of stationary cylinders and movable conical nuts, was an infringement. *Ibid.*, 139, 140.

5. The particular shape of the grinding chambers and the form of the teeth, is, however, no part of the patented combination; where, therefore, a machine by a change in these points ground better and faster than the patented mill, yet if it contained the combination of the movable conical nuts with the stationary cylinders, *Held*, it was an infringement. *Ibid.*, 140, 142.

## BRAN DUSTER.

FROST & MONROE'S PATENT.

*Issued February 27th*, 1849.
*Reissued March 13th*, 1855.

1. The patent was for "an improvement in machinery for separating flour from bran," and the claim was for the external case, with the internal stationary scourer, and the revolving cylindrical scourer and blower, constructed, arranged, and operating in the manner and for the purpose set forth.

*Held*, that the patentee did not claim any of the component parts as original or new, but that the claims were limited to certain combinations of the several parts making up the entire machine. *Carr* v. *Rice*, 4 Blatchf., 202.—NELSON, J.; N. Y., 1858.

2. The *third* claim is not valid on account of its uncertainty. *Ibid.*, 202.

3. The *fourth* claim is for a legal result, and is not maintainable, the plaintiffs not claiming to be the original inventors of mechanism to produce such

a result, but only of a new combination of parts. *Ibid.*, 202.

## Brick or Tiles, making.

### Wood's Patent.

*Issued November 9th*, 1836.

"The patent was for a new and useful improvement in the art of manufacturing bricks and tiles;" and the claim was for using fine anthracite coal, or coal-dust with clay for such purpose. The general proportion mentioned was three-fourths of a bushel of coal-dust to one thousand brick; but it was stated that some clay might require more dust, and some less—the clay which required the most burning would require the greatest proportion of coal dust.

*Held*, that the specification was not so vague and uncertain on its face as to avoid the patent. *Wood* v. *Underhill*, 5 How., 46.—Taney, Ch. J.; Sup. Ct., 1846.

## Brass Kettles.

### Hayden's Patent.

*Issued December 16th*, 1851.

1. The patent was for "machinery for making kettles and articles of a like character from disks of metal," and the invention claimed was for improvements in machinery for making such articles, by stretching a flat disk of metal on a proper form or forms, by the compression of a proper tool operating on the disk while rotating with and against the form.

*Held*, that the patent did not grant the several parts, or any part of the machinery, by which the combination claimed is called into action, and made to perform its office; but the grant was the application of a rotary form or mould, or forms and moulds, in combination with proper tools, moved or directed by competent means, for the purpose of operating upon a blank, so as to reduce it gradually from the centre to the edge, at the same time forming it with straight sides by successive stages, into a complete kettle. *Waterbury Brass Co.* v. *N. Y. & Brook. Brass Co.*, 3 Fisher, 43.—Ingersoll. J.; N. Y., 1858.

2. The patent described, at the side of the form, a movable slide-rest, running parallel with the side of the kettle, and carrying a small fixed tool, which is brought up against the revolving blank, to roll the disk into the proper shape; *Held*, that an invention subsequently patented to Mary Cannon, which dispensed with such movable slide-rest, and provided for holding the tool against the form by a workman holding firmly one arm of a lever, was an infringement upon the Hayden patent. *Ibid.*

## Burring Machines.

### Whipple's Patent.

*Issued October 28th*, 1840.
*Extended October 28th*, 1854.

1. The patent was for "improvements in machines for cleansing wool from burs, &c.," and the suit was founded upon the second clause, which was, "forming and arranging the teeth of cylinders for burring wool in such a manner that their outer convex sides shall be substantially concentric with the axis of the cylinder, for the purpose of seizing and holding the fibres, and presenting a surface against which the guard can act in removing burs, &c."

*Held*, that the invention, so far as such claim was concerned, was to form and arrange the teeth with points which would seize and hold the fibre, with a smooth surface in the rear of the points, firm and non-elastic, to support or float the burs, so that the guard could remove them; and such teeth to be in such succession around the cylinder that their points should be protected by the heels or smooth surface in the rear of the preceding teeth, so as to prevent burs from being taken hold of by the points of the teeth, and also so as to prevent too many fibres of the wool being seized. *Whipple* v. *Middlesex Co.*, MS.—SPRAGUE, J.; Mass., 1860.

2. The claim regards the smooth surface as a part of the teeth, or an essential ingredient in the arrangement of the teeth, and of the invention. *Ibid.*

## BUTTONS, DESIGNS FOR.

### BOOTH'S PATENT.

*Issued July 24th*, 1847.

The patent was for "a new and ornamental design for figured silk buttons," and the claim was for the radially formed ornaments on the face of the mould of the button, combined with the mode of winding the covering of the same, substantially as set forth, and the specification described the configuration of the mould, and the winding it with various colored threads, but did not describe the process of winding.

*Held*, that the patent did not cover the *process*, but was for the arrangement of the different colored threads in the process, so as to produce the radially formed ornaments on the face of the button. *Booth* v. *Garelly*, 1 Blatchf., 248, 249.—NELSON, J.; N. Y., 1847.

## CARS, SUPPORTING BODIES OF.

### IMLAY'S PATENT.

*Issued September 21st*, 1837.
*Extended September 21st*, 1851.

The patent was for "a new and useful improvement in the mode or means of supporting the bodies of railroad cars and carriages, and connecting them with the truck," and the object of the invention of the patent was to furnish a support for the carriage body, while the cars were in motion, which was both longitudinal and lateral, and also give a vertical support; and the means used were two cylindrical plates, male and female, one above and within the other; the upper one slightly convex on its lower surface, so that it rested only on the centre of the bed-plate, which could thus turn and vibrate under the top plate—one confined to the carriage and the other to the truck—and one entering within the other a sufficient depth to afford the desired support, without the aid of any other instrumentality, such as the ordinary king-bolt.

*Held*, that the patent secured the use and application of the two cylinder-plates, male and female, one within the other, and acting in combination, whereby the truck and carriage are combined to give support to all kinds of railroad carriages. *Imlay* v. *Nor. & Wor. R. R. Co.*, 4 Blatchf., 233.—INGERSOLL, J.; Ct., 1858.

2. *Held*, also, that the use, for the purpose of connecting the cars with the trucks, of similar male and female cylindrical plates, though neither of them were convex, and though used in combination with the ordinary king-bolt, was an infringement. *Ibid.*, 236.

## CARS FOR COAL.

### WINAN'S PATENT.

*Issued June 26th*, 1846.

The patent was for "an improvement in cars for the transportation of coal." The invention described and claimed was the making the body of the car in the form of the frustum of a cone, whereby the force of the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, by which the lower part is so reduced as to pass down within the truck, to lower the centre of gravity of the load, without diminishing the capacity of the car.

2. *Held*, that though the patentee had described no form, except the frustum of a cone, his patent covered also such variations of form as substantially embodied his mode of operation, and attainted the same kind of result, and that the use of an octagonal, instead of a circular car, was an infringement. *Winans* v. *Denmead*, 15 How., 344.—CURTIS, J.; Sup. Ct., 1853.

## CARRIAGES FOR RAILWAYS.

### WINANS' PATENT.

*Issued July 30th*, 1831.

The patent was for "a new and useful improvement of railway and other wheeled carriages," and the claim was for extending the axles each way outside of a pair of wheels far enough to form external gudgeons to receive the bearing box of the body load. It appeared, however, that the invention had been before applied to other carriages, though not to railway carriages.

*Held*, that therefore the patent was void. *Winans* v. *Bos. & Prov. R. R. Co.*, 2 Story, 415.—STORY, J.; Mass 1843.

## CARS, EIGHT-WHEELED.

### WINANS' PATENT.

*Issued October 1st*, 1834.

1. The patent was for "a new and useful improvement in the construction of carriages intended to travel on railroads," and the improvement consisted in placing two bearing carriages, each with four wheels, at or near each end of the car, and the two wheels on either side of these carriages to be placed very near to each other, the spaces between their flanges being not greater than is necessary to prevent their contact with each other; and the claim was for "the described manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, so as to accomplish the end proposed by the means set forth, or by any others which are analogous and dependent upon the same principles."

*Held*, that the claim was for the car itself, constructed and arranged as described in the patent, complete and fit for use, and not for the separate parts which enter into his arrangement, or for the particular arrangement or combination. *Winans* v. *Schenec. & Troy R.R. Co.*, 2 Blatchf., 284, 293, 294.—NELSON, J.; N. Y., 1851.

2. The location of the trucks relatively to each other under the body of the car, as well as the near proximity of the

two axles of each truck to each other, form a most essential part of the arrangement of the patentee in the construction of the car; the trucks to be placed as remotely from each other as can conveniently be done, for the support of the carriage, and the spaces between the two axles to be no greater than is necessary to prevent the flanges of the wheels coming in contact with each other. But the improvement does not consist in placing the axles of the two trucks at any precise distance apart, or at any precise distance from each end of the body. And the specification is sufficiently definite without specifying the exact distance, in feet and inches, from the ends of the car body at which it would be best to arrange the trucks, or the exact distance between the axles. *Ibid.*, 295, 297.

3. Winans' patent is for the manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad carriage, as shall enable a car with a long body to pass curves with greater facility and safety and less friction, and at the same time cause the body of the car to pursue a more smooth, even, direct, and safe course over the curvatures and irregularities of the road. *Winans* v. *N. Y. & E. R. R. Co.*, 21 How., 102.—GRIER, J.; Sup. Ct., 1858.

4. Carriages with eight wheels, arranged and connected substantially in the same manner, and upon the same mechanical principles, with those described in Winans' patent, having been known before his invention;

*Held*, that he was not entitled to recover. *Ibid.*, 103.

## CAR WHEELS.

### WOLF'S PATENT.

*Issued March 17th*, 1838.

1. The patent was for "a new and useful improvement in the mode of making cast-iron wheels to be used on railroads, and applicable to other purposes," and the claim was for "the manner of constructing railroad car wheels with double convex plates, one convex outward and the other inward, and an undivided hub, the whole cast in one piece."

*Held*, that the patent was not for the mode or method of constructing the wheel, as distinct from the instrument itself; but that it was the thing, the instrument or wheel after it was made, which they claimed to have discovered. *Many* v. *Jagger*, 1 Blatchf., 378.—NELSON, J.; N. Y., 1848.

2. *Held*, also, that the claim was not for any of the parts of the wheel taken separately, but for the entire wheel as constructed—a cast iron-wheel, with double plates, a solid hub, and a chilled rim, all cast in one piece. *Ibid.*, 378, 379.

3. *Held*, also, that the peculiar form of the double plates being nearly parallel—one convex inward, and the other convex outward—so that in consequence of such curvature they would contract without danger of fracture, was not essential, any further than as respects a form that would allow for the contraction of the plates in cooling, the allowance being made for the purpose of procuring a chilled rim. *Ibid.*, 379.

4. The correctness of the ruling of

the court in this case questioned in *Many* v. *Sizer*, 1 Fisher, 43.—SPRAGUE, J.; Mass., 1849.

## CASTERS FOR BEDSTEADS.

### BLAKE'S PATENT.

*Issued June 30th*, 1838.

The patent was for "an improved caster for bedsteads."

*Held*, that the invention was the old *wheel and pintle*, so adapted to and arranged with the leg of the bedstead by inserting it in the centre, that the top of the pintle may be received in the conical cavity of the upper metallic *bearing*, to sustain the weight, while the lower metallic bearing constitutes a back to the lower end of the hold, to secure the pintle against lateral motion. *Blake* v. *Sperry*, 2 N. Y. Leg. Obs., 255.—INGERSOLL, J.; Ct., 1843.

It dispenses with the *plate and screws* of the *plate caster*, the *iron frame* of the *French caster*, the *clasps and staples* of the *safe caster*, the *wood frame and braces* of the *invalid caster*, and the *sheath* of the *socket caster*; and that the patent was a valid patent. *Ibid.*

## COTTON GIN, RIBS OF.

### CARVER'S PATENT.

*Issued June 12th*, 1838.
*Reissued Nov. 16th*, 1839.

1. This patent was for "a new and useful improvement in the ribs of the cotton gin," and the patentee claimed as his invention, the increasing the depth or space between the upper or outer, and the lower or inner surfaces of the rib, so that it should be equal to the length of the fibre of the cotton to be ginned; and also, as part of the same improvement, sloping up the lower or inner surface of the rib so as to meet the upper or outer surface, leaving no break or shoulder between the two surfaces.

*Held*, That the patent was for one entire thing, that is, for an improved rib, or a specified improvement upon the common rib, and not for two distinct and independent improvements—the thickness or depth of the rib, and the sloping up of the surfaces thereof. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 445, 446.—STORY, J.; Mass., 1843.

2. *Held*, also, that the same thing was patented in both the original and renewed patents. *Ibid.*, 438, 445.

3. The true construction of this patent is, that it claims not only the increasing the depth or space between the upper or outer, and the lower or inner surface of the rib, at the part where the cotton is drawn through the grate; but also, the sloping up of the lower or inner surface so as to meet the upper or outer surface above the saws, leaving no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between them. *Carver* v. *Hyde*, 16 Pet., 517.—TANEY, Ch. J.; Sup. Ct., 1842.

## COTTON SPEEDER.

### DAVOLL'S PATENT.

*Issued May 19th*, 1843.

This invention was for "improvements in the machine known as the speeder, double speeder, or fly-frame, for roving cotton." The specification described the spindles as arranged in two rows, and

that the flyers were made in one continuous piece, instead of being open at the bottom. The claim was for the arrangement of the spindles and flyers in two rows, in combination with the described arrangement of gearing, or substantially such arrangement.

*Held*, that this improvement was confined to the use of the bow-flyer, that is, the flyer in one continuous piece. *Davoll* v. *Brown*, 1 Wood. & Min., 55, 60.—WOODBURY, J.; Mass., 1845.

## CULTIVATORS.

### IDE'S PATENT.

*Issued April 18th*, 1846.

1. The patent was for "an improvement in cultivators," and the claim was for the arrangement of the teeth in two rows, in combination with a pair of wheels, the treads of which are in a line midway between the points of the two rows of teeth, substantially as described. The specification described the teeth as seven in number, arranged in two straight rows, three in one row and four in another, the points of the three being in front of the line of the wheels, and the points of the four behind such line, and the tread of the wheels being placed midway between the rows of the teeth, to resist any tendency of either row of teeth to cut too deep, and the tread of the wheels between them acting as a fulcrum, so as to relieve the team of any strain arising from either row of the teeth running too low or too shallow, and by which arrangement also the use of guiding handles or of four wheels, could be dispensed with; and the defendant's machine used but two wheels, and no guiding handles, and had also seven teeth, three in front of the wheels and four behind, but the middle tooth of the forward three was moved forward of the others, and the two middle teeth of the back row were placed behind the others, so that the two rows were not straight, and the axle of the wheels was thrown forward so that the tread of the wheels was not midway between the rows of the teeth, by which strain on the team was further reduced.

*Held*, that the defendant's machine was an infringement upon the plaintiff's as it used the principle and substance of plaintiff's invention, and was not even an improvement, as it was only the result of practical experience in the use of plaintiff's machine, and involved no invention. *Tracy* v. *Torrey*, 2 Blatchf., 277, 278.—NELSON, J.; N. Y., 1851.

2. In an action for an infringement of the same patent, referred to last above, where the defendant's machine was like that of Torrey, except that the middle tooth of the forward three was set back, so that two teeth were forward of the wheels, and five were back, *Held*, that defendant's machine was an infringement. *Chamberlin* v. *Ganson*, 2 Blatchf., 279 (note).—NELSON, J.; N. Y., 1851.

## DYEING PARTI-COLORED YARN

### SMITH'S PATENT.

*Issued June 18th*, 1850.
*Reissued January 11th*, 1852.

1. The patent was for "an improvement in apparatus for parti-coloring yarn," and the claim was for the method described of parti-coloring yarns, by winding them on reels in frames, so as to admit of immersing such portions as

are desired to be dyed, and shifting the same for dyeing other parts in like manner.

*Held*, that the patent was for the apparatus, and not for a process or method. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

2. The essential, if not the only novelty of the combination, is the movable frame and its appurtenances; and a material particularity in its construction and specialty is, that the yarn, to the length of the skein, is required to be wound or rolled upon the frame over the reels rotating at its two ends. The yarn must be in a reeled and measured state when placed upon the frame, and prepared to be immersed in the dye to a measured distance. *Ibid.*

3. The combination claimed consists of the construction and arrangement of the movable frames, reels, and yarns, and their conjoint operation in dyeing, and without including the measuring scale. *Ibid.*

4. The thing invented is: the horizontal frame carrying the reeled yarns combined with the dyeing vat by machinery adapted to let down and draw up this frame, and measure the extent of the immersion, or the extent of the line of dyeing upon the yarn. *Smith* v. *Higgins*, MS.—NELSON, J.; N. Y., 1859.

5. In other words, the thing discovered is the combination of the horizontal frame, carrying the reeled yarns with the dyeing vat by machinery—which must always be kept in view as very important—which lets down the frame carrying the yarn, and draws it up, and at the same time measures the line of yarn to be dyed. *Ibid.*

6. It is not a patent for the discovery of the idea of coloring parti-colored yarns by immersion in the dye, but for an arrangement or combination of machinery, as a means to be used in dyeing parti-colored yarns by immersion in the dye. *Ibid.*

## DYEING AND FINISHING SILK GOODS.

### STEARNES & BARRETT'S PATENT.

*Issued May 12th*, 1818.

This patent was for "a new and useful improvement, being a mode for dyeing and finishing all kinds of silk woven goods," and the specification described two machines, one a reel, on which spirally to wind and secure the silk, and put it into the dye; the other a frame for the purpose of extending and finishing the silk after it is dyed.

*Held*, that the patent was for dyeing and finishing such goods by means of the reel and frame in combination, and not for each of the machines severally, as well as in combination. *Barrett* v. *Hall*, 1 Mas., 448, 477.—STORY, J.; Mass., 1818.

## ELECTRIC TELEGRAPH.

### BAIN'S PATENT.

*Issued April 17th*, 1849.

The invention of Bain, for which application for a patent was made April 18th, 1848, and being for his chemical telegraph, so called, being the application of chemically prepared paper to receive and record signs by means of the pulsations of an electric current transmitted from a distance, and operating directly and without the intervention of any secondary current, or me-

chanical contrivance, through a metal marking style, in contact with such prepared paper, is not the same invention as that of Morse, for which application for a patent was made January 20th, 1848, and in which he claimed the use of a single circuit of conductors for marking signs by means of the decomposing effects of electricity on prepared paper, and by means of the machinery described for such purpose. Each was entitled to a patent for the particular combination he had invented. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

MORSE'S PATENTS.

"MAGNETIC."—*Issued June 20th*, 1840.
*Reissued January 25th*, 1846.
*Reissued June 13th*, 1848.
"*Local Circuit.*"—*Issued April 11th*, 1846.
*Reissued June 13th*, 1848.
"CHEMICAL."—*Issued May 1st*, 1849.
*House Instrument.*
*Columbian Instrument.*

1. The patent of Morse, of June 20th, 1840, for improvements in the electro-magnetic telegraph, should be limited to the term of fourteen years from the date of his French patent, August 18th, 1838, and not being so limited, but purporting to give an exclusive right for fourteen years from *its* date, is void. *Smith* v. *Ely*, 5 McLean, 79, 82.—McLEAN, J.; Ohio, 1849.

2. But such error is not fatal to the right of the patentee, and may be corrected at the Patent Office. *Ibid.*, 80.

3. The motive power of the galvanic current, however developed to produce a given result, can be no more patented than the motive power of steam to propel boats, however applied. *Ibid.*, 91.

4. The essence of Morse's method, beyond what before had existed, or been practised, was to make electro-magnetism, when excited, not merely exhibit some evanescent sign at the other end, but a sign which the machine is made to trace, and thus record them permanently. *Smith* v. *Downing*, 1 Fisher, 72.—WOODBURY, J.; Mass., 1850.

5. The chief principle or characteristic of Morse's telegraphic invention, is that by its type-rule, or knob-spring at the starting place, it is able to make dots and lines by breaking the circuit, for a shorter or longer time, and then being felt along the wires to the other end, trace there on paper, passing under or over the needle or pin at the end of the lever, like dots and lines, which remain on it permanently written, to be afterward, by the stenographic alphabet, translated into Roman letters and words. *Ibid.*, 86.

6. Before his invention, there were already known the wires and circuit, the galvanic battery, the use of posts, and the ground for a part of the circuit, the breaking of the circuit by various devices, the making of signals and marks, the paper and clock-work, and the deflected needle, if not the lever. *Ib.*, 88.

7. The lever of Morse's instrument seems to be but the old needle, depressed at one end by the magnet, and of course elevated at the other, and a pin or pen inserted in it to make dots or strokes on the paper. *Ibid.*, 90.

8. The novelties in Morse's patents are 1st, local circuits; 2d, recording or writing at a distance by electro-magnetism, and 3d, doing this by a regular stenographic alphabet on rolling paper. *Ibid.*, 90.

9. House's telegraphic machine is more complicated than Morse's, moves much faster, at the rate of 60 to 70

breaks in a second, and at once records the information by its own machinery, in Roman letters. It gives "letters to lightning," as well as "lightning to letters." *Ibid.*, 85.

10. It makes no tracing at either end of the circuit, but acts at both ends by means of signals, and traces nothing. Morse's is a tracing or writing telegraph, House's a signal and printing telegraph. *Ibid.*, 86.

11. House uses no local circuits, makes no tracing, but records by printing and by means of two additional powers in axial magnetism and air, and uses no stenographic alphabet. *Ib.*, 88.

12. The use of electro-magnetism generally for communicating intelligence at a distance and there recording it, is not new to either Morse or House. *Ibid.*, 89.

13. By the assertion and claim found in Morse's patent of 1848, of "the *essence* of his invention being the use of the motive power of the electric or galvanic current, *however developed*, for marking and printing intelligible characters at any distance," he must be considered as claiming it in the form of his application—according to his machinery—rather than as intending to cover the application itself of electro-magnetism to telegraphic purposes, in every possible form. Otherwise, his renewed patent of 1848, must be regarded as void, for claiming too much, and for wishing to protect a mere principle or effect, "however developed," and without reference to any method described by him, and to cover a principle, also before known. *Ibid.*, 67,68.

14. The original patent of Morse—commonly known as his Magnetic patent, of June 20th, 1840; and its reissue of January 25th, 1846, and its second reissue of June 13th, 1848, in all their changes, contain no flagrant diversity of claim. They all claim the same thing essentially; and in them all, he claims, and renews his claim of property in the same invention—he declares the existence of a new art, and asserts his right in it as its inventor and owner; and his title was vested as patentee of the art. *French* v. *Rogers*, 1 Fisher, 140, 141.—KANE, J.; Pa., 1851.

15. Morse's Local Circuit patent, granted April 11th, 1846, and reissued June 13th, 1848, are also both for the same invention. *Ibid.*, 149.

16. The subject or leading principle of his Chemical patent of May 1st, 1849, is also clearly within his original patent, and was appropriated and secured by the magnetic patent of 1840. *Ibid.*, 151.

17. *Morse* was the first and original inventor of the electro-magnetic telegraph. *O'Rielly* v. *Morse*, 15 How., 109, 125.—TANEY, Ch. J.; GRIER, J.; Sup. Ct., 1853.

18. There is nothing in the reissued patents of 1846 and 1848 that may not be regarded as a more careful description than the patent of 1840. *Ibid.*, 112.

19. His patent is not void, because it does not on its face bear the same date with his French patent, previously obtained for the same invention, but its monopoly is limited to the term of fourteen years from the date of the foreign patent. *Ibid.*, 112.

20. Morse's eighth claim in his reissued patent of 1848, which is as follows: "I do not propose to limit myself to the specific machinery or parts of machinery in the foregoing specifications and claims; the essence of my invention being the use of the motive power of the electric or galvanic cur-

rent, which I call electro-magnetism however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer," is illegal and void, as claiming the *exclusive* right to the use or effect of such power for such purpose, without respect to the process or machinery by which accomplished—but he is entitled to a patent only for the particular method or process discovered by him. *Ibid.*, 112, 120.

21. The delay of Morse to enter a disclaimer for such claim, it having received the sanction of the head of the Patent Office, and been sustained by a Circuit Court, until such claim was passed upon by the Supreme Court, was not unreasonable, and the omission does not render his patent void. *Ibid.*, 122.

22. Morse's patent of 1846, reissued in 1848, for the local circuits, is for an invention not embraced in his former patents, and was properly issued. *Ibid.*, 123.

23. The Columbian telegraph, so-called, uses substantially the same means embraced in Morse's patent, and is an infringement upon it. *Ibid.*, 123, 124.

24. As to the construction of agreements respecting the electric telegraph, see AGREEMENTS, B., 17, 18, 19, 20, 35, 48, 49, 50.

## FIRE-ENGINES.

### RANSOM & WENMAN'S PATENT.

*Issued February 13th*, 1841.

1. The patent was for "an improvement in fire-engines," and described as connecting the receiving tubes or pumps of the engine, by means of hose, to hydrants, in which the water was under pressure, and claimed "the employment of a column of falling water, or the tendency of the hydrostatic pressure upon water at rest, to act in the working of fire-engines, by combining a hose or tube, conducting said water into the receiving tube of an engine or pump operated by manual or mechanical power."

*Held*, that the invention patented was "the combination of the pumps or receiving tubes of the fire-engine with a connecting-pipe or hose, forming a connection between such engine and a hydrant or water pipe from which water is forced by the hydrostatic pressure existing in the hydrant into the pumps of the engine, and applied so as to combine the power of this hydraulic pressure with the power applied to the brakes of the engine," substantially as set forth. *Ransom* v. *Mayor, &c.*, 1 Fisher, 261.—HALL, J.; N. Y., 1856.

2. *Held*, also, that the patent was not for a principle, and did not grant to the patentee the exclusive privilege of using such hydrostatic pressure in all forms and modes in which it could be applied to the production of the purposes of the character intended by him, but that the patent was only for the means and devices by which the patentee proposed to make such pressure available for the purpose indicated in the specification. *Ibid.*, 262.

## GLASS KNOBS.

### WHITNEY & ROBINSON'S PATENT.

*Issued August 22d*, 1826.

The patent was for "a new and useful

improvement in the mode of manufacturing glass knobs," by machinery, at one operation, in such a manner as, without any blowing, to produce a finished knob, with a hole perforated through it, and a neck or enlargement.

*Held*, that the description in the specification was sufficient in law, and that the patent was not broader than the invention. *Whitney* v. *Emmett*, Bald., 304, 315.—BALDWIN, J.; Pa., 1831.

## GRAIN-CLEANING MACHINES.

### PITTS' PATENT.

*Issued December 29th*, 1837.

1. The patent was for "a new and useful improvement in the machine for threshing and cleaning grain." The claim was for "the construction and use of an endless apron, divided into troughs or cells, in a machine for cleaning grain, operating substantially as described."

*Held*, that the patent was not for the endless apron of troughs or cells, but of an endless apron of troughs or cells combined with a particular threshing machine described, and that if the combination was new, it was patentable, although a part might have been applied to similar purposes in other machines. *Pitts* v. *Whitman*, 2 Story, 618, 619. —STORY, J.; Me., 1843.

2. And though the patentee described his invention as "a new and useful improvement," and it in fact consisted of a combination of several improvements, *Held*, that the patent was good not only for the whole combination, but also for each distinct improvement, so far as it was his invention. *Ibid.*, 620, 621.

3. The four claims in this patent each consist of combinations of mechanical powers, which produce a given result. *Pitts* v. *Wemple*, 6 McLean, 561.—McLEAN, J.; Ill., 1855.

### SANDERS' PATENT.

*Issued June 19th*, 1849.
*Reissued April 10th*, 1855.

1. This patent was for an "improvement in winnowing machines," and the claim was, the trunk gradually enlarged from below upward, and communicating with the atmospheric current through the grain-screen, in combination with the hopper, and the fan placed at the end of an opposite vertical trunk, to separate the chaff and other impurities from the grain, in the manner substantially as described.

*Held*, that the claim in the original patent is a correct description of the whole invention. *Sanders* v. *Logan*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

2. The third claim of the reissued patent is too broad. The use of a vertical blast-spout, so arranged that grain is cleaned from impurities within said spout, was not new. *Ibid.*

## GRINDING TOOLS.

### HOVEY'S PATENT.

*Issued September 23d*, 1845.

This patent was for "a new and useful improvement in the machinery for grinding tools." *Held*, that the uncertainty and obscurity in the specification of this patent as to what the patentee claims as his invention, or what is in fact the novelty of it, is so great as to render the patent invalid. *Hovey* v.

*Stevens*, 3 Wood. & Min., 19, 30, 31.—WOODBURY, J.; Mass., 1846.

## GUN LOCKS.

### ALLEN'S PATENT.

*Issued November 11th*, 1837.
*Reissued August 3d*, 1844.

The patent was for "an improvement in the method of constructing fire-arms."

*Held*, that the reissued patent of August 3d, 1844, is for the same invention as that described in the patent of November 11th, 1837. *Allen* v. *Sprague*, 1 Blatchf., 567.—NELSON, J.; N. Y., 1850.

## HARVESTING MACHINES.

### MCCORMICK'S PATENTS.

*Issued June 21st*, 1834.
*Issued January 31st*, 1845.
*Issued October 23d*, 1847.
*Reissued May 24th*, 1853.

1. The claim of McCormick, in his patent of October 23d, 1847, for improvement in reaping machines, was as follows: "The arrangement of the seat of the raker over the end of the finger pieces, and just back of the driving wheel as described, in combination with and placed at the end of the reel, whereby the raker can sit with his back toward the team, and thus have free access to the cut grain laid on the platform and back of the reel, and rake it from thence on to the ground by a natural sweep of his body, and lay it in a range at right angles with his swarth as described, thereby avoiding unevenness and scattering in the discharge of the wheat, as well as accomplishing the same with a great saving of labor."

*Held*, that it was the seat as thus described, by which the raker may sit or stand on the frame, and rake the wheat from the platform with convenience, that was claimed. *McCormick* v. *Seymour*, 2 Blatchf., 248, 251.—NELSON, J.; N. Y., June, 1851.

2. But the claim is not for the seat *as a seat*, or for its particular mode and form of construction, but for the arrangement and combination described, by which the benefit of a seat or position for the raker is obtained, by which the raker is placed where he is placed, standing or sitting, and do his work. *Ibid.*, 250, 253.

3. The improvement was not simply putting a seat on the machine for the raker, but was the arrangement and combination of the parts of the machine, so that the patentee was enabled to obtain room on the machine for the raker, and that he might have the free use of his body and limbs in raking off the grain, avoiding the labor and fatigue and inconvenience of walking. The seat or position of the raker on the machine was the object had in view, and was the result of his new arrangement and combination of the different parts of the machine. *McCormick* v. *Seymour*, MS.—NELSON, J.; N. Y., Oct., 1851.

4. The second claim in McCormick's patent, which is as follows: "I claim the reversed angle of the teeth of the blade, in manner described," is not simply for the reversed angles of the sickle teeth of the blade, but for reversing the angles of the teeth *in the manner previously described in his patent*—it is a claim for the angles formed by the peculiar shape of the fingers, in connec-

tion with the cutter, having the angles of the teeth reversed. *McCormick* v. *Seymour*, 3 Blatchf., 223.—NELSON, J. N. Y., 1854. [Reversed, *post* 11.]

5. McCormick's patent of June 21st, 1834, having expired, whatever of invention is contained in it belongs to the public, and may be used by any one. *McCormick* v. *Manny*, 6 McLean, 543, 544.—MCLEAN, J.; Ill., 1855.

6. In McCormick's patent of 1847, reissued in 1853, he claimed "the combination of the bow L and dividing iron M, for separating the wheat to be cut from that to be left standing." This claim being for a combination, the use of a wooden divider, as used and patented by Manny, is no infringement. *Ibid.*, 547, 549.

7. The reel part of McCormick, placed behind the sickles, and leaning forward, so as to bring the part of it supporting the reel perpendicular, also extending forward, so as to admit of being braced directly to the tongue, in combination with which it was claimed, is not infringed by the reel part of Manny, which connects with the hindmost post of the machine, and is sustained by braces. *Ibid.*, 550.

8. The improvement of McCormick, as to the seat, consists in the peculiar organization of advancing the reel in front of the cutters, and shortening it and putting the driving wheel back and the gearing forward, so as to balance the machine with the weight of the raker on the extended finger piece. It is adapted to no other part of the machine, and his improvement is limited to his specification. *Ibid.*, 552.

9. McCormick's invention was not the seat for the raker, but the change of the machinery to make a place for it. If a raker can be seated on a different part of the machine, and where he can rake without balancing the machine, and without interruption from the reel, or on any part of the machine which does not require substantially the same invention and improvement as McCormick's, it is no infringement of his right. *Ibid.*, 556, 557.

10. The patent of John H. Manny of March 6th, 1855, does not infringe upon McCormick's patent of 1847, reissued, 1853. *Ibid.*, 556.

11. McCormick's patent of 1845, among its claims had the following: "2. I claim the reversed angle of the teeth of the blade, in manner described. 3. I claim the arrangement and construction of the fingers or teeth for supporting the grain, so as to form the angular spaces in front of the blade, as and for the purpose described." *Held*, that the two were not to be construed together, as a claim for the reversed angle of the teeth of the blade, in combination with the peculiar form of the fingers; but that each claim was to be construed and considered separately. *Seymour* v. *McCormick*, 19 How., 99, 106.—NELSON, J.; Sup. Ct., 1856.

12. And that the former, the second, not being new, costs could not be recovered in an action for infringement, without a disclaimer being made of such claim. *Ibid.*, 106.

13. McCormick was not the original inventor of the contrivance called the divider, for separating the grain in advance of the cutting apparatus. *McCormick* v. *Talcott*, 20 How., 406.—GRIER, J.; Sup. Ct., 1857.

14. His fourth claim in his patent of 1845, for "the combination of the bow L and dividing iron M, for separating the wheat in the way described" is the proper subject of a patent, but is not

infringed by one who uses only a part of the combination; nor can it challenge other improvements on the same machine, different in form or combination, as infringements, because they perform the same functions, by calling them equivalents. It is a claim for the combination of the bow with a dividing iron of a certain form, and for nothing more. *Ibid.*, 406.

15. The divider described in Manny's patent of 1847, is not an infringement on the invention of McCormick. *Ibid.*, 406, 407. [DANIEL, J.; dissenting.]

16. The manner of supporting the reel, us used in Manny's machine, is not the same as the invention of McCormick, and it had been in use before McCormick's patent. *Ibid.*, 407, 408.

17. As to the raker's seat, McCormick's claim was for the combination of the reel with a seat, arranged and located according to his description. Manny's arrangement is substantially different, both in form and combination, and is no infringement upon McCormick's patent. *Ibid.*, 408.

### HUSSEY'S PATENT.

*Issued August 7th*, 1847
*Reissued April 14th*, 1857, *in three.*

The patent was for certain "new and useful improvements in reaping machines," and the claim was for the combination of vibrating scalloped cutter, the indentations of whose edge act as a series of moving shear blades, with slotted guard fingers, the sides of which act as a corresponding series of fixed shear blades; the parts of such fingers forming the slot being connected at the front ends only, leaving the rear of the slot open and free for the escape of material that would otherwise clog the cutter.

*Held*, that his invention was not confined to a guard finger with a slot open at the *top*, but included a guard finger with a slot open below the cutter, and that it was not required that the scallop should be of any particular depth, or that the angle they make should be greater or less, or that the cutter should be sickle-edged; any combination of the open slotted finger with vibrating scalloped cutters is embraced in the patent. *Hussey* v. *McCormick*, 1 Fisher, 513.—McLEAN, J.; Ohio, 1859.

### HAT BODIES.

#### WELLS' PATENT.

*Issued April 25th*, 1846.
*Reissued September 30th*, 1856.
*Reissued October 7th*, 1856.

1. In an action for an infringement upon Well's patent for making hat bodies, the defendants in their machine divided the tunnel or chamber into which the fibres of the fur were thrown, and used a perforated cone of wire gauze, of larger opening than Wells, and put a finer one of grass cloth over it, and used a metallic picker instead of the hair brush to throw the fibres of the fur into the chamber, and also, instead of immersing the bat formed on the cone, into warm water, to harden it, so that it could be removed, discharged jets of steam upon the bat during the process of formation.

*Held*, on an application for an injunction, that the machine of the defendants, and their process of making the hat body, was substantially like that of the complainants, the assignees of

Wells, and that they were entitled to an injunction. *St. John* v. *Prentiss*, MS.—NELSON, J.; N. Y., 1853.

2. The nature of this invention is the formation of hat bodies by throwing the fibres of wool or fur, in proper proportions, on a perforated cone, exhausted by a fan or other contrivance, to hold the fibres on the cone by the currents of air rushing through the perforated cone, and to harden sufficiently the bat of wool or fur. Previous to the discovery and invention of Wells, no devices were known to accomplish such desired object in a satisfactory way. *Burr* v. *Cowperthwaite*, 4 Blatchf., 165.—INGERSOLL, J.; Ct., 1858.

3. The devices or essential means used, are a fur table, upon which the fur is distributed, a suitable feeding apparatus to bring the fur to the table and present it to rotary brushes, or other suitable device for disintegrating and casting the fur into a current of air induced by the brushes or otherwise, a trunk or other device between the brushes and cone extending some distance from the brushes and in the direction of a perforated exhausted rotary cone to control and give direction to the current of air, and a hood, or some analogous device, to further modify the current of air for the proper distribution of the fur upon the cone. *Ibid.*, 167.

4. Before the discovery of Wells, no machine was known or used that did, by any means, *direct* a sheet of fur on a section of a perforated exhausted rotary cone, or other form, so as to make a bat of fur on the cone or other form, of the desired shape and thickness, in properly regulated quantities, at the will of the operator. By the machines before known no sheet of fur was *directed* by the organization of the machine on to the perforated cone, but the fur was deposited on the exhausted cone by the power of gravity, or the power of the exhaust, or both, and not by the power of the machine, *directing* how and in what manner the fur should be distributed on the cone. *Ibid.*, 168.

5. This mode (by directing the fur) of forming the bats distinguished the Wells' machines from all others known or used before his discovery. *Ib.*, 169.

## ICE, CUTTING.

### WYETH'S PATENT.

*Issued March 18th*, 1829.

The patent was for "a new and useful improvement in the manner of cutting ice, together with the machinery and apparatus therefor," and it was claimed as new, to cut ice of a uniform size, by means of an apparatus worked by any power other than human. The invention of the art described, as well as the particular method of the application of the principle, were both claimed.

*Held*, that so far as the patentee claimed the art of cutting ice by means of any power other than human, it was a claim for an art or principle in the abstract, and void; but so far as it claimed the machines described, it might be good, if a disclaimer was properly entered under §§ 7 and 9 of the act of 1837. *Wyeth* v. *Stone*, 274, 285, 287, 294.—STORY, J.; Mass., 1840.

## INDIA-RUBBER.

### CHAFFEE'S PATENT.

*Issued August 31st*, 1846

The patent was for "a new improve-

ment in the application of caoutchouc to cloths, &c."

*Held*, that the patent covered both the process described in the specification, and the machinery described as that to be used in carrying on the process. *Day* v. *Union India-rubber Co.*, 3 Blatchf., 490.—HALL, J.; N. Y., 1856.

GOODYEAR'S PATENTS.

SHIRRED GOODS PATENT, *issued March* 9, 1844.
SOFT RUBBER PATENT, *issued June* 15, 1844.
*Reissued December* 25. 1849.

1. Goodyear's invention for combining with calendar rollers, an elastic endless apron, for manufacturing corrugated, or shirred, india-rubber goods, does not consist either in the whole machine, or in any particular part of it, but consists in a new combination of known mechanical principles or powers to produce a new and useful effect. *Warner* v. *Goodyear*, MS.—CRANCH, Ch. J.; D. C., 1846.

2. The surrender of Goodyear's original patent for vulcanized rubber, of June 15th, 1844, and the reissued patent, December 25th, 1849, was legal, and the reissued patent is not void upon its face. *Day* v. *Goodyear*, MS.—GRIER, J.; N. J., 1850.

3. Charles Goodyear must be considered as the first and original inventor of the process of vulcanizing india-rubber. *Ibid.*

4. His reissued patent of December 25th, 1849, is not void because of the publication of the invention, in his original and defective patent, in the interval between the original and reissued patent, on the ground that such publication amounts to an abandonment or dedication to the public. *Ibid.*

5. Goodyear's invention did not consist merely in the use of sulphur, or lead, or both, or the application of heat to rubber in connection with both, either or neither of them; all these things had been done before. The essential and distinctive peculiarity of his discovery is, that by using a certain degree of heat in the treatment of rubber, in connection with those materials, it can be made to assume new and valuable qualities, distinguishing it from any other substance heretofore known. *Ibid.*

6. By the agreements of October 29th, 1846, November 5th, 1846, and December 5th, 1846, making one agreement, made by and between H. H. Day and Charles Goodyear, and the acts under them, and in perfecting the same, Day is estopped thereafter from denying the validity of Goodyear's patents. *Ibid.*

7. Goodyear's invention of vulcanizing rubber, is a discovery of a new compound, substance, or manufacture, and both the process and composition of matter are new, and both are protected or included in the patent. *Goodyear* v. *the Railroads*, 2 Wall., Jr., 361.—GRIER, J.; N. J., 1853.

8. His claim is for the vulcanizing of rubber and sulphur by artificial heat, however produced; the method of communicating heat is not the thing patented; therefore, the use of steam instead of heated air, is an infringement upon his invention. *Ibid.*, 362.

9. His patent is for a new product as well as a new process, and being both for the process and the product, the use and sale of the composition, unless when purchased from persons licensed by him to use the process and vend the product, is an infringement of his franchise, and may be prohibited by him. *Ibid.*, 365.

10. Under the agreement of September 5th, 1850, made between Chaffee, the patentee, and William Judson, as trustee, that the latter should hold the patent, and have the control thereof for the benefit of Goodyear and those holding rights under him, the entire ownership of the patent, legal and equitable, passed to Judson. *Hartshorn* v. *Day*, 19 How., 220.—NELSON, J.; Sup. Ct., 1856. The same decision made in *Day* v. *Union I. R. Co.*, 20 How., 217.—NELSON, J.; Sup. Ct., 1857.

11. The agreement of October 29th, 1846, the two supplemental agreements of November 5th, 1846, and the further one of December 5th, 1846, made between Goodyear and Day, and by which Goodyear sold and assigned to Day the full, absolute, and exclusive right, license, and privilege to make, use, and vend *shirred or corrugated goods*, and to use certain machinery and compounds in connection therewith, granted to Day only the right to make and vend such shirred or corrugated goods as are described in, and were patented to Goodyear, by what is called the shirred goods patent, issued March 9th, 1844, and did not confer upon Day any right to use Goodyear's preparations, and improvements in india-rubber, or to use vulcanized rubber in the manufacture of any elastic articles, or elastic goods, or elastic cloths, except the *shirred or corrugated* goods made according to such patent of March 9th, 1844. *Day* v. *Carey*, 4 Blatchf., 278.—INGERSOLL, J.; N. Y., 1859.

12. The meaning of the words "shirred or corrugated goods," as understood and used by the parties to such deeds, was the elastic rubber goods manufactured according to the patent of March 9th, 1844, and no other kind of elastic goods was meant by the use of these terms. *Ibid.*, 279.

13. The opposite of the above view, however, taken in Maryland, by GILES, J.; who held that by the contract of October, 29th, 1846, the term *shirred* or *corrugated goods*, means all kinds of shirred or corrugated goods, whether cemented, woven, or sewed, and is not limited to the goods made under the patent of March 9th, 1844; and that if such contract did not confer upon Day such right, the agreement of May 24th, 1858, made between Goodyear and said Day, conveyed such interest to him. *Day* v. *Stellman*, 1 Fisher, 501.—GILES, J.; Md., 1859.

14. The same view taken in *Day* v. *Stellman*, was also taken in *Day* v. *Lyons*, MS.—MCCALEB, J.; La., 1860.

### MEYER'S GREASE PATENT.

*Issued December 20th*, 1853.

1. The patent was for an "improvement in the manufacture of caoutchouc and other vulcanizable gums," and the claim was for the producing of smooth and glossy surfaces upon the hard compounds of caoutchouc and other vulcanizable gums, by means of the use of oil, or other equivalent substance, applied to the surface of the prepared gum, and between the gum and the plates of metal, or the moulds.

*Held*, that the patent granted the exclusive use of oil, or other equivalent substances, applied to the surface of the prepared gum, and between the gum and plates of metal, or tin-foil, placed on each side of it, or the moulds, substantially as described in the patent. *Poppenheusen* v. *N. Y. Gutta-Percha Comb Co.*, 4 Blatchf., 190.—INGERSOLL, J.; N. Y., 1858.

*Held also*, on a motion for an injunction, in respect to an alleged infringement of this same patent, that the use of turpentine with india-rubber dissolved in it, was an equivalent of oil, and its use an infringement. *Poppenheusen* v. *Falke*, 2 Fisher, 217.—SHIPMAN, J.; N. Y., 1862.

MEYER'S TIN-FOIL PATENT.

*Issued April 4th*, 1854.
*Reissued August 16th*, 1859.

1. This patent was for an "improvement in treating caoutchouc and other vulcanizable gums," and the invention consisted in covering the surface of the hard compound of caoutchouc during the process of vulcanization with tin-foil or other equivalent substance, to preserve the form previously given by embossing or moulding.

*Held*, the patent did not grant the exclusive right to vulcanize the hard compound, in contact with metallic surfaces, or vulcanize such compound when a series of sheets are piled upon one another with interposed sheets of flexible material, when the pile is confined between iron plates; or generally to give form or shape to such compound by pressure; or to preserve, during the progress of vulcanization, the form previously imparted by pressure to the hard compound. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 78.—INGERSOLL, J.; N. Y., 1858.

2. But this patent granted the exclusive right to the use and application of tin-foil, or its equivalents, to the hard compound of india-rubber and gutta-percha, during the process of vulcanization, to preserve and retain, during the process of heating and hardening, the forms and shapes given to the material, before the heating process commences, without any other pressure or moulds. *Ibid.*, 78.

3. And though tin-foil or any other flexible or pliable metal may have before been used in some way, in connection with such gums, if they were not substantially performing the same office in substantially the same way, they would not make this patent inoperative, or deprive the inventor of the right granted by it. *Ibid.*, 78.

4. On a motion for an attachment for violating an injunction restraining the use of the invention described in this patent, *Held*, that sheets of brass and tin, like roofing tin, were not the equivalent of tin-foil. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 83.—INGERSOLL, J.; N. Y., 1859.

5. But the reissued patent embraces the use and application of all metal plates that are sufficiently flexible to be used substantially in the manner described in the patent, and with substantially the same results that tin-foil could be used. *Poppenheusen* v. *Falke*, MS. —SHIPMAN, J.; N. Y., 1862.

## IRREGULAR FORMS, TURNING.

BLANCHARD'S PATENT.

*Issued September 6th*, 1819.
*Issued January 20th*, 1820.

1. The patent was for a "machine for turning and cutting irregular forms," and the patentee in his specification declared that, "as to the mechanical powers by which the movements are obtained, he claims none of them as his invention. These movements may be effected by

application of various powers indifferently. Neither does he claim as his invention the cutter wheel or cutters, or friction wheel as such, nor the use of a model to guide the cutting instrument, as his invention. But he claims as his invention, the method or mode of operation in the abstract, explained in the second article, whereby the infinite variety of forms described in general terms, may be turned or wrought." In the second article was described not a mere function, but a machine of a particular structure, whose modes of operation are pointed out, to accomplish a particular purpose, function, or end.

*Held*, that his invention was for a particular machine, constituted in the way pointed out, for the accomplishment of a particular end or object, and that the patent was for a machine, and not for a principle or function detached from machinery. *Blanchard* v. *Sprague*, 3 Sumn., 536, 540; 2 Story, 166, 170.—STORY, J.; Mass., 1839.

2. It is immaterial whether the lateral motion was produced, as in Blanchard's machine, by a screw, or whether by a wheel or axle. *Blanchard's Gun-Stock Turning Fac.* v. *Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

3. It is also immaterial whether the cutter and friction wheels have the lateral motion, or the pattern and rough material, as the relative effect of the parts acting on each other is the same. *Ibid.*, 278.

4. The particular manner or process for throwing the machine out of gear, also formed no part of the invention. *Ibid.*, 278.

5. The objection that the specification claims that any article can be turned from a model, by the machine, whether larger or smaller, preserving the same proportions, is not tenable, though the capacity of the machine may be limited. *Ibid.*, 279.

6. Though it was claimed that the machine would turn any irregular surface, but could not in fact turn a square shoulder, *Held*, the defect was too remote and extreme to affect the validity of the patent. *Ibid.*, 280.

7. The principle or inventive element to be found in Blanchard's machine, is the cutting or turning of any given article of an irregular form longitudinally and transversely, by one joint operation, by the combination of four instruments, the model, the rough material, the tracer or friction wheel, and the rotary cutter. *Blanchard* v. *Beers*, 2 Blatchf., 413.—NELSON, J.; Ct., 1852.

8. It embraces in its scope and operation the cutting of almost every species of irregular form, embracing any given extent of irregularity of form, by means of the application of the combination or principle which he has discovered. *Ibid.*, 415.

9. A person who uses Blanchard's machine, though only for the performance of one of its functions, as turning wagon spokes, is guilty of an infringement. *Ibid.*, 416.

*Renewed Patent, under Act of June 30th, 1834.*

The act was "an act to renew the patent of Thomas Blanchard," but the references in this act to the patent of Blanchard intended to be extended, did not agree with any of his previously existing patents.

*Held*, that the variances were such that the court could not correct them, or give validity to the patent issued under such act. *Blanchard* v. *Sprague*,

3 Sumn., 279, 285, 286.—STORY, J.; Mass., 1838.

*Renewed patent, under Act of February 6th*, 1839.

1. The title of this act was as follows: "an act to amend and carry into effect the intention of an act entitled an act to renew the patent of Thomas Blanchard, approved June 30, 1834."

*Held*, that it was not unconstitutional, but could be sustained upon ordinary principles of construction. *Blanchard* v. *Sprague*, 2 Story, 171.—STORY, J.; Mass., 1839.

2. § 1 of the act of 1839 intended to give to assignees of the old patent an equally exclusive privilege in the extended term. *Blanchard's Gun-Stock Turning Factory* v. *Warner*, 1 Blatchf., 275.—NELSON, J.; Ct., 1846.

3. The act of 1839, extending Blanchard's patent, did not extend the mere legal right under the patent, but the exclusive right to the invention, and the specification was referred to only to identify the invention. *Ibid.*, 279.

## LEAD PIPE MACHINES.

### TATHAM'S PATENT.

*Issued October 11th*, 1844.

1. The patent was for an "improvement in the machinery for making pipes or tubes of lead, tin, and other metallic substances;" and the claims were 1st, "the long core or core-holder, formed and held stationary with relation to the dies, as described," and 2d, "the constructing the piston B, hollow, in the manner described, and the combination of the same with the long core or core holder, upon which the piston slides." The *second* claim was the one in dispute.

*Held*, that the patent was for an improvement on the Burr machine, and that the improvement of the patentee enabled him to use a long core or core-holder, extending through the ram, and held stationary with relation to the dies by fixing it firmly at the crosshead of the frame, and by means of the hollow piston sliding upon the core-holder, the defect in the Burr machine of the unsteadiness of the core was got rid of, as was also the defect in the Hanson machine, of an imperfect union of the metal, because of the use of a bridge near the bottom of the cylinder, holding a short core—this bridge being dispensed with in the Tatham machine. *Tatham* v. *Le Roy*, 2 Blatchf., 482, 484.—NELSON, J.; N. Y., 1852.

2. The invention does not, however, consist in the combination of the hollow ram and the core or core-holder alone—cylinders sliding upon rods having previously existed in mechanical constructions and in practical use—but in adapting or applying this peculiar combination to producing a useful and practical result—the making lead pipe by pressure. *Ibid.*, 490, 491.

### HANSON'S PATENT.—TATHAM, ASSIGNEE.

*Issued March 29th*, 1841.
*Antedated August 31st*, 1837.
*Reissued March 14th*, 1846.

1. The patent was for "improvements in machinery for making pipes or tubes of lead, etc.," and the claim was the combination of the core and bridge or guide-piece, the chamber and die, when used to form pipes of metal under heat and pressure in the manner set

forth, or substantially the same; *Held*, that the invention did not consist in the novelty of the machinery employed, but in bringing a newly discovered principle into practical operation, by which a useful article of manufacture is produced, and wrought pipe made, as distinguished from cast pipe. *Le-Roy* v. *Tatham*, MS.—NELSON, J.; N. Y., 1849.

2. The reissued patent of 1846, is for the same invention as the original patent. *Ibid.*

3. Decision in the case above, overruled, and held, that the claim was for the combination of machinery through which the new property of lead is developed, as a part of the process in the structure of lead pipe, and that the claim could not be sustained without establishing the novelty of the combination. *Le Roy* v. *Tatham*, 14 How., 177.—MCLEAN, J.; Sup. Ct., 1852.

4. The question, whether the newly developed property of lead—that while under heat and pressure in a close vessel, it would, after a separation of its parts, reunite perfectly—as used in the formation of pipes, might have been patented, if claimed as developed, without the invention of machinery, was not in the case. *Ibid.*, 177.

5. This patent further examined, and explained, and sustained. *Le Roy* v. *Tatham*, 22 How., 141.—MCLEAN, J.; Sup. Ct., 1859.

### CORNELL'S PATENT.

*Issued August 21st*, 1847.

The patent was for an "improvement in lead pipe machinery," and the machine was also an improvement upon the Burr machine.

*Held*, the invention consists in boring the solid ram of Burr, and placing the die in the face of it, at the same time closing the bottom of Burr's cylinder, and fixing the core firmly at the bottom, where Burr's die was placed. The core extends through the cylinder and into the die thus fixed in the face of the ram. In the operation of the machine the core passes through the die and into the hollow ram nearly the length of it, the pipe passing through the same aperture above. *Tatham* v. *Le Roy*, 2 Blatchf., 484, 485.—NELSON, J.; N. Y., 1852.

## LOCOMOTIVES, VARIABLE EXHAUST OF.

### WINANS' PATENT.

*Issued November 26th*, 1840.
*Extended November 26th*, 1854.

1. The patent was for "an improvement in regulating the waste steam of locomotive engines," and the claim was for increasing or diminishing the force with which the waste steam enters the chimney at the pleasure of the engineer, by enlarging or contracting the orifices of the escape pipes, and thereby increasing or diminishing the draught of the chimney.

*Held*, that the idea conceived by the patentee and reduced to practical use, is the regulation of the exhaust steam, turned into the smoke chimney to increase the draught of the fire, according to the necessities of the operation of the locomotive—increasing the current of the steam and thereby the draught, when it is necessary to generate steam rapidly, and again diminishing it when so great a quantity is not necessary to accomplish the carrying of the lead.

*Winans* v. *Danforth*, MS.—NELSON, J.; N. Y., 1860.

2. And it makes no difference what may be the location of the machinery for regulation, whether at the bottom or midway in the smoke-stack, or in the chimney; the idea, operation, or effect being the same and the difference only in degree. *Ibid.*

## LOOMS.

### STONE'S PATENT.

*Issued April 30th*, 1829.

1. The patent was for "a new and useful improvement in looms," and the specification declared the improvement as consisting in the communication of motion from the reed to the yarn-beam, and in the connection of the one with the other, which is produced and described as follows: the claim was "the connection of the reed with the yarn-beam, and the communication of the motion from the one to the other, which *may be* done as specified."

*Held*, that the patentee's invention was limited to the specific machinery and mode of communication of the motion from the reed to the yarn-beam, set forth and specifically described. *Stone* v. *Sprague*, 1 Story, 270, 272.—STORY, J.; R. I., 1840.

2. If the patent included all other modes of communication of motion from the reed to the yarn-beam, and for the connection of the one to the other generally, it would be void, as being an attempt to maintain a patent for an abstract principle, or for all possible and probable modes whatsoever of such communication, though invented by others, and substantially differing from the mode described by the patentee. *Ibid.*, 272.

## MATCHES, FRICTION.

### PHILLIPS' PATENT.

*Issued October 24th*, 1836.
*Extended September 11th*, 1850.

1. The patent was for "a new and useful improvement in the manufacture of friction matches for the instantaneous production of light," and the specification set forth the making of friction matches by the use of phosphorus, chalk, and glue, without chlorate of potash and sulphuret of antimony, and stated that the proportion of the ingredients could be varied, and that gums could be used in place of glue, and other absorbent earths or materials instead of the carbonate of lime. The claim was for the use of a paste or composition, consisting of phosphorus, an earthy material, and a glutinous substance, without chlorate of potash, or sulphuret of antimony. *Held*, that the patent was not void, from vagueness, generality, or uncertainty. *Ryan* v. *Goodwin*, 3 Sumn., 517, 522.—STORY, J.; Mass., 1839.

2. The invention claimed by the patentee, consists in rejecting the two elements, chlorate of potash and sulphuret of antimony, and substituting in their place, chalk or some earthy matter. *Byam* v. *Farr*, 1 Curt., 262.—CURTIS, J.; Mass., 1852.

3. *Held* also, that the other claim, which consisted in sawing the matches in sheets, so as to leave them united at one end, and wrapping them in strips of paper, must be construed to embrace only the entire and complete mode de-

scribed, and that the use of a part of it, as sawing the matches as described, but without wrapping them in paper, was no infringement. *Ibid.*, 265.

3. The invention is not a compound of new ingredients, before unused in making matches, but simply and only a new combination of old materials before in use for that purpose. *Byam* v. *Eddy*, 2 Blatchf., 523.—PRENTISS, J.; Vt., 1853.

## MILLSTONES, REGULATING, &C.

### SMITH'S PATENT.

*Issued September 25th*, 1837.

1. The patent was for a "new, improved mode of grinding, holding, and accommodating millstones." The part claimed as new, was "connecting the bridge-tree with the top of the frame, or its substitute, in the manner described, and the mode or manner of elevating or depressing the running stone by the application of the screw to the bridge-tree in the manner described, or any other producing the effect." The improvement of the defendant consisted in the manner in which he constructed the part called the pressure rod, which is intended to elevate the bridge-tree, and consequently the running stone, and to regulate the action of the mill in that particular part.

*Held*, that the principle of elevating and lowering the upper stone, or runner, was that which was new, and which gave value to the machine, and that defendant's machine, though different in form, was the same in principle as to elevating and lowering the stone, and therefore an infringement. *Smith* v. *Pearce*, 2 McLean, 179.—MCLEAN, J.; Ohio, 1840.

## MOULDINGS, MAKING.

### SERRELL'S PATENT.

*Issued May 16th*, 1846.
*Reissued January 7th*, 1851
*Reissued June 21st*, 1853.

1. The patent was for "an improvement in machinery for making mouldings," and the object of the invention was to make mouldings on an angular piece of wood, effecting a great saving of material.

*Held*, that what was granted, among others, is the combination of the ring or rings, with a cutter or cutters, for operating on an angular strip for making mouldings, whether such angular strip be a *bevel* or an *angular* strip, whether the cutter or cutters be stationary or rotary, or both, and whether the cutter or cutters operate upon the face or the edge of the strip, or on both the face and edge, substantially as described. *Serrell* v. *Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

2. This patent is not for yielding and fixed pressure, and feed rollers in combination with rotary and fixed cutters; but it is for the combination described for operating on an angular strip for making mouldings. *Ibid.*

## NAILS, MANUFACTURE OF.

### PERKINS' PATENT.

*Issued February 14th*, 1799.

1. The patent was for "an improvement in machinery for making nails," and the machine consisted of an upright and permanent jaw and a movable one, united by a pivot at the top; in each

jaw a cutter was fixed to nip the bar of iron to the size of the nail, and a griping die to hold it until the head is made by a heading die, the power used being a lever of the first order.

*Held*, that the patent was not for the machine itself, which is composed of parts which have long become public property, but for an improvement in the art of making nails by means of a machine which cuts and heads the nails at one operation. It is not the grant of an abstract principle, nor of the different parts of any machine, but of an improvement applied to a particular use, effected by a combination of various mechanical powers to produce a new result. *Gray* v. *James*, Pet. C. C., 400. —WASHINGTON, J.; Pa., 1817.

2. And that a machine having two jaws pivoted below, and worked by a friction roller and a lever of the second order, the differences as to such roller and lever being the necessary consequences of the machine being invented, was an infringement on it. *Ibid.*, 399, 401.

### PALM-LEAF, PREPARING.

SMITH'S PATENT.

*Issued March* 18*th*, 1841.

The patent was for a "new and useful improvement in the application of a material called palm-leaf, or brub grass, to the stuffing of beds, mattresses, sofas, cushions, and all other uses for which hair, feathers, moss, or other soft and elastic substances are used." The specification described preparing palm-leaf by a certain process and machinery for stuffing beds, mattresses, &c., but the same process and machinery had been used in preparing hair for similar purposes.

*Held*, that the patent was not for any new process, but merely applying an old process to a new material, and was not valid. *Howe* v. *Abbott*, 2 Story, 191, 192, 194.—STORY, J.; 1842.

### PAPER, MANUFACTURE OF.

KNIGHT'S PATENT.

*Issued September* 25*th*, 1839.

The patent was for an "improvement in machinery for making paper," and the object of this machine was the completion of the process of manufacture by dyeing, consolidating, and *finishing*. It did this by employing a series of heated metallic cylinders, of which the heat is susceptible of graduation, and which were so arranged as that some of them shall be pressed upon by the others, with regulated degrees of pressure. The naked moist paper is made to pass alternately around and between these cylinders, and is thus progressively dried and consolidated by the heat and pressure which it derives from them through the successive stages of the process.

*Held*, that the principle of the combined machine is the repeated action of heat and pressure applied alternately and directly upon the material, in degrees adapted to its progressive character. The number of the cylinders, their exact relative position, their precise dimensions, and the fact that some of them may be made to revolve without actual contact, and the arrangement for graduating the heat and pressure are not essential. *Knight* v. *Gavit*, Mir. Pat. Off., 131.—KANE, J.; Pa., 1846.

AMES' PATENT.

The patent was for a "new and useful improvement in machinery for making paper." The summary was as follows: "I do not claim the felting, vats, rollers, presses, wire-cloth, or *any separate* parts of the above-described machinery or apparatus, as my invention. What I claim is, the construction and use of the peculiar kind of cylinder described, and the several parts thereof in combination for the purposes aforesaid."

*Held*, that the patent was not for the cylinder and the several parts thereof, but its construction and use, in combination with the other parts of the machinery, for the purpose of making paper. *Ames* v. *Howard*, 1 Sumn., 483, 487.—STORY, J.; Mass., 1833.

## PLANING MACHINES.

WOODWORTH'S PATENT.

*Issued December 27th*, 1828.
*Extended November 16th*, 1842.
*Reissued July 8th*, 1845.
*Disclaimer as to the application of the circular saw, filed January 2d*, 1843.

1. The patent was for a "new and useful improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either, plank, boards, or any other material, and for reducing the same to an equal width and thickness; and also for facing and dressing brick, and cutting mouldings, or facing metallic, mineral, or other substances;" and the claim was for the improvement and application of cutting or planing wheels to planing boards, &c.; also his improved method of cutters for grooving, tonguing, and cutting mouldings, or facing brick, &c.; also the application of the circular saw in the manner described.

2. *Held*, that the extension to the administrator of the patentee was legally granted. *Brooks* v. *Bicknell*, 3 McLean, 259, 260.—MCLEAN, J.; Ohio, 1843. [This view sustained in *Van Hook* v. *Scudder*, MS., N. Y., 1843; *Brooks* v. *Bicknell*, 3 McLean, 436, 1844; *Washburn* v. *Gould*, 3 Story, 133, 1844; *Woodworth* v. *Wilson*, 4 How., 716, 1845.]

3. The specifications of this patent describe the machine so as to enable a skilful mechanic to construct it. It contains nothing which an intelligent mind, though but little versed in mechanics, may not fully comprehend. The facts that the moving power is described in some of its parts in the alternative, and that the material, whether wood or iron, of construction is not stated, are not material. *Ibid.*, 260, 261.

4. The specifications show with reasonable certainty the combination of which the invention consists. *Brooks* v. *Bicknell*, 3 McLean, 445.—MCLEAN, J.; Ohio, 1844.

5. The invention of Woodworth consists in the combination of certain known mechanical structures, by which boards are planed, tongued, and grooved in the same operation. *Ibid.*, 453.

6. The use of "pressure rollers" instead of a carriage to move the plank to the cutters, and the placing the plane irons on a wheel or arms of a shaft, and inclined so that the cutting edges generate a cone, instead of having the cutters on a cylinder, do not change the principle of the machine. *Ibid.*, 455.

7. The patent is for a mode of accomplishing a particular end by certain

means; for an aggregate or improved machine. *Washburn* v. *Gould*, 3 Story, 146, 151, 158.—STORY, J.; Mass., 1844.

8. The renewed letters patent granted to William W. Woodworth, administrator, on the 8th of July, 1845, are good and valid in law, and are not void for uncertainty, ambiguity, or multiplicity of claim, or any other cause. *Wilson* v. *Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

9. William Woodworth is to be considered the original and first inventor of the planing machine, patented to him December 27th, 1828. *Woodworth* v. *Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

10. Woodworth's specifications can only be sustained for a combination of known mechanical powers, and not for an improved machine. *Brooks* v. *Bicknell*, 4 McLean, 73, 74.—MCLEAN, J.; Ohio, 1845.

11. The *Andrews* machine, so called, which used a planing cylinder, but no tonguing or grooving wheels, and used a carriage instead of friction rollers to move the planks forward, such carriage being moved by an endless chain, and the planks being kept down on the carriage by springs adjusted on frame-work near the planing cylinder, was held, on a motion for an injunction, to be an infringement on Woodworth's patent. *Gibson* v. *Betts*, 1 Blatchf., 164.—NELSON, J.; N. Y., 1846.

12. The substitution in a plaining machine of two smooth plates of iron, operated by a screw and a spring, to press down the board upon the moving platform, in the place of the pressure rollers used by Woodworth, is not a substantial departure from Woodworth's contrivance. *Gibson* v. *Harris*, 1 Blatchf., 170, 171.—NELSON, J.; N. Y., 1846.

13. The cone or disk-shaped wheel of the MacGregor machine is an equivalent for the planing cylinder used by Woodworth. *Sloat* v. *Plympton*, 4 West. Law Jour., 60.—KANE, J.; Pa., 1846.

14. The *MacGregor* machine, which has, in place of the cylinder carrying the knives, an obtuse or flattened cone or conically shaped wheel, the knives being in a plane inclined to the axis or shaft of the wheel, the change in action of the knives consisting simply in the knives passing over more of the surface to be planed, and cutting a part of the distance crosswise of the board, is an infringement of the Woodworth patent. *Van Hook* v. *Pendleton*, 1 Blatchf., 191. —BETTS, J.; N. Y., 1846.

15. The *Bicknell* machine, which had a planing wheel similar to that of the MacGregor machine, in he points in which the latter is claimed to be different from the Woodworth machine, was also held to be an infringement of Woodworth's patent. *Ibid.*, 192.

16. *Gay's* machine, which in construction was like the MacGregor machine, was also held to be an infringement of Woodworth's patent, on a motion for an injunction, by KANE, J.; Pa., *Ibid.*, 192.

17. The case of *Wilson* v. *Rosseau*, 4 How., 644, was founded on the amended specification of 1845 of Woodworth's patent, and it was held by the Supreme Court that the patents of 1828 and 1845 were both for the same invention. *Ibid.*, 194, 195.—NELSON, J.

18. The Supreme Court, in *Wilson* v. *Rosseau*, 4 How., 646, 1845, proceeded on the ground that the reissued patent of Woodworth, upon the surrender after the second extension, that by act of

Congress was valid. *Woodworth* v. *Edwards*, 3 Wood. & Min., 127.—Woodbury, J.; Mass., 1847.

19. The planing machine patented to Brown, of Vermont, in November, 1845, was held, in a suit brought against the patentee in Vermont, to be substantially like Woodworth's, and its use restrained by injunction. *Woodworth* v. *Rogers*, 3 Wood. & Min., 142.—Woodbury, J.; Mass., 1847.

20. The former decisions as to the Woodworth patent, in respect to the novelty of the invention, and whether Woodworth was the first and original inventor; and as to the surrender of the patent and its reissue of the 8th July, 1845, with an amended specification; and as to the identity of the invention covered by the original and reissued patents approved and reaffirmed. *Gibson* v. *Gifford*, 1 Blatchf., 530.—Nelson, J.; N. Y., 1850.

21. Rotary guides, so arranged and adjusted as to press, by means of weights against the edges of the board while it is undergoing the operation of the plane or cutter, and such guides being placed obliquely somewhat to the motion of the board, so that their position produces, as they revolve against the edges, a constant tendency to keep the board to its bed (as patented in 1849 to Levy, assignee of Knowles), are but an *analogous device* for the *pressure* rollers of Woodworth's patent, which act upon the face of the board. Both are used for the same purpose, and lead to the same result, though arranged and adjusted by a somewhat different mechanical contrivance—the only difference being the application of the pressure to a different part of the board. *Gibson* v. *Van Dressar*, 1 Blatchf., 534, 535.—Nelson, J.; N. Y., 1850.

22. The use of a revolving cutter-wheel—as also patented to said Levy—having offsets or bevels near its outer periphery, to allow a board thicker than the finished work is intended to be to enter between the edge of the wheel and the face of the bench, is only a colorable imitation of the rotary cutters of Woodworth. *Ibid.*, 535, 536.

23. Woodworth's patent is not for an organized machine, containing parts performing certain functions, and producing certain results, irrespective of the particular instrumentalities so operating, but it is clearly for a combination only. *Brooks* v. *Fiske*, MS.—Sprague, J.; Mass., 1851.

24. Woodworth's machine is an improvement on the Hill machine, and the only change made by Woodworth consists in placing the rotating cylinder, which, in Hill's machine, was in a fixed position below the bed, in a fixed position above the bed. This arrangement gave to the pressure roller, in addition to its function of keeping the board down upon the bed, the function, performed by the bed in Hill's machine, of keeping the board from being drawn into the axis of the cutter. The effect of such arrangement is to plane the board on the upper instead of the under side, and the result is, that the board comes out of an uniform thickness, which was not accomplished by Hill. *Ibid.*

25. In the Noreross machine, the arrangement of the pressure roller, bed-piece, and cutter, is the same as Hill's; his improvement consists in making the cutting cylinder move vertically, and connecting it with his rest or pressure roller, so that the distance between them is always the same, and the board thereby reduced to a uniform thickness. *Ibid.*

26. The Hill machine did not reduce the board to a uniform thickness. Woodworth attained such a result by his improvement. Norcross accomplished the same purpose, but by a different arrangement than that invented by Woodworth. *Ibid.*

27. Norcross' machine is not an infringement of Woodworth's patent. *Ibid.*

28. The planing machines of Ashton & Winslow, and of Ashton & Beers, are essentially the same as Woodworth's —and the tonguing and grooving apparatus of those machines, and of the Snowden machine, are the same as those used by Woodworth. *Sloat* v. *Patton*, 24 Jour. Fr. Inst., 3d Ser., 26, 27.—KANE, J.; Pa., 1852.

29. The invention relied on in Woodworth's patent, is a new combination of three elements to produce the result of planing a plank against its motion through the machine; the claim of monopoly is the employment of rotary planes in combination with the face of a bench and pressure rollers, to prevent the board from being drawn up by the planes when cutting upward, or from the reduced or planed to the unplaned surface. *Brooks* v. *Fiske*, 15 How., 217.—CATRON, J.; Sup. Ct., 1853.

30. Norcross' planing machine, patented February 12th, 1840, for an improvement on the Hill machine, cannot be considered an infringement on Woodworth's machine, but is an independent invention. *Ibid.*, 222. MCLEAN, WAYNE, and NELSON, JJ., dissenting.

31. The machine patented July 16th, 1839, to James H. Hutchinson, is an infringement upon Woodworth's patent. *Livingston* v. *Woodworth*, 15 How., 555.—DANIEL, J.; Sup. Ct., 1853.

## PLOUGHS.

### DAVIS' PATENT.

*Issued October 1st*, 1825.

This patent was for certain "improvements in the construction of mould-boards of ploughs." The specification set forth, that instead of working the moulding part or face of the mould-board to straight lines, the improvement was to work it to circular or spheric lines, and that the circle or segment extending from the points of the share and inclining to the back part of the mould-board, should have *about* three times the radius of certain described smaller segments, and then proceeded: "This being thus worked off uniformly, forms a section of a loxodromic or spiral curve, and when applied to practice is found to fit or embrace every part of the furrow slice far more than any other shaped plough."

*Held*, that the patent must be construed, not as extending to every mould-board worked by circular or spheric lines, however those lines may cross each other, and whatever may be their relative proportions, and whose face forms a section of a loxodromic or spiral curve, but as applying only to mould-boards, conforming to the particular description contained in the specification, and of the precise and definite shape prescribed, and worked out by segments of circles of the exact form and proportions mentioned; and that in construing the specification, the word *about* must be disregarded, and the patent be restricted to the mould-board as described, independent of that word. *Davis* v. *Palmer*, 2 Brock., 305–308.—MARSHALL, Ch. J.; Va., 1827.

PROUTY & MEAR'S PATENT.

*Issued March 4th*, 1836.

1. The patent was for "a new and useful improvement in the construction of the plough," and the claim was for a combination of three things: 1st. The inclining the standard, and land-side, so as to form an acute angle with the plane of the share; 2d. The placing the beam on a line parallel to the land-side within the body of the plough, and its centre nearly in the perpendicular of the centre of resistance; and 3d. The forming the top of the standard for brace and draught.

*Held*, that the patent was for a combination, and a combination only. The use of one or more of the parts less than the whole, is no infringement. *Prouty* v. *Draper*, 1 Story, 571.—STORY, J.; Mass., 1841.

2. The extension of the standard, and the jogging it into the beam, are claimed as material parts of the plaintiff's improvement; in forming the top of the standard for brace and draught. *Prouty* v. *Ruggles*, 16 Pet., 340.—TANEY, Ch. J.; Sup. Ct., 1842.

PUDDLE BALLS, ROLLING.

BURDEN'S PATENT.

*Issued December 10th;* 1840.

1. The patent was for "a machine used in the manufacture of iron, commonly called a squeezer, and used for converting puddler's balls into blooms, in rolling mills, and rolled the balls between reciprocating plates or tables, or between a revolving cylinder and a stationary segmental trough, with stationary flanges."

*Held*, that the patent was for a new process, mode, or method, of converting puddler's balls into blooms, by continuous pressure and rotation between converging surfaces. *Burden* v. *Corning*, MS.—NELSON, J.; N. Y., 1850. [Contra, *post* 2.]

2. The letters patent are not for a new process, mode, or method of converting puddler's balls into blooms, but for the machine described by him. The patent does not secure the exclusive right to construct, use, and vend, any machine adapted to accomplish the objects of his invention, by the process, mode, or method described. *Corning* v. *Burden*, 15 How., 267, 270.—GRIER, J.; Sup. Ct., 1853.

RAILS FOR RAILROAD CARRIAGES.

STIMPSON'S PATENT.

*Issued August 23d*, 1831.

The patent was for "a new and useful improvement in the mode of forming and using cast or wrought iron plates or rails for railroad carriage wheels to run upon, more especially for those to be used on the streets of cities, on wharves and elsewhere," and the claim was for the employment of plates or rails having narrow grooves on each side of the track for the flanges of the car-wheels to run in, so as to be adapted to the various kinds of common carriages.

*Held*, the combination claimed by the patentee as his improvement, consists of the use of grooves on both sides of a railway track, in which grooves only the flanges of car-wheels are to run, and

which are to be too narrow to admit the wheels of carriages having the most slender rims or felloes; and the whole of this combination or mechanism, is to be depressed to a plane exactly corresponding with that of the street in which it may be introduced. *Stimpson* v. *Balt. & Sus. R. R. Co.*, 10 How., 344.—WAYNE, J.; Sup. Ct., 1850.

## ROCKING CHAIRS.

### BEAN'S PATENT.

*Issued March 30th*, 1840.

The patent was for "a new and useful improvement in the rocking chair," and the specification set forth that the principal features of the invention consisted in making the stool and seat of the chair in two parts, and causing the seat to rock on the top of the stool, thus doing away with long rockers, and rendering the back of the chair susceptible of being fixed in a reclining position at any desired angle; but it was shown that the same apparatus had been before applied, if not to chairs, at least in other machines, to purposes of a similar nature.

*Held*, that the invention, at most, was an old invention, apparatus or machinery applied to a new purpose, and that the patent was invalid. *Bean* v. *Smallwood*, 2 Story, 411.—STORY, J.; Mass., 1843.

## SADDLES.

### DIXON'S PATENT.

*Issued July 16th*, 1849.

The patent was for "an improvement in manufacturing men and women's saddles without saddletrees," but the patentee did not distinguish what was new from what was old and before in use, nor point out in what particulars his improvement consisted; *Held*, that the patent was therefore void. *Dixon* v. *Moyer*, 4 Wash., 69, 73.—WASHINGTON, J.; Pa., 1821.

## SAW-MILLS, CIRCULAR.

### NORCROSS' PATENT.

*Issued January 15th*, 1850.

The patent was for an "improvement in circular saw-mills." The invention was for suspending the saw, so it could have lateral vibration, which was accomplished by supporting the boxes in which the journals of the arbor run, upon standards, to which the boxes were jointed, and being themselves jointed to their foundation, so that the arbor was kept horizontal, while it was allowed sufficient lateral play, and when thrown out of line it would recover itself by the action of the driving belt, which was effected by passing the belt up over a driving pulley above, thus holding the frame up to the proper point, so that the saw was actually suspended by the belt, while it was kept steady and made to move properly by the frame below.

*Held* by the court, that the patent was not for the two improvements—1st, permitting the lateral motion of the saw mandril or arbor, by the device of the rocker boxes, and swing frame; and 2d, restoring the saw to line by the elasticity of the belt acting as a reacting agent—separately, but for the combination of the two, and that the use of a metallic spring instead of the swing

frame, to deflect the saw into line, was not an infringement. *Lee* v. *Blandy*, 2 Fisher, 93.—LEAVITT, J.; Ohio, 1860.

## SAW-MILLS, PORTABLE, CIRCULAR.

### PAGE'S PATENT.

*Issued July 16th*, 1841.
*Extended July 17th*, 1855.

1. The invention was for an "improvement in portable, circular saw-mills," combining free end play of the saw mandril with guide rollers at the periphery.

*Held*, that the patent was for the combination of end play of the saw shaft with guide rollers at the periphery, and covered the use of guide pins instead of rollers, if they were used for the same purpose. And that it did not evade the patent to employ a collar or shoulder on the shaft, if there was still sufficient free end play or lateral action of the saw arbor to accomplish the sawing successfully. *Page* v. *Georgia*, MS.—HALL, J.; N. Y., 1856.

2. The patent is for a manner of affixing and guiding a circular saw by allowing end play to its shaft, in combination with the means of guiding it by friction rollers near its periphery, so as to leave its centre entirely unchecked laterally; *Held*, that the improvement comprehended by the patent was the freedom of revolution of the saw, at its centre, entirely unchecked laterally, used in combination with the friction rollers, embracing the periphery of the saw. *Page* v. *Ferry*, 1 Fisher, 303.—WILKINS, J.; Mich., 1857.

3. Or, the patent of the plaintiff covers *merely a combination of the use of rollers*, or their *equivalents*, with a saw that has *no* cheek *to its lateral motion*, at the centre, but has free end play, so as not in *any* case to have an end bearing against a shoulder in its ordinary revolutions. *Ibid.*, 303.

4. The claim is for the precise organization described, the manner of affixing and guiding the circular saw by allowing end play to the shaft, in combination with the means of guiding it by friction rollers, embracing it near to its periphery, so as to leave its centre entirely unchecked laterally. *Phillips* v. *Page*, 24 How., 167.—NELSON, J.; Sup. Ct., 1860.

5. It having been shown that mills of like construction had been used for sawing shingles; *Held*, that the patent could not be sustained, because of its application to the sawing of ordinary logs in a saw-mill. *Ibid.*, 166, 167.

## SEWING MACHINES.

### HOWE'S PATENT.

*Issued September 10th*, 1846.
*Extended September 10th*, 1860.

1. The original patent embraced five claims. The first claim of this patent was for "the forming of the seam by carrying a thread through the cloth by means of a curved needle on the end of a vibrating arm, and the passing of a shuttle furnished with a bobbin, in the manner set forth, between the needle and its thread, under a combination and arrangement of parts substantially the same with that described."

*Held* by the court, that the real claim is for the means by which the result, the forming of a seam, is reached, namely, by carrying a thread through the cloth, by means of the needle at the end of

a vibrating arm, and then carrying the shuttle with its bobbin between the needle and its thread, under a combination and arrangement of parts substantially as described. *Howe* v. *Morton*, 13 Mo. Law Rep.—SPRAGUE, J.; Mass., 1860.

2. The claim may be considered as for the general combination and arrangement of the parts described in the specification, embracing the mechanism for forming the stitch; the mechanism consisting of two stationary holding surfaces, for holding the material to be sewed; and a mechanism for feeding the cloth—which consists of a piece of metal with points projecting, which take hold of the cloth and then by mechanism carries the cloth with it between the two stationary surfaces, and which surfaces aid in keeping the cloth in place while it is fed. *Ibid.*

3. These holding surfaces also aid in making the stitch, by successively resisting the thrust and retraction of the needle, and keeping the cloth in position, and exactly in the line where it should be, so that the stitch is sure to be made in the proper place. *Ibid.*

4. The eye-pointed needle was not Howe's invention, having been described before his invention. *Ibid.*

5. Fisher & Gibbon's machine, patented in England in December, 1844—the specification of which was enrolled in June, 1845—contained a mechanism by which one thread was carried by a needle through the material, and then another thread was carried by a shuttle between the needle and its thread; but as Howe's *invention* was as early as the middle of May, 1845, before the enrolling of their specification in June, 1845, their invention was not patented, within the meaning of §§ 7 and 15 of the act of 1836, until *after* Howe's invention, and Howe became entitled to a patent under § 9 of the act of 1839. *Ibid.*

### JOHNSON'S PATENT.

*Issued March 7th*, 1854.

The patent was for an "improvement in sewing machines," and the part of the patent under consideration was the third claim:—the feeding of the material to be sewed by means of a vibrating piercing instrument—either the needle itself, or some other instrument in the immediate vicinity thereof—substantially as described.

*Held* by the court, that the patent was not for a result, or for an abstract idea or principle, but was for a means or mechanism to accomplish a certain end. The use of the piercing instrument to feed the cloth, and its use substantially in the manner described—both go to constitute the invention of the patentee. The use of either of the two, and not the other, is no infringement. *Johnson* v. *Root*, 1 Fisher, 355, 356.—SPRAGUE, J.; Mass., 1858.

### SINGER'S PATENT.

*Issued August 12th*, 1851.
*Reissued October 3d*, 1854.

1. The first claim was for giving the shuttle an additional forward movement, after it had been stopped to close the loop, for the purpose of drawing the stitch tight, when such additional movement is given at and in combination with the feed motion in the reverse direction, and the final upward movement of the needle, so that the threads shall be drawn tight at the same time.

*Held*, that this claim was for the com-

bination of the mechanism described, by means of which three pulls are given simultaneously to tighten the stitch; and that the patent did not cover the result attained, but the particular combination of mechanism producing the result. *Singer* v. *Walmsley*, 1 Fisher, 579.—GILES, J.; Md., 1859.

2. The second claim of such patent is for the invention of a friction pad placed between the seam and the bobbin, to make a slight pressure on the thread to prevent the formation of a loop above the cloth, but not sufficient to prevent the needle drawing the thread through the cloth to make the loop below it. *Ibid.*, 579.

3. The third claim is for the combination of an adjustable arm carrying the bobbin or spool, with an eye or guide, attached to and moving with the needle carrier, and through which the thread passes, so that by changing the angle of such arm any desired length of thread can be given for the formation of the loop. *Ibid.*, 579.

4. The fourth claim is for the combination (for feeding the cloth) of the friction of the surface of the periphery of the feed wheel with the spring pressure plate or pad, which grips the thing to be sewed, against the feeding surface; the surface of the feed wheel having a fine thread or parallel groove cut therein, to enable it to perform its office in combination with the pressure plate, instead of being armed with pins. *Ibid.*, 579, 580.

5. The sewing machines of Ladd, Webster & Co., of Boston, are not an infringement on this patent. *Ibid.*, 586.

SINGER'S PATENT.

*Issued April 13th*, 1852.

This patent is for the invention of an improvement in the friction pad, whereby the thread is saved from the chafing it would otherwise be liable to, by substituting for it a cut-off friction pad, which alternately seizes and releases the thread at proper intervals, so as to cause the pad to press upon the thread when required, and then to be released, while the needle is passing through the cloth. *Singer* v. *Walmsley*, 1 Fisher, 580.—GILES, J.; Md., 1859.

SINGER'S PATENT.

*Issued May 30th*, 1854.

This patent is for the combination of the following mechanical devices: *First*, A spring arm guide, through which the thread passes from the tension to the needle. *Second*, The needle carrier, forcing up the spring arm guide to the limit fixed for it. *Third*, A fixed bridle, limiting the upward movement of the spring arm guide. And *Fourth*, A movable bridle to force down the guide to give the required amount of slack thread for the formation of the loop; the carrier forcing up the spring arm guide to the limit governed by the fixed bridle, and the movable bridle forcing it down again, to make the slack thread, these motions being independent of the thread or any contingency affecting it. *Singer* v. *Walmsley*, 1 Fisher, 580.—GILES, J.; Md., 1859.

SINGER'S PATENT.

*Issued November 4th*, 1856.

1. The second claim of this patent is for the combination of a horizontal table with the feed apparatus—the operative part of the feed wheel projecting through the table, and acting on the

under surface of the material to be sewed, while the table answers the purpose of stripping the material from the feed wheel and to cover and protect the mechanism which operates it. *Singer* v. *Walmsley*, 1 Fisher, 580, 581.—GILES, J.; Md., 1859.

2. The third claim is for imparting the feeding motion to the feed wheel, for spacing the stitches, by griping the periphery by a griping lever, in contradistinction to the action of a pawl on a ratchet, whereby the extent of the feeding motion may be adjusted and varied to any degree, instead of being restricted by the size of the ratchet teeth. *Ib.*, 581.

3. The fourth claim is for a combination of a feeder with a presser attached to a slide, which keeps the plane of its under surface always in the same relation to the plane of the table, thereby avoiding the inequality of pressure which takes place when the presser is on an arm working on a fulcrum or hinge joint. *Ibid.*, 581.

### A. B. WILSON'S PATENTS.

*Issued November 12th*, 1850.
*Reissued January 22d*, 1856, *and divided into two patents known as Reissues Nos.* 345, 346.
*No.* 345 *reissued December 9th*, 1856, *and known as Reissue No.* 414.

*Reissue No.* 346.

1. This patent embraces four claims. 1. For the method described of causing the cloth to progress regularly by the joint action of the surfaces between which it is clasped, and which act in conjunction in the manner and for the purposes mentioned, that is, in a regular intermittent progress of the cloth, by the means described, so that the cloth, while grasped by the surfaces, could be turned as it had before been turned when it had been advanced by the hand of the operator, and the purpose was to secure a regularity of stitch and also that the seams might be sewed of any considerable degree of curvature. 2. For the method of holding the cloth at rest by the needle, as described, in combination with the method described of causing it to progress regularly. 3. So arranging the feeding surfaces that they, or one of them, should also perform the office of stripping the cloth from the needle as it rises. And 4. For mounting or attaching one of the feeding surfaces, so that it could be removed or drawn away from the other at pleasure, to effect the objects set forth. The second claim was admitted to be valid, but the others were disputed. *Potter* v. *Holland*, 4 Blatchf., 241.—INGERSOLL, J.; Ct., 1858.

2. *Held*, that the devices or means specified in the first claim were sufficient to cause the cloth to progress regularly, merely by the joint instrumentality of the two feeding surfaces, between which it is clasped, and without the aid of the needle or any other instrumentality, and that the patent was not invalid, because a useful result was not produced by the means specified. *Potter* v. *Holland*, *Ibid.*, 246, 247.

3. The third claim was for giving one of the feeding surfaces the additional function of a stripper; *Held*, as to this, that the mode of arranging the feeding surfaces, as pointed out, so that they, or one of them, in addition to the office which they performed as acting as a feeder, should also perform the office of a stripper, was new, and was not known before such invention, and therefore the grant of right in that patent for such arrangement was valid. *Ibid.*, 248.

4. But such grant will not prevent any one from using any stripper which was known and in use prior to the invention of Wilson. *Ibid.*, 248.

5. The fourth claim was claimed to be invalid for the reason that it required no invention; *Held*, that the device mentioned in the fourth claim was new, as well as useful, and had a sufficient amount of invention to authorize a patent. *Ibid.*, 249.

6. The leading original idea of Wilson is the substitution of the two surfaces between which the cloth is clasped or held, for the baster-plate of previous machines, and so arranging these two surfaces that one of them, by an automatic intermittent motion of one or both, would advance the cloth to the needle, and at the same time admit of its being turned by the hand, so as to sew curved seams. *Potter* v. *Wilson*, 2 Fisher, 111.—NELSON, J.; N. Y., 1860.

7. This conception is capable of being embodied in a working machine in various modes and forms; but so long as the inventor'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 is an infringer. *Ibid.*, 111, 112.

8. All the several claims rest upon and grow out of the main improvement in the feeding apparatus, and this device being novel, these dependent combinations and devices may well be maintained. *Ibid.*, 111.

*Reissue No.* 414.

1. What is patented by the patent No. 414 is a sewing machine, having in combination the three elements of a table or platform to support the material to be sewed; a sewing mechanism proper; and a mechanical automatic feed. The only element claimed as new is the mechanical feed automatic, by which the cloth is made to progress regularly to be sewed, and to which the cloth is not attached. *Potter* v. *Holland*, 4 Blatchf., 243.—INGERSOLL, J.; Ct., 1858.

2. There had before been known and in use a sewing machine having in combination the three elements of a table or platform, a sewing apparatus, and a feed motion. It was claimed that although the patentee had invented a *new* feed motion, that he could not patent the combination in a single machine, of the elements of the table and sewing mechanism, which constituted two of the elements of the old combination, and his new mechanical feed, but that he could only patent his improvement on the feed motion;

*Held*, that as the mechanical automatic feed of Wilson was a new invention, never having before been known, was a new mechanical automatic feed, and was an improvement on the old feed only in the sense that any new and useful mechanical device to accomplish a given purpose is an improvement on other known mechanical devices to accomplish the same object. *Ibid.*, 244.

3. And that as such new mechanical automatic feed of the patentee was not to be used in conjunction with, or in aid of, or in addition to the old feed, but was independent of it, and dispensed with it, and discarded it, that it was an entire new device, and was a new and independent element in the combination patented to him, and that therefore it must be held that the machine containing the combination of elements patented to him was a new and different machine from the machine containing

the combination of old elements known before his invention. *Ibid.*, 245.

### A. B. Wilson's Patent.

(Fitzgerald Patent.)
*Issued December 19th*, 1854.

This patent is an improvement on the feed motion embraced in reissues Nos. 346, 414. The surface, moving the cloth to the needle, is caused to drop from the cloth, on its return to again seize it, and advance it for another stitch. The effect is, to free the cloth from the surface in its return, with a view again to advance it. The novelty of the invention was disputed. *Held*, from the evidence, that Wilson was the first inventor of the improvement described. *Grover & Baker Sew. Mach. Co.* v. *Sloat*, 2 Fisher, 114.—Nelson, J.; N. Y., 1860.

### Sowing Seed.

#### Cahoon's Patent.

*Issued September 1st*, 1857.
*Reissued May 17th*, 1858.

1. The patent was for an "improvement in seeding machines," and the object of the invention was to sow seed broadcast as the machine was drawn along. The reissued patent had four claims.

*Held*, that the improvements covered by the first claim of the patent are, 1st. A tubular chamber or discharger rotating rapidly on a horizontal axis, having its edge in a plane, vertical, or nearly so, to the horizon, and operating by centrifugal force generated by the revolution of the chamber, to throw out the seed in a plane of discharge, vertical or nearly so to the horizon, and perpendicular to the line of travel of the machine. *Cahoon* v. *Ring*, 1 Fisher, 403.—Clifford, J.; Me., 1859.

2. The improvement described in the second claim consists of a funnel or conical-shaped discharging chamber, having flanches to arrest the seed and prevent its dropping upon the ground, and assist to carry it round the axis of revolution and accelerate its centrifugal force. *Ibid.*, 404.

3. The third improvement consists of a disk or plate of metal, or its equivalent, placed in front of and combined with the centrifugal discharger, to prevent the entrance of currents of air into the discharger, which might interfere with the proper distribution of the seed, by blowing it out of its proper position while it is still in the chamber. *Ib.*, 405.

4. The improvement covered by the fourth claim consists of a hopper to hold a supply of seed, and deliver it to the discharger, such hopper being combined with the discharger, and having a stirrer to stir the grain, and a gate at its mouth to regulate the quantity of grain that will pass out and be sown. *Ibid.*, 406.

5. *Held*, also, that the seeding machine patented to Aaron Ring, March 2d, 1857, was an infringement on the patent of Cahoon. *Ibid.*, 423.

### Steam-Engines.

#### Sickles' Patent.

*Issued September 19th*, 1846.

1. The patent was for an "improvement in steam-engines, in connecting the cylinder and steam-chest." The claim was not simply for casting the steam-chest with the cylinder, or with the cylinder bottom and condenser, but for the

method of casting them together as described.

*Held*, that what was secured to the patentee by this patent was, *first*, the casting the steam-chest with the cylinder, by making the sides of the steam-chests the sides of the cylinder, in combination with the manner of fitting the cylinder head and the lower end of the cylinder to the chests as described, and the mode of making the attachments without the continuation of the flanches, when the condenser is not on a line of the cylinder and distinct therefrom. *Sickles* v. *The Pacific Mail Steamship Company*, MS.—INGERSOLL, J.; N. Y., 1857.

2. And *second*, when the condenser is on a line with the cylinder, and near to it, the casting one steam-chest with the cylinder, and the other with the cylinder bottom and condenser, by making the side of one steam-chest the side of the cylinder, and the side of the other steam-chest the side of the condenser, in combination with the manner of fitting the cylinder head and the lower end of the cylinder to the chests as described, and the mode of making the attachments as described, when one steam-chest is so cast on the cylinder and the other on the condenser. *Ibid.*

## STEAM GENERATORS.

### LATTA'S PATENT.

*Issued April 10th*, 1855.

1. The patent was for an "improvement in steam generators," and the invention claimed was for a mode of feeding a coiled tubular boiler, by means of a hand pump, so as to throw water upon pipes already heated, and thus generate steam suddenly. In connection with the hand pump was described a "water box," or open water vessel, so as to enable the engineer to see the water going in, though its place could be supplied by any thing that will give motion to some mechanical contrivance. This water box the defendant did not use, and claimed that the plaintiff's patent was for a combination, which was not infringed by a use of less than all its parts.

*Held*, by the court, that the patent was for a combination, but that it was a question for the jury whether the water box was an essential element of the combination, and that the defendant could not evade the patent by not using a part not material. *Latta* v. *Shawk*, 1 Fisher, 471.—LEAVITT, J.; Ohio, 1859.

2. The jury found it was not a material part of the combination, and judgment was for the plaintiff. *Ibid.*, 472.

## STOVES, COOKING.

### BUCK'S PATENT.

*Issued May 20th*, 1839.

1. This patent was for "improvements in the construction of stoves, for cooking," and the claim was "the extending of the oven under the apron or open hearth of the stove, and in the combination thereof with the flues constructed as specified," that is, reverberating flues, so called, and a front flue, between the front plate of the stove and the front plate of the oven.

*Held*, that the invention was the *combination* of the extension of the oven under the hearth of the stove, and the reverberating flues, *with* the flue in front, formed by the front plates. *Buck* v. *Hermance*, 1 Blatchf., 400, 402.—NELSON, J.; N. Y., 1849.

*Held*, also, that though the combination of the extended oven and the reverberating flues, that is, the side and centre flues, was old, the bringing into connection with such old combination the flue in front, made a new and a patentable combination. *Ibid.*, 403.

2. The claim of Buck is for the flues described—reverberating flues—in combination with the extended oven. *Buck* v. *Gill*, 4 McLean, 176.—McLean, J.; Ohio, 1846.

### Foote's Patent.

*Issued May 26th*, 1842.

1. The patent was for "a new and useful mode of regulating the heat of stoves and other structures for fires," and the claim was for the application of the expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove or other structure, by which a more perfect control over the heat is obtained than can be by a damper in a flue; and also the mode described of setting the heat of a stove at any requisite degree, by which different degrees of expansion are requisite to open or close the damper.

*Held*, that the substance of the discovery as claimed by the patentee and secured to him by his patent, is the application of the principle of the contraction and expansion of a metallic rod, by the use of certain mechanical contrivances described and set forth, to the cast or sheet-iron stove in common use, by which means he produces a self-regulating power over the heat of the same, at any given degree of heat that may be desired within the capacity of the stove. *Foote* v. *Silsby*, 1 Blatchf., 463.—Nelson, J.; N. Y., 1849.

2. The first claim, "the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove," is not for a discovery of a natural property of the metallic rod, which of itself, is not a patentable subject, but for a new application of it by means of mechanical contrivances, which is one of the commonest subjects of a patent. *Ibid.*, 464.

3. The claim in this patent in reference to regulating the heat of a stove by the expansive and contracting power of a metallic rod, is one independent of any particular arrangement or combination of machinery; and the inventor has a right to use any means, old or new, in the application of the new property to produce the new and useful result. *Foote* v. *Silsby*, 2 Blatchf., 263, 264.—Nelson, J.; N. Y., 1851.

4. This patent, on appeal to the Supreme Court held to be valid. *Silsby* v. *Foote*, 20 How., 385.—Nelson, J.; Sup. Ct., 1857.

## Straw-Cutter.

### Hovey's Patent.

*Issued February 12th*, 1844.

This patent was for an "improvement in straw-cutters," and the claim was for a cylinder "having any number of arms around it, to which adjustable knives are affixed, constructed as described, in combination with the roller against which they cut, in the manner and for the purpose set forth."

*Held*, that the patent was for a new

combination, which was good, unless all the parts had been known in such combination. *Hovey* v. *Henry*, 3 West. Law Jour., 154.—WOODBURY, J.; Mass., 1845.

### TAILORS' SHEARS.

HEINRICH'S PATENT.

*Issued February 27th*, 1839.

The patent was for "an improvement in tailor's shears," and the invention claimed consisted of three things. 1st, the projection at the point of the beak, on the upper bow. 2d, the addition of a convex protuberance or swelling on the right side of the upper and lower bows to fill the palm of the hands; and 3d, a concave lip on the left side of the upper bow, for the thumb to rest upon. The improvement enabled a person to hold the shears with a firmer grasp.

*Held*, that the invention did not consist in a resting point for the handles so as to avoid a strain upon the joint of the shears, as that had been done in many ways. But the invention consists in the beak, by which such old result is produced by new means. *Heinrich* v. *Luther*, 6 McLean, 346, 348.—MCLEAN, J.; Ohio, 1855.

### THREAD, PACKING, &c.

LANGDON'S PATENT.

*Issued June 20th*, 1821.

The patent was "for an improvement in preparing and packing cotton and other threads, and floss cotton for retailing," and the specification set forth the improvement as consisting "in folding the thread and floss cotton into skeins or hanks of a convenient quantity for retailing, with a sealed wrapper round the same, and a label containing the number and description of the article."

*Held*, that the patent was void because the invention was not a useful one within the meaning of the patent law. *Langdon* v. *De Groot*, 1 Paine, 204, 206.—LIVINGSTON, J.; N. Y., 1822.

### VALVES FOR GOVERNORS.

JUDSON'S PATENT.

*Issued November 5th*, 1850.
*Reissued January 10th*, 1854.

1. This patent was for an "improved valve for governors," and the object of the invention was an improvement in the valve, by which an increase or decrease in the motion of an engine is effected, without any disturbance, or as little as practicable.

*Held*, that the invention was for an improvement and was not for a combination, and that the right secured by the patent was for the making an opening or openings controlled by the governor valves of steam-engines of gradually increasing capacities from the closed to the open position: but such openings, while gradual or regular, are not necessarily in geometrical or arithmetical progression. *Judson* v. *Moore*, 1 Fisher, 540, 550.—LEAVITT, J.; Ohio, 1860.

2. The principle of a gradual opening, through all the range of motion, is the distinct characteristic of Judson's invention. *Ibid.*, 556.

3. The patent is for a distinct and independent improvement, and not for a combination. The claim is for an improved valve, and that valve to operate

in connection with a governor; and there is no claim of an invention disconnected from the governor. The distinguishing characteristic of the valve is, that the openings should be produced upon the principle of graduation, controlled by the governor, so that the engine shall be governed with uniformity in any state of steam in the boiler, and accommodate itself to any degree of pressure or labor that can be thrown upon it. *Judson* v. *Cope*, 1 Fisher, 622.—LEAVITT, J.; Ohio, 1860.

## VALVES, LIFTING, AND TRIPPING.

### SICKLES' PATENT.

*Issued May 20th*, 1842.

1. This patent was for "apparatus for lifting and regulating the closing of the valves of steam-engines," and the subject matter of his improvement was the puppet valve acted on in the usual way, connected with a valve stem, and raised by a lifter.

*Held*, that the patentee was the first inventor of the improved machinery described in his patent, for effecting a cut-off in steam-engines. *Sickles* v. *Glou. Manuf. Co.*, 1 Fisher, 225.—GRIER, J.; N. J., 1856.

2. The specification sets forth two separate improvements, not claimed jointly as one *machine*, but as distinct improvements of two several parts of a known machine. *Ibid.*, 229.

3. The first claim is not for the scheme of tripping valves, but for a combination of certain devices as an improvement, in the manner of tripping valves, and the combination and arrangement of parts have all reference to a peculiar sort of valve—the puppet valve. *Ibid.*, 231.

4. The second claim is for the regulating the closing of the valves and preventing them from slamming, by means of a *water reservoir*, or a reservoir of *water*, *oil*, or other *fluid*. The word *fluid* is used in its popular sense as a synonym for *liquid*. There is no intimation that an elastic fluid, as air, could be used for the same purpose. *Ibid.*, 236.

5. But the apparatus described in the first and second claims must be combined to effect the purpose intended. The two things constitute one whole invention. *Ibid.*, 236.

6. The invention of Corlies for tripping *sliding* valves, and breaking the shock of the weight used to close such valve by cushioning it on an *air cushion*, is no infringement of Sickles' patent. *Ibid.*, 236–8.

7. The claims of the patent of Sickles of May 20th, 1842, for regulating the closing of the valves of steam-engines, and preventing their slamming, "by means of a water reservoir," are not infringed by the patent of Corlies of July 29th, 1851, in which the weights which close the valves are prevented from slamming by being cushioned on air. *Sickles* v. *Youngs*, 3 Blatchf., 301.—NELSON, J.; N. Y., 1855.

8. The term *fluid* in Sickles' patent means a fluid that is tangible, that can be seen or handled like water or oil, and with which a vessel can be filled in part or in whole at the option of the patentee. It does not embrace *air*, though the term *fluid* in its generic and technical scientific sense includes air and the gases. *Ibid.*, 302.

## VALVES, LIFTING.

### SICKLES' PATENT.

*Issued September 19th*, 1845.
*Extended September 19th*, 1859.
*Reissued February 21st*, 1860.

This patent was for an "improvement in cut-off valves of steam-engines;" *Held*, the novelty of the invention consisted in the new set of ideas by which the patentee saw the possibility of dispensing with the lifting motion as a means of detaching the valve and allowing it to drop, and in deriving power from some other part of the engine *Sickles* v. *Borden*, 3 Blatchf., 538.—NELSON, J.; N. Y., 1856.

2. The improvement, however, does not limit the patentee to the motion or power derived from the eccentric strap, but it may be taken from any other moving part of the engine, always excluding, however, the motion from the lifting rod. *Ibid.*, 538.

3. Such independent motion may be used to trip the valve at *any* desirable point, at the discretion of the engineer, or constructor. *Ibid.*, 539.

4. The claim in the reissued patent for "imparting a coexisting movement to two reciprocating catch pieces, in the operation of the trip cut-off valves," is for an effect or function, and is not patentable. *Sickles* v. *The Falls Co.*, 4 Blatchf., 509.—NELSON, J.; Ct., 1861.

## WATER-CLOSET VALVES, GOVERNORS FOR.

### BARTHOLOMEW'S PATENT.

*Issued June 20th*, 1854.

1. This patent was for "a method of governing the action of valve cocks," adapted to the purposes of water-closets, and the nature of the invention consisted in providing and applying a governor to the valve or valves of a cock, adapted to the purposes of a water-closet, &c., by which the valve could be made to open or close gradually, and while opening or closing to admit a limited supply of water to pass through, and thus avoid the necessity of employing any cistern or reservoir of water between the main supply and basin. The variable chamber could be filled with air or water.

*Held*, that the patent covered the combining such variable chamber and valves by the means specified, so that the variable chamber, by the discharge of the air or water, or the drawing in of air or water should control the closing of the valve, the valve being self-closed by a spring or its equivalent. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

2. The object of the variable chamber is to resist the action of the spring or weight that closes the valve, so that the closing, instead of being sudden, shall be gradual, to allow the required flow of water. *Ibid.*

## WATER-WHEELS.

### PARKER'S PATENT.

*Issued October 19th*, 1829.
*Extended October 19th*, 1843.

1. This patent was for an "improvement in percussion and reaction water-wheels." 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 therefore an infringement. *Parker* v. *Haworth*, 4 McLean, 474.—McLean, J.; Ill., 1848.

2. The claim intended to be made in this patent, is that of the wheel called the compound vertical, percussion, and reaction wheel; the concentric cylinders enclosing the shaft, and the manner of supporting them; and the spouts which conduct the water to the wheel. *Parker* v. *Stiles*, 5 McLean, 58.—Leavitt, J.; Ohio, 1849.

3. But it does not embrace the arrangement or duplication of wheels, on a horizontal shaft, as a part of the invention of the patentee. *Ibid.*, 58, 59.

4. The concentric cylinders enclosing the shaft, and the spiral conductors for leading the water to the wheels, are also within the claims of the patent. *Ibid.*, 60.

5. The patentee claims to have been the first to discover, devise, and apply to use, 1. The propulsive effect of vortical motion of water in a reaction wheel, operating by its centrifugal force, and so directed by mechanism as to operate in the appropriate direction. *Parker* v. *Hulme*, 7 West. Law Jour., 421.—Kane, J.; Pa., 1849.

6. And 2. The mechanical arrangements for making, guiding, and controlling the vortical motion, as set forth in their specification, both as new mechanical devices, considered separately in their application to these objects, and as new in their combination to produce and effectuate, or perfect the same objects. *Ibid.*, 421.

7. *Held*, that the mechanical arrangemcnts and devices, separately or in combination, are patentable. In regard to the arrangement of vertical wheels in pairs on a horizontal shaft, the mere fact that this was a duplication of the single wheel did not, of itself, invalidate the patent. 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. *Ibid.*, 421.

8. *Held*, also, that the more general subject of the claim—the propulsive effect of vortical motion of water in a reaction wheel operating by its centrifugal force, and so directed by mechanism as to operate in a given direction—was also a valid subject of claim, and properly to be secured by letters patent. *Ibid.*, 422.

9. *Held* as matters of law—1. That the letters patent vested in the patentees an exclusive right to construct and use mechanical devices, whether such as are described in their specification, or equivalent therefor, for producing, directing, and applying, as a motive power, in reaction wheels, the centrifugal force of water revolving vortically round the shaft, and passing into and acting upon the wheels in the direction of their revolution. *Ibid.*, 422.

10. And 2. A similar exclusive right to employ vortical reaction wheels, having two or more wheels arranged in pairs on the same horizontal shaft. *Ibid.*, 423.

11. In *Parker* v. *Hulme*, Pa., the jury found specially that the patentees "were the first to invent and apply to use two or more reaction wheels arranged in pairs on an horizontal shaft." *Parker* v. *Sears*, 1 Fisher, 98.—Grier, J.; Pa., 1850.

12. In *Parker* v. *Stiles*, Ohio, it was so fully proven that the patentees were not the first inventors of such arrangement that the plaintiffs admitted the

fact and denied that the patent claimed such a machine, and the court held "that the plaintiff's patent did not claim the duplication of wheels on a horizontal shaft." *Ibid.*, 98.

13. In *Parker* v. *Ferguson*, N. Y., the court instructed the jury the wheel claimed was "one constructed by placing two or more of the wheels on a horizontal shaft, with the inner and outer cylinders supplied with water by a spiral spout." *Ibid.*, 101.

14. This patent is not for the vertical or horizontal arrangement of the wheels upon the shaft, or the putting them in pairs; neither does it embrace as a distinct discovery, the concentric cylinder enclosing the shaft, nor the spout, the gate, the outer cylinder, or the buckets on the wheel. *Wintermute* v. *Redington*, 1 Fisher, 248.—WILSON, J.; Ohio, 1856.

15. The purpose or aim is to obtain an increase of power with a given quantity of water; and the secret of the invention of the wheel is the vortical motion of the water on the wheel, which operates as a coefficient to the reactive power of the water in the buckets. *Ibid.*, 248, 249.

16. The essence of the invention is, the producing a vortical motion on a *reaction* wheel, in the line of its motion, and the invention of producing a vortical motion upon a percussion or impact water-wheel, is not within the claim. *Ibid.*, 250.

## WHEELS, HORIZONTAL, FOR BOATS.

### ISAACS' PATENT.

*Issued November 17th*, 1819.

The patent was for "an improvement on the horizontal circular plane or wheel," invented by the patentee for the purpose of gaining power by applying animal weight to the propelling of boats on water, or to machinery on land; but it was not stated what was the nature of the invention upon which it was alleged to be an improvement, nor whether patented or not.

*Held*, that the nature of the improvement was altogether unintelligible, and the patent void. *Isaacs* v. *Cooper*, 4 Wash., 259, 261.—WASHINGTON, J.; 1821.

## WOOD-BENDING MACHINE.

### MORRIS' PATENT.

*Issued March 11th*, 1856.

1. This patent was for an "improved method of bending wood," and the improvement was for working the levers that bent the wood, on "fixed fulcrums," to prevent the wood twisting while being bent, and also in attaching clamps to the levers, which should abut against the end of the wood, thus upsetting the fibre and preventing breakage on the outside of the curve, and the claim was, 1st, for the clamps, to prevent end expansion; and 2d, the levers working on fixed fulcrums, for the purposes set forth.

*Held*, that the claim was not for a combination, but for two distinct improvements in the art of bending wood, and that the use of both or either was an infringement. *Morris* v. *Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1853.

2. *Held* also, that the use of radiating arms with rollers for the plaintiff's fulcrums, and clamps permitting a partial relaxation, was an infringement on the patent. *Ibid.*, 462–465.

# PATENTED ARTICLES OR MACHINES.

**A.** RIGHT OF PURCHASERS TO USE, REPAIR, &c..... 576
**B.** PRODUCTS OF, RIGHT TO SELL AND USE 580

## A. RIGHT OF PURCHASERS TO USE, REPAIR, &c.

1. If one has a right to a machine, and to the use of it, he has a right to work it himself, or by his servants, or to lease it out to any other person. *Rutgen* v. *Kanowrs*, 1 Wash., 168.—WASHINGTON, J.; Pa., 1804.

2. The power of Congress is only to ascertain and define the rights of property in the invention or work; it does not extend to regulating the use of it. This is exclusively of local cognizance. Such property, like every other species of property, must be used and enjoyed within each state according to the laws of such state. *Livingston* v. *Van Ingen*, 9 John, 581.—KENT, Ch. J.; N. Y., 1812.

3. The sale of a patented machine by a sheriff, under an execution, does not in and of itself convey to the purchaser any right to use the machine in the manner pointed out in the patent-right. The purchaser acts at his own peril. *Sawin* v. *Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

4. To entitle a purchaser of a machine to the benefits of § 7 of the act of 1839, he must be one who has used the invention before the application for a patent by license from the inventor himself, and not a fraudulent purchaser, or a purchaser from a wrongdoer, without the knowledge or against the will of the inventor. *Pierson* v. *Eagle Screw Co.*, 3 Story, 406, 407.—STORY, J.; R. I., 1844.

5. Under § 18 of the act of 1836, those who are in the use of the patented article at the time of the renewal, are entitled to the benefit of a renewal, of a patent, and such persons have the right to continue to use, during such extension, the machines held by them at the time of such renewal "to the extent of their interests," be that interest in one or more machines. *Wilson* v. *Rosseau*, 4 How., 682, 683.—NELSON, J.; Sup. Ct., 1845.

6. The right to *use* a machine to be constructed according to a certain specification, involves the right *to make*, or cause to be made, the machine thus permitted to be used. *Woodworth* v. *Curtis*, 2 Wood. & Min., 526.—WOODBURY, J.; Mass., 1847.

7. In respect to some patents, the right to make, vend, or use, may be separated. The circumstances, nature, and words of each grant must decide the construction which is just and legal *Ibid.*, 526.

8. Where A owned the right to an invention—Woodworth's planing machine—for a certain district, and conveyed to B the authority to use one machine in that district, *Held*, that B could build as well as use such machine, and that he might build and use another instead of it, but not both at one time. *Ibid.*, 526, 527.

9. The right or license to use *one* machine during the term of the patent, does not mean any particular machine then sold, but has reference to what must be considered one machine in number at one time. A second machine may therefore be run if the first one wears out, or is destroyed by fire, or is constructed erroneously, or is dis-

used entirely for want of repair. *Ibid.*, 527.

10. The right to use such a machine may be assigned to a third person. A machine and a right to use it is personal property rather than a mere patent-right, and has all the incidents of personal property, making it subject to pass by sale. *Ibid.*, 527.

11. Under § 18 of the act of 1836, the use of such a machine may be continued, notwithstanding the extension of the patent, until it is worn out, or destroyed. *Ibid.*, 528.

12. The assignees and grantees having such right to use, are those holding that right at the time of the renewal of the patent. *Ibid.*, 530.

13. Their right is not, however, a mere personal privilege, but a right of property in and attached to the machine used, when it is the last one used at the time the term expires. *Ibid.*, 530.

14. The machine and the right attached to it may pass by sale, devise, or levy of execution, or assignment of an insolvent's effects. *Ibid.*, 530.

15. The right to use a machine cannot be made to depend upon or be affected by the fact of the sale of one machine or the purchase of another. Where, therefore, a party had the right to use one machine, his right was not affected by selling that particular machine and purchasing another. *Wilson* v. *Stolley*, 4 McLean, 277.—McLean, J.; Ohio, 1847.

16. A license to use one machine will always be construed to run a machine, whether the particular one existing at the time of the license or not, unless the license in express terms is limited to one identical machine. *Ibid.*, 278.

17. The sale of a patented machine does not necessarily carry the right to use it. A sale by the patentee gives an implied right of use; but such an inference does not necessarily follow where the sale of the machine is made by one who has no exclusive right, but only a license to use. *Ibid.*, 278.

18. Under the rule laid down in *Wilson* v. *Rosseau*, 4 How., 646, 1845, where the material of a combination ceases to exist, in whatever way that may occur, the right to renew depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild. *Wilson* v. *Simpson*, 9 How., 123.—Wayne, J. Sup. Ct., 1849.

19. But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists for restoration to its original use, by the owner who has bought its use. When the wearing or injury is partial, then repair is restoration and not reconstruction. *Ibid.*, 123.

20. Repairing partial injuries, whether they occur from accident or wear, is only refitting a machine for use. And it is no more than that, though it shall be a replacement of an essential part of a combination. *Ibid.*, 123.

21. But if a patented machine as a whole should happen to be broken, so that its parts could not be readjusted, or be so much worn as to be useless, a purchaser cannot make or replace it by another, but must buy a new one. The doing of either would be a reconstruction. *Ibid.*, 124.

22. If, however, it is a part of an original combination, essential to its use, then the right to repair and replace occurs. *Ibid.*, 124.

23. The right to replace the cutters in Woodworth's planing machine is a

part of the invention transferred to an assignee, as the use of the machine depends upon the replacement of such cutters; as a machine will last several years, whereas the cutters must be replaced every sixty or ninety days. *Ibid.*, 125.

24. And an assignee of a right to use such a planing machine, who has, under the decision in *Wilson* v. *Rosseau*, 4 How., 646, the right to continue the use of a particular machine after the extension of the patent, may replace the knives or cutters when worn out, without destroying the identity of the machine; the right to replace is a part of the invention transferred. *Ibid.*, 125, 126.

25. A replacement of temporary parts does not alter the identity of a machine, but preserves it, though there may not be in it every part of its original material. *Ibid.*, 126.

26. Under § 18 of the act of 1836, as construed by the Supreme Court in *Wilson* v. *Rosseau*, 4 How., 682, a licensee may continue to use an invention actually in use by him at the time of an extension, during the term of such extension; but no such right exists under an extension by act of Congress, unless specially provided for. *Bloomer* v. *Stolley*, 5 McLean, 163.—McLean, J.; Ohio, 1850.

27. Contracts in relation to a patented machine or implement are regulated by the laws of the several states, and are subject to state jurisdiction. *Wilson* v. *Sandford*, 10 How., 99.—Taney, Ch. J.; Sup. Ct., 1850.

28. The right to make a machine is distinct from that of using it.—*Bicknell* v. *Todd*, 5 McLean, 238.—McLean, J.; Ohio, 1851.

29. The right to use implies a right to repair, but not to construct. It also implies a right to purchase when the one in use is worn out or destroyed. *Ibid.*, 239.

30. The purchase of an implement or machine for the purpose of use in the ordinary pursuits of life, does not become possessed of a portion of the franchise or monopoly conferred by the patent, derived from and under the United States, and which is the right to exclude every one from making, using, or vending the thing patented. *Bloomer* v. *McQuewan*, 14 How., 549.—Taney, Ch. J.; Sup. Ct., 1852.

31. Such a purchaser, in using the thing purchased, exercises no right conferred by the acts of Congress, nor does he derive title to it by virtue of the franchise granted to the patentee; when the machine passes into his hands, it is no longer within the limits of the monopoly, or under the protection of the act of Congress. *Ibid.*, 549.

32. If his right to it is infringed, he must seek redress in the courts of the state, and according to its laws, and not in the courts of the United States, or under the acts of Congress. The implement becomes his private property, not protected by the laws of the United States, but by those of the state in which it is situated. *Ibid.*, 549, 550.

33. Like other individual property, it is then subject to state taxation. *Ibid.*, 550.

34. The value of the implement or machine in the hands of a purchaser for use does not depend on the time for which the exclusive possession is granted to the patentee, nor upon the exclusion of others from its use. He does not look to the duration of the exclusive privilege, but to the usefulness of the thing he buys, and the advantages

he will derive from its use. *Ibid.*, 550.

35. Under the decision of *Wilson* v. *Rosseau*, 4 How., 688, one in the lawful use and ownership of a patented machine, under a purchase made during the original term of the patent, may continue to use such a machine during an extension of the patent, under the provisions of § 18 of the act of 1836, and is also entitled, within the spirit and intention of the patent laws, to continue to use such machine during an after extension made by special act of Congress, unless there is something in the language of the act requiring a different construction. *Ibid.*

36. Where a patentee under his original patent, prior to the commencement of an extended term, had sold a machine made by himself under his patent, *Held*, that the vendee had a right to continue to use such machine during the extended term: and that this right existed, though such extension was by special act of Congress, without any saving clause in favor of assignees, or of persons who had acquired rights under the previous term of the patent. *Blanchard* v. *Whitney*, 3 Blatchf., 309.—NELSON, J.; Ct., 1855.

37. There is a manifest distinction between a case where the title to a machine is derived from a person who has purchased simply a right or license to manufacture it under the patent, and a case where the purchase of the article is made directly from the patentee. In one case the patentee has parted only with his interest in the term of the patent, which is limited: in the other, he has sold the machine itself, with all the rights appertaining to his title as vendor; and of course without any limitation of its use or enjoyment. *Ibid.*, 309.

38. Under the provisions of § 18 of the act of 1836, an assignee or person in use of the invention at the time of the expiration of the original patent, has a right to continue, under an extension of such patent, the use of "the thing patented," whether the patent be for a process, and a machine to be used in such process—or for a process alone—or for a machine alone, and whether the identical machinery in use by such person under the extended patent was or was not in existence prior to the renewal of the patent. *Day* v. *Union Rub. Co.*, 3 Blatch., 49, 504.—HALL, J.; N. Y., 1856.

39. Where at the expiration of the original term of the patent, A had a right to use the patented invention for the manufacture of certain articles, and continued, during an extension of the patent granted under § 18 of the act of 1836, the use of the invention to the extent he was entitled at the time the original expired, *Held*, that A had the right to continue such use during the extended patent as against B, an assignee of the original patentee. *Ibid.*, 497.

40. The language of § 18 of the act of 1836, as to the rights of assignees and grantees of an original patent, under an extended term thereof, is broad enough to cover and protect, and was intended to cover and protect, the right to use the patented invention during the extension, whether such right arose from a direct assignment or grant (from the patentee) of a limited or unlimited right to use, or from the purchase of the machine. *Ibid.*, 497.

41. The sale of a machine, and the right to use a patented article with it, imports a license to use the article patented: and such license is not within the provisions of § 11 of the act of 1836,

which require an assignment or grant to be in writing. *Buss* v. *Putney*, 11 Mo. Law Rep., 687.— J.; N. H., 1858.

42. When a patented machine rightfully passes to the hands of a purchaser from the patentee, or any person authorized to convey it, such machine is no longer within the monopoly, or under the peculiar protection granted to patented rights: it is no longer protected by the laws of the United States, but by the laws of the state in which it is situated. *Chaffee* v. *Boston Belt. Co.*, 22 How., 223.—CLIFFORD, J.; Sup. Ct., 1859.

43. By a valid sale and purchase, the patented machine becomes the private individual property of the purchaser, and it is no longer protected by the laws of the United States, but by the laws of the state in which it is situated. *Ibid.*, 223.

44. The person acquiring title may continue to use the machine until worn out, or may repair it, or improve it, in the same manner as if dealing with property of any other kind. *Ibid.*, 223.

45. The fact that certain machines were a patented article cannot affect a contract of insurance against loss by fire, to measure the damages by its value when the loss occurred. What they were worth, patented or unpatented, is the measure of their value. *Com. Ins. Co.* v. *Sennett*, 37 Penn., 209.—THOMPSON, J.; Pa., 1860.

## B. PRODUCTS OF, RIGHT TO SELL AND USE.

1. A contract to buy all the product of a patented machine, during a certain period, does not render the purchaser liable to an action of infringement for the use of the machine, upon which made. *Keplinger* v. *De Young*, 10 Wheat., 364.—WASHINGTON, J.; Sup. Ct., 1825.

2. Otherwise, if such contract is only a colorable purchase of the products, but is in reality a hiring of the machine. *Ibid.*, 364.

3. Articles manufactured under a patent may be sold at any and every place, by any one who has purchased for speculation or otherwise. The patent law protects the thing patented and not the products. *Boyd* v. *Brown*, 3 McLean, 296.—MCLEAN, J.; Ohio, 1843.

4. The right of an assignee of a patent-right, for a particular district, is not infringed upon by the sale within such district, of the product of the same patent-right, manufactured by a party holding an interest in the same patent, in another district. *Ibid.*, 296.

5. Whether, if the manufacturer in the second district was actually engaged in selling such articles within the district held by the other, it would not be a violation of the right of such other person; *query*. *Ibid.*, 296.

6. The exclusive grant in a patent is the construction and use of the thing patented. The patent law protects the thing patented, and not the product. *Ibid.*, 297.

7. The sale of a thing manufactured by a patented machine, is no violation of the exclusive right to use, construct, or sell, the machine itself. The product cannot be reached except in the hands of some one in some manner connected with the use of the patented machine. *Boyd* v. *McAlpine*, 3 McLean, 429.—MCLEAN, J.; Ohio, 1844.

8. But if the sale of the product is by some one connected with the illegal use of the machine, he is responsible in

damages, and the court will restrain him from selling the product. *Ibid.*, 430.

9. And this may be done, if the court have jurisdiction of the person, though the use of the machine is beyond the jurisdiction of the court. *Ibid.*, 430.

10. An assignment of an exclusive right to make, use, and vend to others a patented machine, within a certain territory only, does not prohibit the assignee from selling elsewhere, out of the said territory, the products of such machines. *Simpson* v. *Wilson*, 4 How., 711.—NELSON, J.; Sup. Ct., 1845.

11. The restriction in the assignment applies solely to the using of the machine and is no restriction as to place, of the sale of the product. *Ibid.*, 711.

12. A purchaser, for his own account, of articles manufactured by a patented machine, though purchased with a full knowledge that they were manufactured in violation of the patent, cannot be enjoined, or held liable in any other way. *Anon.*, 3 West. Law Jour., 144.—BETTS, J.; N. Y., 1845.

13. The sale of an article, if the *product* of an invention, is not a "sale of the invention," within the meaning of § 7 of the act of 1839. A sale within that section, must be a sale of the invention, or patented article. But where a patent was for a *design*, an ornamental design for figured silk buttons—and such design was worked on the face of the button, whether a sale of the button would not be a sale of the *design*, the thing patented. *Booth* v. *Garelly*, 1 Blatchf., 250.—NELSON, J.; N. Y., 1847.

14. An action of infringement cannot be maintained against a mere purchaser of articles, manufactured in violation of a patent, after they have been manufactured, unless he is concerned in the manufacture. *Blanch. Gun-Stock Tur. Co.* v. *Jacobs*, 2 Blatchf., 70, 71.—BETTS, J.; N. Y., 1847.

15. Where A and B agreed with C, to purchase of the latter, all of a certain article, lead pipe, which he should make, A and B agreeing to furnish the lead, and pay C a given price for manufacturing, and C used in such manufacture a machine patented to plaintiff's assignor. *Held*, in an action for infringement against A, B, and C, that if A and B had no connection with the manufacture except to furnish the lead and pay a given price, that they were not liable for infringement. *Tatham* v. *Le Roy*, MS.—NELSON, J.; N. Y., 1849.

16. But if the agreement was only colorable, and entered into for the purpose of securing the profits of the business without assuming the responsibility for the use of the invention, then they would be liable. Aiding and assisting a person in carrying on such a business, and in operating the machinery, will implicate the parties so engaged. *Ibid.*

17. Where a license to run a planing machine contained a condition that the licensees should not sell dressed lumber out of the limits of the territory assigned, nor dress lumber for other persons to be carried out of such territory, and sold as an article of merchandise, *Held*, the true meaning of the condition was, that under no circumstances, could the planed article, with the privity or consent of the licensees, be sold out of their territory, or be sold within such territory to be carried out and resold, and that such use would be enjoined as in violation of the license. *Wilson* v. *Sherman*, 1 Blatchf., 539, 540.—NELSON, J.; N. Y., 1850.

18. Where a license to use a patented machine contained a clause restricting

the sale of the product, except in the territory within which such machine could be used, but the actual agreement was, that the licensee was to have the right to vend the products without any restriction as to place; *Held*, that a court of equity would reform the contract to make it as the parties understood it at the time it was made; but if, in the mean time, the rights of *bona fide* purchasers intervened, which might be prejudiced, then the contract could not be reformed. *Woodworth* v. *Cook*, 2 Blatchf., 154, 159.—NELSON, J.; N. Y., 1850.

19. 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. *Goodyear* v. *The Railroads*, 2 Wall., Jr., 362.—GRIER, J.; N. J., 1853.

20. Where a known manufacture or product is in the market, purchasers are not bound to inquire whether it was made on a patented machine, or by a patented process. *Ibid.*, 362.

21. But if a patentee be the inventor or discoverer of a new manufacture or composition of matter, not known or used by others before his discovery thereof, 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, the exclusive right to vend which is secured to the inventor or discoverer. *Ibid.*, 362, 363.

22. The purchaser of the product of a patented process, may use such product for any purpose he may see fit; and cannot be compelled to use it in subservience to any arrangement made between the patentee and any of his licensees. He may use it for his own purposes, without inquiring for or regarding any private agreement between licensees not to compete with one another. *The Washing Machine Co.* v. *Earle*, 2 Fisher, 206.—GRIER, J.; Pa., 1861.

23. And every person who purchases the right to use a patented machine or process, may sell the manufacture or product to whom they please, without inquiring the purpose of the purchaser, or imposing any condition on him, as to how he shall use it, unless he binds himself by covenants to restrict such right. *Ibid.*, 206.

24. A patentee, Goodyear, sold the plaintiffs the exclusive right to use his vulcanized rubber in its application to, and in combination with all wringing, washing, and starching machines. He had previously sold a like right to the Boston Belting Co., for "hose, pipe, and tubes." The defendants purchased india-rubber tubing of the Boston Belting Co., and used it to make wringers. *Held*, that the defendants had the right to apply such article, purchased by them, to making rollers for wringing machines without infringing the rights of the plaintiffs, and that the arrangements of the plaintiffs to create a monopoly could not affect defendants' rights to do as they pleased with their own property. *Ibid.*, 206.

25. A patentee may hold a close monopoly of his right, or he may grant out his entire right. But he cannot divide his right into parts, and grant to one man the right to use it in its connection with or application to one thing, and to another in connection with a different thing, to such an extent as that *purchasers* from any of these persons may not use the fabric purchased exactly as they like and if they please, in violation of what the patentee has supposed were rights not granted by him. *Ibid.*, 205.

26. An agreement between licensees, that one shall make a certain article, and the other another article, gives neither a right to an interference of chancery, to compel a purchaser from them to use the article purchased for any particular use or purpose; and if any covenants are made between the patentee and his licensees, the public are not compelled to notice or regard them, or the right conferred or reserved by them. *Ibid.*

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## PENALTIES, AND ACTIONS FOR.

A. UNDER THE COPYRIGHT LAWS..... 583
B. UNDER THE PATENT LAWS. ..... 584

### A. UNDER THE COPYRIGHT LAWS.

1. Where a copyright of a work had been taken out in this country, and the defendants had imported a number of copies of the same work published in England, and sold the same, *Held*, that the penalty of fifty cents was incurred for every sheet contained in the whole number of volumes found to have been in the defendant's possession, or which they had imported for sale, or sold, or held for sale. *Dwight* v. *Appletons*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

2. The penalty of infringement is fixed by law. If the jury find there has been an infringement, they must ascertain the number of sheets proved to have been sold, or offered for sale (not the number printed), and return a verdict for one dollar for each sheet so sold or offered to be sold. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

3. A defendant is not liable to the penalty under § 7 of the act of 1831, unless he was guilty of the infraction of the copyright within two years before action was brought. *Reed* v. *Carusi*, 8 Law Rep., 412.—TANEY, Ch. J.; Md., 1845.

4. But though the plates of a piece of music were engraved more than two years before, yet every printing for sale would be a new infraction of the right, and if such printing was within two years before suit brought, the defendant is liable. *Ibid.*, 412.

5. The penalty is at the rate of one dollar for each sheet the defendant may have caused to be printed for sale, within two years before suit brought. *Ibid.*, 412.

6. The penalty imposed by § 11 of the copyright act of 1831, for putting the imprint of copyright upon a work not legally copyrighted, and given by such act "to the *person* who shall sue for the same," cannot be recovered in the name of more than one person. *Ferrett* v. *Atwill*, 1 Blatchf., 154, 155.—BETTS, J.; N. Y., 1846.

7. A declaration for such penalty in the name of *two* persons is bad on general demurrer. *Ibid.*, 154.

8. In actions upon a statute, the party prosecuting must allege and prove every fact necessary to make out his title to the thing demanded, and his competency to sue for it. *Ibid.*, 155.

9. There is a manifest difference between giving a penalty to a common informer, and imposing one for the benefit of the person aggrieved: in the latter case the term person may be regarded as comprehending every one affected by the injury. *Ibid.*, 156

10. The language of the statute is to be particularly adhered to in the construction of penal laws. *Ibid.*, 156

11. Under § 6 of the copyright act of 1831, the penalty of fifty cents on each sheet (whether printed or being printed, or published, or exposed to sale), is limited to the sheets in possession of the defendant, and does not embrace every sheet which the defendant has published or procured to be published. *Backus* v. *Gould*, 7 How., 811.—McLean, J.; Sup. Ct., 1848.

12. A penal statute must be construed strictly. *Ibid.*, 811.

13. The statute penalty imposed by § 6 of the act of 1831, is not incurred by printing and publishing so much of a book as to amount to an infringement of its copyright. *Rogers* v. *Jewett*, 12 Mo. Law Rep., 340.—Curtis, J.; Mass., 1858.

14. Congress did not intend to inflict these penalties upon the unlawful printing or publication of less than an entire work. *Ibid.*, 34.

15. This question was not decided in *Backus* v. *Gould*, 4 How., 798, though raised in the court below, and ruled *pro forma*, there. *Ibid.*, 342.

## B. Under the Patent Laws.

1. When an action is brought on a penal statute, as the statute is the only foundation of the action, the declaration must aver that the act complained of was done contrary to the statute. *Parker* v. *Haworth*, 4 McLean, 373.—McLean, J.; Ill., 1848.

2. Under § 6 of the act of 1842, the assignees of an interest in a patent-right are no more liable to the penalty prescribed by the act for selling patented articles not having the date of the patent stamped on them, than any other persons, unless it appeared that the articles were manufactured by them or with their connivance. *Palmer* v. *Allen*, MS.—Betts, J.; N. Y., 1854.

3. It is not the selling of the articles so unstamped that makes them liable to the penalty, but the omitting to put the stamp on. If the articles were manufactured before coming to the possession of the assignees, or vendors, they are not bound to put on the stamp. *Ibid.*

4. The penalty attaches for each separate article sold, and not for all sold at each time in the aggregate. *Ibid.*

5. The *two* years' limitation in which to bring suits for penalties, prescribed in the crimes act of 1790, is repealed by implication by § 4 of the act of 1839, which enacts that suits for penalties or forfeitures may be brought at any time within *five* years from the time when the same accrued. *Stimpson* v. *Pond*, 2 Curt., 503, 504.—Curtis, J.; Mass., 1855.

6. § 5 of the act of 1842 authorizes the infliction of a penalty of just one hundred dollars for the offence described therein, and no more. *Ibid.*, 506.

7. The penalties prescribed by the patent acts may be recovered in an action of debt. *Ibid.*, 506.

8. It is necessary that each article should be stamped with the day of the month as well as the year, but if this is done it is sufficient, even if the word "patented" is abbreviated. *Hawley* v. *Bagley*, MS.—Betts, J.; N. Y., 1855.

9. To entitle the plaintiff to recover, he must allege and prove facts showing that he has a title to recover, and the proof must correspond with the allegations. Where the declaration charged the defendant with having sold an "extension pen holder," while the proof showed the patent to be for an "im-

provement in pens and pencil cases." *Held*, that the plaintiff could not recover. *Ibid.*

10. The penalty specified in § 5 of the act of 1842, for affixing the word "patent" to an unpatented article, is incurred as to all articles made and having such word affixed, with a guilty purpose: and this is not changed by the party making application for a patent during such manufacture, at least as to such as were made or ordered to be made, and so stamped before his application. *Stephens* v. *Caldwell*, MS. —SPRAGUE, J.; Mass., 1860.

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## PERFECTING AN INVENTION.

See title INVENTION, B.

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## PLAN OF A WORK.

See COPYRIGHT, B.

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## PLEADING.

**A.** DECLARATION. ..... 585
**B.** PLEAS IN BAR..... 588
**C.** OYER AND PROFERT..... 589
**D.** DEFECTS IN, CURED BY VERDICT..... 590
**E.** DEMURRER..... ..... 590

### A. DECLARATION.

1. In general, in an action for the violation of a patent, it is sufficient to state in the declaration, the substance of the grant or specification to which the grant refers. *Tryon* v. *White*, Pet. C. C., 97. —WASHINGTON, J.; N. J., 1815.

2. But if the declaration professes to set forth the specification as part of the grant, *verbatim*, or according to its tenor, the slightest variation is fatal, and for such variance a nonsuit will be granted. *Ibid.*, 97.

3. It is not a ground for a nonsuit in an action for violating a patent-right, that the declaration does not lay the act complained of to be "against the form of the statute," but merely claims damages. *Contra formam statuti* is matter of form, and the want of it would be cured by verdict. *Ibid.*, 97.

4. The 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. *Gray* v. *James*, Pet. C. C., 482.—WASHINGTON, J.; Pa., 1817.

5. If his title depends upon the performance of certain acts, he must affirm the performance of such acts. *Ibid.*, 482.

6. But if enough is stated to show title in the plaintiff, and with sufficient certainty to enable the court to give judgment, but the declaration is less explicit than might have been required, the defect will be cured by verdict. *Ibid.*, 482.

7. Where the declaration designates the patent by the terms used in the patent, it is not necessary that the specification should be set out in the declaration. It is a matter of evidence to be used at the trial, and the defendant may have it placed on the record by asking oyer of it. *Ibid.*, 482, 483.

8. The declaration must show a title in the plaintiff; but if it aver that the grant or patent, in the form prescribed by law, was issued, this shows the very title on which the action is founded.

*Cutting* v. *Meyers*, 4 Wash., 221.—WASHINGTON, J.; Pa., 1818.

9. It is not necessary to aver that the preliminary steps, such as presentation of petition, &c., were taken, without which a valid grant could not issue, because the court will presume in favor of the grant, that every thing was rightly done which the law required, in order to authorize the issuing of the grant. *Ibid.*, 221.

10. The declaration must, however, allege not only that a patent was made out in due form of law, by which there was granted to the plaintiff certain privileges, but must also allege a *delivery* of such patent to the plaintiff, and that the patent was attested by the president, or proper officer, as such attestation is necessary to the form and validity of the patent, and cannot be implied from the allegation that a patent was made out. The want of these allegations is cause for general demurrer. *Ibid.*, 222.

11. The declaration need not, however, state in what the plaintiff's improvement consists, or set out the patent or specification either verbatim or substantially. If the defendant desires its production he can pray *oyer* of it. *Ibid.*, 223.

12. Where the declaration laid the breach that the defendants, without the leave or license, &c., used the improvement invented by the patentee contrary to the form of the acts of Congress and against the privileges so granted, *Held*, sufficient—the breach assigned being as broad as the right granted. *Ibid.*, 223, 224.

13. Where a plaintiff claims as an assignee under a patent, the declaration should set out the fact, and that such assignments had been recorded; but if the declaration omit to state that such assignments were recorded, and a verdict is given in favor of the plaintiff, the defect will be cured by verdict. *Dobson* v. *Campbell*, 1 Sumn., 326.—STORY, J.; Me., 1833.

14. A declaration is a statement of facts, which in law gives the plaintiff a right to recover. It is materially defective if, to lay the foundation of a recovery, the proof must go further than the allegations it contains. *Stanley* v. *Whipple*, 2 McLean, 41.—MCLEAN, J.; Ohio, 1839.

15. In an action of infringement of a patent, the declaration must aver that the plaintiff had obtained a patent, or that the exclusive right was vested in him. *Ibid.*, 43.

16. Where the declaration stated that the plaintiff claimed a patent, and that the defendant possessed and enjoyed the right, *Held*, that it would be bad on general demurrer. *Ibid.*, 43.

17. But in such case after verdict, a motion in arrest of judgment will not be granted, as the court will presume that the facts showing the right were proved at the trial. *Ibid.*, 43.

18. The declaration in an action for the infringement of a patent need not set out the specification. *Pitts* v. *Whitman*, 2 Story, 614.—STORY, J.; Me., 1843.

19. 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 there is no substantial objection to a *profert*. *Ibid.*, 614.

20. In an action at law for an infringement of a patent for an improvement, the declaration must set out in what the improvement of the patentee consists—this being an essential part of the plaintiff's case—or else it will be demurrable

Leave was, however, given to amend. *Peterson* v. *Wooden*, 3 McLean, 249.—McLean, J.; Ohio, 1843.

21. If a declaration in a patent suit shows that the plaintiff has an interest in only a part of a patent, as a license to use, in the manufacture of a particular kind of goods, the invention described in it, it is bad on its face, and judgment will be rendered for the defendant. *Suydam* v. *Day*, 2 Blatchf., 23.—Nelson, Betts, JJ.; N. Y., 1846.

22. The declaration for an infringement of a patent need not aver the specific time of the invention. It need only be before the application for a patent. It is wholly immaterial as to the pleadings, whether the invention was long antecedent to the application or directly preceded it. *Wilder* v. *McCormick*, 2 Blatchf., 33.—Betts, J.; N. Y., 1846.

23. The declaration need not set forth any of the steps taken in securing the patent. The grant of the patent itself is sufficient evidence that all the preliminary steps required by law were properly taken. It is sufficient to set forth the patent in substance. *Ibid.*, 34.

24. The declaration must tender an issue upon the novelty and utility of the discovery patented; but it need not aver the regularity of the preliminary proceedings in its issue. *Ibid.*, 35.

25. A declaration which avers the patent and specification to be "in language of the *import* and to the effect following," and which sets forth the letters patent according to their words and figures, is sufficient; and it is not a good exception that the word "import" is used instead of "tenor," even if the words are not identical in signification, because the language is that of recital, and not of grant. *Ibid.*, 35.

26. A recital in a declaration that "the letters patent, in due form of law, are ready in court to be produced," is equivalent to *profert* in the most formal and ample terms. *Ibid.*, 35.

27. A reiteration of infringements of a patent, like a repetition of torts of any other kind, may be sued for and recompensed in one action. A declaration is not bad or demurrable, for duplicity, because it sets forth different and distinct infringements. *Ibid.*, 36.

28. A declaration which commences in *case* and concludes in the form of an action of debt by demanding actual damages in gross in compensation of the wrong, is good. *Ibid.*, 36, 37.

29. Though a declaration is not formal in its frame, if it embodies all that is essential to enable the plaintiff to give evidence of his right, and of its violation by the defendant, and affords the defendant the opportunity to interpose the defences allowed by law, the court will not encourage objections merely critical, and will seek, even on special demurrer, to sustain pleadings substantially sufficient. *Ibid.*, 37.

30. In an action for an infringement of a patent bearing date the 19th of October, 1829, and which has been extended, the declaration averred "that before the expiration of the term for which the original patent was granted, to wit, the 4th of October, 1843, such patent was in due form of law extended for the term of seven years from and after the 19th of October, 1843." On demurrer that the mode of extension should be set out at large, *Held*, that the general averment was sufficient. *Phelps* v. *Comstock*, 4 McLean, 353.—McLean, J.; Ind., 1848.

31. If the declaration aver that the defendant has made the thing "in imi-

tation of the plaintiff's patent," it will be sufficient to maintain the action. *Parker* v. *Haworth*, 4 McLean, 371, 373.—McLean, J.; Ill., 1848.

32. In an action for damages for an infringement of a patent, it is not necessary that the declaration should set forth the act complained of as contrary to the statute. This is only necessary when the action is brought on a penal statute. *Ibid.*, 373.

33. Where an original patent and the improvement on it are united in the same person, they constitute a whole, an entire right, and they must be asserted as such in the declaration in an action of an infringement of them. *Case* v. *Redfield*, 4 McLean, 529.—Huntington, J.; Ind., 1849.

34. If the declaration claims damages for the infringement of the original patent, and also separately for the infringement of the improvement, the action cannot be sustained. *Ibid.*, 529.

35. The declaration need not set out in what or by what means the defendants have infringed: it need only aver that the defendant has made, constructed, used, and sold the thing patented. *Ibid.*, 530.

36. Letters patent are not necessarily a part of the declaration. *Smith* v. *Ely*, 5 McLean, 90.—McLean, J.; Ohio, 1849.

37. The declaration, in a patent suit, averring an assignment of the invention *before* the issuing of the patent, such being the facts of the case, and claiming title under such an assignment, is not demurrable, such assignment being sufficient in law. *Rathbone* v. *Orr*, 5 McLean, 133.—McLean, J.; Mich., 1850.

38. In an action *qui tam*, under § 6 of the act of 1842, for a penalty, the proof must correspond with the allegations of the declaration. Where the declaration charged the defendant with having sold an "extension pen-holder" without stamping on it the date of the patent, while the proof showed the patent to be for an "improvement in pens and pencil cases," *Held*, that the plaintiff could not recover. *Hawley* v. *Bagley*, MS.—Betts, J.; N. Y., 1855.

## B. Pleas in Bar.

See also Defences; General Issue.

1. The recovery of a verdict by the plaintiff in an action for the infringement of a patent will not prevent him from bringing another action of infringement for a future use of the defendant's machine: every future use is an infringement. *Whittemore* v. *Cutter*, 1 Gall., 484.—Story, J.; Mass., 1813.

2. Where a declaration goes for the user of a machine during a limited period, a verdict and judgment in such action is no bar to a subsequent action for a user during another and subsequent period. *Earle* v. *Sawyer*, 4 Mas., 14.—Story, J.; Mass., 1825.

3. If the matter alleged in a plea is not a bar to the action, the plaintiffs may demand and have submitted the question of law to the court. Or they may deny the facts alleged in the plea, and take issue thereon, and go to the jury. *Grant* v. *Raymond*, 6 Pet., 245.—Marshall, J.; Sup. Ct., 1832.

4. A plea admitting the existence of a patent but denying its validity, is bad, as the plea refers a matter of law to the jury. *Bennett* v. *Martin*, 6 Mo., 461.—Tompkins, J.; Mo., 1840.

5. A plea of prior use or sale, under § 7 of the act of 1839, to be a bar to the

plaintiff's action, must state that it was more than two years before the application for a patent, or equivalent to an abandonment, to constitute a bar to the action—if it does not, it is demurrable. *Root* v. *Ball*, 4 McLean, 179.—McLean, J.; Ohio, 1846.

6. A plea in bar must contain a full defence against the rights of the plaintiff—that the plaintiff has no right to recover—or it is bad on demurrer. If the truth of the pleas may be admitted, and the action be still maintainable, such pleas are essentially defective. *Smith* v. *Ely*, 5 McLean, 85, 89.—McLean, J.; Ohio, 1849.

7. Where, therefore, the pleas alleged that the patentee was not the inventor of the thing claimed, and certain others were named as the first inventors, but such pleas did not allege a knowledge of the part of the patentee of such prior invention, and that such prior invention had been patented or described in some written publication, *Held*, that such pleas were defective and demurrable, not containing a full defence to the plaintiff's action. *Ibid.*, 85, 86, 89.

8. And a plea alleging the use of an invention with the consent and allowance of the patentee, should aver also an abandonment, or that the sale or prior use had been for more than two years before the application of the patentee. *Ibid.*, 86, 87.

9. Craving oyer of letters patent does not make them a part of a plea. *Ibid.*, 90.

10. If a party, by his pleading, tender an immaterial issue, the jury must find the issue as presented, and assess damages for the breach, if any, of the thing alleged. It makes no difference that it is an immaterial issue. *Goodyear* v. *Day*, MS.—Grier, J.; N. J., 1850

11. A plea of a defendant setting up an agreement, and justifying under the same, should aver the performance on the part of the defendant of the conditions precedent provided thereby, or aver that the defendant belongs to the class of persons who are provided for by such agreement: if it does not, it is ground for demurrer. *Day* v. *Hartshorn*, MS.—Pitman, J.; R. I., 1854.

## C. Oyer and Profert.

1. If the declaration designates the patent by the terms used in the patent, it is not necessary that the specification should be set out in the declaration. That is matter of evidence to be used at the trial. If the defendant wishes it to be put on the record, he can have it put there by asking oyer of it. *Gray* v. *James*, Pet. C. C., 482, 483.—Washington, J.; Pa., 1817.

2. The declaration need not set out the patent or specification either verbatim or substantially. If the defendant desires its production, he can pray oyer of it. *Cutting* v. *Myers*, 4 Wash., 223.—Washington, J.; Pa., 1818.

3. The *profert* of letters patent makes them, when produced, a part of the declaration, and gives all the certainty as to the invention patented which is required by law. It is therefore not good cause of objection that the declaration does not set them out. *Pitts* v. *Whitman*, 2 Story, 614.—Story, J.; Me., 1843.

4. It would be more formal to annex a copy of the letters patent and specification to the declaration, but there is no substantial objection to a *profert*. *Ibid.*, 614.

5. A recital in a declaration that the letters patent, in due form of law, are

ready in court to be produced, is equivalent to *profert* in the most formal and ample terms. *Wilder* v. *McCormick*, 2 Blatchf., 35.—BETTS, J.; N. Y., 1846.

6. Oyer of letters patent is not demandable as of a deed; but being matter of record, it is accessible to the defendant. *Smith* v. *Ely*, 5 McLean, 90.—McLEAN, J.; Ohio, 1849.

7. Letters patent are not necessarily a part of the declaration, and therefore where a plea alleges any thing respecting them, they should be stated in the plea. *Ibid.*, 90.

8. Craving oyer does not make the specification of letters patent part of a plea. *Ibid.*, 90.

9. Oyer of letters patent referred to in the declaration is not demandable as of right; being matter of record, the defendant can obtain them if he desires them. *Singer* v. *Wilson*, MS.—INGERSOLL, J.; N. Y., 1858.

## D. DEFECTS IN, CURED BY VERDICT.

1. Want of form in a declaration for an infringement of a patent, as not laying the act complained of as being "against the form of the statute," will be cured by verdict. *Tryon* v. *White*, Pet. C. C., 97.—WASHINGTON, J.; N. J., 1815.

2. If the declaration show title in the plaintiff, and with sufficient certainty to enable the court to give judgment, but the declaration is not as explicit as might have been required, the defect will be cured by verdict. *Gray* v. *James*, Pet. C. C., 482.—WASHINGTON, J.; Pa., 1817.

3. In an action for infringement of a patent brought by an assignee, the declaration omitted to state that the assignments had been recorded, as required by § 4 of the act of 1793, but judgment was rendered for plaintiff; *Held*, that the defect was cured by the verdict, as a verdict could not have been rendered for the plaintiff if the assignment had not been recorded, as nothing would pass by the deed unless recorded. *Dobson* v. *Campbell*, 1 Sumn., 326.—STORY, J.; Me., 1833.

4. Where a matter is so essentially necessary to be proved to establish a 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 the matter in express terms in the declaration is cured by the verdict, if the general terms of the declaration are otherwise sufficient to comprehend it. *Ibid.*, 326.

5. After verdict, defects in substance in the declaration are cured if the issue joined be such as necessarily required on the trial, proof of the facts defectively or imperfectly stated or omitted; after verdict, the court will presume that the facts showing the right were proved. *Stanley* v. *Whipple*, 2 McLean, 42, 43.—McLEAN, J.; Ohio, 1839.

## E. DEMURRER.

As to necessary substance in pleading, see PLEADING, A., B.

1. Where a plaintiff brought eleven *qui tam* actions for penalties against the same defendant, who demurred specially to each declaration, and the plaintiff joined in demurrer, a motion that one demurrer be argued, and that proceedings in the other cases be stayed, to abide the event of the one argued, was denied. A party bringing a multiplicity of suits must take the responsibility

of meeting them in the usual way. *Ferrett* v. *Atwill*, 1 Blatchf., 152, 153.—BETTS, J.; N. Y., 1846.

2. Where it is alleged as cause of demurrer that the declaration is not properly entitled, but the defect is not pointed out until on the argument, and consisted in a variance between the writ and the declaration, the court will not act upon it upon such suggestion. *Wilder* v. *McCormick*, 2 Blatchf., 32.—BETTS, J.; N. Y., 1846.

3. But if the objection had been properly raised, the court would have allowed an amendment of the error, under § 32 of the act of 1789. (1 *U. S. Stat. at Large*, 91.) *Ibid.*, 32.

4. Variances between the writ and declaration cannot be taken advantage of on general demurrer. *Ibid.*, 33.

5. Courts will not encourage objections merely critical, and will seek, even on special demurrer, to sustain pleadings substantially sufficient. *Ibid.*, 37.

6. If a demurrer is taken to all the pleas, and any one is found good, the demurrer will be overruled. *Brown* v. *Duchesne*, 2 Curt., 97.—CURTIS, J.; Mass., 1854.

7. Where in an action for the violation of a patent, the defendant pleaded the general issue and two special pleas, and the plaintiff demurred, alleging that the several pleas were insufficient," *Held*, that as one of the pleas, the general issue was good, the demurrer must be overruled. *Ibid.*, 97.

8. Where a demurrer does not restrict itself to the usual form of replying to one or more pleas, which is, as to the said pleas by the defendant secondly, or secondly and thirdly pleaded, the legal intendment is, that it applies to all. *Ibid.*, 97.

## PRINCIPLE.

See also ART; DISCOVERY; EFFECT; MODE OR METHOD; PURPOSE.

1. The legal title to a patent consists not in a principle merely, but in an application of a principle, whether previously in existence or not, to some new and useful purpose. *Whitney* v. *Carter*, Fessenden on Pat., 2d Ed., 139.—JOHNSON, J.; Geo., 1809.

2. A mere abstract principle is unsusceptible of appropriation by patent. The applicant for a patent must show how the principle is to be used and applied to some useful purpose. *Evans* v. *Eaton*, Pet. C. C., 341, 342.—WASHINGTON, J.; Pa., 1816.

3. A principle, in the sense of an elementary truth or power, is not the subject of a patent. 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. *Barrett* v. *Hall*, 1 Mas., 470, 471.—STORY, J.; Mass., 1818.

4. The word "principles," as used in the act of Congress, does not mean merely the elementary principles of bodies, as earths, alkalies, &c.; or of mechanic power, as the lever, screw, wheel, &c.; or of power obtained by water, air, fire, &c. Because scarcely any machine, medicine, or utensil could be constructed or operate without the aid of some such principles. It means not only elementary principles, but the application of them. *Holden* v. *Curtis*, 2 N. Hamp., 64.—WOODBURY, J.; N. H., 1819.

5. There must be the discovery of new principles, or the employment of old ones in a new proportion, or in a

new process, or to a new purpose. In the language of Lord Bacon, there must be "an invention of further means to endow the condition and life of man with new powers or works. *Ibid.*, 64.

6. The thing to be patented is not a mere elementary principle or intellectual discovery, but a principle put in practice and applied to some art, machine, manufacture, or composition of matter. *Earle* v. *Sawyer*, 4 Mas., 6.—STORY, J.; Mass., 1825.

7. What constitutes form, and what principle, is often a nice question to decide. The safest guide to accuracy in making the distinction, is to ascertain what is the result to be obtained by the discovery; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principles of the invention. *Treadwell* v. *Bladen*, 4 Wash., 706.—WASHINGTON, J.; Pa., 1827.

8. A patent cannot be for a principle or function of a machine, detached from machinery. *Blanchard* v. *Sprague*, 3 Sumn., 540.—STORY, J.; Mass., 1839.

9. A patent cannot be maintained for an abstract principle, or for all possible and probable modes of doing a thing; but such a patent would be utterly void. *Stone* v. *Sprague*, 1 Story, 272.—STORY, J.; R. I., 1840.

10. A patent for an abstract principle is void. *Wyeth* v. *Stone*, 1 Story, 285. —STORY, J.; Mass., 1840.

11. Where, therefore, in a patent for an improvement in the manner of cutting ice, the patentee claimed "as new, to cut ice of a uniform size by means of an apparatus worked by any other power than human," *Held*, that such a claim was utterly unmaintainable in point of law, as it was a claim for an art or principle in the abstract, and not for any particular method or machinery by which ice was to be cut. No man can have a right to cut ice by all means or methods, or by all or any sort of apparatus, although he is not the inventor of any or all of such means, methods, or apparatus. *Ibid.*, 285.

12. There cannot be a patent for a principle, nor for the application of a principle, nor for an effect. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

13. Two persons may use the same principle and produce the same effect *by different means*, without interference or infringement, and each would be entitled to a patent for his own invention. *Ibid.*

14. A mere difference in form or size is not a difference in principle; but a new application of known mechanical power is, in regard to invention, a new principle. *Foote* v. *Silsby*, 1 Blatchf., 459, 466.—NELSON, J.; N. Y., 1849.

15. A principle is not patentable. "The motive power of the galvanic current, however developed to produce a given result," can be no more patented than the motive power of steam to propel boats, however applied. *Smith* v. *Ely*, 5 McLean, 91.—MCLEAN, J.; Ohio, 1849.

16. The discovery of a new principle is not patentable, but it must be embodied and brought into operation by machinery so as to produce a new and useful result. *Tatham* v. *Le Roy*, MS. —NELSON, J.; N. Y., 1849.

17. He who first discovers that a law of nature can be applied, and having devised machinery to make it operative, introduces it in a practical form to the knowledge of his fellow-men, is a dis-

coverer and inventor of the highest grade—not merely of the mechanism, but of the force which operates through the mechanical medium, the principle, or, to use the synonym given for this term in the act of 1793, the *character* of the machine. *Parker* v. *Hulme*, 7 West. Law Jour., 422.—KANE, J.; Pa., 1849.

18. He may assert and establish his property, not only in the formal device for which mechanical ingenuity can at once, as soon as the principle is known, imagine a thousand substitutes—some as good, others better, perhaps all dissimilar, yet all illustrative of the same principle, and depending on it—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. *Ibid.*, 422.

19. This is not to patent an abstraction, but rather the invention, as the inventor has given it to the world, in its full dimensions and extent—nothing less, but nothing more. It is to patent the invention in the broad and general terms that properly express it, and to secure to the party the exclusive right, for a limited time, to precisely that discovery which he has imparted to the public, and which the public, when that limited time expires, will enjoy. *Ibid.*, 422, 423.

20. What is to be protected, is not an abstract or isolated principle, but the embodiment of a principle into a machine or manufacture, as described in the specification; and it is the invention in conformity with that embodiment or representation of its working, which the act of Congress protects. *Smith* v. *Downing*, MS.—WOODBURY, J.; Mass., 1850.

21. It is well settled that a patent cannot cover a new principle, without reference to any mode or method of enforcing it. *Ibid.*

22. The impropriety of granting a patent for the invention or discovery of a principle, however important it may be *per se*, rests on the idea that the exclusive use of the invention is given to the patentee to reward his genius and expense in making the invention, and pointing out how it can be used beneficially. The patent is, and must be, in order to possess validity, not for the principle—but for the machine, mode, or manufacture, to carry out the principle and reduce it to practice. The principle thus becomes the *modus operandi*, and rests in the new mode adopted to accomplish certain results. *Ibid.*

23. Though some expressions may have been used by some of the judges, which look like a sanction to patenting a principle, yet they are used in the sense of a principle in operation, in the manner set out in the specification, or are used too loosely from haste and inadvertence. *Ibid.*

24. A patent cannot be for a principle or a result, but must be for the mechanical means by which the principle is carried into effect, or the result attained. *Brooks* v. *Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

25. Although a mere abstract conception of the application of a principle is not the subject matter of a patent, yet when it is reduced to practice by any means, old or new, resulting usefully, it is the subject of a patent, independent of the machinery by which the application is made. *Foote* v. *Silsby*, 2 Blatchf., 265.—NELSON, J.; N. Y., 1851.

26. And it is immaterial whether the means used be new or old, for though

old means be used for giving application to the new conception, yet the patent excludes all persons other than the patentee from the use of those means, and of all other means, in a similar application. *Ibid.*, 265.

27. A principle in the abstract is a fundamental truth—an original cause—a motive; these cannot 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, as steam, electricity, or any other power of nature. *Le Roy* v. *Tatham*, 14 How., 175.—McLean, J.; Sup. Ct., 1852.

28. In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. The right of the inventor is secured against all who use the same mechanical power, or one substantially the same. *Ibid.*, 176.

29. In this case the patentees claim the combination of machinery described, as their invention, which can only be sustained by establishing its novelty. The question whether a newly discovered property of lead might be patented is not in the case. *Ibid.*, 177.

30. A patent cannot be for an effect produced, distinct from the process or machinery necessary to produce it. *O'Rielly* v. *Morse*, 15 How., 120.—Taney, Ch. J.; Sup. Ct., 1853.

31. Morse's claim for "the use of the motive power of the electric or galvanic current, however developed, for marking or printing intelligible characters, at a distance;" *Held*, to be a claim for a principle, and therefore not patentable. *Ibid.*, 120.

32. A new principle or idea, until it becomes properly and practically clothed, is not patentable. *McCormick* v. *Ketchum*, MS. (App. Cas.)—Morsell, J.; D. C., 1853.

33. Neither principles, nor abstract philosophical ideas, nor the natural functions either of the human body, or of matters of nature, are patentable. *Morton's Case*, 8 Opin., 272.—Cushing, Atty. Gen.; 1856.

34. A patent cannot be sustained for a mere principle; but 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 the application of the principle which constitutes the grant of the patent. *Wintermute* v. *Redington*, 1 Fisher, 247.—Wilson, J.; Ohio, 1856.

35. The principle so embodied and applied, and the principle *of such* embodiment and application are essentially different: the former being a truth of exact science, or a law of natural science, or a rule of practice; the latter a practice founded upon such truth, law, or rule. *Ibid.*, 247.

36. A patentee claimed the application of the expansive and contractive power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove. *Held*, that it was a valid claim, not being for a principle, and that the patent was good. *Silsby* v. *Foote*, 20 How., 385.—Nelson, J.; Sup. Ct., 1857. Grier, Daniel, JJ., dissenting, 1857.

37. The true doctrine is, that there cannot be a patent for a principle, for a result, or the function of a machine: but there may be a patent for a machine or manufacture, and when we come to

test the question of infringement, the question of principle comes up in this light, What is the mode of operation of the machine invented? *Singer* v. *Walmsley*, 1 Fisher, 563.—GILES, J.; Md., 1859.

38. A principle is not patentable; but if one discovers a principle, and a mode of operation, he has a right to have a patent for the mode of carrying the principle into effect; and if anybody takes his principle and his mode of operation, substantially, though he varies the form, he is an infringer. *Ibid.*, 563.

39. However brilliant the discovery of a 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., 137.—MCLEAN, J.; Sup. Ct., 1850.

40. The principle may be the new and valuable discovery, but the practical application of it to some useful purpose is the test of its value. *Ibid.*, 137.

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## PRINCIPLE OF A MACHINE.

See MACHINES, A.

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## PRINTED PUBLICATION.

See PUBLIC WORK.

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## PRIOR KNOWLEDGE AND INVENTION.

See also, as bearing on this title, INVENTION, B.; INVENTOR, A., B.; PUBLIC WORK.

1. In this country, if it appears that the plaintiff was not the original inventor, in reference to other parts of the world as well as America, he is not entitled to a patent. *Aliter*, in England, in consequence of the statute of James I., which speaks of new manufactures, *within the realm*. *Reutgen* v. *Kanowrs*, 1 Wash., 170.—WASHINGTON, J.; Pa., 1804.

2. In an action for a violation of a patent, to entitle the plaintiff to recover, the jury must be satisfied that he was the original inventor, not only in relation to the United States, but to other parts of the world. Even if there was no proof that the plaintiff knew that the discovery had been before made, still he could not recover, if in truth he was not the original inventor. *Dawson* v. *Follen*, 2 Wash., 311.—WASHINGTON, J.; Pa., 1808.

3. It is not necessary, to defeat a patent, that a machine should have previously existed in every respect similar: a mere change of former proportions will not entitle a party to a patent. *Woodcock* v. *Parker*, 1 Gall., 340.—STORY, J.; Mass., 1813.

4. The title of a patentee may be impeached by showing that his invention had been known and used before in any part of the world, although he was ignorant, at the time he received his patent, that the invention had been in use before his discovery. *Evans* v. *Eaton*, Pet. C. C., 342.—WASHINGTON, J.; Pa., 1816. [Affirmed, *post* 9.]

5. Any patent may be defeated, by showing that the thing secured by the patent had been discovered and put in actual use prior to the discovery of the patentee, however limited the use or the knowledge of the prior discovery may have been. *Bedford* v. *Hunt*, 1 Mas., 305.—STORY, J.; Mass., 1817.

6. If the first inventor reduced his

theory to practice, and put his machine or other invention into use, the law could never 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 same invention. *Ibid.*, 305.

7. It makes no difference as to the patentee's rights, whether the prior machine or invention has fallen into disuse or not: if it was used before his discovery he cannot obtain a patent for it. *Evans* v. *Hettick*, 3 Wash., 443.—WASHINGTON, J.; Pa., 1818.

8. And it is immaterial whether the patentee had notice of a prior invention or not. If it was in use in any part of the world, however unlikely or impossible that the fact should come to the knowledge of the patentee, his patent for the same machine cannot be supported. *Ibid.*, 443.

9. Under § 6 of the act of 1793, if the thing had been in use or known anterior to the patentee's supposed discovery, his patent is void. Though the patentee had no knowledge of such previous use, still his patent is void, as the law supposes he may have known it. *Evans* v. *Eaton*, 3 Wheat., 514.—MARSHALL, Ch. J.; Sup. Ct., 1818.

10. If a defendant attempts to avoid a patent, by showing that the patentee was not the original inventor, the patent will be considered as relating back to the original *discovery*, and not to the time of *application* for a patent. *Dixon* v. *Moyer*, 4 Wash., 72.—WASHINGTON, J.; Pa., 1821.

11. Under the act of 1793, the invention must be new as to all the world, and must not have been "known or used before the application" either by the inventor or others; and must be useful. The time of the discovery referred to in § 6, refers to the date of the application, and does not go back of it. *Thompson* v. *Haight*, 1 U. S. Law Jour., 573.—VAN NESS, J.; N. Y., 1822.

12. § 1 of the act of 1793 is to be construed with § 6, and means that the improvement or discovery should be unknown and not used as the invention of any other person than the patentee, before the application for a patent. *Morris* v. *Huntington*, 1 Paine, 352.—THOMPSON, J.; N. Y., 1824.

13. The use of an invention by another, while the inventor is practising and experimenting with it for the sake of perfecting his invention, will not invalidate the patent afterward granted the inventor. *Ibid.*, 354.

14. Under the act of 1793 the prior existence of an article the same in principle with an article patented, would not be regarded as impeaching the validity of such patent, if such article had never been in use before the patentee's invention. *Pennock* v. *Dialogue*, 4 Wash., 543.—WASHINGTON, J.; Pa., 1825.

15. The use of a machine even to a limited extent—as of a biscuit machine to the extent of perhaps half a barrel of flour—amounts to a using of it within the true meaning of § 6 of the patent act of 1793, and such as will invalidate a patent granted for a subsequent invention. *Watson* v. *Bluden*, 4 Wash., 583.—WASHINGTON, J.; Pa., 1826.

16. And it will make no difference that such use may have been for the purpose of testing its practical utility. *Ibid.*, 583.

17. The testimony of a witness that he had seen, before plaintiff's invention, articles resembling those produced by it, but of which he had no knowledge

how they were made, is not sufficient evidence to invalidate plaintiff's patent, on the ground that he was not the first inventor, or that the same thing had been in use before his invention, unless the jury can safely conclude from the appearance of such articles, that they were made by a machine embodying the principles of plaintiff's patent. *Treadwell* v. *Bladen*, 4 Wash., 706.—WASHINGTON, J.; Pa., 1827.

18. The true construction of the act of 1793 is, that to invalidate a patent, the thing patented, where a prior patent is relied on, must have been used prior to the alleged *discovery* of the patentee, and that it is not sufficient to show that it was so used prior to the application. *Ibid.*, 708.

19. The rule, that if an invention has been in use, or described in a public work before the supposed discovery, the patent is void, whether the patentee knew of such previous use or publication or not, holds if the machines are the same in principle, though they may differ in proportions or form. *Brooks* v. *Bicknell*, 3 McLean, 263.—MCLEAN, J.; Ohio, 1843.

20. An inventor will not be deprived of the benefits of his invention and a right to a patent, by a use of his invention before his application for a patent, without his consent and against his will, and without any *laches* or misconduct on his part. *Pierson* v. *Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844.

21. If a patentee is not the first or original inventor, in reference to all the world, he is not entitled to a patent, though he had no knowledge of any previous use or description of the invention. *Street* v. *Silver*, Brightly, 98.—ROGERS, J.; Pa., 1846.

22. The provisions of §§ 7 and 15 of the act of 1836, introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad—that is, a discovery not patented, and not described in any printed publication. Anon., 5 Opin., 21.—TOUCEY, Atty. Gen.; 1848.

23. A *bona fide* inventor in this country, and who believed himself to be the original and first inventor, at the time of his application, and did not know or believe his invention had before been known or used, is entitled to a patent for his invention, though the same invention may have been known and used in a foreign country, provided it had not been patented or described in any printed publication. *Ibid.*

24. In such a case, the American inventor is, in contemplation of law, under the provisions of the act of Congress, the original and first inventor. The fact that an invention, not patented or described in any printed publication, has been before known and used in any foreign country, is immaterial, except so far as it may have come to the knowledge of the American inventor, and conflict with the oath he is required to take as an original inventor. *Ibid.*

25. If the applicant is an original inventor, and is in a condition to take the oath required, the act requires the Commissioner to issue the patent, and the courts to declare it valid, and establishes the American right, to the exclusion of the foreign discovery, which has not, in either of the modes indicated by the act of Congress, been communicated to the public. *Ibid.*

26. Where a prior invention is set up

to defeat a patent, such invention must be shown to be more than an idea, and must have been reduced to some practical use. An abortive experiment will not be sufficient. *Many* v. *Jagger*, 1 Blatchf., 383.—NELSON, J.; N. Y., 1848.

27. Where a prior invention was claimed to be substantially like a subsequent one, *Held*, the jury could take into consideration, in determining the question of identity, that such prior invention was known to persons who experimented to produce the subsequent one, but failed to do so. *Ibid.*, 386.

28. It is not enough to defeat a patent already issued, that another conceived the idea or possibility of effecting what the patentee accomplished. *Parkhurst* v. *Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

29. 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. *Ibid.*, 494.

30. Crude and imperfect experiments, equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor, who has perfected his improvement and obtained his patent. *Ibid.*, 494.

31. Where a dispute arises as to priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent. *Parker* v. *Hulme*, 7 West. Law Jour., 424.—KANE, J.; Pa., 1849.

32. It is not enough in order to defeat a patentee's right, to show that a machine like that patented had been *made*, but it must also be shown that it was *used* before the plaintiff's invention. This is the test of what is required, to defeat the title of the patentee of an improved machine. *Ibid.*, 425.

33. In order to confer any exclusive right on the patentee, the thing patented must have been original with the inventor, and not known to others. The only exception to this rule, is where an individual obtains a patent, believing the invention to be original, and it is made to appear it had been *known* in a *foreign* country, but not patented there, nor described in any printed publication. *Parker* v. *Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

34. Proof of a previous structure, bearing some resemblance in some respects to the plaintiff's improvements, and which might have been suggestive of ideas, or led to experiments resulting in the discovery and completion of his improvement, will not invalidate his patent. *Ibid.*, 62.

35. The prior construction and use of a thing, in one instance only, for private use, and which had never been brought to the knowledge of the public, and which had been finally forgotten or abandoned, before the invention of the same thing by another, who obtained a patent for it, will not invalidate such patent. *Gayler* v. *Wilder*, 10 How., 496, 498.—TANEY, Ch. J.; Sup. Ct. 1850.

36. Where a person, F., invented an improvement in safes, consisting of the use of a double iron chest, the space between which was filled with plaster of Paris, for which improvement letters patent were secured in 1843, and on an action for an infringement, brought by his assignee, G., it was proved that C., between the years 1829 and 1832, had constructed for his own use a safe substantially the same, and used the same

until 1838, when it passed out of his hands, and no other trace of it was shown; and C. himself also purchased another safe for his own use, and there was no evidence that F. even had any knowledge of the invention and use by C.; *Held*, that F. was to be considered as a first and original inventor within the meaning of the patent laws of the United States, notwithstanding the prior use by C., F. being in reality the first to confer on the public the benefit of the invention, the safe of C. having passed from his memory and those who had seen it, and having disappeared, and the knowledge of the improvement being as completely lost as if it had never been discovered. *Ibid.*, 496, 498.

37. By the knowledge and use, referred to in § 6 of the act of 1836, is meant knowledge and use existing in a manner accessible to the public. *Ibid.*, 497.

38. The same rule holds also in respect to the lost arts. If any one should discover a lost art, and it was a useful improvement, he would be entitled to a patent, though 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. *Ibid.*, 497.

39. The patentee must be the original inventor of the machine or improvement, or he can receive no patent. The original inventor, means the first inventor, subject only to the provision of § 15 of the act of 1836. The law authorizes no presumption of forgetfulness. The question is, was C.'s invention prior to F.'s. It is of no importance that C.'s invention was used only for his *private* purpose. The invention is the question, and not the manner of its use. If F. was not the original and first inventor, he is not entitled to a patent. *Ibid.*, 499–502, 506, 507.—McLean, J.; Daniel, J., Dissenting.

40. The illustration of a lost art is not apposite to the case. That term is applicable to certain monuments of antiquity still remaining, but the process of whose accomplishment has been lost for centuries. If a means of producing the effect we see and know be discovered and none can by history or tradition refer to a similar, or the identical process, the inventor may claim the merit of originality, though the work may have been produced possibly by the same means. *Ibid.*, 508.

41. To defeat a patent on the ground of prior invention, the question is whether anterior to such patent, any person had discovered the application of the principle involved in such patent, and applied it by some apparatus which operated to effect the object secured by such patent. *Foote* v. *Silsby*, 2 Blatchf., 266.—Nelson, J.; N. Y., 1851.

42. In order to overthrow the claim of a patentee, the thing set up in defence, tending to disprove the novelty of the patentee's invention, must be of practical utility, and must have embraced all the elements of the patentee's combination. *Ibid.*, 274.

43. To the general rule laid down in *Evans* v. *Eaton*, Pet., C. C., 349, that if an inventor abandons his invention, no other person can take out a patent for it, there are exceptions, as in the case of the lost arts, where the knowledge of the invention has been as completely lost as if it had never been discovered *Rich* v. *Lippincott*, 2 Fisher, 7.—Grier, J.; Pa., 1853.

44. But if the original invention remained in existence and use, and has not been entirely lost and forgotten, the omission of the original inventor to bring it into public use or notice does not give a subsequent inventor a right to a patent. *Ibid.*, 7.

45. And though the first inventor may have abandoned its use, and been ignorant of the extent of its value, a subsequent inventor of the same thing would not be entitled to a patent therefor, provided the original invention, and the mode of its construction, were still in the memory of the original inventor, or in the knowledge of others, before they were recalled by the subsequent inventor. *Ibid.*, 7–8.

46. If the first inventor reduced his theory to practice, and put his 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. *Ibid.*, 6.

47. Though a prior inventor has gone to a certain extent, if he fall short of making a complete machine, practically useful, those who come after him may secure to themselves the advantages of his invention. The first inventor gave nothing to the public; it was only an idea, never carried out in a machine that could anticipate one subsequently invented. *Howe* v. *Underwood*, 1 Fisher, 166.—SPRAGUE, J.; Mass., 1854.

48. It is not the law, that if a prior inventor has gone to a certain extent, although he fall short of making a complete machine, practically useful, those who come after him have no right to secure to themselves the advantage of his invention. *Ibid.*, 167.

49. If the thing invented or discovered has been described in any foreign publication, before the invention of the patentee, it will be fatal to his right. This goes upon the presumption, if such foreign publication has been made, the patentee may have acquired a knowledge of it; and this presumption is not rebutted by proving, so far as a negative can be proved, that the inventor had no knowledge of it. *Allen* v. *Hunter*, 6 McLean, 313, 314.—MCLEAN, J.; Ohio, 1855.

50. To defeat a patent on the ground of prior invention, it is not sufficient that another person has conceived the possibility of effecting what the patentee has accomplished. 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. *Ibid.*, 321.

51. A prior accidental combination or invention, similar in character to that which the plaintiff has patented, but under circumstances such that the public obtained no knowledge of the invention, will not defeat a patent. *Ransom* v. *Mayor, &c.*, 1 Fisher, 265.—HALL, J.; N. Y., 1856.

52. As to the question of infringement, it is a standing principle of law, that every person is entitled to the free use of whatever was known and used, prior to the patent which attempts to appropriate it as a new discovery, and it is unimportant whether the character and capacities of machinery open to general use are understood or not by the public at large, or had been used by many; it is sufficient to show that the public had free means of access to it, and to employ it, and the law then presumes it was well known and in public

use. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

53. A previous description of a thing in a patent or work is like notice, and of the same effect against a patentee, as a public use of the thing itself. Such prior use or notice must, however, have been prior to the date of the patentee's discovery, or at least before the filing of his application for a patent. *Ibid.*

54. It is to be assumed, that persons obtaining patents have acquainted themselves with the state of the art in which they are interested, as made known in books or by machines built and put in use; and evidence is not admissible to prove the contrary; nor is it matter of inquiry whether machines described in printed works were ever practically put to use or not. *Ibid.*

55. Under § 15 of the act of 1836, providing that the prior knowledge or use of a thing in a foreign country—it not appearing that the same had been before patented or described in a printed publication—should not invalidate a patent granted here, the patentee believing, at the time of his application, that he was the first discoverer or inventor. If the jury find that the patentee, when he made application for a patent, believed himself to be the first inventor of the thing patented, his patent will not be invalidated by the prior existence of the thing abroad. *Forbush* v. *Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

56. In determining the question, under § 15 of the act of 1836, whether a patentee believed himself to be the first inventor of the thing patented, notwithstanding the actual existence of such thing in a foreign country, which, however, had not been patented or described, the defendant may give evidence, that the patentee knew of the existence of the thing abroad; and in considering the fact whether he *believed* himself to be the first inventor, it is material to determine whether he was in fact the original inventor. *Ibid.*, 664.

57. To constitute a prior invention or knowledge, which will deprive a patentee of the right granted to him, it is not enough that the person conceived the idea that the thing could be done; but he must have put his idea into practice. *Poppenheusen* v. *N. Y. G. L. Comb Co.*, 2 Fisher, 68.—INGERSOLL, J.; N. Y., 1858.

58. To defeat a patent which has been issued, it is not enough that some one, before the patent, conceived the idea of effecting what the patentee accomplished. To constitute such a prior invention as will avoid a patent that has been granted, it must be made to appear that some one, before the patentee, not only conceived the idea of doing what the patentee has done, but also that he reduced his idea to practice, and embodied it in some useful and practical form. The idea must have been carried into practical operation. *Ellithorpe* v. *Robertson*, 4 Blatchf., 309.—INGERSOLL, J.; N. Y., 1859.

59. Experiments made, equivocal in their results, and given up for years, will not be permitted to prevail against an original inventor who has reduced his invention to practice, and has without fraud obtained a patent. *Ibid.*, 309.

60. The decision in *Gayler* v. *Wilder*, 10 How., 496, 1850, is only that if the discovery of the first inventor had been so far laid aside, that it was in point of fact absolutely and irrevocably forgot ten by him and by the world, but for its recall to his memory by the second invention, then the second inventor must

be held equally meritorious as the one who discovers a long lost art, or an unpatented and unpublished foreign invention, and like him entitled to a patent. *Babcock* v. *Degener*, MS.—(App. Cas.) —MERRICK, J.; D. C., 1859.

61. The first proviso of § 15 of the act of 1836 qualifies the language of § 6 of the same act; by knowledge and use the legislature meant knowledge and use accessible to the public. *Cahoon* v. *Ring*, 1 Fisher, 410.—CLIFFORD, J.; Me., 1859.

62. Where, therefore, a person invented a machine, but did not make it public, and had used it for no purpose except simply for his own private experiments, and it had been broken up, and the materials used for other purposes, and its essential parts had been lost, prior to the invention of the same thing by another person, who had obtained a patent for his invention, *Held*, that such prior invention and use was no obstacle to the subsequent inventor taking out a patent, and would not invalidate his patent. *Ibid.*, 411.

63. And if a single specimen only of such machine was made, whether capable of use, or whether actually used or not by the party making it, for the purpose of testing its operation, if such machine was kept in the maker's own possession, from the knowledge of the public, and was subsequently broken up, and its substantial parts lost, so that the public could not derive the knowledge of it from the machine itself, but only from the memory of the alleged inventor, the existence of such prior machine will not invalidate the patent of a subsequent inventor, though such prior machine may have embodied all the improvements of the subsequent one, if the subsequent inventor was an original inventor, without knowledge of the prior one. *Ibid.*

64. The prior use of an invention in England, from 1855 to 1859, but not with the consent of the inventor, is no bar to his receiving a patent therefor. *Fry & Seeley*, *Ex parte*, MS. (App. Cas.) —MORSELL, J.; D. C., 1859.

65. A prior use of a thing in a foreign country will not invalidate a patent afterward taken out in this country, where the inventor supposed himself to be the first inventor, unless the prior invention had been patented or described in some printed public work. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

66. A patent will not be avoided, by the mere fact that the invention or discovery patented had been known and used in a foreign country before the discovery of the patentee, provided the patentee, at the time of his application for a patent (act of 1836, § 15), believed himself to be the first and original inventor of the thing patented. *Bartholomew* v. *Sawyer*, 4 Blatchf., 350.—INGERSOLL, J.; N. Y., 1859.

67. No description in any printed publication, of the thing patented will avoid a patent, unless such publication was prior in point of time to the *invention* of the patentee. It is not sufficient that such publication was prior to the *application* of the patentee for his patent. *Ibid.*, 351.

68. The time referred to in § 15 of the act of 1836, by the terms "having been before known and used in any foreign country," or "had been patented or described in any printed publication," is the time when the original discovery or invention of a patentee was made, and not the time when he presented his application for a patent. *Ibid.*, 352.

69. It is not proof of the want of

originality or novelty in an invention for which an American citizen has obtained a patent, that it may have been known or used in a foreign country, unless it appears that the invention or improvement was patented in such foreign country, or there described in some public work. *Judson* v. *Cope*, 1 Fisher, 623.—LEAVITT, J.; Ohio, 1860.

70. But to make such a defence available, it must appear that the improvement which has been known in a foreign country has been so clearly and intelligibly described, that the invention could be made or constructed by a competent mechanic. A mere suggestion or imperfect description of an invention would not be sufficient to defeat the American patent. *Ibid.*

71. To defeat a patent by reason of prior use or knowledge, such prior use or knowledge must be shown to have been anterior not merely to the date of the patent, but to the time when the invention was actually made. *Ibid.*

72. Evidence cannot be received of actual use and knowledge of an invention in a foreign country, prior to the time of the invention here, in order to defeat the American patent, but the defendants must be confined to the description of the invention as found in printed publications or patents; they cannot go beyond such publication or patents, because no prior use abroad, unless the invention has been described in a printed publication or has been patented, will affect the validity of the patent in this country. *Ibid.*

73. It is not necessary to show that a prior invention had ever been *put* in use; it is enough to bar a right to a patent to show that the thing had been described. *Sceley*, *Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

74. If an invention is completed, it is wholly immaterial as to the questior of priority of invention, how limited was the use or knowledge of the prior discovery. *Sturtevant* v. *Greenough*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

75. To constitute a prior invention, which will avoid a patent, it is necessary that there should have been not only an idea of the machine, but it should have been embodied in a working machine. Mere experiments, which were unsatisfactory and have been abandoned, are not enough. *Winans* v. *Danforth*, MS.—NELSON, J.; N. Y., 1860.

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## PRIOR USE.

See also ABANDONMENT, B. 1.

1. If an inventor had gratuitously imparted, or negligently suffered his invention to become public before his application, he is not entitled to a patent therefor. *Thompson* v. *Haight*, 1 U. S. Law Jour., 575.—VAN NESS, J.; N. Y., 1822.

2. The meaning of the words "not known or used," in § 1 of the act of 1793, is that the invention for which a patent is sought must not have been known or used *by others* before the application. If it were necessary for the inventor to employ others to assist him in the original structure or use by himself, or if, before his application, his invention should be pirated by another, or used without his consent, such knowledge or use will not invalidate the patent. *Pennock* v. *Dialogue*, 2 Pet., 18, 19.—STORY, J.; Sup. Ct., 1829.

3. But although he is the first as well as the true inventor, yet if he puts his

invention into public use, or sells it for public use before he makes an application for a patent, such use can be set up as a bar to his patent under § 6 of the act of 1793. *Ibid.*, 23.

4. The true construction of the patent act of 1793, is that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use before he makes application for a patent. His voluntary act or acquiescence in the public sale and use, creates a disability to comply with the terms and conditions on which alone a patent can issue to him. *Ibid.*, 23, 24.

5. The previous use, to avoid a patent, must not be a private or surreptitious use, in fraud of the patentee, but a public use by his consent, by a sale by himself, or by others with his acquiescence, by which he abandons his right, or disables himself from complying with the law. *Whitney* v. *Emmett*, Bald., 309, 310.—BALDWIN, J.; Pa., 1831.

6. But unless the invention has been more or less used by others, or publicly communicated by the patentee, his patent will be sustained. *Ibid.*, 310.

7. The time during which the thing patented had been known and used, is not material, the criterion is its public, not its private or surreptitious use, the use with the consent of the inventor, express or implied, from circumstances. *Ibid.*, 310.

8. The patentee may make experiments with his invention, or disclose it to those he may wish to consult, or employ others to assist him in making and using it, or may explain it to those using it, so as to give notice of an infringement, without impairing his patent, unless he is guilty of negligence in procuring his patent. *Ibid.*, 310, 311.

9. The prior knowledge and use spoken of in the act of 1793, has reference to the public only, but there may be cases in which a knowledge of the invention may be surreptitiously obtained, and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the *right* to the *public* by the inventor, though an acquiescence on his part will lay the foundation for such a presumption. *Shaw* v. *Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

10. Under §§ 3 and 6 of the act of 1793, and §§ 6 and 15 of the act of 1836, the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge and consent, before his application for a patent. *Ryan* v. *Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839.

11. If the use or sale is without such knowledge or consent, or if the use be merely experimental, to ascertain its value, or utility, or the success of the invention, by putting it in practice, that is not such a use as will deprive the inventor of his title. *Ibid.*, 518.

12. Such use or sale must also be before application. A sale or use with his knowledge and consent, intermediate between his application for a patent and the grant thereof, has no such effect. *Ibid.*, 519.

13. The use of an invention before application for a patent, to be sufficient to defeat a patent, under § 15 of the act of 1836, must be a public use of the invention substantially as patented—with the consent of the inventor—and must be either generally allowed or acquiesced in, or at least be unlimited in time, or extent, or object. *Wyeth* v

*Stone*, 1 Story, 281.—Story, J.; Mass., 1840.

14. A mere occasional use by the inventor, in trying experiments, or a temporary use by a few persons, as an act of personal accommodation or kindness for a short and limited period, will not take away a right to a patent. *Ibid.*, 281.

15. On the other hand, a user without the inventor's consent, and adverse to his patent, is a clear violation of his rights, and cannot deprive him of his patent. *Ibid.*, 281.

16. The circumstances ought to be very clear and cogent, which will justify a court in adopting a conclusion so subversive of private rights—that a user of an invention before application for a patent, destroys the right to a patent—when the party has subsequently taken out a patent. *Ibid.*, 281.

17. § 7 of the act of 1839 allows the use of an invention, even by leave of the inventor, for two years before application, without invalidating his right to a patent; *a fortiori*, the use by a third person, or a subsequent inventor, after the first invention and before the issuing of a patent to the first inventor, without his consent, is no bar to the issuing of a patent to the first inventor. *Hildreth* v. *Heath*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1841.

18. The use of an invention by the patentee himself, before his application for a patent, will not deprive him of his right to a patent. *Reed* v. *Cutter*, 1 Story, 597.—Story, J.; Mass., 1841.

19. It would be a fair construction of § 15 of the act of 1836, that if an inventor allow another, without objection, to use his invention for a time, before making an application for a patent, but afterward obtain a patent, that such public use would make the subsequently obtained patent void. But if such use is regarded as under an assumed license, the patent might still be regarded valid. *McClurg* v. *Kingsland*, 1 How., 208.—Baldwin, J.; Sup. Ct., 1843.

20. § 7 of the act of 1839, allowing the use and sale of an invention, for two years before the application for a patent, is in the nature of a statute of limitations; and the defendant setting up a sale more than two years before, must establish the fact of such a sale, in a manner that will justify a jury in taking away the property of the plaintiff. *Hovey* v. *Henry*, 3 West. Law Jour., 155.—Woodbury, J.; Mass., 1845.

21. The prior use or sale of an invention, referred to in § 7 of the act of 1839, has exclusive reference to an original application for a patent, and not to a renewal or reissue of it. *Stimpson* v. *West Chest. R. R.*, 4 How., 403.—McLean, J.; Sup. Ct., 1845.

22. It is clear that under the act of 1836, and the act of 1839, a use, in order to defeat a prior invention, must be public, and with the consent of the inventor, and continue two years. *Allen* v. *Blunt*, 2 Wood. & Min., 143.—Story, J.; Mass., 1846.

23. Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during the application for a patent, is such a use as will defeat a patent. *Sparkman* v. *Higgins*, 1 Blatchf., 209.—Betts, J.; N. Y., 1846.

24. An inventor may *forfeit* his right to a patent, if he constructs and vends his invention to others for use, or uses it publicly at any time prior to two years before he makes application for a patent. That is, he is not allowed to derive any benefit from the sale or use of

his machine without forfeiting his right, except within two years prior to the time of his application. *Pitts* v. *Hall*, 2 Blatchf., 235.—NELSON, J.; N. Y., 1851.

25. Such use however must be by the inventor himself publicly, in the ordinary way of a public use of the machine, and not by way of experiment, and with a view to further improvements, or of ascertaining its defects. *Ibid.*, 235, 236.

26. This ground of forfeiture is not favored in law; the evidence must be quite clear that the use was not by way of experiment, or for the purpose of perfecting a machine, in order to justify the conclusion that the patentee had forfeited his right to the improvement. *Ibid.*, 237.

27. Under the act of 1839, an inventor may use his improvement, by making and using his machines, and by vending and taking pay for them, for two years previous to his application for a patent, without forfeiting the benefits conferred upon him by his patent. But if an inventor either sells a machine or uses one, or puts one into public use, at any time more than two years before his application, it works a forfeiture of his right to a patent. *McCormick* v. *Seymour*, 2 Blatchf., 254.—NELSON, J.; N. Y., June, 1851.

28. How far the use of an invention for a time, so long as it could be kept a secret, and securing a patent only when there was danger of discovery, would invalidate a patent granted; *query*. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

29. The use of an invention which will operate as a forfeiture, must be the use of the perfected invention—the invention complete. If the use be experimental, to ascertain the value, or the utility, or the success, of the thing invented, by putting it into practice by trial, such use will not deprive the patentee of his right to the product of his genius. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst.; 3d Ser., 322.—NELSON, J.; N. Y., 1855.

30. An absolute sale by an inventor of his invention to another, is equivalent to a public use of his invention with his consent, and the inventor cannot, by a repurchase of his invention, resume any rights he may have lost by such a sale. *Hunt* v. *Howe*, MS. (App. Cas.) —MORSELL, J.; D. C., 1855.

31. Unless the use of an invention exceeds two years before an application for a patent, there is no abandonment. *Heinrich* v. *Luther*, 6 McLean, 347.—McLEAN, J.; Ohio, 1855.

32. The sale of an invention for more than two years before an application for a patent, bars the applicant under § 7 of the act of 1839, of his right to a patent. *Rugg* v. *Haines*, MS. (App. Cas.) —MORSELL, J.; D. C., 1855.

33. Both before and since the act of 1839, an inventor might exercise and put in use his invention, or his claim to an inchoate right to an invention, which was capable of being perfected to an exclusive right, by obtaining letters patent. *Sargent* v. *Seagrave*, 2 Curt., 555. —CURTIS, J.; R. I., 1855.

34. Before the act of 1839, he could, by way of experiment, bring the knowledge of his invention before the public, at the same time making known that he was about to apply for a patent. Since the act of 1839, he may sell any number of his machines to the public, during any period less than two years, accompanied by a claim to the inchoate right sufficient to show an intention not

to abandon it to the public. *Ibid.*, 555.

35. No knowledge or use of an invention, by any one, will deprive the first and original inventor thereof of the exclusive right to make and use the same, unless such knowledge and use was for more than two years prior to the application for a patent. *Sickles* v. *Mitchell*, 3 Blatchf., 550.—INGERSOLL, J.; N. Y., 1857.

36. As to the use of an invention under § 7 of the act of 1839, for more than two years before the application for the patent, where there has been more than one application, the two years must date from the time of the filing of the first application, at least if such first application has not been withdrawn. *Bell* v. *Daniels*, 1 Fisher, 377.—LEAVITT, J.; Ohio, 1858.

37. Where an application was made in January, 1838, to which objection was made, and afterward an amended specification was filed, upon which a patent was issued in March, 1840, *Held*, that the two years dated from the first filing. *Ibid.*, 377.

38. Where a party filed a caveat in 1847, made his application in 1851, which was rejected, and withdrew his application in 1852, and in 1857 made a new application for a patent, for the same invention; but it appeared that he had been manufacturing and selling his invention for more than two years before his last application, *Held*, that he had abandoned his invention, and could not receive a patent. *Mowry* v. *Barber*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

39. § 7 of the act of 1839, gives to inventors the privilege of a prior use for two years; but it thereby limits such use to two years, and precludes a public use for a longer period. *Shreeve* v. *United States*, MS.—LORING, J.; Ct. Claims, 1859.

40. Under the act of 1839, the right to a patent is forfeited only where the invention has been in use more than two years before the *application*, and not before the granting of his patent. *Adams* v. *Jones*, 1 Fisher, 530.—GRIER, J.; Pa., 1850.

41. If a party allow his invention to go into public use, or sell it, for more than two years before he makes application for a patent, he is not entitled to receive a patent. *Cowperthwaite* v. *Gill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

42. The putting on sale—out of the possession or control of the inventor—without limit or restraint as to public or private use, an invention more than two years before application for a patent, though some of the articles may have been sold on condition, with the right to return them; *Held*, such a sale as bars the inventor under § 7 of the act of 1837, to a right to a patent. *Seeley* v. *Bean*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

43. Under the act of 1836, the use of an invention, by a single person, or a sale of the thing invented to a single person, might amount to such a public use, with the consent or allowance of the patentee, as would forfeit his right to a patent. § 7 of the act of 1839, provided a remedy for cases where the conduct of the party did not show an actual abandonment. *Sanders* v. *Logan*, 2 Fisher, 173.—GRIER, J.; Pa., 1861.

44. The use of several machines in public, for more than two years prior to applying for a patent, although slightly varying in form and arrangement, yet substantially the same as afterward patented, cannot be alleged to be ex

perimental, so as to avoid the legal consequences of such prior use. *Ib.*, 173.

45. The obvious construction of § 7 of the patent act of 1839, is that a purchase, sale or prior use, within two years before applying for a patent, shall not invalidate, unless it amounts to an abandonment to the public. *Ibid.*, 173.

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## PROFERT.

See PLEADING, C.

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## PUBLIC USE.

1. 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 cannot debar another person from an invention or patent of it. *Adams* v. *Edwards*, MS.——J.; Mass., 1848.

2. A public use need not be a general use by the community. It must be used, however, and used openly, so that the structure and *modus operandi* are apparent. *Ibid.*

3. A public use, as meant by the statute, is a use in public—it need not be generally adopted by the public. Public is not equivalent to general, but distinguished from secret use—used in a public manner. *Hunt* v. *Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

4. An absolute sale by an inventor of his invention to another, is equivalent to a public use of his invention with his consent, and the inventor cannot, by a repurchase of his invention, resume any rights he may have lost by such a sale. *Ibid.*

5. The *public use* referred to in § 7 of the act of 1836, means *public* as opposed to *secret*, a use *in public* and not *by* the public. *Ellithorpe* v. *Robertson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

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## PUBLIC WORK, OR PRINTED PUBLICATION.

See also PRIOR KNOWLEDGE AND INVENTION.

1. A report of a company describing a thing patented cannot be read in evidence, under the provisions of the patent law, § 6 of the act of 1793, as it is a private not a public work. *Pennock & Sellers* v. *Dialogue*, 4 Wash., 545.—WASHINGTON, J.; Pa., 1825.

2. Where the defence that a machine claimed to be essentially similar to that of the plaintiff is set up, and the proof relied on is a description of such machine contained in a written publication, such description must be sufficiently full and precise to enable a mechanic to construct it, and must be in all material respects like that covered by or described in the plaintiff's patent. *Parker* v. *Stiles*, 5 McLean, 61, 62.—MCLEAN, J.; Ohio, 1849.

3. If the thing invented or discovered has been described in any foreign publication before the invention of the patentee, it will be fatal to his right. This goes upon the presumption, if such foreign publication has been made, the patentee may have acquired a knowledge of it. And this presumption is not rebutted by proving, so far as a negative can be proved, that the inventor had no knowledge of it. *Allen* v. *Hunter*, 6 McLean, 314.—MCLEAN, J.; Ohio, 1855.

4. A public work or printed publica-

tion may be proved, as to its contents, and the fact of publication, by the production of the book, or by parol testimony. *Ibid.*, 314.

5. A book introduced in evidence under § 15 of the act of 1836, to prove that the invention of the plaintiff had been described, before the discovery thereof by the patentee, is not evidence of any other facts or matter contained in it, beyond the description of the invention referred to. *Seymour* v. *McCormick*, 19 How., 107.—NELSON, J.; Sup. Ct., 1856.

6. A patent will not be avoided, by the mere fact that the invention or discovery patented had been known and used in a foreign country, before the discovery of the patentee, provided the patentee at the time of his application for a patent (act of 1836, § 15) believed himself to be the first and original inventor of the thing patented. *Bartholomew* v. *Sawyer*, 4 Blatchf., 350.—INGERSOLL, J.; N. Y., 1859.

7. The description of an invention in any public work, to invalidate a patent, should be, to some degree, in the nature of a specification, so far as to enable a mechanic skilled in the art to construct the machine; they should not be vague references to or suggestions of the thing described. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

8. To render admissible in evidence under § 15 of the act of 1836 a printed publication, it is not necessary to make proof of the date of its publication. A book purporting on its title-page to be published in "London in 1840," was admitted without other proof of publication being required. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

9. A book of plates, unaccompanied by any description whatever, cannot be received in evidence under § 15 of the act of 1836. *Semble*, that it is not a "printed publication." 1 Fisher, 19.

10. Under the laws concerning patents for inventions, a previous description of the alleged invention in a "public work," which means a printed book, defeats a patent. But such a description in an *unprinted* book has no such effect. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 65.—CADWALLADER, J.; Pa., 1860.

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## PUBLICATION OF BOOK OR MANUSCRIPT.

1. A sale of a book imports publication. It is to be presumed that the purchaser exercised his right to know the contents of the book, and make them known to others, or that an actual publication followed the sale. *Baker* v. *Taylor*, 2 Blatchf., 85.—BETTS, J.; N. Y., 1848.

2. Where copies of a book were sold prior to the deposit of the title-page in the clerk's office, *Held*, that such sale was evidence of the publication of the book at the time of sale. *Ibid.*, 85.

3. And where a printed copy of a book, then complete, was deposited in the clerk's office at the same time the title-page was deposited there, *Held*, that this fact warranted the inference of actual publication before the deposit of the title-page. *Ibid.*, 85.

4. The first publication of a work, without having secured a copyright, is a dedication of it to the public; that having been done, any one may republish it. *Bartlett* v. *Crittenden*, 5 McLean, 37.—MCLEAN, J.; Ohio, 1849.

5. An acquiescence in the publication

of a manuscript, or in the republication of a printed book, authorizes a presumption of assignment or abandonment. *Ibid.*, 41.

6. An author may license the publication of his manuscript. But unless a copyright is secured the first publication of it will abandon it to the public. *Pulte* v. *Derby*, 5 McLean, 332.—McLean, J.; Ohio, 1852.

7. An author may be said to be the creator or inventor, 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. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 228.—Grier, J., Pa., 1853.

8. But when he has published his book, and given his thoughts to the world, he can have no longer an exclusive possession of them. The author's conceptions have become the common property of the public. *Ibid.*, 228.

9. The acting or representation of a play is not a publication within the meaning of the statute. *Roberts* v. *Myers*, 13 Mo. Law Rep., 398.—Sprague, J.; Mass., 1860.

10. In the absence of any legislation for the special protection of dramatic literary property, an authorized public circulation of a printed copy of a drama, for which there is no legislative copyright, is a publication which legalizes a subsequent theatrical representation by anybody from such copy. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—Cadwallader, J.; Pa., 1860.

11. The intended meaning of the word *publication*, in the acts respecting copyrights, is publication *in print*. *Ibid.*, 44, 45, 65.

12. A publication of a composition is an act which renders its contents, in any mode or degree, an addition to the store of human knowledge. *Ibid.*, 77.

13. An *unqualified* publication dedicates it to the public. *Ibid.*, 78.

14. A *limited* publication of it is an act which communicates a knowledge of the contents to a *select few*, upon conditions expressly or impliedly precluding its rightful ulterior communication, except in restricted private intercourse. *Ibid.*, 80.

15. Any publication which is not restricted, both as to persons and purpose, is *general*. When the word *publication* is used without any express qualification, a *general publication* is meant. *Ibid.*, 80, 99.

16. A publication is not directly affected by printing, but follows it. *Ibid.*, 82.

17. The sale of a single copy only, of a first edition of a book, is a general publication. But in such a case, if its literary proprietor has possession of all the other copies, and of the manuscript from which they were printed, and wishing to suppress the publication, buys back the copy sold before it has been read, he must stand on the same footing as if he had never parted with it. That before he got it back the purchaser may have read it, can make no rational difference, unless the impression on the latter's memory may enable him to make ulterior publication. *Ibid.*, 93.

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## PURPOSE.

See also Effect; New Application.

1. Intent is no ground of a patent. *Kemper*, *Ex parte*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1841.

2. If the thing done be not new, tho

intent with which the act is done, cannot entitle it to a patent. *Ibid.*

3. 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, 411.—STORY, J.; Mass., 1843.

4. The application of a known thing to a new purpose, as the use of rivets to fasten parts of a shoe, instead of sewing, though such particular parts of the shoe had never before been so fastened, is not the subject of a patent. *Hazard* v. *Green*, MS. (App. Cas.)—CRANCH, Ch., J.; D. C., 1847.

5. The mere application of an old machine to a new purpose, is not patentable. *Tyler* v. *Deval*, 1 Code Rep., 30. —MCCALEB, J.; La., 1848.

6. A new application of a known principle to a new and useful purpose, by new mechanical contrivances and apparatus, as the application of the principle of the expansive and contracting power of a metallic rod, by different degrees of heat, to regulate the action of the damper of and the heat of a common stove, is the subject of a patent. *Foote* v. *Silsby*, 1 Blatchf., 464.—NELSON, J.; N. Y., 1849.

7. The application of a thing already known, to a new and useful purpose, may be the subject of a patent provided the new use is not analogous to the old, and requires the exercise of the inventive faculties. *Winans* v. *Schenec. & Troy R. R.*, 2 Blatchf., 293.—CONKLING, J.; N. Y., 1851.

8. Although two machines may be similar in appearance and arrangement, if the conditions under which they are to act are not alike—if the same service is not to be performed—if their *purpose* is different, and there is no identity of object or effect, they are not identical. *Emery*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

9. The object and purpose of two inventions may be referred to and taken into consideration in determining the question of identity between them. Where their object and purpose are entirely different, and material advantages result from one invention, it will be patentable, though it may have some resemblances to the other. *Barstow*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

10. The purpose or object had in view by an invention, may be considered in determining the question whether it is identical with another invention. *Hoyt*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

11. The mere use of a mechanical structure, before applied to a particular purpose (as a valve used on railway locomotives), for a different purpose, is not patentable; but if the valve be so changed as to be applicable to *all* engines, and producing a new and useful result, it is a patentable subject. *Judson* v. *Moore*, 1 Fisher, 556.—LEAVITT, J.; Ohio, 1860.

## REISSUE OF PATENT.

**A.** WHEN MAY BE HAD; BY WHOM; FOR WHAT..... 612
**B.** ACTION OF COMMISSIONER IN CASES OF 617
**C.** TO BE FOR SAME INVENTION AS THE ORIGINAL..... 618
**D.** VALIDITY AND FORCE OF, AND RIGHTS CONFERRED BY..... 622

E. EFFECT OF, ON ASSIGNEES, AND OTHERS, AND THEIR RIGHTS UNDER.....: 625

## A. WHEN MAY BE HAD; BY WHOM; FOR WHAT.

See also REISSUE, B.

1. A defective patent may be surrendered and a new patent taken for the unexpired part of the original term—for a term less than fourteen years. The restriction of time is on the *maximum* only, not on the *minimum*. *Sullivan's case*. Opin.; Gilpin's Ed., 1841, 168.—WIRT, Atty. Gen.; 1818.

2. Even under the patent laws of 1793, *Held*, that there was no good reason why on an *ex parte* application a patent could not be surrendered and cancelled of record in the department of state, if no misconduct be imputable to the patentee in taking it out: but the second patent should only be for the unexpired balance of the fourteen years. *Morris* v. *Huntington*, 1 Paine, 355, 356.—THOMPSON, J.; N. Y., 1824.

3. Previous to the act of 1836, a patentee had the right to surrender his patent and take out a new one, and on a trial the new patent was to be considered in the same light as if no other had been issued. *Grant* v. *Mason*, 1 Law & Int. Rev., 22.—THOMPSON, J.; N. Y., 1828.

4. A patent may be surrendered and a new one taken, including an additional improvement, and bearing the same date with the original patent. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen., 1831.

5. Under the patent act of 1793, the Secretary of State had power to receive a surrender of a patent, cancel the record thereof, and issue a new patent for the unexpired portion of the term, when the defect in the specification arose from mistake, without fraud or misconduct of the patentee. *Grant* v. *Raymond*, 6 Pet., 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

6. Its emanation, though not founded on the words of the law, is indispensably necessary to the faithful execution of the promise made by the government to reward the inventor. *Ibid.*, 242.

7. The holder of a defective patent may surrender it to the department of state and obtain a new one. The new patent has relation to the original transaction, and the application may be considered as appended to the original application. *Shaw* v. *Cooper*, 7 Pet., 314, 315.—MCLEAN, J.; Sup. Ct., 1833.

8. In regard to the right of a patentee to surrender a defective patent and take out a new one, there is no difference between a citizen and alien. *Ibid.*, 314.

9. An assignee of a patent cannot make a surrender of the patent and obtain a reissue without the co-operation of the original patentee. The assignee cannot swear to the invention, as specified in the new specification: no one but the inventor himself can make the oath required. *Goulding's Case*, 2 Opin., 572.—TANEY, Atty. Gen.; 1833.

10. Unless there be some error in the specification arising from inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, a patentee cannot surrender a patent which includes several distinct improvements and take out several new ones. *Anon.*, 3 Opin., 164.—BUTLER, Atty. Gen.; 1836.

11. An effort on the part of an inventor to include several distinct improvements in his first patent, and then to surrender it and take out several new

ones, so as to pay but one fee on the surrender, and thereby defraud the revenue, would be such a fraudulent design as to be within the law and destroy the right to surrender. *Ibid.*, 164.

12. There is nothing in the provisions of § 13 of the act of 1836, and § 8 of the act of 1837, as to the reissue of a patent, which requires the patentee to claim all things in the renewed patent which were claimed as his original invention, or part of his invention, in his original patent. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 439.—STORY, J.; Mass., 1843.

13. A specification may be defective and unmaintainable under the patent act, as well by an excess of claim as by a defect in the mode of stating it. *Ibid.*, 439.

14. But the inventor is always at liberty, in a renewed patent, to omit a part of his original invention if he deems it expedient, and to retain that part only of his original invention which he deems it fit to retain. *Ibid.*, 439.

15. 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 and extent and character of the invention. This latter is the common defect for which most renewed patents are granted. *Ibid.*, 440.

16. Under the acts of 1832 and 1836, no prior use of an invention under a defective patent can take away the right to surrender such patent and take out a new and amended one, or authorize a use under the renewed patent. *Stimpson* v. *West. R. Road*, 4 How, 402.—MCLEAN, J.; Sup. Ct., 1845.

17. A specification may be insufficient or defective under § 13 of the act of 1836, so as to allow a reissue, either by a mistake of law, as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact, in omitting things which are indispensable to the completeness and exactness of the description of the invention, or of the mode of constructing, or making, or using the same. *Allen* v. *Blunt*, 3 Story, 744.—STORY, J.; Mass., 1845.

18. The Commissioner of Patents can lawfully receive a surrender of letters patent for a defective specification, and reissue letters on an amended specification, after the expiration of the original patent, and during the existence of an extended term, and at any time during such term. *Wilson* v. *Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

19. The mode of issuing one set of new letters patent, for two or more different terms before existing, is of doubtful legality. The better 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 Wood. & Min., 262.—WOODBURY, J.; Mass., 1846.

20. If the specification is so uncertain, as to whether a particular thing is claimed as a part of a new combination, or as a new invention, as to be unintelligible, it is void, but it may be surrendered and amended. *Hovey* v. *Stevens*, 1 Wood. & Min., 302.—WOODBURY, J.; Mass., 1846.

21. The power to surrender a patent and take a renewal thereof is vested exclusively by § 13 of the act of 1836 in the patentee, his executors or administrators, their assignees, and the grantees of an exclusive right for a specified part of the United States; and there is nothing in the act restricting such right because of special or limited grants or li-

censes previously made. *Smith* v. *Mercer*, 4 West. Law Jour., 51, 52.—KANE, J.; Pa., 1846.

22. On the surrender and reissue under § 13 of the act of 1836, of a patent which has been extended, "the residue of the period then unexpired for which the original patent was granted," is the residue of the twenty-one years. The extended patent of twenty-one years is, in such case, to be regarded as the "original patent" within the meaning of § 13. *Gibson* v. *Harris*, 1 Blatchf., 169.—NELSON, J.; N. Y., 1846.

23. The surrender and reissue of a patent, extended by act of Congress to twenty-eight years, after it had been previously extended under § 18 of the act of 1836 to twenty-one years, stands on the same footing, as if such surrender and reissue were made in the case of the patent for twenty-one years, or as extended under § 18. There is no difference in principle. *Ibid.*, 169, 170.

24. Where a patent, which had been once extended under § 18 of the act of 1836, was afterward extended by act of Congress, and the patent was issued, in form, for the whole term of twenty-eight years from the date of the original patent, *Held*, that it was not invalid, but that in legal effect, it was a patent for the residue only of the period unexpired at the time it was issued. *Ibid.*, 170.

25. If a patent which has been twice extended is surrendered for a defective specification, and new letters taken with an amended specification, they may be taken for the whole twenty-eight years. *Woodworth* v. *Edwards*, 3 Wood. & Min., 126.—WOODBURY, J.; Mass., 1847.

26. Though the old specification had been adjudged good, yet if defective so as to be open to litigation, and thus somewhat "inoperative," the Commissioner may renew it, and the renewal will be of all for the twenty-eight years, and the granting of the reissued patent will be *prima facie* proof that the state of things justified the reissue, and that the specification relates to the same patent. *Ibid.*, 127–129.

27. There may be more than one surrender and reissue of the same patent. There is nothing in the patent acts, or in their policy, that limits the correction of errors to such as may have been the first discovered. *French* v. *Rogers*, 1 Fisher, 137.—GRIER, KANE, JJ.; Pa., 1851.

28. A reissue is granted in consideration of some more full or accurate disclosure, than that which had been made in the original specification, or some renunciation of an apparently secured right, and it is for the public interest that the surrender and reissue should be allowed to follow each other as often as the patentee is content to be more specific, or more modest in his claims. *Ibid.*, 137.

29. The surrender and the reissue, no matter how often they recur, are reciprocal—each in consideration of the other—and form together but a single act. If a reissue is invalid for want of authority to make it, the surrender is ineffective for want of authority to accept it. *Ibid.* 138.

30. The fact that things described in an original patent had been in public use, in the interval between the issue of the original and the reissue, does not prevent an inventor of the right to resume them in a reissue. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

31. The mistake of claiming too little, in the original patent, has an equal claim to correction with that of claiming too much. *Ibid.*

32. If an original patent include two inventions, and its validity on that account is doubted, a separate renewal is just and proper. *Ibid.*

33. § 13 of the act of 1836 contemplates two classes of cases, in which reissues may be granted. First, where a patent shall be *inoperative* and *invalid* by reason of a defective or insufficient description or specification: Second, where that objection arises, by reason of the patentee claiming in his own specification, as his own invention, more than he had or shall have a right to claim as new. *Ibid.*—DICKERSON, J.; N. J., 1852.

34. As to the first case, although the description or specification be clear and distinct to describe some improvement or invention, yet if it does not describe the particular invention intended to be described, it is inoperative and invalid, according to the sense of the law, and will justify a surrender and reissue. *Ibid.*

35. The right to surrender an 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. *O'Rielly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

36. Whether the defect be in the specification or claim, under § 13 of the act of 1836, the patentee may surrender his patent, and by an amended specification or claim, cure the defect. When the specification or claim are so vague as to be inoperative and invalid, an amendment may give it validity, and protect the rights of the patentee against subsequent infringements. *Battin* v. *Taggert*, 17 How., 83.—MCLEAN, J.; Sup. Ct., 1854.

37. The sole right to surrender under § 13 of the act of 1836, is given: 1. To the patentee, if he is alive, and has made no assignment of the original patent: 2. To the executors and administrators 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*, 4 Blatchf., 209.—INGERSOLL, J.; NELSON, J., concurring; Ct., 1858.

38. Where, however, there has been an assignment of an undivided part of the whole original patent, in such a case the assignee of such a part and the patentee 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. *Ibid.*, 209.

39. But a licensee, or one who has had transferred to him a less or different interest than either the interest in the whole patent, or an undivided part of such interest, or an exclusive sectional interest, has no legal right as assignee to surrender, and a surrender without his concurrence is valid. *Ibid.*, 210.

40. Under § 13 of the act of 1836, as to reissue, the Commissioner has no power to grant a reissue to alter the date of a previously granted antedated patent. *Cushman, W. M. C., Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.

41. The right to amend or correct the defects, either in the description of the schedule, or in the matter of the summary of the claim, by a surrender of an old patent, in order to a reissue, has its existence upon the broad principles of reason and justice, coeval with the authority to grant the protective, exclu-

sive right itself. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

42. The real question is between the inventor and the public—with the limitation or exception of fraud and deception toward the public—and as to the fair and equitable limits of the original invention, embracing all combinations, new and valuable, with their functions, so as in the best and most effectual manner to guard and protect this right from invasion by pretended inventors and pirates, and from the effect of subtle, refined distinctions. *Ibid.*

43. If to do this, it should become necessary to divide and subdivide the invention, the reason is very sufficient and within the provision of the law allowing the reissue of separate patents. *Ibid.*

44. It is not necessary to justify a reissue, that there should have been any adjudication upon the patent: the oath of the party as to the existence of the facts required for a reissue is enough. *Ibid.*

45. The statutes as to reissues are not to be considered as restraining, but as confirmatory of the principles laid down by the Supreme Court in *Battin* v. *Taggert*, 17 How., 83. *Ibid.*

46. Upon a reissue a party may claim that which in his original application he had disclaimed, provided the error arose from inadvertency, accident, or mistake. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

47. A statement in an original patent that a part is old, or a disclaimer of a part, does not necessarily prevent such part being claimed in a reissued patent, though it seems it would have that effect if made advisedly, and not by inadvertence, accident, or mistake. *Laidley* v. *James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

48. § 13 of the act of 1836, gives to the patentee a right to correct his description or specification, when its imperfection has arisen from inadvertency, accident, or mistake. *Moffitt* v. *Garr*, 1 Fisher, 613.—LEAVITT, J.; Ohio, 1860.

49. But the only condition on which this can be done is, that the original patent is *inoperative or invalid* by reason of a failure to comply with the requirements of the statute. The proceeding is therefore equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling a patentee to an action for its infringement. *Ibid.*, 613.

50. An application for a reissue may be made by the assignee of an original inventor. *Selden, Assignee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

51. Upon an application for a reissue, under § 5 of the act of 1837, asking for several reissued patents, each division or separate patent asked for, is not such a separate case as to require the payment of $25.00 on an appeal to the judges; but one appeal carries up the *whole* case, not a part; and notwithstanding that separate reissued patents may be granted. *Ibid.*

52. Under § 13 of the act of 1836, but one reissued patent was allowable, but the party obtaining such reissue had the right of division of the subject, in his specification, that he now has. *Ibid.*

53. The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patentee from embracing the part so disclaimed in a reissue of his patent. *Hayden, Ex parte*,

MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

54. Inadvertence and error may occur, as well in a disclaimer as in a claim, and whenever such a mistake occurs, it may be cured by a reissue. *Poppenheusen* v. *Falke*, 4 Blatchf., 499.—INGERSOLL, J.; N. Y., 1861.

55. A patent obtained by an alien, upon an oath, ignorantly or inadvertently made, that he is a citizen of the United States, is void and not voidable only. The true representation of citizenship, is a condition precedent to the issue of the patent. *Mini's Assignee*, v. *Adams*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

56. Such a mistake does not fall within such "defective or insufficient description or specification" as will allow the Commissioner, under § 13 of the patent act of July 4th, 1836, to receive a surrender of the old patent and grant a reissue. *Ibid.*

57. Neither has that officer any such inherent or judicial power as will, independently of the act, enable him to grant a reissue in correction of the applicant's mistake. *Ibid.*

## B. ACTION OF COMMISSIONER IN CASES OF.

1. In the case of the surrender of a patent for a defective or insufficient specification, under the provisions of § 13 of the act of 1836, the Commissioner of Patents is to *decide* whether the invention claimed in the original patent and that claimed in the amended one are substantially the same. He is to inquire and ascertain whether the specification is definite or insufficient in point of law or fact, and whether the inventor has claimed more than he has invented, and in each case, whether the error has arisen from inadvertency, accident, or mistake, or with a deceptive or fraudulent intention. *Allen* v. *Blunt*, 3 Story, 744.—STORY, J.; Mass., 1845.

2. *Prima facie*, it must be presumed that the amended patent has been properly and rightfully granted by him. It may be doubted whether his decision is re-examinable elsewhere unless impeached on account of fraud or connivance between him and the patentee, or unless his excess of authority is manifest upon the very face of the papers. *Ibid.*, 744.

3. The Commissioner is presumed, in issuing new letters patent, to have discharged his duty faithfully and correctly. *Allen* v. *Blunt*, 2 Wood. & Min., 138.—WOODBURY, J.; Mass., 1846.

4. The issuing of new letters patent by the Commissioner of Patents, with an amended specification, is to be presumed to have been done correctly, on account of mistake or inadvertence in the description or specification for the same invention. *Ibid.*, 139.

5. But such inference or presumption in respect to identity is open to be contradicted by proper evidence, which should be submitted to the jury. *Ibid.*, 139.

6. The action of the Commissioner of Patents in the reissue of letters patent, is not re-examinable elsewhere, unless a clear case of fraud is made out. *Day* v. *Goodyear*, MS.—GRIER, J.; N. J., 1850.

7. It is the duty of the Commissioner of Patents to see that a reissued patent does not cover more than the original one. And it is to be presumed that it does not until the contrary appears. *O'Reilly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

8. The proceedings before the Commissioner of Patents, in the surrender and reissue of a patent, are not open for consideration except on the ground of fraud. *Battin* v. *Taggert*, 17 How., 84.—McLean, J.; Sup. Ct., 1854.

9. The power and duty of granting a new patent for the original invention, upon a lawful surrender of the old patent, is confided to the Commissioner of Patents. His decision is not re-examinable by the courts unless it is apparent upon the face of the patent that the Commissioner has exceeded his authority, or unless there is a clear repugnancy between the old and the new patent, or unless the new one has been obtained by collusion between the Commissioner and the patentee. *Potter* v. *Holland*, 4 Blatchf., 242.—Ingersoll, J.; Ct., 1858.

10. Under § 8 of the act of 1837, on an application for a reissue the question of joint or sole invention is open, as also priority of invention, laches, or any other legal cause which, on an original application, would lead the Commissioner to refuse a patent. *Wilson* v. *Singer*, MS. (App. Cas.).—Dunlop, J.; D. C., 1860.

### C. To be for same Invention as the Original.

1. Evidence is admissible to show that there are material differences between an original and a reissued patent, and to explain these differences. *Phil. & Tren. R. R. Co.* v. *Stimpson*, 14 Pet., 462.—Story, J.; Sup. Ct., 1840.

2. The question whether the original patent and the reissued one are or are not identical, for the same invention, is one which belongs to the province of a jury to decide, and with which the court will not meddle. *Carver* v. *Braintree Manuf. Co.*, 2 Story, 441, 442.—Story, J.; Mass., 1843.

3. Whether a reissued patent is substantially for a different invention from the first patent is a question of fact for a jury: but as by § 13 of the act of 1836 the Commissioner of Patents is authorized to issue a renewed patent, the inquiry afterward in regard to the surrender is limited to the fairness of the transaction—to the question of fraud in the surrender. *Stimpson* v. *Westchester R. R.*, 4 How., 404.—McLean, J., Sup. Ct., 1845.

4. If an amended specification describes a different improvement from that which was embraced in the original patent, the new patent will not thereby be invalidated. For the purpose of an injunction, if no more, the invention must be taken to be the same in both patents, after the Commissioner of Patents has so decided by granting a new patent. *Smith* v. *Mercer*, 4 West. Law Jour., 56.—Kane, J.; Pa., 1846.

5. A reissued patent is presumed to be for the same invention as that included in the original patent. But such inference or presumption in respect to identity is open to be contradicted by proper evidence, which should be submitted to a jury. *Allen* v. *Blunt*, 2 Wood. & Min., 139.—Woodbury, J.; Mass., 1846.

6. A patentee can legally take out a reissued patent for more than is described in the surrendered patent, if it does not exceed the actual discovery when the first patent was taken out. *Tatham* v. *Lowber*, Mir. Pat. Off., 146—Nelson, Betts, JJ.; N. Y., 1847.

7. A reissued patent, granted upon the surrender of a former patent, can only be for the same invention *claimed* in the original patent. *Battin* v. *Tag*

*gert*, 2 Wall., Jr., 102.—KANE, J.; Pa., 1851.

8. Where, therefore, a patentee in his patent granted in 1843, specified his invention to be for the manner in which he had *arranged and combined certain parts*, but did not specify that he had *invented* any of such parts, though in fact such was the case, and afterward, in 1849, surrendered his patent and took out a new one, in which he claimed a particular part, *Held*, that the part claimed in the reissued patent, having been in use for six years before it was claimed, had become public, and could not be reclaimed by the reissued patent of 1849. *Ibid.*, 102. [Reversed, *post* 15.]

9. § 13 of the act of 1836, allowing the patentee to make his specification more accurate, and § 7 of the act of 1837, providing for restricting a claim too broad, do not apply to and help such a case. *Ibid.*, 102.

10. It is not the meaning of the law that the patentee, in his reissue, must describe and claim just what was described and claimed in his original patent. His new specification must be of the same invention, and his claim cannot embrace a different subject matter from that which he sought to patent originally; but unless the correction contemplated by the statute is narrowed down to a mere disclaimer, the corrected specification must be broader than the original one. *French* v. *Rogers*, 1 Fisher, 138.—GRIER, KANE, JJ.; Pa., 1851.

11. An applicant for the reissuing of a patent is not bound to describe or claim all that he described or claimed in his original patent; but he may not describe or claim any new or other improvement. *Goodyear* v. *Day*, MS.—DICKERSON, J.; N. J., 1852.

12. It is to be presumed that the reissued patent does not cover more than the original one. *O'Reilly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

13. Variations from the description given in the former specification do not necessarily imply that it is for a different discovery, as the right to surrender is 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 the first. It necessarily varies from it. *Ibid.*, 112

14. The reissued patent must be for the same invention substantially, though it be described in terms more precise and accurate than in the former patent But a new and different invention can not be claimed. *Battin* v. *Taggert*, 17 How., 82.—McLEAN, J.; Sup. Ct., 1854.

15. By the defects provided for in the statute, nothing passes to the public from the specifications and claims within the scope of the patentee's invention. The describing a part of a machine in the first patent, but without making any claim to it, does not deprive the inventor of a right to a patent for such part. *Ibid.*, 84.

16. The jury are to judge whether the renewed patent is for the same invention as the original one. *Ibid.*, 85.

17. Whether a reissued patent is for the same invention as the original one is a question of fact for a jury. *Heilner* v. *Battin*, 27 Penn., 521, 524.—WOODWARD, J.; Pa., 1856.

18. Though an action is founded on a reissued patent, the rights of the plaintiff must rest upon the discovery described in the original patent. Whatever may be the language of the reissued patent, it imparts no right not contained in the first grant. The

privilege the law gives by means of the reissue is 'to rectify any errors or deficiencies in the first specification. *Smith* v. *Higgins*, MS.—BETTS, J.; N. Y., 1857.

19. The legal presumption is, from the action of the Patent Office, that a reissued patent is for the same invention as the original patent. *Hussey* v. *Mc Cormick*, 1 Fisher, 515.—MCLEAN, J.; Ill., 1859.

20. With respect to reissues, § 13 of the act of 1836 and § 5 of the act of 1837 are to be taken together in construction, and the most just and equitable extent to which the terms of the law in its true spirit will admit of ought to be adopted. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

21. If the patent is defective or insufficient, either in the specification or claim, the patentee has a right, if he desires it, in the absence of fraud and deception, on complying with the other requisites, to have a reissue of patents for each distinct and separate part, effectually to cure the defect in the mode of stating it. *Ibid.*

22. And he has a right to *restrict* or enlarge his claim so as to give it operation and to effectuate his invention. *Ibid.*

23. The patentee, in his reissue, is entitled to every advantage within the full scope of his invention. *Ibid.*

24. And on an application for a reissue, a new function developed by the combination of different elements of the invention, will not be considered new matter. *Ibid.*

25. Upon an application for a reissue, the original model may be referred to as evidence of the extent of the true invention, and the patentee is not necessarily confined to the original *record*, *i. e.*, the patent and specification, of his first patent, as would seem to have been the practice of the Patent Office, under its rule 44. *Ibid.*

26. If there is a defect in the *original patent* and its specification, as to the nature and extent of the invention, the applicant may go outside of these and resort to the next highest evidence —the model—to show the defects complained of. *Ibid.*

27. A reissue is prohibited, both by the law and the rules of the Patent Office, for any thing save the same invention which was described or shown in the original patent—that is, described in the specification or shown in the model or drawing. *Dietz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

28. What the legislature designed to secure to patentees by § 13 of the act of 1836, was to enable them to *cure honest mistakes*, and to get *substantially protection* for the *same invention* they had made and *intended* to be patented when the original patent was granted. The only limitation in the statute is, that the invention should be the same. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

29. The legislature has not said by what proof the applicant shall show that his invention, claimed on reissue, is the same invention made and intended to be patented on his original application. He is not limited by the statute to prove it by the specification, models, or drawings; any legal proof to show it to be the same invention, whether found in the record or *aliunde*, ought to be received and weighed by the Patent Office. *Ibid.*

30. No authority is given to the Patent Office to limit the range of the applicant's proof, if it is such as upon the

law of evidence is held sufficient to prove facts before other legal tribunals. *Ibid.*

31. An original applicant has no right, by law, to an amendment of his specification, except by § 7 of the act of 1836, to conform his specification to the alterations suggested by the Commissioner. But an amendment in the case of a reissue is different; it is not of *grace*, but of *right*. *Ibid.*

32. § 13 does not point to the model and drawings as the *sole* means of proof, or to any means of proof; the whole matter of proof is left at large. It requires that the invention sought to be introduced in the amended specification, should be the *same invention* originally intended to be patented, and is silent as to *how* that is to be ascertained. *Ibid.*

33. The applicant is to prove the invention sought to be covered by his reissue, to be the same intended to be originally patented, but the *quo modo* of proof is not defined, and of course it is open to the patentee to offer any *sufficient legal proof*, record or otherwise. *Ibid.*

34. The gist of the applicant's invention was to give a differential motion or variable speed to the stripper so called, by which at one time, the stripper, by having a motion faster than the main cylinder, cleaned the main cylinder of the cotton imbedded in it, in the process of carding, and then when the stripper was filled with the cotton, its movement was rendered slower than that of the main cylinder, by which such main cylinder became the stripper of the stripper, and these changes were made without stopping the machine; but the original specification described only the *fast* movement of the stripper, and not the slow motion; *Held*, on an application for a reissue, that the applicant could go outside of his original specification and the drawings and model of his patent, and show by other proof that his invention, at the time of the original patent, was such as he sought to protect by his reissue, and that he could cover in his reissue what was his original invention. *Ibid.*

35. Rule 45 of the Patent Office as to reissues, is general in its terms, and properly so. It does not profess to be without an exception. It states what may be the subject of a reissue, not what shall not be. It does not prescribe that the mode mentioned therein shall be the sole and only mode of showing the invention to be the same invention. *Ibid.*

36. The presumption arising from the matured specification of a patent is that the patentee has described his invention in clear and unequivocal language, though such presumption may be overcome by evidence in favor of the party, upon the allegation of mistake or inadvertence, upon a claim for a reissue. *Collins* v. *White*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

37. A patentee on an application for a reissue, may claim all those devices which were clearly exhibited in his original specification, drawings, and model, and which he might have legally claimed at the time of taking out his original patent. *Wilson, Assignee of Aiken & Felthousen*, v. *Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

38. There can be embraced in a reissue, only what was invented *before* or *at the time* of the grant of the original patent; what was then invented and *omitted* to be put in the original patent by accident or mistake, and without any fraudulent or deceptive intention, and *only* such *invention* is, *by law*,

the subject of a reissue. *Dyson* v. *Gambril & Burgee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

39. The cases of *Battin* v. *Taggert*, 17 How., 85 (1854), and *Carver* v. *Braintree Manuf. Co.*, 2 Story, 441 (1843), do not sustain the position that the question whether a reissued patent is for the same invention as the original patent, is one of fact, which can *only* be determined by a jury. The power of a court of equity to pass upon such fact is not touched by them. *Poppenheusen* v. *Falke*, 4 Blatchf., 406.—SHIPMAN, J.; N. Y., 1861.

40. If, however, such question is involved in considerable doubt, that might be a reason why it should be sent to a jury. *Ibid.*, 497.

41. Though the decision of the Commissioner of Patents that the reissued patent is for the same invention as the original, is, as a general rule, at least *prima facie* evidence of its truth, it is not conclusive when doubts are raised in the minds of the court by an examination of the instruments themselves. *Ibid.*, 497.

## D. VALIDITY AND FORCE OF, AND RIGHTS CONFERRED BY.

See also REISSUE, B.

1. Whether a reissued patent confers any right is a question for judicial decision. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen.; 1831.

2. In the case of a surrender of a patent for a defect arising from inadvertence and mistake, and a reissue, the new patent and the proceedings on which its 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. The second patent cannot in any respect be considered as independent of the first. *Grant* v. *Raymond*, 6 Pet., 244.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. A reissued patent granted upon the surrender of the first one is only a continuation of the original patent. *Ames* v. *Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833.

4. A reissued patent has relation to the original transaction of the issuing of the first patent; and being only a continuation of the first one, the rights of the patentee are to be ascertained by the law under which the original application was made. *Shaw* v. *Cooper*, 7 Pet., 315.—MCLEAN, J.; Sup. Ct., 1833.

5. Under § 13 of the act of 1836, a second patent with corrected specifications has relation back to the emanation of the first patent, as fully for every legal purpose, as to causes subsequently accruing, as if the second patent had been issued at the date of the first one. *Stanley* v. *Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839.

6. The second patent legalizes the rights of the patentee from the date of the first patent. *Ibid.*, 38.

7. If a patent which was invalid by reason of a defective specification, is surrendered, and a new one taken out, the second patent relates back to the date of the original patent. *Smith* v. *Pearce*, 2 McLean, 176.—MCLEAN, J.; Ohio, 1840.

8. It is not necessary that a reissued patent should contain any recitals that the prerequisites to the grant of it—as that it was reissued for errors arising not from inadvertency, accident, or mistake—have been duly complied with, for the law makes the presumption that

they have been. *Phil. & Tren. R. R.* v. *Stimpson*, 14 Pet., 458.—STORY, J.; Sup. Ct., 1840.

9. The presumption of right in a patentee, because of the acquiescence of the public in his claim, is not changed in consequence of the original patent being surrendered on account of its informality. The original patent was not void, but was efficacious to preserve the right of the patentee, which would have been lost had the invention been used without a patent. *Orr* v. *Badger*, 7 Law Rep., 468.—SPRAGUE, J.; Mass., 1844.

10. The grant of an amended patent by the Commissioner of Patents, is conclusive as to the existence of all the facts necessary for a reissue, unless it is apparent on the face of the patent itself, without any auxiliary evidence, that he was guilty of a clear excess of authority, or that the patent was procured by fraud between him and the patentee. *Allen* v. *Blunt*, 3 Story, 745.—STORY, J.; Mass., 1845.

11. The decision of the Commissioner of Patents, in accepting the surrender of an old and granting a new patent, is not re-examinable elsewhere, unless it is apparent from the face of the patent, that he has exceeded his authority, or there is a clear repugnancy between the old or new patent, or the new one has been obtained by collusion between the Commissioner and the patentee. *Woodworth* v. *Stone*, 3 Story, 753, 754.—STORY, J.; Mass., 1845.

12. No prior use of a defective patent can authorize the use of the invention after the emanation of a renewed patent. Any person using an invention protected by a renewed patent, subsequently to the date, is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent. *Stimpson* v. *West-Chester R. R.*, 4 How., 402, 403.—MCLEAN, J.; Sup. Ct., 1845.

13. The decision of the officers of the government in granting a renewed patent, by reason of a defective or insufficient specification, &c., is *prima facie* evidence that the claim for a renewal was within the statute; and conclusive, except as to fraud. The inquiry as to the surrender, is limited to the fairness of the transaction. *Stimpson* v. *West R. R.*, 4 How., 404.—MCLEAN, J.; Sup. Ct., 1845.

14. In whatever manner the mistake or inadvertence may have occurred is immaterial. The action of the government in renewing the patent must be considered as closing this point, and as leaving open for inquiry the question of fraud only. *Ibid.*, 404.

15. A reissued patent, with an amended specification, operates, except as to suits for violations commenced before the amendment, from the commencement of the original term. *Woodworth* v. *Hall*, 1 Wood. & Min., 257.—WOODBURY, J.; Mass., 1846.

16. It is 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 did. *Ibid.*, 257.

17. Recoveries under the original patent are evidence after the new letters and new specification, to strengthen the title of the patentee so as to obtain an injunction, thus regarding the patent as one and the same. *Ibid.*, 257.

18. A renewal of a patent with an amended specification, is presumed to have been made legally, that is to correct a mistake, or inadvertence, and for the same invention; but this presump-

tion may be rebutted by evidence. *Allen* v. *Blunt*, 2 Wood. & Min., 139.—WOODBURY, J.; Mass., 1846.

19. But whether the decision of the Commissioner is conclusive to the extent laid down in *Allen* v. *Blunt*, 3 Story, 745 (*ante* 10); *query*. *Ibid.*, 139.

20. Whether a reissued patent may unite several before existing terms—as terms of fourteen and seven, and seven years, in one patent, for twenty-eight years; *query*. *Woodworth* v. *Hall*, 1 Wood. & Min., 400.—WOODBURY, J.; 1846.

21. If such a renewal is void, the surrender of the former patents is likewise void, but perhaps recoveries may be had on the original patents, as if never attempted to be consolidated. *Ibid.*, 400.

22. Such a consolidated reissue was upheld by the Supreme Court, 4 Howard, 646, *Wilson* v. *Rosseau*, but no objection was there raised to such a practice. *Ibid.*, 400.

23. If a renewal is not valid, the surrender which led to it will also be invalid, and the old letters will be considered in full force, and violators may be prosecuted under such old patent, with the old specification. *Woodworth* v. *Edwards*, 3 Wood. & Min., 127.—WOODBURY, J.; Mass., 1847.

24. Whenever the power of reissue has been fraudulently or corruptly abused, the renewal will be avoided. *Ibid.*, 129.

25. Upon the surrender and reissue of a patent, the corrected patent is made to all cases of infringement subsequently accruing, as though it had been so issued originally, and even though the original patent was invalid. *Bloomer* v. *Stolley*, 5 McLean, 166.—MCLEAN, J.; Ohio, 1850.

26. In ordinary cases of reissue, the Commissioner's action has more than *prima facie* influence in deciding the question of identity of invention. *French* v. *Rogers*, 1 Fisher, 139.—KANE, J.; Pa., 1851.

27. A reissued patent is not void, because the things claimed in the original had been in public use in the interval between the original and reissued patent. Such a publication is not an abandonment or dedication. *Goodyear* v. *Day*, MS.—DICKERSON, J.; N. J., 1852.

28. The fact of procuring a patent for a new and useful machine, under the assumption of a reissue, which was not useful as patented in the surrendered patent, for want of some parts, used in the reissued patent, would present a question of fraud, committed on the public by the patentee, by giving his reissued patent date as an original discovery, made at the time of the original patent, and thereby over-reaching similar inventions made between the time of the original patent and the time of the reissued patent. *Brookes* v. *Fiske*, 13 How., 220.—CATRON, J.; Sup. Ct., 1853.

29. A reissued patent, which has been obtained upon the surrender of the former patent, under § 13 of the act of 1836, is not a new patent, nor does it confer any new and distinct right; and an existing contract concerning the patent, made before the surrender, applies equally to the reissued patent. *McBurney* v. *Goodyear*, 11 Cush., 571.—MERRICK, J.; Mass., 1853.

30. There is a marked and well recognized difference between a *renewed* and a *reissued* patent. The former grants a wholly new term, the latter legalizes and confers the right during the continuance of the original term. *Ibid.*, 571.

31. A contract concerning a patent, made before its surrender, applies equally to the reissued patent. A reissued patent is not a new patent. *Ibid.*, 571.

32. In an action for infringement on a reissued patent, proof of use of the thing patented, during the interval between the original and reissued patents, will not defeat the action. *Battin* v. *Taggert*, 17 How., 84.—McLean, J.; Sup. Ct., 1854.

33. A reissued patent is considered as if granted at the date of the original one. It is no defence to an action upon the reissued patent, that the defendant's machine was made and put up during the original patent, under which he was not liable to an action for an infringement. *Carr* v. *Rice*, 1 Fisher, 211.—Betts, J.; N. Y., 1856.

34. After a patent has been surrendered, an action cannot be maintained for damages for an infringement occurring under the old patent, before the surrender. *Moffitt* v. *Garr*, 1 Fisher, 613.—Leavitt, J.; Ohio, 1860.

## E. Effect of, as to Assignees and others; and their rights under.

1. A patentee cannot, by a surrender of his patent, affect the rights of third persons to whom he had previously, by assignment, passed his interest in the whole or a part of the patent, without the consent of such assignee. *Woodworth* v. *Stone*, 3 Story, 750.—Story, J.; Mass., 1845.

2. A surrender of letters patent renders void all assignments under such patent, so far as those are concerned who assent to such surrender. It is necessary that a prior assignee should have a new assignment, before he can maintain an action for an invasion of the patent. *Gibson* v. *Richards*, Index Pat. Dec., No. 376.—Nelson, J.; N. Y., 1845.

3. Amendments to a patent made on a reissue thereof, will inure to the benefit of the assignees and grantees under the patent as it stood before such reissue. *Smith* v. *Mercer*, 4 West. Law Jour. 52.—Kane, J.; Pa., 1846.

4. But such grantees may, if they prefer, rest their claims upon the specification as it stood when they purchased their right. *Ibid.*, 52.

5. A patentee cannot, by a surrender of his patent, affect injuriously the rights of third parties, to whom he has already passed an interest in his patent. They will share with him the benefits conferred by the reissue. *McBurney* v. *Goodyear*, 11 Cush. 571.—Merrick, J.; Mass., 1853.

6. It is not in the power of a patentee, by a surrender of his patent, to affect the rights of third persons, to whom he had previously passed his interest in the whole or a part of the patent, without their consent. Such consent may be manifested by joining in the surrender, or previously authorizing it, or subsequently ratifying, or approving it; and taking advantage and benefit of it would be a ratification. And when so consented to, the rights of the party consenting, in and to the old patent, are forever gone. *Potter* v. *Holland*, 4 Blatchf., 214.—Ingersoll, J.; Nelson, J., concurring; Ct., 1858.

7. Such third parties, though *entitled* to the same right in the reissued patent, that they had in the old, are not however *compelled* to take under the reissued patent and give up the right had under the old one, but may hold under the old patent, if they choose the same

rights they had before the surrender. *Ibid.*, 214.

8. There may be one claim of right under one or the old patent, for one section of country, and a different claim of right under the reissued patent, to the same invention, for another section of country. *Ibid.*, 216.

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## REPAIRS OF PATENTED MACHINES.

See PATENTED MACHINES, A.

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## REPORTS.

1. No reporter has or can have any copyright in the written opinions of the judges of a court; nor can the judges confer on any reporter any such right. *Wheaton* v. *Peters*, 8 Pet., 668.—McLEAN, J.; Sup. Ct., 1834.

2. Though there cannot be any copyright in the opinions of the court, published under authority of law, a reporter may have a copyright in his own marginal notes, and in the arguments of counsel, as prepared and arranged by him. *Gray* v. *Russell*, 1 Story, 21.—STORY, J.; Mass., 1839.

3. The right of copyright belongs to the reporters of judicial decisions, in common with other authors, to the extent of their authorship in the composition of their works. *Little* v. *Gould*, 2 Blatchf., 170.—CONKLING, J.; N. Y., 1851.

4. But this does not comprise the written opinions of the judges, because of these the reporter is not the author, and the judges of a court cannot confer on him any copyright in the written opinions delivered by them. *Ibid.*, 170.

5. Judicial decisions are the property of the public, and therefore are not the subject of a copyright. *Little* v. *Gould*, 2 Blatchf., 362.—NELSON, J.; N. Y., 1852.

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## RESTRAINT OF TRADE.

1. An agreement between two partners in the manufacture of a patented article, that one would discontinue such manufacture, is not void as being in restraint of trade, and against the principles of public policy, but is simply an ordinary business arrangement. *Parkhurst* v. *Kinsman*, 1 Blatchf., 495.—NELSON, J.; N. Y., 1849. [Affirmed, *post* 3.]

2. A bond given to a patentee by one who has infringed on a patent, conditioned that he will not, during the continuance of the patent, manufacture or vend the patented article, is not void as being in restraint of trade. *Barry* v. *Clirhugh*, 12 Law Rep., 367.—JONES, Ch. J.; N. Y., 1849.

3. An agreement stipulating, that under certain conditions, one party shall cease the manufacture of a patented article, is not void as being in restraint of trade; such clause is but a provision for the prosecution of the business in a particular manner, and not for its restraint. *Kinsman* v. *Parkhurst*, 19 How., 293.—CURTIS, J.: Sup. Ct., 1855.

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## RESULT.

See "EFFECT;" PURPOSE.

## REVIEWS.

1. A reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purpose of fair and reasonable criticism. But if he thus cites the most important parts of the work, with a view, not to criticize, but to supersede the use of the original work, and substitute the review for it, such a use will be deemed, in law, a piracy. *Folsom* v. *Marsh*, 2 Story, 106.—STORY, J.; Mass., 1841.

2. Extracts, representing or embodying the spirit and force of a work, may be taken therefrom to a reasonable extent by a reviewer, for the purpose of showing the merit or demerit of the work. But this privilege cannot be so exercised as to supersede the original book. *Story* v. *Holcombe*, 4 McLean, 309.—MCLEAN, J.; Ohio, 1847.

3. Sufficient may be taken to form a correct idea of the whole; but no one is allowed, under the pretence of quoting, to publish either the whole or a principal part of another man's composition. A review must not, therefore, serve as a substitute for the book reviewed. *Ibid.*, 309.

4. If so much is extracted, that the article communicates the same knowledge as the original work, it is an actionable violation of literary property. *Ibid.*, 309, 310.

5. The abridgement of a work, for which a copyright has been secured, and which has been publicly circulated, is not an infringement of the statutory privilege; but such an abridgement would violate the right of the literary proprietor of a book of which the circulation had been private only. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 82.—CADWALLADER, J.; Pa., 1860.

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## RULES OF PATENT OFFICE.

1. The rules of the Patent Office as to taking evidence in contested cases, made by the Commissioner of Patents, under § 12 of the act of 1839, while they remain unabrogated, are as binding as the law itself; and upon the Commissioner himself, as upon others. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. After a deposition has been taken, while the rules were in force, a revocation of them cannot affect that deposition. A revocation only affects subsequent proceedings. *Ibid.*, 27.

3. The rule of the Patent Office, as to taking and transmitting testimony, and providing that no evidence, unless taken and filed in compliance with such rules, will be *considered* on the hearing of the case, in which taken, does not prohibit the Commissioner from *looking into* the deposition informally transmitted, or reading it, and ascertaining its contents, but only prohibits him from *considering* it as evidence touching the matter in issue. *Smith* v. *Flickenger*, MS. (App. Cas.)—CRANCH, Ch. J.: D. C., 1843.

4. If found informal, on such inspection, the Commissioner may, if he see fit, allow further time to correct the informality. *Ibid.*

5. The object of notice, required by the rules of the Patent Office, in the examination of witnesses, is to bring the adverse party before the examining officer, to give him an opportunity to cross-examine. But if the adverse party

comes, and is present, and cross-examines, notice and proof of service of it are of no account. *Gibbs* v. *Ellithorpe*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

6. The rules and regulations of the Patent Office, as to taking testimony in cases of interference, are binding upon the parties, and each is entitled to the benefits of them, and until abrogated, are as binding upon the Commissioner himself, as if enacted by the statute itself. *O'Hara* v. *Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

7. The rules of the Patent Office, as to the taking of depositions, give to either of the litigant parties, the right to take depositions, *without restraint*, up to the day of hearing fixed by the Patent Office, or to a day near enough to give time for the transmission of the evidence to the Patent Office. *Spear* v. *Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

8. The power granted to the Patent Office, under § 12 of the act of 1839, to make rules in respect to the taking of evidence, gives no right to make new rules of evidence, or to make new rules of law, or to divert vested rights, by its rules of practice. *Dyson*, *Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

9. The 26th rule of the Patent Office, providing that amendments of the model, drawings, or specification, must relate to the subject matter originally embraced in at least one of them, applies only to *original* applications, and not to cases of reissue. If it did, it would be void. *Ibid.*

10. The rule of the Patent Office confining reissues to the invention described or shown in the original patent is, cautious and general in its terms. It does not profess to be without an exception. It states what may be the subject of a reissue; not, what shall not be; and does not prescribe, that the mode mentioned therein shall be the sole and only mode of showing the invention to be the same invention. *Ibid.*

11. The practice of the Patent Office, under its rules, as to reissue, of confining the applicant to his original patent and specification, as the evidence of what was his original invention, is not correct, but reference may also be made to the model for a like purpose. *Ball*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

## SECRET USE OF INVENTION.

1. If an invention be the mere speculation of a philosopher or mechanician in his closet, and he takes no step toward securing a patent, but keeps his invention a secret, and another person, who is also an original but subsequent inventor of the same thing, obtain a patent for it, and bring it into use, the patentee in a suit at law will be considered the first inventor. *Hildreath* v. *Heath*, MS. (App. Cas.).—CRANCH, Ch. J.; D. C., 1841.

2. How far the use by the discoverer of his invention or monopoly so long as it could be kept a secret, and seeking a patent only when it was in danger of discovery, would invalidate the patent, *query*. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

3. The object of the patent laws being not only to benefit the inventor but also the public or community at large, by the use of the invention after the mo-

nopoly has terminated, it follows that an inventor who designedly and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the constitution or acts of Congress, and is not entitled to favor if during such concealment another person should find out and bring into use the same invention. *Kendall* v. *Winsor*, 21 How., 328.—DANIEL, J.; Sup. Ct., 1858.

4. If an inventor keep his invention a secret until another has discovered the same thing, and lie by while such other inventor makes application for a patent, and manufactures and sells the article invented, and neglects to give notice of his claim or make application for a patent, such first inventor will lose his right to a patent. *Savory* v. *Louth*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

5. A party has a right to keep his inchoate right to an invention concealed as long as he pleases—but when he desires to perfect his right to a patent, he must proceed with vigilance. *Ellithorpe* v. *Robertson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

6. The statutory bar, § 7 of the act of 1839, imposed upon the inventor who sells his invention for more than two years before his application for a patent, would seem by analogy properly applicable to the inventor who *secretes*. *Spear* v. *Stuart*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

7. The policy of the patent laws favors diligence and condemns neglect. It is the duty of an inventor *without delay* to patent his perfected invention. He has no right to use it himself, or permit others to use it, for any length of time, and then expect a monopoly from the public. *Marcy* v. *Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

8. There can be no doubt that where a party has made an invention and buried the secret in his own bosom, he may, after the lapse of years, come forward and, on making the secret known by an application for a patent, obtain a monopoly. *Berg* v. *Thistle*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

9. But if in the mean time another has made the same invention, and has obtained a patent, and the public has thereby become possessed of the discovery, when the first inventor applies he will be met with the inquiry whether he has used due diligence in communicating his discovery—in such case the first inventor forfeits his claim. *Ibid.*

10. If an inventor *conceals* his invention after it is complete, even though he never sold it for profit or introduced it to public use, he cannot claim a patent. *Loveridge* v. *Dutcher*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

11. An inventor who *designedly*, and with the view of applying it indefinitely and exclusively for his own profits, withholds his invention from the *public*, comes not within the policy or the objects of the constitution or acts of Congress. He does not promote but impedes the progress of science and the useful arts. *Ibid.*

12. The decision in *Spear* v. *Stuart* (*ante* 6), that the concealment of an invention for more than two years stands on no better footing than the sale of such invention before two years, considered and approved. *Ibid.*

13. A negligence, in secreting and failing to patent an invention for more than two years after its discovery, forfeits all right to claim a patent. Even the filing a caveat, if filed more than two years

after such discovery, will not save the rights of the inventor. *Snowden* v. *Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

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## SPECIFIC PERFORMANCE.

1. The fact, that the subject matter of a contract sought to be enforced is a patent right, does not of itself give the courts of the United States jurisdiction. A bill filed for the specific performance of such a contract must contain the proper averments as to the *character* of the parties, to show that the court has jurisdiction. *Burr* v. *Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

2. The Circuit Courts have no jurisdiction of an action as to enforce the specific execution of a contract respecting a patent, where the parties are all citizens of the same state: but where the plaintiffs set up a right under a patent, and allege that the defendants are infringing, citizenship will not oust jurisdiction. *Brooks* v. *Stolley*, 3 McLean, 525.—MCLEAN, J.; Ohio, 1845.

3. But where the court has obtained jurisdiction on the ground of infringement, it may then decide other matters which of themselves would not afford ground for the original exercise of jurisdiction. *Ibid.*, 529.

4. Under § 17 of the act of 1836, the jurisdiction of the Circuit Courts as to subject matter does not extend to a bill in equity filed for the specific performance of a contract to transfer a patent—the jurisdiction of such courts being confined to actions under the patent *laws* granting or confirming rights to inventors. *Nesmith* v. *Calvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845.

5. But if such a bill is filed against several defendants, some of whom are residents of the same state with the complainants, the bill may still be maintained against the defendants who are residents of another state. *Ibid.*, 37.

6. And if the bill prays for an injunction against the use of a patent, that may be a ground for exercising jurisdiction against all the defendants. *Ibid.*, 38.

7. Where a bill is filed to enforce the specific performance of a contract in relation to a patent, the Supreme Court has no appellate jurisdiction, unless the matter in controversy exceeds the value of two thousand dollars. *Brown* v. *Shannon*, 20 How., 56, 57.—TANEY, Ch. J.; Sup. Ct., 1857.

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## SPECIFICATION.

**A.** GENERAL PRINCIPLES OF CONSTRUCTION 630
**B.** HOW INVENTION TO BE DESCRIBED IN. 630
**C.** AMBIGUITY IN, AND EFFECT OF..... 636
**D.** CONCEALMENT IN, AND EFFECT OF.... 636
**E.** DEFECTS IN, HOW REMEDIED..... 637

### A. GENERAL PRINCIPLES OF CONSTRUCTION.

See PATENT, P. 1.

### B. HOW INVENTION TO BE DESCRIBED IN.

See also COMPOSITION OF MATTER, B.; IMPROVEMENT, B.; MACHINE, B.

1. Under the patent act of 1793, before a patent can issue, the inventor should so explain his invention, that others beside himself may understand and use it; more especially when the in-

vention is to relieve human misery, care should be taken to have a plain and thorough exposition of the art. A thing capable of doing good, if judiciously used, may be very pernicious if misapplied. *Perkins' Case*, 1 Opin., 64.—Lee, Atty. Gen.; 1796.

2. The thing for which a patent is granted, should be truly and fully described in the specification; but if this be done so as clearly to distinguish it from other things, and 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 will be 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., 198.—Washington, J.; Pa., 1813.

3. The description of the invention must be full, clear, and explicit, so as to distinguish it from all others of the same kind, and to enable any person skilled in the art, of which it is a branch, to make and use it. The description should be accommodated to the comprehension of any practical mechanic, without taxing his genius or inventive powers. *Gray* v. *James*, Pet. C. C., 401.—Washington, J.; Pa., 1817.

4. Whether a specification is defective within the interpretation of the law, must depend upon the evidence of those skilled in the science or art of the invention. *Ibid.*, 401.

5. The patentee must describe, in full and exact terms, in what his invention consists. If the description mixes up the old and the new, and does not distinctly ascertain for which in particular the patent is claimed, it is void. *Lowell* v. *Lewis*, 1 Mas., 187.—Story, J.; Mass., 1817.

6. The inventor must deliver a written description of his invention, in such full, clear, and exact terms, that any person acquainted with the art, may know how to construct and use it. The reasons for this requirement are, to guard the public against unintentional infringement of the patent, during its continuance, and to enable an artist to make the improvement, by a refer ce to some known and certain recorded authority, after the patent has run out. *Evans* v. *Eaton*, 3 Wash., 453.—Washington, J.; Pa., 1818.

7. Whether a patent be valid or not, must materially depend upon the accuracy and distinctness with which the invention is stated. *Moody* v. *Fiske*, 2 Mas., 118.—Story, J.; Mass., 1820.

8. A specification need not particularly describe the operation of mechanism which is well known by persons acquainted with the art. *Kneass* v. *Schuylkill Bank*, 4 Wash., 14.—Washington, J.; Pa., 1820.

9. Merely describing in the specification the parts of a thing, or the *modus operandi*, and as to which no claim is made, does not make such things a part of the patent. *Ibid.*, 14.

10. The specification should distinguish the new from the old, and point out in what the invention consists. The invention cannot be shown by testimony, nor can the jury infer it from examining the thing patented, and comparing it with others before in use. No description of the discovery secured by a patent, will fulfil the demands of justice and of law, but such as is of record, and of which all the world may have the benefit. *Dixon* v. *Moyer*, 4 Wash., 73.—Washington, J.; Pa., 1821.

11. Where the specification does not describe the invention, so as to show in

what respects the plaintiff's invention or improvement differs from what had been before known or used, the patent is void. *Langdon* v. *De Groot*, 1 Paine, 207.—LIVINGSTON, J.; N. Y., 1822.

12. The act of 1793, § 3, requires that the specification must describe the invention "in such full, clear, and exact terms," as to distinguish the same from all things before known. The specification has two objects: one, to make known the manner of constructing the invention, 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 object is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim any thing that is in common use, or 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., 434. —STORY, J.; Sup. Ct., 1822.

13. A specification which mixes up the new and the old, but does not explain what is the nature or limit of the invention claimed, cannot be sustained. *Ibid.*, 434.

14. The invention cannot be made out and shown at the trial, or be established by comparing the invention specified in the patent with former ones in use. *Ibid.*, 434, 435.

15. Both the language and policy of the act of Congress require, that the specification should be clear, plain, and intelligible, so that others may be taught by it to make or do the thing for which the patent is granted. The object of the specification is to inform the public, after the expiration of the term for which the patented is granted, what the invention is; and it ought therefore to put the public in possession of whatever is necessary to the use and enjoyment thereof. *Sullivan* v. *Redfield*, 1 Paine, 450.—THOMPSON, J.; N. Y., 1825.

16. It is a correct rule as to patents, that if the specification is sufficiently explicit in its details to enable a skilful machinist to construct the patented improvement or invention, without any other aid, it is not to be considered void because some of the minor details of the machine are not set forth at large. *Burrall* v. *Jewett*, 2 Paige, 142.—WALWORTH, Chan.; N. Y., 1830.

17. A patent is a bargain with the public, in which the same rules of good faith prevail as in other contracts, and if the disclosure communicates the invention to the public, the statute is satisfied. *Whitney* v. *Emmett*, Bald., 319. —BALDWIN, J.; Pa., 1831.

18. As the English statute does not require any specification, these rules and principles are matters of judicial construction, on which the English courts act without any statutory direction. But in the United States it is different, and the law is more explicit. As to the specification, nothing is left to construction, as to its requisites or purposes, both being so clearly defined, and in such a manner, as to leave no discretion in the courts to presume what was intended, to alter, or diminish. *Ibid.* 319, 320.

19. If from the patent, specification, drawings, model, and old machine, clear ideas are conveyed to men of mechanical skill in the subject matter, by which they could make, or direct the making of the machine, by following the directions given, the specification is good within the act of Congress. *Ibid.*, 322.

20. The patentee is bound to describe

with reasonable certainty, in what his invention consists, and what his particular claim is. But he is not bound to use any precise form of words. 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, 286, 287.—STORY, J.; Mass., 1840.

21. The specification must contain reasonable certainty—must describe the machine so as to enable a person skilled in the construction of machines, to build it—but it need not be so clear as to be understood by a person wholly unskilled in the art. *Brooks* v. *Bickwell*, 3 McLean, 260.—MCLEAN, J.; Ohio, 1843.

22. But the patentee need not state of what material every part of the machine should be made. The principle is the same, whether the parts are composed of wood or metal. *Ibid.*, 261.

23. The object of the law in requiring a full, clear, and exact description of the thing patented, is twofold: 1st, as the grant gives an exclusive right, that the nature and extent of it may be understood; and 2d, that when the exclusive right ceases, from the description the machine may be constructed. *Brooks* v. *Bicknell*, 3 McLean, 441, 442.—MCLEAN, J.; Ohio, 1844.

24. If the invention is not so described, as to be known, in the language of the statute, from every other thing, the patent is void. *Ibid.*, 443.

25. The specification must be complete. No defects can be obviated by extraneous evidence at the trial. *Ibid.*, 444.

26. The utmost precision in the description of a machine is not essential. Parts of machinery, and processes generally known, need not be described. Nor is it essential to state the proportionate parts of a machine, nor the velocity of its operations. The size or velocity makes no difference in the principle. *Ibid.*, 447, 448.

27. The specification and drawing of a patent, must be so clear, full, and exact, as to enable one skilled in the art to which it pertains, to make and use the invention. It is not enough, if some very skilful artisan could make and use it, but persons of ordinary skill must be able to do so; must be able not only to construct, but to use the machine for a useful purpose. *Lippincott* v. *Kelly*, 1 West. Law Jour., 514.—IRVIN, J.; Pa., 1844.

28. Old and well-known machinery, with which the new contrivance is to be connected, need not be described in the specification, or delineated in the drawing, when no change in their forms or proportions enters into the new invention. *Emerson* v. *Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

29. If, however, the description is uncertain and obscure, as to what was meant, and what is in fact the novelty, that it cannot be determined whether the improvement consists in the combination of the whole, or of all the parts, or only of some of them, and of which—or of an invention of some, and if so, of which—the uncertainty will be fatal, and the patentee will be under the necessity of making a new specification, setting forth his claim with greater certainty, accuracy and clearness, and disclaiming all not new. *Hovey* v. *Stevens*, 3 Wood. & Min., 30–32.—WOODBURY, J.; Mass., 1846.

30. The patentee must describe his invention with reasonable certainty. Unless this is done, the public are unable to know whether they violate the patent or

not, and are also unable, when the term expires, to make machines correctly, and derive the proper advantages from the patent. *Davoll* v. *Brown*, 1 Wood. & Min., 56, 57.—WOODBURY, J.; Mass., 1845.

31. But a patent will be held valid, if the invention is described with so much clearness and certainty, that other machines could readily be made from it by mechanics acquainted with the subject. *Ibid.*, 57.

32. The object of the provisions of the statute requiring an inventor to describe his invention in as full, clear, and exact terms as to enable a skilful person to construct it, is twofold: 1, that when the term has expired, and the invention becomes public property, such means of information may be accessible through the Patent Office as will enable others to avail themselves of its benefits; and 2, that while the patent is in force others may be informed of the precise claim of the patentee, and not ignorantly infringe his exclusive rights. *Parker* v. *Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849.

33. By the patent laws the inventor is not to be protected unless he describes plainly and fully what he has done, so that the public may copy or imitate, and use the invention, after his patent expires. This is the consideration for the exclusive use during the period of the patent, and having this prevents the patentee from claiming afterward more than he had invented when his patent issued. *Smith* v. *Downing*, MS.—WOODBURY, J.; Mass., 1850.

34. And what he does not, or certainly what in the misty future he cannot describe, he must be presumed not to have invented. *Ibid.*

35. All that the law requires in respect to clearness in the specification is, that it should be clear enough to be understood by ordinary mechanics, and that the thing described could be made from it, considering the specification as a whole, and adverting to the drawings on file. *Hogg* v. *Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

36. As a previous condition to the granting or issuing of every patent, the applicant must set forth in his specification a true, full, and clear account and description of his invention, showing the contrivances, mode, method, manner, or means by which the result is to be produced, and what his *invention is*, what he claims to be *new*, and what he admits to be *old*. *Yearsley* v. *Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

37. Whoever discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it, provided he specifies the means used so fully and exactly that a skilful person can, by using the means specified, without addition or subtraction, produce the result described. If this cannot be done, the patent is void; if it can be, the patent gives the exclusive right to use the means specified, and nothing more. *O'Reilly* v. *Morse*, 15 How., 119.—TANEY, Ch. J.; Sup. Ct., 1853.

38. He who discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for such discovery, provided he sets forth in his specification the means he uses to produce such useful result, so that any one skilled in the art, &c., can by using the means specified, without any addition or subtraction from them, produce precisely the

result he describes. If this cannot be done by the means he describes the patent is void. *Amer. Pin Co.* v. *Oakville Pin Co.*, 3 Blatchf., 192; 3 A. L. R., 137. —INGERSOLL, J.; Ct., 1854.

39. The clearness the law requires in a specification must be such as will distinguish the thing patented from all others previously known, and which will enable a person skilled in the art or science of which it is a branch, or with which it is nearly connected, to construct the thing specified. *Teese* v. *Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

40. As the patent laws of the United States grant the patentee a monopoly, and not only award damages but inflict penalties for the violation of exclusive privilges, it requires the invention to be so described in the specifications, that one acquainted with the art or manufacture to which it relates may not only understand the invention, but be able by following the specification, with the aid of the drawing, to make the thing which is the subject of the patent. *Wintermute* v. *Redington*, 1 Fisher, 243.—WILSON, J.; Ohio, 1856.

41. The patentee may be regarded as a purchaser from the public, being bound to so communicate his secret by specification, drawings, and models, that it shall be successfully available to the whole community at the expiration of the patent. *Ibid.*, 243.

42. The patentees, to make their title good, must describe fully and clearly their whole invention, and the method of using it. If any thing material in respect to its construction or working is omitted in their specification, they lose all claim to the exclusive use of their discovery. *Carr* v. *Rice*, 1 Fisher, 204. —BETTS, J.; N. Y., 1856.

43. It is a settled rule of law that the specification need not describe that which is within the *ordinary knowledge* of any workman having a competent knowledge of the work, who may be employed to put up the apparatus, or construct the machine. *Page* v. *Ferry*, 1 Fisher, 304.—WILKINS, J.; Mich., 1857.

44. A patent may be considered in the light of a deed from the government, the consideration of which is the invention specified; and the patentee is bound to communicate it by so full, clear, and exact a description, that it shall be within the comprehension of the public at the expiration of the patent, for at that period his invention becomes public property. *Ibid.*, 306–7.

45. The specification is intended to teach the public the improvement patented: it must fully disclose the secret; must give the *best* mode known to the inventor; and contain nothing defective, or that would mislead artists of competent skill in the particular manufacture. *Ibid.*, 309.

46. A witness, in order to be competent to testify as to whether a specification contains a sufficient description of the invention, must be one *skilled in the art:* one not so skilled is not a fit person to determine as to the sufficiency of the description. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, 2 Fisher, 70.—INGERSOLL, J.; N. Y., 1858.

47. If the specification does not clearly specify and point out the improvement or combination which is claimed as the invention of the applicant, a patent cannot be granted. *Davis, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

48. The object and design of the law requiring the description of the invention to be full, clear, and exact, is,

that the public may be admonished of precisely what the patentee claims, so that it may not be ignorantly infringed, and also that when the exclusive right has expired, the public may be at no loss to know what the nature of the invention was, so as to make it valuable and practical. *Judson* v. *Moore*, 1 Fisher, 547.—LEAVITT, J.; Ohio, 1860.

49. Whether there is a sufficient specification or not for such purpose, is a question of fact for the jury. *Ibid.*, 547.

50. The description need not, however, be so particular as to dispense with the exercise of skill and judgment on the part of the mechanic. In carrying out an 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. *Ibid.*, 548.

51. In deciding whether the subject of an invention is set forth in a clear and intelligible manner, so that one can understand its precise character, it is necessary to take the whole specification together, not simply the summary at the conclusion, but the entire paper. The single point is whether, taking the whole specification together, there is a subject set forth and described which in itself is patentable, and whether it is so clearly described that it can be understood, and the precise character of the invention known. *Judson* v. *Cope*, 1 Fisher, 622.—LEAVITT, J.; Ohio, 1860.

## C. AMBIGUITY IN, AND EFFECT OF.

See AMBIGUITY.

## D. CONCEALMENT IN, AND EFFECT OF.

1. It is a question for a jury whether the specification contain the whole truth relative to the discovery, and if not, whether it has been concealed with a view to deceive. *Reutgen* v. *Kunowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. As to the materiality of the thing concealed, the question is, could an artist, after the patentee's right is expired, construct a machine by looking at the specification. This is a question for the jury. *Ibid.*, 171.

3. Under § 6 of the act of 1793, a defect or concealment in a specification, in order to make the patent invalid, must appear to have been made for the purpose of deceiving the public. *Whitney* v. *Carter*, Fessenden on Pat., 2d ed., 139.—JOHNSON, J.; Geo., 1809.

4. Any matters not disclosed in a patent, to invalidate it must appear to have been concealed for the purpose of deceiving the public. *Park* v. *Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

5. Under § 6 of the act of 1793, a defect or concealment in a specification, to avoid a patent, must arise from an intention to deceive the public. *Whittemore* v. *Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813.

6. Under the act of 1793, though the specification is materially defective, it will not invalidate the patent, unless the jury are satisfied that the concealment of the circumstances not described was intended to deceive the public. *Gray* v. *James*, Pet., C. C., 401.—WASHINGTON, J.; Pa., 1817.

7. The degree of evidence required to prove such fraudulent intention, rests with the jury. Positive evidence is not necessary. The intention may be presumed from circumstances, as 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. But such a presumption would be weakened by the testimony of such skilful persons, that they could not hesitate in supplying the omissions. *Ibid.*, 402.

8. If the specification is not so full, clear, and exact, as to enable a skilful person to compound and make the same, this, under § 6 of the act of 1793, does not avoid the patent, unless the defective concealment or description has been made for the purpose of deceiving the public. *Lowell* v. *Lewis*, 1 Mas., 189, 190.—STORY, J.; Mass., 1817.

**E.** DEFECTS IN, HOW REMEDIED.

See MISTAKES; REISSUE OF PATENT.

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## STATES, POWERS OF.

1. The power of Congress under article 1, § 8 of the constitution, in securing to authors and inventors the exclusive right to their respective writings and discoveries, is limited to authors and inventors only, and does not embrace introducers, who are not the authors or inventors. *Livingston* v. *Van Ingen*, 9 John., 560, 566, 582.—YATES, THOMPSON, and KENT, JJ.; N. Y., 1812.

2. But such clause does not prevent the several states from exercising the power of securing to persons introducing useful inventions the exclusive benefit of such inventions for a limited period. *Ibid.*, 560, 566, 582.

3. Nor does it take away from the states the power to enlarge within their jurisdiction the privilege, by extending the term of the patent or monopoly, beyond the term allowed by the acts of Congress. *Ibid.*, 581.

4. A state cannot take away from an individual his patent-right, but if an author or inventor should, instead of resorting to the act of Congress, apply to the legislature of a state for an exclusive right to his production, there is nothing to hinder the state granting it, though the operation of the grant would be confined to the limits of the state. *Ibid.*, 581.

5. So a patentee may have the time of his monopoly extended by the legislature of any state beyond the term granted under the acts of Congress. *Ibid.*, 581.

6. Nor does that clause of the constitution operate as an exclusion of all state legislative authority and interference to aid and protect the rights obtained under the general government, if the power is exercised in harmony with and in subordination to the superior power of Congress. Such power is not granted by exclusive words to the United States, nor prohibited to the individual states; it is therefore a concurrent power, which may be exercised by the states, in a variety of cases, without any infringement of the congressional power. *Ibid.*, 567, 581.—(THOMPSON, KENT, JJ.)

7. The power of Congress is only to ascertain and define the rights of property in the invention or work; it does not extend to regulating the use of it. This is exclusively of local cognizance. Such property, must be used and enjoyed within each state according to the laws of such state. *Ibid.*, 581.

8. The grant by the legislature of a state of an exclusive privilege to an invention for a limited time, does not imply that at the expiration of the period

the invention shall become public property. The state may renew the grant at the end of the period, or refuse to do so. *Evans* v. *Eaton*, Pet., C. C., 337.—WASHINGTON, J.; Pa., 1816.

9. Contracts in relation to patented machines, are regulated by the laws of the several states. *Wilson* v. *Sandford*, 10 How., 99.—TANEY, Ch. J.; Sup. Ct., 1850.

10. If the right of the purchaser of a patented machine is infringed, he must seek redress in the courts of the states, and according to their laws. The machine is personal property, and is not protected by the laws of the United States, but by the laws of the state in which it is situated. *Bloomer* v. *McQuewan*, 14 How., 550.—TANEY, Ch. J.; Sup. Ct., 1852. *Chaffee* v. *Bost. Belting Co.*, 22 How., 223.—CLIFFORD, J.; Sup. Ct., 1859.

11. Previous to the acts of Congress, many of the states had exercised the power of granting exclusive privileges, within their respective territories, to inventors and introducers of inventions. Provision was made in the act of 1793, § 7, for such cases. [*Ed.*]

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## STATUTES.

**A.** COPYRIGHT ACTS..... ..... 638
**B.** PATENT ACTS.
1. *Power of Congress to enact*..... 647
2. *Policy and Intent of*..... 647
3. *General or Public Acts*..... 649
4. *Special or Private Acts.*
*a.* Generally..... ..... 676
*b.* Act for Relief of Thomas Blanchard..... 677
*c.* Act for Relief of Oliver Evans..... ..... 678
*d.* Act for Relief of William Woodworth..... 679

## A. COPYRIGHT ACTS.

The notes here inserted under the different sections of the several acts, are of a general character, or have more particular reference to the *construction* of the statutes themselves than to their *application;* and such notes are confined to those sections as to which there have been direct adjudications.

For the several copyright acts in full, and with more extended notes thereto, see APPENDIX. [*Ed.*]

### ACT OF 1790. CHAP. 15.

*Section* 1.

1. Copyright was formerly considered to be founded on common law; but can now only be viewed as part of our statute law. *Clayton* v. *Stone*, 2 Paine, 383.—THOMPSON, J.; N. Y., 1828.

2. The object of the acts of Congress securing to authors the exclusive right to their writings, was the promotion of science. *Ibid.*, 392.

3. The privilege of an author to an exclusive sale of his works for a limited number of years, although a monopoly, is not so in the odious meaning of the term; but is but a proper reward for his labor provided by law, and to which he is as much entitled as to the exclusive enjoyment of any other kind of property. *Blunt* v. *Patten*, 2 Paine, 395.—THOMPSON, J.; N. Y., 1828.

4. The "copyright" recognized by this act, and which is intended to be protected, is presumed to be the right of property which an author has, at common law, in his manuscript. Such protection is given as well to books published as to manuscript copies. *Wheaton* v. *Peters*, 8 Pet., 661.—McLEAN, J.; Sup. Ct., 1834.

5. Congress, in passing the act of 1790, did not legislate in reference to existing rights. Instead of sanctioning

an existing right; it created it. *Ibid.*, 661.

6. In the United States an author can have no exclusive property or copyright in his published production except under the laws of Congress. *Ibid.*, 662.

7. A person cannot have an exclusive right or copyright in a label, as it is not a book, within the provisions of the statute. *Coffeen* v. *Brunton*, 4 McLean, 517.—McLean, J.; Ind., 1849.

*Section* 3.

1. The provisions of this section, which require the author to publish the title of his book in a newspaper, and to deliver a copy of the work itself to the Secretary of State, are merely directory, and constitute no part of the essential requisites for securing the copyright. *Nichols* v. *Ruggles*, 3 Day, 158.—Curiam, Ct., 1808.

2. The publication in the newspaper is intended as legal notice of the rights secured to the author, but is not necessary where actual notice is brought home to the party. *Ibid.*, 158.

3. Under this section a proprietor can acquire no title to a copyright for the term of the first fourteen years, unless he shall deposit in the clerk's office a printed copy of the title of the book. *Ewer* v. *Coxe*, 4 Wash., 490.—Washington, J.; Pa., 1824.

4. But the condition upon which the proprietor is to be entitled to the benefit of the act cannot be extended to the requisition contained in the last sentence of that section, to publish a copy of the record of the title, as prescribed therein.—*Ibid.*, 490.

5. If the title of an author depended upon the act of 1790, it would be complete, provided he had deposited a printed copy of the title of the book in the clerk's office, as directed by § 3; and the publication of a copy of the same would only be necessary to enable him to sue for the forfeitures created by that section. *Ibid.*, 490.

*Section* 4.

1. The copy of a book to be delivered to the Secretary of State within six months after publishing thereof, appears to be designed for public purposes, and has no connection with the copyright. A neglect to deliver such copy will not invalidate the copyright, and is not a condition precedent thereto. *Nichols* v. *Ruggles*, 3 Day, 153.—Curiam, Ct., 1808.

2. Under this section, a copy of a book may be deposited with the Department of State after the expiration of six months from the time of its publication, if not done before, and will avail from the time of its being deposited. *Daboll's Case*, 1 Opin., 532.—Wirt, Atty. Gen.; 1822.

3. Where the work consisted of a number of volumes, *Held*, that the delivery to the Secretary of State of the first volume of the work within six months after its publication, and of the rest of the volumes before the offence complained of is committed, or the action brought, is a sufficient compliance with the law. *Dwight* v. *Appleton*, 1 N. Y., Leg. Obs., 199.—Thompson, J.; N. Y., 1843.

Act of 1802. Chap. 36.

*Section* 1.

1. The act of 1802, § 1, provides that no person can be entitled to the benefits of the act of 1790, unless he shall, *in*

*addition* to the requisites enjoined in §§ 3 and 4 of that act, cause a copy of the record, required by that act to be published, to be inserted, at full length, in the title-page, or on the page immediately following the title. *Ewer* v. *Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

2. The person, therefore, claiming a copyright, before he can be entitled to the benefits of the act of 1790, must perform the requisites required by the act of 1802, *in addition* to those prescribed in §§ 3 and 4 of the act of 1790, and must perform the whole. The act admits of no other construction. *Ibid.*, 491.

3. The meaning of the act is as if it read: "the proprietor, before he shall be entitled to the benefit of the act of 1790, shall cause a copy of the record of the title to be published; and shall deliver a copy of the book to the Secretary of State, as directed by the third and fourth sections of that act; and shall also cause a copy of the said record to be inserted at full length in the title-page," &c. *Ibid.*, 491.

4. Under the act of 1790, when considered in connection with § 1 of the act of 1802, an author can obtain no exclusive right in his work, unless he complies with the requirements of §§ 3 and 4 of the act of 1790, by causing a copy of the record of his copyright to be printed in the newspapers, and delivering a copy of his work to the Secretary of State. *Wheaton* v. *Peters*, 8 Pet., 665.—MCLEAN, J.; Sup. Ct., 1834.

*Section 2.*

1. Under this section, the person intended and described as the proprietor of a copyright in a print, is one who shall not only invent *and* design, but who shall also engrave, etch, or work the print to which the right is claimed; or, who, *from his own works and inventions*, shall cause the print to be designed and engraved, etched or worked. *Binns* v. *Woodruff*, 4 Wash., 51.—WASHINGTON, J.; Pa., 1821.

2. In the first case, the inventor and designer is identified with the engraver; or, in other words, the entire work, or subject of the copyright is executed by the same person. In the latter, the invention is designed or embodied by the person in whom the right is vested, and the form and completion of the work are executed by another. *Ibid.*, 51.

3. But in neither case can a person claim a copyright for a mere invention, the work of his imagination locked up in his own mind, or existing in a form not visible to others. *Ibid.*, 51.

4. Neither is he so entitled, unless he has not only invented, but also designed or represented the subject in some visible form. *Ibid.*, 51.

5. The phrase *design*, when used as a term of art, means the giving of a visible form to the conceptions of the mind, or, in other words, to the invention. *Ibid.*, 52.

6. Where neither the design nor the general arrangement of a print, nor the parts which composed it, were the invention of the plaintiff, but he had employed and paid the artists who had composed and executed it, *Held*, that he was not entitled to a copyright under the provisions of the acts of Congress. *Ibid.*, 53.

ACT OF 1819. CHAP. 19.

1. Under the act of 1790 and 1819, as to patents and copyrights, the owners of copyrights and patents, do not

have redress or relief in any cases where they could not before have had relief in some court either of equity or law. *Pierpont* v. *Fowle*, 2 Wood. & Min., 27.—WOODBURY, J.; Mass., 1846.

2. These acts merely enable them to prosecute such claims in the Circuit Court of the United States, as they usually had done before, but without going to the state tribunals; the public interest required a uniform construction to be placed by one tribunal, on all important questions connected with rights so held. *Ibid.*, 27.

3. The act of 1819, so far as it gave cognizance to the courts of the United States, in cases of copyright, still remains in force, and is the only law conferring equitable jurisdiction on these courts in such cases; § 9 of the act of 1831, protects manuscripts only. *Stephens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct.; 1854.

4. The equity jurisdiction of such courts, as to copyrights, does not extend to the adjudication of forfeitures; a decree therefore cannot be entered for the penalties incurred for a violation of the copyright. *Ibid.*, 455.

5. The jurisdiction of the Federal courts, under the acts of Congress, respecting copyrights, has not taken away or diminished the original jurisdiction, which, before such acts, the state courts exercised—except where the jurisdiction was made exclusive in express terms or by the necessary construction of the Federal constitution. *Woolsey* v. *Judd*, 4 Duer, 382.—DUER, J.; N. Y., 1855.

6. Under the act of Congress giving to the Circuit Courts cognizance of cases arising under the laws of the United States, granting to authors the exclusive right to their writings, the citizenship of the parties litigant is immaterial. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44, 45.—CADWALLADER, J.; Pa., 1860.

7. The act of 1819 concerns remedies, and not rights. *Ibid.*, 45.

8. Under the statutes, which confer and regulate *rights* of literary proprietorship, the citizenship of such parties is also unimportant. It is sufficient if the complainant is a *resident* of the United States. *Ibid.*, 45.

### ACT OF 1831. CHAP. 16.

*Section* 1.

See also COPYRIGHT, A., B., C.

1. Under this act, a person to be a "resident," so as to be entitled to a copyright, must be a permanent resident of the country. A person temporarily residing here, even though he has declared his intention of becoming a citizen, cannot take or hold a copyright. *Carey* v. *Collier*, 56 Niles' Reg., 262.—BETTS, J.; N. Y., 1839.

2. Capt. Maryatt, a subject of Great Britain, and an officer under that government, being temporarily in this country, took the required oath of his intention to become a citizen, and then took out a copyright for one of his books, and assigned the same to the plaintiff; *Held*, that he was not a "resident" within the meaning of the act of 1831, so as to be entitled to a copyright for his book. *Ibid.*

3. The author or compiler of a musical composition, made up of different parts, copied from older compositions without material change, and put together into one tune, with only slight alterations or additions, is not entitled

to a copyright for such therefor. *Reed* v. *Carasi*, 8 Law Rep., 411.—TANEY, Ch. J.; Md., 1845.

4. One who gets others to compile a work, or engrave a print, is not entitled to a copyright. *Pierpont* v. *Fowle*, 2 Wood. & Min., 46.—WOODBURY, J.; Mass., 1846.

5. To constitute one an author, he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself. *Atwill* v. *Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

6. A person cannot secure a copyright for alterations and improvements in a musical composition, made by others for him, and at his expense. *Ibid.*, 46.

7. Under the copyright act of 1831, the legal assignee of the author may take out the copyright, and it will make no difference whether he holds it as trustee, for the benefit of another, or not. *Little* v. *Gould*, 2 Blatchf., 366.—NELSON, J.; N. Y., 1852.

8. An artist, who is employed by the United States to engrave a chart, of which the original manuscript was the property of, and furnished by the government, has no pretence of right of copyright in the engraved plates, or impressions therefrom. *Seibert's Case*, 7 Opin., 656.—CUSHING, Atty. Gen.; 1856.

9. Under the act of 1831, no person can obtain a copyright, except authors who are citizens or residents of the United States, and proprietors under derivations of title from *such* authors. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

10. The assignee of a work, composed by a *non-resident alien*, cannot obtain a copyright for it. *Ibid.*, 45.

11. A person who hires another to write a book, and gives him the description and scope of the work, is not the author. The literary man who writes the book, and prepares it for publication, is the author; and the copyright is intended to protect him, and not the person who employed him. *De Witt* v. *Brooks*, MS.—NELSON, J.; N. Y., 1861.

12. Where the incidents and events of a person's life were furnished by such person to another, who prepared them for publication, and the copyright was taken out in the name of the person so furnishing such facts, *Held*, that he was not the author, and that a party claiming as his assignee could not maintain an action for infringement. *Ibid.*

*Section 2.*

See also COPYRIGHT, E.

1. An assignment of a "copyright" is to be referred to what was then in existence, and not to any future contingency. *Pierpont* v. *Fowle*, 2 Wood. & Min., 43, 45.—WOODBURY, J.; Mass., 1846.

2. An assignment of a "copyright" should not by construction be extended beyond the first term, unless it seems to be actually so meant by the author, and to include any future contingency. *Ibid.*, 44.

3. The taking out a second term of a copyright is not like the strengthening of a defective title, but rather like a new interest obtained after the general interest had expired. *Ibid.*, 46.

*Sections 4 & 5.*

See also COPYRIGHT, D

1. Where a work consists of a number

of volumes, the insertion of the record on the page next following the title-page of the *first volume* of the work, is a sufficient compliance with the statute. *Dwight* v. *Appleton*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

2. The number of volumes in which it was stated the work would be published, made no part of its title, and may be rejected as surplusage. *Ibid.*, 199.

3. The author may insert the same record in another edition, published in a different number of volumes, without impairing the copyright. *Ibid.*, 199.

4. Under §§ 4 and 5 of the act of 1831, depositing the title-page in the proper clerk's office, publishing a notice according to the act, and delivering a copy of the book, are conditions the performance of which is essential to the title. *Baker* v. *Taylor*, 2 Blatchf., 84.—BETTS, J.; N. Y., 1848.

5. Where the title-page of a book was deposited in 1846, and the notice of the entry inserted in the book stated it to have been deposited in 1847, *Held*, that the error created a fatal defect in the plaintiff's title. *Ibid.*, 84.

6. Even if the error arose from mistake, it will make no difference as to the result. *Ibid.*, 84.

7. Under § 4 a person is not entitled to any benefit, under the act, unless he deposits the title-page *before* the publication of his work. *Ibid.*, 85.

8. By the provisions of the copyright act of 1831, there are three preliminary steps requisite to the securing a valid copyright: 1. The deposit of a printed copy of the title before publication, with the clerk of the District Court. 2. Notice to the public, by printing in the place designated, the fact of the entry, in the form prescribed by the statute, and, 3. The deposit with the clerk of a copy of the book, &c., or musical composition, within three months from the date of publication. *Jollie* v. *Jaques*, 1 Blatchf., 620.—NELSON, J.; N. Y., 1850.

9. Until all the things required by §§ 4 and 5, act of 1831, are done, the copyright is not secured; but by taking the incipient step, a right is acquired, which chancery will protect until the other acts may be done. *Pulte* v. *Derby*, 5 McLean, 332.—MCLEAN, J.; Ohio, 1852.

10. The provisions of § 4 of the copyright act of 1831, as to the deposit of the title-page of the book to be copyrighted, before publication, and the deposit of a printed volume of the book within three months after publication, must be complied with in order to enable a party to avail himself of the provisions secured by that act. *Struve* v. *Schwedler*, 4 Blatchf., 24.—NELSON, J.; N. Y., 1857.

*Section 6.*

See also INFRINGEMENT, A.

1. It is of no consequence in what form the works of another are used, whether it be a simple reprint, or by incorporating it in some other work. If his copyright is violated, he can maintain an action therefor. *Gray* v. *Russell*, 1 Story, 19.—STORY, J.; Mass., 1839.

2. To entitle a party to an action for the infringement of a copyright, it is not necessary that the whole, or a greater part of his work should be taken. If so much is taken as to impair the value of the original, or so that the labors of the original author are substantially appropriated, an action will lie. *Folsom* v.

*Marsh*, 2 Story, 115.—STORY, J.; Mass., 1841.

3. The entirety of the copyright is the property of the author, and it is no defence that another has appropriated only a part of such property, and not the whole. *Ibid.*, 116.

4. Nor does it necessarily depend upon the quantity taken, whether it is an infringement of a copyright or not. *Ibid.*, 116.

5. If a copyright has been invaded, whether the party knew the work was copyrighted or not, he is liable to the penalty for violation. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

6. A book may, in one part of it, infringe the copyright of another work, and in other parts be no infringement; in such a case the remedy will not be extended beyond the injury. *Story* v. *Holcombe*, 4 McLean, 315.—MCLEAN, J.; Ohio, 1847.

7. A book, within the meaning of the statute, does not include a translation of a work. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 230.—GRIER, J.; Pa., 1853.

8. A translation may be called a transcript, or copy of the author's thought or conception; but in no correct sense can it be called a *copy* of his book. *Ibid.*, 231.

*Penalties under.*

1. The penalty of fifty cents per sheet imposed by this section, is incurred for every sheet found to have been in the defendant's possession, or which they had sold, or held for sale. *Dwight* v. *Appleton*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

2. An *action on the case* is the proper form of action to recover damages for a violation of a copyright: *trespass* will not lie. *Atwill* v. *Ferrett*, 2 Blatchf., 48.—BETTS, J.; N. Y., 1847.

3. The penalty declared by this section can be adjudged only for the sheets found in the possession of the defendant. *Backus* v. *Gould*, 7 How., 811.—MCLEAN, J.; Sup. Ct., 1848.

4. The penalty imposed by this section is not incurred by printing and publishing so much of a book as to amount to an infringement of the copyright. *Rogers* v. *Jewett*, 12 Mo. Law Rep., 340.—CURTIS, J.; Mass., 1858.

5. The words "a copy of a book," found in § 6 of the act of 1831, import a transcript or copy of the entire book. *Ibid.*, 341.

6. Congress did not intend to inflict these penalties upon the unlawful printing or publication of less than an entire work. *Ibid.*, 341.

*Section 7.*

1. The penalty for an infringement is fixed by this section. If the jury find there has been an infringement, they must ascertain the number of sheets proved to have been sold, or offered for sale (not the number printed), and return a verdict for one dollar for each sheet so sold or offered to be sold. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

2. A defendant is not liable to the penalty imposed by this section, unless he was guilty of the infraction of the copyright, within two years before action was brought. *Reed* v. *Carusi*, 8 Law Rep., 412.—TANEY, Ch. J.; Md., 1845.

3. The engraving or preparation of plates, where the work is printed from plates, may have been more than two years; but every printing for sale would

be a new infraction of the right, and if such printing was within two years before suit brought, the defendant is liable. *Ibid.*, 412.

4. The penalty is at the rate of one dollar for each sheet the defendant may have caused to be printed for sale, within two years before suit brought. *Ibid.*, 412.

*Section 9.*

See also LETTERS; MANUSCRIPTS.

1. There remains in an author, notwithstanding the copyright by statute, a common law title to his works before publication. *Jones* v. *Thorne*, 1 N. Y. Leg. Obs., 400.—McCOUN, V. Chan.; N. Y., 1843.

2. At common law, independently of the statute, the author of a manuscript might obtain redress against one who had surreptitiously gained possession of it. *Bartlette* v. *Crittenden*, 4 McLean, 301.—McLEAN, J.; Ohio, 1847.

3. On general, equitable principles, relief may also be given, under like circumstances, by a Court of Chancery. *Ibid.*, 301.

4. The use, by an author, of his manuscript for the purpose of instruction, is not an abandonment of it to the public. Nor is it an abandonment to allow his pupils to take copies. *Ibid.*, 303.

5. Those also who have been permitted to take copies, have no right to a use which was not in contemplation, when the consent to take copies was given. *Ibid.*, 303.

6. The common law protects the right of an author to his manuscript only. *Bartlette* v. *Crittenden*, 5 McLean, 38.—McLEAN, J.; Ohio, 1849.

7. § 9 of the copyright act of 1831, also protects such right. *Ibid.*, 38.

8. The act of 1831, § 9, giving redress for the unauthorized *printing or publishing of manuscripts*, operates in favor of a resident of the United States, who has acquired the proprietorship of an *unprinted* literary composition from a non-resident alien author. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

9. But this section—and which is the only one enabling a proprietor, who derives his title from such an author, to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

*Section 11.*

The penalties referred to in this section, cannot be recovered in an action brought in the name of more than one person. *Ferrett* v. *Atwill*, 1 Blatchf., 155.—NELSON, J.; N Y., 1846.

ACT OF 1834. CHAP. 157.

1. An assignment of an interest in a copyright must be in writing to be valid and operative; but an *agreement* to assign may be by parol. *Gould* v. *Banks*, 8 Wend., 565.—NELSON, J.; N. Y., 1832.

2. An assignment of a copyright, although not recorded, is still valid as between the parties, and as to all persons, not claiming under the assignors. *Webb* v. *Powers*, 2 Wood. & Min., 510.—WOODBURY, J.; Mass., 1847.

3. A formal transfer of a copyright, by this act, is required to be proved and recorded as a deed for the conveyance of land, and such record operates as notice. *Little* v. *Hall*, 18 How., 171.—McLEAN, J.; Sup. Ct., 1855.

4. The statute of 1834, sanctioning

assignments of copyright, prescribes only the instrument by which they may be assigned, and the mode of recording, but does not define what interest may be assigned. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 401.—SPRAGUE, J.; Mass., 1860.

5. There is no sufficient reason for preventing an author conveying a distinct portion of his right. Divisibility, as well as assignability, enhances the value of his property. *Ibid.*, 401. [Contra, 75, *post.*]

6. Where an assignment, under which suit was brought, was of the exclusive right of acting and representing a certain drama, within the United States, except as to five cities, for the term of one year, *Held*, that such an assignment was valid under the statute. *Ibid.*, 400, 401.

7. The statutes of the United States, for the protection of authors, do not, like those for the benefit of inventors, sanction transfers of limited local proprietorships of exclusive privileges. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 46.—CADWALLADER, J.; Pa., 1860.

8. A writing, which is in form a transfer, by an author, of his exclusive right for a designated portion of the United States, operates *at law*, only as a mere *license*, and is ineffectual as an assignment. *Ibid.*, 46.

9. But in *equity*, a limited local, or other partial assignment, if made for a valuable consideration, may be carried into effect whether it would be effectual in law or not. *Ibid.*, 47.

### ACT OF 1856. CHAP. 169.

1. The act of 1856 was passed to give to the authors of dramatic compositions the exclusive right of acting and representing, which they did not enjoy under the previous statutes. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 397.—SPRAGUE, J.; Mass., 1860.

2. This act assumes the doctrine that representation is not publication. The prior acts secured to authors the exclusive right of printing and publication; and it was only because publication did not embrace acting or representation, that this statute of 1856 was passed, superadding that exclusive right to those previously enjoyed. *Ibid.*, 397.

3. The previous acting or representing a play, will not deprive the author of the right to afterward take out a copyright. *Ibid.*, 397.

4. An assignee of the exclusive right of acting and representing a drama, in certain places, may maintain an action in his own name, even after a representation by him, for an injunction to prevent its being represented by another within such places. *Ibid.*, 400, 401.

5. And such action may be maintained, although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 401. [Contra, 15 *post.*]

6. The only act which affords redress for unauthorized theatrical representations, is the act of August 18th, 1856; but this only applies to cases in which copyright is effectually secured under the act of 1831. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

7. But under this act, an assignee of a dramatic composition, cannot maintain an action for its unauthorized representation by others, unless he has performed *all* the acts required by law to secure a copyright, including the deposit of a *printed* copy. *Ibid.*, 45, 46.

## B. Patent Acts.

### 1. *Power of Congress to enact.*

See Congress.

### 2. *Policy and Intent of.*

See also Patents, P. 1.

1. Many of the provisions of our patent acts are derived from the principles and practice which have prevailed in the construction of those of England; and though it is not strictly the case in respect to the English statute of monopolies, as in respect to the statute of frauds and of limitations, which have been adopted into our own legislation, that the known and settled construction of those statutes by courts of law has been considered as silently incorporated into our acts, or has been received with all the weight of authority, yet the construction of the statute of monopolies adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it. *Pennock* v. *Dialogue*, 2 Pet., 18.—Story, J.; Sup. Ct., 1829.

2. The intention of the patent law, as declared by Congress, is to promote the progress of the useful arts, by the benefits *granted to inventors;* not by those accruing to the public after the patent has expired, as in England. *Whitney* v. *Emmett*, Bald., 321.—Baldwin, J.; Pa., 1831.

3. Intended for their protection and security, the law should be construed favorably and benignly in favor of patentees. When the invention is substantially new and useful, and the specification is intelligible to men who understand the subject, juries ought to look favorably on the right of property, and find against a patentee only for some substantial defect in his title papers or proof. *Ibid.*, 322.

4. To promote the progress of the useful arts is the interest and policy of every enlightened government. It cannot be doubted that the settled purpose of the United States has even been to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought to be construed in the spirit in which they have been made; and should be executed fairly on the part of the United States, if this can be done without transcending the statute, or countenancing acts which are fraudulent or may prove mischievous. *Grant* v. *Raymond*, 6 Pet., 241, 242.—Marshall, Ch. J.; Sup. Ct., 1832.

5. The great object and intention of the patent acts is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. *Ibid.*, 243.

6. Patents for inventions are not to be treated as mere monopolies odious in the eyes of the law, and therefore not to be favored; nor are they to be con-

strued with the utmost rigor, as *strictissimi juris*. *Ames* v. *Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

7. The constitution of the United States, in giving authority to Congress to grant patents for a limited period, declares the object to be to promote the progress of science and useful arts, an object as truly national, and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any overnice and critical refinements. *Ibid.*, 485.

8. It is no objection to the validity of laws respecting patents, that they are retrospective in their operation. The powers of Congress to legislate upon the subject of patents is plenary by the constitution, and as there are no restraints on its exercise, there can be no limitation of its right to modify them at pleasure, so that they do not take away the rights of property in existing patents. *McClurgh* v. *Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

9. The patent law gives to Inventors an exclusive right in their inventions, but it is not a monopoly in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefits. And to secure them the remuneration the law provides, a liberal construction should be given to it. *Brooks* v. *Bicknell*, 3 McLean, 437.—MCLEAN, J.; Ohio, 1844.

10. The patent laws are not made to encourage monopolies of what before belonged to others, or to the public—which is the true idea of a monopoly—but the design is to encourage genius in advancing the arts, through science and ingenuity, by protecting its productions of what did not before exist, and of what never belonged to another person, or the public. *Davoll* v. *Brown*, 1 Wood. & Min., 57.—WOODBURY, J.; Mass., 1845.

11. Under the patent laws the inventor receives no monopoly. Instead of receiving any thing from the public, he confers on it the greatest benefits; and all he asks, and all he receives, is that for a few years he shall realize some advantage from his own creation. *Parker* v. *Haworth*, 4 McLean, 372.—MCLEAN, J.; Ill., 1848.

12. The power granted by the patent laws is domestic in its character, and necessarily confined within the limits of the United States. The patent acts do not and were not intended to operate beyond the limits of the United States, and a patentee's right of property and exclusive use cannot extend beyond the limits to which the law itself is confined. *Brown* v. *Duchesne*, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.

13. The patent acts have been passed for the promotion of the useful arts—for the ultimate benefit of the republic, and not for the sole benefit of inventors and patentees. It is for the ultimate benefit of the public that privileges are granted to inventors, allowed to operate, and protected for limited times for their direct benefit. *Day* v. *Union Rub. Co.*, 3 or 4 Blatchf.—HALL, J.; N. Y., 1856.

14. Patents are granted to inventors not for their benefit simply, but for the purpose of benefiting the public by encouraging inventors to make inventions which may be useful to the public when placed at their disposal. *Ransom* v.

*Mayor, &c.*, 1 Fisher, 255.—HALL, J.; N. Y., 1856.

15. The limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another, and doubtless the primary object in granting and securing that monopoly. *Kendall* v. *Winsor*, 21 How., 327, 328.—DANIEL, J.; Sup. Ct., 1858.

16. This was at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects. *Ibid.*, 328.

### 3. *General or Public Acts.*

The notes here inserted under the different sections of the several acts, are of a general character, or have more particular reference to the *construction* of the statutes, than to their *application;* and such notes are confined to those sections as to which there have been direct adjudications.

For the several patent acts in full, and with more extended notes thereto, see APPENDIX. [*Ed.*]

#### ACT OF 1790. CHAP. 7.

##### *Section* 1.

1. Under this section it was held that the allegations and suggestions of the petition must be substantially recited in the patent, or the patent was void. *Evans* v. *Chambers*, 2 Wash., 126.—WASHINGTON, J.; Pa., 1807.

2. The Secretary of State cannot issue a patent unless the prerequisites required by law are complied with; as he cannot issue a patent without a specification, or with a specification altogether ambiguous and unintelligible. *Kneass* v. *Schuylkill Bank*, 4 Wash., 13.—WASHINGTON, J.; Pa., 1820.

##### *Section* 3.

The officer authorized to give copies of papers or drawings, in patent cases, has no concern with the purpose for which asked. The policy of the law rather requires than forbids that copies should be given when applied for. *Anon.*, 1 Opin., 171.—PINCKNEY, Atty. Gen.; 1812.

##### *Section* 4.

A erected on his own premises, and at his own expense, a machine, which was the invention of B. B then took of A a lease of the machine for a term of years, covenanting to reconvey the same, at the end of the term of years to A. B afterward brought an action against A for the use under such reconveyance. *Held*, that this amounted to a license or consent to use, in writing, within the meaning of this section. *Reutgen* v. *Kanowrs*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

##### *Section* 5.

See act of 1793, § 10.

##### *Section* 6.

As to General Issue and notice, see notes to act of 1793, § 6, and act of 1836, § 15.

See also PATENT, P. 2.

Under the act of 1790 a patent was made *prima facie* evidence; that act was repealed by the act of 1793, and that provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, but the plaintiff was bound to prove these facts in order to make out his case. But the act of 1836 introduced a new system; and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of the facts asserted in it. *Corning* v. *Burden*, 15 How., 270, 271.—GRIER, J.; Sup. Ct., 1853.

ACT OF 1793. CHAP. 9.

*Section* 1.

1. The first section of this act is to be construed with the other parts of the act to mean that the discovery should be unknown, and not used as the invention of any other than the patentee, before the application for a patent. *Morris* v. *Huntington*, 1 Paine, 353.—THOMPSON, J.; N. Y., 1824.

2. The first section of the act of 1793 is to be construed with the sixth section of the same act, and means that the first inventor has a right to a patent, though there may have been a knowledge of the thing invented before the *application* for a patent, if such use or knowledge was not anterior to the *discovery*. *Mellus* v. *Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825.

3. The true construction of the act of 1793, considering the first and sixth sections together, is that to invalidate a patent because of a prior use or knowledge, the thing patented must have been used prior to the alleged *discovery* of the patentee, and not merely prior to the *application*. *Treadwell* v. *Bladen*, 4 Wash., 707, 708.—WASHINGTON, J.; Pa., 1827.

4. The meaning of the words "not known," &c., in § 1 of the act of 1793, is that the invention must not have been known or used *by the public* before the application. *Pennock*, v. *Dialogue*, 2 Pet., 19.—STORY, J.; Sup. Ct., 1829.

5. The patent act of 1790 used the words "not known or used before," without adding the words "the application," in connection with the structure of the sentence in which they stand; they might have been referred either to the time of the invention, or of the application. The addition of the latter words in the act of 1793 must have been *ex industria*, and with the cautious intention to clear away a doubt and fix the original and deliberate meaning of the legislature. *Ibid.*, 22.

6. The words "not known or used before the application," refer to the application for the patent, and not to the discovery referred to in the sixth section; but the previous use to invalidate a patent must be a public use by the consent or acquiescence of the patentee. *Whitney* v. *Emmett*, Bald., 309.—BALDWIN, J.; Pa., 1831.

7. Within the spirit of this section it was held that the Secretary of State, though not expressly authorized, might receive the surrender of letters patent which were defective by reason of mistakes innocently committed, either by the department, or by the inventor, and reissue a new and corrected patent. *Grant* v. *Raymond*, 6 Pet., 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

8. The knowledge and use spoken of in this act has reference to the public only. A surreptitious knowledge and use will not affect the right of the in-

ventor. *Shaw* v. *Cooper*, 7 Pet., 319.—McLean, J.; Sup. Ct., 1833.

9. Though this act, like that of 1790, requires a petition to be presented, and the patent, when issued, to recite the "allegations and suggestions of the petition," it appears on investigation that after the act of 1790, the petition alone seldom contained any thing as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations or suggestions, or descriptions whatever, except those in the schedule or specification. *Hogg* v. *Emerson*, 6 How., 480, 481.—Woodbury, J.; Sup. Ct., 1847.

10. But the specification being filed at the same time, and often on the same paper, seems to have been regarded, whether specially named in the petition or not, as a part of it. To avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. *Ibid.*, 481.

*Section 2.*

See also Form.

1. It is not every change of form and proportion which is declared by this act to be no discovery, but such as is *simply* a change of form and proportion, and nothing more. 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. *Davis* v. *Palmer*, 2 Brock., 310.—Marshall, Ch. J.; Va., 1827.

2. Though this declaratory act, that a change in form is not a discovery, was not re-enacted in the law of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. *Winans* v. *Denmead*, 15 How., 341.—Curtis, J.; Sup. Ct., 1853.

*Section 3.*

1. The taking of the oath, by the inventor, is but a prerequisite to the granting of a patent, and in no degree essential to its validity. If therefore not conformable to the statute, it is no objection to the patent. *Whittemore* v. *Cutter*, 1 Gall., 433.—Story, J.; Mass., 1813.

2. Under the provisions of this section requiring drawings with written references, if the specification refers to the drawings, they thereby become part of the written description of the invention. *Earle* v. *Sawyer*, 4 Mas., 10, 11.—Story, J.; Mass., 1825.

3. An exemplification of a specification of a patent is made evidence by this section of the act of Congress. The exemplification of the patent itself stands upon the common law, as being an exemplification of a record of a public document, and is always to be received as evidence. The drawing or model need not be exemplified. *Peck* v. *Furrington*, 9 Wend., 45.—Savage, Ch. J.; N. Y., 1832.

4. The patent act of 1793 does not limit the inventor to one single mode or one single set of ingredients to carry into effect his invention. He may claim as many modes as he pleases, provided always that the claim is limited to such as he has invented, and as are substantially new, and § 3 of this act requires in the case of a machine, that the inven-

tor shall explain the several modes in which he has contemplated the application of its principle. *Ryan* v. *Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

5. Under this section, the omission of written references in the specification to the drawings, unless such references are necessary to an understanding of the invention, will not vitiate the patent. *Brooks* v. *Bicknell*, 3 McLean, 261.—McLEAN, J.; Ohio, 1843; *Washburn* v. *Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

6. It is doubtful whether this section requires the specification to contain *written* references to the drawings. It is sufficient if drawings and written references are put on file with the specification; and if the references required are written on the drawings, the statute is satisfied. *Emerson* v. *Hogg*, 2 Blatchf., 9, 10.—BETTS, J.; N. Y., 1845.

7. Under the act of 1793, the specification was not required to be made a part of the letters patent, but the inventor could have it so incorporated with them if he desired. *Hogg* v. *Emerson*, 11 How., 604.—WOODBURY, J.; Sup. Ct., 1850.

*Section* 4.

1. It is the business of the assignee of a patent-right to see that the assignment is put on record. *Morrill* v. *Worthington*, 14 Mas., 392.—CURIAM; Mass., 1817.

2. An assignment of a patent, though not recorded in the office of the Secretary of State, is still valid, except as against creditors and subsequent purchasers. *Holden* v. *Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

3. Under this section an assignment is not valid unless it has been recorded in the office of the Secretary of State. *Higgins* v. *Strong*, 4 Blackf., 183.—DEWEY, J.; Ind., 1836.

4. An assignment of a particular interest in a patent-right, as a conveyance of a right to use an invention within a limited territory, is not required to be recorded. *Stevens* v. *Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

5. Under this section, until an assignment is recorded, the assignee is not substituted to the rights and responsibilities of the patentee, so as to maintain a suit at law or in equity, founded thereon. *Wyeth* v. *Stone*, 1 Story, 296.—STORY, J.; Mass., 1840.

*Section* 5.

1. Actions brought for an infringement of a patent are not cognizable in a state court, but are only cognizable in the Circuit Courts of the United States. *Parsons* v. *Barnard*, 7 John., 144.—CURIAM; N. Y., 1810.

2. Under this section the assignee of a *part* of a patent cannot maintain an action at law for a violation of the patent. *Tyler* v. *Tuel*, 6 Cra., 324.—CURIAM; Sup. Ct., 1810.

3. But the assignee of a moiety may join with the patentee in an action for a violation. *Whittemore* v. *Cutter*, 1 Gall., 430.—STORY, J.; Mass., 1813.

4. Under this section, subjecting to a penalty "any person who shall make, devise, *and* use, or sell, the thing so invented," it might well be questioned whether any person would be subject to the penalty for using a machine, which he had not also made and devised. But this doubt is removed by § 3 of the act of 1800, which repeals this § 5, and subjects to damages "any person who shall make, devise, use, *or* sell" the in-

vention of another. *Evans* v. *Jordan*, 1 Brock., 250, 251.—MARSHALL, Ch. J.; Va., 1813.

5. Where an inventor assigned his invention before patent taken out, *Held*, that the action for infringement could not be maintained by the patentee, but should be brought by the assignee. *Herbert* v. *Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

6. Whether the assignee of a part interest in a patent, circumscribed by local limits, may maintain a suit at law; *query*. But he may in equity. *Ogle* v. *Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

7. Under the acts of 1793 and 1800, the Circuit Courts of the United States alone have jurisdiction of actions brought for damages for an infringement of a patent. *Burrall* v. *Jewett*, 2 Paige, 145.—WALWORTH, Chan.; N. Y., 1830.

8. The maker and seller of a patented article, within the meaning of this section, is the person for whom, by whose direction, and for whose account the article is sold, and not the mere workman employed to sell. *Delano* v. *Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

9. § 4 of the patent act of 1790, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. § 5 of the act of 1793, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. § 3 of the act of 1800, provided that an infringer should pay three times the actual damages sustained. *Seymour* v. *McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

10. § 14 of the patent act of 1836, confines the jury to the actual damages sustained by the patentee. The power to increase them, as punitive damages, is committed to the discretion and judgment of the court. *Ibid.*, 489.

### *Section* 6.

1. This section does not enumerate all the defences of which the defendant may legally avail himself: as he may give in evidence that he never did the thing attributed to him; that the patentee is an alien, and not entitled under the act; or that he has a license or authority under the patentee. *Whittemore* v. *Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813.

2. The object of this section was to guard against defeating patents by the setting up of a prior invention which had never been reduced to practice. *Bedford* v. *Hunt*, 1 Mas., 305.—STORY, J.; Mass., 1817.

3. This section appears to have been drawn with the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue, and intends to relieve the defendant from the difficulties of pleading, by allowing him to give in evidence matter which affects the patent. *Evans* v. *Eaton*, 3 Wheat., 503, 504.—MARSHALL, Ch. J.; Sup. Ct., 1818.

4. Such notice is, however, for the security of the plaintiff, to protect him against surprise. *Ibid.*, 504.

5. The provisions of this section do not apply to enable a plaintiff to treat his patent as void. The proceedings under this section are the acts of the defendant only, and the plaintiff has no right to set up a defect in his own patent. *Morris* v. *Huntington*, 1 Paine, 355.—THOMPSON, J.; N. Y., 1824.

6. This section does not enumerate all the defences which a party may

make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. *Pennock* v. *Dialogue*, 2 Pet., 23.—STORY, J.; Sup. Ct., 1829.

7. The Circuit Court, in a civil suit, cannot declare a patent void except for the causes specified in this section. If the patent is defective for any other cause, the verdict must be general for the defendant. *Whitney* v. *Emmett*, Bald., 321.—BALDWIN, J.; Pa., 1831.

8. If a defendant seeks to annul a patent he must proceed in precise conformity with § 6 of the act of 1793; and "fraudulent intent" must be found by the jury to justify a judgment of *vacatur* by the court. This section does not control the third. *Grant* v. *Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832.

*Section* 9.

1. An inventor filed a description of his alleged invention, in 1802, as required by § 3 of the act of 1793, and took no further step until 1814. In that year another person made application for a patent for the same invention, without knowledge of the first invention. *Held*, that there was no limitation of time within which a patent must be taken out after the specification filed, and that the facts made a case of interference to be arbitrated under this section. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

2. The refusal of a defendant to submit his claim to arbitration under this section, and his subsequently obtaining a patent therefor, is not conclusive evidence, in a proceeding under § 10, that such patent was obtained surreptitiously. *Stearnes* v. *Barrett*, 1 Mas., 174.—STORY, J.; Mass., 1816.

*Section* 10.

1. Proceedings under this section upon the rule *nisi* are not conclusive. The process awarded upon making the rule absolute, is in the nature of a *scire facias*, and is not final. *Stearnes* v. *Barrett*, 1 Mas., 165.—STORY, J.; Mass., 1816.

2. The authority intended to be given by this section is vested exclusively in the District Courts, and proceedings under it are summary, and not in the nature of a *scire facias*. The making the rule *nisi* absolute works a repeal of the patent without further proceedings. *McGaw* v. *Bryan*, 1 U. S. Law Jour., 98.—VAN NESS, J.; N. Y., 1822.

3. Under this section the making the rule *nisi* absolute does not *de facto* work a repeal of the patent: but the process to be issued is in the nature of a *scire facias* to the patentee to show cause why the patent should not be repealed. *Wood & Brundage, Ex parte*, 9 Wheat., 604, 615.—STORY, J.; Sup. Ct., 1824.

4. The jurisdiction given to the District Court, under this section, applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestion, or by some wilful misrepresentation and deception. *Delano* v. *Scott*, Gilpin, 493.—HOPKINSON, J.; Pa., 1834.

5. The hearing on the return of the rule to show cause is only initial, and the order of the judge is not that the patent is invalid, but only that process shall issue for a trial of its validity. *Ibid.*, 494.

6. The summary proceeding under this section is given to protect the pub-

lic from manifest fraud in taking out patents (the fees of office being no check) for known and common things. *Ibid.*, 494.

7. It gives the power to any person to call upon a patentee for an examination of his right, and have his patent repealed if it shall be found that he is not entitled to it. *Ibid.*, 500.

8. In proceedings under this section, the United States will not be substituted as plaintiffs in an action of *scire facias* in the place of the patentee. *Wood* v. *Williams*, Gilpin, 520, 524.—HOPKINSON, J.; Pa., 1834.

*Section* 11.

1. The officer intrusted to give copies of papers or drawings in patent cases, has no concern with the purpose for which asked. The policy of the law rather requires than forbids that copies should be given. *Anon.*, 1 Opin., 171.—PINCKNEY, Atty. Gen.; 1812.

2. A defendant being permitted, under § 6 of the act of 1793 to set up the defence that the plaintiff's specification does not contain the whole truth, he has under this section a right to call for and have a copy of the plaintiff's specification, and no conditions can be imposed upon the use of such copy. *Anon.*, 1 Opin., 376.—WIRT, Atty. Gen.; 1820.

3. The proviso to this section cannot be considered as opening to all persons indiscriminately the right to demand copies of papers respecting patents granted to others. As to others than a defendant, as provided for in § 6, it rests in the discretion of the department whether copies shall be furnished or refused. *Anon.*, 1 Opin., 718.—WIRT, Atty. Gen.; 1825.

4. Copies of papers cannot be taken by third persons. They must be made by the proper officer, and the fees paid therefor. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen.; 1831.

ACT OF 1800. CHAP. 25.

*Section* 1.

1. Under this act a foreigner, though having resided within the United States for more than two years, could not have a patent for an invention operated by him in another country, before he came here, as he could not take the oath required by this statute. *Duplat's Case*, 1 Opin., 322.—WIRT, Atty. Gen.; 1820.

2. By the provisions of this act, taken in connection with those of the act of 1793, citizens and aliens, as to patent-rights, are placed substantially upon the same ground, as to a right to a patent when the invention has been known or used before it was patented. In both cases the right is to be tested by the same rule. *Shaw* v. *Cooper*, 7 Pet., 316.—MCLEAN, J.; Sup. Ct., 1833.

*Section* 3.

1. This section gave jurisdiction only in actions *on the case; Held*, before, that a suit in equity, respecting a patent, in order to be cognizable in the Circuit Courts, must come within the provisions of the judiciary act of 1789, and that where the parties were all residents of the same state, such courts had not jurisdiction. *Livingston* v. *Van Ingen*, 1 Paine, 48, 54.—LIVINGSTON, J.; N. Y., 1811. [This defect was afterward remedied by the act of 1819. *Ed.*]

2. This section gives an action against any one who shall "make, devise, use,

*or* sell," the thing patented, and takes the place of § 5 of the act of 1793, which gave an action against any one who should "make, devise, *and* use, or sell," and which is repealed by § 4 of the act of 1800. This change was made because of some doubt whether the language of § 5 of the act of 1793, did not couple the making and *using* together, to constitute an offence, so that making, without using, or using without making, was not an infringement. *Whittemore* v. *Cutter*, 1 Gall., 432.—STORY, J.; Mass., 1813.

3. The doubt which arose under § 5 of the act of 1793, whether any person would be subject to the penalty therein mentioned, for *using* a machine which he had not also *made* and devised, is removed by this section, which repeals § 5 of the act of 1793, and subjects to damages any person who shall "make, devise, use, or sell," the thing patented. *Evans* v. *Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

4. Under this section, the sale, under execution, of the *materials* of patented articles, is not such a sale as makes the sheriff liable to an infringement. *Sawin* v. *Guild*, 1 Gall., 487.–STORY, J.; Mass., 1813.

5. Under this section the jury find single damages, and the court treble them in awarding judgment. *Lowell* v. *Lewis*, 1 Mas., 185.—STORY, J.; Mass., 1817.

6. Under this section if the jury find for the plaintiff, they are to find the actual damages sustained by him. The court will treble them. *Gray* v. *James*, Pet. C. C., 403.—WASHINGTON, J.; Pa., 1817. *Evans* v. *Hettick*, 3 Wash., 422.—WASHINGTON, J.; Pa., 1818.

7. This section fixed the amount of the recovery at three times the actual damage sustained. Trebling the damages, under the act of 1836, rests with the discretion of the court. *Guyon* v. *Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

### ACT OF 1819. CHAP. 19.

1. This act removes the defect that existed under the act of 1800, by which the Circuit Courts did not have jurisdiction of suits in equity, but only of actions on the case, where the parties were all residents of the same state. *Livingston* v. *Van Ingen*, 1 Paine, 54, N. Y., 1811 (note).

2. This act does not enlarge or alter the powers of the court over the subject matter of the cause of action. It only extends its jurisdiction to parties not before falling within it. It removed the objection that prior to it, 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, and gave the jurisdiction, although the parties were citizens of the same state. *Sullivan* v. *Redfield*, 1 Paine, 447, 448.—THOMPSON, J.; N. Y., 1825.

3. This act extends the jurisdiction of the Circuit Courts to all cases at law and in equity, arising under the patent laws; but there is nothing in the act which, either in terms or by necessary implication, renders that jurisdiction exclusive. *Burrall* v. *Jewett*, 2 Paige, 145.—WALWORTH, Chan.; N. Y., 1830.

4. Though the substance of this enactment, so far as it relates to the subject of patent-rights, is incorporated into § 17 of the act of 1836, and is no longer in force, *proprio vigore*, yet so far as it gave cognizance to the courts

of the United States of cases of copyright, it still remains in force, and is the only law conferring equitable jurisdiction on those courts in such cases. *Stevens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

5. There is nothing in this act which extends the equity powers of the courts to the adjudication of forfeitures. *Ibid.*, 455.

ACT OF 1832. CHAP. 162.

*Section 2.*

1. Under the patent laws, prior to 1836, if a patent was renewed, it was a new grant, independent of the old, and the patentee was entitled to the sole and exclusive benefit thereof, unless the licensees, or assignees, had by their original grant secured to themselves, by express covenant or grant, a right to the benefit of the renewed patent. *Washburn* v. *Gould*, 3 Story, 135.—STORY, J.; Mass., 1844.

2. Prior to this statute, the only mode of prolonging the term of a patent, beyond the original grant, was by means of private acts of Congress, upon individual applications. *Wilson* v. *Rosseau*, 4 How., 685.—NELSON, J.; Sup. Ct., 1845.

*Section 3.*

1. The proviso of this section is in affirmance of the principles laid down by the Supreme Court in *Pennock* v. *Dialogue*, 2 Pet., 1, 1829; *Grant* v. *Raymond*, 6 Pet., 241–245, 1832; and *Shaw* v. *Cooper*, 7 Pet., 314, 315, 1833. *McClurgh* v. *Kingsland*, 1 How., 207. —BALDWIN, J.; Sup. Ct., 1843.

2. As the exception in the proviso is limited to the use of the invention, under a special license, after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in *Pennock* v. *Dialogue*, 2 Pet., 1, 1829, whereby the patent would become void. *Ibid.*, 207.

3. The provision of this section is susceptible of but one construction, and that is, that the patentee may sustain an action for any use or violation of his invention, after the grant of the new patent. No prior use of a defective patent can authorize the use of the invention after the emanation of the renewed patent. *Stimpson* v. *West Chester R. R.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

4. To give to the patentee the fruits of his invention was its object, which would be defeated if a right could be founded on a use subsequent to the original patent, and prior to the renewed one. *Ibid.*, 402.

ACT OF 1836. CHAP. 357.

*Section 2.*

See also COMMISSIONER, G.

1. Under this section the chief clerk is the acting Commissioner whenever for any reason, the Commissioner is unable to discharge his duties. *Woodworth* v. *Hall*, 1 Wood. & Min., 256, 392. —WOODBURY, J.; Mass., 1846.

2. The courts will take notice, judicially, of the persons who, from time to time, preside over the Patent Office, whether permanently or transiently. *York & Maryland R. R.* v. *Winans*, 17 How., 41.—CAMPBELL, J.; Sup. Ct., 1854.

*Section* 4.

See also COPIES OF PAPERS.

1. A certified copy of an assignment is competent evidence, and the party cannot be required to produce the originals. *Brooks* v. *Bicknell*, 3 McLean, 436.—McLEAN, J.; Ohio, 1844.

2. Certified copies of papers and drawings, on file in the Patent Office, must be received in evidence when offered. If they are discordant, they may destroy the effect of each other; but they need not concur in every particular. *Emerson* v. *Hogg*, 2 Blatchf., 12.—BETTS, J.; N. Y., 1845.

3. If copies of a patent are erroneous, the Commissioner of Patents has the power, and ought to make them conform to the patent itself, and to the record. *Woodworth* v. *Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

4. Certified copies of papers, in the Patent Office, are *prima facie* evidence of the genuineness of the original on file, and absolute evidence of the correctness of the copies from the record. *Parker* v. *Haworth*, 4 McLean, 371.—McLEAN, J.; Ill., 1848.

5. The Commissioner of Patents having under his care and custody the records as to patents, it is his duty to give authenticated copies to any person demanding the same, on payment of the legal fees; but a demand, accompanied by rudeness and insult, is not a legal demand. *Boyden* v. *Burke*, 14 How., 583.—GRIER, J.; Sup. Ct., 1852.

6. A certified copy of an assignment of a patent, from the Patent Office, is *prima facie* evidence of the genuineness of the original. *Lee* v. *Blandy*, 2 Fisher, 91.—LEAVITT, J.; Ohio, 1860.

*Section* 5.

See also PATENT, D. 1, E.

1. Under the patent laws, since 1836, the specification is always annexed to, and forms a part of the letters patent. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Me., 1843.

2. The phraseology of this act, in respect to what the patent shall contain, was changed from that contained in the acts of 1790 and 1793, in order to conform to the usage and construction under the act of 1793 (of inserting the whole descriptive portion of the petition in the patent), as such course sometimes was misunderstood, and led to misconstructions. *Hogg* v. *Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

*Section* 6.

As to subject matter of patent, see PATENT, A.

As to how invention should be described, see SPECIFICATION, B.

As to patent including more than one invention, see PATENT, D. 2.

See also DRAWINGS; MACHINE, B.; OATH.

1. This section seems clearly to show that a patentee may lawfully unite in one patent, all the modes of applying his invention contemplated, and all the different sorts or modifications of machinery, by which it may be applied, and if each were new, the patent would cover them all. *Wyeth* v. *Stone*, 1 Story, 292.—STORY, J.; Mass., 1840.

2. The words "by others," in this section, were probably added by way of

explanation of the doubt formerly entertained on the subject, whether a use by the patentee himself of his invention, before application, would deprive him of a right to a patent; and to confirm the decision in *Pennock* v. *Dialogue*, 2 Pet., 18–22. *Reed* v. *Cutter*, 1 Story, 597.—STORY, J.; Mass., 1841.

3. The words "not known or used *by others* before his discovery or invention," do not denote a plurality of persons, by whom the use should be known, but that the use should be by some other person or persons than the patentee. *Ibid.*, 597, 598.

4. §§ 6 and 15 of the act of 1836, and § 9 of the act of 1837, are to be construed, as to originality of invention, as though they were embodied in one act. *Smith* v. *Ely*, 5 McLean, 84.—McLEAN, J.; Ohio, 1849.

5. The second set of drawings required by this act, are unnecessary until the patent issues, and need not accompany the application. *French* v. *Rogers*, 1 Fisher, 136.—KANE, J.; Pa., 1851; *O'Reilly* v. *Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

6. The things specified in this section are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent, may show that they have not been complied with, and in that mode defeat the action of the supposed inventor. *Ransom* v. *Mayor, &c.*, 1 Fisher, 257.—HALL, J.; N. Y., 1856.

*Section 7.*

As to withdrawal, see APPLICATION, C. See also PRIOR KNOWLEDGE AND INVENTION.

1. The Commissioner is bound to issue a patent in the case and under the circumstances mentioned in this section. He has no discretion about it. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. When a patent has issued, the jurisdiction of the Commissioner is exhausted, and he has no further control over it, except under § 13, upon application for a reissue. *Pomeroy* v. *Commison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

3. The renewal oath required by this section is required only when the applicant persists in his application, after having been informed of the defects of his specification. This happens before rejection. If the rejection is final, though upon a first examination, no new oath is necessary to enable him to appeal. *Crooker, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

4. The words "prior to the application," in § 7 of the act of 1836, refer only to the "public use or sale (of the invention, with the applicant's consent or allowance," and do not refer to any thing else. *Bartholomew* v. *Sawyer*, 4 Blatchf., 350.—INGERSOLL, J.; N. Y., 1859.

5. The words "prior to the alleged invention of the applicant," refer to an invention or discovery of some one, other than the applicant, in this country, and also to a patent or description in this or some foreign country. *Ibid.*, 351.

6. The true meaning of this section is, that a patent shall issue to the applicant, and be valid, if he is the originator and author of a useful invention, unless the thing invented by him has, prior to his alleged invention or discovery, been invented, or discovered, or used, by some one else in this country; or unless the invention of the applicant has been patented, or described in some printed

publication, in this or some foreign country, prior to the alleged invention or discovery of the applicant; or has been on sale with the applicant's consent, prior to his application for a patent. *Ibid.*

7. An original application or specification cannot be amended, except under this section, to conform the specification to the alterations suggested by the Commissioner. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

*Section* 8.

See also APPEALS, B.

1. Under this section no appeal can be taken from the decision of the Commissioner of Patents, unless the *application* for a patent is rejected. In no case can an appeal be taken to the granting of a patent. *Pomeroy* v. *Commison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

2. The words "either," in this section—when speaking of the parties who may appeal—applies to the words "such applicants," i. e., *either* of *such applicants*. This construction is sustained by the language below, authorizing the judge, on appeal, "to determine which or whether *either of the applicants* is entitled to *receive* a patent as *prayed* for." *Ibid.*

3. There is no limitation of time as to an appeal from a decision of the Commissioner of Patents to the justices of Circuit Court. *Janney, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

4. Under the act of 1836, §§ 7 and 8, two classes of cases are provided for. An appeal is given by § 7 to an applicant, where there is no opposing party; and by § 8, where there are interfering applications. And there is nothing in the repealing act of 1839 which takes away or impairs such right. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C.; 1853.

5. Under this section a patentee has equal right of appeal from a decision of the Commissioner of Patents in favor of an applicant, that an applicant has from a decision in favor of a prior patentee. *Babcock* v. *Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

6. The right of appeal is now considered as established in accordance with this last decision. [*Ed.*]

7. Appeals are now taken to the justices of the Circuit Court of the District of Columbia, instead of to the board of examiners created by this section. See act of 1839, § 11, and act of 1852, § 1.

*Section* 9.

By § 10 of the act of March 2, 1861, all laws discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are repealed; and a new rate of fees enacted, uniform for all. [*Ed.*]

*Section* 10.

1. Under this section, if an inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such person in trust for the heirs at law or devisees of the inventor. *Stimpson* v. *Rogers*, 4 Blatchf., 335.—INGERSOLL, J.; Ct., 1859.

2. It need not, however, be expressed in the patent that it is issued to such executor *in trust for* those entitled to it. It will be sufficient that the patent set forth that it was issued to the grantee as executor. What the executor does in relation to the property of the devisor, he does in trust for those to whom such property is given by the will. *Ibid.*

*Section* 11.

See also ASSIGNMENT, A., B., C.

1. The provision as to recording assignments within three months is merely directory, and except as to intermediate *bona fide* purchasers, without notice, any subsequent recording is sufficient. *Brooks* v. *Byam*, 2 Story, 542.—STORY, J.; Mass., 1843; *Pitts* v. *Whitman*, 2 Story, 615.—STORY, J.; Maine., 1843; *Blanch. Gun-Stock Fac.* v. *Warner*, 1 Blatchf., 271.—NELSON, J.; Ct., 1846.

2. A mere license need not be recorded; it is not an exclusive right. *Brooks* v. *Byam*, 2 Story, 542, 543.—STORY, J.; Mass., 1843.

3. 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 country. *Washburn* v. *Gould*, 3 Story, 131.—STORY, J.; Mass., 1844.

4. This section provides for but three kinds of assignments: 1st, As to the whole interest; 2d, As to an undivided part; and 3d, An exclusive right in any district. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 339, 340.—GRIER, J.; Pa., 1849.

5. This statute renders the monopoly capable of subdivision as to locality, and in no other way. *Ibid.*, 340.

6. Under this section an assignment of a patent may be made as well before the issuing of the patent as afterward. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates; and when the party has acquired an inchoate right, an assignment of it is legal. *Gayler* v. *Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850.

7. Under this section an assigument must be recorded within three months to defeat the right of a subsequent purchaser without notice, and for a valuable consideration. 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. Within that period he must protect himself in the best way he can, as an unrecorded assignment would prevail, but it must be one in writing that may be recorded. *Gibson* v. *Cook*, 2 Blatchf., 148.—NELSON, J.; N. Y., 1850.

*Section* 12.

1. This section, providing for a caveat, is for the benefit of the inventor, but is not necessary for the preservation of his right, nor does the omission to file a caveat impair his title. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. It only enables him to have notice of any interfering application. It, however, gives no notice to the world, nor even to the interfering applicant; and is notice to the Commissioner only. *Ibid.*

3. The caveat is to set "forth the de-

sign and purpose" of the invention, and "its principal and distinguishing characteristics," but it is not necessary that it should explain the principle involved, or the modes in which it can be applied, nor how it is distinguished from other inventions. Nor is it necessary to accompany it with specimens of ingredients, or compounds, or models, or drawings, or with an oath of invention or discovery. *Anon.*, MS., Opin.—BLACK, Atty. Gen.; 1857.

4. The Commissioner can perform no act upon it but filing it, nor in consequence of it, except to give the caveator notice of a conflicting application. *Ibid.*

5. The purpose of a caveat is to save the discoverer of an invention from the effect of the rule of law that gives to the inventor who first adapts his invention to practical use the right to the grant of a patent: and if the Commissioner complies with the terms of § 12 of the act of 1836 as to giving the caveator notice of any interfering application, it is to secure him against the effect of the rule. *Phelps, Dodge & Co.* v. *Brown Bros.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

6. But if the Commissioner accidentally omits to give the caveator the notice required, his rights will not be prejudiced thereby. *Ibid.*, 364.

*Section* 13.

See also REISSUE OF PATENT.

1. This section made no material change from § 3 of the act of 1832, in respect to the use of an invention, under a defective patent, conferring any right to continue such use under the reissued patent; but any person using an invention protected by a renewed patent, subsequently to the date of the act of 1836 (July 4), is guilty of an infringement, however long he may have used the same, after the date of the defective and surrendered patent. *Stimpson* v. *West Chester R. R.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

2. Under this section the power to surrender a patent and take out a renewal thereof, is vested exclusively in the patentee, his executors, administrators, or assigns; and there is nothing restricting such right, because of special or limited grants or licenses previously made. *Smith* v. *Mercer*, 4 West. Law Jour., 52.—KANE, J.; Pa., 1846.

3. It is not the meaning of this section that the patentee, in his reissue, must describe and claim, in his new specification, either in words or idea, just what he described and claimed in his old one; but his specification must be of the same invention, and he cannot embrace a different subject matter than that he sought to patent originally. *French* v. *Rogers*, 1 Fisher, 138.—GRIER, KANE, JJ.; Pa., 1851.

4. There may be more than one reissue of the same patent; the surrender and reissue should be allowed to follow each other as often as the inventor is content to be more specific or more modest in his claims. *Ibid.*, 137.

5. This section may be regarded as affirming the propriety of the usage which had obtained under the former laws, and under which a second reissue was allowed, as well as the first. *Ibid.*, 137.

6. An improvement may be annexed, under this section, to the specification of the original patent, so as to make it form a part of the original patent: but there is nothing that forbids an inventor

taking out a new patent for the improvement, if he prefers it. *O'Reilly* v. *Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

7. The power to correct mistakes in a patent is confided to the Commissioner of Patents under this section, and does not belong to the courts. The courts can only construe the specification and claim, as it stands. *Kittle* v. *Merriam*, 2 Curt., 478.—CURTIS, J.; Mass., 1855.

8. By this section, the sole right to surrender is given, 1st. To the patentee, if he is alive and has made no assignment of the original patent; 2d. To the executors and administrators of the patentee, after his decease, where there has been no such assignment; and, 3d. 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*, 4 Blatchf., 209.—INGERSOLL, J.; Ct., 1858.

9. Where, however, there has been an assignment of an undivided part of the whole patent, in such case the assignee and patentee become joint owners, and should join in the surrender, and if they do not, it will be invalid, unless the part owner not joining shall ratify it. *Ibid.*, 209.

10. This section gives to the patentee the right to correct his description or specification, when its imperfection has arisen from inadvertency, accident, or mistake. But the only condition on which this can be done is that the original patent is *inoperative* or invalid by reason of a failure to comply with the requirements of the statute. The proceeding is therefore equivalent to a distinct admission that the patent has no validity entitling a patentee to an action for its infringement. *Moffitt* v. *Garr*, 1 Fisher, 613.—LEAVITT, J.; Ohio, 1860.

11. The words, "it shall be *lawful* for the Commissioner, &c., to cause a new patent to be issued," in § 13, act of 1836, are to be construed as *mandatory*, and to be of the same import as if the words had been, "it *shall be the duty* of the Commissioner," &c. The true meaning is, the Commissioner is to have no discretion in the case provided for in the section. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

12. When the case provided for arises, he is *commanded* to exercise the power, whether he thinks it just and right to exercise it, or not; he has no discretion. *Ibid.*

13. What the legislature designed to secure to patentees by this section was, to enable them to cure *honest mistakes*, and to get *substantially protection for the same invention* they had made and *intended* to be patented, when the original patent was granted. The only limitation in the statute is that the invention shall be the same. *Ibid.*

14. To prove that his invention, claimed on the reissue, is the same made and intended to be patented, he is not limited to the specification, models, or drawings of his original patent, but he may go outside of these and show by other proof, that his invention, at the time of the original patent, was such as he sought to protect by his reissue. *Ibid.*

*Section 14.*

See also ACTIONS, B. 1, 3; DAMAGES.

1. The assignees of an exclusive right in a patent, are the proper persons to maintain an action for a violation of it.

*Washburn* v. *Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1844.

2. The grantee of an exclusive right under a patent, even though such right is limited to a particular number of machines, may maintain an action for infringement. *Wilson* v. *Rosseau*, 4 How., 686, 688.—NELSON, J.; Sup. Ct., 1845.

3. Under this section, in connection with § 11 of the act of 1836, an action is given only to such party—composed of one or more persons—as possesses the whole interest in the patent. *Suydam* v. *Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

4. Where a party has an interest in only a part of a patent, as a license to use the invention, he cannot maintain an action for an infringement. *Ibid.*, 23.

5. *Actual damages*, according to this section, are the sum fixed by the verdict. The court may render judgment for three times the amount of the verdict. *Stephens* v. *Felt*, 2 Blatchf., 38.—BETTS, J.; N. Y., 1846.

6. Under this section, it rests in the discretion of the court whether the damages shall be trebled. Under the act of 1800, the amount of recovery was fixed at three times the actual damages sustained. *Guyon* v. *Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

7. But under this section the court may increase the damages, though the plaintiff is not entitled to recover costs under § 9 of the act of 1837, by reason of neglect in filing a disclaimer until after action was commenced. *Ibid.*, 246.

8. Previous to the act of 1836, the court were compelled to treble the damages. Since that act they are not compelled to do so, but may increase them or not, at their discretion. *Stimpson* v. *Railroads*, 1 Wall., Jr., 166.—GRIER, J.; Pa., 1847.

9. Actual damages does not mean exemplary, vindictive damages. *Ibid.*, 169.

10. The word "assignees," in this section, must be construed by reference to § 11 of the same act, as meaning the assignee of a whole interest, or an undivided one, or an exclusive local right. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849.

11. To enable an assignee of a sectional interest in a patent to sue in his own name under this section, he must have the exclusive right, or entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself, as well as others. *Gayler* v. *Wilder*, 10 How., 494.—TANEY, Ch. J.; Sup. Ct., 1850.

12. § 4 of the patent act of 1790, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. § 5 of the act of 1793, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. The act of 1800 provided that an infringer should pay three times the actual damages sustained. § 14 of the patent act of 1836 confines the jury to the actual damages sustained by the patentee. The power to increase them as punitive damages, is committed to the discretion and judgment of the court. *Seymour* v. *McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

*Section* 15.

See also DEFENCES; GENERAL ISSUE; PRINTED PUBLICATION; PRIOR KNOWLEDGE AND INVENTION; PRIOR USE.

1. The public use of an invention, before application, referred to in this section, means a public use with the

consent of the inventor, either generally allowed or acquiesced in, or at least unlimited in time, or extent, or object, and not merely experimental or temporary, as an act of accommodation or kindness. *Wyeth* v. *Stone*, 1 Story, 281.—STORY, J.; Mass., 1840.

2. The defence specified in this section, "that the patentee was not the original and first inventor or discoverer of the thing patented," is complete, without showing that the first inventor had put his invention in practice. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

3. The clause using "reasonable diligence in adapting and perfecting," an invention, is applicable only to the case of a defence that the plaintiff's patent had been surreptitiously or unjustly obtained; and if pleaded it may be necessary for the defendant to show, in order to vacate the patent, that he was using due diligence when the patent was obtained. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

4. The provision in this section, requiring notice of prior knowledge and use, was intended to guard against surprise from such evidence as was given in Whitney's case. Though his invention was one of undoubted originality, two persons were brought forward, one of whom testified that he had seen such an invention in England seventeen years before, and the other that he had seen one in Ireland. *Wilton* v. *Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847.

5. The provisions of §§ 7 and 15 of the act of 1836, introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad—that is, a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty. Gen.; 1848.

6. A *bona fide* inventor in this country, and who believed himself to be the original and first inventor, at the time of his application, and did not know or believe his invention had before been known or used, is entitled to a patent for his invention, though the same invention may have been known and used in a foreign country, provided it had not been patented or described in any printed publication. *Ibid.*

7. The words in this section, "unless such person was using reasonable diligence in adapting and perfecting the same," constitute a *qualification* of the preceding language of the section, so that an inventor who has first actually perfected his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in *fact invented* by another, *unless the latter* was at the time *using reasonable diligence* in adapting and perfecting the same. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

8. The defence that the patentee had "surreptitiously and unjustly obtained the patent, for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same," does not necessarily imply bad faith on the part of the patentee, against whose patent this defence is set up. The words were intended to be used, and are used, in their broadest sense. *Phelps, Dodge & Co.* v. *Brown Bros.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

9. The meaning of the word *patented*, in the phrase "patented in any foreign country," is that the invention shall

have been made patent to the world. In England, therefore, an invention is not patented until the complete specification is filed, which need not be until six months after the date of the letters patent. *Howe* v. *Morton*, MS.—SPRAGUE, J.; Mass., 1860.

*Section* 16.

1. Proceedings under this section, and § 10 of the act of 1839, in equity, against the Commissioner of Patents, to compel him to issue a patent, must be commenced in the Circuit Court of the United States, for the District of Columbia, and the Circuit Courts in the various states have no jurisdiction. *Prentiss* v. *Ellsworth*, Mir. Pat. Off., 35, 36.—RANDALL, J.; Pa., 1846.

2. The assignee of an invention, by virtue of an assignment made before patent issued, may file a bill in his own name, under this section and § 10 of the act of 1839, against a patentee to whom a patent issued on the rejection of the assignor's application, for the purpose of annulling the patent issued, and having one granted to him as assignee. And such assignment need not have been recorded before suit brought; it will be sufficient, if it is recorded at any time before the issuing of the patent. *Gay* v. *Cornell*, 1 Blatchf., 509, 510.—NELSON, J.; N. Y., 1849.

3. Upon a bill filed to declare a patent, granted by the Commissioner, after an interference, invalid, or inoperative, under this section, and amended by § 10 of the act of 1839, the hearing is altogether independent of that before the Commissioner, and takes place upon such testimony as the parties may see fit to produce, agreeably to the rules and practice of a court of equity. The evidence before the Commissioner is not evidence in such a suit, except by consent of parties; nor are the parties restricted to the testimony used before the Commissioner. Either party is at liberty to introduce additional evidence. *Atkinson* v. *Boardman*, MS.—NELSON, J.; N. Y., 1851.

*Section* 17.

See also COURTS, B. 1.

1. "Other reasonable cases," under this section, in which appeals and writs of error may be allowed to the Supreme Court, must be limited to cases which relate to the construction of the patent laws, and such as involve important and not trifling matters, connected with those laws, and questions really doubtful. *Allen* v. *Blunt*, 2 Wood. & Min., 157.—WOODBURY, J.; Mass., 1846.

2. Under this section, if a writ of error is allowed by the court as "reasonable," such writ must bring up the whole case for consideration, and the court below cannot decide as to what particular points shall be taken up. *Hogg* v. *Emerson*, 6 How., 478.—WOODBURY, J.; Sup. Ct., 1847.

3. The word "reasonable" applies to the cases, rather than to any discrimination between the different points in the cases. *Ibid.*, 478.

4. A judge at chambers may allow a writ of error under this section, in the "other cases" referred to, where the judgment is less than $2,000. *Foote* v. *Silsby*, 1 Blatchf., 544.—NELSON, J.; N. Y., 1850.

5. The "other cases" in this section, does not include a suit in equity to set aside an assignment of a patent. *Wilson* v. *Sandford*, 10 How., 101, 102.—TANEY, Ch. J.: Sup. Ct., 1850.

6. The discretionary power, as to granting writs of error in patent cases, vested in the Circuit Courts by this section, is confined to cases which involve the construction of the patent laws, and the rights of patentees under them. *Sizer* v. *Many*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

7. Under this section the Circuit Courts have jurisdiction, irrespective of the right of the plaintiff to an injunction, or a demand for one. *Nevins* v. *Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

8. The natural interpretation of the language of this section seems to be, that Congress has bestowed upon this court a common jurisdiction, both on its law and equity sides, over all cases under the patent laws, and that no suit of that character can be maintained at law which may not also be prosecuted in equity. *Ibid.*

*Section* 18.

See also EXTENSION OF PATENT.

1. The decision of the Board of Commissioners, under this section, is conclusive within the scope of its authority. *Brooks* v. *Bicknell*, 3 McLean, 258.—McLEAN, J.; Ohio, 1843.

2. In this section the word *patentee* is used as equivalent to *inventor*. *Woodworth* v. *Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844.

3. The right of renewal is not limited to future patents, but also applies to the past. *Ibid.*, 179, 180.

4. The object of the clause as to assignees is to preserve any previous contracts of assignment, in the sense in which both parties understood and intended at the time it was made, and to secure to the purchaser the right he had intended to buy, and which the patentee intended to sell. *Wilson* v. *Turner*, 7 Law Rep., 530.—TANEY, Ch. J.; Md., 1845.

5. The extension of a patent, under this section, does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any exclusive right. But the benefit of such renewal is limited to those who were in the use of the patented article at the time of the renewal, and saves to such persons the right to use the machines held by them at the time of such renewal. *Wilson* v. *Rosseau*, 4 How., 682.—NELSON, J.; Sup. Ct., 1845.

6. The meaning of the words "thing patented" in the latter part of this section, when construed in connection with the simple right to *use*, without the right to *make* and *vend*, has reference to the machine patented. *Ibid.*, 683.

7. The phrase "to the extent of their interests therein," means their interests in the patented machines, be that interest in one or more at the time of the extension. *Ibid.*, 683.

8. This section authorizes the extension of a patent on the application of an administrator; and this though the patentee during his lifetime had disposed of all his interest in the existing patent, and having at the time of his death no interest in it. *Ibid.*, 686.

9. But one extension is provided for by this section. *Gibson* v. *Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

10. The words of this section as to assignees and grantees, seem to convey the impression that something more than the mere ownership of existing machines was intended, and that they were intended to embrace all classes of

such assignees and grantees, and all inventions, whether of machines, processes, or compositions of matter, and to embrace rights and interests which were different in extent, either of time or territory, or both. *Day* v. *Union Rub. Co.*, 3 Blatchf., 497.—HALL, J.; N. Y., 1856.

11. But such right is limited to a right to *use*, although the person holding it may also have held, during the original term, an exclusive right to use, to make, and vend. And such right to use is secured only to the extent of the respective interests of the assignees or grantees therein. *Ibid.*

ACT OF 1837. CHAP. 45.

*Section* 2.

1. Where a patent was granted in 1834, to which no drawing was attached, nor any reference made thereto; and in June, 1837, such patent was recorded anew, which patent was also extended for seven years on the 20th of September, 1848, and in November, 1848, a drawing of the invention, with written references was filed, with an affidavit of the patentee that such drawing was a true delineation of his invention, *Held*, in an action of infringement, that under this section a certified copy of such drawing was admissible in evidence in connection with the patent and specification, and that the whole together made *prima facie* evidence of the particulars of such invention. *Winans* v. *Schenec. & Troy R. R.*, 2 Blatchf., 283, 285, 298.—NELSON, J.; N. Y., 1851.

2. Such a drawing, however, as a general rule will not be effectual to correct any material defect in the specification, unless it should appear that it corresponded with drawings which accompanied the original application for a patent: otherwise, in case of discrepancy between the drawings and specification, the latter must prevail. Nor will such a drawing have the same effect as if it had been referred to in the specification. *Ibid.*, 299.

*Section* 3.

1. Where a patent was obtained in 1834, the original of which and the drawings were destroyed by fire in 1836, and the patentee, under the act of 1837, afterward in 1841 filed a copy of his patent, and deposited a drawing which, however, was not verified, but which he verified in February, 1844; and subsequently, in March, 1844, considering such copy imperfect, filed another and a fuller drawing, and commenced suit in May, 1844; *Held*, that a certified copy of such second drawing was properly received in evidence in such action. *Emerson* v. *Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

2. When such drawings are put on file they become public records, and copies of them must be received in evidence. If they are discordant, one may destroy the effect of the other. *Ibid.*, 12.

3. Under this section drawings, when burnt, may be restored, and if in some respects erroneous, they can be corrected. *Hogg* v. *Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

4. But it would not be proper to leave the drawings so long not restored or corrected as to evince neglect, or a design to mislead the public. *Ibid.*, 606.

*Section* 5.

See also REISSUE OF PATENT.

With respect to reissues this section and § 13 of the act of 1836 are to be taken together in construction, and the most just and equitable extent to which the terms of the law in its true spirit will admit of, ought to be adopted. If the patent be defective or insufficient, either in the specification or *claim*, the patentee has a right, in the absence of fraud and deception, to have a reissue for each separate and distinct part, effectually to cure the defect: and he has the right to *restrict* or *enlarge* his claim, so as to give it operation, and effectuate his invention. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

*Section 6.*

See also ASSIGNEE, B. 3.

1. This is an enabling statute. Prior to its passage, letters patent could only issue to the inventor; and after they were issued they were assignable so as to give the assignee, in whole or in part, legal rights. The act of 1837 gave the right to the assignee or assignees to have the patent issued to him or them, and not to the inventor. *Anon.*, 4 Opin., 400.—MASON, Atty. Gen.; 1845.

2. Under this section patents cannot issue jointly to the inventor, as such, and to the assignee of a partial interest: but must issue to the assignee or assignees of the whole interest. *Ibid.*, 401.

3. After the assignment of the invention under this section, by which the inventor divests himself of all interest therein, and transfers it to the assignee, although the application for a patent must be in his name, still, for all substantial purposes, and in judgment of law, the assignee is the party making the application. *Gay* v. *Cornell*, 1 Blatchf., 509.—NELSON, J.; N.Y., 1849.

4. The provision of this section requiring duplicate drawings, though directory in its terms, is not a condition; and it has reference in point of time, to the issuing of the patent, and not to the filing of the petition for it. Duplicate drawings need not be filed at the time of the application, and such is the interpretation of the Patent Office. *French* v. *Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851; *O'Reilly* v. *Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

5. If an inventor assign all his right in an invention, the assignee may have the patent issued to himself. But if the assignment be only partial, though the part excepted is small, the assignee has no legal claim to the patent. It must be issued in the name of the inventor, and be held by him in trust for the use of the assignee to the extent of the equities he has by virtue of his contract. *Ager's Case*, MS., Opin.—BLACK, Atty. Gen.; 1859.

*Section 7.*

See also DISCLAIMER.

1. The disclaimer mentioned in this section applies solely to suits pending when the disclaimer is filed, and the disclaimer mentioned in § 9 applies solely to suits brought after the disclaimer is filed. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

2. *Semble*, that a disclaimer, under this section should not only disclaim what is not claimed as new, but should also distinctly set forth what part of the invention is still claimed, as it is manifestly designed to act as a new specification. *Lippincott* v. *Kelly*, 1 West. Law Jour., 515.—IRVIN, J.; Pa., 1844.

3. A disclaimer of a part of an invention cannot affect a prior grantee under the patent, unless he accepts of it; he may refuse to be affected by it. *Smith* v. *Mercer*, 4 West. Law Jour., 52.—KANE, J.; Pa., 1846.

4. Where a disclaimer made by a patentee stated that "it was to operate to the extent of the interest in said letters patent vested" in the patentee; *Held*, that it fairly imported on its face, that the patentee was the owner of the entire interest in the patent, and if so, there was a substantial compliance with the statute, as to the disclaimer stating the interest of the party making it. *Foote* v. *Silsby*, 1 Blatchf., 449, 450, 461.—NELSON, J.; N. Y., 1849. [Affirmed, *Silsby* v. *Foote*, 14 How., 221.—CURTIS, J., Sup. Ct., 1852.]

5. Under this section the owner of a sectional interest may disclaim a part of the thing patented, which will be considered a part of the original patent, to the extent of his interest; but the patentee is not compelled to join in it, nor will it affect any one except him making it, and those claiming under him. *Potter* v. *Holland*, 4 Blatchf., 217.—INGERSOLL, J.; Ct., 1858.

6. After such a disclaimer a different claim of right is secured to the disclaimant from what is purported to be secured to the patentee; different claims of right in the same invention are secured to different sectional owners. *Ibid.*, 217.

7. The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patent from embracing the part so disclaimed, on a reissue of his patent. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

### *Section 8.*

This section, so far as it provides for additions to existing patents, is repealed by act of March 4th, 1861. [*Ed.*]

### *Section 9.*

See also DISCLAIMER.

1. § 9 of the act of 1837, contemplated the rule of the common law—that if a patent embraces different machines, and any one of them is not new, or was not the invention of the patentee, or the like, the whole patent would be void—as being then in full force, and therefore sought to mitigate it by providing that under the cases therein mentioned, the patent should be good to the extent of the patentee's invention. *Wyeth* v. *Stone*, 1 Story, 288, 289.—STORY, J.; Mass., 1840.

2. The disclaimer mentioned in this section applies solely to suits brought after the disclaimer is filed. *Ibid.*, 294.

3. This section is intended to cover "inadvertences and mistakes" of law, as well as inadvertences and mistakes of fact. *Ibid.*, 293, 295.

4. The doctrine that a patentee may take out a valid patent for a combination, and in it include a right to each distinct improvement, is confirmed by the obvious intent of this section, which gives a patentee a right of action for a piratical use of any of his invented improvements, which is distinctly stated in his patent, though he may by mistake, accident, or inadvertence, have claimed others of which he was not the inventor. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Me., 1843.

5. Prior to the act of 1836, if the pat-

entee claimed more than he had invented, his patent was void. But under this section the patent is not absolutely void, because the patentee claims more than he has actually invented, but is valid for so much as is truly and *bona fide* his own; but to secure the benefits of this section, the specification must state in what the improvement consists. *Peterson* v. *Wooden*, 3 McLean, 249.—McLEAN, J.; Ohio, 1843.

6. Prior to the act of 1836, a patent was void if the claim extended beyond the invention. Under § 6 of the act of 1836, it was void if a substantial part had been patented, or described in a printed publication. § 15 of the same act, saved the patent from being void, if the patentee believed himself to be the first inventor. § 9 of the act of 1837 enlarged the rights of the patentee, providing, notwithstanding § 15 of the act of 1836, that the pateut should not be void, where he had acted in good faith, if through mistake or inadvertence he had claimed more than he had invented, and that he might maintain suit on the part actually invented by him, provided he filed, within a reasonable time, a disclaimer of the parts not invented by him. *Smith* v. *Ely*, 5 McLean, 84, 85.—McLEAN, J.; Ohio, 1849.

7. Where a patent contains several claims, and the invention embraced in one is not new, or is useless, the patentee under this section and § 7 may still maintain an action for an infringement, although he did not, before action brought, make a disclaimer of the part claimed without right; but he will not be entitled to costs. *Hall* v. *Wiles*, 2 Blatchf., 198.—NELSON, J.; N. Y., 1851.

8. And if in the progress of a trial it turns out that a disclaimer ought to have been made as to part claimed, the plaintiff may still recover, but will not be entitled to costs. *Ibid.*, 198.

### ACT OF 1839. CHAP. 88.

#### *Section* 6.

1. The date of a patent may be altered to correspond with that of a foreign patent, previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. *Detmold's Case*, 4 Opin., 335.—NELSON, Atty. Gen., 1844.

2. Under this section, if the domestic patent, in a case where a foreign patent has been previously obtained, purports to give an exclusive right for fourteen years from its date, instead of from the date of the foreign patent, it is void, as having been issued without authority of law; but the error is not fatal, and may be corrected on application to the Patent Office. *Smith* v. *Ely*, 5 McLean, 78, 80.—McLEAN, J.; Ohio, 1849.

3. The proviso of this section, as to when a home patent shall bear the date of a foreign patent, relates only to such patents as are *applied for* here *after* the issue of a foreign patent. *French* v. *Rogers*, 1 Fisher, 136.—GRIER, KANE, JJ.; Pa., 1851.

4. Where, therefore, an application for a patent was made in this country in April, 1838, and acted on in that month, but a patent was not actually issued until June 20th, 1840, at which time the patent was dated, and a foreign patent was obtained in August, 1838, *Held*, as the application here was before the foreign patent, that the grant of the patent here was under the general enactments of the act of 1836, and its term was properly from its date. *Ib.*, 136.

5. A patent is not void, because it does not, on its face, bear the same date with a foreign patent. If it is not, for any reason, exempt from the operation of the statute, on such subject, the only effect is to limit the monopoly to fourteen years from the date of the foreign patent. *O'Reilly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

*Section 7.*

See also PRIOR USE.

1. The seventh section of the act of 1839 allows the use of an invention, even with leave of the inventor, for two years before application for a patent, without invalidating his right to a patent; *a fortiori*, the use by a third person, or a subsequent inventor, after the invention and before the issuing of a patent to the first inventor, without his consent, is no bar to the issuing of a patent to the first inventor. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. Under this section the purchaser must be a purchaser from the inventor himself, before his application for a patent, and not from a wrongdoer without his knowledge or against his will. *Pierson* v. *Eagle Screw Co.*, 3 Story, 406, 407.—STORY, J.; R. I., 1844.

3. This section, allowing the use and sale of an invention for two years before the application for a patent, is in the nature of a statute of limitations. *Hovey* v. *Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

4. The object of this section is twofold: first, to protect the person who has used the thing patented, from any liability to the patentee or his assignee; and, second, to protect the rights granted to the patentee against any infringement by any other persons. *McClurg* v. *Kingsland*, 1 How., 208, 209.—BALDWIN, J.; Sup. Ct., 1843.

5. This section relieved the patentee from the effects of the former laws and their construction by the court, while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor, which, if given before the application for a patent, would justify a continued use of it after it issued, without liability. *Ibid.*, 209.

6. It is not limited to patents for machine manufactures and compositions of matter, but embraces inventions for modes of doing a thing, as a new improvement in the act of casting iron. *Ibid.*, 209.

7. Nor is it to be construed as confined to a specific machine as distinguished from an invention or thing patented, but the words, "newly invented machine, manufacture, or composition of matter," and, "such invention," mean the "invention patented," and the words "specific machine," refer to "the thing as originally patented," whereof the right is secured by patent, but not to any newly invented improvement on a thing once patented. *Ibid.*, 210.

8. This section has exclusive reference in respect to the use of a machine to an original patent, and not to a renewal or reissue of it. *Stimpson* v. *West Chester R. R.*, 4 How., 403.—MCLEAN, J.; Sup. Ct., 1845.

9. The sale of the product of an invention is not a sale of the thing invented, within this section. The sale there spoken of must be a sale of the invention, or patented article. *Booth* v. *Garelly*, 1 Blatchf., 250.—NELSON, J N. Y., 1847.

10. This section virtually extends the patentee's privilege to sixteen years instead of fourteen. *McCormick* v. *Seymour*, 2 Blatchf., 254.—NELSON, J.; N. Y., 1851.

11. This section gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

12. The provision in § 7, of the act 1839, as to the use of an invention, relates to the case of an use, sale or license to use, given or made and claimed under the inventor, who admits and claims the privilege. The clause should read thus: "The patent shall not be held invalid by reason that the inventor has sold or allowed his invention to be used prior to the application for a patent, unless he has abandoned it to the public, or that such sale or prior use has been for more than two years prior to such application for a patent." *Ellithorpe* v. *Robertson*, MS. (App. Cas.) D. C.—MORSELL, J.; 1858.

13. The privilege granted by § 7 of the act of 1839, is applicable only to the inventor, or those claiming under him, and this construction is sustained by *Peirson* v. *Eagle Screw Co.*, 3 Story, 402. The use of an invention by an independent inventor, or under a separate and independent patent, is not such a case as is contemplated by that section. *Beech* v. *Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

14. This section provided a remedy for cases where the conduct of the party as to the sale of his invention did not show an actual abandonment. It also secures the rights of those who may have purchased or constructed any newly-invented machine prior to the application for a patent. *Sanders* v. *Logan*, 2 Fisher, 173.—GRIER, J.; Pa., 1861.

15. The obvious construction of it is, that a purchase, sale, or prior use shall not invalidate, unless it amounts to an abandonment to the public. *Ibid.*, 173.

### *Section* 11.

See also APPEALS, B.

1. The provision that "the decision of the judge shall govern the further proceedings of the commissioner in the case," applies only to so much of the case as is involved in the reasons of appeal; and the appeal itself can only be considered as an appeal to so much of the decision of the commissioner as is affected by such reasons. *Arnold* v. *Bishop*, (App. Cas.) MS.—CRANCH, C.J.; D. C., 1841.

2. The officer of the Patent Office attending before the judge on an appeal is not to be considered as counsel for the Patent Office, or as an advocate for either of the parties litigant, but only attends to explain the decision of the commissioner. *Perry* v. *Cornell*, (App. Cas.) MS.—CRANCH, C. J.; D. C., 1847.

3. All the conditions prescribed by this section must be complied with as prerequisites, before the judge can take jurisdiction. His jurisdiction is special and limited, and no other power can be exercised except that expressly given. *Greenough* v. *Clarke*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. The provision of this section requiring the judge to hear and determine appeals "on the evidence produced before the commissioner," is to be construed with reference to § 7 of the act of 1836, providing that reasonable notice

shall be given, both to the party appealing and the commissioner, "so that they may have an opportunity of furnishing such facts and evidence as they may deem necessary to a just decision." There is nothing in the act of 1839 which takes away or impairs that right, but every reason to infer that it was intended to be saved to the fullest extent. *Fultz, Ex parte*, MS. (App.Cas.)—MORSELL, J.; D. C., 1853.

5. The restrictive part of this section applies to the trial of the cause by the judge on the merits. *Ibid.*

6. Where a party has been prevented from producing before the Commissioner his proofs to support his claim, it is the duty of the judge, by reasonable regulations, similar to those directed by § 12, of the act of 1839, to pursue such a course as will afford the party an opportunity to produce such proofs; and he may make an order authorizing the party to take and file his proofs as to his invention. *Ibid.*

7. The provisions of this section as to the examination, on appeals, of the Commissioner or examiners of the Patent Office must be considered in connection with the provision in § 7 of the act of 1836 as to the powers of the old board of examiners. The language of the statute means that the explanation, authorized to be required of the commissioner, may be so full and clear an explanation of the *principles* of the thing, as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be limited to a mere exposition of the terms used; and such explanations so given the judge is bound to respect as a part of the case. *Richardson* v. *Hicks*, MS. (App.Cas.)—MORSELL, J.; D. C., 1854.

8. Under this section the judge succeeds to all the authority conferred upon the board of examiners by § 7 of the act of 1836, to require of the commissioners and examiners information relative to the subject matter under consideration, and to the full extent. *Seeley's Appeal*, MS. (App. Cas.)—MORSELL J.; D. C., 1853.

*Section* 12.

See also RULES OF PATENT OFFICE.

1. The rules, as to evidence, made under this section by the Commissioner of Patents, in conformity with the law, while they remain unabrogated, are as binding as the law itself, and as well upon the Commissioner as on others. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. The rules of the Patent Office as to taking evidence, prescribed under this section must be *just and reasonable*, according to the established principles and precedents in like cases. *Nichols* v. *Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

3. The rules and regulations of the Patent Office as to taking testimony, in cases of interference, are binding upon the parties, and each is entitled to the benefit of them, and until abrogated, they are as binding upon the Commissioner himself as if enacted by the very statute. *O'Hara* v. *Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

4. The power granted to the Commissioner under this section to make rules as to the taking of evidence, gives no right to make new rules of evidence, or to make new rules of law so as to divest vested rights. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

ACT OF 1842. CHAP. 263.

*Section* 5.

See also PENALTIES, B.

1. This section, though its phraseology, "a penalty of not less than one hundred dollars," is peculiar, authorizes the infliction of a penalty of just one hundred dollars for the offence therein described, and no more. *Stimpson* v. *Pond*, 2 Cur., 506.—CURTIS, J.; Mass., 1855.

2. The penalty may be recovered in an action of debt. *Ibid.*, 506.

3. The penalty mentioned in this section is incurred as to all articles made, and having the word "patent" affixed, with a guilty purpose. *Stephens* v. *Caldwell*, MS., SPRAGUE, J.; Mass., 1860.

*Section* 6.

See also PENALTIES, B.

1. Under this section the assignees of an interest in a patent are no more liable for articles purchased and sold by them, without the date of the patent stamped on them, than any other persons, unless the articles were manufactured with their connivance. *Palmer* v. *Allen*, MS.—BETTS, J.; N. Y., 1854.

2. It is not the selling of the articles so unstamped that makes them liable to the penalty, but the omitting to put the stamp on. *Ibid.*

3. The penalty attaches for each separate article sold. *Ibid.*

4. It is necessary that each article should be stamped with the day of the month as well as the year; but if this is done it is sufficient, even if the word "patented" is abbreviated. *Hawley* v. *Bagley*, MS.—BETTS, J.; N. Y., 1855.

ACT OF 1848. CHAP. 47.

*Section* 1.

See also EXTENSION OF PATENT.

1. This act is not a repeal of § 18 of the act of 1836, providing for the extension of patents, and the enactment of a new system for that purpose; but simply a repeal of so much of it as related to the action of the Secretary of State and the solicitor of the treasury, leaving the Commissioner of Patents alone to go on in the execution of the duty. *Colt* v. *Young*, 2 Blatchf., 473.—NELSON, J.; N. Y., 1852.

2. Where an application for an extension of a patent, under § 18 of the act of 1836, was pending at the time of the passage of the act of 1848, which conferred upon the Commissioner of Patents alone, the same power in respect to extending patents, previously vested in the board created by the act of 1836, *Held*, that it was not necessary to renew the application, but that the Commissioner had the power to go on with the proceedings, as having been already properly instituted, and complete them by granting the extension. *Ibid.*

ACT OF 1861. CHAP.

*Sections* 2, 3.

See also EXAMINERS.

1. Previous to the act of March 2,

1861, all judicial acts done in the Patent Office by the primary examiners or the Board of Appeals were in intendment of law, the judicial acts of the Commissioner, and had no legal validity until sanctioned by him. They were the organs of the Commissioner to *inquire* and *enlighten* his judgment, and till the Commissioner gave validity to their judicial acts by his *fiat*, they had no legal evidence as judgment. *Snowden* v. *Pierce*, MS. (App. Cas.)—DUNLOP, J., D. C., 1861.

2. Under the act of 1861 the primary examiners and examiners in chief are recognized as *judicial officers*, acting independently of the Commissioner, who can *only control them*, when their judgment in due course comes before the Commissioner on appeal. *Ibid.*

3. Their acts are not the acts of the Commissioner, but their own acts. They are no longer *mere* organs of the Commissioner, but independent officers. He can only reach and overrule them when their judgments come regularly before him, *on appeal*. *Ibid.*

4. The Commissioner can give no judgment till an appeal to him, and this cannot be done till the judgment of the primary examiners has been submitted to the examiners in chief. *Ibid.*

### 4. *Special or Private Acts.*

#### *a.* Generally.

1. A private act of Congress authorizing the issue of a patent to an inventor, is to be considered as engrafted on the general acts for the promotion of the useful arts, and the patent is issued in pursuance of both. *Evans* v. *Eaton*, 3 Wheat., 518.—MARSHALL, Ch. J.; Sup. Ct., 1818.

2. An act of Congress extending a patent, passed in general terms, ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority. And it ought to be construed not to operate retrospectively, or *ex post facto*, unless that construction is unavoidable. *Blanchard* v. *Sprague*, 3 Sumn., 542.—STORY, J.; Mass., 1839.

3. A reservation in favor of assignees, in a special act of Congress extending a patent, will not make the act unconstitutional on the ground that Congress is only authorized to confer privileges on *inventors*. The power of Congress, to reserve rights and privileges to assignees, is incidental to the general power conferred to promote the progress of the useful arts. *Blanchard's Gun-Stock Co.* v. *Warner*, 1 Blatchf., 271, 276.—NELSON, J.; Ct., 1846.

4. Congress may, by special act extend a patent even after the expiration of the original patent. *Ibid.*, 276.

5. Congress may exercise its constitutional power as to granting rights to inventors by special acts or otherwise, by a general system. *Bloomer* v. *Stolley*, 5 McLean, 161.—MCLEAN, J.; Ohio, 1850.

6. And may extend a patent by special act, after such patent has been once extended, *Ibid.*, 162.

7. Alleged fraud and misrepresentation in the passage of an act of Congress, as an act granting a special patent, will not be presumed; but such an act will be regarded by the courts as the law of the land, until it is repealed. *Gibson* v. *Gifford*, 1 Blatchf., 531.—NELSON, J.; N. Y., 1850.

8. A special act in relation to any particular patent, is to be considered as engrafted upon the general acts relating to patents. They are statutes in *pari*

*materia*, and all relate to the same subject, and must be construed together. *Bloomer* v. *McQuewan*, 14 How., 548, 551.—TANEY, Ch. J.; Sup. Ct., 1852.

*b.* Acts for relief of Thomas Blanchard.

ACT of 1834., CH. 213. ACT OF 1839., CH. 14.

1. The act of Congress of 1834, chap. 213, renewing the patent of Thomas Blanchard, for his "machine for cutting or turning irregular forms," secures to patentees and purchasers their rights only upon the same conditions as they had before enjoyed them; *Held*, that the United States had no right to make and use his invention, except on the payment of the sum per musket or rifle secured by the terms of the former assignment to them. *Blanchard's Case*, Opin. Gilpin's Ed. 1841, 1125.—BUTLER, Atty. Gen.; 1837.

2. In construing an act of Congress, if there be a plain mistake, apparent upon the face of the act, which may be corrected by other language in the act itself, the mistake is not fatal. *Blanchard* v. *Sprague*, 3 Sumn., 282.—STORY, J.; Mass., 1838.

3. The mere misnomer of the name of a person or corporation named in the act, as of a person to whom a patent is granted by the act, if the person really intended can be collected from the terms of the act, is also not a fatal mistake. *Ibid.*, 282.

4. But when the descriptive words constitute the very essence of the thing, as the title or designation of the invention, unless the description is so clear and accurate as to refer to the particular thing, and are incapable of being applied to any other, the mistake is fatal. *Ibid.*, 283.

5. The act of Congress of 1834, granted a patent to B. for the term of fourteen years from the *twelfth* day of January, 1837, giving him "the exclusive right," &c., of making, using, &c., his invention of "a *machine* for turning or cutting irregular forms," and reference was made in such act to a description of such invention, contained in a specification annexed to letters patent granted said B., on the *twelfth* of January, 1820—and in point of fact B. never had granted to him any letters patent dated January *twelfth*, 1820, but had received on January *twentieth*, 1820, certain letters patent for "an *engine* for turning or cutting irregular forms out of wood, iron, brass, or other material or substance, which can be cut by ordinary tools, called B.'s self-directing machine;" *Held*, that the mistake was fatal, and that the court could not depart from the very words of the act to correct the mistake. *Ibid.*, 285.

6. The act of 1839, chap. 14, is not unconstitutional on the ground that it operates retrospectively, to give a patent for an invention, which, though made by the patentee, was in public use at the time of the passage of the act. The power of Congress as to granting patents is general, 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 Congress to enact, where the invention has not been known or used by the public. All that is required is that the patentee should be the inventor. *Blanchard* v. *Sprague*, 3 Sumn., 541.—STORY, J.; Mass., 1839.

7. The act of Congress of 1839, chap. 14, extending to Thomas Blanchard a

patent for "turning irregular forms," by the proviso of the first section, intended to give to assignees of the old patent an equally exclusive privilege in the extended term. *Blanchard's Gun-Stock Turning Factory* v. *Warner*, 1 Blatchf., 275.—NELSON, J.; Ct., 1846.

8. The reservation in such act as to assignees, does not make the act unconstitutional on the ground that Congress can only confer privileges on *inventors*. The power of Congress to reserve rights and privileges to assignees is incidental to the general power conferred to promote the progress of the useful arts by securing to inventors, for limited times, the exclusive right to their discoveries. *Ibid.*, 276.

9. This act of 1839 did not extend the mere legal right of the patentee, under his patent, but granted the exclusive right to the invention, and the specification of the patent was only referred to to identify the invention extended. *Ibid.*, 279.

### c Act for relief of Oliver Evans.

ACT OF 1808. CHAP. 13.

1. Under this act, and a patent taken out pursuant to it, *Held*, that Evans could recover damages for the use of a machine violating his patent, after notice of the patent, although the machine might have been constructed prior to the passing of the law. *Evans* v. *Weiss*, 2 Wash., 343.—WASHINGTON, J.; Pa., 1809.

2. This act, which was passed after a patent had expired, contained a proviso "that no person who shall have used the improvement" (secured by the patent), "or have erected the same for use before the issuing of the said (second) patent, shall be liable to damages therefor," *Held*, that this proviso did not authorize the use of the improvement, subsequent to the date of the second patent; and that for such subsequent use, the parties using were liable to damages to the patentee. *Ibid.*, 248, 253.

3. The act for the relief of Oliver Evans, is not to be construed so as to exempt either from treble or single damages, the use, subsequent to the passage of such act, of the machinery mentioned therein, which was erected subsequent to the expiration of the original patent, and previous to the passage of such act. *Evans* v. *Jordon*, 9 Cra., 202, 204.—WASHINGTON, J.; Sup. Ct., 1815.

4. The right to recover damages for using his patent arises not under this law, but under the general patent law of 1793. *Ibid.*, 203.

5. Though this act gave to Evans the exclusive property not only in the *entire improvement*, but in the *several machines* employed to produce the specified results, yet as the patent actually issued was confined to the whole improvement, it contained no exclusive right to use severally the several machines. *Evans* v. *Eaton*, Pet., C. C., 340. — WASHINGTON, J.; Pa., 1816. [But see *post*, 9.]

6. The patent of Evans for his improved hopper-boy, granted under the special act of 1808, is not, either by force of such act, or of the decision of the Supreme Court in *Evans* v. *Eaton*, 3 Wheat., 454, an exception to the general rule; nor is it for the whole hopper-boy, whether he was the inventor of it or not. *Evans* v. *Hettick*, 3 Wash., 424–432.—WASHINGTON, J.; Pa., 1818.

7. His patent covers only that of which he was the first inventor, and his invention, if an improvement, must be

set forth so as to clearly distinguish it. This not having been done, he cannot recover. *Ibid.*, 428.

8. The patent of Oliver Evans is not, either by the special act passed for his relief, or by virtue of the decision of the Supreme Court (*Evans* v. *Eaton*, 3 Wheat., 1818), an exception to the general principles governing the issue of patents. If he is not the original inventor of the things patented to him, or if his invention is not properly set forth, he cannot recover. *Evans* v. *Eaton*, 3 Wash., 451, 455.—WASHINGTON, J.; Pa., 1818.

9. Though, under the general patent law, a doubt might arise whether improvements on different machines could regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination; the "act for the relief of Oliver Evans," authorizes the issuing to him of a patent granting to him the full and exclusive right in his invention and improvements in the art of manufacturing flour, and in the several machines he has invented, discovered, improved, and applied to that purpose. *Evans* v. *Eaton*, 3 Wheat., 506.—MARSHALL, Ch. J.; Sup. Ct., 1818.

10. Taking the whole together, his patent under such act is to be construed as a grant of the general result of the whole machinery, and of the improvements in each machine; and he may claim, under his patent, the exclusive use of his inventions and improvements, in the art of manufacturing flour, and in the several machines which he has invented, and in his improvements on machines previously discovered. *Ibid.*, 517.

11. The decision of the court below in *Evans* v. *Eaton*, 3 Wash., 451, that if Evans' patent was for the hopper-boy, he could not recover unless he was the first inventor thereof, and that if it was a patent for an improvement on the hopper-boy, it was defective in not specifying the improvement, affirmed. *Evans* v. *Eaton*, 7 Wheat., 431, 435.—STORY, J.; Sup. Ct., 1822.

12. Decision of WASHINGTON, J., in *Evans* v. *Hettick*, 3 Wash., 424–432 (*ante* 6), as to the force and extent of Evans' patent, affirmed, *Evans* v. *Hettick*, 7 Wheat., 470.—STORY, J.; Sup. Ct., 1822.

13. Oliver Evans, for his invention in the art of manufacturing flour, received protection originally by means of an act of the legislature of Pennsylvania, passed March 29th, 1787—before any act of Congress had been passed—which secured to him the exclusive privilege in his invention for fourteen years. After the expiration of this time, in 1808, a special act of Congress was passed, authorizing an issue of a patent for another term of fourteen years, under which a patent was issued, bearing date January 22d, 1808. [*Ed.*]

### *d.* Act for relief of William Woodworth.

ACT OF 1845. CHAP. 27.

1. There being in this act extending the Woodworth patent, no implied or expressed reservation in favor of assignees, *Held*, that an assignee under the original patent, or first extension, had no further right to use such patent. *Bloomer* v. *Stolley*, 5 McLean, 163.—McLEAN, J.; Ohio, 1850.

2. There being, in the special act of February 26th, 1845, extending the

Woodworth patent for seven years from 1849, no reservation or proviso in favor of assignees under the first term, or the first extension under the act of 1836, they have no right in the term extended by Congress, and cannot even continue the use of machines held and in use by them at the expiration of the first extension. *Gibson* v. *Gifford*, 1 Blatchf., 530, 531.—NELSON, J.; N. Y., 1850.

3. So held also in *Mason* v. *Tallman*, MS.—WOODBURY, PITMAN, JJ.; R. I., 1850; *Bloomer* v. *Vaught*, MS.—MCKINLEY, MCCALEB, JJ.; La., 1850; *Woodworth* v. *Barbour*, MS.—WARE, J.; Me., 1850; and *Woodworth* v. *Curtis*, MS.—SPRAGUE, J.; Mass., 1850.

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## SUGGESTIONS, BEARING OF.

See also MECHANIC, SKILL OF.

1. The suggestions of the mechanic employed to make a machine, or of others, as to its form or proportions, are not inventions or improvements for which a patent could be obtained, nor can they invalidate the patent for the thing to which they are applied. *Pennock* v. *Dialogue*, 4 Wash.. 544.—WASHINGTON, J.; Pa., 1825.

2. Except this was so, very few patents could be supported; as in most cases it might probably be shown that whilst the thing patented was constructing, or before it was brought to perfection, many such improvements were adopted in consequence of such suggestions. *Ibid*, 544.

3. The suggestions of a mechanic of alterations in the form or proportions of a machine, as designed by the inventor, will not be sufficient to deprive the inventor of the merit of the invention, or affect the validity of his patent, if incorporated within it; nor would it be, as to such alterations, a discovery which would entitle the mechanic to take out a patent for them. *Watson* v. *Bladen*, 4 Wash., 582.—WASHINGTON, J.; Pa., 1826.

4. 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 mechanician who constructs the machine. *Ibid*, 582.

5. If a party suggest an idea as to an invention which is indispensable to its operation, and which in reality constitutes its whole value, and another adopts such suggestion and takes out a patent therefor, the patent is void, as not being the invention of the patentee. *Thomas* v. *Weeks*, 2 Paine, 102.—THOMPSON, J.; N. Y., 1827.

6. And it is sufficient if such a suggestion was made by such other person, without being carried out or patented by him. *Ibid.* 103.

7. To show invention in another than the patentee, because of suggestions made by such other person, the question for the jury is, whether such person communicated substantially the invention, so that without more inventive power the other could have applied it. A mere hint is not sufficient, nor, on the other hand, need he communicate every minute thing about the invention; but he must have communicated the substance. *Alden* v. *Dewey*, 1 Story, 338, 339.—STORY, J.; Mass., 1840.

8. The testimony of a witness, however, that he gave such communication as to an invention, is in the nature of

aiconfession, and is always regarded as an uncertain kind of evidence. *Ibid.*, 339.

9. In order to invalidate a patent on the ground that the patentee did not conceive the idea embodied in the improvement, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement. In other words, the suggestions must have been sufficient to enable him to construct a complete and perfect machine. *Pitts* v. *Hall*, 2 Blatchf., 234.—NELSON, J.; N. Y., 1851.

10. If they simply aided him in arriving at the useful result, and if, after all the suggestions, there was something left for him to devise and work out by his own skill and ingenuity, then he is, in contemplation of law, to be regarded as the first and original discoverer. *Ibid.*, 234.

11. On the other hand, if the suggestions and communications of another go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another. *Ibid.*, 234.

12. Inquiries made, or information or advice received from men of science, in the course of an inventor's researches, will not impair his right to the character of an inventor. It makes no difference whether an inventor derive his information from books, or from conversation with men skilled in science. *O'Reilly* v. *Morse*, 15 H., 111.—TANEY, Ch. J.; Sup. Ct., 1853.

13. If the idea involved in the patented article had occurred to others, or had come to the patentee from others, still, if the patentee had been the first to give to that idea a useful and practical form, he will be considered the first inventor. *Teese* v. *Phelps* 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

14. Mere conversations about the practicability of an improvement, or suggestions as to the manner in which it might be carried out or accomplished, will not of themselves defeat the claims to originality of him who perfects the idea and secures a patent. *Judson* v. *Moore*, 1 Fisher, 555.—LEAVITT, J.; Ohio, 1860.

15. But any information to a patentee, sufficient to enable him to construct the thing itself, would destroy the originality of the invention. Such knowledge, however, must be definite and tangible, and sufficient of itself to enable the party to whom imparted to construct the thing. *Ibid.*, 555.

## TECHNICAL TERMS AND PHRASES.

1. "Lateral motion," in mechanics, does not mean, as the term ordinarily signifies, a side motion, but a longitudinal one. *Brooks* v. *Bicknell*, 3 McLean, 454.—MCLEAN, J.; Ohio, 1844.

2. The word "substantial," is not susceptible of an exact definition. But it is very generally used, and no word is more familiar in courts of justice and in the ordinary affairs of life. Beyond the exact sciences we do not look for precision. We look more to the *substance* of things than their forms. *Ibid.*, 456.

3. If technical terms are used peculiar to mechanics, in describing an invention,

evidence may be heard in explanation of those terms, and in such case a jury may be necessary. *Ibid.*, 442.

4. As to the meaning of words of art and technical phrases in commerce and manufactures, which may materially affect, enlarge, or control the meaning of the words of the patent and specification, the jury are to judge. *Washburn* v. *Gould*, 3 Story, 158.—STORY, J.; Mass., 1844.

5. The patentee is not, in the description of his invention, to be confined to technical language; but may make use of that which is in popular use, and better understood by all. The fewer technical terms used the better, if the subject is intelligible without them. *Hovey* v. *Stevens*, 3 Wood. & Min., 28.—WOODBURY, J.; Mass., 1846.

6. A thing is *substantially* the same with another, when it is the same in all important particulars. It must be the same material, when material is important—of the same thickness, when thickness is important—be applied in the same way, condition, and extent, when either of these circumstances are important. *Adams* v. *Edwards*, MS. ———, J.; Mass., 1848.

7. Experts may be examined to explain terms of art, on the principle of *cuique in sua arte credendum*. *Corning* v. *Burden*, 15 How., 270.—GRIER, J.; Sup. Ct., 1853.

8. "End play" of a shaft is its lateral play within the boxes in which it runs. "Free play" is *its* unchecked action. "Free end play" is its unchecked lateral action in its revolutions. *Page* v. *Ferry*, 1 Fisher, 302.—WILKINS, J.; Mich., 1857.

9. "May, in fact," does not signify "shall be." *Ibid.*, 304.

10. Experts may be examined as witnesses, to explain terms of art, and the state of the art at any given time. The maxim of *cuique in sua arte credendum* permits them to be examined as to questions of art or science peculiar to their trade or profession. *Winans* v. *N. Y. & E. R. R.*, 21 How., 100, 101.—GRIER, J.; Sup. Ct., 1858.

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## THEORY.

1. A patent cannot be legally obtained for a mere philosophical or abstract theory; it can only be for such a theory reduced to practice in a particular structure or combination of parts. *Lowell* v. *Lewis*, 1 Mas., 187.—STORY, J.; Mass., 1817.

2. The mere speculation of a philosopher or mechanician, which has never been tried by the test of experience, and never put into actual 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 Mas., 305.—STORY, J.; Mass., 1817.

3. A discovery of some new principle, theory, elementary truth, or an improvement upon it, abstracted from its application, is not a new invention. *Whitney* v. *Emmett*, Bald., 311.—BALDWIN, J.; Pa., 1831.

4. But when such discovery is applied to any practical purpose, in the new construction, operation, or effects of machinery or composition of matter, producing a new substance, or an old one in a new way, by new machinery, or by a new combination of the parts of an old one, operating in a peculiar, better, cheaper, or quicker method, it is a "discovery," "invention," or "improve-

ment," within the acts of Congress. *Ibid.*, 311, 312.

5. 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, cannot be, patentable under the patent laws. *Reed* v. *Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

6. If an invention be the mere speculation of a philosopher or mechanician in his closet, and he takes no step toward securing a patent, but keeps his invention a secret, and another person, who is also an original but subsequent inventor of the same thing, obtain a patent for it, and bring it into use, the patentee in a suit at law will be considered the first inventor. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

7. It is not enough to conceive the idea of a new manufacture, or of a new and useful instrument. That alone is no benefit to mankind, and is not worthy the patronage of government. The new idea must be reduced to some practical use before it can become the subject of a patent, or be set up and relied upon to defeat one. *Many* v. *Jagger*, 1 Blatchf., 383.—NELSON, J.; N. Y., 1848.

8. The mere speculation of a philosopher or mechanic, never put into practice or operation, will not deprive a subsequent inventor, who has employed his labor and talents in putting it into practice, of the reward due to his ingenuity and enterprise. *Rich* v. *Lippincott*, 2 Fisher, 7.—GRIER, J.; Pa., 1853.

9. The same position laid down in *Reed* v. *Cutter*, 1 Story, 599 (*ante* 5), held also in the following case. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

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# TRADE-MARKS.

A. PROPERTY IN; IN WHAT MAY EXIST... 683
B. WHO MAY ACQUIRE PROPERTY IN..... 687
C. PROPERTY IN; HOW PROTECTED..... 691
D. VIOLATION OF; WHAT IS..... 691
E. WHEN VIOLATION OF WILL BE RESTRAINED..... 691

## A. PROPERTY IN; IN WHAT MAY EXIST.

1. The right of a person in a trade-mark does not partake in any considerable, if in any degree, of the nature and character of a patent or copyright. *Taylor* v. *Carpenter*, 2 Sand. Ch., 617 (Ct. Errors).—SPENCER, Senator; N. Y., 1846.

2. Another is at full liberty to manufacture and vend the same article to any extent, and whenever he chooses. He is only required to depend for his success upon his own character and fame, and not to pirate upon the trade-marks, the rights of others. *Ibid.*, 617.

3. The assurance that a party can enjoy the exclusive benefit of his trade-marks is among the highest incentives to ingenuity, laborious exertion, and honorable and faithful conduct, and is one of the greatest securities to the public against imposition. *Ibid.*, 617.

4. A label or trade-mark, when it has become known, is a species of property; and the owner will be protected against the attempts of others to appropriate to themselves, by its use, the benefit which such owner is exclusively entitled to enjoy. *Partridge* v. *Menck*, How. App. Cas., 559.—WRIGHT, J.; N. Y., 1848.

5. The owner of an original trade-mark has a right to be protected in the exclusive use of all the marks, forms, or symbols appropriated as designating the origin and ownership of the thing to which affixed, but he cannot be protected in those which have no such relation. *Amoskeag Manuf. Co.* v. *Spear*, 2 Sand. S. C., 606.—DUER, J.; N. Y., 1849.

6. He has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. *Ibid.*, 606, 607.

7. The use of words, marks, or signs, indicating the name, mode, or process of manufacture, and its peculiar or relative quality as distinguished from those indicating origin or ownership, cannot be protected in any particular person, but are free to all when used as an expression of the facts which they really signify. *Ibid.*, 609, 610.

8. Where the plaintiffs used in their label the letters A. C. A., not as an indication of ownership, but only to indicate the relative quality of the goods, *Held*, that the defendants could not be restrained from using the same letters for a similar purpose. *Ibid.*, 609, 616, 619.

9. The right of a party to the exclusive enjoyment of a trade-mark does not depend upon any exclusive right of property in the article sold, or upon any exclusive right in the label—as that is not a book within the provisions of the statute—but upon the use and established reputation it has attained, and that its fraudulent use is an injury to third persons. *Coffeen* v. *Brunton*, 4 McLean, 517, 519.—MCLEAN, J.; Ind., 1849.

10. The right which any person may have to the protection of the court as to his trade-mark does not depend upon any exclusive right which he may be supposed to have to a particular name, or to a particular form of words; his right is to be protected against fraud, and this may be practised against him by means of a name, though the person practising it may have a perfect right to use that name, provided he does not accompany the use of it with such other circumstances as to effect a fraud upon others. *Stone* v. *Carlan*, 3 Mo. Law. Rep., 361.—CAMPBELL, J.; N. Y., 1850.

11. Trade-marks may be either the name of the maker; or symbolical; or the name of the compound. *Davis* v. *Kendall*, 2 R. I., 569.—GREENE, J.; R. I., 1853.

12. In all cases where names, signs, marks, brands, labels, words, or devices of any kind can be advantageously used to designate the goods or property, or particular place of business, of a person engaged in trade or manufactures, or any similar business, he may adopt and use such as he pleases, which are adapted to that end, and have not been before appropriated. *Stokes* v. *Landgraff*, 17 Barb. S. C., 609.—STRONG, J.; N. Y., 1853.

13. No other person can lawfully imitate them, and by that means sell his own goods or property, or carry on his business, as the goods, property, or business of the former. If any one does so, he is liable to an action at law for damages, or may be restrained by injunction. *Ibid.*, 609.

14. In respect to words, marks, or devices which do not denote the goods or property, or particular place of business of a person, but only the nature, kind, or quality of the articles in which he deals, a different rule prevails. *Ibid.*, 609.

15. No property in such words, marks, or devices, can be acquired. They may be used by many different persons at the same time, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article can be defrauded. *Ibid.*, 609.

16. The credit and reputation which a man acquires by his care or skill in the manufacture of a particular article, is a species of property which the law recognizes and protects: and where, as a means of extending his reputation and guiding purchasers, he affixes some mark or symbol to designate that article as his manufacture, he is injured by the sale of an article manufactured by another, with his peculiar symbol or trade-mark affixed to it. *Lemoine* v. *Gauton*, 2 E. D. Smith, 347, 348.—DALY, J.; N. Y., 1854.

17. There is no essential difference in kind in reference to the protection to be granted to trade-marks between establishments formed for the purpose of trade and those formed for the purpose of mere amusement. *Christy* v. *Murphy*, 12 How. Pr., 78.—CLERKE, J.; N. Y., 1856.

18. While neither exercises, or is calculated to exercise, any demoralizing influence, one is as well entitled to the protection of the law as the other. *Ibid.*, 78.

19. The plaintiff organized a band of performers of negro minstrelsy, and named them after himself, "Christy's Minstrels." *Held*, that he was entitled to the exclusive use of that name, and that the assumption and use of that name by others, without a license, would be perpetually restrained by injunction. *Ibid.*, 78, 79.

20. The privilege of a party to the exclusive enjoyment of a trade-mark does not rest upon a right of property therein, but on its prior use and application in the manner in which it has been imitated and employed by the defendant. *Walton* v. *Crawley*, 3 Blatchf., 448.—BETTS, J.; N. Y., 1856.

21. A "*name*" may in some cases be rightfully used and protected as a trade-mark; but this is only when the name is used as indicating the true origin or ownership of the article offered for sale —never when it is used to designate the article itself, and has become, by adoption and use, its proper appellation. *Fetridge* v. *Wells*, 13 How. Pr., 387.—DUER, J.; N. Y., 1857.

22. All who have an equal right to manufacture and sell the article have an equal right to designate and sell it by its appropriate name, provided such person is careful to sell the article as prepared and manufactured by himself, and not by another. *Ibid.*, 387.

23. An exclusive right to use, on a label or other trade-mark, the appropriate name of a manufactured article, exists only in those who have an exclusive property in the article itself. *Ibid.*, 388.

24. There can be no exclusive property in a generic or specific name, unless as incident to an exclusive property in the article, composition, or process, which the name is used to designate. *Tomlinson* v. *Battel*, MS.—DUER, J.; N. Y., 1857.

25. A name or appellation may be appropriated as a trade-name; and this may be given to a compound or article every ingredient or portion of which is open to the use of every one, but the sale of which, under that appellation, is not lawful to any other person. *Fetridge* v. *Merchant*, 4 Abb. Pr., 158.—HOFFMAN, J.; N. Y., 1857.

26. The further removed such an appellation is from actually representing the article in question, the more decided and exclusive becomes the right to it. *Ibid.*, 158.

27. And even if the term used be common, yet it may be employed with such peculiar emblems, colors, and devices, as to give the person using an exclusive right. Strictly, the right of appropriation in such instances results from the peculiar emblems. *Ibid.*, 158, 159.

28. What will be protected embraces not merely names, but the manner of putting up the articles, and even including the wrappers or envelopes employed by the person entitled to the trade-mark. *Williams* v. *Johnson*, 2 Bosworth, 7.—WOODRUFF, J.; N. Y., 1857.

29. When a person forms a new word to designate an article made by him, which has never before been used, he may obtain such a right to that name as to entitle him to the sole use of it as against others, who attempt to use it for the sale of a similar article; but such an exclusive use can never be successfully claimed of words in common use previously as applicable to similar articles. *Wolfe* v. *Gourard*, 18 How. Pr., 67.—INGRAHAM, J.; N. Y., 1859.

30. Words, as used in any language, cannot be appropriated by any one, to his exclusive use, to designate an article sold by him similar to that for which they were previously used. *Ibid.*, 67.

31. No person can acquire a right to the exclusive use of words, applied as the name of an article sold by him, if in their ordinary acceptation they designate the same or a similar article. *Ibid.*, 69.

32. Every man has a right to the reward of his skill, his energy, and his honest enterprise; and when he has appropriated, as his trade-mark, letters combined into a word before unknown, and has used that word and published it to the world as his adopted "trade-mark," he has acquired rights in it which the courts will protect. *Burnett* v. *Phalon*, 12 Mo. Law, Rep., 223.—PIERREPONT, J.; N. Y., 1859.

33. But no one can appropriate a word in general use, as the words gin, wine, brandy, which designate things or the qualities of things, as his trademark, and restrain others from using that word. *Ibid.*, 223.

34. A manufacturer or vender of an article cannot acquire a right to an exclusive employment of a word or words, having an established meaning, to qualify the name of such article, so as to deprive every other person of the right of using such words to designate any other article, apparently similar, when the words are such as have no reference to the origin, ownership, or manufacture of such article. *Corwin* v. *Daly*, Upton on Trade-Marks, 191.—ROBERTSON, J.; N. Y., 1860.

35. The principle, that the mere use of a name to designate an article, would give to those employing it the exclusive right to designate such article by such name, would be giving a copyright of a most odious kind, without reference to the utility of the application, or the length of the title, and one that would be perpetual. *Ibid.*, 195, 196.

36. Where a person used the words "Club-House Gin," as a label, and another manufacturer of the same article, designated his as "Old London Club-House Gin," *Held*, that there could be no exclusive use of the words "Club-House," as these words had no reference to the origin, ownership, or manufacture of the article. *Ibid.*, 196.

37. The exclusive use of known words in a language, in a trade-mark, is confined to those which indicate the origin or ownership of the article—otherwise, selling by the same title would not tend to represent them to be the same words. *Ibid.*, 197.

38. Such an epithet as "club-house" indicates no more than the words "hotel," "royal," "imperial," or "princes," or any other high-sounding title would do, and no one would be bound to suspect that there lurked beneath those words, the indication of a particular ownership or manufacture. *Ibid.*, 197.

39. The true rule is, that no words can be used by themselves without other devices, as a trade-mark, except such as point out ownership, or origin, and those which have no reference, in any possible way, to any other attribute of the article. *Ibid.*, 198.

40. Though an exclusive right to a trade-mark, or label, devised and intended to deceive the public, will not be protected by injunction, yet the fact that a trade-mark bears a fictitious name, as the name of the manufacturer of the article, does not affect the owner's right to protection, where it is shown that it is not used with any fraudulent intent, and does not in fact deceive the public. *Dale* v. *Smithson*, 12 Abb. Pr., 239, 241. —HILTON, J.; N. Y., 1861.

## B. WHO MAY ACQUIRE PROPERTY IN.

See also ALIENS.

1. Where parties adopt certain trade-marks, and stamp them upon articles manufactured by them, they are entitled to such mark, and have an undoubted right to the assistance of a court of equity to enforce that title by a perpetual injunction. *Taylor* v. *Carpenter*, 11 Paige, 297.—WALWORTH, Chan.; N. Y., 1844.

2. The venders of an article of manufacture distinguished by a particular trade-mark, and to which they have given a reputation, although they may not be the manufacturers of the article, are entitled to be protected in such trade-mark. *Taylor* v. *Carpenter*, 2 Sand. Ch. 614 (Ct. Errors).—LOTT, Senator, N. Y.; 1846.

3. The maker and vender is only entitled to protection against a piracy of his trade-mark, not the person who buys to sell. *Ibid.*, 620.—WRIGHT, Senator, dissenting.

4. It is not necessary that a party should have a copyright, or be a citizen, in order to claim protection against counterfeits and forgeries of their labels and marks. *Ibid.*, 618.—BARLOW, J., Senator.

5. The question as to the protection of a trade-mark, is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he puts his trade-mark, nor whether the article made and sold by the defendant, under the complainant's trade-mark is an article of the same value or quality. *Partridge* v. *Menck*, 2 Barb. Ch. 103.—WALWORTH, Chan.; N. Y., 1847.

6. But the court proceeds upon the ground that the complainant has a valuable interest in the good-will of his trade, or business, and that having appropriated to himself a particular label, or sign, or trade-mark, indicating that the article is manufactured or sold by him, or under his authority, or that he carries on his business at a particular place, he is entitled to protection against any other person who attempts to pirate upon the good-will of his friends or

customers, or of the patrons of his trade or business, by sailing under his flag without his authority. *Ibid.*, 103.

7. A person having adopted and used a particular label or trade-mark, in his business, others, without his consent, have no right, with the view of deriving advantage from the same, to use such label or trade-mark, without change, or even with such colorable difference as is calculated to deceive. *Partridge* v. *Menck*, How. App. Cas., 559.—WRIGHT, J.; N. Y., 1848.

8. But where a person manufactures and sells an article under the name of the original manufacturer, although he may have purchased of such one the secret of his manner of preparing the article, and also the right to use his name, he is not entitled to be protected. *Ibid.*, 559, 561.—GARDINER, Senator.

9. And it makes no difference that the article manufactured by him is in all respects equal to that offered by the original manufacturer. *Ibid.*, 561.

10. The privilege of deceiving the public for their own benefit is not a legitimate subject of commerce, and therefore it makes no difference that the complainant has *purchased* the right to use the name of the first proprietor. A party asking equity, must come with clean hands. *Ibid.*, 561.

11. Every manufacturer, and merchant for whom goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the market, and that he may secure the profits that their superior repute may be the means of gaining. His trade-mark is an assurance to the public of the quality of his goods, and a pledge of his own integrity in their manufacture and sale. *Amoskeag Manuf Co.* v. *Spear*, 2 Sand. S. C., 605.—DUER, J.; N. Y., 1849.

12. An acquiescence of a manufacturer in the use or imitation of his trade-mark may be inferred from his knowledge and silence; but such consent, whether expressed or implied, when gratuitous, may be withdrawn: it is no more than a revocable license. *Ibid.*, 615.

13. Where the plaintiff had an agreement with the proprietors of a hotel —the Irving House—to use the name of such proprietors, and the name of their hotel upon the coaches and badges of their servants, and entered into bonds for the faithful performance of their duties in carrying passengers and baggage to and from the steamboats, &c., &c., *Held*, that the plaintiff had an exclusive right, as against third persons, in the use of the name of such hotel on his coaches and badges for such purpose, and that he was entitled to an injunction to restrain the use, by others, of the words "Irving House," or "Irving Hotel," to induce travellers to believe they were the servants of such hotel. *Stone* v. *Carlan*, 3 Mo. Law Rep., 360–362.—CAMPBELL, J.; N. Y., 1850.

14. The inventor of a medicine, though he can have no exclusive right to make and vend the same unless he obtain a patent therefor, is entitled to his trade-mark in the name of such medicine, and the law will recognize and protect this right. *Davis v. Kendall*, 2 R. I., 569.—GREENE, Ch. J., R. I., 1853.

15. A party will be protected in the use of a name which he has appropriated and rendered valuable, whether such name is upon articles of personal property which he may manufacture, or

applied to a hotel where he has built up a business. *Howard* v. *Henriques*, 3 Sand. S. C., 727.—CAMPBELL, J.; N. Y., 1851.

16. Where the proprietor of a hotel opened it as the "Irving House," and it became generally known also as the "Irving Hotel," and was designated by both names indiscriminately, *Held*, that he had an exclusive right to the use of such names, and that an injunction would lie against other persons setting up a hotel called also the "Irving Hotel." *Ibid.*, 726, 728.

17. The proprietor of a hotel—the Revere House—agreed with the plaintiff to keep coaches at a certain railroad depot, to convey passengers to such house, and authorized him to put on his coaches and on the caps of his drivers the words "Revere House." A similar agreement had existed between the said proprietor of the Revere House and the defendants, but had been terminated. The defendants, however, continued to use the same words on their coaches and drivers' caps, and held themselves out as connected with such house. *Marsh* v. *Billings*, 7 Cushing, 322.—FLETCHER, J.; Mass., 1851.

18. *Held*, that the plaintiff had an exclusive right to use the words "Revere House," as indicating and holding himself out as having the patronage of that establishment for the conveyance of passengers, and that the use by defendants of the same words for the purpose of falsely holding themselves out as having such patronage, was a fraud upon the plaintiff and a violation of his rights, for which he could maintain an action. *Ibid.*, 322.

19. The principle is well settled that a manufacturer may, by priority of appropriation of names, letters, marks, or symbols of any kind to distinguish his manufactures, acquire a property therein as a trade-mark, for the invasion of which an action for damages will lie, and in the exclusive use of which he may have protection, when necessary, by injunction. *Stokes* v. *Landgraff*, 17 Barb., 608.—STRONG, J.; N. Y., 1853.

20. There is no essential difference between establishments formed for the purpose of trade and those formed for the purpose of mere amusement. *Christy* v. *Murphy*, 12 How. Pr., 78.—CLERKE, J.; N. Y., 1856.

21. Where a person organized a band of performers of negro minstrelsy, and named them, after himself, "Christy's Minstrels," *Held*, that he was entitled to the exclusive use of such name, and that he would be protected in it. *Ibid.*, 78, 79.

22. The owner of goods, which he exposes to sale in market in his own right, is entitled to the exclusive use of any trade-mark devised and applied by him to the goods to distinguish them, as being of a particular manufacture or quality, although he is not himself the manufacturer, and although the name of the real manufacturer is used as a part of the trade-mark. *Walton* v. *Crawley*, 3 Blatchf., 448.—BETTS, J.; N. Y., 1856.

23. The assignee of the whole right in such trade-mark, and of the property in the goods to which it is attached, is entitled to the enjoyment of the exclusive right thereto, and may maintain an action in his own name for any wrongful use by others of such trade-mark, to the like extent as the originator thereof. *Ibid.*, 448.

24. A person cannot acquire a right in a trade-mark, in which he will be

protected, when such name was intended to deceive the public. An exclusive privilege for deceiving the public is not one that can be sanctioned. *Fetridge* v. *Wells*, 13 How. Pr., 389. LUER, J.; N. Y., 1857.

25. Where the plaintiffs were engaged in manufacturing and selling an article called the "Balm of a Thousand Flowers," and which they represented as "the very balm and extract of healing blossoms," but which in fact was only a liquid soap, *Held*, that the name was intended to deceive the public, and that the plaintiff could not be protected therein. *Ibid.*, 390, 393.

26. In determining the right of a person to a trade-mark, the invention of the article sold is not an element of decision. But the first use or appropriation of the designation or name is the material question. *Fetridge* v. *Merchant*, 4 Abb. Pr., 160.—HOFFMAN, J.; N. Y., 1857.

27. A manufacturer of goods who, in order to designate his own manufacture, has adopted names, marks or labels, which are peculiar and not before used, is entitled to be protected in a court of equity in their use. *Williams* v. *Johnson*, 2 Bosworth, 6.—WOODRUFF, J.; N. Y., 1857.

28. Though the mark has no other meaning than to distinguish their manufacture from others, if the party has given it out as his mark, and by it the article has acquired reputation and sale, he is entitled to protection in it. *Ibid.*, 6.

29. This is true, though the articles manufactured by him may be composed of well-known ingredients, which any person may combine and sell at his pleasure.—*Ibid.*, 6.

30. The courts will protect the title of the author or inventor of any names, marks, letters, or other symbols which any manufacturer, trader, or other person has devised, or appropriated, or been accustomed to use in his trade or business, and will restrain by injunction any unauthorized use thereof to his prejudice. *Bloss* v. *Bloomer*, 23 Barb. S. C., 609.—SMITH, J.; N. Y., 1857.

31. But it would seem to be implied that such individuals should not themselves attempt or allow any imposition upon the public by the false and fraudulent use of such labels, devices, and names or inventions, for the sale of spurious or simulated articles. *Ibid.*, 609.

32. Where the plaintiffs, growers of garden seeds, agreed to sell defendants empty paper bags, with the plaintiffs' labels thereon, which they, defendants, were to fill with seeds and sell in certain counties, *Held*, that it was a contract against public policy, and therefore void. *Ibid.*, 605, 610.

33. The law of trade-marks is of recent origin, and may be comprehended in the proposition that a dealer "has a property in his trade-mark." *Clark* v. *Clark*, 25 Barb. S. C., 79.—MITCHELL, J.; N. Y., 1857.

34. The ownership is allowed to him, that he may have the exclusive benefit of the reputation which his skill has given to articles made by him, and that no other person may be able to sell to the public as his, that which is not his. *Ibid.*, 79.

35. It is to protect one's right of selling his own that the law of trade-marks has been introduced. It must include a right to sell to all—to the incautious as well as to the cautious. *Brooklyn W. L. Co.* v. *Masury*, 25 Barb., S. C., 418. —MITCHELL, J.; N. Y., 1857.

36. The right to a trade-mark does not become established until the trade-

mark be so often used, and so long employed, exclusively and uninterruptedly, as to create a presumption that every body would know and acknowledge it as a distinctive badge of ownership, and that the use of it by others must have been intended to deceive. *Corwin* v. *Daly*, Upton on Trade-Marks, 199.—ROBERTSON, J.; N. Y., 1860.

37. Even if others have used it previously—but its use had been discontinued so long as to give room for the inference that it had been abandoned, as an ordinary designation of any similar articles, and it is then taken up by a person dealing in the article, and used exclusively and uninterruptedly so long as to give rise to the presumption that it was universally recognized as the *indicia* of his ownership, his right should be protected as much as though it had then been used for the first time. *Ibid.*, 199.

38. A party cannot be protected in the use of trade-marks which are employed to deceive the public, and to deceive them by the fraudulent representations contained in the labels and devices which are claimed to constitute wholly or in part, such trade-marks. An intent to deceive the public is not favored. *Hobbs* v. *Francais*, 19 How. Pr. 571.—BOSWORTH, J; N. Y., 1860.

39. Where the plaintiff manufactured a skin powder, called "Meen Fun," which was represented as made in London, and "patronized by Her Majesty, the Queen," when, in fact, it was made in New York, and the defendant manufactured a like article, representing it as "patronized by Her Majesty, the Empress," *Held*, that the court would not grant an injunction; not out of any regard for the defendant, but not to assist in deceiving the public. *Ibid.*, 571.

40. The neglect of a party to carry on his business, under its well-known name, for a number of years, does not prevent him from resuming the same, or entitle another to use the name of his business. *Howe* v. *Searing*, 19 How. Pr., 25—HOFFMAN, J.; N. Y., 1860.

C. PROPERTY IN, HOW PROTECTED.

See ACTIONS, C.; EQUITY, C.

D. VIOLATION OF, WHAT AMOUNTS TO.

See INFRINGEMENT, C.

E. WHEN VIOLATION OF WILL BE RESTRAINED.

See INJUNCTION, C.

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## TRANSLATION.

1. One person may have a right to a copyright in a translation upon which he has bestowed time and labor; but another has an equal right to translate the original work, and publish his translation. *Emerson* v. *Davies*, 3 Story, 780.—STORY, J.; Mass., 1845.

2. A *copy* of a book must be a transcript of the *language* in which the conceptions of the author are clothed. The same conceptions, clothed in another language, cannot constitute the same composition; nor can it be called a transcript, or "*copy*," of the same "*book*." *Stowe* v. *Thomas*, 2 Amer. Law Reg., 229.—GRIER, J.; Pa., 1853.

3. Though the point was not directly in issue in the great case of *Miller* v. *Taylor*, 4 Burr., 2305, yet the inference that a translation is not an infringement

of a copyright is a logical result, and stated by the judges themselves as a necessary corollary from the principle of law then decided by the court. *Ibid.*, 230.

4. The case of *Miller* v. *Taylor*, 4 Burr., settled the question as to the nature of the property which an author has in his works; and it is, that after publication, his property consists in the "right of copy," which signifies "the sole right of printing, publishing, and selling his literary composition or book;" not that he has such a property in his original conceptions that he alone can use them in the composition of a new work, or clothe them in a different dress by translation. *Ibid.*, 230.

5. A translation can, in no just sense, be called a "copy" of a book. *Ibid.*, 231.

6. Where an exclusive privilege has been secured by statute in a book which is publicly circulated, a stranger who, in whole or in part, reproduces it in the new form of translation, or abridgement, or index, or table of contents, or analytical review, does not infringe the statutory privilege. But either of these acts would violate the right of the literary proprietor of a book of which the circulation had been private only. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 82.—CADWALLADER, J.; Pa., 1860.

## UNITED STATES.

1. In an action under § 10 of the act of 1793, the court will not order the United States to be substituted as plaintiffs in the action of *scire facias*, in place of the petitioner. *Wood* v. *Williams*, Gilpin, 520, 524.—HOPKINSON, J.; Pa., 1834.

2. The United States cannot be brought in as a party to a litigation, respecting the validity of any rights claimed or derived under the United States laws. *Ibid.*, 520.

3. On the contrary, these rights are considered private rights. A controversy as to them is strictly between the parties concerned, although the public may have an eventual interest in it. *Ibid.*, 520, 521.

4. Where a patent was extended by special act of Congress, which secured to patentees and purchasers their rights only upon the same terms and conditions they had before enjoyed them, and under the former patent the United States had the right to use the invention at a stipulated price, *Held*, that under such extension the United States could not continue to use the invention except upon the terms before agreed upon; there was no exception in its favor. *Blanchard's Case*, Opin., Gilpin's ed., 1126.—BUTLER, Atty. Gen.; 1837.

5. S. being an inventor of an improvement in dragoon and pack saddles, made application for a patent therefor before May, 1847. In November, 1847, before such application was acted on, G. made application for a patent for the same invention; but notice of interference was not given. In December, 1847, the Secretary of State addressed the Commissioner of Patents, that an early issue of a patent to G. would facilitate a supply of saddles to the government; G.'s application was taken up, and a patent issued December 11th, 1847—S.'s application remaining not acted upon and postponed. *Held*, that the wrong done to S. was not committed by the United States, or by any of its officers, so as to render them pecuniarily responsible therefor. *Thistle* v. *United States*

Devereaux's Rep., 130.—SCARBURGH, J.; Ct. Claims, 1856.

6. There is nothing to estop the government of the United States from showing a patent, which it has granted, to have been a nullity *ab initio*, owing to the non-existence of the condition precedent of novelty of the invention. *King* v. *United States*, 10 Mo. Law Rep., 631.—Ct. Claims, 1857.

7. The United States are not precluded by the fact of granting a patent, from giving in evidence, or availing themselves of any legal objections that may be brought against any such patent. *Shreeve* v. *United States*, MS.—LORING, J.; Ct. Claims, 1859.

## VERDICT IN PATENT CASES.

As to effect of verdict in feigned issues, see FEIGNED ISSUE, B.

As to what defects are cured by verdict, see PLEADING, D.

As to effect of former recoveries or verdicts upon the question of right to an injunction, see INJUNCTION, B. 2. *b*.

1. The recovery of a verdict by the plaintiff in an action for the infringement of a patent, does not pass any legal right to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiff's patent. *Whittemore* v. *Cutter*, 1 Gall., 484.—STORY, J.; Mass., 1813.

2. The verdict of a jury in an action on a second patent, cannot avoid a first patent. *Morris* v. *Huntington*, 1 Paine, 356.—THOMPSON, J.; N. Y., 1824.

3. Whether a verdict for a plaintiff and the assessment of damages for a violation of his patent, entitles the defendant to use the machine subsequently, or transfers to him the right to use it; *query*. *Earle* v. *Sawyer*, 4 Mas., 13.—STORY, J.; Mass., 1825.

4. In an action for an infringement of a patent, where the declaration goes for a user during a limited period, and afterward the party sues for a user during another and subsequent period, a verdict and judgment in the former case, is not a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. *Ibid.*, 14.

5. Whether a verdict given in a suit at law is ever evidence of any thing, but the fact that it was rendered, unless a judgment has been duly rendered thereon; *query*. *Allen* v. *Blunt*, 3 Story, 746.—STORY, J.; Mass., 1845.

6. A former verdict of dismissal between the same parties, on an issue out of chancery, on a bill asking for an injunction, and upon an original specification, is not admissible in evidence in a suit at law for damages for violation of the patent, with corrected specifications, and in no case is such a verdict a bar to the second action, unless judgment was rendered on such verdict against the plaintiff, or such verdict of dismissal was on the merits. *Ibid.*, 132–134.

7. A verdict in a patent case, and sustaining a patent, can in no case be evidence at law or in equity, in another action brought by a witness called by the plaintiff on the trial in the former action, and who was interested in the same patent, for the purpose of establishing his title to the patent, as it is a proceeding *inter alios*. *Buck* v. *Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

8. But such verdict would be admissible on a motion for a provisional injunction, as affording strong evidence of the validity of the patent, and of his title. It is evidence, however, only in cases where his own deposition would be competent, cases in which the application is to the sound discretion of the court. *Ibid.*, 324, 325.

9. Where a patentee and his assignee brought a suit in equity in the Circuit Court in Louisiana, under section 16 of the act of 1836, against a junior patentee, to declare such junior patent void, on the ground of its interference with the plaintiff's patent; and afterward the same plaintiffs brought an action at law in another circuit, for an infringement of their patent, against a party who was not a party to the suit in Louisiana, but who had obtained an interest in the junior patent, sought to be set aside by that suit, after the commencement of that suit and before the judgment rendered therein; *Held*, that the parties to such suit at law were within the proviso of said § 16, and that their rights would be bound by a decision in the suit in Louisiana, declaring that such patents interfered, or that either of them was valid or invalid. *Tyler* v. *Hyde*, 2 Blatchf., 309, 312.—BETTS, J.; N. Y., 1851.

10. In an action for the infringement of a patent, if the jury adopt, as the measure of damages, the price of the patent fee, proved in the case, such verdict will operate to vest the title of the patent to the extent of its use by the defendant complained of, throughout its term. *Sickles* v. *Borden*, 3 Blatchf., 545.—NELSON, J.; N. Y., 1856.

## WARRANTY.

1. A conveyance or license "to build and use a patent machine," describing it "and such as I have a patent-right for," does not amount to a covenant on the part of the vender that he had a valid patent-right. *Bull* v. *Pratt*, 1 Conn., 343, 346.—SWIFT, Ch. J.; Ct., 1815.

2. If a party sell an interest in a patent-right, making representations that are equivalent to a warranty that the invention is of value, but the title is passed by an ordinary bill of sale or assignment, which contains no words of guarantee, the purchaser cannot go behind such assignment and prove representations and assertions made previous to the execution of the assignment, and thus impeach the consideration of the sale, and avoid payment—the presumption of law being that the writing contains the whole contract. *Van Ostrand* v. *Reid*, 1 Wend., 432.—SAVAGE, Ch. J.; N. Y., 1828.

3. There is no implied warranty in the sale of a patent-right. The vendor, selling in good faith, is not responsible for the goodness of his title beyond the extent of his covenants. *Hiatt* v. *Twomey*, 1 Dev. & Bat. Eq., 317, 318.—DANIEL, J.; N. C., 1836.

4. In sales of personal property, there is an implied warranty that the vendor has title to the property, and the same implications arise as to sales of patent-rights. *Darst* v. *Brockway*, 11 Ohio, 471.—BIRCHARD, J.; Ohio, 1842.

5. Where notes were given for the purchase of a patent which proved to be void, *Held*, that an injunction would be allowed against the collection of such notes outstanding, and in the hands

of the vendors of the patent. *Ibid.*, 471.

6. If a bill of sale of a patent contains no warranty, but a simple transfer of title, the vendee cannot set up a parol warranty, for it is to be presumed that the writing contains the entire contract. *Jolliffe* v. *Collins*, 2 Mo., 341.—SCOTT, J.; Mo., 1855.

7. Where a warranty is not included in the written contract, it cannot be proved by parol evidence, unless it is also alleged that it was false or fraudulent, and that thereby the vendee was deceived, and then parol proof is only evidence of such representation. *McClure* v. *Jeffries*, 8 Ind., 83.—DAVISON, J.; Ind., 1856.

8. An assignment contained a warranty that the invention was original, and that no other invention had been patented in the United States on the same principle. In an action of covenant in which breaches were assigned in the terms of the warranty; *Held*, that the patent was not conclusive that the invention was original, and upon a new principle, and that upon proof of the breaches assigned, the plaintiff could recover. *Wright* v. *Wilson*, 11 Rich. Law., 144, 152.—O'NEALL, J.; S. Car., 1857.

9. In contracts for the sale of interests in a patent where there is no fraud, the purchaser must depend, when they prove of no value, upon his covenants. If both parties are equally innocent, and there is no warranty of title, the loss must fall where the bargain leaves it. *Cansler* v. *Eaton*, 2 Jones Eq., 501.—NASH, Ch. J.; N. Car., 1856.

## WITHDRAWAL.

See APPLICATION FOR PATENT, C.

## WITNESSES.

See EVIDENCE, G.

## WORKMEN, LIABILITY AS INFRINGERS.

See AGENT, EMPLOYEE.

## WRIT OF ERROR IN PATENT CASES.

See also APPEALS, A.; BILLS OF EXCEPTION; COURTS, B. 1.

1. From a judgment in a proceeding under § 10 of the act of 1793, in a District Court, a writ of error lies to the Circuit Court, under § 22 of chap. 20 of the judiciary act of 1790, if the amount in controversy exceeds fifty dollars. *Stearns* v. *Barrett*, 1 Mas., 166, 167.—STORY, J.; Mass., 1816.

2. A refusal to amend a verdict is not the subject of a writ of error: it being but a mere exercise of discretion by the court below. *Ibid.*, 168.

3. Under § 17 of the act of 1836, if a writ of error is allowed by the court in cases where the amount in dispute does not reach $2,000, and in such as are deemed "reasonable," it must bring up the whole case for consideration, and the court below cannot determine that only particular points shall be taken up.

*Hogg* v. *Emerson*, 6 How., 477, 478.—Woodbury, J.; Sup. Ct., 1847.

4. The word "reasonable" applies to the cases rather than to any discrimination between the different points in the cases. *Ibid.*, 478.

5. Under § 17 of the act of 1836, an appeal or writ of error lies to the Supreme Court, under an order of the court, although the judgment is under the amount of $2,000. *Foote* v. *Silsby*, 1 Blatchf., 544.—Nelson, J.; N. Y., 1850.

6. A judge of this court sitting at chambers is a court in the proper and usual sense of the term, and has the power to allow a writ of error, under § 17 of the act of 1836, in cases where the judgment is under $2,000, and where the court shall deem such writ reasonable. *Ibid.*, 544.

7. There might be some reason for holding that the judge, when allowing such writ, must be sitting at a stated term of the court, and not at chambers, where the court at chambers and at the stated term were held by different persons. But where they are held by the same person the distinction is not well founded. *Ibid.*, 544.

8. On the allowance of such a writ of error, the judge made an order giving leave to the defendants to make a bill of exceptions. On the trial, two years before, no bill of exceptions had been settled in form, but a case had been made and settled, to move for a new trial. No reservation was contained in the case to turn it into a bill of exceptions; but it had first been drawn up in the form of a bill of exceptions, and changed by direction of the judge at the trial. *Held*, on a motion to set aside the order, that as the points and exceptions were taken in the required form at the trial to entitle the party to the benefit of them on a writ of error, though the paper book was in the form of a case, which, however, was given it under the direction of the judge at the trial, without prejudice to the right of the defendants to make a bill of exceptions, that the order should stand. *Ibid.*, 544, 545.

9. The last clause of § 17 of the act of 1836 providing for appeals and writs of error "in all other cases in which the court shall deem reasonable," does not apply to a suit in equity to set aside an assignment of a patent. *Wilson* v. *Sandford*, 10 How., 101, 102.—Taney, Ch. J.; Sup. Ct., 1850.

10. The right of appeal is confined to the cases mentioned in the first part of the section—"to actions, suits, controversies, and cases arising under any law of the United States granting or confirming to inventors the exclusive right to their inventions or discoveries"—and was intended to secure uniformity of decision in the construction of the acts of Congress in relation to patents. *Ibid.*, 101–313.

11. A judgment of a Circuit Court rendered upon an agreed statement of facts between the parties, may be re-examined by this court on a writ of error. *Stimpson* v. *Bal. & Sus. R. R. Co.*, 10 How., 346, 347.—Daniel, J.; Sup. Ct., 1850.

12. A writ of error will not lie from an act done in the court below, the doing of which was a matter of discretion with the court. *Silsby* v. *Foote*, 14 How., 220.—Curtis, J.; Sup. Ct., 1852.

13. A second writ of error brings up for revision nothing but the proceedings subsequent to the mandate. *Sizer* v. *Many*, 16 How., 103.—Taney, Ch. J.; Sup. Ct., 1853.

14. Where, therefore, after the mandate, the court below did nothing but tax the costs, and these amounted to less than $2,000, *Held*, that no writ of error would lie. *Ibid.*, 103.

15. The discretionary power as to granting writs of error in patent cases, vested in the Circuit Court by § 17 of the act of 1836, is confined to cases which involve the construction of the patent laws, and the rights of patentees under them; and does not justify a writ of error merely to review a question of costs. *Ibid.*, 103.

# STATUTE LAWS

OF THE

# UNITED STATES OF AMERICA

RELATING TO

# PATENTS FOR INVENTIONS

## TRADE-MARKS

# DESIGNS AND COPYRIGHTS

WITH

## SECTIONAL HEAD NOTES AND INDEXES

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# PREFACE

In the United States, property in Copyright and in Patents for Inventions, is created by, and depends solely upon, the laws passed by Congress. Previous to the adoption of the Federal Constitution, in 1789, the several states had granted exclusive rights to authors and inventors; but by that instrument such power was given to Congress, and the states can *now perform no acts in respect thereto, or none not in* harmony with, and in subordination to, the superior power of Congress. At its first session in 1790, Congress passed initiatory laws for the obtaining of copyrights and patents for inventions. In 1831, the several acts respecting copyright were revised and consolidated, and, in 1836, similar action was taken as to the acts respecting patents for inventions. Such laws of 1831, and of 1836, are still the basis of the present copyright and patent systems of this country, though additional acts have, from time to time, been passed for the better and more effectually protecting such property and its enjoyment.

The laws in respect to copyright, in their general features, are substantially like those of England and other countries, except, perhaps, as to the duration of the right conferred, and the formalities by which such right is to be acquired; but in respect to patents for inventions, the differences between our laws and those of other countries are marked and distinct. In England, and in most other countries, patents, originally, were grants proceeding directly from the sovereign, and were considered by the Courts in the light of monopolies, and as odious in the eyes of the law. In this country, however, it has been uniformly held that the design of our patent laws was to encourage genius in advancing the arts, by protecting its productions, and that such laws were to be construed favorably and beneficially for patentees; and that patents granted thereunder were to be considered, not as monopolies, but liberally, and as highly beneficial to the community—as well as rewards to ingenious men for the advantages derived by the public from their exertions.

The peculiar and distinctive feature of our patent system is that, which requires all applications for patents to be subjected to a preliminary examination, before a patent can be granted. In most, if not all other countries, patents issue, as of course, without examination, except merely to determine whether the alleged invention or discovery falls within any class, as to which patents cannot issue.

It is undoubtedly a matter of no little difficulty to select such persons as are fitly qualified to make such examination, and to determine in the first instance whether any invention is patentable, and such examiners may often err, sometimes granting patents inconsiderately, and again refusing them in cases where they ought to issue;

but it will scarcely be denied that the labors of such persons are highly useful, not only to the inventor, in bringing to his notice what is already known in the art to which his invention appertains, but also to the public, in interposing a salutary check to the issue of numerous trifling, worthless patents.

Further legislation, however, seems to be required to secure to the inventor, or patentee, such benefits as are due him by reason of such examination. Though he may be compelled, as he frequently is, to appeal from the decision of the primary examiners to the examiners in chief, and again to the Commissioner, and, perhaps, still again to the Justices of the Circuit Court of the District of Columbia, before he can obtain his patent, each step being attended with delay, and increased expense, yet when his patent is infringed, and he seeks protection in the Courts, all this preliminary examination and investigation, as the law now stands, avails him nothing, except to strengthen somewhat the *prima facie* character of his patent, the validity of which, if denied, he must, however, sustain as if no previous investigation had been had in respect to it. If the government requires such an examination, before a patent can issue, surely the patent, when granted, ought to have a higher character, and give a more complete protection, than if no condition had been imposed upon its issue. Such protection might be secured, by giving a patentee, in case of the infringement of his patent, the benefit of process in the nature of an attachment, against both the machinery used in such infringement, and the thing manufactured, the same to be forfeited should the patent be sustained: and the party infringing should not be allowed to continue his manufacture, except upon security to account for all proceeds received by him, and to pay all damage the patentee might sustain, and any expense he might be put to by reason of the infringement.

Further legislation seems also to be required with reference to the right of recovery, by patentees, of the costs and expenses attendant upon litigation made necessary by reason of the infringement of their patents. The nature of litigation in patent cases, the wide range of investigation embraced in such cases, and the peculiar character of the testimony required, demanding frequently great research and investigation in connection with varied scientific attainments, all combine to render the expense of litigation, in such cases, much greater than in other actions. All that a patentee can now recover, however, is the actual damages he may have sustained, with only such disbursements as are recoverable in ordinary actions, and no costs, except an insignificant record fee, and that only when a judgment is obtained. A provision, which should entitle a patentee to recover, in addition to the actual damage sustained by him by the infringement of his patent and the taxable costs so-called, such expenses, within just limits, as he may have been put to by reason of such infringement, would seem but simple justice to him, and no injustice toward those who have endeavored to deprive him of the benefit of his invention.

Considered, however, as a whole, the patent system of this country, as construed and interpreted by the Courts, is highly favorable to inventors and the progress of intention, and we may confidently anticipate increasing perfection in it; and in no country are the rights of authors and inventors more fully and willingly recognized, and nowhere are their rewards and remuneration more generous and munificent.

# PROVISION

OF THE

# CONSTITUTION OF THE UNITED STATES,

AUTHORIZING THE GRANT OF

## EXCLUSIVE RIGHTS TO AUTHORS AND INVENTORS.

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## CONSTITUTION OF THE UNITED STATES.

### ARTICLE 1, SECTION 8.

THE Congress shall have power:
To promote the progress of science and useful arts, by securing for limited

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### POWER OF CONGRESS, AND OF THE SEVERAL STATES UNDER.

The power of Congress, under this article and section, is limited to authors and inventors only, and does not embrace introducers, who are not authors and inventors. *Livingston* v. *Van Ingen*, 9 John., 560, 566, 582.—YATES, THOMPSON and KENT, JJ.; (Ct. Errors); N. Y., 1812.

But such clause does not prevent the several states from exercising the power of securing to introducers of useful inventions the exclusive benefit of such inventions for a limited period. *Ibid.*, 560, 566, 582.

Nor does it take away from the states the power to enlarge, within their jurisdiction, the privilege, by extending the term of the patent or monopoly, beyond the term allowed by the acts of Congress; nor operate as an exclusion of all state legislation to aid and protect the rights obtained under the general government, if the power is exercised in harmony with, and in subordination to, the superior power of Congress. *Ibid.*, 567, 581.

Though a state cannot take away from an individual his patent, yet if an author or inventor, instead of resorting to the act of Congress, should apply to the legislature of a state for an exclusive, right to his production, there is nothing to hinder a state granting it, though the operation of the grant would be confined to the limits of the state. *Ibid.*, 581.

The power of Congress is only to ascertain and define the rights of property in the invention; it does not extend to regulating the use of it. This is exclusively of local cognizance; such property, like every other species, must be used and enjoyed within each state, according to the laws of such state. *Ibid.*, 581.

The laws of any state, however, granting exclusive rights and privileges in respect

**times, to authors and inventors, the exclusive right to their respective writings and discoveries:**

to patents and inventions, are inoperative as against the laws of the United States, with which they may come in collision. *Gibbons* v. *Ogden*, 9 Wheat., 186.—MARSHALL, Ch. J.; Sup. Ct., 1824.

The laws of the state of New York, granting to Livingston & Fulton the exclusive right to navigate all the waters within its jurisdiction, with boats moved by steam, or fire, for a term of years, were held to be inoperative as against the laws of the United States regulating the coasting trade, and that they could not restrain vessels licensed under the laws of the United States, to carry on the coasting trade, from navigating such waters. *Ibid.*, 220.

A state cannot exercise its legislative authority in reference to patents and inventions, so as to restrain a free intercourse among the several states. *Ibid.*, 239.—JOHNSON, J.

Whether Congress can decide the fact that an individual is an inventor or author, without leaving the question of invention, &c., open for investigation, the courts will never presume Congress to have decided that question in a general act, the words of which do not render such a construction unavoidable. *Evans* v. *Eaton*, 3 Wheat., 513 —MARSHALL, Ch. J.; Sup. Ct., 1818.

The power of Congress, as to patents, is general, and it rests in its sound discretion to say, when and for what length of time, and under what circumstances, a patent for an invention shall be granted. There is no restriction which limits its power to enact, to cases where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor. *Blanchard* v. *Sprague*, 3 Sumn., 541.—STORY, J.; Mass., 1839.

An act of Congress, however, passed in general terms, ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority; and to be construed not to act retrospectively, or *ex post facto*, unless that construction is unavoidable. *Ibid.*, 542.

The power of Congress to legislate upon the subject of patents is plenary; and as there is no restraint upon its exercise, there can be no limitation to the right to modify at pleasure the laws respecting patents, so that they do not take away the rights of property in existing patents. *McClurg* v. *Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

It is no objection to the validity of the laws respecting patents, that such laws are retrospective in their operation. *Ibid.*, 206.

A reservation in favor of *assignees*, in an act extending a patent, will not make the act unconstitutional on the ground that Congress can only confer privileges on *inventors*. The power to reserve rights and privileges to assignees is incidental to the general power conferred to promote the progress of the useful arts. *Blanchard Gun-Stock Turning Fac.* v. *Warner*, 1 Blatchf., 271, 276.—NELSON, J.; Ct., 1846.

Congress has the constitutional right to confer a new and further term on the patentee, and that even after the expiration of the first. *Blanchard* v. *Haynes*, 3 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848.

A legislative act does not bind a subsequent legislature. There is no mode by which a legislative act can be made irrepealable, except it assume the form and substance of a contract. *Bloomer* v. *Stolley*, 5 McLean, 161.—MCLEAN, J.; Ohio, 1850.

And Congress may pass an act which shall act retrospectively. Such an act is not necessarily unconstitutional. Though no state can impair the obligations of a contract, this inhibition does not apply to the general government. *Ibid.*, 165.

Under the fifth amendment of the Constitution, declaring that no person shall be deprived of life, liberty, or property, without due process of law, Congress would have

**Also to make all laws which shall be necessary and proper for carrying into execution the foregoing powers.**

no right to pass an act depriving purchasers of a patented article of the right to use such article. Such an act could not be regarded as due process of law. *Bloomer* v. *McQuewan*, 14 How., 553.—TANEY, Ch. J.; Sup. Ct., 1852.

Under the authority conferred by section 8th, article 1st., of the Constitution, it does not follow that Congress may authorize an inventor to recall rights which he has granted to others, or reinvest him with rights of property, which he has before conveyed for a valuable consideration. *Ibid.*, 553.

See also DIGEST, titles CONGRESS; STATUTES, B. 1.

### PRIVATE ACTS.

Congress may exercise its constitutional power, as to granting rights to inventors, either by special acts, or by a general system. *Bloomer* v. *Stolley*, 5 McLean, 161.—McLEAN, J.; Ohio, 1850.

A private act of Congress, authorizing the issue of a patent to an inventor, is to be considered as engrafted on the general acts for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Evans* v. *Eaton*, 3 Wheat., 518.—MARSHALL, Ch. J.; Sup. Ct., 1818.

They are all statutes in *pari materia*, and all relate to the same subject, and are to be construed together. *Bloomer* v. *McQuewan*, 14 How., 549, 551.—TANEY, Ch. J.; Sup. Ct., 1852.

Alleged fraud and misrepresentation in the passage of an act of Congress extending a patent, will not be presumed; but such an act will be regarded by the courts as the law of the land, until it is repealed. *Gibson* v. *Gifford*, 1 Blatchf., 531.—NELSON, J.; N. Y., 1850.

See also DIGEST, title STATUTES, B. 4.

# LAWS

OF THE

# UNITED STATES

RELATING TO

# PATENTS FOR INVENTIONS

# DESIGNS

# TRADE-MARKS AND COPYRIGHTS

NOW IN FORCE

# LAWS OF THE UNITED STATES

## RELATING TO

# PATENTS FOR INVENTIONS AND DESIGNS,

## REGISTRATION OF TRADE-MARKS

## AND COPYRIGHTS.

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The laws of the United States now in force as to Patents, Trade-marks, and Copyrights are contained in the Revised Statutes of the United States, approved June 22, 1874 (which substantially re-enacted, with some additions, the provisions of the revised and consolidated Patent Act of July 8, 1870), and in Acts of Congress passed since the Revised Statutes. In this compilation, reference is made, for greater convenience, both to the Revised Statutes, and also to the Patent Act of 1870 or other acts: the **heavy type** at the beginning of each section indicating the section of the Revised Statutes, and the reference in *italics*, indicating the corresponding section of the Act of 1870 or of other Acts.

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## ORGANIZATION OF THE PATENT OFFICE.—GENERAL PROVISIONS AFFECTING PATENTS AND PATENT SUITS.


SEC. 440. Clerks and employees of the patent office.
475. Establishment of the patent office.
476. Officers, and appointment of.
477. Salaries of officers.
478. Seal of the patent office.
479. Bonds of commissioner and chief clerk.
480. Restrictions upon officers and employees.
481. Duties of the commissioner.
482. Duties of the examiners-in-chief.
483. Establishment of regulations.
484. Arrangement and exhibition of models, &c.
485. Disposals of models on rejected applications.
486. Provisions for 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. Printing additional specifications and drawings.
492. Lithographing and engraving.
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. 629. Jurisdiction of suits and actions under the patent laws.
699. Writs of errors and appeals.
711. Jurisdiction exclusive.
718. Temporary restraining orders.
719. Injunctions, who may grant; duration of.
720. Jury in patent cases.
892. Evidence—Copies of patents, records, &c., of patent office.
893. Evidence—Copies of foreign letters patent.
894. Evidence—Printed copies of specifications and drawings of patents.
1587. Patented articles connected with marine engines, how purchased by U. S.
1678. No royalty to be paid by the United States on certain patents.

## TITLE XI, CHAP. 1, p. 74.

**Sec. 440.** (*Act of* 1870, § 3.) [**Clerks, examiners, &c., of patent office.**] There shall be in the Department of the Interior—

In the Patent Office:

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

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

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

Twenty-four principal examiners, at a salary of two thousand five hundred dollars a year each.

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

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

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

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

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

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

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

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

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

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

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

* Grade of third assistant examiners abolished, Act of 1875, ch. 129.

## TITLE XI, CHAP. 6, p. 79–81.

**Sec. 475.** (*Act of* 1870, § 1.) [**Establishment of the patent office.**] 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.

**Sec. 476.** (*Act of* 1870, § 2.) [**Officers and Employees.**] 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.

**Sec. 477.** (*Act of* 1870, § 4.) [**Salaries of officers.**] 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.

**Sec. 478.** (*Act of* 1870, § 12.) [**Seal of patent office.**] 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.

**Sec. 479.** (*Act of* 1870, § 6.) [**Bonds of commissioner and chief clerk.**] 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.

**Sec. 480.** (*Act of* 1870, § 16.) [**Restrictions upon officers and employees.**] 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.

**Sec. 481.** (*Act of* 1870, § 7.) [**Duties of the commissioner.**] The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

**Sec. 482.** (*Act of* 1870, § 10.) [**Duties of the examiners-in-chief.**] The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of 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.

**Sec. 483.** (*Act of* 1870, § 19.) [**Establishment of regulations.**] The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**Sec. 484.** (*Act of* 1870, § 13.) [**Models, arrangement of.**] The Commissioners 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.

**Sec. 485.** (*Act of* 1870, § 14.) [**Disposals of models on rejected applications.**] 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.

**Sec. 486.** (*Act of* 1870, § 15.) [**Library.**] There shall be purchased for the use of the Patent Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

**Sec. 487.** (*Act of* 1870, § 17.) [**Patent agents may be refused recognition.**] 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.

**Sec. 488.** (*Act of* 1870, § 18.) [**Printing of papers filed.**] The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

**Sec. 489.** (*Act of* 1870, § 20.) [**Printing copies of claims, laws, decisions, &c.**] 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.

**Sec. 490.** (*Res.* 1871, *Jan.* 11.) [**Printing specifications and drawings.**] 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.

* The Commissioner of Patents is also required to furnish a copy of the bound volumes of specifications and drawings to each of the Executive Departments of Government, when requested to do so. Act of March 3, 1875, ch. 130, § 12.

**Sec. 491.** (*Res. of* 1871, *Jan.* 11.) [**Additional specifications and drawings.**] 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.

**Sec. 492.** (*Res.* 1874, *March* 24, § 1.) [**Lithographing and engraving.**]

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.

**Sec. 493.** (*Act of* 1871, ch. 5, § 2.) [**Specifications and drawings, price of.**] 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.

**Sec. 494.** (*Act of* 1870, § 16.) [**Annual report of commissioner.**] The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. (See §§ 195, 196.)

**Sec. 495.** (*Act of* 1854, ch. 242, § 8.) [**Collections of Exploring Expeditions, custody of.**] The collections of the Exploring Expedition now in the Patent Office shall be under the care and management of the Commissioner of Patents.

**Sec. 496.** (*Act of* 1870, § 69.) [**Disbursements for Patent Office, by whom made.**] All disbursements for the Patent Office shall be made by the disbursing clerk of the Interior Department.

## TITLE XIII, CHAP. 7, p. 109–111.

**Sec. 629.** (*Act of* 1870, § 55.) [**Actions, where cognizable.**] The Circuit Courts shall have original jurisdiction,

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

## TITLE XIII, CHAP. 2, p. 130.

**Sec. 699.** (*Act of* 1870, § 56.) [**Writs of Error and Appeals.**] 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, without regard to the sum or value in dispute.

From 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.

## TITLE XIII, CHAP. 12, p. 134–5.

**Sec. 711.** (*Act of* 1870, § 55.) **[Jurisdiction exclusive.]** The jurisdiction vested in the courts of the United States shall be exclusive of the courts of the several states;

Of all cases arising under the Patent right or Copyright laws of the United States.

**Sec. 718.** (*Act of* 1872, ch. 255, § 7.) **[Temporary restraining orders.]** Whenever notice is given of a motion for an injunction out of a circuit or district court, the court or judge thereof may, if there appears to be danger of irreparable injury from delay, grant an order restraining the act sought to be enjoined until the decision upon the motion; and such order may be granted with or without security, in the discretion of the court or judge.

**Sec. 719.** (*Act of* 1793, ch. 22, § 5. 1807, ch. 13, § 2.) **[Injunctions, who may grant; duration of.]** Writs of injunction may be granted by any Justice of the Supreme Court in cases where they might be granted by the Supreme Court; and by any Judge of a Circuit Court, in cases where they might be granted by such Court. But no Justice of the Supreme Court shall hear or allow any application for an injunction or restraining order in any cause pending in the circuit to which he is allotted, elsewhere than within such circuit, or at such place outside of the same as the parties may stipulate in writing, except when it can not be heard by the Circuit Judge of the Circuit, or the District Judge of the District.

And an injunction shall not be issued by a District Judge, as one of the Judges of a Circuit Court, in any case where a party has had a reasonable time to apply to the Circuit Court for the writ; nor shall any injunction so issued by a District Judge continue longer than to the Circuit Court next ensuing, unless so ordered by the Circuit Court.

**Sec. 720.** (*Act of* 1875, ch. 77, § 2.) **[Jury in Patent cases.]** The Circuit Courts of the United States, when sitting in equity for the trial of patent causes, may impanel a jury of not less than five, or 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.

## TITLE XIII, CHAP. 17, p. 168.

**Sec. 892.** (*Act of* 1870, § 57.) **[Copies of records, &c., how made evidence.]** Written or printed copies of any records, books, papers or drawings

belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof.

**Sec. 893.** (*Act of* 1870, § 57.) [**Copies foreign letters patent, how made evidence.**] Copies of the specifications and drawings of foreign letters patent, certified as provided in the preceding section, shall be prima-facie evidence of the granting of such letters patent, and of the date and contents thereof.

**Sec. 894.** (*Res. of Jan.* 11, 1871.) [**Printed copies of specifications, &c., how made evidence.**] The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained.

## TITLE XV, CHAP. p. 261.

**Sec. 1537.** (*Act of* 1861, ch. 8, § 3.) [**Patented articles as to marine engines, purchase of.**] No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use.

## TITLE XVII, CHAP. p. 292.

**Sec. 1673.** (*Act of* 1872, ch. 316, § 17.) [**Royalties not to be paid by U. S for certain articles.**] No royalty shall be paid by the United States to any one of its officers or employees for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employees may be directly or indirectly interested.

## PATENTS FOR INVENTIONS AND DISCOVERIES.


SEC. 4883. Patents, how issued and recorded.
4884. Patents, contents and duration of.
4885. Patents, date of.
4886. What inventions patentable.
4887. Patents for inventions previously patented abroad.
4888. Requisites of applications. Description, specification, and claim.
4889. Drawings, when requisite.
4890. Specimens of ingredients, &c.
4891. Model, when requisite.
SEC. 4892. Oath of applicant, before whom made.
4893. Examination, and issuing Patent.
4894. Applications, when to be completed.
4895. Patents may issue to assignee.
4896. Executors and administrators, when may obtain patent.
4897. Renewal of application, on failure to pay fees in season.
4898. Assignments of Patents.
4899. Purchaser or user of invention, before application, rights of.

SEC. 4900. Patented articles, to be marked as such.
4901. Falsely marking or labeling articles as patented, penalty for.
4902. Caveats, who may file.
4903. Rejection of claim, applicant to be notified.
4904. Interferences.
4905. Affidavits and depositions, rules as to.
4906. Subpœnas to witnesses.
4907. Witness fees.
4908. Penalty for refusing to attend or testify.
4909. Appeals from primary examiners to examiners-in-chief.
4910. Appeals from examiners-in-chief to commissioner.
4911. Appeals from the Commissioner to the Sup. Ct., of Columbia.
4912. Appeal to Sup. Ct., Dist. of Columbia. Notice.
SEC. 4913. Proceedings on appeal to Supreme Court.
4914. Determination of such appeal and its effect.
4915. Patents obtainable by bill in equity.
4916. Re-issue of defective patents.
4917. Disclaimer.
4918. Suits as to interfering patents.
4919. Suits for infringement; damages.
4920. Pleading and notice in actions for infringement.
4921. Power of courts as to injunctions and damages.
4922. Suits maintainable when specification is too broad.
4923. Patent not void, because of prior use in foreign country.
4928. Operation of extensions.

## TITLE LX, CHAP. 1, p. 953.

**Sec. 4883.** (*Act of* 1870, § 21.) **[Patents, how issued and recorded.]** All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.

**Sec. 4884.** (*Act of* 1870, § 22.) **[Patents, contents and duration of.]** 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.

**Sec. 4885.** (*Act of* 1870, § 23.) **[Patent, date of.]** 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.

**Sec. 4886.** (*Act of* 1870, § 24.) **[What inventions patentable.]** Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known nor 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 prodeedings had, obtain a patent therefor.

**Sec. 4887.** (*Act of* 1870, § 25.) **[Patents for inventions previously patented abroad.]** No person shall be debarred from receiving a patent for his

invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited 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.

**Sec. 4888.** (*Act of* 1870, § 26.) [**Requisites of applications—description, specification, and claim.**] Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making. constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

**Sec 4889.** (*Act of* 1870, § 27.) [**Drawings, when requisite.**] When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

**Sec. 4890.** (*Act of* 1870, § 28.) [**Specimens of ingredients, etc.**] 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.

**Sec. 4891.** (*Act of* 1870, §29.) [**Model, when requisite.**] In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

**Sec. 4892.** (*Act of* 1870, § 30.) [**Oath of applicants, before whom made.**] The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, charge 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.

**Sec. 4893.** (*Act of* 1870, § 31.) [**Examination, and issuing patent.**] On the filing of any such application and the payment of the fees required by

law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

**Sec. 4894.** (*Act of* 1870, § 32.) **Applications, when to be completed.**] 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.

**Sec. 4895.** (*Act of* 1870, § 33.) [**Patents may issue to assignee.**] Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discover, if he is living, unless the patent was issued and the assignment made before the eighth day of July 1870, eighteen hundred and seventy.

**Sec. 4896.** (*Act of* 1870, § 34.) [**Executors or administrators, when may obtain patent.**] When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or adminstrator, 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 life-time; 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.

**Sec. 4897.** (*Act of* 1870, § 35.) [**Renewal of application; failure to pay fees in season.**] Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact.

**Sec. 4898.** (*Act of* 1870, § 36.) [**Assignments of Patents.**] Every patent or any interest therein shall be assignable in law by an instrument in writing;

and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

**Sec. 4899.** (*Act of* 1870, § 37.) **[Purchaser or user of inventions before application; rights of.]** 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.

**Sec. 4900.** (*Act of* 1870, § 38.) **[Patented articles to be marked as such.]** It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

**Sec. 4901.** (*Act of* 1870, § 39.) **[Falsely marking or labeling articles as patented, penalty for.]** 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.

**Sec. 4902.** (*Act of* 1870, § 40.) **[Caveats, who may file.]** 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 confiden-

tial archives of the office and preserved in secresy, 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 endorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

**Sec. 4903.** (*Act of* 1870, § 41.) [**Rejection of claim; applicant to be notified.**] 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.

**Sec. 4904.** (*Act of* 1870, § 42.) [**Interferences.**] Whenever an application is made for a patent which in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

**Sec. 4905.** (*Act of* 1870, § 43.) [**Affidavits and depositions, rules as to.**] 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.

**Sec. 4906.** (*Act of* 1870, §§ 44, 45.) [**Subpœnas to witnesses.**] The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall upon 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.

**Sec. 4907.** (*Act of* 1870, § 45.) [**Witness fees.**] 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.

**Sec. 4908.** (*Act of* 1870, §§ 44, 45.) [**Penalty for refusal to attend or testify.**] 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 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.

**Sec. 4909.** (*Act of* 1870, § 46.) [**Appeals from primary examiners to examiners-in-chief.**] Every applicant for a patent or for the reissue for 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.

**Sec. 4910.** (*Act of* 1870, § 47.) [**Appeals from examiners-in-chief to commissioner.**] If such party is dissatisfied with the decision of the examiners-in-chief, he may on payment of the fee prescribed, appeal to the Commissioner in person.

**Sec. 4911.** (*Act of* 1870, § 48.) [**Appeals from the commissioner to the Supreme Court, District of Columbia.**] If such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia sitting in banc.

**Sec. 4912.** (*Act of* 1870, § 49.) [**Appeal to Supreme Ct. Dist. of Columbia; notice.**] 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.

**Sec. 4913.** (*Act of* 1870, § 50.) [**Proceedings on appeal to Supreme Court.**] 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.

**Sec. 4914.** (*Act of* 1870, § 51.) [**Determination of such appeal, and its effect.**] The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the

Commissioner a certificate of its proceedings and 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.

Sec. 4915. (*Act of* 1870, § 52.) [**Patents obtainable by bill in equity.**] Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia, upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

Sec. 4916. (*Act of* 1870, § 53.) [**Re-issue of defective patents.**] Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued 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 re-issued, 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.

Sec. 4917. (*Act of* 1870, § 54.) [**Disclaimer.**] 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.

**Sec. 4918.** (*Act of* 1870, § 58.) [**Suits as to interfering patents.**] Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment

**Sec. 4919.** (*Act of* 1870, § 59.) [**Suits for infringement; damages.**] 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.

**Sec. 4920.** (*Act of* 1870, § 61.) [**Pleading and notice in actions for infringement.**] In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove, on trial, any one or more of the following special matters:

*First.* That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

*Second.* That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

*Third.* That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

*Fourth.* That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

*Fifth.* That it had been in public use or on sale in this country for more

than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

**Sec. 4921.** (*Act of* 1870, § 55.) [**Power of courts as to injunctions and damages.**] The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable;* and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

* See also Secs. 718, 719, *ante*, p. 6.

**Sec. 4922.** (*Act of* 1870, § 60.) [**Suits maintainable where specification is too broad.**] Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentees 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.

**Sec. 4923.** (*Act of* 1870, § 62.) [**Patent not void because of prior use in foreign country.**] Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof if it had not been patented or described in a printed publication.

**Sec. 4924, 4925, 4926, and 4927.** (*Act of* 1870, §§ 63, 64, 65, and 66.) These sections relate wholly to proceedings on applications for extensions; and are omitted, as extensions can now no longer be granted in any case.

**Sec. 4928.** [**Extensions.**] 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.

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## PATENTS FOR DESIGNS.

SEC. 4929. Patents for designs authorized.
4930. Models of designs.
4931. Duration of patents for designs.
SEC. 4932. Extension of patents for designs.
4933. Patents for designs subject to general rules of patent law.

**Sec. 4929.** (*Act of* 1870, § 71.) [**Designs, what patentable.**] 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 [pattern], print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication; may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

**Sec. 4930.** (*Act of* 1870, § 72.) [**Models of designs.**] The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

**Sec. 4931.** (*Act of* 1870, § 73.) [**Duration of patents for designs.**] Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

**Sec. 4932.** (*Act of* 1870, § 74.) [**Extension of patents for designs.**] Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one.

**Sec. 4933.** (*Act of* 1870, § 76.) [**Patents for designs, subject to general rules of patent law.**] All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs. [§§ 4919–4921.]

## FEES FOR PATENTS AND DESIGNS.

SEC. 4934. Rates of fees.
4935. How may be paid.
4936. Refunding of.

**Sec. 4934.** (*Act of* 1870, § 75.) **[Fees for patents, and on appeals, &c.]** 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.

**Sec. 4935.** (*Act of* 1870, § 69.) **[Mode of payment.]** Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever.

**Sec. 4936.** (*Act of* 1870, § 70.) **[Refunding.]** The treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or 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.

## REGISTRATION OF 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.
SEC. 4943. Restriction upon action 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.

## TITLE LX, REV. STAT. CHAP. 2. p. 963.

**Sec. 4937.** (*Act of* 1870, § 77. [**Trade-marks, registration of.**] 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-similies 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.

**Sec. 4938.** (*Act of* 1870, § 77.) [**Declaration required, what.**] 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.

**Sec. 4939.** (*Act of* 1870, § 79.) [**Restriction on registration of trade-marks.**] 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 distinguth 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.

**Sec. 4940.** (*Act of* 1870, § 80.) [**Trade-mark; time of, receipt of noted; copy of evidence.**] The time of the receipt of any trade-mark at the Patent Office for registration shall be noted and recorded. 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.

**Sec. 4941.** (*Act of* 1870, § 78.) [**Trade-mark; duration of protection of, and renewal.**] 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 for 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.

**Sec. 4942.** (*Act of* 1870, § 79.) [**Remedy for infringement of registered trade-mark.**] 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 [§§ 4919–4921, note].

**Sec. 4943.** (*Act of* 1870, § 84.) **[Restrictions upon actions for infringment.]** No action shall be maintained under the provisions of this chapter by any such 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.

**Sec. 4944.** (*Act of* 1870, § 82.) **[Penalty for false registration of trade-mark.]** 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.

**Sec. 4945.** (*Act of* 1870, § 83.) **Trade-marks; former rights and remedies reserved.]** 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.

**Sec. 4946.** (*Act of* 1870, § 78.) **[Trade-marks, expiration of terms for, effect of]** Nothing in this chapter shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person to any trade-mark after the expiration of the term for which such trade-mark was registered.

**Sec. 4947.** (*Act of* 1870, § 81.) **[Trade-marks, transfer of rights in.]** 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.

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## COPYRIGHTS.


SEC. 4948. Librarian of congress to have charge of copyrights.
4949. Seal: authentication by.
4950. Bond of Librarian.
4951. Annual report.
4952. What may be copyrighted.
4953. Term of copyrights.
4954. Extension of term.
4955. Assignments, and recording of.
4956. Deposit of title and copies of work.
4957. Recording copyright by librarian.
4958. Fees of Librarian.
4959. Copies of work to be sent to Librarian.
SEC. 4960. Penalty for not sending.
4961. Postmasters to give receipts.
4962. Notice of copyright, how to be made.
4963. Penalty for false notice.
4964. Damages for violating copyright of books.
4965. Damages for violating copyright of maps.
4966. Damages for violating copyright of dramatic compositions.
4967. Damages for printing or publishing manuscripts.
4968. Limitation of time of action.
4969. Defenses to action in copyright cases.

SEC. 4970. Injunctions in copyright cases.
4971. Aliens and non-residents not privileged.
4972.* Notice of copyright, how given.
SEC. 4973.* Fees of librariau.
4974.* Construction of words "Engraving," "cut," "print," &c.
4975.* Repeal of former laws.
4976.* Act, when takes effect.

## REVISED STATUTES, TITLE LX. CHAP. 3, p. 965.

**Sec. 4948.** (*Act of* 1870, § 85.) [**Librarian of congress to have charge of copyrights.**] 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.

**Sec. 4949.** (*Act of* 1870, § 85.) [**Seal, authentication by.**] 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.

**Sec. 4950.** (*Act of* 1870, § 85.) [**Librarian to give bond.**] 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 officers of the Treasury a true account of all moneys received by virtue of his office.

**Sec. 4951.** (*Act of* 1870, § 85.) [**Annual report.**] 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.

**Sec. 4952.** (*Act of* 1870, § 86.) [**What may be copyrighted.**] 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 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 translate their own works.

**Sec. 4953.** (*Act of* 1870, § 87.) [**Term of copyrights.**] Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

**Sec. 4954.** (*Act of* 1870, § 88.) [**Extension of term.**] The author, inventor, or designer, if he be still living and a citizen of the United States or resident therein, or his widow and 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.

**Sec. 4955.** (*Act of* 1870, § 89.) [**Assignments, and recording of.**] 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.

**Sec. 4956.** (*Act of* 1870, § 90.) [**Deposit of title and copies of work.**] 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 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.

**Sec. 4957.** (*Act of* 1870, § 91.) [**Recording title by Librarian.**] 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.

**Sec. 4958.** (*Act of* 1870, § 92.) [**Fees of Librarian.**] The Librarian of Congress shall receive from the persons to whom the services designated are rendered, the following fees: 1. For recording the title or description of any copyright book or other article, fifty cents. 2. For every copy under seal of such record actually given to the person claiming the copyright or his assigns, fifty cents. 3. For recording any instrument of writing for the assignment of a copyright, fifteen cents for every one hundred words. 4. 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. (a)

(a) Amended by act of 1874, § 2.

**Sec. 4959.** (*Act of* 1870, § 93.) [**Copies of work to be sent to Librarian.**] 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.

**Sec. 4960.** (*Act of* 1870, § 94.) [**Penalty for not sending.**] 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 4956 and 4959, 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.

**Sec. 4961.** (*Act of* 1870, § 96.) [**Post-masters to give receipts.**] The post-master 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.

**Sec. 4962.** (*Act of* 1870, § 97.) [**Notice of copyright, how to be made.**] 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 portion of the face, or front thereof, or on the face of the substance on which the same shall be mounted, the following words: "Entered according to act of Congress, in the year ———, by A. B., in the office of the Librarian of Congress at Washington." (a)

(a) Amended by act of 1874, § 1.

**Sec. 4963.** (*Act of* 1870, § 98.) [**Penalty for false notice.**] 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 to the person who shall sue for such penalty, and one-half to the use of the United States.

**Sec. 4964.** (*Act of* 1870, § 99.) [**Damages for violating copyright of books.**] 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.

**Sec. 4965.** (*Act of* 1870, § 100.) [**Damages for violating copyright of maps.**] 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 pro-

prietor 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.

**Sec. 4966.** (*Act of* 1870, § 101.) [**Damages for violating copyright of dramatic compositions.**] 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.

**Sec. 4967.** (*Act of* 1870, § 102.) [**Damages for printing or publishing manuscripts.**] 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.

**Sec. 4968.** (*Act of* 1870, § 104.) [**Limitation of time of action.**] 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.

**Sec. 4969.** (*Act of* 1870, § 105.) [**Defenses to action in copyright cases.**] In all actions arising under the laws respecting copyrights the defendant may plead the general issue, and give the special matter in evidence.

**Sec. 4970.** (*Act of* 1870, § 106.) [**Injunctions in copyright cases.**] 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 injunctions 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.

**Sec. 4971.** (*Act of* 1870, § 103.) [**Aliens and non-residents not privileged.**] 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.

## ACT OF JUNE 18, 1874, CHAP. 301.

### AN ACT TO AMEND THE LAW RELATING TO PATENTS, TRADE-MARKS, AND COPYRIGHTS.

**Sec. 4972.*** (*Act of* 1874, ch. 301, § 1.) [**Notice of copyright, how given.**] 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."

**Sec. 4973.*** (*Act of* 1874, ch. 301, § 2.) [**Fees of Librarian.**] 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. 4974.*** (*Act of* 1874, ch. 301, § 3.) [**Construction of words, "engraving," "cut," and "print."**] 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.

**Sec. 4975.*** (*Act of* 1874, ch. 301, § 4.) [**Repeal.**] All laws and parts of laws inconsistent with the foregoing provisions be and the same are hereby repealed.

**Sec. 4976.*** (*Act of* 1874, ch. 301, § 5.) [**Act, when to take effect.**] This act shall take effect on and after the first day of August, eighteen hundred and seventy-four.

Approved, June 18, 1874.

# INDEX.


| | SEC. | PAGE |
|---|---|---|
| Actions, under patent and copyright laws—where cognizable | 629 | 5 |
| Jurisdiction, exclusive | 711 | 6 |
| Appeal in, to supreme court | 699 | 5 |
| Administrator, when may receive patent | 4896 | 10 |
| Affidavits, in cases pending in Patent Office | 4905 | 12 |
| Rules for taking—before whom may be taken | 4905 | 12 |
| Aliens, may obtain patent | 4886 | 8 |
| When may file caveat | 4902 | 11 |
| Resident, may have copyright | 4952 | 22 |
| Non-resident, not privileged | 4971 | 25 |
| Appeal, in Patent and Copyright cases, to supreme court | 699 | 5 |
| Appeals in patent proceedings from primary examiner to board of examiners-in-chief | 4909 | 13 |
| From examiners-in-chief to commissioner of patents | 4910 | 13 |
| From commissioner of patents to supreme court of district of Columbia | 4911 | 13 |
| To supreme court of district of Columbia, notice on, and filing of reasons of appeal | 4912 | 13 |
| To supreme court of district of Columbia, proceedings in | 4913 | 13 |
| Action of supreme court of district of Columbia on appeal; effect of | 4914 | 13 |
| Assignment of patent, or interest in, how made; recording of 4895 | 4898 | 10 |
| When void, against subsequent purchaser of copyrights, how made; recording of | 4955 | 28 |
| Assignee of inventor, patent may issue to | 4895 | 10 |
| Assistant commissioner of patents, appointment of | 476 | 3 |
| Salary of | 477 | 3 |
| Caveat, who entitled to file | 4902 | 11 |
| How filed, and how long operative | 4902 | 11 |
| Action on, on interfering application | 4902 | 11 |
| When alien may file | 4902 | 11 |
| Circuit courts, jurisdiction of in patent and copyright cases | 629 | 5 |
| Jurisdiction of, exclusive | 711 | 6 |
| Power to grant temporary restraining orders | 718 | 6 |
| May grant injunctions in Patent cases | 4921 | 16 |
| May grant injunctions in copyright cases | 4970 | 25 |
| May impanel jury in Patent causes | 720 | 6 |
| Clerks in Patent Office | 440 | 2 |
| Commissioner of Patents, how appointed | 476 | 3 |
| Power of, as to nomination of officers | 476 | 3 |
| Salary of | 477 | 3 |
| Bond of | 479 | 3 |
| Right of, as to holding patents | 480 | 3 |
| General duties of | 481 | 3 |
| May make regulations as proceedings in Patent Office | 483 | 3 |
| To classify and arrange models, &c | 484 | 3 |
| Power of, as to models on rejected applications | 485 | 4 |
| Power of, as to Patent Agents guilty of gross misconduct | 487 | 4 |
| May require papers to be printed at expense of party filing | 488 | 4 |
| Authority of, to print copies of claims, laws, decisions, &c | 489 | 4 |
| To print specifications and drawings, for distribution | 490 | 4 |

| | SEC. | PAGE |
|---|---|---|
| To print specifications, &c., for sale | 491 | 4 |
| To fix price of uncertified printed copies of specications and drawings | 493 | 5 |
| To make annual reports to congress | 494 | 5 |
| To have charge of collections of exploring expetions | 495 | 5 |
| All patents to be countersigned by | 4883 | 8 |
| Applications for patents to be made to | 4888 | 9 |
| May require specimens of ingredients, when | 4890 | 9 |
| To require applicant to furnish model | 4891 | 9 |
| To cause examination of alleged new invention, &c., and issue patent | 4893 | 9 |
| Power of, as to question of abandonment of application | 4894 | 10 |
| To notify applicant of rejection of application, with reasons | 4908 | 12 |
| When to order re-examination of | 4903 | 12 |
| To notify applicant of interfering application or patent | 4904 | 12 |
| To issue patent to prior inventor, unless appeal made, &c | 4904 | 12 |
| To prescribe time for taking appeal | 4904 | 12 |
| To prescribe rules for taking affidavits, cases pending in Patent Office | 4905 | 12 |
| Appeal to, from board of examiners-in-chief | 4910 | 13 |
| Appeal from, to supreme court of district of Columbia | 4911 | 13 |
| Duty of, as to granting reissues | 4916 | 14 |
| May re-issue several patents for separate parts of invention | 4916 | 14 |
| When to allow amendments by new matter | 4916 | 14 |
| To make regulations and prescribe forms for transfer of right to use trade-mark | 4947 | 21 |
| Copyright, custody of records &c., relating to, required by | 4948 | 22 |
| General duty of Librarian of Congress as to | 4948 | 22 |
| Seal for authenticating records, &c., relating to | 4949 | 22 |
| Librarian, to give bond | 4950 | 22 |
| Annual report of Librarian of Congress as to | 4951 | 22 |
| Who may have bond, and for what | 4952 | 22 |
| Rights secured by; rights as to dramatic compositions | 4952 | 22 |
| Term of | 4953 | 22 |
| Extension of the term of | 4954 | 22 |
| Assignment of; and recording deposit of title and copies of work | 4956 | 23 |
| Record of title of work; attested copy of same | 4957 | 23 |
| Fees for recording title, assignments, and for copies | 4958 | 23 |
| Fees for recording title, assignments, and for copies | 4973 | 26 |
| Copies of work, to be delivered to Librarian of Congress | 4959 | 23 |
| Penalty for failure to deliver | 4960 | 24 |
| Receipt of postmaster for title or copy mailed | 4961 | 24 |
| Notice of copyright to be inserted in book; penalty on default | 4962 | 24 |
| Penalty on default | 4972 | 26 |
| Penalty for falsely inserting notice of copyright | 4963 | 24 |
| Penalty for infringing copyright of book | 4964 | 24 |
| Penalty for infringing copyright of map | 4965 | 24 |
| Damages for infringing copyright of dramatic composition | 4966 | 25 |
| Damages for printing or publishing manuscript | 4967 | 25 |
| Limitation of action for infringement of copyright | 4968 | 25 |
| Defenses to action for infringement of copyright | 4969 | 25 |
| Injunctions to restrain violations | 4970 | 25 |
| Provisions not applicable to aliens and non-residents | 4971 | 25 |
| Meaning of words "engraving," "cut," "print." | 4974 | 26 |
| "Cut," meaning of, under copyright laws | 4974 | 26 |
| Damages, not recoverable for use; article purchased of inventor, or made with his consent, before application for patent | 4899 | 11 |
| When not recoverable by patentee failing to mark or label patented article | 4900 | 11 |
| For infringement of patent, and when may be increased | 4919 | 15 |

| | SEC. | PAGE |
|---|---|---|
| Assessment of, by the court, in suit in equity | 4921 | 16 |
| Infringement of trade-mark | 4942 | 20 |
| Injuries suffered by reason of false registry of trade-mark | 4942 | 20 |
| For violation of copyright of book | 4964 | 24 |
| For violating copyright of maps, &c | 4965 | 24 |
| For violating copyright of dramatic composition | 4966 | 25 |
| For printing any manuscript without consent of the author | 4967 | 25 |
| Department of Interior, patent office attached to | 475 | 2 |
| Disbursements for patent office, made by | 496 | 5 |
| Depositions, commissioner of patents may prescribe rules for taking | 4905 | 12 |
| Before whom may be taken | 4905 | 12 |
| Designs, new and original, patentable | 4929 | 17 |
| Models of, when may be dispensed with | 4930 | 17 |
| Term of patent for | 4931 | 17 |
| Extension of patents issued for | 4932 | 17 |
| Patents for, governed by rules as to patents for inventions | 4933 | 17 |
| Disclaimer, when patentee and assigns may make | 4917 | 14 |
| How to be made, effect of in patent | 4917 | 14 |
| Effect of in pending suits | 4917 | 14 |
| If not made before bringing suit, costs not recoverable | 4922 | 16 |
| Drawings of invention to be annexed to patent | 4884 | 8 |
| To be furnished by applicant; how signed and attested | 4889 | 9 |
| Copy attached to patent, to be furnished by patent office | 4889 | 9 |
| Drawing of design may dispense with model thereof | 4930 | 17 |
| "Engraving," what word applies to | 4974 | 26 |
| Equity, suits in, cognizable by circuit courts | 629 | 5 |
| Jurisdiction exclusive | 711 | 6 |
| Suit in, to obtain issue of patent on rejection of claim, &c. | 4915 | 14 |
| In case of interfering patents | 4918 | 15 |
| Defenses, pleadable in suits in | 4920 | 15 |
| Recoveries in, extent of damages | 4921 | 16 |
| Damages, may be increased | 4921 | 16 |
| Remedy in, for infringement of trade-mark | 4942 | 20 |
| Remedy in, for violations of copyrights | 4970 | 25 |
| Examiners, principal, how many | 440 | 2 |
| Principal, how appointed | 476 | 3 |
| Appeal from, to board of examiners-in-chief | 4909 | 13 |
| Examiners-in-chief, appointment of | 476 | 3 |
| Salary of | 477 | 3 |
| Duties of | 482 | 3 |
| Appeals from, to commissioner of Patents | 4910 | 13 |
| Executions, may take patent, when | 4896 | 10 |
| Extension of patents, to whom benefit extends | 4928 | 17 |
| Fees, patent fees, rates of | 4934 | 18 |
| For registrating trade-mark | 4937 | 19 |
| Of librarian in copyright cases | 4958 | 23 |
| Of librarian in copyright cases | 4973 | 26 |
| How payable | 4935 | 18 |
| Refunding of | 4936 | 18 |
| General issue, and notice with in actions for infringement of patents | 4920 | 15 |
| In actions arising under copyright laws | 4969 | 25 |
| Infringement of patent, damages not recoverable, if patentee fails to mark patened article, except when | 4900 | 11 |
| Action, for what sum judgment may be rendered | 4919 | 15 |
| Pleading and proof in action for | 4920 | 15 |
| Injunction to prevent | 4921 | 16 |
| Recovery for, when specification too broad | 4922 | 16 |
| Infringement of trade-mark, remedies for | 4942 | 20 |
| No remedy for, of trade-mark used for unlawful purposes, or obtained by fraud | 4943 | 21 |
| Infringement of copyright, no action maintainable unless notice of copyright given | 4962 | 24 |
| Of copyrights of books, forfeiture and damages | 4964 | 24 |
| Of copyrights of maps, &c., damages for | 4965 | 24 |
| Of copyright of dramatic composition, damages for | 4966 | 25 |
| Limitation of time for action, for | 4968 | 25 |

| | SEC. | PAGE |
|---|---|---|
| Pleading and evidence in actions for | 4969 | 25 |
| Power of circuit courts to enjoin | 4970 | 25 |
| Injunctions, Temporary, restraining orders, when grantable | 718 | 6 |
| By whom may be granted | 719 | 6 |
| When may be issued by a district judge | 719 | 6 |
| Issued by district judge, when expires | 719 | 6 |
| In cases of infringement of patents for inventions | 4921 | 16 |
| In cases of infringement of designs | 4933 | 17 |
| In cases of wrongful use of trade-mark | 4942 | 20 |
| In cases of violation of copyrights | 4970 | 25 |
| Interference, notice of, to applicant | 4904 | 12 |
| Priority, how determined | 4904 | 12 |
| Appeal in cases of, to board of examiners | 4909 | 13 |
| From board of examiners to commissioner | 4910 | 13 |
| No appeal from commissioner to supreme court district of Columbia | 4911 | 13 |
| Suit in equity to adjust in case of interfering patents | 4918 | 15 |
| Inventions, short description of, to be contained in patent | 4884 | 8 |
| What patentable | 4886 | 8 |
| Examination as to, to be made on application for patent | 4893 | 9 |
| Priority of invention, in cases of interference, how determined | 4904 | 12 |
| Disclaimer of, formalities and effect of | 4917 | 14 |
| Incorrectly claimed, when suits maintainable | 4922 | 16 |
| When patent not void on account of prior invention in foreign country, when will not vitiate patent | 4923 | 16 |
| Inventions of designs, what patentable | 4929 | 17 |
| Labels, when may be registered in patent office | 4974 | 26 |
| Librarian of Congress—charge of records, &c., relating to copyrights | 4948 | 22 |
| Seal of office of, for what to be used | 4949 | 22 |
| Bond of | 4950 | 22 |
| Annual report of | 4951 | 22 |
| Assignments of copyrights to be recorded in office of | 4955 | 23 |
| Deposit with of printed copy of title of book, before publication | 4956 | 23 |
| To record name of copyright article | 4957 | 23 |
| Fees to be paid to, in respect of copyrights | 4958 | 23 |
| Fees to be paid to in respect of copyrights | 4973 | 26 |
| Copies of copyright articles to be delivered to | 4959 | 23 |
| Penalty for not delivering copies of copyright article to | 4960 | 24 |
| Limitations—of time for bringing action under copyright laws | 4968 | 25 |
| Lithographing—for specifications and drawings, how done | 492 | 4 |
| Models—to be classified and arranged | 484 | 3 |
| In cases of rejected application how disposed of. | 485 | 4 |
| Model of invention to be furnished by applicant. | 4891 | 9 |
| Oath, of applicant for patent. | 4892 | 9 |
| Before whom may be taken | 4892 | 9 |
| Patent agents, when commissioner of patents may refuse to recognize | 487 | 4 |
| Patented articles—how to be marked, &c | 4900 | 11 |
| Penalty for marking unpatented article as patented | 4901 | 11 |
| Patent office, establishment of | 475 | 2 |
| A part of the department of interior | 475 | 2 |
| Clerks and employees in | 440 | 2 |
| Appointment of commissioner assistant commissioner, and three examiners-in-chief in | 476 | 3 |
| Appointment of other officers, clerks, &c., in | 476 | 3 |
| Salaries of commissioner, assistant commissioner, and three commissioners-in-chief | 477 | 3 |
| Seal of | 478 | 3 |
| Bond of commissioners and chief clerk | 479 | 3 |
| Officers, &c., not to have interest in patents | 480 | 3 |
| General duties of commissioner | 481 | 3 |
| Qualifications and duties of examiners-in-chief | 482 | 3 |
| Regulations by whom prescribed | 483 | 3 |
| Classification, arrangement, &c., of models, &c., in | 484 | 3 |
| Library of | 486 | 4 |
| Exclusion from, of patent agents | 487 | 4 |

| | SEC. | PAGE |
|---|---|---|
| Commissioner to print copies of claims, decisions, &c | 489 | 4 |
| Commissioner to print specifications and drawings for distribution | 490 | 4 |
| For sale | 491 | 4 |
| Lithographing and engraving of specifications and drawings | 492 | 4 |
| Price of uncertified copies of specifications and drawings | 493 | 5 |
| Annual report of commissioners | 494 | 5 |
| Custody of collections of exploring expedition to be under commissioner | 495 | 5 |
| Disbursements for, by whom to be made | 496 | 5 |
| All patents to be issued under seal of, and recorded in | 4883 | 8 |
| Drawings of inventions to be filed therein | 4889 | 9 |
| Of assignments, &c., of patents to be recorded in | 4898 | 10 |
| Decisions of supreme Court of District of Columbia, to be recorded in | 4914 | 13 |
| Disclaimer to be recorded in | 4917 | 14 |
| Trade-marks to be registered in | 4937 | 19 |
| Patents, how issued, attested, and recorded | 4883 | 8 |
| And duration of | 4884 | 8 |
| Date of | 4885 | 8 |
| For what inventions and discoveries granted | 4886 | 8 |
| Right to, not barred by previously obtaining foreign patent, unless, &c | 4887 | 8 |
| Term of, to expire at same time with previously obtained foreign patent, not exceeding, &c | 4887 | 9 |
| Application for, what to contain | 4888 | 9 |
| Copy of drawings to be attached to patent as part thereof | 4889 | 9 |
| To be granted upon examination | 4893 | 9 |
| Time of completing and preparing application for | 4894 | 10 |
| May be issued or re-issued to assignee | 4895 | 10 |
| May be issued to executor or administrator | 4896 | 10 |
| Renewal of application for in case of failure to pay fee | 4897 | 10 |
| Abandonment a question of fact on renewed application for | 4897 | 10 |
| Assignment of to be recorded | 4898 | 10 |
| Purchaser a user of invention, before application for patent, rights of | 4899 | 11 |
| Rejection of claim for, notice of; re-examination of | 4903 | 12 |
| Interference, on application for | 4904 | 12 |
| Patent to issue to prior inventor | 4904 | 12 |
| When may issue, by decree of court | 4915 | 14 |
| Re-issue of defective patents | 4916 | 14 |
| Interfering patents, how may be declared void, in whole or in part | 4918 | 15 |
| Infringement of, damages for | 4919 | 15 |
| Violation of injunctions to prevent | 4921 | 16 |
| How far valid, when claim is too broad | 4922 | 16 |
| Not void, because of preknowledge or use in foreign country | 4923 | 16 |
| Extension of, to whom enures | 4928 | 17 |
| For new and original designs, &c | 4929 | 17 |
| For designs, term of | 4931 | 17 |
| For designs, extension of | 4932 | 17 |
| For designs, subject to provisions as to patents for inventions | 4933 | 17 |
| "Print," what is, under copyright laws | 4974 | 26 |
| When may be registered by patent office | 4974 | 26 |
| Re-issue of patents, may be granted to assignee | 4895 | 10 |
| Application to be signed by inventor | 4895 | 10 |
| Appeal on application for re-issue to board of examiners | 4909 | 13 |
| Appeal to commissioner in person | 4910 | 13 |
| Appeal to supreme court of District of Columbia | 4911 | 13 |
| When, and to whom allowed | 4916 | 14 |
| May be granted for separate parts of thing patented | 4916 | 14 |
| New matter, when not allowable | 4916 | 14 |
| New matter, when allowable | 4916 | 14 |
| Secretary of the Interior, to | | |

| | SEC. | PAGE |
|---|---|---|
| appoint clerks in patent office on | 476 | 3 |
| To approve rules of Patent office | 483 | 3 |
| Control over disbursements of patent office | 496 | 5 |
| To sign letters patent | 4883 | 8 |
| Specifications, to be recorded with patent in patent office | 4883 | 8 |
| Copy of, to be annexed to patent | 4884 | 8 |
| What to set forth | 4888 | 9 |
| To be signed by inventor, and by two witnesses | 4888 | 9 |
| By whom sworn to on application by assignee | 4895 | 10 |
| On application for re-issue, who to sign | 4895 | 10 |
| In cases of re-issue | 4916 | 14 |
| Specifiations and drawings, printing of, for distribution | 490 | 4 |
| Printing of, for sale | 491 | 4 |
| A copy to be annexed to patent | 4884 | 8 |
| Supreme court of the District of Columbia, appeal to, from decision of Commissioner | 4911 | 13 |
| Notice of, how and to whom given | 4912 | 13 |
| Proceedings on appeal | 4913 | 13 |
| Determination of appeal, and effect of | 4914 | 13 |
| Surrender of Patent, when may be made for re-issue | 4916 | 14 |
| Several re-issues may be granted | 4916 | 14 |
| Trade-marks, protection for, who may have | 4937 | 19 |
| Declaration, what to set forth | 4938 | 19 |
| Declaration, to be verified | 4939 | 19 |
| What can not be registered as | 4939 | 20 |
| Time of receipt, for registration to be recorded | 4940 | 20 |
| Certified copies of, and of declaration to be evidence | 4940 | 20 |
| Term of protection of; rights secnred by, renewal of | 4941 | 20 |
| Remedy for infringement of; damages | 4942 | 20 |
| Wrongful use of, may be enjoined | 4942 | 20 |
| When actions not maintainable for alleged infringement of | 4943 | 21 |
| Penalty for false or fraudulent registration | 4944 | 21 |
| Former remedies at law or in equity, preserved | 4945 | 21 |
| Claim to, not affected by expiration of term of registration | 4946 | 21 |
| Rules and forms of transfer of right to use | 4947 | 21 |
| Witnesses, in cases pending in patent office; may be subpœnaed, and by whom | 4906 | 12 |
| Fees of | 4907 | 12 |
| Attendance of, how compelled | 4908 | 13 |
| When not in contempt for disobeying subpœna | 4908 | 13 |
| What can not be compelled to disclose | 4908 | 13 |

# STATUTE LAWS

OF THE

# UNITED STATES OF AMERICA

RELATING TO

# COPYRIGHT

AND

# PATENTS FOR INVENTIONS

FROM

1790 TO 1874

NOT NOW IN FORCE

WITH

NOTES AND REFERENCES

# EXPIRED

# ACTS OF CONGRESS

IN RESPECT TO

# COPYRIGHTS.

## 1790 TO 1874.

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THE acts of Congress in respect to Copyrights, passed previous to 1819, are now obsolete, having been repealed by the act of 1831; but they are inserted in full for the purposes of reference and comparison, when desired, with the acts in force.

The notes of decisions inserted under the obsolete acts, are such as explain their construction, or have special reference to them. Decisions of a general nature, though made under such acts, are inserted under the acts now in force, as assisting to a proper understanding and interpretation of them.

It has not been intended to insert under the several acts, all the decisions explanatory of them, but only those of a mere general character, adding suitable references to appropriate titles of the DIGEST; nor has any special care been taken to arrange such notes in chronological order.

## ACT OF 1790, CHAPTER 15.

### (1 STAT. AT LARGE, 124.)

**An Act for the Encouragement of Learning, by securing the Copies of Maps, Charts, and Books, to the Authors and Proprietors of such Copies, during the Times therein mentioned:**

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States, being a citizen or citizens thereof or resident within the same, his or their executors, administrators or assigns, who hath or have not transferred to any other person the copyright (*a*) of such map, chart, book or books, share or shares thereof; and any other person or persons, being a citizen or citizens of these United States, or residents therein, his or their executors, administrators or assigns, who hath or have purchased or legally acquired the copyright (*a*) of any such map, chart, book or books, in order to

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(*a*) The "copyright" recognized by this act, and which is intended to be protected, is presumed to be the right of property which an author has at common law, in his manuscript. Such protection is given as well to books published, as to manuscript copies. *Wheaton* v. *Peters*, 8 Pet., 661.—MCLEAN, J.; Sup. Ct., 1834.

print, reprint, publish, or vend the same, shall have the sole right and liberty of printing, reprinting, publishing, and vending such map, chart, book or books, for the term of fourteen years from the recording the title thereof in the clerk's office, as is hereinafter directed: And that the author and authors of any map, chart, book or books already made and composed, and not printed or published, or that shall hereafter be made and composed, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. (*b*) And if, at the expiration of the said term, the author or authors or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years: *Provided,* he or they shall cause the title thereof to be a second time recorded and published in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years aforesaid.

SECTION 2. *And be it further enacted,* That if any other person or persons, from and after the recording the title of any map, chart, book or books, and publishing the same as aforesaid, and within the times limited and granted by this act, shall print, reprint, publish, or import, or cause to be printed, reprinted, published, or imported from any foreign kingdom or state, any copy or copies of such map, chart, book or books, without the consent of the author or proprietor thereof, first had and obtained in writing, signed in the presence of two or more credible witnesses; or knowing the same to be so printed, reprinted, or imported, shall publish, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such map, chart, book or books, without such consent first had and obtained in writing as aforesaid, then such offender or offenders shall forfeit all and every copy and copies of such map, chart, book or books, and all and every sheet and sheets, being part of the same, or either of them, to the author or proprietor of such map, chart, book or books, who shall forthwith destroy the same: And every such offender and offenders shall also forfeit and pay the sum of fifty cents for every sheet which shall be found in his or their possession, either printed or printing, published, imported, or exposed to sale, contrary to the true intent and meaning of this act, the one moiety thereof to the author or proprietor of such map, chart, book or books, who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, wherein the same is cognizable. *Provided always,* That such action be commenced within one year after the cause of action shall arise, and not afterward.

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(*b*) Congress in passing the act of 1790, did not legislate in reference to existing rights. Instead of sanctioning an existing right, it created it. *Ibid.*, 661.

ACT OF 1790, CHAP. 15, §§ 3, 4.

SECTION 3. *And be it further enacted*, That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside: (*a*) And the clerk of such court is hereby directed and required to record the same forthwith, in a book to be kept by him for that purpose, in the words following (giving a copy thereof to the said author or proprietor, under the seal of the court, if he shall require the same). "District of to wit: *Be it remembered*, That on the day of in the year of the independence of the United States of America, A. B. of the said district, hath deposited in this office the title of a map, chart, book or books (as the case may be), the right whereof he claims as author or proprietor (as the case may be), in the words following, to wit: [here insert the title] in conformity to the act of the Congress of the United States, intituled, 'An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.' C. D., clerk of the district of ." For which the said clerk shall be entitled to receive sixty cents from the said author or proprietor, and sixty cents for every copy under seal actually given to such author or proprietor as aforesaid. And such author or proprietor shall, within two months from the date thereof, cause a copy of the said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks. (*b*)

SECTION 4. *And be it further enacted*, That the author or proprietor of any such map, chart, book or books, shall, within six months after the publishing

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(*a*) Under this section, a proprietor can acquire no title to a copyright for the term of the first fourteen years, unless he shall deposit in the clerk's office a printed copy of the title of the book. *Ewer* v. *Coxe*, 4 Wash., 490. WASHINGTON, J.; Pa., 1824.

If the title of an author depended upon the act of 1799, it would be complete, provided he had deposited a printed copy of the title of the book in the clerk's office, as directed by this section. *Ibid.*, 490.

(*b*) The provision of this section requiring the author to publish the title of his book, in a newspaper, is merely directory, and constitutes no part of the essential requisites for securing the copyright. *Nichols* v. *Ruggles*, 3 Day, 158. CURIAM; Ct.. 1808.

The publication in the newspaper, is intended as legal notice of the rights secured to the author; but is not necessary where actual notice is brought home to the party. *Ibid.*, 158.

The condition upon which the proprietor is to be entitled to the benefit of the act, cannot be extended to the requisition contained in the last sentence of that section, to publish a copy of the record of the title, as prescribed therein. *Ewer* v. *Coxe*, 4 Wash., 490;—WASHINGTON, J.; Pa., 1824.

The publication of a copy of such notice is only necessary to enable him to sue for the forfeitures created by that section. *Ibid.*, 490.

thereof, deliver, or cause to be delivered to the Secretary of State a copy of the same, to be preserved in his office. (*a*)

SECTION 5. *And be it further enacted*, That nothing in this act shall be construed to extend to prohibit the importation or vending, reprinting or publishing within the United States, of any map, chart, book or books, written, printed, or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States.

SECTION 6. *And be it further enacted*, That any person or persons who shall print or publish any manuscript, without the consent and approbation of the author or proprietor thereof, first had and obtained as aforesaid (if such author or proprietor be a citizen of, or resident of these United States), shall be liable to suffer and pay to the said author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof.

SECTION 7. *And be it further enacted*, That if any person or persons shall be sued or prosecuted for any matter, act or thing done under or by virtue of this act, he or they may plead the general issue, and give the special matter in evidence.

Approved May 31st, 1790.

Repealed by act of 1831, § 14.

## ACT OF 1802, CHAPTER 36.

(2 STAT. AT LARGE, 171.)

An Act supplementary to an act, intituled "An act for the encouragement of learning, by securing the copies of maps, charts, and books to the authors and proprietors of such copies during the time therein mentioned," and extending the benefits thereof to the arts of designing, engraving, and etching historical and other prints.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the*

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(*a*) The requirements of this section, as to delivering a copy of the book to the Secretary of State is merely directory, and constitutes no part of the essential requisites for securing a copyright. The copy to be delivered to the Secretary of State appears to be designed for public purposes, and has no connection with the copyright. *Nicholls* v. *Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

Under this section a copy of a book may be deposited with the department of state after the expiration of six months from the time of its publication, if not done before, and will avail from the time of its being deposited. *Daboll's Case*, 1 Opin., 532.—WIRT, Atty. Gen.; 1822.

Where a work consisted of a number of volumes, the delivery to the Secretary of State of the first volume of the work within six months after its publication, and of the rest of the volumes, before the offence complained of is committed, or the action brought, is a sufficient compliance with the law. *Dwight* v. *Appletons*, 1 N. Y. Leg. Obs., 199.—THOMPSON, J.; N. Y., 1843.

ACT OF 1802, CHAP. 36, § 2.

*United States of America in Congress assembled*, That every person who shall, from and after the first day of January next, claim to be the author or proprietor of any maps, charts, book or books, and shall thereafter seek to obtain a copyright of the same agreeable to the rules prescribed by law, before he shall be entitled to the benefit of the act, intituled "An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the time therein mentioned," he shall, in addition (*a*) to the requisites enjoined in the third and fourth sections of said act, if a book or books, give information by causing the copy of the record, which, by said act he is required to publish in one or more of the newspapers, to be inserted at full length in the title-page, or in the page immediately following the title of every such book or books; and if a map or chart shall cause the following words to be impressed on the face thereof, viz.: "*Entered according to act of Congress, the day of* 18 [here insert the date when the same was deposited in the office] *by A. B. of the state of* [here insert the author's or proprietor's name and the state in which he resides].

SECTION 2. *And be it further enacted*, That from and after the first day of January next, every person, being a citizen of the United States or resident within the same, who shall invent and design, engrave, etch or work, or from his own works and inventions, shall cause to be designed and engraved, etched or worked, (*b*) any historical or other print or prints, shall have the sole right

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(*a*) By this section no person can be entitled to the benefit of the act of 1790, unless he shall, *in addition* to the requisites enjoined in §§ 3 and 4 of that act, cause a copy of the record required by that act to be published, to be inserted at full length in the title-page, or on the page immediately following the title of the book. *Ewer* v. *Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

The person, therefore, claiming a copyright, before he can be entitled to the benefits of the act of 1790, must perform the requisites required by this act, *in addition* to those prescribed in §§ 3 and 4 of the act of 1790, and must perform the whole. The act admits of no other construction. *Ibid.*, 491.

The meaning of the act is as if it read, "the proprietor, before he shall be entitled to the benefit of the act of 1790, shall cause a copy of the record of the title to be published, and shall deliver a copy of the book to the Secretary of State, as directed by the third and fourth sections of that act; and shall also cause a copy of the said record to be inserted at full length in the title-page, &c." *Ibid.*, 491.

The act of 1802 requires the requisites enjoined in §§ 3 and 4 of the act of 1790, as to notice and the deposit of the book in the state department, to be performed "in addition" to the one required by this act of 1802, before an author "shall be entitled to the benefit of the first act." *Wheaton* v. *Peters*, 8 Pet., 665.—MCLEAN, J.; Sup. Ct., 1834.

(*b*) The person who under this section, is intended and described as the proprietor of a copyright in a print, is one who shall not only invent *and* design, but who shall also engrave, etch, or work the print to which the right is claimed; or, who, *from his own works and inventions*, shall cause the print to be designed and engraved, etched, or worked. *Binns* v. *Woodruff*, 4 Wash, 51.—WASHINGTON, J.; Pa., 1821.

In the first case, the inventor and designer is identified with the engraver, or in other words, the entire work, or subject of the copyright, is executed by the same person. In the latter, the invention is designed or embodied by the person in

and liberty of printing, reprinting, publishing and vending such print or prints, for the term of fourteen years from the recording the title thereof in the clerk's office, as prescribed by law for maps, charts, book or books: *Provided*, he shall perform all the requisites in relation to such print or prints, as are directed in relation to maps, charts, book or books, in the third and fourth sections of the act to which this is a supplement, and shall moreover cause the same entry to be duly engraved on such plate, with the name of the proprietor, and printed on every such print or prints as is hereinbefore required to be made on maps or charts.

SECTION 3. *And be it further enacted*, That if any printseller or other person whatsoever, from and after the said first day of January next, within the time limited by this act, shall engrave, etch or work, as aforesaid, or in any other manner copy or sell, or cause to be engraved, etched, copied or sold, in the whole or in part, by varying, adding to, or diminishing from the main design, or shall print, reprint, or import for sale, or cause to be printed, reprinted, or imported for sale, any such print or prints, or any parts thereof, without the consent of the proprietor or proprietors thereof, first had and obtained, in writing, signed by him or them respectively, in the presence of two or more credible witnesses; or knowing the same to be so printed or reprinted, without the consent of the proprietor or proprietors, shall publish, sell, or expose to sale or otherwise, or in any other manner dispose of any such print or prints, without such consent first had and obtained, as aforesaid, then such offender or offenders shall forfeit the plate or plates on which such print or prints are or shall be copied, and all and every sheet or sheets (being part of or whereon such print or prints are or shall be copied or printed) to the proprietor or proprietors of such original print or prints, who shall forthwith destroy the same; and further, that every such offender or offenders shall forfeit one dollar for every print which shall be found in his, her, or their custody; either printed, published, or exposed to sale, or otherwise disposed of, contrary to the true intent and meaning of this act, the one moiety thereof to any person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered in any court having competent jurisdiction thereof. . . . . .

SECTION 4. *And be it further enacted*, That if any person or persons from and after the passing of this act, shall print or publish any map, chart, book or books, print or prints, who have not legally acquired the copyright of such map

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whom the right is vested, and the form and completion of the work are executed by another. *Ibid.*, 51.

But in neither case can a person claim a copyright for a mere invention, the work of his imagination locked up in his own mind, or existing in a form not visible to others. Neither is he so entitled, unless he has not only invented, but also designed or represented the subject in some visible form. *Ibid.*, 51.

Where neither the design nor the general arrangement of a print, nor the parts which composed it, was the invention of the plaintiff, but he had employed and paid the artists who had composed and executed it, *Held*, that under this section he was not entitled to a copyright. *Ibid.*, 53.

chart, book or books, print or prints, and shall, contrary to the true intent and meaning of this act, insert therein or impress thereon that the same has been entered according to act of Congress, or words purporting the same, or purporting that the copyright thereof has been acquired; every person so offending shall forfeit and pay the sum of one hundred dollars, one moiety thereof to the person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, having cognizance thereof. *Provided always*, that in every case for forfeitures hereinbefore given, the action be commenced within two years from the time the cause of action may have arisen.

Approved April 29th, 1802.

Repealed by act of 1831, § 14.

## ACT OF 1819, CHAPTER 19.

(3 STAT. AT LARGE, 481.)

An act to extend the jurisdiction of the Circuit Courts of the United States to cases arising under the law relating to patents [and copyrights].

*Be it enacted, by the Senate and House of Representatives of the United States of America, in Congress assembled*, That the Circuit Courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable; (*a*) *Provided, however*, That from all judgments and

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(*a*) Where a wrong has been committed in respect to a literary work, but the bill does not ask for an injunction to protect the common law rights of the author, or the violation of any copyright secured, but only asks an account, redress cannot be sought in a court of equity, but the party must proceed at law for damages. *Monk* v. *Harper*, 3 Edw. Ch., 110, 111.—McCOWN, V. Chan.; N. Y., 1837.

Under the acts of 1790 and 1819, as to patents and copyrights, the owners of copyrights and patents do not have redress or relief in any cases where they could not before have had relief in some court, either of equity or law. *Pierpont* v. *Fowle*, 2 Wood. & Min., 27.—WOODBURY, J.; Mass., 1846.

These acts merely enable them to prosecute such claims in the Circuit Court of the United States, as they usually had done before, but without going to the state tribunals; the public interest required a uniform construction to be placed by one tribunal on all important questions connected with rights so held. *Ibid.*, 27.

The act of 1819, so far as it gave cognizance to the courts of the United States in cases of copyrights, still remains in force, and is the only law conferring equitable

decrees of any Circuit Courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decress of such Circuit Courts. (*b*)

Approved, February 15th, 1819.

## ACT OF 1831, CHAPTER 16.

### (4 STAT. AT LARGE, 436.)

An Act to amend the several acts respecting copyrights. (*a*)

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from and after the passing of this act, any person or persons, being a citizen or citizens of the United

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jurisdiction on these courts in such cases: the 9th section of the act of 1831, protects manuscripts only. *Stephens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

The equity jurisdiction of such courts, as to copyrights, does not extend to the adjudication of forfeitures: a decree, therefore, cannot be entered for the penalties incurred for a violation of a copyright. *Ibid.*, 455.

The jurisdiction of the federal courts under the acts of Congress respecting copyrights, has not taken away or diminished the original jurisdiction, which, before such acts, the state courts exercised—except where the jurisdiction was made exclusive in express terms, or by the necessary construction of the federal constitution. *Woolsey* v. *Judd*, 4 Duer, 382.—DUER, J.; N. Y., 1855.

Under the act of Congress, giving to the Circuit Courts cognizance of cases arising under the laws of the United States, granting to authors the exclusive right to their writings, the citizenship of the parties litigant is immaterial. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44, 45.—CADWALLADER, J.; Pa., 1860.

The act of 1819 concerns remedies, and not rights. *Ibid.*, 45.

See also DIGEST, titles ACTIONS, A; EQUITY, A.

(*b*) A writ of error, or appeal, as the case may require, now lies to the Supreme Court, from all judgments or decrees of any Circuit Court, rendered in any action, at law or in equity, arising under any of the laws as to copyrights. Act of 1861, chap. 37.

### (*a*) OBJECT OF THE COPYRIGHT LAWS, AND FOUNDATION OF COPYRIGHT.

Copyright, though formerly considered to be founded on common law, can now only be viewed as part of the statute law. *Clayton* v. *Stone*, 2 Paine, 383.—THOMPSON, J.; N. Y., 1828.

The object of the acts of Congress securing to authors the exclusive right to their writings, was the promotion of science. *Ibid.*, 392.

The term science cannot be applied to a work of so fluctuating and fugitive a character as a newspaper or price current. Such a publication is not a book, the copyright of which can be secured under the acts of Congress. *Ibid.*, 392, 393.

In the United States an author can have no exclusive property or copyright in his published production except under the laws of Congress. *Ibid.*, 662.

The author of a literary composition has, at common law, no exclusive right to print and publish it. *Dudley* v. *Mayhew*, 3 Coms., 12.—STRONG, J.; N. Y., 1849.

See also DIGEST, title COPYRIGHT, A.

States, or resident therein, who shall be the author or authors (*b*) of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving (*c*), and the executors, administrators, or legal assigns of such person or persons, shall have the sole right

(*b*) WHO MAY HAVE COPYRIGHT.

Under this act a person, to be a "resident" so as to be entitled to a copyright, must be a permanent resident of the country. A person temporarily residing here, even though he has declared his intention of becoming a citizen, cannot take or hold a copyright. *Carey* v. *Collier*, 56 Niles' Reg., 262.—BETTS, J.; N. Y., 1839.

The author or compiler of a musical composition, made up of different parts copied from older compositions, without material change, and put together into one tune with only slight alterations or additions, is not entitled to a copyright for such therefor. *Reed* v. *Carusi*, 8 Law Rep., 411.—TANEY, Ch. J.; Md., 1845.

To constitute one an author, he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself. *Atwill* v. *Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

One who gets others to compile a work or engrave a print is not entitled to a copyright. *Pierpont* v. *Fowle*, 2 Wood. & Min., 46.—WOODBURY, J.; Mass., 1846. *Atwill* v. *Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846. *DeWitt* v. *Brooks*, MS.—NELSON, J.; N. Y., 1861.

The legal assignee of the author may take out the copyright, and it will make no difference whether he holds it as trustee for the benefit of another or not. *Little* v. *Gould*, 2 Blatchf., 366.—NELSON, J.; N. Y., 1852.

Under this act no person can obtain a copyright except authors who are citizens or residents of the United States, and proprietors under derivations of title from such authors. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860

The assignee of a work composed by a *non-resident alien* cannot obtain a copyright for it. *Ibid.*, 45.

See also DIGEST, titles AUTHOR; COPYRIGHT, C.

(*c*.) WHAT SUBJECT OF COPYRIGHT.

The phrase *design*, when used as a term of art, means the giving of a visible form to the conceptions of the mind; or, in other words, to the invention. *Binns* v. *Woodruff*, 4 Wash., 52.—WASHINGTON, J., Pa., 1821.

A newspaper, or price current, is not such a publication as falls under the protection of the copyright laws. *Clayton* v. *Stone*, 2 Paine, 392.—THOMPSON, J.; N. Y., 1828.

A work may be the subject of a copyright, if the plan, arrangement, and combination of its materials are new, though the materials may be drawn from many sources, but are, for the first time brought together in such plan, arrangement and combination. *Gray* v. *Russell*, 1 Story, 17.—STORY, J.; Mass. 1839.

Any new and original plan, arrangement or combination of materials, will entitle the author to a copyright, even though the materials are not new. *Emerson* v. *Davies*, 3 Story, 778.—STORY, J., Mass., 1845.

There can be no copyright of a plan distinct from the work itself, any more than there can be of an idea. The words in which an idea is expressed, are a subject of property; and so is the classification of the subject discussed. *Story's Exrs.* v. *Holcombe*, 4 McLean, 316.—MCLEAN, J., Ohio, 1847.

A person cannot have an exclusive right, or copyright in a label, as it is not a

and liberty of printing, reprinting, publishing, and vending (*d*) such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

SECTION 2. *And be it further enacted*, That if, at the expiration of the aforesaid term of years, such author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more than one per-

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book, within the provisions of the statute. *Coffeen* v. *Brunton*, 4 McLean, 517.—McLEAN, J.; Ind., 1849.

A reporter cannot have any copyright in the written opinions of the judges of a court; nor can the judges confer any such right on the reporter. *Wheaton* v. *Peters*, 8 Pet., 668.—McLEAN, J.; Sup. Ct., 1834. *Little* v. *Gould*, 2 Blatchf., 170.—CONKLING, J.; N. Y., 1851.

Such decisions are the property of the public, and are not the subject of copyright. *Little* v. *Gould*, 2 Blatchf., 362.—NELSON, J.; N. Y., 1852.

But a reporter may have a copyright in his own marginal notes, and in the arguments of counsel, as arranged and prepared by him. *Gray* v. *Russell*, 1 Story, 21.—STORY, J.; Mass, 1839.

See also DIGEST, titles, COPYRIGHT, B.: ABRIDGEMENT; CHARTS; COMPILATIONS; DICTIONARIES; REVIEWS; TRANSLATION.

(*d*) COPYRIGHT, WHAT IS.

The privilege of an author to an exclusive sale of his works, for a limited number of years, although a monopoly, is not so in the odious meaning of the term; but is but a proper reward for his labor, and to which he is as much entitled as to the exclusive enjoyment of any other kind of property. *Blunt* v. *Patten*, 2 Paine, 395.—THOMPSON, J.; N Y., 1828.

Copyright is an exclusive right to the multiplication of copies, for the benefit of the author or his assigns, disconnected from the plate, or any other physical existence. *Stephens* v. *Cady*, 14 How., 330.—NELSON, J.; Sup. Ct., 1852.

Before publication, an author has the exclusive possession of the ideas contained in his book, and the combination of words to represent them. But when he has published his book, and given his thoughts, sentiments, knowledge or information, to the world, he can have, no longer, an exclusive possession in them. *Stowe* v. *Thomas*, 5 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

When an author has sold his work, the only property which he reserves to himself, or which the law gives to him, is the exclusive right to multiply the copies of that particular combination of character which exhibits to the eyes of another, the ideas intended to be conveyed. This is what the law terms copy, or copyright. *Ibid.*, 228.

An author's exclusive property in a literary composition, or copyright, consists only in a right to multiply copies of his book, and enjoy the profits therefrom, and not in an exclusive right to his conceptions. *Ibid.*, 228.

The case of *Millar* v. *Taylor*, 4 Burr, 311, has finally settled the question as to the nature of the property which an author has in his works; and it is, that after publication, his property consists in the "right of copy," which signifies "the sole right of printing, publishing, and selling, his literary composition or book;" not that he has such a property in his original conceptions, that he alone can use them in the composition of a new work, or clothe them in a different dress by translation. *Ibid.*, 230.

See also DIGEST, title COPYRIGHT, A.

son, be still living, and a citizen or citizens of the United States, or resident therein, or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided*, That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term. (*a*)

SECTION 3. *And be it further enacted*, That in all cases of renewal of copyright under this act, such author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more of the newspapers printed in the United States, for the space of four weeks.

SECTION 4. *And be it further enacted*, (*b*) That no person shall be entitled to the benefit of this act, unless he shall, before publication, deposit a printed copy of the title of such book, or books, map, chart, musical composition, print, cut, or engraving, in the clerk's office of the District Court of the district wherein the author or proprietor shall reside, and the clerk of such court is hereby directed and required to record the same thereof forthwith, in a book to be kept for that purpose, in the words following, (giving a copy of the title, under the seal of the court, to the said author or proprietor, whenever he shall require the same): "District of to wit: Be it remembered, that on the day of Anno Domini, A. B., of the said district, hath deposited in this office the title of a book, (map, chart, or otherwise, as the case may be), the title of which

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(*a*) The extension of a copyright, by the copyright acts of 1790 and 1831, is given to the author alone, or to others only, who purchase it from him. *Pierpont* v. *Fowle*, 2 Wood. & Min., 44.—WOODBURY, J.; Mass., 1846.

An assignment of a "copyright" should not, by construction, be extended beyond the first term, unless it seems to be actually so meant by the author, and to include any future contingency. *Ibid.*, 44.

An assignment of a "copyright" is to be referred to what was then in existence, and not to any future contingency. *Ibid.*, 45.

The taking out a second term of a copyright is not like the strengthening of a defective title, but rather like a new interest obtained after the general interest had expired. *Ibid.*, 46.

See also DIGEST; title COPYRIGHT, E.

### (*b*) NOTES TO §§ 4 AND 5.

The act of 1831 embodies the provisions of the acts of 1790 and 1802, and imposes on the persons claiming the privilege of copyright, the same duties and liabilities which attended the right under the prior statutes. *Baker* v. *Taylor*, 2 Blatchf., 83.—BETTS, J.; N. Y., 1848.

Under §§ 4 and 5 of this act, the depositing the title-page in the proper clerk's office, publishing a notice according to the act, and delivering a copy of the book, are conditions, the performance of which is essential to the title. *Ibid.*, 84.

And the notice must be published in the manner specified in the act. *Ibid.*, 84.

All the things required by these sections must be done to secure a copyright. *Jollie* v. *Jaques*, 1 Blatchf., 620.—NELSON, J.; N. Y., 1850. *Struve* v. *Schwedler*, 4 Blatchf.—NELSON, J.; N. Y., 1857.

is in the words following, to wit: (here insert the title); the right whereof he claims as author, (or proprietor, as the case may be), in conformity with an act of Congress, entitled 'An act to amend the several acts respecting copyrights.' C. D., Clerk of the district." For which record the clerk shall be entitled to receive, from the person claiming such right, as aforesaid, fifty cents, and the like sum for every copy under seal, actually given to such person or his assigns. And the author or proprietor of any such book, map, chart, musical composition, print, cut, or engraving, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver, or cause to be delivered, a copy of the same to the clerk of said district. And it shall be the duty of the clerk of each District Court, at least once in every year, to transmit a certified list of all such records of copyright, including the titles so recorded, and the dates of record, and also all the several copies of books or other works deposited in his office according to this act, to the Secretary of State, to be preserved in his office.

SECTION 5. *And be it further enacted*, (*b*) That no person shall be entitled to the benefit of this act, unless he shall give information of copyright being secured, by causing to be inserted in the several copies of each and every edition published during the term secured on the title-page, or the page immediately following, if it be a book, or, if a map, chart, musical composition, print, cut, or engraving, by causing to be impressed on the face thereof, or if a volume of maps,

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Where the title-page of a book was deposited in 1846, and the notice of the entry, inserted in the book, stated it to have been deposited in 1847, *Held*, that the error created a fatal defect in the plaintiff's title. *Baker* v. *Taylor*, 2 Blatchf., 84.—BETTS, J.; N. Y., 1848.

Even if the error arose from mistake, it will make no difference as to the result. *Ibid.*, 84.

Under § 4 a person is not entitled to any benefit, under the act, unless he deposits the title-page *before* the publication of his work. *Ibid.*, 85.

Where copies of a book were sold prior to the date of the deposit of a copy of the title-page, and a printed copy of the book was deposited in the clerk's office, at the same time the title-page was deposited, *Held*, that these facts warranted an inference of an actual publication of the book prior to the date of such deposit. *Ibid.*, 85.

Until all the things required by these sections are done, the copyright is not secured; but by taking the incipient step, a right is acquired which chancery will protect, until the other acts may be done. *Pulte* v. *Derby*, 5 McLean, 332.—MCLEAN, J.; Ohio, 1852.

Where a work consists of a number of volumes, the insertion of the record on the page next following the title-page of the *first volume* of the work is a sufficient compliance with the statute. *Dwight* v. *Appleton*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

The author may insert the same record in another edition, published in a different number of volumes, without impairing the copyright. *Ibid.*, 199.

The number of volumes in which it was stated the work would be published, make no part of its title, and may be rejected as surplusage. *Ibid.*, 199.

After such title-page has been deposited, the author can maintain an action for an infringement or violation of his right, even though the work may not have been pub

charts, music, or engravings, upon the title or frontispiece thereof, the following words, viz.: "Entered according to act of Congress, in the year , by A. B., in the clerk's office of the District Court of ," (as the case may be.)

SECTION 6. *And be it further enacted*, That if any other person or persons, from and after the recording the title of any book or books, according to this act, shall, within the term or terms herein limited, print, (*a*) publish, or import, or cause to be printed, published, or imported, any copy of such book, or books, without the consent of the person legally entitled to the copyright thereof, first had and obtained in writing, signed in presence of two or more credible witnesses, or

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lished, or the printed copy deposited. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 398.—SPRAGUE, J.; Mass., 1860. CONTRA, *Keene* v. *Wheatley*, 1 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

The record from the clerk's office, made in the form prescribed by § 4, or of the depositing of a title-page, is *prima facie* evidence that a printed title was deposited. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 398.—SPRAGUE, J.; Mass., 1860.

See also DIGEST, title COPYRIGHT, D.; and notes to § 3 of the act of 1790, and to § 1 of the act of 1802.

(*a*) The intent with which a work is reprinted cannot be taken into consideration; it is the act of reprinting that is prohibited by the statute. *Nichols* v. *Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

It is of no consequence in what form the works of another are used, whether it be a simple reprint or by incorporating it in some other work. If his copyright is violated he can maintain an action therefor. *Gray* v. *Russell*, 1 Story, 19.—STORY, J.; Mass., 1839.

To entitle a party to an action for the infringement of a copyright, it is not necessary that the whole or a greater part of his work should be taken. If so much is taken as to impair the value of the original, or so that the labors of the original author are substantially appropriated, that is sufficient in point of law to constitute a piracy. *Folsom* v. *Marsh*, 2 Story, 115.—STORY, J.; Mass., 1841.

The entirety of the copyright is the property of the author; and it is no defence that another has appropriated only a part of such property and not the whole. *Ibid.*, 116.

Nor does it necessarily depend upon the quantity taken, whether it is an infringement of a copyright or not. *Ibid.*, 116.

Intention cannot be taken into account in reference to an infringement. If a copyright has been invaded, whether the party knew the work was copyrighted or not, he is liable to the penalty for violation. *Millett* v. *Snowden*, 1 West. L. Jour., 240.—BETTS, J.; N. Y., 1843.

The infringement of a copyright does not depend so much upon the length of the extracts as upon their value. Nor has the intention with which extracts are made any bearing upon the question of violation. *Story's Exrs.* v. *Holcombe*, 4 McLean, 309, 310.—MCLEAN, J.; Ohio, 1847.

A book may in one part of it infringe the copyright of another work, and in other parts be no infringement; in such a case the remedy will not be extended beyond the injury. *Ibid.*, 315.

A book, within the meaning of the statute, does not include a translation of a work. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 230.—GRIER, J.; Pa., 1853.

A translation may be called a transcript or copy of the author's thought or conception, but in no correct sense can it be called a *copy* of his book. *Ibid.*, 231.

See also DIGEST, title INFRINGEMENT, A.

shall, knowing the same to be so printed or imported, publish, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such book without such consent in writing; then such offender shall forfeit every copy of such book to the person legally, at the time, entitled to the copyright thereof; and shall also forfeit and pay fifty cents for every such sheet which may be found in his possession, either printed, or printing, published, imported, or exposed to sale, contrary to the intent of this act, the one moiety thereof to such legal owner of the copyright as aforesaid, and the other to the use of the United States, to be recovered by action of debt in any court having competent jurisdiction thereof. (*a*)

SECTION 7. *And be it further enacted*, That if any person or persons, after the recording of the title of any print, cut, or engraving, map, chart, (*b*) or musical composition, according to the provisions of this act, shall, within the term or terms limited by this act, engrave, etch, or work, sell, or copy, or caused to be

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(*a*) AN *action on the case* is the proper form of action to recover damages for a violation of a copyright; *trespass* will not lie. *Atwill* v. *Ferrett*, 2 Blatchf., 48.—BETTS, J.; N. Y., 1846.

The penalty of fifty cents per sheet imposed by this section is incurred for every sheet found to have been in the defendant's possession, or which they had sold, or held for sale. *Dwight* v. *Appleton*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

The penalty declared by this section can be adjudged only for the sheets found in the possession of the defendant. *Backus* v. *Gould*, 7 How., 811.—MCLEAN, J.; Sup. Ct., 1848.

The penalty imposed by this section is not incurred by printing and publishing so much of a book as to amount to an infringement of the copyright. *Rogers* v. *Jewett*, 12 Mo. Law Rep., 340.—CURTIS, J.; Mass., 1858.

The words "a copy of a book," found in § 6 of the act of 1831, import a transcript or copy of the entire book. *Ibid.*, 341.

Congress did not intend to inflict these penalties upon the unlawful printing or publication of less than an entire work. *Ibid.*, 341.

This question was not decided in *Backus* v. *Gould*, 7 How., 798, though raised in the court below and decided *pro forma* there. *Ibid.*, 342.

See also DIGEST, title PENALTIES, A.

(*b*) Though a party cannot have a copyright in the original elements or materials of his chart, he has a right to the result of his labors and surveys in making it. Another party may resort to the original materials of the chart, and survey for himself; but he cannot avail himself, either in whole or in part, of the surveys of the former. *Blunt* v. *Patten*, 2 Paine, 395, 396.—THOMPSON, J.; N. Y., 1828.

The natural objects from which charts are made, being, however, open to all, a copyright cannot subsist in a chart, as a general subject, but it may in an individual work, and others may be restrained from copying such work. *Ibid.*, 400, 401.

But a right in such a subject is violated only when another copies from the chart of him who has secured the copyright, and thereby availed himself of his labor and skill. *Ibid.*, 402.

In all such cases, it is a proper question for a jury, whether the one is a copy of the other or not; if there was some small variance, it would be a proper subject of inquiry whether the alteration was not merely colorable. *Ibid.*, 402.

But a subsequent compiler has a right to avail himself of all prior publications, which are not copyrighted, and if his chart is compiled from such publications, it is no infringement, although it may agree with another's chart. *Ibid.*, 403.

engraved, etched, worked, or sold, or copied, either on the whole, or by varying, adding to, or diminishing the main design, with intent to evade the law; or shall print or import for sale, or cause to be printed or imported for sale, any such map, chart, musical composition, print, cut, or engraving, or any parts thereof, without the consent of the proprietor or proprietors of the copyright thereof, first obtained in writing, signed in the presence of two credible witnesses; or knowing the same to be printed or imported without such consent, shall publish, sell, or expose to sale, or in any manner dispose of any such map, chart, musical composition, engraving, cut, or print, without such consent, as aforesaid; then such offender or offenders shall forfeit the plate or plates on which such map, chart, musical composition, engraving, cut, or print, shall be copied, and also all and every sheet thereof so copied or printed as aforesaid, to the proprietor or proprietors of the copyright thereof; and shall further forfeit one dollar for every sheet of such map, chart, musical composition, print, cut, or engraving, which may be found in his or their possession, printed or published, or exposed to sale, contrary to the true intent and meaning of this act; the one moiety thereof to the proprietor or proprietors, and the other moiety to the use of the United States, to be recovered in any court having competent jurisdiction thereof. (*a*)

SECTION 8. *And be it further enacted*, That nothing in this act shall be construed to extend to prohibit the importation, or vending, printing, or publishing of any map, chart, book, musical composition, print, or engraving, written, composed, or made by any person not being a citizen of the United States, nor resident within the jurisdiction thereof.

SECTION 9. *And be it further enacted*, That any person or persons who shall print or publish any manuscript whatever without the consent of the author or

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One person may publish a map of the same state or country for which another has a copyright, by using the like means or materials, and the like skill, labor, and expense, in its preparation. But he has no right to publish a map, taken substantially and designedly from the map of such other person, without any such exercise of skill, labor, or expense. *Emerson* v. *Davies*, 3 Story, 781.—STORY, J.; Mass., 1845.

See also DIGEST, title CHARTS.

(*a*) The penalty for an infringement is, under this section, fixed by law. If the jury find there has been an infringement, they must ascertain the number of sheets proved to have been sold, or offered for sale (not the number printed), and return a verdict for one dollar for each sheet so sold, or offered to be sold. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

A defendant is not liable to the penalty imposed by this section, unless he was guilty of the infraction of the copyright within two years before action was brought. *Reed* v. *Carusi*, 8 Law Rep., 412.—TANEY, Ch. J.; Md., 1845.

The engraving or preparation of plates, where the work is printed from plates, may have been more than two years, but every printing for sale would be a new infraction of the right, and if such printing was within two years before suit brought, the defendant is liable. *Ibid.*, 412.

The penalty is at the rate of one dollar for each sheet the defendant may have caused to be printed for sale, within two years before suit brought. *Ibid.*, 412.

See also DIGEST, title, PENALTIES, A.

legal proprietor first obtained as aforesaid, (if such author or proprietor be a citizen of the United States, or resident therein), shall be liable to suffer and pay to the author or proprietor, all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof; (*a*) and the several courts of the United States empowered to grant injunctions to prevent the violation of the rights of authors and inventors, are hereby empowered to grant injunctions, in like manner, according to the principles of equity, to restrain such publication of any manuscript as aforesaid.

SECTION 10. *And be it further enacted*, That, if any person or persons shall be sued or prosecuted, for any matter, act, or thing done under or by virtue of this act, he or they may plead the general issue, and give the special matter in evidence.

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(*a*) 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., 657.—McLEAN, J.; Sup. Ct., 1834.

Notwithstanding the copyright by statute, there remains in an author a common law title to his works before publication. *Jones* v. *Thorne*, 1 N. Y. Leg. Obs., 409.—McCOUN, V. Ch.; N. Y., 1843.

At common law, independently of the statute, the author of a manuscript might obtain redress against one who had surreptitiously gained possession of it. *Bartlette* v *Crittenden*, 4 McLean, 301.—McLEAN, J.; Ohio, 1847.

On general equitable principles, relief may also be given, under like circumstances, by a court of chancery. *Ibid.*, 301.

The use, by an author, of his manuscript for the purpose of instruction, is not an abandonment of it to the public. Nor is it an abandonment to allow his pupils to take copies. *Ibid.*, 303.

Those also who have been permitted to take copies have no right to a use which was not in contemplation when the consent to take copies was given. *Ibid.*, 303.

An author has a common law right in his manuscript until he relinquishes it by contract or some equivocal act. *Bartlette* v. *Crittenden*, 5 McLean, 36, 38.—McLEAN, J.; Ohio, 1849.

Such right is also protected by § 9 of the copyright act of 1831. *Ibid.*, 38.

A surreptitious publication of an important part of a manuscript is equally within the statute as if the manuscript was complete; and the whole of a manuscript need not be printed. *Ibid.*, 39, 40.

At common law an author has a right to his unpublished manuscripts the same as to any other property he may possess; and this act of the 3d of February, 1831, gives him a remedy by injunction to protect this right. *Little* v. *Hall*, 18 How., 170.—McLEAN, J.; Sup. Ct., 1855.

The common law right of an author in his manuscript has not been taken away or abridged by the statutes which have been passed for the protection of copyright. Its existence is prior to these statutes, and independent of their provisions. *Woolsey* v. *Judd*, 4 Duer, 385.—DUER, J.; N. Y., 1855.

The act of 1831, § 9, giving redress for the unauthorized *printing or publishing* of *manuscripts*, operates in favor of a resident of the United States who has acquired the proprietorship of an *unprinted* literary composition from a non-resident alien author. *Keene* v. *Wheatley*, 9 Amer. Law. Reg., 45.—CADWALLADER, J.; Pa., 1860.

But this section—and which is the only one—enabling a proprietor, who derives

SECTION 11. *And be it further enacted*, That, if any person or persons, from and after the passing of this act, shall print or publish any book, map, chart, musical composition, print, cut, or engraving, not having legally acquired the copyright thereof, and shall insert or impress that the same hath been entered according to act of Congress, or words purporting the same, every person so offending shall forfeit and pay one hundred dollars: one moiety thereof to the person who shall sue for the same, and the other to the use of the United States, to be recovered by action of debt, in any court of record having cognizance thereof. (*a*)

SECTION 12. *And be it further enacted*, That, in all recoveries under this act, either for damages, forfeitures, or penalties, full costs shall be allowed thereon, any thing in any former act to the contrary notwithstanding.

SECTION 13. *And be it further enacted*, That no action or prosecution shall be maintained, in any case of forfeiture or penalty under this act, unless the same shall have been commenced within two years after the cause of action shall have arisen.

SECTION 14. *And be it further enacted*, That the "act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies during the times therein mentioned," passed May thirty-first, one thousand seven hundred and ninety, and the act supplementary thereto, passed April twenty-ninth, one thousand eight hundred and two, shall be, and the same are hereby, repealed: saving, always, such rights as may have been obtained in conformity to their provisions.

SECTION 15. *And be it further enacted*, That all and several the provisions of this act, intended for the protection and security of copyrights, and providing remedies, penalties, and forfeitures, in cases of violation thereof, shall be held and construed to extend to the benefit of the legal proprietor or proprietors of each and every copyright heretofore obtained, according to law, during the term thereof, in the same manner as if such copyright had been entered and secured according to the directions of this act.

SECTION 16. *And be it further enacted*, That, whenever a copyright has been heretofore obtained by an author or authors, inventor, designer, or engraver, of any book, map, chart, print, cut, or engraving, or by a proprietor of the same:

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his title from such an author, to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

See also DIGEST, titles LETTERS; MANUSCRIPTS.

(*a*) The penalty imposed by this section, and given "to the *person* who shall sue for the same," cannot be recovered in the name of more than one person. *Ferrett* v. *Atwill*, 1 Blatchf., 154, 155.—BETTS, J.; N. Y., 1846.

A declaration for such penalty in the name of *two* persons is bad on general demurrer. *Ibid.*, 154.

There is a manifest difference between giving a penalty to a common informer, and imposing one for the benefit of the person aggrieved: in the latter case the term person may be regarded as comprehending every one affected by the injury. *Ibid.*, 156.

See also DIGEST, title PENALTIES, A.

if such author or authors, or either of them, such inventor, designer, or engraver, be living at the passage of this act, then such author or authors, or the survivor of them, such inventor, engraver, or designer, shall continue to have the same exclusive right to his book, chart, map, print, cut, or engraving, with the benefit of each and all the provisions of this act, for the security thereof, for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right to his widow, child, or children, to renew the copyright, at the expiration thereof, as is above provided in relation to copyrights originally secured under this act. And if such author or authors, inventor, designer, or engraver, shall not be living at the passage of this act, then his or their heirs, executors and administrators, shall be entitled to the like exclusive enjoyment of said copyright, with the benefit of each and all the provisions of this act for the security thereof, for the period of twenty-eight years from the first entry of said copyright, with the like privilege of renewal to the widow, child, or children, of author or authors, designer, inventor, or engraver, as is provided in relation to copyrights originally secured under this act: *Provided*, That this act shall not extend to any copyright heretofore secured, the term of which has already expired.

Approved February 3d, 1831.

## ACT OF 1834, CHAPTER 157.

(4 STAT. AT LARGE, 728.)

An Act supplementary to the Act to amend the several Acts respecting Copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America, in Congress assembled*, That all deeds or instruments in writing for the transfer or assignment of copyrights, (*a*) being proved or acknowledged in such manner as deeds for the conveyance of land are required by law

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(*a*) An assignment of an interest in a copyright must be in writing to be valid and operative; but an *agreement* to assign may be by parol. *Gould* v. *Banks*, 8 Wend.. 565.—NELSON, J.; N. Y., 1832.

An assignment of a "copyright" in general terms is to be referred to what was then in existence, and not to any future contingency. It should not be by construction extended beyond the first term, unless it seems to be so actually meant by the author, and to include a future contingency. *Pierpont* v. *Fowle*, 2 Wood. & Min., 43–45.—WOODBURY; J.; Mass., 1846.

Otherwise, if the contract of sale or assignment uses language looking beyond the existing copyright, such as referring to all the *interest* in the matter, or to the *manuscript* or book itself, or using some other expression more comprehensive than the word "copyright." *Ibid.*, 45.

An assignment of a copyright, although not recorded, is still valid as between the parties, and as to all persons not claiming under the assignors. *Webb* v. *Powers*, 2 Wood. & Min., 510.—WOODBURY, J.; Mass., 1847.

to be proved or acknowledged in the same state or district, shall and may be recorded in the office where the original copyright is deposited and recorded; and every such deed or instrument that shall in any time hereafter be made and executed, and which shall not be proved or acknowledged and recorded as aforesaid, within sixty days after its execution, shall be judged fraudulent and void against any subsequent purchaser or mortgagee for valuable consideration without notice. (*a*)

SECTION 2. *And be it further enacted*, That the clerk of the district court shall be entitled to such fees for performing the services herein authorized and required, as he is entitled to for performing like services under existing laws of the United States.

Approved, June 30th, 1834.

## ACT OF 1846, CHAPTER 178.

(9 STAT. AT LARGE, 106.)

Extract from an Act to establish the "Smithsonian Institution," for the Increase and Diffusion of Knowledge among Men.

SECTION 10. *And be it further enacted*, That the author or proprietor of any book, map, chart, musical composition, print, cut, or engraving, for which a copyright shall be secured under the existing acts of Congress, or those which shall hereafter be enacted respecting copyrights, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver, or cause to be delivered, one copy of the same to the librarian of the Smithsonian Institution, and one copy to the librarian of Congress Library, for the use of the said libraries.

Approved August 10, 1846.

Repealed by act of 1859, §6.

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A formal transfer of a copyright by this act, is required to be proved and recorded as deeds for the conveyance of land, and such record operates as notice. *Little* v. *Hall*, 18 How., 171.—McLEAN, J.; Sup. Ct., 1855.

(*a*) This statute prescribes only the instrument by which they may be assigned, and the mode of recording, but does not define what interest may be assigned. *Roberts* v. *Myers*, 13 Mo. Law Rep., 401.—SPRAGUE, J.; Mass., 1860.

There is no sufficient reason for preventing an author conveying a distinct portion of his right. *Ibid.*, 401.

Where an assignment was of the exclusive right of acting and representing a certain drama, within the United States, except as to five cities, for the term of one year, *Held*, that it was valid under the statute. *Ibid.*, 400, 401.

The statutes of the United States for the protection of authors do not, like those for the benefit of inventors, sanction transfers of limited local proprietorships of exclusive privileges. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 46.—CADWALLADER, J.; Pa., 1860.

A writing which is in form a transfer by an author of his exclusive right for a designated portion of the United States, operates *at law* only as a mere *license*, and is ineffectual as an assignment. *Ibid.*, 46.

# ACT OF 1856, CHAPTER 169.

(11 STAT. AT LARGE, 138.)

An Act supplemental to an Act entitled "An Act to amend the several Acts respecting copyright," approved February third, eighteen hundred and thirty-one.

*Be it enacted, by the Senate and House of Representatives of the United States of America, in Congress assembled:* Any copyright hereafter granted under the laws of the United States to the author or proprietor of any dramatic composition, designed or suited for public representation, shall be deemed and taken to confer upon the said author or proprietor, his heirs or assigns, along with the sole right to print and publish the said composition, the sole right also to act, perform or represent the same, or cause it to be acted, performed or represented, on any stage or public place, during the whole period for which the copyright is obtained; and any manager, actor, or ohter person acting, performing or representing the said composition, without or against the consent of the said author or proprietor, his heirs or assigns, shall be liable for damages, to be sued for and recovered by action on the case or other equivalent remedy, with costs of suit in any court of the United States, such damages in all cases to be rated and assessed at such sum not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court having cognizance thereof shall appear to be just: (*a*)

*Provided nevertheless*, That nothing herein enacted shall impair any right to act, perform or represent a dramatic composition as aforesaid, which right may

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But in *equity*, a limited local or other partial assignment, if made for a valuable consideration, is carried into effect, whether it would be effectual in law or not. *Ibid.*, 47.

(*a*) The act of 1856 was passed to give to the authors of dramatic compositions the exclusive right of acting and representing, which they did not enjoy under the previous statutes. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 397.—SPRAGUE, J.; Mass., 1860.

It assumes the doctrine that representation is not publication. The prior acts secured to authors the exclusive right of printing and publication; and it was only because publication did not embrace acting or representation that this act was passed, superadding that exclusive right to those previously enjoyed. *Ibid.*, 397.

The previous acting or representing a play will not deprive the author of the right to afterward take out a copyright. *Ibid.*, 397.

An assignee of the exclusive right of acting and representing a drama in certain places, may maintain an action in his own name even after a representation by him, for an injunction to prevent its being represented by another within such places. *Ibid.*, 400, 401.

And such action may be maintained although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 401. (CONTRA, next below.)

A legislative enactment securing generally to literary proprietors a copyright for a limited period, but containing no special provision as to theatrical representation, does not, in the case of a dramatic literary composition, include the sole right of

have been acquired, or shall in future be acquired by any manager, actor or other person previous to the securing of the copyright for the said composition, or to restrict in any way the right of such author to process in equity in any court of the United Sta es for the better and further enforcement of his rights.

Approved August 18th, 1856.

## ACT OF 1859, CHAPTER 22.

(11 STAT. AT LARGE, 379.)

Extract from an Act passed February 5th, 1859, entitled, "An Act for keeping and distributing all Public Documents."

SECTION 6. *And be it further enacted*, That the tenth section of an act entitled, "An Act to establish the Smithsonian Institution for the increase and diffusion of knowledge among men," approved, August 10th, 1846, is hereby repealed.

SECTION 8. *And be it further enacted*, That all books, maps, charts, and other publications of every nature whatever heretofore deposited in the Department of State, according to the laws regulating copyrights, together with all the records of the Department of State, in regard to the same, shall be removed to, and be under the control of the Department of the Interior, which is hereby charged with all the duties connected with the same, and with all matters pertaining to copyright, in the same manner and to the same extent that the Department of State is now charged with the same; and hereafter all such publications of every nature whatever shall, under present laws and regulations, be left with and kept by him.

Approved, February 5th, 1859.

## ACT OF 1861, CHAPTER 37.

(12 STAT. AT LARGE, 130.)

An Act to extend the right of appeal from the decisions of circuit courts to the Supreme Court of the United States.

"*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from all judgments and decrees

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representing it. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

The only act which affords redress for unauthorized theatrical representations is the act of 18th August, 1856; but this only applies to cases in which copyright is effectually secured under the act of 1831. *Ibid.*, 45.

But under this act, an assignee of a dramatic composition cannot maintain an action for its unauthorized representation by others, unless he has performed *all* the acts required by law to secure a copyright, including the deposit of a *printed* copy. *Ibid.*, 45, 46

of any circuit court rendered in any action, suit. controversy, or case, at law or in equity, arising under any law of the United States granting or confirming authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action.

Approved February 18th, 1861.

## ACT OF 1865, CHAPTER 126.
(13 STAT. AT LARGE, 540.)

An Act supplemental to an Act entitled "An Act to amend the several Acts respecting copyrights," approved February third, eighteen hundred and thirty-one, and to the Acts in addition thereto and amendment thereof.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the provisions of said act shall extend to and include photographs and the negatives thereof which shall hereafter be made, and shall inure to the benefit of the authors of the same in the same manner and to the same extent, and upon the same conditions, as to the authors of prints and engravings.

SECTION 2. *And be it further enacted,* That a printed copy of every book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall be secured under said acts, shall be transmitted free of postage or other expense by the author or proprietor thereof, within one month of the date of publication, to the library of Congress at Washington, for the use of said library; and the librarian of Congress is hereby required to give a receipt in writing for the same.

SECTION 3. *And be it further enacted,* That if any proprietor of a book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall be secured as aforesaid, shall neglect to deliver the same pursuant to the requirement of this act, it shall be the duty of the librarian of Congress to make demand thereof in writing, at any time within twelve months after the publication thereof; and in default of the delivery thereof within one month after the demand shall have been made, the right of exclusive publication secured to such proprietors under the acts of Congress respecting copyrights shall be forfeited.

SECTION 4. *And be it further enacted,* That in the construction of this act, the word "book" shall be construed to mean every volume and part of a volume, together with all maps, prints, or other engravings belonging thereto; and shall include a copy of any second or subsequent edition which shall be published with any additions, whether the first edition of such book shall have been published before or after the passing of this act: *Provided, however,* That it shall not be requisite to deliver to the said library any copy of the second or any subsequent edition of any book, unless the same shall contain additions as aforesaid, nor of any book which is not the subject of copyright.

Approved March 3, 1865.

## ACT OF 1867, CHAPTER 43.
(14 STAT. AT LARGE, 395.)

An Act amendatory of the several Acts respecting copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That every proprietor of a book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall have been secured, who shall fail to deliver to the library of Congress at Washington a printed copy of every such book, pamphlet, map, chart, musical composition, print, engraving, or photograph, within one month after publication thereof, shall, for every such default, be subject to a penalty of twenty-five dollars, to be collected by the librarian of Congress, in the name of the United States, in any district or circuit court of the United States within the jurisdiction of which the delinquent may reside or be found.

SECTION 2. *And be it further enacted,* That every such proprietor may transmit any book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which he may have secured a copyright, to the librarian of Congress, by mail free of postage, provided the words "copyright matter" be plainly written or printed on the outside of the package containing the same, and it shall be the duty of the several postmasters and deputy postmasters to give a receipt for the same, if requested, and when such package shall be delivered to them, or any of them, to see that the same is safely forwarded to its destination by mail, without cost or charge to said proprietor

Approved February 18, 1867.

# EXPIRED

# ACTS OF CONGRESS

IN RESPECT TO

# PATENTS FOR INVENTIONS.

1790 TO 1874.

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THE several acts of Congress, in respect to Patents, passed previous to 1836, are now obsolete, having all been repealed by that act, but they are inserted in full for the purpose of reference and comparison, when desired, with the acts now in force.

The notes of decisions, inserted under the obsolete acts, are such as have reference to the construction of such acts, or to some particular matter therein. Decisions of a general nature, though made under those acts, are inserted under the acts now in force, as assisting to a proper understanding and interpretation of them.

It is not intended, however, to repeat, under the several acts, all the decisions explanatory of them, but only those of a mere general character, adding suitable references to appropriate titles of the DIGEST. Nor has any effort been made to arrange the notes in strict chronological order.

## ACT OF 1790, CHAPTER 7.

(1 STAT. AT LARGE, 109.)

An act to promote the progress of useful arts.

SECTION 1. *Be it enacted, by the Senate and House of Representatives of the United States of America, in Congress assembled*, That upon the petition of any person or persons to the Secretary of State, the Secretary for the department of war, and the Attorney-General of the United States, setting forth, that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the department of war, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, (*a*) to bear teste by the President of the United

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(*a*) Under this section it was held, that the allegations and suggestions of the petition must be substantially recited in the patent, or the patent was void. *Evans* v. *Chambers*, 2 Wash., 126.—WASHINGTON, J.; Pa., 1807.

States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and endorsed on the patent by the said Secretary at the time of granting the same.

SECTION 2. *And be it further enacted*, That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; (*a*) which specification shall be filed in the office of the said Secretary, and certified copies thereof shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege, shall come in question.

SECTION 3. *And be it further enacted*, That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant. (*b*)

SECTION 4. *And be it further enacted*, That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon,

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(*a*) As to how invention should be set forth or described, see DIGEST, titles COMPOSITION OF MATTER, B.; IMPROVEMENT, B.; SPECIFICATION, B.

(*b*) See DIGEST, title COPIES OF PAPERS, and also notes to act of 1836, § 4.

or in any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators or assigns, first had and obtained in writing, every person so offending, shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved the thing or things so devised, made, cónstructed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act. (*a*)

Section 5. *And be it further enacted*, That upon oath or affirmation made before the judge of the district court, where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said dist ..t court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants, shall be recovered in due course of law. (*b*)

Section 6. *And be it further enacted*, That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence, that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified, and that the same is truly specified; (*c*) but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff;

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(*a*) See notes to act of 1793, § 5.

(*b*) See Digest, title Courts, B. 3, and notes to act of 1793, § 10.

(*c*) Of the novelty and utility of an invention, the patent is *prima facie* evidence of a very slight character. *Lowell* v. *Lewis*, 1 Mas., 184.—Story, J.; Mass., 1817.

Under the act of 1790, a patent was made *prima facie* evidence; that act was repealed by the act of 1793, and that provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the inven

or his attorney, thirty days before the trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; (*a*) or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

SECTION 7. *And be it further enacted*, That such patentee as aforesaid, shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifications, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

Approved April 10th, 1790.

Repealed by act of 1793, § 12.

## ACT OF 1793, CHAPTER 11.

(1 STAT. AT LARGE, 318.)

An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose.

SECTION 1. *Be it enacted, by the Senate and House of Representatives of the United States of America, in Congress assembled*, That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, (*b*) and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State, to cause letters patent to be made out in the name of the United States, bearing teste by the

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tion patented was new or useful, but the plaintiff was bound to prove these facts in order to make out his case. But the act of 1836 introduced a new system, and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of the facts asserted in it. *Corning* v. *Burden*, 15 How., 270, 271.—GRIER, J.; Sup. Ct., 1853.

See also DIGEST, title PATENT, P. 2.

(*a*) As to General Issue, and notices with, see notes to act of 1793, § 6, and to act of 1836, § 15.

(*b*) This section is to be construed with the other parts of the act to mean that the discovery should be unknown, and not used as the invention of any other than the patentee, before the application for a patent. *Morris* v. *Huntington*, 1 Paine, 353.—THOMPSON, J.; N. Y., 1824.

President of the United States, reciting the allegations and suggestions of the said petition, (*a*) and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of

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This section of the act is to be construed with § 6 of the same act, and means that the first inventor has a right to a patent, though there may have been a knowledge of the thing invented before the *application* for a patent, if such use or knowledge was not anterior to the *discovery*. *Mellus* v. *Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825. *Goodyear* v. *Matthews*, 1 Paine, 301.—LIVINGSTON, J.; Ct., 1814.

The true construction of the act of 1793, considering §§ 1 and 6 together, is that to invalidate a patent, because of a prior use or knowledge, the thing patented must have been used prior to the alleged *discovery* of the patentee, and not merely prior to the *application*. *Treadwell* v. *Bladen*, 4 Wash., 707, 708.—WASHINGTON, J.; Pa., 1827.

The meaning of the words "not known or used," &c., in this section, is that the invention must not have been known or used BY THE PUBLIC *before the application*. *Pennock* v. *Dialogue*, 2 Pet., 19.—STORY, J.; Sup. Ct., 1829.

The patent act of 1790 used the words "not known or used before," without adding the words "the application:" in connection with the structure of the sentence in which they stand, they might have been referred either to the time of the invention, or of the application. The addition of the latter words in the act of 1793, must have been *ex industria*, and with the cautious intention to clear away a doubt, and fix the original and deliberate meaning of the legislature. *Ibid.*, 22.

The words "not known or used before the application," refer to the application for the patent, and not to the discovery referred to in the sixth section; but the previous use, to invalidate a patent, must be a public use, by the consent or acquiescence of the patentee. *Whitney* v. *Emmett*, Bald., 309.—BALDWIN, J.; Pa., 1831. *Thompson* v. *Haight*, 1 U. S. Law Jour., 573.—VAN NESS, J.; N. Y., 1822.

Within the spirit of this section, it was held that the Secretary of State, though not expressly authorized, might receive the surrender of letters patent, which were defective by reason of mistakes committed either by the department, or by the inventor, innocently, and reissue a new and corrected patent. *Grant* v. *Raymond*, 6 Pet., 242.—MARSHALL, Ch. J.; Sup. Ct., 1832. Same view had been before taken in *Sullivan's Case*, Opin., Gilpin's Ed., 158.—WIRT, Atty. Gen., 1818. *Morris* v. *Huntington*, 1 Paine, 355.—THOMPSON, J.; N. Y., 1824. *Grant* v. *Mason*, 1 Law Int. and Rev., 22.—THOMPSON, J.; N. Y., 1828. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen., 1831.

The knowledge and use spoken of in this act has reference to the public only. A surreptitious knowledge and use will not affect the right of the inventor. *Shaw* v. *Cooper*, 7 Pet., 319.—MCLEAN, J.; Sup. Ct., 1833.

(*a*) Though this act, like that of 1790, required a petition to be presented, and the patent, when issued, to recite the "allegations and suggestions of the petition," it seems that after this act of 1790, the petition alone seldom contained any thing as to the patent beyond a mere title. *Hogg* v. *Emerson*, 6 How., 480, 481.—WOODBURY, J.; Sup. Ct., 1847.

But the specification being filed at the same time and often on the same paper,

State, who shall present the letters patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed: and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

SECTION 2. *Provided always, and be it further enacted,* That any person, who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which have been patented, and shall have obtained a patent for such improvement, he shall not be at liberty to make, use or vend the original discovery, nor shall the first inventor be at liberty to use the improvement. (*a*) And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery. (*b*)

SECTION 3. *And be it further enacted,* That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe, that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or charac ter, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the

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seems to have been regarded, whether specially named in the petition or not, as a part of it. To avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. *Ibid.*. 481.

(*a*) As to doctrine that the patentee of an improvement has no right to use the original discovery, nor the first inventor the right to use the improvement, see *Gray* v. *James*, Pet. C. C., 399.—WASHINGTON, J.; Pa., 1817; *Washburn* v. *Gould*, 3 Story, 150.—STORY, J.; Mass., 1844; *Woodworth* v. *Rogers*, 1 Wood. & Min., 141.—WOODBURY, J.; Mass., 1847; and generally DIGEST, title IMPROVEMENT, C.

(*b*) It is not every change of form and proportion which is declared by this act to be no discovery, but such as is *simply* a change of form and proportion, and nothing more. 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. *Davis* v. *Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

Though this declaratory act, that a change in form is not a discovery, was not reenacted in the law of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. *Winans* v. *Denmead*, 15 How., 341. —CURTIS, J.; Sup. Ct., 1853.

See also DIGEST, titles FORM; IMPROVEMENT, A.

case admits of drawings, (*a*) or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent-right, shall come in question. (*b*) And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

SECTION 4. *And be it further enacted*, That it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree. (*c*)

SECTION 5. *And be it further enacted*, That if any person shall make, devise,

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(*a*) Under the provisions of this section requiring drawings with written references, if the specification refers to the drawings, they thereby become part of the written description of the invention. *Earle* v. *Sawyer*, 4 Mas., 10, 11.—STORY, J.; Mass., 1825. *Brooks* v. *Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843. *Washburn* v. *Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

It is sufficient if drawings and written references are put on file with the specification; and if the references required are written on the drawings the statute is satisfied. *Emerson* v. *Hogg*, 2 Blatchf., 9, 10.—BETTS, J.; N. Y., 1845.

The patent act of 1793 does not limit the inventor to one single mode or one single set of ingredients to carry into effect his invention. He may claim as many modes as he pleases, provided always that the claim is limited to such as he has invented and as are substantially new. And § 3 of the act requires, in the case of a machine, that the inventor shall explain the several modes in which he has contemplated the application of its principle. *Ryan* v. *Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

Under the act of 1793, the specification was not required to be made a part of the letters patent, but the inventor could have it so incorporated with them if he desired. *Hogg* v. *Emerson*, 11 How., 604.—WOODBURY, J.; Sup. Ct., 1850.

(*b*) An exemplification of a specification of a patent is made evidence by this section of the act of Congress. The exemplification of the patent itself stands upon the common law, as being an exemplification of a record of a public document, and is always to be received as evidence. The drawing or model need not be exemplified. *Peck* v. *Farrington*, 9 Wend., 45.—SAVAGE, Ch. J.; N. Y., 1832.

(*c*) It is the business of the assignee of a patent-right to see that the assignment is put on record. *Morrill* v. *Worthington*, 14 Mass., 392.—CURIAM; Mass., 1817.

Under this section an assignment is not valid unless it has been recorded in the office of the Secretary of State. *Higgins* v. *Strong*, 4 Blackf., 183.—DEWEY, J.; Ind., 1836.

Under this section, until an assignment is recorded, the assignee is not substituted to the rights and responsibilities of the patentee so as to maintain a suit at law or in equity, founded thereon. *Wyeth* v. *Stone*, 1 Story, 296.—STORY, J.; Mass., 1840.

Under this section the recording of an assignment is indispensable to convey the right. *Dobson* v. *Campbell*, 1 Sumn., 326.—STORY, J.; Me., 1833. *Boyd* v. *McAlpine*, 3 McLean, 428.—MCLEAN, J.; Ohio, 1844.

and use, or sell the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending, shall forfeit and pay to the patentee a sum, that shall be at least equal to three times the price, for which the patentee has usually sold or licensed to other persons, the use of the said invention; (*a*) which may be recovered in an action on the case founded on this act, in the Circuit Court of the United States, or any other court having competent jurisdiction. (*b*)

SECTION 6. *Provided always, and be it further enacted*, That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter, (*c*) of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove, that the specification, filed by the plaintiff, does not contain the whole truth relative

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(*a*) Under this section, subjecting to a penalty "any person who shall make, devise, *and* use, or sell the thing so invented," it might well be questioned whether any person would be subject to the penalty for using a machine which he had not also made and devised. Such doubt is removed by § 3 of the act of 1800, which subjects to damages "any person who shall make, devise, use, *or* sell" the invention of another. *Evans* v. *Jordan*, 1 Brock., 250, 251.—MARSHALL, Ch. J.; Va., 1813.

The maker and seller of a patented article, within the meaning of this section, is the person for whom, by whose direction, and for whose account the article is sold—and not the mere workman employed to sell. *Delano* v. *Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

Where one erected on his own premises and at his own expense, a machine which was claimed to be the invention of another; and afterward such inventor took a lease of the machine for a term of years, covenanting to reconvey the same at the end of the term of years, *Held*, that such covenant amounted to license or consent in writing, within the meaning of this section. *Reutgen* v. *Kanowrs*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

The patent act of 1790, § 4, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, § 5, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. The act of 1800, § 3, provided that an infringer should pay three times the actual damages sustained. *Seymour* v. *McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

The patent act of 1836, § 14, confines the jury to the actual damages sustained by the patentee. The power to increase them, as punitive damages, is committed to the discretion and judgment of the court. *Ibid.*, 489.

(*b*) Under this section, it was held the assignee of a *part* of a patent could not maintain an action for a violation. *Tyler* v. *Tuel*, 6 Cra., 324.—CURIAM; Sup. Ct., 1810.

But the assignee of a moiety may join with the patentee in an action for a violation. *Wilkinson* v. *Cutter*, 1 Gall., 430.—STORY, J.; Mass., 1813.

This section repealed by act of 1800, § 4.

(*c*) The object of this section was to guard against defeating patents by the setting up of a prior invention which had never been reduced to practice. *Bedford* v. *Hunt*, 1 Mas., 305.—STORY, J.; Mass., 1817.

This section appears to have been drawn with the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue, and intends to relieve the defendant from the difficulties of pleading, by allowing him to give in

to his discovery, (*a*) or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made, for the purpose of deceiving the public, or that the thing, thus secured by patent, was not originally discovered by the patentee, but had been in use, (*b*) or had been described in some public work anterior to the supposed discovery of the patentee,

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evidence matter which affects the patent. *Evans* v. *Eaton*, 3 Wheat., 503, 504.—MARSHALL, Ch. J.; Sup. Ct., 1818.

Such notice is, however, for the security of the plaintiff, to protect him against surprise. *Ibid.*, 504.

(*a*) This section does not enumerate all the defences of which the defendant may legally avail himself; as he may give in evidence that he never did the thing attributed to him; that the patentee is an alien, and not entitled under the act; or that he has a license or authority under the patentee. *Whittemore* v. *Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813. *Kneass* v. *Schuylkill Bank*, 4 Wash., 11.—WASHINGTON, J.; Pa., 1820. *Pennock* v. *Dialogue*, 2 Pet., 23.—STORY, J.; Sup. Ct., 1828.

Where a defence is made that the patentee is not the original discoverer of the thing patented, the patent will be considered as relating back to the original discovery. Construing §§ 1 and 6 together, the patentee's right does not date from the time of his application for a patent, but from the time of his discovery. *Dixon* v. *Moyer*, 4 Wash., 72.—WASHINGTON, J.; Pa., 1821.

It is a question for the jury whether the specification contains the whole truth relative to the discovery; and, if not, whether it has been concealed with a view to deceive. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

(*b*) Under this section a defect or concealment in a specification, in order to make the patent invalid, must appear to have been made for the purpose of deceiving the public. *Whitney* v. *Carter*, Fessenden on Pat., 2d ed., 139.—JOHNSON, J.; Geo., 1809. *Park* v. *Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813. *Whittemore* v. *Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813. *Gray* v. *James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817. *Lowell* v. *Lewis*, 1 Mas., 189.—STORY, J.; Mass., 1817.

Under this section, if the thing had been in use or known anterior to the patentee's supposed discovery, his patent is void. Though the patentee had no knowledge of such previous discovery, still his patent is void, as the law supposes he may have known it. *Evans* v. *Eaton*, 3 Wheat., 514.—MARSHALL, Ch. J.; Sup. Ct., 1818.

The use of a machine, to test its value, as a cracker machine to the extent of half a barrel of flour, held to amount to a using of it within the meaning of this section. *Watson* v. *Bladen*, 4 Wash., 583.—WASHINGTON, J.; Pa., 1826.

If a defendant seeks to annul a patent, he must proceed in precise conformity with § 6 of the act of 1793, and "fraudulent intent" must be found by the jury to justify a judgment of vacatur by the court. This section does not control the 3d. *Grant* v. *Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832.

This section only declares the defences available against a patentee; but no process or means are given by it for the examination of a patent, however false and fraudulent it may be, if the patentee will forbear to bring suit against those using it. *Delano* v. *Scott*, Gilpin, 499.—HOPKINSON, J.; Pa., 1834.

The Circuit Court, in a civil suit, cannot declare a patent void except for the causes specified in this section. If the patent is defective for any other cause, the verdict must be general for the defendant. *Whitney* v. *Emmett*, Bald., 321.—BALDWIN, J.; Pa., 1831.

Under this section, the Circuit Courts of the United States have exclusive jurisdiction in suits where the patent may be declared void. *Parsons* v. *Barnard*, 7 John.,

or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

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

SECTION 8. *And be it further enacted*, That the persons, whose applications for patents, were, at the time of passing this act, depending before the Secretary of State, Secretary at War, and Attorney General, according to the act passed the second session of the first Congress, intituled "*An act to promote the progress of useful arts*," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

SECTION 9. *And be it further enacted*, That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State in writing, and subscribed by them, or any two of them, shall be final, as far as respects the granting of the patent: And if either of the applicants shall refuse or fail to chuse an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose. (*a*)

SECTION 10. *And be it further enacted*, That upon oath or affirmation being made before the judge of the District Court, where the patentee, his executors, administrators, or assigns reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said District

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144.—CURIAM; N. Y., 1810. *Wilson* v. *Woodworth*, 8 Paige, 134.—WALWORTH, Chan.; N. Y., 1840.

See also notes to act of 1836, § 15, and DIGEST, title GENERAL ISSUE.

(*a*) An inventor filed a description of his alleged invention in 1802, as required by § 3 of the act of 1793, and took no further step until 1814, when another person made application for a patent for the same invention; *Held*, that there was no limitation of time within which a patent must be taken out after specification filed, and that the facts made a case of interference, to be arbitrated under this section. *Anon.*, 5 Opin., 701.—RUSH, Atty. Gen.; 1814.

The refusal of a defendant to submit his claim to arbitration under this section, and his subsequently obtaining a patent therefor, is not conclusive evidence, in a proceeding under § 10, that such patent was obtained surreptitiously. *Stearnes* v. *Barrett*, 1 Mas., 174.—STORY, J.; Mass., 1816.

Court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law. (*a*)

SECTION 11. *And be it further enacted*, That every inventor, before he presents his petition to the Secretary of State, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the Secretary of State, when he presents his petition; and the money thus paid, shall be in full for the sundry services to be performed in the office of the Secretary of State, consequent on such petition, and shall pass to the account of clerk-hire in that office. *Provided nevertheless*, That for every copy, which may be required at the said office, (*b*) of any paper respecting any patent that has been granted, the person, obtaining such copy, shall pay, at the rate of twenty cents, for every copy-sheet of one hundred words, and for every copy of a drawing, the party obtaining the

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(*a*) The jurisdiction given to the District Court, under this section, applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestion, or by some wilful misrepresentation and deception. *Delano* v. *Scott*, Gilpin, 493.—HOPKINSON, J.; Pa., 1834.

The summary proceeding under this section, is given to protect the public from manifest fraud, in taking out patents (the fees of office being no check), for known and common things. *Ibid.*, 494.

It gives the power to any person to call upon a patentee for an examination of his right, and have it repealed, if it shall be found that he is not entitled to it. *Ibid.*, 500.

Proceedings under this section, upon the rule *nisi*, are not conclusive. The process awarded, upon making the rule absolute, is in the nature of a *scire facias*, and is not final. *Stearnes* v. *Barrett*, 1 Mas., 165.—STORY, J.; Mass., 1816; *Wood & Brundage*, *Ex parte*, 9 Wheat., 615.—STORY, J.; Sup. Ct., 1824; *Delano* v. *Scott*, Gilpin, 499.—HOPKINSON, J.; Pa., 1834. CONTRA, *McGaw* v. *Bryan*, 1 U. S. Law Jour., 98.—VAN NESS, J.; N. Y., 1822.

In proceedings under this section, the United States will not be substituted as plaintiffs, in place of the patentee. *Wood* v. *Williams*, Gilpin, 520, 524.—HOPKINSON, J.; Pa., 1834.

(*b*) A defendant, being permitted under § 6 of the act of 1793, to set up the defence that the plaintiff's specification does not contain the whole truth, he has, under this section, a right to call for and have a copy of the plaintiff's specification, and no conditions can be imposed upon the use of such copy. *Anon.*, 1 Opin., 376.—WIRT, Atty. Gen.; 1820.

The proviso to this section cannot be considered as opening to all persons, indiscriminately, the right to demand copies of papers respecting patents granted to others.

same, shall pay two dollars; of which payments, an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

SECTION 12. *And be it further enacted*, That the act, passed the tenth day of April, in the year one thousand seven hundred and ninety, intitnled "An act to promote the progress of useful arts," be, and the same is hereby repealed. *Provided always*, That nothing contained in this act, shall be construed to invalidate any patent that may have been granted under the authority of the said act; and all patentees under the said act, their executors, administrators, and assigns, shall be considered within the purview of this act, in respect to the violation of their rights; provided such violations shall be committed after the passing of this act.

Approved February 21st, 1793.

Repealed by act of 1836, § 21.

## ACT OF 1794, CHAPTER 58.

(1 STAT. AT LARGE, 393.)

An Act supplementary to the act intituled "An Act to promote the progress of useful arts."

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all suits, actions, process and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An Act to promote the progress of useful arts," which may have been set aside, suspended or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation, in which they may have been, when they were so set aside, suspended or abated; and that the parties to the said suits, actions, process or proceedings, be, and are hereby entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place. *Provided always*, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding, as is used in other cases for compelling the appearance of a party.

Approved June 7th, 1794.

Repealed by Act of 1836, § 21.

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As to others than a defendant, as provided for in § 6, it rests in the discretion of the department whether copies shall be furnished or refused. *Anon.*, 1 Opin., 718.—WIRT, Atty. Gen.; 1825.

# ACT OF 1800, CHAPTER 25.

(2 STAT. AT LARGE, 37.)

**An Act to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees.**

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all and singular the rights and privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries and improvements, by the act intituled "An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby are extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed, by such persons, in as full and ample manner, and under the same conditions, limitations and restrictions, as by the said act is provided and directed in the case of citizens of the United States. *Provided always*, That every person petitioning for a patent for any invention, art or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art or discovery, which it shall afterward appear had been known or used previous to such application for a patent shall be utterly void (*a*).

SECTION 2. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery or improvement on account of

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(*a*) Under this act a foreigner, though having resided within the United States for more than two years, could not have a patent for an invention operated by him in another country before he came here, as he could not take the oath required by this statute. *Duplat's Case*, 1 Opin., 332.—WIRT, Atty. Gen.; 1820.

By the provisions of this act, taken in connection with those of the act of 1793, citizens and aliens are placed substantially upon the same ground as to a right to a patent when the invention has been known or used before it was patented. In both cases the right is to be tested by the same rule. *Shaw* v. *Cooper*, 7 Pet., 316.—MCLEAN, J.; Sup. Ct., 1833.

Where a person made an invention in England, in 1813 or 1814, and before coming to this country made known his invention to others, and shortly after coming here disclosed it, in 1817, to an individual here, and in 1817 or 1818 the invention was sold in England, and soon after went into use there and in France, and subsequently, in 1822, the inventor took out a patent here; *Held*, that there had been such a public use of the invention, without an assertion of right on the part of the inventor, as rendered the patent void. *Ibid.*, 318–323.

which a patent might, by virtue of this or the above mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations and restrictions, as the same was held, or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

SECTION 3. *And be it further enacted*, That where any patent shall be, or shall have been granted pursuant to this or the above-mentioned act, and any person without the consent of the patentee, his or her executors, administrators or assigns first obtained in writing, shall make, devise, use, or sell (*a*) the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum equal to three times the actual damage (*b*) sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offence, which sum shall and may be recovered by action (*c*) on the

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(*a*) This section gives an action against any one who shall "make, devise, use, *or* sell," the thing patented, and takes the place of § 5 of the act of 1793, which gave an action against any one who should "make, devise, and use, or sell." This change was made because of some doubt whether the language of § 5 of the act of 1793 did not couple the making and *using* together to constitute an offence, so that making without using, or using without making, was not an infringement. *Whittemore* v. *Cutter*, 1 Gall., 432.—STORY, J.; Mass., 1813.

The doubt which arose under § 5 of the act of 1793, whether any person would be subject to the penalty therein mentioned, for *using* a machine which he had not also *made*, and devised, is removed by this section, which repeals § 5 of the act of 1793, and subjects to damages any person who shall "make, devise, use, or sell," the thing patented. *Evans* v. *Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

Under this section the sale, under execution, of the *materials* of patented articles is not such a sale as makes the sheriff liable to an infringement. *Sawin* v. *Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

(*b*) Under this section the jury find single damages, and the court treble them in awarding judgment. *Lowell* v. *Lewis*, 1 Mas., 185.—STORY, J.; Mass., 1817.

Under this section, if the jury find for the plaintiff, they are to find the actual damages sustained by him. The court will treble them. *Gray* v. *James*, Pet., C. C., 403.—WASHINGTON, J.; Pa., 1817. *Evans* v. *Hettick*, 3 Wash., 422.—WASHINGTON, J.; Pa., 1818.

This section fixed the amount of the recovery at three times the actual damage sustained. Trebling the damages, under the act of 1836, rests with the discretion of the court. *Guyon* v. *Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

(*c*) This section gave jurisdiction only in actions *on the case; Held*, therefore, that a suit in equity, respecting a patent, in order to be cognizable by the Circuit Courts, must come within the provisions of the judiciary act of 1789, as to citizenship of parties, and that where the parties were all residents of the same state, such courts had

case founded on this and the above-mentioned act, in the circuit court of the United States, having jurisdiction thereof. (*a*)

SECTION 4. *And be it further enacted*, That the fifth section of the above-mentioned act, intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be and hereby is repealed.

Approved April 17th, 1800.

## ACT OF 1819. CHAP. 19.

(3 STAT. AT LARGE, 481.)

An Act to extend the jurisdiction of the circuit courts of the United States to cases arising under the law relating to patents:

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the circuit courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided, however*, That from all judgments and decrees of any circuit courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such circuit courts. (*a*)

Approved February 15th, 1819.

Repealed by act of 1836, § 21.

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not jurisdiction. *Livingston* v. *Van Ingen*, 1 Paine, 48, 54.—LIVINGSTON, J.; N. Y., 1811.

This defect was afterward remedied by the act of 1819, Chap. 19.

(*d*) Under this act, and the act of 1793, the Circuit Courts of the United States alone have jurisdiction of actions brought for damages, for an infringement of a patent. *Burrall* v. *Jewett*, 2 Paige, 145.—WALWORTH, Chan.; N. Y., 1830.

(*a*) This act removed the defect that existed under the act of 1800, by which the Circuit Courts did not have jurisdiction of suits in equity, except in actions on the case. *Livingston* v. *Van Ingen*, 1 Paine, 54 (note).—LIVINGSTON, J.; N. Y., 1811.

This act does not enlarge or alter the powers of the court over the subject matter of the cause of action. It only extends its jurisdiction to parties not before falling within it. It removed the objection, that prior to it, 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, and gave the jurisdiction, although the parties were citizens

# ACT OF 1832, CHAP. 162.

(4 STAT. AT LARGE, 559.)

An Act concerning patents for useful inventions.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

SECTION 2. *And be it further enacted*, That application to Congress to prolong or renew the term of a patent, shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the state or territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom. (*a*)

SECTION 3. *And be it further enacted*, That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-

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of the same state. *Sullivan* v. *Redfield*, 1 Paine, 447, 448.—THOMPSON, J.; N. Y., 1825.

This act extends the jurisdiction of the Circuit Courts to all cases at law and in equity, arising under the patent laws; but there is nothing in the act which, either in terms or by necessary implication, renders that jurisdiction exclusive. *Burrall* v. *Jewett*, 2 Paige, 145.—WALWORTH, Chan.; N. Y., 1830.

Though the substance of this enactment, so far as it relates to the subject of patent rights, is incorporated into § 17 of the act of 1836, and is no longer in force, *proprio vigore*, yet so far as it gave cognizance to the courts of the United States of cases of copyrights, it still remains in force, and is the only law conferring equitable jurisdiction on these courts in such cases. *Stevens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup Ct., 1854.

(*a*) Under the patent laws, prior to 1836, if a patent was renewed, it was a new grant, independent of the old, and the patentee was entitled to the sole and exclusive

first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided, however*, That such new patent, so granted, shall, in all respects, be liable to the same matters of objection and defence as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid. (*a*)

Approved July 3d, 1832.

Repealed by act of 1836, § 21.

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benefit thereof, unless the licensees or assignees had, by their original grant, secured to themselves by express covenant or grant, a right to the benefit of the renewed patent. *Washburn* v. *Gould*, 3 Story, 135.—STORY, J.; Mass., 1844.

Prior to this statute, the only mode of prolonging the term of a patent beyond the original grant, was by means of private acts of Congress upon individual applications. *Wilson* v. *Rosseau*, 4 How., 685.—NELSON, J.; Sup. Ct., 1845.

(*a*) The provision of this section is susceptible of but one construction, and that is, that the patentee may sustain an action for any use or violation of his invention, after the grant of the new patent. No prior use of a defective patent can authorize the use of the invention after the emanation of the renewed patent. *Stimpson* v. *Westchester R. R.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

To give to the patentee the fruits of his invention was its object, which would be defeated, if a right could be founded on a use subsequent to the original patent, and prior to the renewed one. *Ibid.*, 402.

The proviso of this section is in affirmance of the principles laid down by the Supreme Court in *Pennock* v. *Dialogue*, 2 Pet., 1 (1829); in *Grant* v. *Raymond*, 6 Pet., 241–245 (1832); and in *Shaw* v. *Cooper*, 7 Pet., 314, 315 (1833).—*McClurg* v. *Kingsland*, 1 How., 207.—BALDWIN, J.; Sup. Ct., 1843.

As the exception in the proviso is limited to the use of the invention under a special license after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in *Pennock* v. *Dialogue*, 2 Pet., 1; whereby the patent would become void. *Ibid.*, 207.

# ACT OF 1832, CHAPTER 203.

(4 STAT. AT LARGE, 577.)

An Act concerning the issuing of patents to aliens, for useful discoveries and inventions.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended, in like manner, to every alien, who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided*, That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same for any period of six months after such introduction shall not continue to be publicly used and applied in the United States, or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

Approved July 13th, 1832.

Repealed by act of 1836, § 21.

# ACT OF 1836, CHAPTER 357.

(5 STAT. AT LARGE, 117.)

An Act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose. (*a*)

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be estab-

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(*a*) POLICY OF THE PATENT LAWS.

Many of the provisions of our patent acts are derived from the principles and practice which have prevailed in England. And though the known and settled construction of the English statute of Monopolies, by their courts of law, has not been received by our courts with all the weight of authority, yet the construction that statute by the English courts, and the principles and practice which have regulated the grants of English patents, afford materials to illustrate our statute. *Pennock* v. *Dialogue*, 2 Pet., 18.—STORY, J.; Sup. Ct., 1829.

The intention of the patent laws is to promote the progress of the useful arts, by the benefits *granted to inventors*, not by those accruing to the public, after the patent has expired, as in England. Intended for their benefit and security, the law should be construed favorably and beneficially in favor of patentees. *Whitney* v. *Emmett*, Bald, 321–323.—BALDWIN, J.; Pa., 1831.

The settled purpose of the United States has ever been to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public from the exertions of the individual, and is intended as a stimulus to those exertions. The laws passed for such purpose should be construed in the spirit in which they have been passed, and should be fairly executed by the United States. *Grant* v. *Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

The great object and intention of the patent acts is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to those discoveries, by the exclusive right to make, use and sell the thing discovered for a limited time. *Ibid.*, 243.

Patents are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor, as *strictissimi juris*. *Ames* v. *Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

lished and attached to the Department of State an office to be denominated the Patent Office, the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and cus-

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The Constitution of the United States, in giving authority to Congress to grant patents for a limited period, declares the object to be to promote the progress of science and the useful arts, an object as truly national and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any overnice and critical refinements. *Ibid.*, 485.

Under the laws of the United States, patents for inventions are to be treated as a just reward to ingenious men, and as highly beneficial to the public. They are therefore clearly entitled to a liberal construction, since they are not granted as restrictions upon the rights of the community, but "to promote science and the useful arts." *Blanchard* v. *Sprague*, 3 Sumn., 539, 540.—STORY, J.; Mass., 1839.

The patent law gives to inventors a monopoly, but not in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefits. To secure to inventors the remuneration for their time, ingenuity, and expense, a liberal construction should be given to the law. *Brooks* v. *Bicknell*, 3 McLean, 437.—MCLEAN, J.; Ohio, 1844. *Parker* v. *Haworth*, 4 McLean, 372.—MCLEAN, J.; Ill., 1848. *Parker* v. *Stiles*, 5 McLean, 54, 56.—LEAVITT, J.; Ohio, 1849. *Bloomer* v. *Stanley*, 5 McLean, 162.—MCLEAN, J.; Ohio, 1850. *Parker* v. *Sears*, MS.—GRIER, J.; Pa., 1850. *Goodyear* v. *Railroads*, 2 Wall., Jr., 363.—GRIER, J.; N. J., 1853. *Allen* v. *Hunter*, 6 McLean, 306.—MCLEAN, J.; Ohio, 1855.

The patent laws are not made to encourage monopolies of what before belonged to others, or to the public—which is the true idea of a monopoly—but the design is to encourage genius in advancing the arts, through science and ingenuity, by protecting its productions of what did not before exist, and of what never belonged to another person, or the public. *Davoll* v. *Brown*, 1 Wood. & Min., 57.—WOODBURY, J.; Mass., 1845.

The patent acts have been passed for the promotion of the useful arts—for the ultimate benefit of the republic, and not for the sole benefit of inventors and patentees. It is for the ultimate benefit of the public, that privileges are granted to inventors, allowed to operate, and protected for limited times for their direct benefits. *Day* v. *Union Rub. Co.*, 3 Blatchf., 500.—HALL, J.; N. Y., 1856.

The power granted by the patent laws is domestic in its character, and necessarily confined within the limits of the United States. The patent acts do not and were not intended to operate beyond the limits of the United States, and the patentee's right of property and exclusive use cannot extend beyond the limits to which the law itself is confined. *Brown* v. *Duchesne*, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.

The limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large, was another and doubtless the primary object in granting and securing that monopoly. *Kendall* v. *Winsor*, 21 How., 327, 328.—DANIEL, J.; Sup. Ct., 1858.

tody of all the books, records, papers, models, machines, and all other things belonging to said office. (*a*) And said Commissioner shall receive the same compensation (*b*) as is allowed by law to the Commissioner of the Indian Department, (*c*) and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

SECTION 2. *And be it further enacted*, That there shall be, in said office, an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, (*d*) and to be called the Chief Clerk of the Patent Office; who, in all cases during the necessary absence of the Commissioner, or when the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner during such vacancy. (*e*) And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks, at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk, at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger, at seven hundred dollars. (*f*) And said Commissioner, clerks,

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This was at once the equivalent given by the public for benefits bestowed by the genius, and meditations, and skill of individuals, and the incentive to further efforts for the same important objects. *Ibid.*, 328.

See also DIGEST, titles PATENT, P. 1; STATUTES, B. 2.

(*a*) The Patent Office is now attached to the Department of the Interior, and the Secretary of the Interior performs all the duties connected therewith formerly devolving upon the Secretary of State. Act of 1849, § 2.

(*b*) Salary fixed at $4,500 by act of 1861, § 4.

(*c*) The franking privilege was annulled by the "Act to reduce the rates of postage," approved March 3d, 1845; but was again restored by the "Act to establish certain post routes, and for other purposes," approved March 3d, 1847; and also by the patent act of 1848, § 4.

(*d*) Salary increased to $2,500 by act of 1861, § 4.

(*e*) A patent is not invalid because it is certified by a person as "*acting*" Commissioner, instead of being certified by the Commissioner himself. *Wilson* v. *Rosseau*, 4 How., 663, 668.—NELSON, J.; Sup. Ct., 1845.

The certificate to a patent, made by a person as "acting Commissioner," is legal and sufficient. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846. *York & Md. R. R.* v. *Winans*, 17 How., 41.—CAMPBELL, J.; Sup. Ct., 1854.

The appointment of an acting Commissioner will be presumed to have been duly made, where drawn in question, incidentally or collaterally, if it be shown that the person certifying is in the public discharge of those duties. *Woodworth* v. *Hall*, 1 Wood. & Min., 255.—WOODBURY, J.; Mass., 1846.

Under this section the chief clerk has been considered as the "acting Commissioner," whenever the Commissioner has been unable to discharge his duties from any necessary cause, as well as when a vacancy occurs from death or resignation. *S. C.*, 392.—WOODBURY, J.; Mass., 1846.

See also DIGEST, title COMMISSIONER OF PATENTS, G.

(*f*) As to the appointment of additional examiners, see act of 1837, § 11; act of 1839, § 1; act of 1856, §§ 9, 10; and act of 1860, § 5.

and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

SECTION 3. *And be it further enacted*, That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon the duties of his office or appointment, make oath or affirmation truly and faithfully to execute the trust committed to him. And the said Commissioner and the Chief Clerk shall also, before entering upon their duties, severally give bonds, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

SECTION 4. *And be it further enacted*, That the said Commissioner shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings, belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant, under the signature of the Chief Clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. (*a*) And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office (*b*), on paying, for the

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The Commissioner of Patents is now authorized to appoint additional examiners, not exceeding four in each class, by the act of 1861, § 7.

(*a*) A certified copy of an assignment is competent evidence, and the party cannot be required to produce the originals. *Brooks* v. *Bicknell*, 3 McLean, 436.—McLEAN, J.; Ohio, 1844.

Certified copies of papers and drawings, on file in the Patent Office, must be received in evidence when offered. If they are discordant, they may destroy the effect of each other; but they need not concur in every particular. *Emerson* v. *Hogg*, 2 Blatchf., 12.—BETTS, J.; N. Y., 1845.

Certified copies of papers in the Patent Office are *prima facie* evidence of the genuineness of the original, on file, and absolute evidence of the correctness of the copies from the records. *Parker* v. *Haworth*, 4 McLean, 371.—McLEAN, J.; Ill., 1848.

A certified copy of an assignment of a patent, from the Patent Office, is *prima facie* evidence of the genuineness of the original. *Lee* v. *Blandy*, MS.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

A former and defective certified copy of a patent may be corrected by a full and corrected certified copy. *Brooks* v. *Bicknell*, 3 McLean, 434.—McLEAN, J.; Ohio, 1844. *Woodworth* v. *Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

(*b*) The Commissioner of Patents having under his care and custody the records as to patents, it is his duty to give authenticated copies to any person demanding the same, on payment of the legal fees: but a demand accompanied by rudeness and in-

written copies, the sum of ten cents for every page of one hundred words; and for copies of drawings, the reasonable expense of making the same. (*a*)

SECTION 5. *And be it further enacted*, That all patents issued from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the Secretary of State; (*b*) and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, (*c*) and in its terms grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, (*d*) the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery, referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery. (*e*)

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sult is not a legal demand. *Boyden* v. *Burke*, 14 How., 583.—GRIER, J.; Sup. Ct., 1852.

The officer intrusted to give copies of papers or drawings, in patent cases, has no concern with the purpose for which asked. The policy of the law rather requires than forbids that copies should be given when asked for. *Anon.*, 1 Opin., 171.—PINCKNEY, Atty. Gen.; 1812.

(*a*) Copies of papers cannot be taken by third persons. They must be made by the proper officer, and the fees paid therefor. *Anon.*, 2 Opin., 456.—TANEY, Atty. Gen.; 1831.

See also DIGEST, title COPIES OF PAPERS.

(*b*) Now signed by the Secretary of the Interior.

(*c*) Under the patent laws since 1836, the specification is always annexed to and forms a part of the letters patent. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Mass., 1843.

The phraseology of this act, in respect to what the patent shall contain, was changed from that contained in the acts of 1790 and 1793, in order to conform to the usage and construction under the act of 1793 (of inserting the whole descriptive portion of the petition in the patent), as such course sometimes was misunderstood, and led to misconstructions. *Hogg* v. *Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

(*d*) The term of the patent is now extended to seventeen years. Act of 1861, § 16.

A patent may be issued for a less term of years than fourteen. The restriction is on the *maximum* only, not on the *minimum*. *Sullivan's Case*, Opin., Gilpin's Ed., 1841, 168.—WIRT, Atty. Gen.; 1818.

A patentee under this section is not obliged to claim the whole fourteen years. He may waive his claim to a part of the term, in favor of the public, by antedating it, or he may take a patent for a term less than fourteen years, or he may seek protection against strangers for six months previous to the issue, if in that time he has made application and is seeking in good faith and with reasonable diligence to perfect his specifications. *Cushman, Ex parte*. MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.

(*e*) The exclusive grant of a patent is the construction and use of the thing patented. The patent law protects the thing patented, and not the product. *Boyd* v. *Brown*, 3 McLean, 297.—MCLEAN, J.; Ohio, 1843.

It does not cover the products of the patented machine. *Ibid.*, 297. *Simpson* v.

ACT OF 1836, CHAP. 357, § 6.

SECTION 6. *And be it further enacted*, That any person or persons, having discovered or invented any new and useful art, (*a*) machine, (*b*) manufacture, or

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*Wilson*, 4 How., 711.—NELSON, J.; Sup. Ct., 1845. *Goodyear* v. *The Railroads*, 2 Wall., Jr.—GRIER, J.; N. J., 1853.

At common law, an inventor has no exclusive right to make and vend his invention, after he has published it to the world. Such exclusive right is the creature of the statute, which also prescribes the remedy for its violation. *Dudley* v. *Mayhew*, 3 Coms., 13–17.—STRONG, J.; N. Y., 1849.

The fact that a party has a patent, giving him the exclusive right to make, use, and sell a particular medicine, does not confer upon him the right to practise as a physician, and use such medicine in any particular state, except in conformity with the laws of such state. *Jordan* v. *Overseers of Poor*, 4 Ohio, 310.—LANE, J.; Ohio, 1831. *Thompson* v. *Staats*, 15 Wend., 395.—NELSON, J.; N. Y., 1836.

A party has not necessarily a right to use an invention, in any state, merely because he has a patent for it under the United States. *Vannoni* v. *Paine*, 1 Harrington, 68. —ROBINSON, J.; Del., 1833.

Where V. had a patent for a plan for constructing and drawing lotteries, and had obtained a patent therefor, but there was a state law prohibiting lotteries, except under certain conditions, which the plaintiff and his associates had not complied with, *Held*, that V. was not entitled to any relief, by way of injunction or otherwise, for any alleged use of his invention in the state. *Ibid.*, 69.

The Commissioner of Patents, in issuing letters patent, does not warrant the same, nor does the patent bind the government more than it does private persons; but the validity of such patent is open to inquiry, either in whole or in part, whether at the instance of private persons or of the government. A patent does not conclude any body. *Morton's Anæsthetic Patent*, 8 Opin., 276.—CUSHING, Atty. Gen.; 1856.

Letters patent issue subject to all legal objections that may be brought against them. *Shreeve* v. *United States*, MS.—LORING, J.; Ct. Claims, 1859.

As to what is embraced in the "letters patent," see DIGEST, title PATENT, E.

See also DIGEST, title PATENT, D. 1.

(*a*) When art is spoken of as the subject of a patent, it is not an art in the abstract, but it is an art as explained in the specification, and illustrated by a machine, or model, or drawings, when of a character so to be. It means a useful art or manufacture, which must be described with exactness in its mode of operation, and which can be protected only in the mode and to the extent described. *Smith* v. *Downing*, MS.—WOODBURY, J.; Mass., 1850.

In the English patent laws the word "art" is not used at all. In ours, as well as in our constitution, the word art means a useful art, or a manufacture which is beneficial. *Ibid.*

A process, *eo nomine*, is not the subject of a patent, under our laws. It is included under the general term "useful art," and an art may require one or more processes or machines, in order to produce a certain result or manufacture. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

See also DIGEST, titles ART; PROCESS.

(*b*) 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. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

A patent cannot be for the function or abstract effect of a machine, but only for the machine itself. *Ibid.*, 268.

A new process is usually the result of discovery; a machine of invention. *Ibid.*, 268.

One may discover an improvement in a process, irrespective of any particular form of machinery: and another may invent a labor-saving machine, by which the

composition of matter, (*a*) or any new and useful improvement (*b*) on any art, machine, manufacture, or composition of matter, not known or used by others (*c*) before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance,

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operation or process may be performed, and each may be entitled to a patent. *Ibid.*, 268.

The word "machine" in the statute includes new combinations as well as new organizations of mechanism. *Wintermute* v. *Redington*, MS.—WILSON, J.; Ohio, 1856.

See also DIGEST, title MACHINES, A.

(*a*) It is not necessary that every ingredient, or that any one ingredient used by the patentee in his invention, should be new or unused before, for the purpose intended. The true question is whether the combination of materials used by the patentee is substantially new. *Ryan* v. *Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839.

There is a wide difference between the invention of a new method or process, by which a known fabric, product, or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance, or manufacture, having qualities never found to exist together in any other material. *Goodyear* v. *The Railroads*, 2 Wall., Jr., 360.—GRIER, J.; N. J., 1853.

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. *Ibid.*, 361.

If a patentee be the inventor or discoverer of a new manufacture or composition of matter, not known or used by others before his discovery thereof, 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. *Ibid.*, 362.

It is no ground, for the rejection of an application for a patent for a composition of matter, that the thing invented is an imitation of a real existing substance or material—as an artificial honey. If the artificial is a good and wholesome substitute for the real, and can be made and supplied at a cheaper rate, there is no good reason why it should not be deemed a new and useful invention. *Corbin & Martlett, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

See also DIGEST, titles COMPOSITION OF MATTER; MANUFACTURE, ARTICLE OF.

(*b*) An "improved machine," and "an improvement on a machine," are substantially the same. *Barrett* v. *Hall*, 1 Mas., 476.—STORY, J.; Mass., 1818. *Evans* v. *Eaton*, 3 Wheat., 517.—MARSHALL, Ch. J.; Sup. Ct., 1818.

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*, MS.—WILKINS, J.; Mich., 1857.

See also DIGEST, title IMPROVEMENTS.

(*c*) The words "by others," in this section, were probably added by way of explanation of the doubt formerly entertained on the subject, whether a use by the patentee himself of his invention before application, would deprive him of a right to a patent; and to confirm the decision in *Pennock* v. *Dialogue*, 2 Pet., 18–22, that a prior use, to invalidate a patent, must have been by others than the inventor. *Reed* v. *Cutter*, 1 Story, 597.—STORY, J.; Mass., 1841.

Such words do not denote a plurality of persons by whom the use should be known, but that the use should be known by some other person or persons than the patentee. *Ibid.*, 597, 598.

The words "not known or used," are qualified by § 15, and mean a knowledge or use existing in a manner accessible to the public. *Gayler* v. *Wilder*, 10 How., 497.—TANEY, Ch. J., Sup. Ct., 1850.

as the inventor or discoverer; (*a*) and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; (*b*) and in case of any machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from

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As to priority of invention, see also DIGEST, title INVENTION, C.; originality and priority of, and PRIOR KNOWLEDGE.

(*a*) Under the constitution and laws of the United States respecting patents, *discovery* is synonymous with *invention*. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

An invention resting in mere theory, or in intellectual notion, or imperfect experiments, and not reduced to practice, is not patentable. *Reed* v. *Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

Conceiving the idea of an improvement or machine is not invention. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

As to what is invention see DIGEST, title INVENTION, A., and the several titles, ART; COMPOSITION OF MATTER, A.; COMBINATION; DISCOVERY; IMPROVEMENTS, A.; MACHINES, A.; MANUFACTURE, ARTICLE OF; NEW APPLICATION; PRINCIPLE.

(*b*) The description should be accommodated to the comprehension of any practical mechanic, without taxing his genius or inventive powers. *Gray* v. *James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817.

No description will fulfil the demands of the law but such as is of record, and of which all the world may have the benefit. *Dixon* v. *Moyer*, 4 Wash., 73.—WASHINGTON, J.; Pa., 1821.

The object of this provision is twofold: 1, that when the term has expired, and the invention becomes public property, such means of information may be accessible through the Patent Office as will enable others to avail themselves of its benefits; and 2, that while the patent is in force, others may be informed of the precise claim of the patentee, and not ignorantly infringe his exclusive right. *Parker* v. *Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849. *Brooks* v. *Bicknell*, 3 McLean, 441.—MCLEAN, J.; Ohio, 1844. *Judson* v. *Moore*, MS.—LEAVITT, J.; Ohio, 1860.

But the specification need not particularly describe the operation of mechanism which is well known by persons acquainted with the art. *Kneass* v. *Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820. *Brooks* v. *Bicknell*, 3 McLean, 447, 448.—McLEAN, J.; Ohio, 1844. *Emerson* v. *Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

It is not enough, however, if, from the description, some very skilful artisan could make and use it, but persons of ordinary skill must be able to do so; and must be able not only to construct but to use the machine for a useful purpose. *Lippincott* v *Kelly*, 1 West. Law Jour., 514.—IRVIN, J.; Pa., 1844.

See also DIGEST, titles COMPOSITION OF MATTER, B.; SPECIFICATION, B.; how invention should be set forth, IMPROVEMENT, B.

other inventions; (*a*) and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. (*b*) He shall, furthermore, accompany the whole with a drawing, or drawings (*c*) and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. (*d*) The applicant shall also make oath or affirmation (*e*) that he does verily believe that he is the original and first inventor or discoverer of the

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(*a*) This section seems clearly to show that a patentee may lawfully unite in one patent all the modes of applying his invention contemplated, and all the different sorts or modifications of machinery, by which it may be applied, and if each were new the patent would cover them all. *Wyeth* v. *Stone*, 1 Story, 292.—STORY, J.; Mass., 1840.

It is the duty of an inventor to describe in his specification the several different modes or devices or modifications known to him of his invention. *Sargent* v. *Carter*, 11 *Mo. Law Rep.*, *655*.—CURTIS, J.; *Mass.*, *1858*.

See also DIGEST, title MACHINES, B.

(*b*) The summing up or claim is conclusive upon the right and title of the patentee. *Wyeth* v. *Stone*, 1 Story, 285.—STORY, J.; Mass., 1840.

The claim is the most material part of the invention. *Many* v. *Jagger*, 1 Blatchf., 378.—NELSON, J.; N. Y., 1848.

Although a patentee does not expressly claim equivalents, he is understood to embrace them, and in contemplation does embrace them. *Byam* v. *Farr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

See also DIGEST, title PATENTS, P. 5.

(*c*) Drawings annexed, and referred to in the specification, constitute a part thereof; and they may be resorted to to aid the description, and to distinguish the thing patented from other things known before. *Earle* v. *Sawyer*, 4 Mas., 9.—STORY, J.; Mass., 1825.

References to the drawings in the specification are not requisite to the validity of a patent, unless they are necessary to an understanding of the invention. *Brooks* v. *Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843. *Washburn* v. *Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

The description of a machine or improvement, accompanied by a drawing, may, in many cases, be understood without references. *Ibid.*, 262.

The drawings may be signed by the inventor, or by his attorney for him. *Anon.*, MS.—BLACK, Atty. Gen.; 1859.

See also DIGEST, title DRAWINGS; and act of 1837, § 6, and notes.

(*d*) Models and drawings are a part of the letters patent, and may be resorted to for clearer information respecting the invention described in the specification. *Hogg* v. *Emerson*, 6 How., 485.—WOODBURY, J.; Sup. Ct., 1847. *Stephens* v. *Salisbury*, MS. —MORSELL, J.; D. C., 1855.

See also DIGEST, title MODELS.

(*e*) The taking of the oath by the inventor is but a prerequisite to the granting of a patent, and in no degree essential to its validity. If, therefore, not conformable to

art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths. (*a*)

SECTION 7. *And be it further enacted*, That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made, an examination (*b*) of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, (*c*) if the

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the statute it is no objection to the patent. *Whittemore* v. *Cutter*, 1 Gall., 433.—STORY, J.; Mass., 1813.

The oath extends to all the schedule or specification no less than to the title of the invention. *Hogg* v. *Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

The declaration admitted under the English law cannot be substituted in place of the oath. *Anon.*, 3 Opin., 532.—GILPIN, Atty. Gen.; 1840.

Affirmation may be substituted in place of an oath, when the person of whom it is required is conscientiously scrupulous of taking an oath. Act of 1837, § 13.

As to the persons before whom the oath may be taken, when the applicant is not, for the time being, residing in the United States. Act of 1842, § 4.

See also DIGEST, title OATH.

(*a*) The act of 1836, §§ 6, 15, and the act of 1837, § 9, are to be construed, as to originality of invention, as though they were embodied in one act. *Smith* v. *Ely*, 5 McLean, 84.—MCLEAN, J.; Ohio, 1849.

The things specified in this section are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent may show that they have not been complied with, and in that mode defeat the action of the supposed inventor. *Ransom* v. *Mayor, &c., of New York*, MS.—HALL, J.; N. Y., 1856.

(*b*) The proceedings before the Commissioner are initiatory—all relating to the question whether a patent shall issue. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J., D. C., 1847. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

See also DIGEST, title APPLICATION FOR PATENT, A.

(*c*) An inventor will not be deprived of the benefit of his invention and a right to a patent, by a use of his invention before his application for a patent, without his consent and against his will, and without any *laches* or misconduct on his part. *Pierson* v. *Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844. *Fry & Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

The provisions of §§ 7 and 15 of the act of 1836, introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad—that is, a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty. Gen.; 1848.

If the applicant is an original inventor, and in a condition to make the oath

Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. (*a*) But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any

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required, the act requires the Commissioner to issue the patent, and the courts declare it valid, and establish the American right to the exclusion of the foreign discovery, which has not, in either of the modes indicated by the act of Congress, been communicated to the public. *Ibid.* Also *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

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. *Parkurst* v. *Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849. *Howe* v. *Underwood*, MS.—SPRAGUE, J.; Mass., 1854. *Allen* v. *Hunter*, 6 McLean, 321.—McLEAN, J.; Ohio, 1855. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, MS.—INGERSOLL, J.; N. Y., 1858. *Ellithorpe* v. *Robertson*, MS.—INGERSOLL, J.; N. Y., 1859.

The words "prior to the application," refer only to the "public use or sale of the invention with the applicant's consent or allowance," and do not refer to any thing else. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

The words "prior to the alleged invention of the applicant," refer to an invention or discovery of some one, other than the applicant, in this country, and also to a patent or description in this or some foreign country. *Ibid.*

The true meaning of this section is, that a patent shall issue to the applicant and be valid, if he is the originator and author of a useful invention, unless the thing invented by him has, prior to his alleged invention or discovery, been invented, or discovered, or used by some one else in this country; or unless the invention of the applicant has been patented or described in some printed publication in this or some foreign country, prior to the alleged invention or discovery of the applicant; or has been on sale with the applicant's consent, prior to his application for a patent. *Ibid.*

See also DIGEST, titles PRIOR KNOWLEDGE; PRIOR USE.

(*a*) The Commissioner is bound to issue a patent in the case and under the circumstances mentioned in this section. He has no discretion about it. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C. 1841. *Aiken, Ex parte* (*Car-Wheels*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

When a patent has issued, the jurisdiction of the Commissioner is exhausted, and he has no further control over it, except under § 13, upon application for a reissue. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

But his power exists in full force until the patent actually issues, and is not controlled by intervening opinions in proceedings during the examination. *Wade* v. *Matthews*, MS., 5 Opin., 222.—JOHNSON, Atty. Gen.; 1849.

See also DIGEST, title APPLICATION FOR PATENTS, B.

As to the utility of an invention, all that the law requires is, that the invention should not be frivolous or injurious. The word *useful* is used in contradistinction to mischievous or immoral. Whether the invention be more or less useful is unimportant. *Lowell* v. *Lewis*, 1 Mas., 186.—STORY, J.; Mass., 1817. *Bedford* v. *Hunt*, 1 Mas., 303.—STORY, J.; Mass., 1817. *Earle* v. *Sawyer*, 4 Mas., 6.—STORY, J.; Mass., 1825. *Whitney* v. *Emmett*, Bald., 309.—BALDWIN, J.; Pa., 1831. *Winans* v. *Schnec. & Troy R. R.*, 2 Blatchf., 290.—NELSON, J.; N. Y., 1851. *Page* v. *Ferry*, MS.—WILKINS, J.; Mich., 1857. *Leach, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

The invention need not be the best for the use to which it can be applied. *Many* v. *Jagger*. 1 Blatchf., 381.—NELSON, J.; N. Y., 1848. *Roberts* v. *Ward*, 4 McLean,

printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. (*a*) In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. (*b*) But if the applicant in such case, shall persist in his claims for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, (*c*) in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, (*d*) to be

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566.—McLean, J.; Mich., 1849. *Wilbur* v. *Beecher*, 2 Blatchf., 137.—Nelson, J.; N. Y., 1850.

See also Digest, title Invention, D. 1.

(*a*) The inventor must be the original inventor as to all the world, to be entitled to a patent. *Reutgen* v. *Kanowrs*, 1 Wash., 188.—Washington, J.; Pa., 1804. *Dawson* v. *Follen*, 2 Wash., 311.—Washington, J.; Pa., 1808. *Lowell* v. *Lewis*, 1 Mas., 190.—Story, J.; Mass., 1817.

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 use, is entitled to a patent. *Reed* v. *Cutter*, 1 Story, 596, 598.—Story, J.; Mass., 1841.

A subsequent inventor, though an original one, is not entitled to a patent. *Ibid.*, 596–598.

The invention must be original with the inventor, and not known to others. The only exception exists in the case of a party obtaining a patent, believing himself to be the original inventor, and his invention is shown to have been *known* in a *foreign* country, but not patented there, or described in any printed publication. *Parker* v. *Stiles*, 5 McLean, 61.—McLean, J.; Ohio, 1849.

See also Digest, title Inventor, B.; Invention, C.

(*b*) An original application or specification cannot be amended, to conform the specification to the alterations suggested by the Commissioner, except under this section. *Dyson, Ex parte*. MS. (App. Cas.)—Dunlop, J.; D. C., 1860.

(*c*) Right of withdrawal extended to foreigners by act of 1837, § 12.

Right of withdrawal, as to applications made after March 2d, 1861, abolished by act of 1861, § 9.

As to the effect of a withdrawal, see Digest, title Application for Patents, C.

(*d*) The renewal oath required by this section, is required only when the applicant persists in his application, after having been informed of the defects of his specification. If the rejection is final, though upon a first examination, no new oath is necessary to enable him to appeal. *Crooker, Ex parte*, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1850.

(*e*) Board of Examiners abolished, and an appeal given to the chief-justice of the Circuit Court of the District of Columbia, by the act of 1839, § 11, and to either of the assistant justices of such court by act of 1852, § 1.

composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, (*a*) as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided, however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; (*b*) and if either shall be dissatisfied with the decision of the Commissioner

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(*a*) An appeal lies under this section to an applicant, upon the refusal of a patent to him when there is no opposing party. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

There is nothing in the act of 1839 which takes away, or impairs such right. *Ibid.*

There is no limitation of time as to an appeal from the decision of the Commissioner of Patents. *Janney, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

As to right of appeal, duties of Commissioner of Patents in cases of, &c., see DIGEST, title APPEALS, B.

See also notes to § 8 of this act, and notes to § 11 of the act of 1839.

(*b*) The Commissioner has authority to permit one of two competing applicants for a patent for a similar invention to withdraw his application, after decision upon an interference, and refile his application, and to declare a second interference between such last application and the competing one. *Wade* v. *Matthews*, 5 Opin., 224.—JOHNSON, Atty. Gen.; 1849.

on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. (*a*) But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months

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The interference mentioned in this section must be an interference in respect to patentable matters, and the claims of the applicants must be limited to the matters specifically set forth as their respective inventions; and what is not claimed is to be considered, for the purpose of such interference as disclaimed. A patentable improvement is not an interference. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

There can be no interference between applications, unless there is a substantial identity of the things for which a patent is sought. *Tyson* v. *Rankin*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

A second interference is only a rehearing of the same case. *Eames* v. *Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

The proceedings in contested cases in the Patent Office have no resemblance to trials at law. *Spear* v. *Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

An interference may be declared between a pending application and an application for a reissue of an existing patent, but the omission to do so at that time does not take away the right of the Patent Office to declare such an interference subsequently. *Hicks* v. *Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

See also DIGEST, title INTERFERENCE.

(*a*) The scope of this section is broad enough to include the question of *interference* as well as that of *priority*, if it should arise, on an appeal to the judge. The question of priority necessarily includes that of interference. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

An appeal is given by § 7 to an applicant where there is no opposing party; and by this section where there are interfering applications; and there is nothing in the repealing act of 1839 which takes away or impairs such right. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

Under this section no appeal can be taken from the decision of the Commissioner of Patents, unless the *application* for a patent is rejected. In no case can an appeal be taken to the granting of a patent. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

A patentee therefore has no right of appeal from the decision of the Commissioner granting a patent to another person, an applicant, in an interference between such applicant and patentee. *Ibid.*

The word "either" in this section—when speaking of the parties who may appeal—applies to the words "such applicants," *i. e.*, *either of such applicants.* This construction is sustained by the language below authorizing the judge, on appeal, "to determine which or whether *either of the applicants* is entitled to *receive* a patent as *prayed* for. *Ibid.*

This decision was followed in *Whipple* v. *Renton*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854. *Hopkins* v. *Barnum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859. *Kingsley* v. *Herriet*, MS. (App. Cas.)—MORSELL, J.; D. C. (and see over), 1854. *Drake* v. *Cunningham*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

next preceding the filing of his specification and drawings. (*a*) And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

SECTION 9. *And be it further enacted*, That before any application for a patent shall be considered by the Commissioner as aforesaid, the applicant shall pay into the Treasury of the United States, or into the Patent Office, or into any of the deposit banks, (*b*) to the credit of the Treasury, if he be a citizen of the United States, or an alien, and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention to become a citizen thereof, the sum of thirty dollars; if a subject of the king of Great Britain, the sum of five hundred dollars; and all other persons the sum of three hundred dollars; (*c*) for which payment duplicate receipts shall be taken, one of which to be filed in the office of the Treasurer. And the moneys received into the Treasury under this act shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office, and to be called the Patent Fund.

SECTION 10. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtain-

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In a later case, it was held that a patentee has equal right of appeal from a decision of the Commissioner of Patents in favor of an applicant, and granting him a patent, that an applicant has from a decision in favor of a prior patentee, and refusing the applicant a patent. *Babcock* v. *Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

This decision was followed in *Spear* v. *Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859; and *Beech* v. *Tucker*. MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

The right of appeal is now considered as established in accordance with these later decisions.

As to the requisites of the reasons of appeal, and the jurisdiction of the justices of the Circuit Court on appeal, and the effect of their decisions, see notes to § 11 of the act of 1839. See also DIGEST, title APPEALS, B.

(*a*) The provisions of this section, and of § 6, of the act of 1839, as to the obtaining of patents after foreign patents have been secured, and as to the date of the home patent in such case, relates only to such patents as are *applied for* here *after* the issue of the foreign patent. *French* v. *Rogers*, MS.—KANE, J.; PA., 1851.

(*b*) As to what officers' patent fees may now be paid, see § 15 of the act of 1846.

(*c*) By a subsequent statute, all laws fixing the rates of the Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are repealed, and a uniform rate of fees established for all. Act of 1861, § 10.

ing such patent shall devolve on the executor or administrator of such person, in trust for the heirs-at-law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or *might have been claimed or enjoyed by such person in his or her lifetime*; (*a*) and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

SECTION 11. *And be it further enacted*, That every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use (*b*) the thing patented within and throughout any specified part

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(*a*) Under this section, if an inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such persons in trust for the heirs at law or devisees of the inventor. *Stimpson* v. *Rogers*, 3 or 4 Blatchf.—INGERSOLL, J.; Ct., 1859.

It need not, however, be expressed in the patent, that it is issued to such executor *in trust* for those entitled to it. It will be sufficient that the patent set forth that it was issued to the grantee as executor. What the executor does in relation to the property of the devisor, he does in trust for those to whom such property is given by the will. *Ibid.*

(*b*) This section provides for but three kinds of assignments: 1st. As to the whole interest: 2d. As to an undivided part: and, 3d. An exclusive right in any district. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 339.—GRIER, J.; Pa., 1849. *Potter* v. *Holland*, MS.—INGERSOLL, J.; Ct., 1858.

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 country. *Washburn* v. *Gould*, 3 Story, 131.—STORY, J.; Mass., 1844.

The monopoly is capable of subdivision as to locality, and in no other way. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849. *Whittemore* v. *Cutter*, 1 Gall., 431.—STORY, J.; Mass., 1813. *Brooks* v. *Byam*, 2 Story, 525, 552.—STORY, J.; Mass., 1843. *Saydam* v. *Day*, 2 Blatchf., 23.—NELSON, J.; N. Y., 1846. *Ritter* v. *Serrell*, 2 Blatchf., 383.—BETTS, J.; N. Y., 1852. *Washing Mach. Co.* v. *Earle*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

An assignment of a patent may be made as well before the issuing of the patent as afterward. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates. And when the party has acquired an inchoate right, an assignment of it is legal. *Gayler* v. *Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850. *Rathbone* v. *Orr*, 5 McLean, 131, 132.—MCLEAN, J.; Mich., 1850. *Rich* v. *Lippincott*, 26 Jour. Fr. Inst., 3d Ser., 13.—GRIER, J.; Pa., 1853.

Future improvements may be sold, as well as those already made; and to include a second as well as a first patent. *Nesmith* v. *Calvert*, 1 Wood. & Min., 41.—WOODBURY, J.; Mass., 1845.

The inchoate right of an inventor to a renewal is the subject of sale. *Clum* v. *Brewer*, 2 Curt., 520.—CURTIS, J.; Mass., 1855.

One tenant in common has as good right to use and sell to others to use, the thing

or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof, (*a*) for which the assignee or grantee shall pay to the Commissioner the sum of three dollars.

SECTION 12. *And be it further enacted*, That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, (*b*) file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention; (*c*) which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secresy. And if application shall be made

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patented, as the other tenant in common has; and neither can restrain the other from such use or sale. *Ibid.*, 524.

A paper purporting to be an assignment of an expired patent is void. *Bell* v. *McCullogh*, MS.—LEAVITT, J.; Ohio, 1858.

(*a*) The provision as to recording assignments within three months is merely directory, and except as to intermediate *bona fide* purchasers, without notice, any subsequent recording is sufficient. *Brooks* v. *Byam*, 2 Story, 542.—STORY, J.; Mass., 1843. *Pitts* v. *Whitman*, 2 Story, 615.—STORY, J.; Mass., 1843. *Blanch. Gunstock Fac.* v. *Warner*, 1 Blatchf., 271.—NELSON, J.; Ct., 1846. *Holden* v. *Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

A mere license need not be recorded—it is not an exclusive right. *Brooks* v. *Byam*, 2 Story, 542, 543.—STORY, J.; Mass., 1843. *Stevens* v. *Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

Under this section an assignment must be recorded within three months to defeat the right of a subsequent purchaser without notice, and for a valuable consideration. 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. Within that period he must protect himself in the best way he can, as an unrecorded assignment would prevail; but it must be one in writing, that may be recorded. *Gibson* v. *Cook*, 2 Blatchf., 148.—NELSON, J.; N. Y., 1850.

See also DIGEST, titles ASSIGNMENT, B. 2; LICENSE, B.

(*b*) The fee required on filing a caveat is now reduced to ten dollars, and such sum is no longer to be considered as a part of the sum required to be paid on filing a subsequent application for a patent for the same invention. Act of 1861, §§ 9, 10.

(*c*) This section is for the benefit of the inventor, but is not necessary for the preservation of his right, nor does the omission to file a caveat impair his title. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

It only enables him to have notice of any interfering application. It, however, gives no notice to the world, nor even to the interfering applicant, and is notice to the Commissioner only. *Ibid.*

The caveat is to set forth the "design and purpose" of the invention, and "its principal and distinguishing characteristics;" but it is not necessary that it should explain the principle involved, or the modes in which it can be applied, nor how it is distin-

by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposite the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application, (*a*) who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of the Commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: *Provided, however*, That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

SECTION 13. *And be it further enacted*, That whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had or shall have a right to claim as new; if the error has, or shall have arisen by inadvertency, accident, or mistake, and without any fraudu-

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guished from other inventions. Nor is it necessary to accompany it with specimens of ingredients or compounds, or models or drawings, or with an oath of invention or discovery. *Anon.*, MS., Opin.—BLACK, Atty. Gen.; 1857.

The Commissioner can perform no act upon it, but filing it, nor in consequence of it, except to give the caveator notice of a conflicting application. *Ibid.*

A caveat answers a double purpose: 1st, to give notice of the claim of the inventor; and 2d, to prevent a patent issuing to another for the same thing. *Allen* v. *Hunter*, 6 McLean, 304.—MCLEAN, J.; Ohio, 1855.

A caveat is evidence as to an invention, so far as it extends to the *description* of the invention and the machinery which was then constructed. *Jones* v. *Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

A caveat is not conclusive evidence that an invention is not perfected. *Johnson* v. *Root*, MS.—SPRAGUE, J.; Mass., 1858.

A caveat will directly protect only one of several distinct patentable subjects falling within its general scope, at the election of the party inventing them. *Woodruff & Cobb, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

(*a*) The fact that a patent is granted to one person, while another has a caveat pending and in force, will not of itself vacate the patent granted, nor authorize the Commissioner to grant a patent to the caveator. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

The purpose of a caveat is to save the discoverer of an invention from the effect of the rule of law that gives to the inventor who first adapts his invention to practical use the right to the grant of a patent; and if the Commissioner gives the caveator notice of any interfering application, it secures him against the effect of the rule. *Phelps, Dodge & Co.* v. *Brown Bros.*, 18 How. Pr., 7.—NELSON, J.; N. Y., 1859.

But if the Commissioner accidentally omits to give the caveator the notice required, his rights will not be prejudiced thereby. *Ibid.*

See also DIGEST, title CAVEAT.

lent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. (*a*) And in case of his death, or any assignment by him made

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(*a*) This section contemplates two classes of cases, where a patent is *invalid or inoperative;* 1st, by reason of a defective or insufficient specification; and 2d, where the same objection arises because the patentee has claimed more than he had a right to claim. *Goodyear* v. *Day*, MS.—DICKERSON, J.; N. J., 1852.

This section may be regarded as affirming the propriety of the usage which had obtained under the former laws, and under which a second reissue was allowed as well as the first. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851.

There may be more than one reissue of the same patent. The surrender and reissue should be allowed to follow each other as often as the inventor is content to be more specific or more modest in his claims. *Ibid.* Also *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

The power to correct mistakes in a patent is confided to the Commissioner of Patents under this section, and does not belong to the courts. The courts can only construe the specification and claim as it stands. *Kittle* v. *Merriam*, 2 Curt., 478.—CURTIS, J.; Mass., 1855.

This section gives to the patentee the right to correct his description or specification, when its imperfection has arisen from inadvertency, accident, or mistake. But the only condition on which this can be done, is that the original patent is *inoperative* or invalid by reason of a failure to comply with the requirements of the statutes. The proceeding is therefore equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling a patentee to an action for its infringement. *Morfit* v. *Gaab*, MS.—LEAVITT, J.; Ohio, 1860.

The words in this section, "it shall be *lawful* for the Commissioner, &c., to cause a new patent to be issued," are to be construed as *mandatory*, and to be of the same import as if the words had been, "it *shall be the duty* of the Commissioner," &c. The true meaning is, the Commissioner is to have no discretion in the case provided for in the section. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

When the case provided for arises, he is *commanded* to exercise the power, whether he thinks it just and right to exercise it or not; he has no discretion. *Ibid.*

The surrender and reissue of a patent extended by act of Congress, after an extension, under § 18 of the act of 1836, stands on the same footing as if such surrender and reissue were made under the extension by virtue of said § 18. *Gibson* v. *Harris*, 1 Blatchf., 169, 170.—NELSON, J.; N. Y., 1846.

It is not the meaning of this section that the patentee, in his reissue, must describe and claim in his new specification, either in words or idea, just what he described and claimed in his old one; but his specification must be of the same invention, and he cannot embrace a different subject matter than that he sought to patent originally. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851. *Battin* v. *Taggert*, 17 How., 83.—MCLEAN, J.; Sup. Ct., 1854.

Upon an application for a reissue, the applicant is not necessarily confined to the original *record*, *i. e.*, the patent and specification, but the original model may be referred to as evidence of the then invention. *Ball, Ex parte*, MS. (App. Cas.) *Wilson* v. *Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860. *Dietz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

of the original patent, a similar right shall vest in his executors, administrators, or assignees. (*a*) And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent. (*b*) And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings

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This section does not point to the specification and model as the *sole* means of proof, or to any means of proof. All that it requires is, that the reissue should be for the *same invention* originally intended to be patented. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

What the legislature designed to secure to patentees by this section was to enable them to cure *honest mistakes*, and to get *substantial protection for the same invention* they had made and *intended* to be patented when the original patent was granted. The only limitation in the statute is, that the invention shall be the same. *Ibid.*

Any legal proof to show it to be the same invention, whether found in the record or *aliunde*, ought to be received. No authority is given to the Patent Office to limit the range of proof. It is open to the patentee to offer any *sufficient legal* proof, record or otherwise. *Ibid.*

Fee on reissue now thirty dollars. Act of 1861, § 10.

See also DIGEST, title REISSUE OF PATENT, B., C.

(*a*) Under this section the power to surrender a patent and take out a renewa thereof, is vested exclusively in the patentee, his executors, administrators, or assigns and there is nothing restricting such right because of special or limited grants or licenses previously made. *Smith* v. *Mercer*, 4 West. Law Jour., 52.—KANE, J.; Pa., 1846.

By this section the sole right to surrender is given, 1st, to the patentee, if he is alive and has made no assignment of the original patent; 2d, to the executors and administrators of the patentee, after his decease, where there has been no such assignment; and 3d, to the assignee, where there has been an assignment of the original patent. The right to surrender is given to no one else. *Potter* v. *Holland*, MS.—INGERSOLL, J.; Ct., 1858.

Where, however, there has been an assignment of an undivided part of the whole patent, in such case the assignee and patentee become joint owners, and should join in the surrender; and if they do not it will be invalid, unless the part owner not joining shall ratify it. *Ibid.*

A licensee has no authority to make a surrender, and one made without his consent is valid. But such a licensee may hold under the original or the reissued patent, as he prefers. *Ibid.*

There may be a claim of right in an invention, under one or the old patent, for one section of the country, and a different claim of right, under the reissued patent, for the same invention, for another section of country. *Ibid.*

See also DIGEST, title REISSUE OF PATENT, A.

(*b*) Under this section the second patent, with corrected specifications, has relation back to the emanation of the first patent, as fully for every legal purpose as to causes subsequently accruing, as if the second patent had been issued at the date of the first one. *Stanley* v. *Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839.

being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as hereinbefore provided, have the same annexed to the original description and specification; and the Commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall hereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification. (*a*)

SECTION 14. *And be it further enacted*, That whenever, in any action for damages for making, using, or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case, with costs; (*b*) and such damages may be recovered by action on the case, in any

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A reissued patent is only a continuation of the original one. *Ames* v. *Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833. *Stanley* v. *Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839. *Woodworth* v. *Hall*, 1 Wood. & Min., 257.—WOODBURY, J.; Mass., 1846.

The rights of the patentee are to be ascertained by the law under which the original application was made. *Shaw* v. *Cooper*, 7 Pet., 315.—MCLEAN, J.; Sup. Ct., 1833.

A patentee cannot by a surrender affect the rights of third persons to whom he had previously conveyed an interest. *Woodworth* v. *Stone*, 3 Story, 750.—STORY, J.; Mass., 1845. *McBurney* v. *Goodyear*, 11 Cush., 370.—MERRICK, J.; Mass., 1853.

The grant of an amended patent is conclusive as to the existence of the facts necessary for a reissue; unless it is patent there is a clear excess of authority, or there has been fraud. *Allen* v. *Blunt*, 3 Story, 745.—STORY, J.; Mass., 1845. *S. C.*, 2 Wood. & Min., 139.—WOODBURY, J.; Mass., 1846. *Battin* v. *Taggart*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854.

(*a*) Under this section an improvement may be annexed to the specification of the original patent, so as to make it form a part of the original patent; but there is nothing that forbids an inventor taking out a new patent for the improvement, if he prefers it. *O'Reilly* v. *Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

Nor is he bound in his new patent to refer specially to his former one. *Ibid.*, 122.

The provision of this section authorizing additions to patents for improvements, is now repealed, and patents of additions are no more granted. Act of 1861, § 9.

(*b*) The patent act of 1790, § 4, made the infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, § 5, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. The act of 1800 provided that an infringer should pay three times the actual damages sustained. *Seymour* v. *McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

This section confines the jury to the actual damages sustained by the patentee. The power to increase them as punitive damages is committed to the discretion and judgment of the court. *Ibid.*, 488.

*Actual damages*, according to this section, are the amount fixed by the verdict. *Stephens* v. *Felt*, 2 Blatchf., 38.—BETTS, J.; N. Y., 1846.

But such term cannot be construed to mean exemplary, vindictive, or punitory

court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States. (*a*)

SECTION 15. *And be it further enacted*, That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence, (*b*) of which notice in writing may have been given to the

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damages, inflicted by way of smart money. *Stimpson* v. *Railroads*, 1 Wall., Jr., 169. —GRIER, J.; Pa., 1847. *Buck* v. *Hermance*, 1 Blatchf., 406.—NELSON, J.; N. Y., 1849. *Pitts* v. *Hall*, 2 Blatchf., 238.—NELSON, J.; N. Y., 1851.

Damages are only to be compensatory: the criterion is indemnity. *Parker* v. *Hulme*, 7 West. Law Jour., 428.—KANE, J.; Pa., 1849.

Damages cannot include counsel fees, in addition to the taxable costs. *Stimpson* v *Railroads*, 1 Wall., Jr., 166, 169.—GRIER, J.; Pa., 1847. *Blanch. Gun-Stock Fac.* v. *Warner*, 1 Blatchf., 272.—NELSON, J.; Ct., 1846. *Parker* v. *Hulme*, 7 West. Law Jour., 429.—KANE, J.; Pa. 1849. *Teese* v. *Huntington*, 23 How., 8.—CLIFFORD, J.; Sup. Ct., 1859.

It rests with the discretion of the court whether the damages shall be trebled. Previous to 1836, the court was compelled to treble them. *Guyon* v. *Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847. *Stimpson* v. *Railroads*, 1 Wall., Jr., 166.—GRIER, J.; Pa., 1847.

The court may increase the damages though the plaintiff is not entitled to costs, for neglect of filing a disclaimer, as required by § 9 of the act of 1837. *Guyon* v. *Serrell*, 1 Blatchf., 246.—NELSON, J.; N. Y., 1847.

The object of this section, as to trebling damages, is to remunerate patentees, who were compelled to sustain their patents against wanton and persistent infringers. *Seymour* v. *McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853. *Bell* v. *McCulloch*, MS.—LEAVITT, J.; Ohio, 1858.

See also DIGEST, titles DAMAGES; INFRINGEMENT.

(*a*) The word "assignees" in this section, is to be construed by reference to § 11, of the same act, as meaning the assignees of a whole interest, or an undivided one, or an exclusive local right. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849. *Suydam* v. *Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

To enable an assignee to sue in his own name, he must have the exclusive right, or entire, or unqualified monopoly, which the patentee had, excluding the patentee himself as well as others. *Gayler* v. *Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850.

The assignees of an exclusive right in a patent, are the proper persons to maintain an action for a violation of it. *Washburn* v. *Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1846.

The grantee of an exclusive right under a patent, even though such right is limited to a particular number of machines, may maintain an action for infringement. *Wilson* v. *Rousseau*, 4 How., 686, 688.—NELSON, J.; Sup. Ct., 1845.

Under this section, in connection with § 11, an action is given only to such party —composed of one or more persons—as possesses the whole interest in the patent. *Suydam* v. *Day*, 2 Blatchf., 23 —NELSON, BETTS, JJ.; N. Y., 1846.

Where a party has an interest in only a part of a patent, as a license to use the invention, he cannot maintain an action for an infringement. *Ibid.*, 23.

Under this section, an action is properly brought in the name of a patentee, in behalf of a licensee who is damaged by an infringement. *Goodyear* v. *McBurney*, 3 or 4 Blatchf.—NELSON, J.; N. Y., 1853.

(*b*) The defendant need not plead the general issue, and give notice of the special

plaintiff or his attorney, thirty days before trial, (*a*) tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, (*b*) or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, (*c*) or that it had been described in some public work anterior to the supposed discovery thereof by the patentee, (*d*) or had been in public use or on sale with the con

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matter. He may plead specially, and then the plea is the only notice. *Evans* v. *Eaton*, 3 Wheat., 504.—MARSHALL, Ch. J.; Sup. Ct., 1818. *Grant* v. *Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832. *Phillips* v. *Combstock*, 4 McLean, 525.—McLEAN, J.; Ind., 1849. *Smith* v. *Ely*, 15 How., 141.—TANEY, Ch. J.; Sup. Ct., 1853. *Day* v. *N. E. Car-Spring Co.*, 3 or 4 Blatchf.—BETTS, J.; N. Y., 1854. CONTRA, *Wilder* v. *Gayler*, 1 Blatchf., 598.—NELSON, J.; N. Y., 1850; but this case overruled by the last.

But where notice of special matter is given under the general issue, special pleas containing the same matters cannot be filed. *Wilder* v. *Gayler*, 1 Blatchf., 597.—NELSON, J.; N. Y., 1850. *Brunswick* v. *Holzalb*, MS.—LEAVITT, J.; Ohio, 1858.

The right to plead the general issue and give notice, is an enlargement of the defendant's mode of defence, but does not take away his right to plead specially. *Phillips* v. *Combstock*, 4 McLean, 525.—McLEAN, J.; Ind., 1849.

(*a*) No order of court is necessary to entitle a defendant to file and serve notice of special matter. It is only necessary that it be in writing and be served thirty days before the trial. *Teese* v. *Huntington*, 23 How., 10.—CLIFFORD, J.; Sup. Ct., 1859.

If a first notice is defective or not sufficiently comprehensive, other notices may be given to remedy the defect or supply the deficiency. *Ibid.*, 10.

Under such notice, depositions taken before it was served, as well as those taken afterward, are admissible. *Ibid.*, 10.

Notices may be served in term time, but must be thirty days before trial. *Latta* v. *Shawk*, MS.—LEAVITT, J.; Ohio, 1859.

(*b*) A defect or concealment is not fatal, unless made with an intention to deceive. *Whittemore* v. *Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813. *Gray* v. *James*, Pet., C. C., 409.—WASHINGTON, J.; Pa., 1817. *Lowell* v. *Lewis*, 1 Mas., 188, 189.—STORY, J.; Mass., 1817.

The question as to the materiality of the thing concealed is, could an artist, after the expiration of the patent, construct a machine by looking at the specification. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

(*c*) The defence "that the patentee was not the original and first inventor or discoverer of the thing patented," is complete without showing that the first inventor had put his invention in practice. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

No person who is not at once the first and original inventor, is entitled to a patent. A subsequent inventor, though an original one, is not. *Reed* v. *Cutter*, 1 Story, 596.—STORY, J.; Mass., 1841.

See also DIGEST, title INVENTOR, B.

(*d*) The description in a public work must be sufficiently full and precise to enable a mechanic to construct the machine, and must be in all material respects like that covered by the plaintiff's patent. *Parker* v. *Stiles*, 5 McLean, 61.—McLEAN, J.; Ohio, 1849.

sent and allowance of the patentee before his application for a patent, (*a*) or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same; (*b*) or that the patentee, if an alien at the time the patent was granted, had failed and neglected for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reason-

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The publication may be proved as to its contents, and the fact of publication by the production of the book, or by parol testimony. *Allen* v. *Hunter*, 6 McLean, 314.—McLEAN, J.; Ohio, 1855.

The publication must have been prior to the *time of invention*. It is not sufficient that it was prior to the time of *application* for a patent. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N.Y., 1859. *Allen* v. *Hunter*, 6 McLean, 314.—McLEAN, J.; Ohio, 1855.

To render admissible in evidence a printed publication it is not necessary to make proof of the date of its publication. A book purporting on its title-page to be published in [illegible] year will be received without proof that it was then published. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

A book of plates without any letter press cannot be admitted in evidence. *Semble*, that it is not a "printed publication." *Ibid.*

Where reference is made to a public work, it should be to the particular part of the work intended to be relied upon. A reference merely to the title of the work is not sufficient. *Foote* v. *Silsby*, 1 Blatchf., 454, 462.—CONKLING, NELSON, JJ.; N. Y., 1849. *Silsby* v. *Foote*, 14 How., 222.—CURTIS, J.; Sup. Ct.; 1852.

See also DIGEST, title PUBLIC WORK.

(*a*) The public use or sale, to defeat the inventor of a right to a patent, must be a public use or sale by others with his knowledge and consent before his application for a patent. *Ryan* v. *Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839. *Wyeth* v. *Stone*, 1 Story, 281.—STORY, J.; Mass., 1840. *Gayler* v. *Wilder*, 10 How., 496, 498.—TANEY, Ch. J.; Sup. Ct., 1850. *Pitts* v. *Hall*, 2 Blatchf., 235, 236.—NELSON, J.; N. Y., 1851. *Hunt* v. *Howe*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

A use with the inventor's knowledge or consent, or experimental to ascertain its value, utility, or success, or a use intermediate the application and grant, will not be sufficient. *Ryan* v. *Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839. *Wyeth* v. *Stone*, 1 Story, 281.—STORY, J.; Mass., 1840. *Pierson* v. *Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 322.—NELSON, J.; N. Y., 1855.

The right to use an invention for two years before application for a patent, is conferred by the act of 1839, § 7.

See also DIGEST, titles ABANDONMENT, A.; PUBLIC USE.

(*b*) An inventor who has first actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at the time using due diligence in adapting and perfecting his invention. *Reed* v. *Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

But the first inventor has the prior right if he is using due diligence, even though another may have first perfected the invention. *Ibid.*, 600.

The clause using "reasonable diligence in adapting and perfecting" an invention is applicable only to the case of a defence that the plaintiff's patent had been surreptitiously or unjustly obtained; and if pleaded, it may be necessary for the defendant to show, in order to vacate the patent, that he was using due diligence when the patent was obtained. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

The words "unless such person was using reasonable diligence in adapting and perfecting the same," constitute a *qualification* of the preceding language of the section, so

able terms, the invention or discovery for which the patent issued; (*a*) in either of which cases judgment shall be rendered for the defendant with costs. And whenever the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used. (*b*) *Provided, however*, That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that

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that an inventor who has actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was *in fact invented* by another, *unless the latter* was at the time *using reasonable diligence* in adapting and perfecting the same. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

The defence that the patentee had "surreptitiously and unjustly obtained a patent for that which was in fact invented or discovered by another, who was using reasonable diligence in perfecting and adapting the same," does not necessarily imply bad faith on the part of the patentee against whose patent this defence is set up. The words were intended to be used, and are used, in their broadest sense. *Phelps, Dodge & Co.* v. *Brown Bros.*, 18 How. Pr.—NELSON, J.; N. Y., 1859.

If a person does not use due diligence in perfecting his invention after he has conceived the idea, and another conceives the idea and perfects it, and applies it to use, the latter will be considered the first inventor, and a patent granted the former will be void. *Ransom* v. *Mayor, &c., of New York*, MS.—HALL, J.; N. Y., 1856.

(*a*) An alien patentee must put and continue on sale his invention within eighteen months from the date of his patent. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

The assignees of an alien patentee take only the right of their assignors; and such assignees, under this section, must put the invention on sale within eighteen months from the time of issuing the patent. *Tatham* v. *Loring*, 5 N. Y. Leg. Obs., 208.—STORY, J.; Mass., 1845.

CONTRA, That such assignees take their patent with all the privileges of American citizens. The alien clause in this section does not apply to such assignees. *Tatham* v. *Lowber*, 2 Blatchf., 50, 51.—NELSON, J.; N. Y., 1847.

But it is not necessary that an alien patentee, or his assignee, should take active measures for putting his patented invention in the market, and forcing a sale, but only that he should at all times be ready to sell at a fair price when a reasonable offer is made. *Tatham* v. *Le Roy*, MS., NELSON, J.; N. Y., 1849.

(*b*) The provision in this section, requiring notice of prior knowledge and use, was intended to guard against surprise from such evidence as was given in Whitney's case. Though his invention was one of undoubted originality, two persons were brought forward, one of whom testified that he had seen such an invention in England seventeen years before, and the other that he had seen one in Ireland. *Wilton* v. *Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847.

The provision of the statute requiring notice of the previous use, is designed to give the patentee the benefit of examining into the facts of the supposed prior use. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

This section requires only the names and residences of the persons who possessed the prior knowledge, and of the places where the invention had been used. The

the same or any substantial part thereof had before been patented or described in any printed publication. (*a*) *And provided, also*, That whenever the plaintiff shall fail to sustain his action on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear

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names and residences of the witnesses need not be given. *Wilton* v. *Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847. *Many* v. *Jagger*, 1 Blatchf., 376.—NELSON, J.; N. Y., 1848.

Notice of the *time* of the prior knowledge or use is not required. *Phillips* v. *Page*, 24 How., 168.—NELSON, J.; Sup. Ct., 1860.

In the seventh circuit, the notice must specify the street or factory where the prior structure was used, or the name of the person or owner using it. The name of the city, or town, or county, is not sufficiently definite as to place. *Latta* v. *Shawk*, MS.—LEAVITT, J.; Ohio, 1859. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

And also, the name of the person by whom the prior knowledge is to be proved. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

See also DIGEST, title GENERAL ISSUE, B.

(*a*) The provision of § 7 and of this section introduced an important modification into the laws of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad, that is a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty. Gen., 1848.

The only exception to the rule that a patentee must be the original and first inventor, exists in the case of a party obtaining a patent, believing himself to be the original inventor, and his invention is shown to have been *known in a foreign country*, but not patented there, or described in a printed publication. *Parker* v. *Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

In determining whether the patentee *believed* himself *to* be the first inventor, the defendant may give evidence that the patentee knew of the existence of the thing abroad; and in considering the fact whether he so *believed* himself to be the first inventor, it is material to determine whether he was in fact the original inventor. *Forbush* v. *Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

A prior use of a thing in a foreign country will not invalidate a patent subsequently taken out here, where the inventor believed himself to be the first inventor, unless the prior invention had been patented, or described in some printed publication. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

Evidence cannot be received of an actual use and knowledge of an invention in a foreign country, prior to the time of the invention here, but the defendants must be confined to the description of the invention as found in printed publications or patents: they cannot go beyond such publications or patents. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

The time referred to in this section by the terms "having been before known and used in any foreign country," or "had been patented or described in any printed publication," is the time when the original discovery or invention of a patentee was made, and not the time when he presented his application for a patent. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

A foreign patent, in order to defeat an American patent for the same invention, must have been before the discovery or invention here: it is not sufficient that it is before the application. *Howe* v. *Morton*, MS.—SPRAGUE, J.; Mass., 1860.

An invention is not "patented" in England within the meaning of this section, until the complete specification has been enrolled—until the invention shall have been made patent to the world, which is usually six months from after the date of the patent. *Ibid.*

that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court, to adjudge and award as to costs as may appear to be just and equitable. (*a*)

SECTION 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, (*b*) on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. (*c*) And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided, however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

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(*a*) The second proviso of this section virtually superseded by the act of 1837, § 9, which see.

(*b*) Or of the chief-justice and assistant justices of the Circuit Court of the District of Columbia, as appeals are now authorized to be taken to them, instead of to the Board of Examiners referrod to in this section. Acts of 1839, § 11, and of 1852, § 1.

The provisions of this section also extended "to all cases where patents are refused for any reason whatever." Act of 1839, § 10.

(*c*) Proceedings, under this section and § 10 of the act of 1839, in equity, against the Commissioner of Patents, to compel him to issue a patent, must be commenced in the Circuit Court of the United States for the District of Columbia, and the Circuit Courts in the various states have no jurisdiction. *Prentiss* v. *Ellsworth*, Mir. Pat. Off., 35, 36.—RANDALL, J.; Pa., 1846.

Upon a bill filed under this section and § 10 of the act of 1839, to declare a patent granted by the Commissioner invalid or inoperative, the hearing is altogether independent of that before the Commissioner, and takes place upon such testimony as the parties may see fit to produce, agreeably to the rules and practice of a court of equity. The evidence before the Commissioner is not evidence in such a suit except by consent of parties; nor are the parties restricted to the testimony used before the Commissioner. Either party is at liberty to introduce additional evidence. *Atkinson* v. *Boardman*, MS.—NELSON, J.; N. Y., 1851.

The assignee of an invention, by virtue of an assignment made before patent issued, may file a bill in his own name under this section and § 10 of the act of 1839, against a patentee to whom a patent issued on the rejection of his assignor's application, for the purpose of annulling the patent so issued, and having one granted to him as assignee. And such assignment need not have been recorded before suit brought; it

ACT OF 1836, CHAP. 357, § 17.

SECTION 17. *And be it further enacted*, That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the power and jurisdiction of a circuit court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: (*a*) *Provided, however*, That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same

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will be sufficient if it is recorded at any time before the issuing of the patent. *Goy* v. *Cornell*, 1 Blatchf., 509, 510.—NELSON, J.; N. Y., 1849.

The Circuit Courts of the United States have exclusive jurisdiction under this section. *Gibson* v. *Woodworth*, 8 Paige, 134.—WALWORTH, Chan.; N. Y., 1840.

(*a*) The jurisdiction conferred upon the Circuit Courts by this section is the same in its nature and extent as the equity jurisdiction in England, from which it is derived. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

Under this section the Circuit Courts have jurisdiction irrespective of the right of the plaintiff to an injunction or a demand for one. *Nevins* v. *Johnson*, 4 Blatchf.—
—NELSON, BETTS, JJ.; N. Y., 1853.

The natural interpretation of the language of this section seems to be, that Congress has bestowed upon this court a common jurisdiction, both on its law and equity sides, over all cases under the patent laws, and that no suit of that character can be maintained at law which may not also be prosecuted in equity. *Ibid.*

Under this section the Circuit Courts of the United States have not only original, but exclusive cognizance of all actions arising under the patent laws. *Dudley* v. *Mayhew*, 3 Coms., 14.—STRONG, J.; N. Y., 1849. *Elmer* v. *Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855. *Parsons* v. *Barnard*, 7 John., 144.—CURIAM; N. Y., 1810.

In cases arising under the patent law, the jurisdiction of the Circuit Courts does not depend upon the citizenship of the parties to the action, or the amount in controversy, but upon the subject matter. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849. *Goodyear* v. *Union Rub. Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

The jurisdiction as to subject matter does not extend to a bill in equity filed for the specific performance of a contract respecting patents. *Nesmith* v. *Calvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845. *Brooks* v. *Stolley*, 3 McLean, 525.—MCLEAN, J.; Ohio, 1845. *Burr* v. *Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

Nor to a suit brought to enforce the covenants of a license granted under a patent. *Goodyear* v. *Union Rub. Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

Section 11 of the judiciary act of 1789 requiring one of the parties, plaintiff or defendant, to be an inhabitant of the state where the suit is brought, does not apply to actions arising under the patent laws. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

To give the courts jurisdiction, the party defendant must be an inhabitant of the district in which the suit is brought, or he must be found within it at the time of the service of the original process. The provisions of § 11 of the act of 1789, in this respect, apply to patent actions. *Day* v. *Newark Ind. Rub. Co.*, 1 Blatchf., 631, 632.—NELSON, J.; N. Y., 1850. *Allen* v. *Blunt*, 1 Blatchf. 486.—NELSON, J.; N. Y., 1849.

manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same. (*a*)

SECTION 18. *And be it further enacted*, That whenever any patentee (*b*) of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; (*c*) and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of

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*Wilson* v. *Sherman*, 1 Blatchf., 541.—NELSON, J.; N. Y., 1850. *Brown* v. *Shannon*, 20 How., 56.—TANEY, Ch. J.; Sup. Ct., 1857. *Chaffee* v. *Hayward*, 20 How., 215.—CATRON, J.; Sup. Ct., 1857.

See also DIGEST, title COURTS, B. 2.

(*a*) Other reasonable cases under this section in which appeals and writs of error may be allowed to the Supreme Court, must be limited to cases which relate to the construction of the patent laws, and such as involve important and not trifling matters connected with those laws, and questions really doubtful. *Allen* v. *Blunt*, 2 Wood. & Min., 157.—WOODBURY, J.; Mass., 1846.

Under this section, if a writ of error is allowed by the court as "reasonable," such writ must bring up the whole case for consideration, and the court below cannot decide as to what particular points shall be taken up. *Hogg* v. *Emerson*, 6 How., 478.—WOODBURY, J.; Sup. Ct., 1847.

The word "reasonable" applies to the cases rather than to any discrimination between the different points in the cases. *Ibid.*, 478.

A judge at chambers may allow a writ of error under this section in the "other cases" referred to, where the judgment is less than $2,000. *Foote* v. *Silsby*, 1 Blatchf., 544.—NELSON, J.; N. Y., 1857.

The "other cases" in this section does not include a suit in equity to set aside an assignment of a patent. *Wilson* v. *Sandford*, 10 How., 101, 102.—TANEY, Ch. J.; Sup. Ct., 1850.

The discretionary power as to granting writs of error in patent cases, vested in the Circuit Courts by this section, is confined to cases which involve the construction of the patent laws, and the rights of patentees under them. *Sizer* v. *Many*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

An appeal or writ of error now lies to the Supreme Court from all judgments and decrees of any Circuit Court rendered in any action arising under the patent laws, without regard to the value or amount in controversy. Act of 1861, chap. 37.

See also DIGEST, titles APPEALS, A.; WRIT OF ERROR.

(*b*) In this section the word *patentee* is used as equivalent to *inventor*. *Woodworth* v. *Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844.

This section authorizes the extension of a patent on the application of an administrator. *Nyman's Case*, 3 Opin., 446.—GRUNDY, Atty. Gen.; 1839. *Van Hook* v. *Scudder* (cited 3 Story, 132), 3 McLean, 438.—THOMPSON, J.; N. Y., 1843. *Brooks* v. *Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843. *Brooks* v. *Bicknell*, 3 McLean, 436.—MCLEAN, J.; Ohio, 1844. *Woodworth* v. *Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844. *Woodworth* v. *Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

And this, though the patentee during his lifetime had disposed of all his interest in the existing patent, and having at the time of his death no interest in it. *Wilson* v. *Rosseau*, 4 How., 675, 686, 688.—NELSON, J.; Sup. Ct., 1845.

See also DIGEST, title EXTENSION OF PATENT, A.

(*c*) The right of renewal is not limited to future patents, but applies to the past,

the treasury, (*a*) as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. (*b*) And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, shall constitute a board (*c*) to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-

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*Woodworth* v. *Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844. *Wilson* v. *Turner*, 7 Law Rep., 529.—TANEY, Ch. J.; Md., 1845.

But this section provides for but one extension. *Gibson* v. *Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

The decision of the Board of Commissioners, under this section, is conclusive within the scope of its authority. *Brooks* v. *Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843. *Wilson* v. *Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845. *Woodworth* v. *Stone*, 3 Story, 753.—STORY, J.; Mass., 1845. *Colt* v. *Young*, 2 Blatchf., 473, 474.—NELSON, J.; N. Y., 1852. *Battin* v. *Taggert*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854. *Clum* v. *Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

See also DIGEST, title EXTENSION OF PATENT, B.

(*a*) The fee is now fifty dollars on the application for an extension, and fifty dollars when the extension is granted. Act of 1861, § 10.

(*b*) The notice of application for an extension is intended to protect the public, and give all an opportunity to appear and oppose. *Gale's Case*, 3 Opin., 594.—GILPIN, Atty. Gen.; 1840.

Application must now be made at least ninety days before the expiration of the patent, and the notice must be published at least sixty days before such expiration. Act of 1861, § 12.

(*c*) Commissioner of Patents substituted for this board by act of 1848, § 1.

one years. (*a*) And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein; (*b*) *Provided, however*, That no extension of a patent shall be granted after the expiration of the term for which it was originally issued. (*c*)

SECTION 19. *And be it further enacted*, That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the

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(*a*) A renewed patent confers the same rights with an original patent. *Evans* v. *Jordan*, 1 Brock., 254.—MARSHALL, Ch. J.; Va., 1813.

After an extension, the original patent becomes one virtually for twenty-one years. *Gibson* v. *Harris*, 1 Blatchf., 169.—NELSON, J.; N. Y., 1846.

If extended again by act of Congress, it becomes one for twenty-eight years. *Woodworth* v. *Edwards*, 3 Wood. & Min., 125.—WOODBURY, J.; Mass., 1847.

Patents may also be extended by act of Congress, after having been once extended. under this section. *Evans* v. *Eaton*, Pet. C. C., 337.—WASHINGTON, J.; Pa., 1816. *Evans* v. *Eaton*, 3 Wheat., 528.—MARSHALL, Ch. J.; Sup. Ct., 1818. *Blanchard* v. *Haynes*, 6 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848. *Bloomer* v. *Stolley*, 5 McLean, 160, 161.—MCLEAN, J.; Ohio, 1850.

See also DIGEST, title EXTENSION OF PATENT, D., E.

(*b*) The object of the clause as to assignees, is to preserve any previous contract of assignment in the sense in which both parties understood and intended it at the time it was made, and to secure to the purchaser the right he had intended to buy, and which the patentee intended to sell. *Wilson* v. *Turner*, 7 Law Rep., 530.—TANEY, Ch. J.; Md., 1845.

The extension of a patent, under this section, does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any exclusive right. But the benefit of such renewal is limited to those who were in the use of the patented article at the time of the renewal, and saves to such persons the right to use the machines held by them at the time of such renewal. *Wilson* v. *Rosseau*, 4 How., 682.—NELSON, J.; Sup. Ct., 1845.

The meaning of the words "thing patented," in the latter part of this section, when construed in connection with the simple right to *use*, without the right to *make* and *vend*, has reference to the machine patented. *Ibid.*, 683.

The phrase "to the extent of their interests therein," means their interests in the patented machines, be that interest in one or more at the time of the extension. *Ibid.*, 683.

The words of this section as to assignees and grantees, seem to convey the impression that something more than the mere ownership of existing machines was intended, and that they were intended to embrace all classes of such assignees and grantees, and all inventions, whether of machines, processes, or compositions of matter, and to embrace rights and interests which were different in extent, either of time or territory, or both. *Day* v. *Union Rub. Co.*, 3 or 4 Blatchf.—HALL, J.; N. Y., 1856.

But such right is limited to a right to *use*, although the person holding it may also have held, during the original term, an exclusive right to use, to make, and vend. And such right to use is secured only to the extent of the respective interests of the assignees or grantees therein. *Ibid.*

See also DIGEST, title EXTENSION OF PATENT, C.

(*c*) The extension of all patents, except for designs, granted subsequently to March 2d, 1861, is now prohibited. Act of 1861, § 16.

Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

SECTION 20. *And be it further enacted*, That it shall be the duty of the Commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be, deposited in said office. (*a*) And said rooms or galleries shall be kept open during suitable hours for public inspection.

SECTION 21. *And be it further enacted*, That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: *Provided, however*, That all actions and processes in law or equity sued out prior to the passage of this act, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto: *And provided, also*, That all applications or petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof

Approved July 4th, 1836.

## ACT OF 1837, CHAPTER 45.

(5 STAT. AT LARGE, 191.)

An Act in addition to the act to promote the progress of science and useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim and drawings annexed or belonging to the same; and it shall be the duty of the Commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed and copied into books of record to be kept for that purpose; and wherever a drawing was not

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(*a*) The Commissioner of Patents may now restore to applicants, models of rejected applications, or of applications for designs, or otherwise dispose of them, in cases where he shall not think it necessary to preserve them. Act of 1861, § 5.

originally annexed to the patent and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require, may be transmitted and placed on file or copied as aforesaid, together with certificate of the oath; or such drawings may be made in the office, under the direction of the Commissioner, in conformity with the specification. And it shall be the duty of the Commissioner to take such measures as may be advised and determined by the Board of Commissioners provided for in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States, to transmit, as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office; and also to make out and transmit to said Commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing, which shall be specially required by said Commissioner.

SECTION 2. *And be it further enacted*, That copies of such record and drawings, certified by the Commissioner, or, in his absence, by the chief clerk, shall be prima facie evidence of the particulars of the invention and of the patent granted therefor in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals; (*a*) and no patent issued prior to the aforesaid fifteenth day of December, shall, after the first day of June next, be received in evidence in any of the said courts in behalf of the patentee or other person who shall be in possession of the same, unless it shall have been so recorded anew, and a drawing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts in behalf of the assignee or other person in possession thereof, until it shall have been so recorded anew.

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(*a*) Under this section it was held, where a patent was granted in 1834, but no drawing was attached thereto, and in June, 1837, such patent was recorded anew, and was also extended for seven years on the 25th of September, 1848, and in November, 1848, a drawing with written references was filed, with an affidavit of the patentee of the correctness of such drawing, that a certified copy of such drawing was admissible in evidence in connection with the patent and specification, and that the whole together made *prima facie* evidence of the particulars of such invention. *Winans v. Schenec. & Troy R. R.*, 2 Blatchf., 283, 285, 298.—NELSON, J.; N. Y., 1851.

Such a drawing, however, as a general rule will not be effectual to correct any material defect in the specification. In case of discrepancy between the drawings and specification, the latter must prevail. Nor will such a drawing have the same effect as if it had been referred to in the specification. *Ibid.*, 299.

SECTION 3. *And be it further enacted*, That whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided, however*, That before such patent shall be issued, the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and description, with specification of the invention or discovery, verified by oath, as shall be required by the Commissioner; and such patent and copies of such drawings and descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification. (*a*)

SECTION 4. *And be it further enacted*, That it shall be the duty of the Commissioner to procure a duplicate of such of the models destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the Commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements: *Provided*, That a duplicate of such models may be obtained at a reasonable expense: *And provided, also*, That the whole amount of expenditure for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to con-

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(*a*) Where a patent was obtained in 1834, the original of which and the drawings were destroyed by fire in 1836, and the patentee, under the act of 1837, filed in 1841 a copy of his patent, and deposited a drawing which, however, was not verified, but which he verified in February, 1844, and subsequently in March, 1844, considering such copy imperfect, filed another and a fuller drawing, and commenced suit in May, 1844; *Held*, that a certified copy of such second drawing was properly received in evidence in such action. *Emerson* v. *Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

When such drawings are put on file they become public records, and copies of them must be received in evidence. If they are discordant, one may destroy the effect of the other. *Ibid.*, 12.

Under this section drawings when burnt may be restored, and if in some respects erroneous they can be corrected. *Hogg* v. *Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

But it would not be proper to leave the drawings so long not restored or corrected as to evince neglect, or a design to mislead the public. *Ibid.*, 606.

The provisions of this section extended to patents granted prior to December 15th, 1836, but lost subsequent thereto. Act of 1842, § 2.

sider and determine upon the best and most judicious mode of obtaining models of suitable construction; and, also, to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said Commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

SECTION 5. *And be it further enacted*, That, whenever a patent shall be returned for correction and reissue under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so to be issued; (*a*) *Provided, however*, That no patent made prior to the aforesaid fifteenth day of December, shall be corrected and reissued until a duplicate of the model and drawing of the thing as originally invented, verified by oath as shall be required by the Commissioner, shall be deposited in the Patent Office;

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor, of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of the thing originally invented, verified as aforesaid, shall have been deposited in the Patent Office, if the Commissioner shall require the same; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the Commissioner, shall, in like manner, be deposited in the Patent Office;

And in all such cases, as well as in those which may arise under the third sec-

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(*a*) If an original patent include two inventions, and its validity on that account is doubted, a separate renewal is just and proper. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

With respect to reissues, this section, and § 13 of the act of 1836 are to be taken together in construction, and the most just and equitable extent to which the terms of the law in its true spirit will admit of, ought to be adopted. *Ball, Ex parte* MS. (App: Cas.)—MORSELL, J.; D. C., 1860.

If the patent be defective or insufficient, either in the specification or *claim*, the patentee has a right, in the absence of fraud and deception, to have a reissue, for each separate and distinct part, effectually to cure the defect: and he has the right, to *restrict* or *enlarge* his claim, so as to give it operation, and effectuate his invention. *Ibid*

Upon an application for a reissue, under this section, and asking for several reissued patents, each division or separate patent asked for is not such a separate case as to require the payment of $25 00 on an appeal to the Judges of the Circuit Court: but one appeal carries up the *whole* case and not a part, and notwithstanding that separate reissued patents may be granted. *Selden, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

See also notes to § 13 of the act of 1836.

tion of this act, the question of compensation for such models and drawing shall be subject to the judgment and decision of the commissioners provided for in the fourth section, under the same limitations and restrictions as are therein prescribed.

SECTION 6. *And be it further enacted*, That any patent hereafter to be issued, may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. (*a*) And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification. (*b*)

SECTION 7. *And be it further enacted*, That, whenever any patentee shall have through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor,

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(*a*) This is an enabling statute. Prior to its passage, letters patent could only issue to the inventor: and after they were issued, they were assignable so as to give the assignee, in whole or in part, legal rights. This act gave the right to the assignee or assignees to have the patent issued to him or them, and not to the inventor. *Anon.*, 4 Opin., 400.—MASON, Atty. Gen.; 1845.

But patents cannot issue jointly to the inventor as such, and to the assignee of a partial interest: but must issue to the assignee or assignees of the whole interest. *Ibid.*, 401.

A partial assignment before issue, does not entitle the partial assignee to have the patent issued to him to the extent of his interest. *Ibid.*, 401.

After the assignment of the invention, under this section, by which the inventor divests himself of all interest therein, and transfers it to the assignee, although the application for a patent must be in his name, still, for all substantial purposes, and in *judgment of law, the assignee is the party making the application.* *Gay* v. *Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

An assignment before patent issued, may be made after the rejection of the assignor's application, and after his appeal to the justices of the Circuit Court, and will be sufficient to enable such assignee to file his bill under § 16 of the act of 1836, amended by § 10 of the act of 1839, to compel the issue of a patent to him. *Ibid.*, 509, 510.

If an inventor assign all his right in an invention, the assignee may have the patent issued to himself. But if the assignment be only partial, though the part excepted is small, the assignee has no legal claim to the patent. It must be issued in the name of the inventor, and be held by him in trust for the use of the assignee, to the extent of the equities he has by virtue of his contract. *Ayer's Case*, MS., Opin.—BLACK, Atty. Gen.; 1859.

See also DIGEST, title ASSIGNEE, B. 3.

(*b*) The provision of this section, requiring duplicate drawings, though directory in its terms, is not a condition: and it has reference, in point of time, to the issuing of the patent, and not to the filing of the petition for it. Duplicate drawings need not be filed at the time of the application, and such is the interpretation of the Patent Office. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851. *O'Reilly* v. *Morse*, 15 How., 126.—GRIER, J.; Sup. Ct., 1853.

some material and substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether, of the whole or of a sectional interest therein, may make disclaimer (*a*) of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; (*b*) which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment by the person disclaiming in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him (*c*) subsequent to the record thereof. But no

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(*a*) The law requiring and permitting a patentee to enter a disclaimer, is penal and not remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construction that would restrict its operation within narrower limits than the law fairly imports. *O'Reilly* v. *Morse*, 15 How., 121.—TANEY, Ch. J.; Sup. Ct., 1853.

Whether a patent is illegal in part because of claiming more than he had described, or more than he has invented, the patentee must in either case disclaim, in order to save the portion to which he is entitled. *Ibid.*, 122.

A patentee has a right to disclaim any thing which has been claimed through "inadvertence or mistake." *Parker* v. *Sears*, MS.—GRIER, J.; Pa., 1850.

*Semble*, That a disclaimer, under this section, should not only disclaim what is not claimed as new, but should also distinctly set forth what part of the invention is still claimed, as it is manifestly designed to act as a new specification. *Lippincott* v. *Kelly*, 1 West. Law Jour., 513.—IRVIN, J.; Pa., 1844.

(*b*) Under this section the disclaimer must state the interest of the person disclaiming. But where an administrator in whose name a patent had been extended, entered a disclaimer, stating that he was the patentee, and referring to the patent as showing his interest, it was held sufficient. *Brooks* v. *Bicknell*, 3 McLean, 439. —McLEAN, J.; Ohio, 1844.

Where a disclaimer made by a patentee stated that "it was to operate to the extent of the interest in said letters patent vested" in the patentee, *Held*, that it fairly imported on its face, that the patentee was the owner of the entire interest in the patent, and if so, there was a substantial compliance with the statute, as to the disclaimer stating the interest of the party making it. *Foote* v. *Silsby*, 1 Blatchf., 461. —NELSON, J.; N. Y., 1849.

Where in a disclaimer the party stated that he was the patentee, and nothing was said as to any transfer of any part of it, the fair presumption is, that he still owns the whole, and it is a sufficient compliance with the statute, as to stating his interest, to say, "that such disclaimer is to operate to the extent of his interest therein." *Silsby* v. *Foote*, 14 How., 221.—CURTIS, J.; Sup. Ct., 1852.

(*c*) If a patent has been previously assigned in part, and a disclaimer has been filed by the patentee alone, such disclaimer will not operate in favor of the assignee, in any suit either at law or equity, unless he has joined in it. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

A disclaimer of part of an invention cannot affect a prior grantee under the patent, unless he accepts of it; he may refuse to be affected by it. *Smith* v. *Mercer*, 5 West. Law Jour., 53.—KANE, J.; Pa., 1846.

such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same. (*a*)

SECTION 8. *And be it further enacted*, That, whenever application shall be made to the Commissioner for any addition of a newly discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the Commissioner; and in all such cases, the applicant, if dissatified with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents. (*b*)

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Under § 7 of the act of 1837, the owner of a sectional interest in a patent may make a disclaimer of part of the thing patented, which will be considered as a part of the original patent, to the extent of his interest; but the patentee is not compelled to join in such disclaimer, nor will it affect any one except him making it, and those claiming under him. *Potter* v. *Holland*, MS.—NELSON, INGERSOLL, JJ.; Ct., 1858.

After such a disclaimer, a different claim of right is secured to the disclaimant from what is purported to be secured to the patentee. Different claims of right in the same invention are thus secured to different sectional owners. *Ibid.*

A disclaimer before it can be received in evidence must be properly proved, either as an original paper, or by a certified copy, and if received at all, must have full effect given to it as a disclaimer. *Foote* v. *Silsby*, 1 Blatchf., 450, 461.—NELSON, J.; N. Y., 1849.

The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patent from embracing the part so disclaimed, on a reissue of his patent. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

(*a*) The disclaimer mentioned in this section applies solely to suits pending when the disclaimer is filed; and the disclaimer mentioned in § 9, applies solely to suits bronght after the disclaimer is filed. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

A disclaimer to be effectual under this and § 9, must be filed before suit brought. If it is filed during the pendency of the suit, the plaintiff will not be entitled to the benefit thereof in that suit. *Reed* v. *Cutter*, 1 Story, 600.—STORY, J.; MASS., 1841.

If filed before suit, the plaintiff will be entitled to costs, if he establish that a part of his invention, not disclaimed, has been infringed by the defendant. *Ibid.*, 600.

But whether filed before or after suit brought, the plaintiff will not be entitled to the benefit thereof, if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defence to the suit. *Ibid.*, 600.

Sections 7 and 9 of the act of 1837, authorizing a disclaimer, do not apply when a patent is for a combination of parts. *Battin* v. *Clayton*, 2 Whar. Dig., 409.—KANE, J.; Pa., 1848.

See also DIGEST, title DISCLAIMER; and notes to § 9 of this act.

(*b*) This section so far as it relates to patents for additions to existing patents, is repealed by the act of 1861, § 9.

ACT OF 1837, CHAP. 45, § 9.

SECTION 9. *And be it further enacted*, (any thing in the fifteenth section of the act to which this is additional to the contrary notwithstanding,) That, whenever by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have in his specification claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and bona fide his own; *Provided*, It shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. (*a*) And every such patentee, his executors, administrators, and assigns, whether of the whole or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be bona fide his own as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. (*b*) But, in every such case in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he

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(*a*) This section contemplates the rule of the common law, that if a patent embraces different machines, and any one of them is not new, or was not the invention of the patentee, or the like, the whole patent would be void, as being then in full force, and therefore sought to mitigate it by providing that under the cases therein mentioned, the patent should be good to the extent of the patentee's invention. *Wyeth* v. *Stone*, 1 Story, 288, 289.—STORY, J.; Mass., 1840.

It points throughout to a single invention, as the "thing patented," and does not justify the position that one patent can lawfully include divers distinct and independent inventions, having no connection with each other, nor any common purpose. It may therefore be deemed a legislative recognition and adoption of the general rule of law in cases not within its exceptive provision. *Ibid.*, 290.

This section is intended to cover "inadvertences and mistakes" of law, as well as inadvertences and mistakes of fact. *Ibid.*, 295.

Prior to the act of 1836, if the patentee claimed more than he had invented, his patent was void. But under this section, his patent is not absolutely void, because the patentee claims more than he has actually invented, but is valid for as much as is truly and *bona fide* his own; but to secure the benefits of this section, the specification must state in what the improvement consists. *Peterson* v. *Wooden*, 3 McLean, 249. —MCLEAN, J.; Ohio, 1843.

(*b*) Prior to the act of 1836, a patent was void if the claim extended beyond the invention. Under § 6 of the act of 1836, it was void if a substantial part had been patented or described in a printed publication. Section 15 of the same act saved the patent from being void, if the patentee believed himself to be the first inventor. Section 9 of the act of 1837, enlarged the right of the patentee, providing, notwithstanding § 15 of the act of 1836, that the patent should not be void, where the patentee had acted in good faith, if through mistake or inadvertence he had claimed more than he had invented, and that he might maintain suit on the part actually invented by him, provided he filed within a reasonable time, a disclaimer of the parts not invented by him. *Smith* v. *Ely*, 5 McLean, 84, 85.—MCLEAN, J.; Ohio, 1849.

The doctrine that a party may take out a valid patent for a combination, and in-

shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented which was so claimed without right: (a) *Provided, however*, That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid. (b)

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clude in it a right to each distinct improvement, is confirmed by the obvious intent of this section, which gives a patentee a right of action for a piratical use of any one of his invented improvements, which is distinctly stated in his patent, though he may by mistake, accident, or inadvertence, have claimed others of which he was not the inventor. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Mass., 1843.

(a) The disclaimer mentioned in this section applies solely to suits brought after the disclaimer is filed. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

Where a patent contains several claims, and the invention embraced in one seems to be not new or useless, the patentee, under this and § 7 may still maintain an action for an infringement, although he did not, before action brought, make a disclaimer of the part claimed without right; but he will not be entitled to costs. *Hall* v. *Wiles*, 2 Blatchf., 198.—NELSON, J.; N. Y., 1851.

If in the progress of a trial, it turns out that a disclaimer ought to have been made, the plaintiff may still recover, but will not be entitled to costs. *Ibid.*, 198.

A disclaimer is necessary only where the thing claimed without right is a material and substantial part of the thing invented. If the part not new is not essential to the machine, and was not introduced into the patent through wilful default, or intent to defraud or mislead the public, the want of a disclaimer affords no ground for invalidating the patent. *Ibid.*, 199.

Under this section, in an action for infringement, the plaintiff cannot recover costs if he has claimed any thing of which he was not the first and original inventor, unless before suit brought he has disclaimed such part: and it makes no difference whether the infringement alleged was of or against the part so claimed, but not new, or of some other part claimed in the patent. *Seymour* v. *McCormick*, 19 How., 106.—NELSON, J.; Sup. Ct., 1856.

The omission to disclaim a part not new, prevents a plaintiff from recovering costs, and it makes no difference that such part is not alleged to be infringed. *Ibid.*, 106.

Though the neglect to file a disclaimer until after suit brought, will prevent the plaintiff recovering costs, it does not interfere with the power of the court to increase the verdict under § 14, of the act of 1836. *Guyon* v. *Serrell*, 1 Blatchf., 245, 246. NELSON, J.; N. Y., 1847.

(b) The plaintiff will not be entitled to the benefit of a disclaimer if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defence to a suit. *Reed* v. *Cutter*, 1 Story, 600.—STORY, J.; Mass., 1841.

An unreasonable delay to enter a disclaimer cuts off the patentee, not only from a right to costs, but also from a right of action. *Brooks* v. *Bicknell*, 3 McLean, 449.—McLEAN, J.; Ohio, 1844.

What is an unreasonable delay is a mixed question of law and fact. Less vigilance will be required from an administrator than from the original inventor. *Ibid.*, 449, 450.

Where a patentee has unintentionally claimed something which was not original, but has unreasonably neglected to file a disclaimer, he cannot, under this section, recover in an action of infringement, even if the defendant has infringed the parts of his invention which are new. *Parker* v. *Stiles*, 5 McLean, 56.—LEAVITT, J.; Ohio. 1849.

SECTION 10. *And be it further enacted*, That the Commissioner is hereby authorized and empowered to appoint agents in not exceeding twenty of the principal cities or towns in the United States as may best accommodate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the Patent fund. (*a*)

SECTION 11. *And be it further enacted*, That, instead of one examining clerk, as provided by the second section of the act to which this is additional, there shall be appointed, in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars; (*b*) and also, an additional copying clerk, at an annual salary of eight hundred dollars. And the Commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the Commissioner.

SECTION 12. *And be it further enacted*, That, whenever the application of any foreigner for a patent shall be rejected and withdrawn for want of novelty in the invention, pursuant to the seventh section of the act to which this is additional, the certificate thereof of the Commissioner shall be a sufficient warrant to the treasurer to pay back to such applicant two-thirds of the duty he shall have paid into the Treasury on account of such application. (*c*)

SECTION 13. *And be it further enacted*, That in all cases in which an oath is required by this act, or by the act to which this is additional, (*d*) if the person

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Under this section, the question of unreasonable negligence or delay in entering a disclaimer goes to the right of the action; and if the delay shows great negligence, the jury may find the patent void. *Hall* v. *Wiles*, 2 Blatchf., 199.—NELSON, J.; N. Y., 1851.

Where a claim has been held valid by the Patent Office, and has been sanctioned by a court below, the patentee will not be guilty of *unreasonable delay* in disclaiming it by waiting to obtain the decision of the highest court upon it. *O'Reilly* v. *Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

Und[illegible]is section, where a patentee claims more than he has invented, or is entitled t[illegible]patent will still be valid for what he has invented, provided he enters a discla[illegible] of what he has included in his patent which he has not invented, without unreasonable neglect or delay. *Silsby* v. *Foote*, 20 How., 387.—NELSON, J.; Sup. Ct., 1857.

See also DIGEST, title DISCLAIMER; and notes to § 7 of this act.

(*a*) This section repealed by act of 1861, § 6.

(*b*) The Commissioner of Patents has now the power to appoint examiners, not to exceed four in each class. Act of 1861, § 7.

(*c*) The right of withdrawal, as to any portion of the patent fee, in applications made subsequent to March 2d, 1861, is now taken away. Act of 1861, § 9.

(*d*) Act of 1836, § 6.

of whom it is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor. (*a*)

SECTION 14. *And be it further enacted*, That all moneys paid into the Treasury of the United States for patents and for fees for copies furnished by the Superintendent of the Patent Office prior to the passage of the act to which this is additional, shall be carried to the credit of the Patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries of the officers and clerks provided for by said act, and all other expenses of the Patent Office, including all the expenditures provided for by this act; and, also, for such other purposes as are or may be hereafter specially provided for by law. And the Commissioner is hereby authorized to draw upon said fund, from time to time, for such sums as shall be necessary to carry into effect the provisions of this act, governed, however, by the several limitations herein contained. And it shall be his duty to lay before Congress in the month of January, annually, a detailed statement of the expenditures and payments by him made from said fund; And it shall also be his duty to lay before Congress, in the month of January, annually, a list of all patents which shall have been granted during the preceding year, designating, under proper heads, the subjects of such patents, and furnishing an alphabetical list of the patentees, with their places of residence; and he shall also furnish a list of all patents which shall have become public property during the same period; together with such other information of the state and condition of the Patent Office as may be useful to Congress or the public. (*b*)

Approved March 3d, 1837.

## ACT OF 1839, CHAPTER 88.

(5 STAT. AT LARGE, 353.)

An Act in addition to "An Act to promote the progress of Useful Arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be appointed, in manner provided in the second section of the act to which this is additional, two assistant examiners, each to receive an annual salary of twelve hundred and fifty dollars. (*c*)

SECTION 2. *And be it further enacted*, That the Commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the

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(*a*) As to what persons may administer this oath, when the applicant is without the jurisdiction of the United States, see act of 1842, § 4.

(*b*) The annual report of the Commissioner of Patents on mechanics is to be prepared so that the plates and drawings shall be comprised in one volume, not to exceed eight hundred pages. Act of 1859, § 4.

(*c*) The Commissioner of Patents has now authority to appoint examiners, not to exceed four in each class. Act of 1861, § 7.

current business of the office requires it; *Provided, however*, That instead of salary, a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office. (*a*)

SECTION 3. *And be it further enacted*, That the Commissioner is hereby authorized to publish a classified and alphabetical list of all patents granted by the Patent Office previous to said publication, and retain one hundred copies for the Patent Office and nine hundred copies to be deposited in the library of Congress, for such distribution as may be hereafter directed; and that one thousand dollars, if necessary, be appropriated, out of the Patent fund, to defray the expense of the same.

SECTION 4. *And be it further enacted*, That the sum of three thousand six hundred and fifty-nine dollars and twenty-two cents be, and is hereby, appropriated from the Patent fund, to pay for the use and occupation of rooms in the City Hall by the Patent Office.

SECTION 5. *And be it further enacted*, That the sum of one thousand dollars be appropriated from the Patent fund, to be expended under the direction of the Commissioner, for the purchase of necessary books for the library of the Patent Office.

SECTION 6. *And be it further enacted*, That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: (*b*) *Provided*, That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided, also*, That in all cases every such patent shall be limited to the term of fourteen years (*c*) from the date or publication of such foreign letters patent. (*d*)

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(*a*) Ten cents per hundred words. Act of 1836, § 4. Act of 1861, § 10.

(*b*) For provision referred to, see act of 1836, § 8.

(*c*) Patents are now granted for the term of seventeen years. Act of 1861, § 16.

(*d*) The date of a patent may be altered to correspond with that of a foreign patent, previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. *Detmold's Case*, 4 Opin., 335.—NELSON, Atty Gen.; 1844.

Under this section, if the domestic patent, in a case where a foreign patent has been previously obtained, purports to give an exclusive right for fourteen years from its date, instead of from the date of the foreign patent, it is void, as having been issued without authority of law; but the error is not fatal, and may be corrected on application to the Patent Office. *Smith* v. *Ely*, 5 McLean, 78, 80.—MCLEAN, J.; Ohio, 1849.

The proviso of this section as to when a home patent shall bear the date of a foreign patent, relates only to such patents as are *applied for* here *after* the issue of a foreign patent. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851.

Where, therefore, an application for a patent was made in this country in April, 1838, and acted on in that month, but a patent was not actually issued until June 20th, 1840, at which time the patent was dated, and a foreign patent was obtained

ACT OF 1839, CHAP. 88, § 7.

SECTION 7. *And be it further enacted,* (*a*) That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter, so made or purchased, without liability therefor to the inventor, or any other

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in August, 1838; *Held*, as the application here was before the foreign patent, that the grant of the patent here was under the general enactments of the act of 1836, and its term runs properly from its date. *Ibid.*

A patent is not void because it does not, on its face, bear the same date with a foreign patent. If it is not, for any reason, exempt from the operation of the statute on such subject, the only effect is to limit the monopoly to fourteen years from the date of the foreign patent. *O'Reilly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

(*a*) This section, allowing the use and sale of an invention for two years before the application for a patent, is in the nature of a statute of limitations. *Hovey* v. *Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

It virtually extends the patentee's privilege to sixteen years instead of fourteen. *McCormick* v. *Seymour*, 2 Blatchf., 254.—NELSON, J.; N. Y., 1851.

The object of this section is twofold: first, to protect the person who has used the thing patented from any liability to the patentee, or his assignee; and second, to protect the rights granted to the patentee against any infringement by any other person. *McClurg* v. *Kingsland*, 1 How., 208, 209.—BALDWIN, J.; Sup. Ct., 1843.

This section relieved the patentee from the effect of the former laws, and their construction by the court, while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor, which, if given before the application for a patent, would justify a continued use of it after it issued, without liability. *Ibid.*, 209.

It is not limited to patents for machines, manufactures, and compositions of matter, but embraces inventions for modes of doing a thing, or processes, as a new improvement in the art of casting iron. *Ibid.*, 209.

This section is not to be construed as confined to a specific machine as distinguished from an invention or thing patented, but the words "newly invented machine, manufacture, or composition of matter," and "such invention," mean the "invention patented," and the words "specific machine" refer to "the thing as originally patented," whereof the right is secured by patent, but not to any newly invented improvement on a thing once patented. *Ibid.*, 210.

This section has exclusive reference, in respect to the use of a machine, to an original patent, and not to a renewal or reissue of it. *Stimpson* v. *West Chester R. R.*, 4 How., 403.—MCLEAN, J.; Sup. Ct., 1845.

This section allows the use of an invention, even with leave of the inventor, for two years before application for a patent, without invalidating his right to a patent; *a fortiori*, the use by a third person, or a subsequent inventor, after the invention and before the issuing of a patent to the first inventor, without his consent, is no bar to the issuing of a patent to the first inventor. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

Both before and since the act of 1839, an inventor might exercise a claim to an inchoate right to an invention, which was capable of being perfected to an exclusive right by obtaining letters patent, and the public may acquiesce in such claim. *Sargeant* v. *Seagrave*, 2 Curt., 555.—CURTIS, J.; R. I., 1855.

Before the act of 1839, he might, by way of experiment, bring the knowledge of his

person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

SECTION 8. *And be it further enacted*, That so much of the eleventh section of the above recited act as requires the payment of three dollars to the Commissioner of Patents for recording any assignment, grant, or conveyance of the

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invention to the public, at the same time making known that he was about to apply for a patent; and since the act of 1839, he may sell any number of his machines to the public, during any period less than two years, accompanied by a claim to the inchoate right sufficient to show an intention not to abandon it to the public. *Ibid.*, 555.

Under this section the purchaser must be a purchaser from the inventor himself, before his application for a patent, and not from a wrongdoer, without his knowledge or against his will. *Pierson* v. *Eagle Screw Co.*, 3 Story, 406, 407.—STORY, J.; R. I., 1844.

The purchase or construction referred to in this section means a purchase from the inventor or his grantee, or a construction by their consent, or by the user's own ingenuity.—*Hovey* v. *Stevens*, 1 Wood. & Min., 301.—WOODBURY, J.; Mass., 1846.

A construction or use in fraud of the first inventor, or by piracy of his invention, is not protected. *Ibid.*, 301.

A surreptitious knowledge and use of an invention, before the application by the inventor for a patent, does not, under this section, give any right to continue to use it after the inventor has obtained a patent for it. *Kendall* v. *Winsor*, 21 How., 330. —DANIEL, J.; Sup. Ct., 1858.

The sale of the product of an invention is not a sale of the thing invented within this section: the sale here spoken of is a sale of the invention or patented article. *Booth* v. *Garelly*, 1 Blatchf., 250.—NELSON, J.; N. Y., 1847.

This section gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

The provision in this section as to the use of an invention, relates to the case of a use, sale, or license to use, given or made and claimed under the inventor who admits and claims the privilege. The clause should read thus: "The patent shall not be held invalid by reason that the inventor has sold or allowed his invention to be used prior to the application for a patent, unless he has abandoned it to the public, or that such sale or prior use has been for more than two years prior to such application for a patent." *Ellithorpe* v. *Robertson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1858.

The privilege granted by this section is applicable only to the inventor, or those claiming under him, and this construction is sustained by *Pierson* v. *Eagle Screw Co.*, 3 Story, 402. The use of an invention by an independent inventor, or under a separate and independent patent, is not such a use as is contemplated by that section. *Beech* v. *Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

This section provided a remedy for cases where the conduct of the party, as to the sale of his invention, did not show an actual abandonment. It also secures the rights of those who may have purchased or constructed any newly invented machine, prior to the application for a patent. *Sanders* v. *Logan*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

The obvious construction of it is, that a purchase, sale, or prior use, shall not invalidate, unless it amounts to an abandonment to the public. *Ibid.*

See also DIGEST, title PRIOR USE.

whole or any part of the interest or right under any patent, be, and the same is hereby, repealed; and all such assignments, grants, and conveyances shall, in future, be recorded without any charge whatever. (*a*)

SECTION 9. *And be it further enacted*, That a sum of money not exceeding one thousand dollars, be, and the same is hereby, appropriated, out of the patent fund, to be expended by the Commissioner of Patents in the collection of agricultural statistics, and for other agricultural purposes; for which the said Commissioner shall account in his next annual report. (*b*)

SECTION 10. *And be it further enacted*, That the provisions of the sixteenth section of the before recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise. (*c*)

SECTION 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, (*d*) by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, (*e*) his reasons of appeal,

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(*a*) Fees for recording assignments are again required, according to certain rates, by the act of 1848, § 2, and the act of 1861, § 10.

(*b*) There having been established a Department of Agriculture, it has been deemed advisable not to insert any other laws particularly referring to that subject.

(*c*) An assignee of an invention, by virtue of an assignment made before patent issued, may file a bill in his own name under § 16 of the act of 1836, and this section, against a patentee to whom a patent issued, upon an interference with complainant's assignor, for the purpose of having the patent so issued set aside, and one granted to the complainant. *Gay* v. *Cornell*, 1 Blatchf., 507.—NELSON, J.; N. Y., 1849.

And it will be sufficient if such assignment is recorded before patent is issued. *Ibid.*, 509.

(*d*) Appeals may also be made to either of the assistant judges of the Circuit Court of the District of Columbia. Act of August 18th, 1852, § 1.

(*e*) The filing of the reasons of appeal is essentially the appeal itself. *Greenough* v. *Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

Where the reasons of appeal are not filed within the time prescribed by the Commissioner of Patents, the right of appeal is lost. *Ibid.* Also, *Wade* v. *Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

But the Commissioner may enlarge the time to file such reasons. *Justice* v. *Jones*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

An appeal cannot be made after the time limited in the notice of appeal. *Linton, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

See also DIGEST, title APPEALS, B. 1.

specifically set forth in writing, (*a*) and also paying into the Patent Office, to the credit of the Patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, (*b*) at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. (*c*) And at the request of any party interested, or at the desire of the

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(*a*) The reasons of appeal must not be vague and unsatisfactory, as "that the decision of the Commissioner was in opposition to a clear apprehension of the merits of the case." *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850. *Douglass* v. *Blakinton*, MS. (App. Cas.)—MERRICK, J.: D. C., 1859.

No reason of appeal can be considered as valid, which would not justify the Commissioner in refusing a patent. *Wade* v. *Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

No assignment is sufficiently explicit which does not, with reasonable certainty, point out the precise matter of alleged error. *Douglass* v. *Blakinton*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

The reasons of appeal should be so expressed that the judge may gather from their language what is meant by them, but they need not be according to any technical formula. *Laidley* v. *James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

See also DIGEST, title APPEALS, B. 4.

(*b*) The questions are to be decided by the judge according to the evidence produced before the Commissioner. *Warner* v. *Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

The provision requiring the judge to hear and determine appeals "on the evidence produced before the Commissioner," is to be construed with reference to § 7 of the act of 1836, providing that reasonable notice shall be given both to the party appealing, and the Commissioner, "so that they may have an opportunity of furnishing such facts and evidence as they may deem necessary to a just decision." *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

There is nothing in the act of 1839, which takes away or impairs that right, but there is every reason to infer that it was intended to be saved to the fullest extent. *Ibid.*

Where, therefore, a party has been prevented before the Commissioner from producing his proofs to support his claim, it is the duty of the judge, by reasonable regulations, similar to those directed by § 12 of the act of 1839, to pursue such a course, as will afford the party an opportunity to produce such proofs, and he may make an order, authorizing the party to take and file his proofs as to the originality and utility of his invention. *Ibid.*

(*c*) All the conditions prescribed by this section must be complied with as prerequisites, before the judge can take jurisdiction. His jurisdiction is special and limited, and no other power can be exercised except that expressly given. *Greenough* v. *Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

judge, the Commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case, is prayed for. (*a*) And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case; (*b*) *Provided, however*, That no opinion or decision of the judge in any such case, shall preclude any person interested in favor or against the validity of any patent which has been, or may hereafter, be granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

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The powers and jurisdiction of the judges on appeal, are special and limited, and must be exercised and construed strictly. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

The power of the justices on appeal from the decision of the Commissioner of Patents is confined to the points involved in the reasons of appeal. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841. *Smith* v. *Flickinger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844. *Warner* v. *Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846. *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850. *Aiken, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850. *Burlew* v. *O'Neil*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

See also DIGEST, title APPEALS, B. 2, 3.

(*a*) The provision of this section as to the examination of the Commissioner, &c., must be considered in connection with § 7 of the act of 1836, as to the powers of the old Board of Examiners. The statute means that the explanation may be so full and clear an explanation of the *principles* of the thing, as to enable the judge to weigh and apply the evidence offered, and is not to be limited to a mere exposition of the terms used; and such explanations the judge is bound to respect as a part of the case. *Richardson* v. *Hicks*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

The judge succeeds to all the authority conferred upon the Board of Examiners by § 7 of the act of 1836, to require of the Commissioner and examiners information relative to the subject matter under consideration, and to the full extent. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

The officer of the Patent Office attending before the judge is not to be considered as counsel for the Patent Office, or for either of the parties, but only attends to explain the decision of the Commissioner. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

(*b*) The provision that "the decision of the judge shall govern the further proceedings of the Commissioner in the case," applies only to so much of the case as is involved in the reasons of appeal; and the appeal itself can only be considered as an appeal to so much of the decision of the Commissioner as is affected by such reasons. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

If, therefore, after the judge shall have decided in favor of an applicant, upon the points involved in the reasons of appeal, other grounds remain for rejecting the claim, it would seem the Commissioner might still reject it; whether such new rejection would be the subject of appeal; *query*. *Ibid*.

As to who may appeal, see notes to § 8, act of 1836.

See also DIGEST, title APPEALS, B. 3 and 5.

ACT OF 1842, CHAP. 263, § 1.

SECTION 12. *And be it further enacted*, That the Commissioner of Patents shall have power to make all such regulations in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. (*a*) And so much of the act to which this is additional, as provides for a board of examiners, is hereby repealed.

SECTION 13. *And be it further enacted*, That there be paid annually, out of the Patent fund, to the said Chief Justice, in consideration of the duties herein imposed, the sum of one hundred dollars. (*b*)

Approved March 3d, 1839.

## ACT OF 1842, CHAPTER 263.

(5 STAT. AT LARGE, 543.)

An Act in addition to an act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose. (*c*)

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same

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(*a*) The rules as to evidence, made under this section by the Commissioner of Patents, in conformity with the law, while they remain unabrogated, are as binding as the law itself, and as well upon the Commissioner as on others. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

After a deposition has been taken while the rules were in force, a revocation of them cannot affect such deposition. A revocation can affect only subsequent proceedings. *Ibid.*

The rules of the Patent Office as to taking evidence, prescribed under this section, must be *just and reasonable*, according to the established principles and precedents in like cases. *Nichols* v. *Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

The rules and regulations of the Patent Office as to taking testimony in cases of interference, are binding upon the parties, and each is entitled to the benefit of them, and until abrogated, they are as binding upon the Commissioner himself as if enacted by the very statute. *O'Hara* v. *Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

The power granted to the Commissioner under this section to make rules as to the taking of evidence, gives no right to make new rules of evidence, or to make new rules of law so as to divest vested rights. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

The power of the Commissioner to make rules as to evidence is now extended to all cases pending before the Patent Office. Act of 1861, § 1.

See also DIGEST, title EVIDENCE, C. 3; RULES OF PATENT OFFICE.

(*b*) This section was repealed by § 3 of the act of 1852; and it was also provided that, in case of an appeal to the chief-justice, or to either of the assistant justices, there should be paid to the judge to whom appeal should be made, the $25 required to be paid by this section. Act of 1852, § 2.

(*c*) This act purports, from its title, to repeal all acts and parts of acts heretofore made to promote the progress of the useful arts; but though it extends some of the existing laws to new cases, it in fact repeals no act or part of any act whatsoever. *Stimpson* v. *Pond*, 2 Curt., 506.—CURTIS, J.; Mass., 1855.

into the Treasury, or to any receiver or depositary to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to said Treasurer by the Commissioner of Patents.

SECTION 2. *And be it further enacted*, That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thirty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided, however*, The same shall not have been recorded anew under the provisions of said act.

SECTION 3. *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases which by the now existing laws would be required of the particular applicant shall be one-half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section. (*a*)

SECTION 4. *And be it further enacted*, That the oath required for applicants for patents may be taken, when the applicant is not, for the time being, residing in the United States, before any minister, plenipotentiary, charge d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public of the foreign country in which such applicant may be. (*b*)

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(*a*) This section repealed, or superseded, by the act of 1861, § 11, which makes other provisions as to patents for designs.

(*b*) Oath required by act of 1836, § 6; affirmation substituted therefor in certain cases by act of 1837, § 13.

ACT OF 1842, CHAP. 263, §§ 5, 6.

SECTION 5. *And be it further enacted*, That if any person or persons, shall paint or print or mould, cast, carve, or engrave, or stamp, upon any thing made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased, from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the word "patent," or the words "letters patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall affix the same, or any word, stamp, or device, of like import, on any unpatented article, for the purpose of deceiving the public, (*a*) he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, (*b*) with costs, to be recovered by action in any of the circuit courts of the United States, or in any of the district courts of the United States having the powers and jurisdiction of a circuit court; (*c*) one-half of which penalty, as recovered, shall be paid to the Patent fund, and the other half to any person or persons who shall sue for the same.

SECTION 6. *And be it further enacted*, That all patentees and assignees of patents hereafter granted, are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended, or offered for sale, the date of the patent; and if any person or persons, patentees or assignees, shall neglect to do so, he, she, or they, shall be liable to the same penalty, to be recovered and disposed of in the manner specified in the foregoing fifth section of this act. (*d*)

Approved August 29th, 1842.

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(*a*) The penalty mentioned in this section is incurred as to all articles made, and having the word "patent" affixed, with a guilty purpose or intent. *Stephens* v. *Caldwell*, MS.—SPRAGUE, J.; Mass., 1860.

(*b*) This section—though its phraseology, "a penalty of not less than one hundred dollars" is peculiar—authorizes the infliction of a penalty of just one hundred dollars for the offence therein described, and no more. *Stimpson* v. *Pond*, 2 Curt., 506.—CURTIS, J.; Mass., 1855.

The penalty may be recovered in an action of debt.—*Ibid.*, 506.

(*c*) The two years' limitation of suits for penalties, contained in § 32 of the Crimes act of 1790 (1 Stat. at Large, 119), is repealed by implication by § 4 of the act of 1839 (5 Stat. at Large, 322), which extends the time to five years. *Ibid.*, 503.

(*d*) Under this section it was held, that it was not the selling the articles unstamped that made the party liable to the penalty, but the omitting to put the stamp on. *Palmer* v. *Allen*, MS.—BETTS, J.; N. Y., 1854.

The assignees of an interest in a patent are no more liable for articles purchased

## ACT OF 1846, CHAPTER 90.

(9 STAT. AT LARGE, 62.)

Extract from the Act entitled "An act to provide for the better organization of the Treasury, and for the collection, safe-keeping, transfer, and disbursement of the public revenue."

SECTION 15. *And be it further enacted*, That all marshals, district attorneys, and others having public money to pay to the United States, and all patentees wishing to make payment for patents to be issued, may pay all such moneys to the Treasurer of the United States, or to the treasurer of either of the mints in Philadelphia or New Orleans, to either of the other assistant treasurers, or to such other depositary constituted by this act as shall be designated by the Secretary of the Treasury in other parts of the United States, to receive such payments, and give receipts or certificates of deposit therefor. (*a*)

Approved August 6th, 1846.

## ACT OF 1848, CHAPTER 47.

(9 STAT. AT LARGE, 231.)

An Act to provide additional examiners in the Patent Office, and for other purposes.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be appointed, in the manner provided in the second section of the act entitled "An

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and sold by them, without the date of the patent stamped on them, than any other persons, unless the articles were manufactured with their connivance. *Ibid.*

Held, also, that the penalty attaches for each separate article sold. *Ibid.*

It is necessary that each article should be stamped with the day of the month, as well as the year; but if this is done it is sufficient, even if the word "patented" is abbreviated. *Hawley* v. *Bagley*, MS.—BETTS, J.; N. Y., 1855.

This section is now repealed by the act of 1861, § 13.

(*a*) Under this act the following officers are authorized to receive patent fees on account of the Treasurer of the United States, and to give receipts or certificates of deposit therefor, to wit:

Assistant Treasurer of the United States, Boston, Massachusetts.
Assistant Treasurer of the United States, New York, New York.
Treasurer of the Mint, Philadelphia, Pennsylvania.
Surveyor and Inspector, Pittsburg, Pennsylvania.
Collector, Baltimore, Maryland.
Collector, Buffalo Creek, New York.
Assistant Treasurer United States, St. Louis, Missouri.
Surveyor of the Customs, Cincinnati, Ohio.
Receiver of Public Moneys, Jeffersonville, Indiana.
Receiver of Public Moneys, Chicago, Illinois.
Receiver of Public Moneys, Detroit, Michigan.
Collector, San Francisco, California.

act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six, two principal examiners, and two assistant examiners, in addition to the number of examiners now employed in the Patent Office; and that hereafter each of the principal examiners employed in the Patent Office shall receive an annual salary of twenty-five hundred dollars, and each of the assistant examiners an annual salary of fifteen hundred dollars: (*a*) *Provided*, That the power to extend patents now vested in the board composed of the Secretary of State, Commissioner of Patents, and Solicitor of the Treasury, by the eighteenth section of the act approved July fourth, eighteen hundred and thirty-six, respecting the Patent Office, shall hereafter be vested solely in the Commissioner of Patents; (*b*) and when an application is made to him for the extension of a patent according to said eighteenth section, and sixty days' notice given thereof, he shall refer the case to the principal examiner having charge of the class of inventions to which said case belongs, who shall make a full report to said Commissioner of the said case, and particularly whether the invention or improvement secured in the patent was new and patentable when patented; and thereupon the said Commissioner shall grant or refuse the extension of said patent, upon the same principles and rules that have governed said board; but no patent shall be extended for a longer term than seven years. (*c*)

SECTION 2. *And be it further enacted*, That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant or conveyance of the whole or any part of the interest in letters patent, or power of attorney, or license to make or use the thing patented, when such instrument shall not exceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of

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(*a*) The Commissioner of Patents is now authorized to appoint from time to time examiners, not to exceed four in each class. Act of 1861, § 7.

As to the gradation and pay of examiners and clerks in the Patent Office, see act of 1853, chap. 97, § 3, and act of 1860, § 5, and act of 1861, § 7.

(*b*) This act is not a repeal of § 18 of the act of 1836, providing for the extension of patents, and the enactment of a new system for that purpose, but simply a repeal of so much of it as related to the action of the Secretary of State, and the solicitor of the treasury, leaving the Commissioner of Patents alone to go on in the execution of the duty. *Colt* v. *Young*, 2 Blatchf., 473.—NELSON, J.; N. Y., 1852.

Where an application for an extension of a patent under § 18 of the act of 1836 was pending at the time of the passage of the act of 1848, which conferred upon the Commissioner of Patents solely, the power previously vested in the Board created by the act of 1836, *Held*, that it was not necessary to renew the application, but that the Commissioner had the power to go on with the proceedings as having been already properly instituted, and complete them by granting the extension. *Ibid.*, 473.

For reference to other decisions bearing upon the extension of patents, see § 18 of the act of 1836, and the notes thereto.

(*c*) The extension of all patents granted subsequently to March 2d, 1861, except patents for designs, which may be extended for seven years, is now prohibited. Act of 1861, § 16.

three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance. (*a*)

SECTION 3. *And be it further enacted*, That there shall be appointed, in manner aforesaid two clerks, to be employed in copying and recording, and in other services in the Patent Office, who shall each be paid a salary of one thousand two hundred dollars per annum.

SECTION 4. *And be it further enacted*, That the Commissioner of Patents is hereby authorized to send by mail, free of postage, the annual reports of the Patent Office, in the same manner in which he is empowered to send letters and packages relating to the business of the Patent Office.

Approved May 27th, 1848.

## ACT OF 1849, CHAPTER 108.

(9 STAT. AT LARGE, 395.)

*Extract from the act entitled* "An act to establish the Home Department, and to provide for the Treasury Department an Assistant Secretary of the Treasury and a Commissioner of the Customs."

SECTION 2. *And be it further enacted*, That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary of State; and the said Secretary of the Interior shall sign all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

Approved March 3d, 1849.

## ACT OF 1851, CHAPTER 32.

(9 STAT. AT LARGE, 617.)

Extract from the act entitled "An act making appropriations for the civil and diplomatic expenses of government," &c.

SECTION 2. *And be it further enacted*, That there shall be appointed and paid, in the manner now provided by law, two principal examiners and two assistent examiners of patents, in addition to the examining force now employed in the Patent Office. (*b*)

Approved March 3d, 1851.

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(*a*) The original provision as to fees for recording assignments, was contained in the act of 1836, § 11. That section was repealed by act of 1839, § 8. Fees for recording were again restored by this section, which is also re-enacted in act of 1861, § 10.

(*b*) The Commissioner of Patents is now authorized to appoint from time to time, examiners, not to exceed four in each class. Act of 1861, § 7.

## ACT OF 1852, CHAPTER 107.

(10 STAT. AT LARGE, 75.)

An Act in addition to an act to promote the progress of the Useful Arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That appeals provided for in the eleventh section of the act entitled "An act in addition to an act to promote the progress of the useful arts," approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the circuit court of the District of Columbia, and all the powers, duties, and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges. (*a*)

SECTION 2. *And be it further enacted*, That in case appeal shall be made to the said chief judge, or to either of the said assistant judges, the Commissioner of Patents shall pay to such chief judge or assistant judge the sum of twenty-five dollars, required to be paid by the appellant into the Patent Office by the eleventh section of said act, on said appeal.

SECTION 3. *And be it further enacted*, That section thirteen of the aforesaid act, approved March the third, eighteen hundred and thirty-nine, is hereby repealed.

Approved August 30th, 1852.

## ACT OF 1852, CHAPTER 108.

(10 STAT. AT LARGE, 95, 96.)

Extracts from the act entitled "An act making appropriations for the civil and diplomatic expenses of the government," &c.

For compensation of the librarian of the Patent Office, twelve hundred dollars to be paid out of the Patent Fund. (*b*)

For books for the library of the Patent Office, to be paid out of the Patent Fund, one thousand five hundred dollars.

For fitting up the library of the Patent Office, to be paid out of the Patent Fund, two thousand dollars.

For additional compensation to the disbursing clerk and draughtsman in the Patent Office, the sum of three hundred dollars each, to be paid out of the Patent Office Fund; and that hereafter the disbursing clerk shall be required to give

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(*a*) As to appeals to the justices of the Circuit Court, who may make, and when, see notes to §§ 7 and 8 of the act of 1836.

As to the power of such justices on appeal, and the effect of their action, see § 11 of the act of 1839, and the notes thereto.

(*b*) The salary of the librarian is now fixed at one thousand eight hundred dollars. Act of 1861, § 4.

bond, with approved security in the sum of five thousand dollars, conditioned for the faithful discharge of the duties of his office.

For the compensation of two additional permanent clerks in the Patent Office, to be appointed by the Commissioner of Patents, at a salary of fourteen hundred dollars each, the sum of twenty-eight hundred dollars, to be paid out of the Patent Office Fund.

Approved August 31st, 1852.

## ACT OF 1853, CHAPTER 97.

(10 STAT. AT LARGE, 209, 210, 211.)

Extracts from "An act making appropriations for the Civil and Diplomatic Expenses of the Government," &c.

SECTION 1. For the purchase of books for the library of the Patent Office, to be paid out of the patent fund, one thousand five hundred dollars.

SECTION 3. *And be it further enacted*, That from and after the thirtieth of June, eighteen hundred and fifty-three, the clerks in the Departments of the Treasury, War, Navy, the Interior, and the Post Office, shall be arranged into four classes, of which class number one shall receive an annual salary of nine hundred dollars each, class number two an annual salary of one thousand two hundred dollars each, class number three an annual salary of one thousand five hundred dollars each, and class number four an annual salary of one thousand eight hundred dollars each.

This section also provides for eight clerks of the second class, twelve (including six assistant examiners) of the third class, and one of the fourth class; (*a*) and also provides for an increase of the salary of the chief clerk to two thousand dollars. (*b*)

Approved March 3d, 1853.

## ACT OF 1855, CHAPTER 175.

(10 STAT. AT LARGE, 670, 674.)

Extracts from "An Act making appropriations for the civil and diplomatic expenses of Government," &c.

SECTION 10. *And be it further enacted*, That there shall be appointed and paid in the manner now provided by law, four principal examiners and four assistant

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(*a*) The Commissioner of Patents is now authorized to appoint examiners, not to exceed four in each class. Act of 1861, § 7.

As to the pay of examiners, see also act of 1860, § 5, and act of 1861, § 7.

(*b*) The salary of the chief clerk is now fixed at two thousand five hundred dollars Act of 1861, § 4.

examiners of patents, in addition to the examining force now authorized by law, to be so employed in the Patent Office; and should the necessities of the public service, in the estimation of the Commissioner of Patents, require any additional examining force to that herein provided, previous to the next session of Congress, there may also be appointed and paid in the manner now provided by law, in addition to the foregoing, not exceeding two principal and two assistant examiners, who shall not so continue to be employed subsequent to the expiration of said next session of Congress, without further provision of law. (*a*)

SECTION 25. *And be it further enacted*, That the first assistant examiners in the Patent Office shall be rated as of the fourth class of clerks, and the second assistant examiners, machinist, and librarian as of the third class.

Approved March 3d, 1855.

## ACT OF 1856, CHAPTER 129.

(11 STAT. AT LARGE, 91.)

Extracts from the "Act making appropriations for certain civil expenses of the Government," &c.

SECTION 9. *And be it further enacted*, That there shall be appointed and paid, in the manner now provided by law, two principal examiners and two assistant examiners, in addition to the examining force now authorized by law to be so employed in the Patent Office. (*b*)

SECTION 10. *And be it further enacted*, That the Commissioner of Patents is hereby authorized to pay those employed in the United States Patent Office from April first eighteen hundred and fifty-four, until April first eighteen hundred and fifty-five, as examiners and assistant examiners of patents, at the rates fixed by law for these respective grades: *Provided*, That the same be paid out of the Patent Office Fund, and that the compensation thus paid shall not exceed that received by those duly enrolled as examiners and assistant examiners of patents for the same period.

Approved August 18th, 1856.

## ACT OF 1859, CHAPTER 80.

(11 STAT. AT LARGE, 422.)

Extract from an "Act making appropriations for the legislative, and other expenses of the Government," &c.

SECTION 4. *And be it further enacted*, That the Secretary of the Interior be,

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(*a*) For provision as to the appointment of examiners by the Commissioner of Patents, see act of 1861, § 7.

(*b*) For provision authorizing the appointment of examiners by the Commissioner of Patents, see act of 1861, § 7.

and he is hereby, directed to cause the annual report of the Commissioner of Patents on mechanics hereafter to be made to the Senate and House of Representatives to be prepared and submitted in such manner as that the plates and drawings necessary to illustrate each subject shall be inserted so as to comprise the entire report in one volume not to exceed eight hundred pages.

Approved March 3d, 1859.

## ACT OF 1860, CHAPTER 211.

(12 STAT. AT LARGE, 110.)

Extract from an "Act making appropriations for sundry civil expenses of the Government," &c.

SECTION 5. *And be it further enacted*, That the Commissioner of Patents is hereby authorized to pay those employed in the Patent Office from April first, eighteen hundred and fifty-five, until April first, eighteen hundred and sixty, as examiners and assistant examiners of patents, at the rates fixed by law for these respective grades: *Provided*, that the same be paid out of the Patent Office Fund, and that the compensation thus paid shall not exceed that received by those duly enrolled as examiners and assistant examiners of patents for the same period.

Approved June 25th, 1860.

## ACT OF 1861, CHAPTER 37.

(12 STAT. AT LARGE, 130.)

An Act to extend the right of appeal from the decisions of circuit courts to the Supreme Court of the United States.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from all judgments and decrees of any circuit court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming to authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action. (*a*)

Approved February 18th, 1861.

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(*a*) The provision as to writs of error or appeals from judgments and decrees rendered in actions arising under the patent laws, previous to the passage of this act, is contained in the act of 1836, § 17.

# ACT OF 1861, CHAPTER 88.

(12 STAT. AT LARGE, 246.)

**An Act in addition to "An Act to promote the Progress of the Useful Arts."**

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, (*a*) and such affidavits and depositions may be taken before any justice of the peace, or other officer authorized by law to take depositions to be used in the courts of the United States, or in the state courts of any state where such officer shall reside; and in any contested case (*b*) pending in the Patent Office it shall be lawful for the clerk of any court of the United States for any district or territory, and he is hereby required, upon the application of any party to such contested case, or the agent or attorney of such party, to issue subpœnas for any witnesses residing or being within the said district or territory, commanding such witnesses to appear and testify before any justice of the peace, or other officer as aforesaid, residing within the said district or territory, at any time and place in the subpœna to be stated; and if any witness, after being duly served with such subpœna, shall refuse or neglect to appear, or, after appearing, shall refuse to testify, (not being privileged from giving testimony,) such refusal or neglect being proved to the satisfaction of any judge of the court whose clerk shall have issued such subpœna, said judge may thereupon proceed to enforce obedience to the process, or to punish the disobedience in like manner as any court of the United States may do in case of disobedience to process of *subpœna ad testificandum* issued by such court; and witnesses in such cases shall be allowed the same compensation as is allowed to witnesses attending the courts of the United States: (*c*) *Provided*, That no witnesses shall be required to attend at any place more than forty miles from the place where the subpœna shall be served upon him to give a deposition under this law: *Provided, also*, That no witness shall be deemed guilty of contempt for refusing to disclose any secret invention made or owned by him: *And provided, further*, That no witness shall be deemed guilty of contempt for disobeying any subpœna directed to him by virtue of this act, unless his fees for going to, returning from, and one day's attendance at the place of examination, shall be paid or tendered to him at the time of the service of the subpœna.

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(*a*) By the act of 1839, § 12, the Commissioner was empowered to make regulations as to taking evidence in contested cases. This act extends to all cases pending in the Patent Office.

(*b*) Whether, under this act, the power to compel the attendance of witnesses is not confined to "contested cases"—as cases of interference—*query*.

(*c*) Witnesses are allowed one dollar and fifty cents per day, and five cents per mile travelling from their places of residence to the place of trial or hearing, and five cents per mile for returning. Act of 1853, chap. 167, § 3.

ACT OF 1861, CHAP. 88, §§ 2–4.

SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners-in-chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents. (*a*)

SECTION 3. *And be it further enacted*, That no appeal shall be allowed to the examiners-in-chief from the decisions of the primary examiners, except in interference cases, until after the application shall have been twice rejected; (*a*) and the second examination of the application by the primary examiner shall not be had until the applicant, in view of the references given on the first rejection, shall have renewed the oath of invention, as provided for in the seventh section of the act entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six.

SECTION 4. *And be it further enacted*, That the salary of the Commissioner of Patents, from and after the passage of this act, shall be four thousand five hundred dollars per annum, and the salary of the chief clerk of the Patent Office

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### (*a*) NOTES TO §§ 2 AND 3.

1. Previous to this act, all judicial acts done in the Patent Office by the primary examiners or the board of appeals were, in intendment of law, the judicial acts of the Commissioner, and had no legal validity until sanctioned by him. They were the organs of the Commissioner to *inquire* and *enlighten* his judgment, and till the Commissioner gave validity to their judicial acts, by his *fiat*, they had no legal evidence as judgment. *Snowden* v. *Pierce* MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

2. Under the act of 1861, the primary examiners and examiners-in-chief are recognized as *judicial officers*, acting independently of the Commissioner, who can *only control them*, when their judgment in due course comes before the Commissioner, on appeal. *Ibid.*

3. Their acts are not the acts of the Commissioner, but their own acts. They are no longer *mere* organs of the Commissioner, but independent officers. He can only reach and overrule them, when their judgments come regularly before him, *on appeal*. *Ibid.*

4. The Commissioner can give no judgment till the appeal reaches him, and this cannot be done till the judgment of the primary examiners has been submitted to the examiners-in-chief. *Ibid.*

shall be two thousand five hundred dollars, and the salary of the librarian of the Patent Office shall be eighteen hundred dollars. (*a*)

SECTION 5. *And be it further enacted*, That the Commissioner of Patents is authorized to restore to the respective applicants, or when not removed by them, to otherwise dispose of such of the models belonging to rejected applications as he shall not think necessary to be preserved. The same authority is also given in relation to all models accompanying applications for designs. He is further authorized to dispense in future with models of designs when the design can be sufficiently represented by a drawing.

SECTION 6. *And be it further enacted*, That the tenth section of the act approved the third of March, eighteen hundred and thirty-seven, authorizing the appointment of agents for the transportation of models and specimens to the patent office, is hereby repealed.

SECTION 7. *And be it further enacted*, That the Commissioner is further authorized, from time to time, to appoint, in the manner already provided for by law, such an additional number of principal examiners, first assistant examiners, and second assistant examiners as may be required to transact the current business of the office with dispatch, provided the whole number of additional examiners shall not exceed four of each class, and that the total annual expenses of the patent office shall not exceed the annual receipts.

SECTION 8. *And be it further enacted*, That the Commissioner may require all papers filed in the patent office, if not correctly, legibly, and clearly written, to be printed at the cost of the parties filing such papers; and for gross misconduct he may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the Commissioner for such refusal shall be duly recorded, and be subject to the approval of the President of the United States.

SECTION 9. *And be it further enacted*, That no money paid as a fee on any application for a patent after the passage of this act shall be withdrawn or refunded, (*b*) nor shall the fee paid on filing a caveat be considered as part of the sum required to be paid on filing a subsequent application for a patent for the same invention. (*c*) That the three months' notice given to any caveator, in pursuance of the requirements of the twelfth section of the act of July fourth, eighteen hundred and thirty-six, shall be computed from the day on which such notice is deposited in the post office at Washington, with the regular time for the transmission of the same added thereto, which time shall be endorsed on the

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(*a*) Previous to this act, the salary of the Commissioner had been three thousand dollars per annum (act of 1836, § 1); that of the chief clerk, seventeen hundred dollars per annum (act of 1836, § 2); and the compensation of the librarian, twelve hundred dollars per annum (act of 1852; act of 1856, § 25.)

(*b*) The right of withdrawal was given to American applicants by the act of 1836, § 7; and was extended to foreigners by the act of 1837, § 12.

(*c*) The right of having a caveat fee applied as part of the sum to be paid upon a subsequent application, was given by the act of 1836, § 12.

notice; and that so much of the thirteenth section of the act of Congress, approved July fourth, eighteen hundred and thirty-six, as authorizes the annexing to letters patent of the description and specification of additional improvements is hereby repealed, and in all cases where additional improvements would now be admissible, independent patents must be applied for.

SECTION 10. *And be it further enacted*, That all laws now in force fixing the rates of the patent office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are hereby repealed, and in their stead the following rates are established:

On filing each caveat, ten dollars.

On filing each original application for a patent, except for a design, fifteen dollars.

On issuing each original patent, twenty dollars.

On every appeal from the examiners-in-chief to the Commissioner, twenty dollars.

On every application for the reissue of a patent, thirty dollars.

On every application for the extension of a patent, fifty dollars; and fifty dollars in addition, on the granting of every extension.

On filing each disclaimer, ten dollars.

For certified copies of patents and other papers, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, and other papers of three hundred words or under, one dollar.

For recording every assignment, and other papers, over three hundred and under one thousand words, two dollars.

For recording every assignment or other writing, if over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making the same.

SECTION 11. *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original design for a bust, statue or bas-relief, or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents, expressing such desire; and the

Commissioner, on due proceedings had, may grant a patent therefor as in the case now of application for a patent, for the term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application: *Provided*, that the fee to be paid in such application shall be for the term of three years and six months, ten dollars, for seven years, fifteen dollars, and for fourteen years, thirty dollars: *And, provided*, That the patentees of designs under this act, shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patent shall expire, upon the same terms and restrictions as are now provided for the extension of letters patent. (*a*)

SECTION 12. *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable; and all applications now pending shall be treated as if filed after the passage of this act, and all applications for the extension of patents, shall be filed at least ninety days before the expiration thereof; and notice of the day set for the hearing of the case shall be published, as now required by law, for at least sixty days. (*b*)

SECTION 13. *And be it further enacted*, That in all cases where an article is made or vended by any person under the protection of letters patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word patented, together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package or otherwise attaching thereto a label on which the notice, with the date, is printed; on failure of which, in any suit for the infringement of letters patent by the party failing so to mark the article the right to which is infringed upon, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented. And the sixth section of the act entitled "An act in addition to an act to promote the progress of the useful arts," and so forth, approved the twenty-ninth day of August, eighteen hundred and forty-two, be, and the same is hereby repealed. (*c*)

SECTION 14. *And be it further enacted*, That the Commissioner of Patents be, and he is hereby, authorized to print, or in his discretion to cause to be printed, ten copies of the description and claims of all patents which may hereafter be

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(*a*) This section supersedes § 3 of the act of 1842.

(*b*) The previous provisions as to the extension of patents are contained in § 18 of the act of 1836, and § 1 of the act of 1848, amending the former act of 1836.

(*c*) The act of 1842 imposed a penalty of one hundred dollars on each article vended or offered for sale, not having the date of the patent stamped or marked upon it; but the neglect to do so did not affect the right of the patentee in any action of infringement brought by him under his patent.

granted, and ten copies of the drawings of the same, when drawing shall accompany the patents: *Provided*, The costs of printing the text of said descriptions and claims shall not exceed, exclusive of stationery, the sum of two cents per hundred words for each of said copies, and the cost of the drawing shall not exceed fifty cents per copy; one copy of the above number shall be printed on parchment to be affixed to the letters patent; the work shall be under the direction, and subject to the approval, of the Commissioner of Patents, and the expense of the said copies shall be paid for out of the patent fund. (*a*)

SECTION 15. *And be it further enacted*, That printed copies of the letters patent of the United States, with the seal of the patent office affixed thereto and certified and signed by the Commissioner of Patents, shall be legal evidence of the contents of said letters patent in all cases.

SECTION 16. *And be it further enacted*, That all patents hereafter granted, shall remain in force for the term of seventeen years from the date of issue; and all extensions of such patents is hereby prohibited.

SECTION 17. *And be it further enacted*, That all acts and parts of acts heretofore passed, which are inconsistent with the provisions of this act, be, and the same are hereby, repealed.

Approved March 2d, 1861.

## ACT OF 1863, CHAPTER 102.

**An Act to amend an Act entitled "An Act to promote the progress of the Useful Arts."**

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That so much of section seven of the act entitled "An act to promote the progress of the useful arts," approved July 4th, 1836, as requires a renewal of the oath, be, and the same is hereby repealed.

SECTION 2. *And be it further enacted*, That, whereas the falling off of the revenue of the Patent Office required a reduction of the compensation of the examiners and clerks, or other employés of the office, after the 31st day of August, 1861, that the Commissioner of Patents be, and he is hereby authorized, whenever the revenue of the office will justify him in so doing, to pay them such sums, in addition to what they shall already have received, as will make their compensation the same as it was at that time.

SECTION 3. *And be it further enacted*, That every Patent shall be dated as of a day not later than six months after the time at which it was passed and allowed, and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within the said six months, the patent shall be withheld, and the invention therein described shall become public property as against the applicant therefor: *Provided*, That, in all cases where patents have been allowed previous to the passage of this act, the said six months shall be reckoned from the date of such passage.

Approved March 3, 1863.

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(*a*) This section repealed by act of July 16, 1862.

ACTS OF 1864, CHAP. 159; 1865, CHAP. 113; 1866, CHAP. 143.

## ACT OF 1864, CHAPTER 159.

(13 STAT. AT LARGE, 194.)

An Act amendatory of "An Act to amend an Act entitled an Act to promote the progress of the useful arts," approved March three, eighteen hundred and sixty-three.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person having an interest in an invention, whether as the inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided by said act, shall have the right to make the payment of such fee, and receive the patent withheld on account of the non-payment of said fee, provided such payment be made within six months from the date of the passage of this act: *Provided*, That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent as aforesaid was ordered to be issued.

Approved June 25, 1864.

## ACT OF 1865, CHAPTER 113.

(13 STAT. AT LARGE, 533.)

An Act amendatory of "An Act to amend an Act entitled an Act to promote the progress of the useful arts," approved March three, eighteen hundred and sixty-three.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person having an interest in an invention, whether as inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided in said act, shall have the right to make an application for a patent for his invention the same as in the case of an original application, provided such application be made within two years after the date of the allowance of the original application: *Provided*, That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent aforesaid was ordered to issue. This act shall apply to all cases now in the Patent Office, and also to such as shall hereafter be filed. And all acts or parts of acts inconsistent with this act are hereby repealed.

Approved March 3, 1865.

## ACT OF 1866, CHAPTER 143.

(14 STAT. AT LARGE, 76.)

An Act in amendment of an Act to promote the progress of the useful arts, and the Acts in amendment of and in addition thereto.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That upon appealing for the first time from the decision of the primary examiner to the examiners-in-chief in the Patent Office, the appellant shall pay a fee of ten dollars into the Patent Office, to the credit of the patent fund; and no appeal from the primary examiner to the examiners-in-chief shall hereafter be allowed until the appellant shall pay said fee.

Approved June 27, 1866.

ACT OF 1867, CHAP. 17; 1868, CHAP. 177, 227.

## ACT OF 1867, CHAPTER 17.

(15 STAT. AT LARGE, 10.)

[*This Act still in Force. Re-enactment of Act of* 1861, § 7.]

An Act to increase the force in the Patent Office.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the Commissioner of Patents is authorized from time to time to appoint, in the manner already provided for by law, such an additional number of principal examiners, first assistant examiners, and second assistant examiners, as may be required to transact the correct business of the office with dispatch: *Provided,* That the whole number of such additional examiners shall not exceed four of each class, and that the total annual expense of the Patent Office shall not exceed its annual receipts.

Approved March 29, 1867.

## ACT OF 1868, CHAPTER 177.

(15 STAT. AT LARGE, 119.)

[*This Act partly in Force and partly Temporary.*]

Extract from "An Act making appropriations for sundry civil expenses of the Government," &c.

SECTION 7. *And be it further enacted,* That the Commissioner of Patents be authorized to rent, under the direction of the committees on patents of the Senate and of the House of Representatives, such rooms as may be necessary for the speedy and convenient transaction of the business of the office: *Provided,* That all the moneys standing to the credit of the "Patent Fund," or in the hands of the Commissioner of Patents, and all moneys hereafter received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever; and the sum of two hundred and fifty thousand dollars is hereby appropriated for salaries, and miscellaneous and contingent expenses of the Patent Office, and for withdrawals, and for *monies* [moneys] paid by mistake, to be disbursed under the direction of the Secretary of the Interior. And it shall be the duty of the Commissioner of Patents to communicate to Congress at the commencement of every December session, a full and detailed account of moneys received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office; and of all moneys expended by him under and by virtue of this provision for said contingent and miscellaneous expenses, and for salaries, and the names of the persons to whom such salaries are paid, and the amount thereof paid to each.

Approved July 20, 1868.

## ACT OF 1868, CHAPTER 227.

(15 STAT. AT LARGE, 168.)

[*This Act still in Force.*]

Extract from "An Act to authorize the temporary supplying of vacancies in the executive departments."

*And provided also,* That in case of the death, resignation, absence, or sickness of the Commissioner of Patents, the duties of said commissioner, until a successor be appointed, or such absence or sickness shall cease, shall devolve upon the examiner-in-chief in said office oldest in length of commission.

Approved July 23d, 1868.

## ACT OF 1868, RESOLUTION No. 77.

(15 STAT. AT LARGE, 262.)

[*This Resolution still in Force.*]

**Joint Resolution relative to printing specifications of patents.**

*Be it resolved by the Senate and House of Representatives of the United States of America in Congress assembled*, That no bills be paid by the treasury for printing specifications of patents above the contract price, except that seventy cents may be added to each thousand words for the additional cost of composition occasioned by change made in printing by order of the Commissioner of Patents.

Approved July 27th, 1868.

## ACT OF 1869, CHAPTER 23.

(15 STAT. AT LARGE, 269.)

[*Temporary Act.*]

**An Act making appropriations for the payment of salaries and contingent expenses of the Patent Office, &c.**

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there be appropriated, out of any money in the treasury not otherwise appropriated, the sum of fifty-four thousand seven hundred and sixty-six dollars, for the payment of the salaries of the officers and employees of the Patent Office, and for the ordinary contingent expenses of said office, for the months of January and February, eighteen hundred and sixty-nine.

Approved February 9th, 1869.

## ACT OF 1869, CHAPTER 121.

(15 STAT. AT LARGE, 293.)

[*This Act in Force in Part, and partly Temporary.*]

**Extract from "An Act making appropriations for the legislative, executive, and judicial expenses of the Government," &c.**

*United States Patent Office.*—For compensation of the Commissioner of the Patent Office, four thousand five hundred dollars; for chief clerk, two thousand five hundred dollars; one superintendent of drawing for the annual report, two thousand five hundred dollars; for three examiners-in-chief, at three thousand dollars each, nine thousand dollars; twenty principal examiners, at two thousand five hundred dollars each, fifty thousand dollars; twenty first assistant examiners, at eighteen hundred dollars each, thirty-six thousand dollars; twenty second assistant examiners, at sixteen hundred dollars each, thirty-two thousand dollars; one librarian, one thousand eight hundred dollars; one machinist, one thousand six hundred dollars; one messenger, one thousand dollars; making, in all, the sum of one hundred and forty thousand nine hundred dollars.

For compensation of six clerks of class three, nine thousand six hundred dollars.

For thirty-five clerks of class two, forty-four thousand eight hundred dollars.

For forty clerks of class one, forty-eight thousand dollars.

For six permanent clerks, at one thousand dollars each, six thousand dollars.

For thirteen copyists of drawings, at one thousand dollars each, thirteen thousand dollars.

For fifty-three female copyists, at seven hundred dollars each, thirty-seven thousand one hundred dollars.

For nine permanent clerks, at nine hundred dollars each, eight thousand one hundred dollars.

For two skilled laborers, at twelve hundred dollars each, two thousand four hundred dollars.

For two skilled laborers, at one thousand dollars each, two thousand dollars.

For seven skilled laborers, at nine hundred dollars each, six thousand three hundred dollars.

For thirty laborers, at six hundred dollars each, eighteen thousand dollars.

For two laborers, at five hundred and seventy-six dollars each, one thousand one hundred and fifty-two dollars.

For one watchman, nine hundred dollars.

For five watchmen, at seven hundred and twenty dollars, three thousand six hundred dollars.

For seven laborers, at six hundred dollars each, four thousand two hundred dollars.

For contingent expenses of the Patent Office, viz.: For illustrations of annual report, stationery for use of office, printing patents, furniture for rooms, repairs, advertising, books for library, international exchanges, plumbing, gas-fitting, and other contingencies, one hundred and twenty thousand dollars; and no further or greater sum shall be paid, or contracted to be paid, for said contingent expenses; and it shall be the duty of the Commissioner of Patents to make a full and detailed report, to each December session of Congress, of the manner in which said contingent expenses have been disbursed: *Provided*, That with the exception of the Commissioner of Patents and the examiners-in-chief, all the officers, clerks, and employees of the Patent Office, shall be subject to the appointing and removing power of the Secretary of the Interior, in like manner and to the same extent as the clerks of the Pension Office are so subject under existing laws; and the disbursements of the Patent Office shall be made by the disbursing clerk of the Department of the Interior.

Approved March 3d, 1869.

## ACT OF 1869, CHAPTER 15.

(16 STAT. AT LARGE, 11.)

[*Temporary Act.*]

Extract from "An Act making appropriations to supply deficiencies in the appropriations for the service of Government," &c.

For compensation of two additional examiners in the Patent Office, at two thousand five hundred dollars each, five thousand dollars.

For twenty-one clerks, class two, in the Patent Office, at fourteen hundred dollars each, twenty-nine thousand four hundred dollars.

For fourteen clerks, class one, in the Patent Office, at twelve hundred dollars each, sixteen thousand eight hundred dollars.

# ACT OF 1870, CHAPTER 230.

## (15 STAT. AT LARGE, 198.)

"An Act to revise, consolidate, and amend the statutes relating to patents and copyrights."

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be attached to the Department of the Interior the office, heretofore established, known as the Patent Office, wherein all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

SEC. 2. *And be it further enacted,* That the officers and employees of said office shall continue to be one Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, to be appointed by the President, by and with the advice and consent of the Senate; one chief clerk, one examiner in charge of interferences, twenty-two principal examiners, twenty-two first assistant examiners, twenty-two second assistant examiners, one librarian, one machinist, five clerks of class four, six clerks of class three, fifty clerks of class two, forty-five clerks of class one, and one messenger and purchasing clerk, all of whom shall be appointed by the Secretary of the Interior, upon nomination of the Commissioner of Patents.

SEC. 3. *And be it further enacted,* That the Secretary of the Interior may also appoint, upon like nomination, such additional clerks of classes two and one, and of lower grades, copyists of drawings, female copyists, skilled laborers, laborers, and watchmen, as may be from time to time appropriated for by Congress.

SEC. 4. *And be it further enacted,* That the annual salaries of the officers and employees of the Patent Office shall be as follows:

Of the Commissioner of Patents, four thousand five hundred dollars.
Of the Assistant Commissioner, three thousand dollars.
Of the examiners-in-chief, three thousand dollars each.
Of the chief clerk, two thousand five hundred dollars.
Of the examiner, in charge of interferences, two thousand five hundred dollars.
Of the principal examiners, two thousand five hundred dollars each.
Of the first assistant examiners, one thousand eight hundred dollars each.
Of the second assistant examiners, one thousand six hundred dollars each.
Of the librarian, one thousand eight hundred dollars.
Of the machinist, one thousand six hundred dollars.
Of the clerks of class four, one thousand eight hundred dollars each.
Of the clerks of class three, one thousand six hundred dollars each.
Of the clerks of class two, one thousand four hundred dollars each.
Of the clerks of class one, one thousand two hundred dollars each.
Of the messenger and purchasing clerk, one thousand dollars.
Of laborers and watchmen, seven hundred and twenty dollars each.

Of the additional clerks, copyists of drawings, female copyists and skilled laborers, such rates as may be fixed by the acts making appropriations for them.

SEC. 5. *And be it further enacted,* That all officers and employees of the Patent Office shall, before entering upon their duties, make oath or affirmation truly and faithfully to execute the trusts committed to them.

SEC. 6. *And be it further enacted*, That the commissioner and chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their duties, and that they will render to the proper officers of the treasury a true account of all money received by virtue of their office.

SEC. 7. *And be it further enacted*, That it shall be the duty of the Commissioner, under the direction of the Secretary of the Interior, to superintend or perform all the duties respecting the granting and issuing of patents which herein are, or may hereafter be, by law directed to be done; and he shall have charge of all books, records, papers, models, machines, and other things belonging to said office.

SEC. 8. *And be it further enacted*, That the Commissioner may send and receive by mail, free of postage, letters, printed matter, and packages relating to the business of his office, including Patent Office reports.

SEC. 9. *And be it further enacted*, That the Commissioner shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subject of such patents; an alphabetical list of the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public.

SEC. 10. *And be it further enacted*, That the examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

SEC. 11. *And be it further enacted*, That in case of the death, resignation, absence, or sickness of the Commissioner, his duties shall devolve upon the Assistant Commissioner until a successor shall be apponited, or such absence or sickness shall cease.

SEC. 12. *And be it further enacted*, That the Commissioner shall cause a seal to be provided for said office, with such device as the President may approve, with which all records or papers issued from said office, to be used in evidence, shall be authenticated.

SEC. 13. *And be it further enacted*, That the Commissioner shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in said office; and said rooms and galleries shall be kept open during suitable hours for public inspection.

SEC. 14. *And be it further enacted*, That the Commissioner may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treasury, as other patent moneys are directed to be paid.

SEC. 15. *And be it further enacted*. That there shall be purchased, for the use of said office, a library of such scientific works and periodicals, both foreign and

American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated by Congress for that purpose.

SEC. 16. *And be it further enacted*, That all officers and employees of the Patent Office shall be incapable, during the period for which they shall hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by said office.

SEC. 17. *And be it further enacted*, That for gross misconduct the Commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded and be subject to the approval of the Secretary of the Interior.

SEC. 18. *And be it further enacted*, That the Commissioner may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

SEC. 19. *And be it further enacted*, That the Commissioner, subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

SEC. 20. *And be it further enacted*, That the Commissioner may print or cause to be printed copies of the specifications of all letters patent and of the drawings of the same, and copies of the claims of current issues, and copies of such laws, decisions, rules, regulations, and cirulars as may be necessary for the information of the public.

SEC. 21. *And be it further enacted*, That all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner, and they shall be recorded, together with the specification, in said office, in books to be kept for that purpose.

SEC. 22. *And be it further enacted*, That every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the said invention or discovery throughout the United States and the Territories thereof, referring to the specifications for the particulars thereof; and a copy of said specifications and of the drawings shall be annexed to the patent, and be a part thereof.

SEC. 23. *And be it further enacted*, That every patent shall date as of a day not later than six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant, or his agent; and if the final fee shall not be paid within that period, the patent shall be withheld.

SEC. 24. *And be it further enacted*, That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor.

SEC. 25. *And be it further enacted*, That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country: provided the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or if there be

more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years.

SEC. 26. *And be it further enacted*, That before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery; and said specification and claim shall be signed by the inventor and attested by two witnesses.

SEC. 27. *And be it further enacted*, That when the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of said drawings, to be furnished by the Patent Office, shall be attached to the patent as part of the specification.

SEC. 28. *And be it further enacted*, That when the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition sufficient in quantity for the purpose of experiment.

SEC. 29. *And be it further enacted*, That in all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish one of convenient size to exhibit advantageously the several parts of his invention or discovery.

SEC. 30. *And be it further enacted*, That the applicant shall make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. And said oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be.

SEC. 31. *And be it further enacted*, That on the filing of any such application and the payment of the duty required by law, the Commissioner shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

SEC. 32. *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

SEC. 33. *And be it further enacted*, That patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer; and, also, if he be living, in case of an application for re-issue.

SEC. 34. *And be it further enacted*, That when any person having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application shall be made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

SEC. 35. *And be it further enacted*, That any person who has an interest in an invention or discovery, whether as an inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who has failed to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application: *Provided*, That the second application be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent, as aforesaid, was ordered to issue, prior to the issue thereof; *And provided further*, That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months from the date of such passage to renew his application, or to file a new one; and if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment shall be considered as a question of fact.

SEC. 36. *And be it further enacted*, That every patent, or any interest therein, shall be assignable in law, by an instrument in writing; and the patentee, or his assigns or legal representatives, may in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States; and said assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

SEC. 37. *And be it further enacted*, That every person who may have purchased of the inventor, or with his knowledge and consent may have constructed, any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or sold or used one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

SEC. 38. *And be it further enacted*, That it shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by

the party failing so to mark, no damages shall be recovered by the plaintiff except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

SEC. 39. *And be it further enacted,* That if any person shall, in any manner, mark 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 shall in any manner mark upon or affix to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee, or his assigns or legal representatives; or shall in any manner mark upon or affix to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, he shall be liable for every such offense to a penalty of not less than one hundred dollars, with costs; one moiety of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

SEC. 40. *And be it further enacted,* That any citizen of the United States who shall have made any new invention or discovery, and shall desire further time to mature the same, may, on payment of the duty required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention; and such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application shall be made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person filing the caveat, who, if he would avail himself of his caveat, shall file his description, specifications, drawings, and model within three months from the time of placing said notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto, which time shall be indorsed on the notice. And an alien shall have the privilege herein granted, if he shall have resided in the United States one year next preceding the filing of his caveat, and made oath of his intention to become a citizen.

SEC. 41. *And be it further enacted,* That whenever, on examination, any claim for a patent is rejected for any reason whatever, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

SEC. 42. *And be it further enacted,* That whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the prim-

ary 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.

SEC. 43. *And be it further enacted*, That the Commissioner may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

SEC. 44. *And be it further enacted*, That the Clerk of any court of the United States for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue [*a*] subpœna for any witness residing or being within said district or territory, commanding him to appear and testify before any officer in said district or territory authorized to take depositions and affidavits, at any time and place in the subpœna stated; and if any witness, after being duly served with such subpœna, shall neglect or refuse to appear, or, after appearing, shall refuse 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.

SEC. 45 *And be it further enacted*, That 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, but no witness shall be required to attend any place more than forty miles from the place where the subpœna is served upon him, nor 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.

SEC. 46. *And be it further enacted*, That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference, in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law.

SEC. 47. *And be it further enacted*, That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the Commissioner in person.

SEC. 48. *And be it further enacted* That if such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia sitting in banc.

SEC. 49. *And be it further enacted*, That when an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 50. *And be it further enacted*, That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint, notifying the Commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and govern the further proceedings in the case. But no opinion or decision of the court in any such case

shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 51. *And be it further enacted*, That on receiving notice of the time and place of hearing such appeal, the Commissioner shall notify all parties who appear to be interested therein, in such manner as the court may prescribe. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish it with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the machine or other thing for which a patent is demanded.

SEC. 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the Commissioner or by the Supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the Commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

SEC. 53. *And be it further enacted*, That whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specifications, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and the Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. And the specification and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model or drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

SEC. 54. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee

has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the duty required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; said disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

SEC. 55. *And be it further enacted*, That all actions, suits, controversies, and cases arising under the patent laws of the United States shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the powers and jurisdiction of a circuit court, or by the supreme court of the District of Columbia, or of any Territory; and the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the *claimant* [complainant] has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by said act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters patent shall be granted or extended, or within six years after the expiration thereof.

SEC. 56. *And be it further enacted*, That a writ of error or appeal to the supreme court of the United States shall lie from all judgments and decrees of any circuit court, or of any district court exercising the jurisdiction of a circuit court, or of the supreme court of the District of Columbia or of any Territory, in any action, suit, controversy, or case, at law or in equity, touching patent rights, in the same manner and under the same circumstances as in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy.

SEC. 57. *And be it further enacted*, That written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent under the signature of the Commissioner or acting Commissioner, with the seal of office affixed, shall be competent evidence in all cases wherein the originals could be evidence, and any person making applications therefor, and paying the fee required by law, shall have certified copies thereof. And copies of the specifications and drawings of foreign letters patent, certified in like manner, shall be prima facie evidence of the fact of the granting of such foreign letters patent and of the date and contents thereof.

SEC. 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as

hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

SEC. 59. *And be it further enacted*, That damages for the infringement of any patent may be recovered by action on the case in any circuit court in the United States, or district court exercising the jurisdiction of a circuit court, or in the supreme court of the district of Columbia, or of any Territory, in the name of the party interested, either as patentee, assignee or grantee. And whenever in any such action a verdict shall be rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

SEC. 60. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee shall have (in his specification) claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer.

SEC. 61. *And be it further enacted*, That in any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

SEC. 62. *And be it further enacted*, That whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented, or described in a printed publication.

SEC. 63. *And be it further enacted*, That where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement, under oath, of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of said invention or discovery. And said application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent, and no extension shall be granted after the expiration of said original term.

SEC. 64. *And be it further enacted*, That upon the receipt of such application, and the payment of the duty required by law, the Commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted.

SEC. 65. *And be it further enacted*, That on the publication of such notice, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make to said Commissioner a full report of the case, and particularly whether the invention or discovery was new and patentable when the original patent was granted.

SEC. 66. *And be it further enacted*, That the Commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to his satisfaction that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the said Commissioner shall make a certificate thereon, renewing and extending the said patent for the term of three years from the expiration of the first term, which cer-

tificate shall be recorded in the Patent Office, and thereupon the said patent shall have the same effect in law as though it had been originally granted for twenty-one years.

SEC. 67. *And be it further enacted*, That the benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented to the extent of their interest therein.

SEC. 68. *And be it further enacted*, That the following shall be the rates for patent fees:

On filing each original application for a patent, fifteen dollars.

On issuing each original patent, twenty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from 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, 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.

SEC. 69. *And be it further enacted*, That patent fees may be paid to the Commissioner, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit, therefor. And all money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever; and all disbursements for said office shall be made by the disbursing clerk of the Interior Department.

SEC. 70. *And be it further enacted*, That the Treasurer of the United States is authorized to pay back any sum or sums of money to any person who shall have paid the same into the treasury, or to any receiver or depositary, to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, certificate thereof being made to said Treasurer by the Commissioner of Patents.

## DESIGNS.

SEC. 71. *And be it further enacted*, That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief, any new and original design for the printing of 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 article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may,

upon payment of the duty required by law, and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor.

SEC. 72. *And be it further enacted*, That the Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

SEC. 73. *And be it further enacted*, That patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

SEC. 74. *And be it further enacted*, That patentees of designs issued prior to March two, 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.

SEC. 75. *And be it further enacted*, That the following shall be the rates of fees in design cases:

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

For all other cases in which fees are required, the same rates as in cases of inventions or discoveries.

SEC. 76. *And be it further enacted*, That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs.

## TRADE-MARKS.

SEC. 77. *And be it further enacted*, That 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:

1st. By causing to be recorded in the Patent Office the names of the parties and their residences and places of business, who desire the protection of the trade-mark.

2d. 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.

3d. 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.

4th. The length of time, if any, during which the trade-mark has been used.

5th. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.

6th. The compliance with such regulations as may be prescribed by the commissioner of patents.

7th. 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 the 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.

SEC. 78. *And be it further enacted*, That such trade-mark 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; and during the period that it remains in force it 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: *Provided*, That six months prior to the expiration of said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the Commissioner of Patents, and the fee for such renewal shall be the same as for the original registration; 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: *And provided further*, That nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

SEC. 79. *And be it further enacted*, That any person or corporation who shall reproduce, counterfeit, copy, or imitate any such 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 in the case for damages for such wrongful use of said trade-mark, at the suit of the owner thereof, in any court of competent jurisdiction in the United States, 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. The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot 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: *Provided*, That this section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act.

SEC. 80. *And be it further enacted*, That the time of the receipt of any trade-mark at the Patent Office for registration shall be noted and recorded, and 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.

SEC. 81. *And be it further enacted*, That the Commissioner of Patents is author-

ized to make rules, regulations, and prescribe forms for the transfer of the right to the use of such trade-marks, conforming as nearly as practicable to the requirements of law respecting the transfer and transmission of copyrights.

SEC. 82. *And be it further enacted*, That any person who shall procure the *the* registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark in the Patent Office under this act, by making any false or fraudulent representation, or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case before any court of competent jurisdiction within the United States.

SEC. 83. *And be it further enacted*, That nothing in this act 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 this act had not been passed.

SEC. 84. *And be it further enacted*, That no action shall be maintained under the provisions of this act 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.

## COPYRIGHTS.

SEC. 85. *And be it further enacted*, That 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. The Librarian shall cause a seal to be provided for said office, with such device as the Joint Committee on the Library may approve, with which all records or papers issued from said office, and to be used in evidence, shall be authenticated. He shall also give an additional 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 officers of the Treasury a true account of all moneys received by virtue of his office. He shall also make an annual report to Congress of the number and description of copyright publications for which entries have been made during the year. And the Librarian of Congress shall receive a yearly compensation of four thousand dollars, to commence when this act shall take effect.

SEC. 86. *And be it further enacted*, That 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 models or designs intended to be perfected as works of the fine arts, and his executors, administrators, or assigns, shall, upon complying with the provisions of this act, 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.

SEC. 87. *And be it further enacted*, That copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

SEC. 88. *And be it further enacted*, That 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.

SEC. 89. *And be it further enacted*, That 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.

SEC. 90. *And be it further enacted*. That no person shall be entitled to a copyright unless he shall, before publication, deposit in the mail a printed copy of the title of the book or other article, or a description of the painting, drawing, chromo, statue, statuary, or model or design for a work of the fine arts, for which he desires a copyright, addressed to the Librarian of Congress, and, within ten days from the publication thereof, deposit in the mail 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, to be addressed to said Librarian of Congress, as hereinafter to be provided.

SEC. 91. *And be it further enacted*, That 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 ————, anno Domini, ————, 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 said proprietor, whenever he shall require it.

SEC. 92. *And be it further enacted*, That for recording the title or description of any copyright book or other article, the Librarian of Congress shall receive, from the person claiming the same, fifty cents; and for every copy under seal actually given to such person or his assigns, fifty cents; and for recording any instrument of writing for the assignment of a copyright, fifteen cents for every one hundred words; and for every copy thereof, ten cents for every one hundred words, which moneys, so received, shall be paid into the treasury of the United States.

SEC. 93. *And be it further enacted*, That the proprietor of every copyright book or other article shall mail to the Librarian of Congress at Washington, 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.

SEC. 94. *And be it further enacted*, That in default of such deposit in the post-office, said proprietor shall be liable to a penalty of twenty-five dollars, to be collected by the Librarian of Congress, in the name of the United States, in an action of debt, in any district court of the United States within the jurisdiction of which the delinquent may reside or be found.

SEC. 95. *And be it further enacted*, That any such copyright book or other article may be sent to the Librarian of Congress by mail, free of postage, provided the words "Copyright matter" are plainly written or printed on the outside of the package containing the same.

SEC. 96. *And be it further enacted*, That 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, without cost to the proprietor.

SEC. 97. *And be it further enacted*, 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 portion of the face or front thereof, or on the face 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."

SEC. 98. *And be it further enacted*, That if any person 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 articles herein named, for which he has not obtained a copyright, every person so offending shall forfeit and pay one hundred dollars; one moiety thereof to the person who shall sue for the same, and the other to the use of the United States, to be recovered by action in any court of competent jurisdiction.

SEC. 99. *And be it further enacted*, That if any person, after the recording of the title of any book as herein provided, 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, such offender shall forfeit every copy thereof to said 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.

SEC. 100. *And be it further enacted*, That 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 herein provided, 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 said 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, pub-

lished, 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 which have by him been sold or exposed for sale; one moiety thereof to the proprietor and the other to the use of the United States, to be recovered by action in any court of competent jurisdiction.

SEC. 101. *And be it further enacted*, That 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, to be recovered by action in any court of competent jurisdiction; said 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.

SEC. 102. *And be it further enacted*, That any person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained (if such author or proprietor be a citizen of the United States, or resident therein), shall be liable to said author or proprietor for all damages occasioned by such injury, to be recovered by action on the case in any court of competent jurisdiction.

SEC. 103. *And be it further enacted*, That nothing herein contained 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.

SEC. 104. *And be it further enacted*, That 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.

SEC. 105. *And be it further enacted*, That in all actions arising under the laws respecting copyrights, the defendant may plead the general issue, and give the special matter in evidence.

SEC. 106. *And be it further enacted*, That all actions, suits, controversies, and cases arising under the copyright laws of the United States shall be originally cognizable, as well in equity as at law, whether civil or penal in their nature, by the circuit courts of the United States, or any district court having the jurisdiction of a circuit court, or in the supreme court of the District of Columbia, or any Territory. And the court shall have power, upon bill in equity, filed by any party aggrieved, to grant injunctions to prevent the violation of any right secured by said laws, according to the course and principles of courts of equity, on such terms as the court may deem reasonable.

SEC. 107. *And be it further enacted*, That a writ of error or appeal to the supreme court of the United States shall lie from all judgments and decrees of any court, in any action, suit, controversy, or case touching copyrights in the same manner and under the same circumstances as in other judgments and decrees of such courts, without regard to the sum or value in controversy.

SEC. 108. *And be it further enacted*, That in all recoveries under the copyright laws, either for damages, forfeitures, or penalties, full cost shall be allowed thereon.

SEC. 109. *And be it further enacted*, That all books, maps, charts, and other publications of every nature whatever, heretofore deposited in the Department of the Interior, according to the laws regulating copyrights, together with all the records of said department, and all records concerning the same which were removed by the Department of the Interior from the Department of

State, shall be removed to and be under the control of the Librarian of Congress, who is hereby charged with all the duties pertaining to copyrights required by law.

SEC. 110. *And be it further enacted*, That the clerk of each of the district courts of the United States shall transmit forthwith to the Librarian of Congress all books, maps, prints, photograp[h]s, music, and other publications of every nature whatever, deposited in the said clerk's office, and not heretofore sent to the Department of the Interior, at Washington, together with all records of copyright in his possession, including the titles so recorded and the dates of record; *Provided*, That where there are duplicate copies of legal, scientific, or mechanical works, one copy of each may be deposited in the library of the Patent Office, for which a receipt shall be given by the Commissioner of Patents to the Librarian of Congress.

## REPEALING CLAUSE AND SCHEDULE.

SEC. 111. *And be it further enacted*, That the acts and parts of acts set forth in the schedule of acts cited, hereto annexed, are hereby repealed, without reviving any acts or parts of acts repealed by any of said acts, or by any clause or provisions therein: *Provided, however*, That the repeal hereby enacted shall not affect, impair, or take away any right existing under any of said laws; but all actions and causes of action, both in law and in equity, which have arisen under any of said laws, may be commenced and prosecuted, and if already commenced may be prosecuted to final judgment and execution, in the same manner a though this act had not been passed, excepting that the remedial provisions of this act shall be applicable to all suits and proceedings hereafter commenced: *And provided also*, That all applications for patents pending at the time of the passage of this act in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof: *And provided further*, That all offences which are defined and punishable under any of said acts, and all penalties and forfeitures created thereby, and incurred before this act takes effect, may be prosecuted, sued for, and recovered, and such offences punished according to the provisions of said acts, which are continued in force for such purpose.

*Schedule of statutes cited and repealed, as printed in the Statutes at Large, including such portions only of the appropriation bills referred to as are applicable to the Patent Office.*

### PATENTS.

Act of July 4, 1836, chapter 357, volume 5, page 117.
March 3, 1837, chapter 45, volume 5, page 191.
March 3, 1839, chapter 88, volume 5, page 353.
August 29, 1842, chapter 263, volume 5, page 543.
August 6, 1846, chapter 90, volume 9, page 59.
May 27, 1848, chapter 47, volume 9, page 231.
March 3, 1849, chapter 108, volume 9, page 395.

Act of March 3, 1851, chapter 32, volume 9, page 617.
August 30, 1852, chapter 107, volume 10, page 75.
August 31, 1852, chapter 108, volume 10, page 76.
March 3, 1853, chapter 97, volume 10, page 209.
April 22, 1854, chapter 52, volume 10, page 276.
March 3, 1855, chapter 175, volume 10, page 643.
August 18, 1856, chapter 129, volume 11, page 81.
March 3, 1859, chapter 80, volume 11, page 410.
February 18, 1861, chapter 37, volume 12, page 130.
March 2, 1861, chapter 88, volume 12, page 246.
March 3, 1863, chapter 102, volume 12, page 796.
June 25, 1864, chapter 159, volume 13, page 194.
March 3, 1865, chapter 112, volume 13, page 533.
June 27, 1866, chapter 143, volume 14, page 76.
March 29, 1867, chapter 17, volume 15, page 10.
July 20, 1868, chapter 177, volume 15, page 119.
July 23, 1868, chapter 227, volume 15, page 168.
March 3, 1869, chapter 121, volume 15, page 293.

## COPYRIGHTS.

Act of February 15, 1819, chapter 19, volume 3, page 481.
February 3, 1831, chapter 16, volume 4, page 436.
June 30, 1834, chapter 157, volume 4, page 728.
August 18, 1856, chapter 169, volume 11, page 138.
February 5, 1859, chapter 22, volume 11, page 380.
February 18, 1861, chapter 37, volume 12, page 130.
March 3, 1865, chapter 126, volume 13, page 540.
February 18, 1867, chapter 43, volume 14, page 395.
Approved, July 8, 1870.

## ACT OF 1871, CHAPTER 132.

(16 STAT. AT LARGE, 583.)

An Act to amend an Act, to revise, consolidate and amend the Statutes relating to patents and copyrights.

Be it enacted by the Senate and House of Representatives of the United States of America, in Congress assembled, That that part of section 33, of an Act entitled "An Act to revise, consolidate, and amend the Statutes relating to patents and copyrights," Approved July eight, eighteen hundred and seventy, which requires that in case of application by assignee or assignees for Reissue of Letters Patent, the application shall be made, and the specification sworn to by the inventor or discoverer, if living, shall not be construed to apply to patents issued and assigned prior to July eight, eighteen hundred and seventy.

Approved, March 3, 1871.

# JOINT RESOLUTION OF 1871, NO. 5.

## (16 STAT. AT LARGE, 590.)

**Joint resolution providing for publishing specifications and drawings of Patent Office.**

Be it resolved by the Senate and House of Representatives of the United States of America, in Congress assembled, that the publication of the abstracts of specifications, and of the engravings heretofore accompanying the annual report of the Commissioner of Patents be discontinued after the publication of that portion of the report for eighteen hundred and sixty-nine, for which the plates have already been prepared; and that, in lieu thereof, the Commissioner be authorized to have printed, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent subsequently issued, together with suitable indexes to be issued from time to time, 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 taken and received in all courts as evidence of all matters therein contained, and shall be certified to under the hand of the Commissioner and seal of the Patent Office, and shall be taken and received in all courts as evidence; said copies not to be taken from said depositories for any other purpose than to be used as evidence; and the Commissioner of Patents is hereby authorized and directed to have printed such additional number of copies of specifications and drawings, certified as hereinbefore provided, 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 the Commissioner is also hereby 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 proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable.

Approved January 11, 1871.

# ACT OF 1871, CHAPTER 5.

## (17 STAT. AT LARGE, 2.)

**An Act to further regulate the publication of the specifications and drawings of the Patent Office.**

Be it enacted by the Senate and House of Representatives of the United States of America, in Congress assembled, that if, in the judgment of the Joint Committee on Printing, the provisions of the joint resolution providing for publishing specifications and drawings of the Patent Office, approved January 11, eighteen hundred and seventy-one, can be performed under the direction of the Commissioner of

Patents more advantageously than in the manner provided in said joint-resolution, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe.

SEC. 2. That the price of the printed copies of specifications and drawings of patents, when uncertified, shall be determined by the Commissioner of Patents, ten cents being hereby fixed as the minimum, and fifty cents as the maximum price of the same; certified copies to be sold at the price fixed by the Patent Act of eighteen hundred and seventy.

Approved March 24, 1871.

# INDEX

TO

# COPYRIGHT LAWS.


| | | PAGE. | SEC. |
|---|---|---|---|
| **Actions, under Copyright Laws,** | | | |
| | cognizable in Circuit Courts of the United States, | 14 | |
| | " " " | 130 | 106 |
| | for forfeitures or penalties, when to be brought, | 9 | 2 |
| | " " " | 24 | 13 |
| | " " " | 29 | 1 |
| | " " " | 130 | 104 |
| | for printing or publishing manuscripts, when lie, | 11 | 6 |
| | " " " " | 22 | 9 |
| | " " " " | 129 | 97 |
| | full costs allowed in, | 24 | 12 |
| | " " | 130 | 108 |
| | defences in, | 11 | 7 |
| | " | 23 | 10 |
| | " | 130 | 105 |
| **Appeals in Copyright Cases,** | | | |
| | when lie to Supreme Court from Circuit Court, | 15 | |
| | " " " | 29 | |
| **Assignment of Copyrights,** | | | |
| | to be in writing, | 25 | 1 |
| | " " | 128 | 89 |
| | to be acknowledged, | 25 | 1 |
| | where to be recorded, | 26 | 1 |
| | " " | 128 | 865 |
| | when to be recorded, | 26 | 1 |
| | " " | 128 | 87 |
| | neglect to record, effect of, | 26 | 1 |
| | " " " | 128 | 89 |
| | fees for recording, | 26 | 2 |
| **Book,** | | | |
| | what construed to include, | 29 | 4 |

| | PAGE. | SEC. |
|---|---|---|
| **Books, Copyright of,** | | |
| who may acquire, | 8 | 1 |
| " " | 15 | 1 |
| " " | 127 | 86 |
| how acquired, | 10 | 3, 4 |
| " | 12 | 1 |
| " | 18 | 4 |
| " | 19 | 5 |
| " | 127 | 86 |
| how forfeited, | 29 | 3 |
| infringement of, penalty for, | 9 | 2 |
| " " | 20 | 6 |
| **Charts, see MAPS.** | | |
| **Circuit Courts, see COURTS** | | |
| **Clerk of District Court,** | | |
| to record titles of books, | 10 | 3 |
| " " | 18 | 4 |
| copy of book to be deposited, with, | 19 | 4 |
| to transmit to Secretary of State records and books deposited, | 19 | 4 |
| to transmit all copyright records to Librarian of Congress, | 131 | 110 |
| fees of, for recording titles, and copies of same, | 10 | 3 |
| " " " | 19 | 4 |
| " " assignments, | 23 | 2 |
| **Congress Library,** | | |
| copy of books, &c., copyrighted to be deposited in, | 26 | 10 |
| act requiring repealed, | 28 | 6 |
| act requiring re-enacted, | 29 | 2 |
| records, &c., of copyrights preserved in, | 127 | 85 |
| seal of, | 127 | 85 |
| **Copyright of Books, Maps, &c.,** | | |
| who may have and enjoy, | 8 | 1 |
| " " | 15 | 1 |
| " " | 127 | 86 |
| how obtained, | | |
| how forfeited, | 29 | 3 |
| printed copy of title to be deposited, | 10 | 3 |
| " " " | 18 | 4 |
| " " " | 128 | 90 |
| copy of book to be deposited with Secretary of State, | 10 | 4 |
| " " Clerk of Court, | 19 | 4 |
| " " Librarian Smithsonian Institute, | 26 | 10 |
| " " " of Congress, | 26 | 10 |
| " " " " | 128 | 90 |
| " " " " | 128 | 93 |
| " " " " | 29 | 2 |

| | | |
|---|---|---|
| **Librarian of Congress**—*continued.* | | |
| assignments to be recorded in office of | 128 | 89 |
| copy of book, &c., to be deposited with, | 128 | 90 |
| to record name of copyright book, &c., | 128 | 91 |
| two printed copies of books to be mailed to, | 128 | 93 |
| copy of book, &c., sent to, free of postage, | 129 | 95 |
| **Manuscripts,** | | |
| printing, &c., without author's consent, prohibited, | 11 | 6 |
| " " " | 22 | 9 |
| " " " | 130 | 102 |
| damages recoverable in such case, | 11 | 6 |
| " " " | 22 | 9 |
| " " " | 130 | 102 |
| injunction to restrain publication of, | 22 | 9 |
| **Maps Charts, &c., Copyright in.** | | |
| who may acquire, | 8 | 8 |
| " | 15 | 1 |
| " | 127 | 86 |
| how acquired, | 10 | 3, 4 |
| " | 12 | 1 |
| " | 18 | 4 |
| " | 127 | 86 |
| how forfeited, | 29 | 3 |
| infringement of copyright of, and penalty for, | 9 | 2 |
| " " " | 13 | 4 |
| " " " | 21 | 7 |
| " " " | 19 | 5 |
| " " " | 129 | 100 |
| **Penalties,** | | |
| for violation of copyright, amount of, and how recovered, | 9 | 2 |
| " " " " | 13 | 3 |
| " " " " | 20 | 6 |
| " " " " | 21 | 7 |
| " " " " | 129 | 100 |
| for publishing book as copyrighted, when not so, | 13 | 4 |
| " " " " | 24 | 11 |
| " " " " | 129 | 96 |
| for failure to deliver copy of book, &c., to library of Congress | 29 | 1 |
| " " " " " | 129 | 94 |
| may be recovered in action of debt, | 21 | 6 |
| " " | 24 | 11 |
| action for, within what time to be brought, | 9 | 2 |
| " " | 130 | 104 |
| " " | 24 | 13 |

| | PAGE. | SEC. |
|---|---|---|
| **Engravings, see PRINTS.** | | |
| **Extension of Copyright, see RENEWAL OF COPYRIGHT.** | | |
| **Fees under the Copyright Acts,** | | |
| of clerk for recording titles of books, | 10 | 3 |
| " " " | 19 | 4 |
| of librarian of Congress for recording titles of books | 128 | 92 |
| for furnishing copies of same, | 10 | 3 |
| " " " | 19 | 4 |
| " " " | 128 | 92 |
| for recording assignments, | 26 | 2 |
| " " | 128 | 92 |
| **Forfeiture,** | | |
| of books, &c., printed in violation of copyright, | 9 | 2 |
| " " " | 13 | 3 |
| " " " | 22 | 7 |
| " " " | 129 | 99 |
| **General Issue with Notice of Special Matter,** | | |
| pleadable in all actions under the copyright acts, | 11 | 7 |
| " " " " | 23 | 10 |
| " " " " | 130 | 105 |
| **Infringement of Copyright,** | | |
| what is, and penalty for, | 9 | 2 |
| " " | 20 | 6 |
| " " | 21 | 7 |
| what is not, | 11 | 5 |
| " | 22 | 8 |
| by acting dramatic compositions, | 27 | |
| when such acting no infringement, | 27 | |
| **Injunctions,** | | |
| to restrain violation of copyright, | 14 | |
| to restrain publication of manuscripts, | 22 | 9 |
| **Importation of books,** | | |
| when an infringement of copyright, and penalty for, | 9 | 2 |
| " " " | 20 | 6 |
| when not an infringement, | 11 | 5 |
| " " | 22 | 8 |
| **Librarian of Congress,** | | |
| to give receipt for copy of books, &c., deposited, | 29 | 2 |
| when to demand copy of book, &c., | 29 | 3 |
| to collect penalty for failure to deliver copy | 20 | 1 |
| copy of book to be transmitted to, without charge, | 29 | 2 |
| to have charge of records, &c., relating to copyrights, | 127 | 85 |
| to give bonds, | 127 | 85 |
| to make annual report, | 127 | 85 |

| | PAGE. | SEC. |
|---|---|---|
| **Copyright of Books, Maps, &c.—*continued.*** | | |
| within what time, | 29 | 2 |
| when not requisite, | 29 | 4 |
| failure to deliver copy, penalty for, | 29 | 1 |
| notice of copyright to be inserted on title-page, &c., | 12 | 1 |
| " " " | 19 | 4 |
| term of fourteen years, | 9 | 1 |
| " twenty-eight years, | 17 | 1 |
| " " " | 128 | 87 |
| " those existing in 1831 extended, | 24 | 16 |
| renewal of, who entitled to have, | 9 | 1 |
| " " " | 17 | 2 |
| " " " | 128 | 88 |
| " how secured, | 9 | 1 |
| " " | 17 | 2, 3 |
| " term of, | 9 | 1 |
| " " | 17 | 2 |
| assignment of, see ASSIGNMENT. | | |
| **Costs in Actions under the Copyright Laws,** | 24 | 12 |
| " " " | 130 | 108 |
| **Courts, United States Circuit,** | | |
| to have cognizance of all actions respecting copyrights, | 14 | |
| " " " | 130 | 106 |
| may grant injunctions therein, | 14 | |
| " " " | 130 | 106 |
| may grant injunctions to restrain publication of manuscripts, | 23 | 9 |
| appeals, or writ of error from to Supreme Court, | 15 | |
| " " " | 29 | |
| **Courts, United States District,** | | |
| penalties to be recovered in, | 129 | 94 |
| **Department of Interior,** | | |
| to have charge of copyright records, &c., | 28 | 8 |
| to perform duties of Secretary of State as to, | 28 | 8 |
| **Copyright records in, to be** | | |
| delivered to Librarian of Congress, | 130 | 109 |
| **Dramatic Compositions,** | | |
| copyright of, to include right to act or represent, | 27 | |
| " " " " " " | 127 | 86 |
| acting of, without consent, prohibited, | 27 | |
| " " " " | 130 | 101 |
| penalty for acting or representing same, | 27 | |
| " " " " | 130 | 101 |
| what acting of, not prohibited, | 27 | |
| " " " " | 130 | 103 |

| | Page. | Sec. |
|---|---|---|
| **Photographs, Copyright in,** | | |
| how acquired, | 29 | 1 |
| **Postmasters,** | | |
| to transmit copy of books, without charge, | 29 | 2 |
| " " " | 129 | 95 |
| to give receipt for same, | 29 | 2 |
| " " | 129 | 96 |
| **Prints and Engravings, Copyright in,** | | |
| who may have, | 12 | 2 |
| " | 16 | 1 |
| " | 127 | 86 |
| how acquired, | 12 | 2 |
| " | 18 | 4 |
| " | 19 | 5 |
| " | 127 | 86 |
| how forfeited, | 29 | 3 |
| infringement of copyright, of, and penalty for, | 13 | 3 |
| " " " | 21 | 7 |
| " " " | 129 | 10 |
| **Renewal of Copyright,** | | |
| who may have, | 9 | 1 |
| " | 17 | 2 |
| " | 24 | 16 |
| " | 128 | 88 |
| title to be a second time recorded and published, | 9 | 1 |
| title to be a second time recorded within six months of expiration of first term, | 18 | 2 |
| " " " | 128 | 88 |
| copy of record to be published for four weeks, | 18 | 3 |
| " " " | 128 | 88 |
| **Secretary of State,** | | |
| copy of book copyrighted to be deposited with, | 10 | 4 |
| " print " " | 13 | 2 |
| to preserve record of copyrights, and copies of books copyrighted, | 19 | 6 |
| duties of, transferred to Secretary of the Interior, | 28 | 8 |
| **Smithsonian Institute,** | | |
| copies of books copyrighted to be sent to, | 26 | 10 |
| act requiring, repealed, | 18 | 6 |
| **Writ of Error in Actions respecting Copyrights,** | | |
| when lie to Supreme Court, | 15 | |
| " " " | 29 | |
| " " " | 130 | 107 |

# INDEX

TO

# PATENT LAWS.


| | PAGE. | SEC. |
|---|---|---|
| **Actions, respecting Patents,** | | |
| cognizable in Circuit Courts of the United States | 44 | |
| " " " | 75 | 17 |
| " " " | 121 | 55 |
| to set aside patent as surreptitiously obtained, | 32 | 5 |
| " " " " | 39 | 10 |
| to determine between interfering patents | 121 | 58 |
| suspended or abated, restoration of, | 41 | |
| when maintainable, though patent too broad, | 86 | 9 |
| " " " | 122 | 60 |
| right to, when lost through neglect to file disclaimer, | 87 | 9 |
| " " " | 122 | 60 |
| to recover penalties for marking unpatented articles as patented, | 98 | 5 |
| " " " " | 118 | 39 |
| to recover penalties for omitting to mark date of patent, | 98 | 6 |
| " " " " | 110 | 13 |
| **Additional Improvements,** | | |
| patent for, may be annexed to original patent, | 67 | 13 |
| to have same effect as if embraced in such original patent, | 67 | 13 |
| patent for, when original patent lost, | 82 | 5 |
| original claim subject to re-examination, | 85 | 8 |
| patents for, right to abolished, | 109 | 9 |
| fee on granting, | 68 | 13 |
| **Administrators of Inventors.** | | |
| may take out patent in case of death of inventor, | 43 | 2 |
| " " " | 62 | 10 |
| " " " | 117 | 34 |
| may apply for and receive reissue of patent, | 67 | 13 |
| " " an extension of patent, | 76 | 18 |
| **Affidavits, see DEPOSITIONS.** | | |

| | PAGE | SEC. |
|---|---|---|
| Affirmation, see OATH. | | |
| Agents to transmit Models, | | |
| Commissioner may appoint not over twenty, | 88 | 10 |
| authority to appoint revoked, | 108 | 6 |
| Agents, Patent, | | |
| Commissioner may refuse to recognize, | 108 | 8 |
| reasons for so doing to be recorded, and approved by President, | 108 | 8 |
| Aliens, | | |
| same rights as citizens to receive patents, | 42 | 1 |
| rights of, as to patents extended, | 47 | |
| to put patented invention on sale within eighteen months, | 47 | |
| " " " " | 71 | 15 |
| when may obtain protection of a caveat, | 64 | 12 |
| " " " | 118 | 40 |
| patents may be granted to, | 53 | 6 |
| when may obtain patent for design, | 97 | 3 |
| " " " | 109 | 11 |
| fees payable by, on applications for patents, | 62 | 9 |
| to pay same fees as citizens, | 109 | 10 |
| two-thirds of fee returned to, on withdrawal, | 88 | 12 |
| right to return of fees abolished, | 108 | 9 |
| Antedate of Patents, | | |
| permitted, not to exceed six months before issue, | 62 | 8 |
| Appeals in Patent Cases, | | |
| from primary examiners to examiners in chief, | 107 | 3 |
| " " " | 119 | 46 |
| from examiners in chief to Commissioner, | 107 | 2 |
| " " " | 119 | 47 |
| from Commissioner to Board of Examiners, | 59 | 7 |
| to chief-justice Circuit Court, District of Columbia, | 93 | 11 |
| to assistant justices, same court, | 102 | 1 |
| to Supreme Court, District of Columbia, | 119 | 48 |
| in cases of interference, | 60 | 8 |
| " " | 93 | 10 |
| reasons of appeal to be filed. | 93 | 11 |
| " " | 119 | 49 |
| power of justices in such appeals, | 94 | 11 |
| duties of Commissioner, " | 94 | 11 |
| Commissioner or examiners may be examined on, | 95 | 11 |
| decision of justices to govern further proceedings, | 95 | 11 |
| fees on appeals from examiners to Commissioner, | 109 | 10 |
| " " " | 107 | 2 |
| " Commissioner to justices of Circuit Court, | 94 | 11 |
| " " " " | 102 | 2 |
| " primary examiners to examiner-in-chief | 112 | 1 |

| | PAGE. | SEC. |
|---|---|---|
| **Appeals to Supreme Courts from judgments of Circuit Courts,** | | |
| in what cases will lie, | 44 | |
| " " | 75 | 17 |
| allowed in all cases, | 105 | |
| " " | 121 | 56 |
| **Applications for Patents,** | | |
| how and by whom may be made | 30 | 1 |
| " " " | 55 | 6 |
| " " " | 115 | 24 |
| for designs, " " | 97 | 3 |
| " " " | 109 | 11 |
| to be accompanied with description, drawings, &c., | 55 | 6 |
| " " " | 116 | 26 |
| to be verified, | 56 | 6 |
| " | 116 | 30 |
| examination of | 57 | 7 |
| " | 116 | 31 |
| when patent to issue on, | 58 | 7 |
| " " | 116 | 31 |
| if defective, applicant to be informed, | 59 | 7 |
| " " may withdraw, | 59 | 7 |
| if rejected, applicant to be informed, | 118 | 41 |
| " remedy by Bill in Equity, | 120 | 52 |
| when to be verified anew, | 59 | 7 |
| *interfering* proceedings in case of, | 60 | 8 |
| " " " | 118 | 42 |
| remedy by bill in Equity, | 74 | 16 |
| to be completed within two years from filing | 110 | 12 |
| " " " | 116 | 32 |
| when longer time may be had, | 110 | 12 |
| " " | 116 | 32 |
| pending March 2d, 861, considered as filed after that time, | 110 | 12 |
| new, when may be made, | 112 | 1 |
| " " " | 117 | 35 |
| **Arbitrators, in Interfering Applications,** | | |
| when and by whom appointed | 39 | 9 |
| decision or award of, effect of, | 39 | 9 |
| **Assignees of Invention,** | | |
| to stand in place of original inventor, | 36 | 4 |
| when patents may issue to, | 83 | 6 |
| " " " | 117 | 33 |

| | PAGE. | SEC. |
|---|---|---|
| **Assignees of Patents,** | | |
| actions by, for infringement, | 31 | 4 |
| " " | 37 | 5 |
| " " | 43 | 3 |
| " " | 68 | 14 |
| when may maintain suit, if patent too broad, | 86 | 9 |
| may surrender and have a reissue of patent, | 67 | 13 |
| right of, in a renewal of a patent, | 78 | 18 |
| to put date of patent on articles sold, | 98 | 6 |
| " " " | 110 | 13 |
| " " " | 117 | 38 |
| **Assignment of Invention or Patent** | | |
| may be of the whole, or undivided part of patent, | 63 | 11 |
| " " " | 117 | 36 |
| to be recorded in office of Secretary of State, | 36 | 4 |
| " Patent Office within three months, | 64 | 11 |
| " " " | 117 | 36 |
| of lost patents, when to be recorded anew, | 79 | 1 |
| not evidence, unless so recorded, | 80 | 2 |
| when void, | 117 | 36 |
| fees for recording, | 64 | 13 |
| " " | 100 | 2 |
| " " | 109 | 10 |
| **Assistant Justices Circuit Court, District Columbia,** | | |
| appeals to, in the same manner as to chief-justice, | 102 | 1 |
| compensation on appeals, | 102 | 2 |
| **Assistant Commissioner of Patents,** | | |
| how appointed, | 113 | 2 |
| salary of, | 113 | 4 |
| when to act in place of commissioner | 114 | 11 |
| **Board of Examiners to determine Appeals,** | | |
| creation of and who to compose, | 59 | 7 |
| appeals to chief-justice, in place of, | 93 | 11 |
| **Caveat,** | | |
| who may file, | 64 | 12 |
| " " | 118 | 0 |
| what to set forth, | 64 | 12 |
| " " | 118 | 40 |
| to be preserved in secrecy, | 64 | 12 |
| " " " | 118 | 40 |
| entitles party to notice of interfering applications, | 65 | 12 |
| " " " | 118 | 40 |
| caveator may be required to complete application in three months, | 65 | 12 |

| | PAGE. | SEC |
|---|---|---|
| **Caveat—*continued.*** | | |
| caveator may be required to complete application in three months | 118 | 40 |
| three months' notice, how computed, | 108 | 9 |
| " " " | 118 | 40 |
| fee on filing, twenty dollars | 64 | 12 |
| " ten " | 109 | 10 |
| to be considered a part of the patent fee, | 64 | 12 |
| no longer a part of patent fee, | 108 | 9 |
| **Chief Clerk of Patent Office,** | | |
| how appointed, and duties of, | 50 | 2 |
| " " | 113 | 2 |
| prohibited from acquiring interests in patents, | 51 | 2 |
| to take oath, and give bonds, | 51 | 3 |
| " " | 114 | 6 |
| salary of | 51 | 3 |
| " | 51 | 2 |
| " | 112*b* | 3 |
| " | 11 | 4 |
| **Chief-Justice Circuit Court, District Columbia,** | | |
| when appeals may be made to, | 93 | 11 |
| compensation of, on | 96 | 13 |
| " " | 102 | 13 |
| **Claim in Specification of Patents,** | | |
| what to specify and point out, | 56 | 6 |
| " " | 116 | 26 |
| to broad, patentee may disclaim, | 83 | 7 |
| " when patent will be held good, | 86 | 9 |
| if rejected, applicant to be informed, | 118 | 41 |
| **Clerks in Patent Office,** | | |
| how appointed, | 50 | 2 |
| required to take oath, | 51 | 3 |
| prohibited from acquiring interest in patents, | 50 | 2 |
| " " " | 115 | 16 |
| chief and disbursing clerk to give bonds, | 102 | |
| temporary and other, appointment of, | 88 | 11 |
| " " " | 89 | 2 |
| " " " | 101 | 3 |
| " " " | 103 | |
| " " " | 113 | 2 |
| compensation of, | 111 | 2 |
| " | 112*b* | 3 |
| " | 113 | 4 |

| | PAGE. | SEC. |
|---|---|---|
| Commissioner of Patents, | | |
| how appointed, | 49 | 1 |
| " | 113 | 2 |
| general duties of | 49 | 1 |
| " | 114 | 7 |
| prohibited from acquiring interest in patents | 51 | 2 |
| to take oath, and give bonds | 51 | 3 |
| " " | 114 | 6 |
| to cause seal of patent office to be made, | 51 | 4 |
| " " " | 114 | 12 |
| to furnish copies of records, when applied to, | 51 | 4 |
| to countersign letters patent, | 52 | 5 |
| " " | 115 | 21 |
| to make annual report to Congress, | 89 | 14 |
| " " | 114 | 9 |
| to report to Congress account of moneys received, | 112*a* | 2 |
| " " " expended, | 112*a* | 2 |
| may frank papers connected with his office, | 50 | 1 |
| " " " | 114 | 8 |
| to classify models, etc., | 114 | 13 |
| may frank Patent Office reports, | 101 | 4 |
| may restore or dispose of models, | 108 | 5 |
| " " | 114 | 14 |
| may appoint examiners, not to exceed four, | 108 | 7 |
| " " | 112*a* | 1 |
| may cause letters patent to be printed, | 110 | 14 |
| " " | 115 | 20 |
| may direct papers illegibly written to be printed, | 108 | 8 |
| " " " | 115 | 18 |
| may refuse to recognize patent agents, | 108 | 8 |
| " " " | 115 | 17 |
| may increase salaries of clerks, &c., | 111 | 2 |
| may rent necessary rooms for office, | 112*a* | 2 |
| power of, to make rules as to taking evidence, | 96 | 12 |
| " " " | 106 | 1 |
| " " " | 115 | 19 |
| duties of, on applications for patents, | 57 | 7 |
| " " " | 97 | 3 |
| " " " | 109 | 11 |
| " " " | 116 | 31 |
| " in cases of interference, | 60 | 8 |
| " " " | 65 | 12 |
| " as to surrenders and re-issues, | 65 | 13 |
| " " " | 82 | 5 |

| | PAGE. | SEC. |
|---|---|---|
| **Commissioner of Patents—*continued.*** | | |
| duties as to surrenders and re-issues, | 85 | 8 |
| " " " | 120 | 53 |
| " as to extensions, | 76 | 18 |
| " " " | 100 | 1 |
| " " " | 123 | 64 |
| " " " | 123 | 65 |
| " " " | 123 | 66 |
| " on appeals to Sup. Court, Dist. of Columbia, | 120 | 51 |
| " on withdrawals, | 59 | 7 |
| " " " | 88 | 12 |
| " as to lost patents, | 79 | 1 |
| " " " | 80 | 2 |
| salary of, | 112*b* | 3 |
| " | 113 | 4 |
| **Copies of Papers from Patent Office,** | | |
| who may obtain, | 31 | 3 |
| " | 51 | 4 |
| when to be received as evidence, | 31 | 2 |
| " " " | 36 | 3 |
| " " " | 51 | 4 |
| " " " | 121 | 57 |
| of restored records, &c., to be evidence, | 80 | 2 |
| " patents, " | 81 | 3 |
| printed, of patents, when evidence, | 111 | 15 |
| fees on obtaining, | 40 | 11 |
| " " | 52 | 4 |
| " " | 109 | 10 |
| **Courts, Circuit, jurisdiction in Patent Cases,** | | |
| jurisdiction in actions on the case, | 43 | 3 |
| " " " | 122 | 59 |
| " in equity as well as at law, | 44 | 1 |
| to have original cognizance, both in equity and at law, | 75 | 17 |
| " " " " | 121 | 55 |
| may declare interfering patents void, | 74 | 16 |
| may render judgment to three times the actual damages, | 68 | 14 |
| " " " | 122 | 59 |
| powers of, in equity, | 121 | 55 |
| appeals from see APPEALS. | | |
| **Courts, District,** | | |
| power as to repeal of patents surreptitiously granted, | 32 | 5 |
| power as to repeal of patents surreptitiously granted, | 39 | 10 |
| suits in, suspended or abated, to be restored, | 41 | |

| | PAGE. | SEC. |
|---|---|---|
| **Damages for Infringement,** | | |
| such as jury may assess, and forfeiture of thing made, | 32 | 4 |
| equal to three times amount of license price, | 37 | 5 |
| equal to three times actual damage sustained, | 43 | 3 |
| jury to find actual damages sustained, | 68 | 14 |
| court may render judgment to three times such sum, | 68 | 14 |
| " " " " | 122 | 59 |
| may be recovered in addition to profits, | 121 | 55 |
| of trade mark, | 126 | 79 |
| **Defences to Patent Actions,** | | |
| defendant may plead general issue with notice, &c, | 32 | 6 |
| " " " " | 37 | 6 |
| " " " " | 69 | 5 |
| " " " " | 122 | 61 |
| See also GENERAL ISSUE. | | |
| **Department of Interior,** | | |
| to have supervision of Patent Office, | 101 | |
| **Depositions,** | | |
| commissioner may prescribe rules for, | 119 | 43 |
| who may take, | 119 | 43 |
| **Designs, Patents for,** | | |
| who may obtain, | 97 | 3 |
| " " | 109 | 11 |
| " " | 124 | 71 |
| duration of patent for, | 97 | 3 |
| " " | 109 | 11 |
| " " | 125 | 73 |
| fees, on applications for, | 97 | 3 |
| " " | 109 | 11 |
| " " | 125 | 75 |
| **Digest of Patents,** | | |
| Commissioner authorized to publish, | 90 | 3 |
| **Disclaimer of Patent,** | | |
| who may make, | 83 | 7 |
| " " | 120 | 54 |
| to state the interest of disclaimant, | 84 | 7 |
| " " " | 120 | 54 |
| to be in writing and witnessed, | 84 | 7 |
| " " | 120 | 54 |
| to be considered as a part of patent, | 84 | 7 |
| " " | 120 | 54 |
| how far affects pending actions, | 85 | 7 |
| " " | 120 | 54 |

| | PAGE. | SEC. |
|---|---|---|
| **Disclaimer of Patent—*continued.*** | | |
| if not filed before action, costs not recoverable, | 86 | 9 |
| " " " | 122 | 60 |
| effect of unreasonable delay in filing, | 87 | 9 |
| " " " | 122 | 60 |
| when necessary, on application for re-issue, | 85 | 8 |
| fees on filing, | 84 | 7 |
| " | 109 | 10 |
| **Draughtsman of Patent Office,** | | |
| how appointed, and salary of | 50 | 2 |
| additional compensation for, | 102 | |
| **Drawings of Invention,** | | |
| to accompany applications, | 56 | 6 |
| " " | 116 | 27 |
| how to be prepared, | 56 | 6 |
| duplicates required, | 83 | 6 |
| to be considered a part of specification, | 83 | 6 |
| how supplied, when none originally filed with patent, | 80 | 1 |
| Commissioner authorized to have printed, | 111 | 14 |
| fees, for copies of, | 52 | 4 |
| " " | 109 | 10 |
| **Evidence in Cases before the Patent Office,** | | |
| Commissioner, may make rules as to, in contested cases, | 96 | 12 |
| power to make rules extended to all cases, | 106 | 1 |
| witnesses may be compelled to give, | 106 | 1 |
| " " " " | 119 | 44 |
| how far witnesses privileged from giving, | 106 | 1 |
| See also COPIES OF PAPERS, | | |
| **Examiners in Patent Office,** | | |
| board of, to determine appeals, created, | 59 | 7 |
| duties of, transferred to chief-justice, | 93 | 11 |
| in chief, appointment of, | 107 | 2 |
| " " | 113 | 2 |
| to revise decisions of primary examiners, | 107 | 2 |
| " " " " | | |
| governed by rules of Commissioner, | | |
| appeals from, to Commissioner, | | |
| appeals to, from primary, when, | | |
| salary of, | | |
| oldest in office, to act in absence of Commissioner, | | |
| primary, how appointed, | | |
| " " | 113 | 2 |

| | PAGE. | SEC. |
|---|---|---|
| Examiners in Patent Office—*continued.* | | |
| additional appointed, | 88 | 11 |
| " " | 100 | 1 |
| " " | 101 | 2 |
| " " | 103 | 3 |
| " " | 103 | 10 |
| " " | 104 | 9 |
| " " | 108 | 7 |
| " " | 112*a* | 1 |
| rated as fourth class clerks, | 104 | 25 |
| salary of, | 50 | 2 |
| " | 103 | 3 |
| " | 108 | 7 |
| " | 112*b* | 3 |
| " | 113 | 4 |
| assistant, appointment of, | 89 | 1 |
| " | 100 | 1 |
| " | 101 | 2 |
| " | 103 | 3 |
| " | 103 | 10 |
| " | 104 | 9 |
| " | 108 | 7 |
| " | 113 | 2 |
| rated as third class clerks, | 104 | 25 |
| salary of, | 89 | 1 |
| " | 103 | 3 |
| " | 108 | 7 |
| " | 111 | 2 |
| " | 112*b* | 3 |
| " | 113 | 4 |
| Extension of Patents, | | |
| on application to Congress, | 45 | 2 |
| on application to Commissioner, | 76 | 18 |
| " " " | 123 | 63 |
| board appointed to determine as to, | 77 | 18 |
| Commissioner substituted for board, | 100 | 1 |
| " to refer application to Examiners, | 123 | 65 |
| " when may extend, | 123 | 66 |
| notice of time and place of hearing to be published, | 77 | 18 |
| sixty days notice to be given, | 100 | 1 |
| " " " | 110 | 12 |
| " " " | 123 | 64 |
| applications to be filed ninety days before expiration. | 110 | 12 |
| " " " | 123 | 63 |

| | PAGE. | SEC |
|---|---|---|
| Extension of Patents—*continued.* | | |
| patent not to be extended over seven years, | 100 | 1 |
| to be extended for three years, | 123 | 66 |
| extended patent, effect of, | 77 | 18 |
| " " | 123 | 66 |
| prohibited as to patents granted after March 2d, 1861, | 111 | 16 |
| " " " " | 123 | 63 |
| fees payable on, | 76 | 18 |
| " " | 109 | 10 |
| **Fees as to Patent Matters,** | | |
| on applications for patent, | 33 | 7 |
| " " | 40 | 11 |
| " " | 62 | 9 |
| " " | 124 | 68 |
| " " for designs, | 97 | 3 |
| " " " | 110 | 11 |
| " " for improvements, | 68 | 13 |
| " reissue, | 66 | 13 |
| " " | 82 | 5 |
| " " | 109 | 10 |
| " " | 124 | 68 |
| " extension, | 76 | 18 |
| " " | 109 | 10 |
| " " | 124 | 68 |
| filing caveat, | 64 | 12 |
| " | 109 | 10 |
| " | 124 | 68 |
| filing disclaimer, | 84 | 7 |
| " " | 109 | 10 |
| " " | 124 | 68 |
| on appeals from Commissioner, | 60 | 7 |
| " " Examiners in chief to Commissioner, | 109 | 10 |
| " " " " " | 124 | 68 |
| " " Primary Examiner to Examiner in chief, | 112 | 1 |
| " " " " " | 124 | 68 |
| for recording assignments, | 64 | 11 |
| " " | 100 | 2 |
| " " | 109 | 10 |
| " " | 124 | 68 |
| copies of papers and drawings, | 40 | 11 |
| " " | 51 | 4 |
| " " | 109 | 10 |
| " " | 124 | 68 |
| " " | 132 | 2 |

| | PAGE. | SEC. |
|---|---|---|
| **Fees as to Patent Matters—*continued.*** | | |
| patent, to whom may be paid, | 99 | 15 |
| " " " | 124 | 69 |
| paid by mistake may be refunded, | 96 | 1 |
| " " " | 124 | 69 |
| refunded on withdrawal, | 59 | 7 |
| " " | 88 | 12 |
| not refunded hereafter on withdrawal, | 108 | 9 |
| of witnesses upon subpœna, | 106 | 1 |
| " " | 119 | 45 |
| effect of non-payment of, | 111 | 3 |
| " " | 115 | 23 |
| final fee, when to be paid, | 112 | 1 |
| " " | 117 | 35 |
| **Foreign and Home Patents for same Invention,** | | |
| home patent to run from date of foreign, | 90 | 6 |
| **Franking privilege of Commissioner,** | | |
| may frank letters, etc., connected with his office, | 50 | 1 |
| " " " | 114 | 8 |
| " Patent Office reports, | 101 | 4 |
| **General Issue and Notice of Special Matter,** | | |
| when defendant may plead, | 32 | 6 |
| " " | 37 | 6 |
| " " | 69 | 15 |
| " " | 122 | 61 |
| what defences may be set up by notice, | 70 | 15 |
| " " " | 122 | 61 |
| **Infringement of Patent,** | | |
| damages for, see DAMAGES. | | |
| penalty for selling unpatented articles as patented | 98 | 5 |
| **Interfering applications,** | | |
| decision, in cases of, by arbitrators, | 39 | 9 |
| " " Commissioner, | 60 | 8 |
| practice in cases of | 60 | 8 |
| " " | 118 | 42 |
| appeal in case of | 60 | 8 |
| remedy in cases of, by bill in equity, | 74 | 16 |
| **Interfering patents** | | |
| actions respecting | 121 | 50 |

| | PAGE | SEC. |
|---|---|---|
| **Invention, when Patentable,** | | |
| must be useful, and not before known or used, | 30 | 1 |
| must be new and useful and not known or used before the application | 33 | 1 |
| must be new and useful | 54 | 6 |
| " " | 115 | 24 |
| not known or used by others before applicants' invention, | 54 | 6 |
| " " " | 115 | 24 |
| not in public use, or on sale with his consent, | 54 | 6 |
| " " " | 115 | 24 |
| may be used or sold for two years before application | 91 | 7 |
| " " " | 115 | 24 |
| **Library of Patent Office,** | | |
| establishment of, and appropriation for, | 78 | 19 |
| " " " | 114 | 15 |
| appropriation for, | 102 | |
| " " | 103 | 1 |
| **Librarian of Patent Office,** | | |
| appropriation to pay, | 102 | |
| rated as a clerk of the third class, | 104 | 25 |
| salary of, established, | 108 | 4 |
| **Machines, Patents for,** | | |
| principles of, to be explained in specification, | 35 | 3 |
| " " " " | 55 | 6 |
| " " " " | 116 | 26 |
| different modes of application to be explained, | 35 | 3 |
| " " " " | 55 | 6 |
| **Machinist in Patent Office,** | | |
| appointment of, and salary, | 50 | 2 |
| rated as a third class clerk, | 104 | 25 |
| **Messenger in Patent Office,** | | |
| appointment of, and salary, | 50 | 2 |
| **Models of Inventions,** | | |
| required on applications, | 31 | 2 |
| " " | 36 | 3 |
| " " | 56 | 6 |
| " " | 116 | 29 |
| lost or destroyed, duplicates to be procured, | 81 | 4 |
| may be dispensed with in patents for designs, | 125 | 72 |
| when may be restored by Commissioner, | 108 | 5 |
| " " " | 114 | 14 |
| to be classified and arranged, | 79 | 20 |
| " " | 114 | 13 |

| | PAGE. | SEC. |
|---|---|---|
| **Money Paid by Mistake,** | | |
| fees so paid to Patent Office may be refunded, | 96 | 1 |
| **Notice of Special Matter,** | | |
| defences by, when to be given, | 32 | 6 |
| " " | 37 | 6 |
| " " | 69 | 15 |
| " " | 122 | 61 |
| what to set forth, | 32 | 6 |
| " " | 37 | 6 |
| " " | 69–72 | 15 |
| " " | 122 | 61 |
| **Notice of Interfering Application,** | | |
| when applicants and patentees entitled to, | 60 | 8 |
| when caveator entitled to, | 65 | 12 |
| **Notice of existing Patent** | | |
| when and how patentees and assignees to give, | 98 | 6 |
| " " " | 110 | 13 |
| **Oath in Patent Proceedings,** | | |
| required on applications for patents, | 35 | 3 |
| " " " | 56 | 6 |
| " " " | 116 | 30 |
| affirmation may be substituted for, | 88 | 13 |
| before whom taken, out of United States, | 97 | 4 |
| " " " | 116 | 30 |
| renewal oath, when required, | 59 | 7 |
| " " | 107 | 3 |
| " act requiring, repealed, | 111 | 1 |
| Commissioner, and other officers to take, | 51 | 3 |
| " " " | 113 | 4 |
| **Patent Office,** | | |
| establishment of, | 49 | 1 |
| attached to Department of State, | 49 | 1 |
| " " Interior, | 101 | 2 |
| " " " | 113 | 1 |
| officers in, to have no interest in patents, | 51 | 2 |
| " to take oath, | 51 | 3 |
| seal of, to be provided, | 51 | 4 |
| appropriation for expenses, etc., of, | 112*b* | 2 |
| **Patents for Inventions, requisites of, &c.,** | | |
| applications for, see APPLICATIONS. | | |
| to be tested by President, | 30 | 1 |
| " " | 33 | 1 |
| to be issued in the name of the United States, | 52 | 5 |
| " " " " | 115 | 21 |

| | PAGE. | SEC. |
|---|---|---|
| **Patents for Inventions, requisites, &c.,—*continued.*** | | |
| lost or destroyed, when new may be recorded, | 81 | 3 |
| to be signed by Secretary of State, | 52 | 5 |
| " " Interior, | 101 | 2 |
| counterigned by Commissioner of Patents, | 52 | 5 |
| " " " | 115 | 21 |
| to be recorded in office of Secretary of State, | 31 | 1 |
| " " " " | 35 | 1 |
| " " Commissioner of Patents, | 52 | 5 |
| lost or destroyed, when may be recorded anew, | 79 | 1 |
| when dated | 115 | 23 |
| when may issue to legal representatives of inventor, | 43 | 2 |
| " " " | 62 | 10 |
| " " | 117 | 34 |
| when may issue to assignees of inventor, | 83 | 6 |
| " " " | 117 | 33 |
| when dated | 111 | 3 |
| what granted by | 52 | 5 |
| what to contain | 115 | 22 |
| term of, to be fourteen years | 31 | 1 |
| " " " | 34 | 1 |
| " " " | 52 | 5 |
| " extended to seventeen years | 111 | 16 |
| " " " " | 115 | 22 |
| for designs, when issued, and term of | 97 | 3 |
| " " " | 109 | 11 |
| patents of addition, when granted | 67 | 13 |
| " " not to be issued | 109 | 9 |
| surreptitiously obtained, how repealed | 32 | 5 |
| " " " | 39 | 10 |
| when invalid, and for what reasons | 69 | 15 |
| when *courts may* declare void, in whole or in part | 74 | 16 |
| " " " | 121 | 58 |
| when valid, though claiming too much | 86 | 9 |
| " " " | 120 | 54 |
| assignable, in whole or in part | 63 | 11 |
| " " | 117 | 30 |
| re-issue of, see RE-ISSUE. | | |
| extension of, see EXTENSION. | | |
| Commissioner may cause to be printed | 110 | 14 |
| classified list of to be published | 90 | 3 |
| annual list of " " | 89 | 14 |
| fee on obtaining, see FEES. | | |

| | PAGE | SEC. |
|---|---|---|
| **Patented Articles,** | | |
| to be marked with date of patent | 98 | 6 |
| " "patented," and with date of patent | 110 | 13 |
| " " " | 117 | 38 |
| when such mark may be on package | 110 | 13 |
| penalty for neglecting so to do | 1 0 | 13 |
| " " | 117 | 38 |
| when purchaser may use | 117 | 37 |
| **Penalties respecting Patents,** | | |
| for marking articles patented when not so | 98 | 5 |
| " " " | 118 | 39 |
| for neglecting to stamp date of patent on articles sold | 98 | 6 |
| " " " " | 110 | 13 |
| " " " " | 117 | 38 |
| **Printing Specifications, Drawings, etc.,** | | |
| Commissioner may direct to be printed | 110 | 14 |
| " " " | 133 | 1 |
| cost of, limited | 110 | 14 |
| expense of, paid out of patent fund | 110 | 14 |
| printed copies to be evidence | 111 | 15 |
| " " | 133 | 1 |
| papers illegibly written may be printed | 108 | 8 |
| cost of to be paid by parties filing | 108 | 8 |
| price of, limited, | 133 | 2 |
| **Reissue of patent,** | | |
| when may be had, and for what errors | 45 | 3 |
| " " " | 65 | 13 |
| " " " | 120 | 53 |
| who may apply for | 46 | 3 |
| " " | 66 | 13 |
| " " | 120 | 53 |
| reissued patent must be for same invention | 66 | 13 |
| several reissues may be had on same patent | 82 | 5 |
| " " " | 120 | 53 |
| original claim subject to revision and restriction | 85 | 8 |
| " " " | 120 | 53 |
| reissued patent to have same effect as if originally filed | 67 | 13 |
| " " " | 120 | 53 |
| fees on applications for | 66 | 13 |
| " | 82 | 5 |
| " | 109 | 10 |
| specification of, when can be sworn to by assignee | 132 | 1 |

| | PAGE. | SEC. |
|---|---|---|
| **Report of Patent Office,** | | |
| annual report to be made, | 88 | 14 |
| mechanical report, drawings of, to be in one volume | 104 | 4 |
| may be sent by Commissioner free of postage | 101 | 4 |
| **Seal of Patent Office,** | | |
| Commissioner to provide | 51 | 4 |
| " | 114 | 12 |
| copies of records etc., verified by, to be evidence | 51 | 4 |
| all patents to be issued under | 52 | 5 |
| printed patents made evidence by | 111 | 15 |
| **Specifications of Patents,** | | |
| what to set forth | 31 | 2 |
| " | 35 | 3 |
| " | 55 | 6 |
| " | 116 | 26 |
| to be accompanied by drawings or specimens | 56 | 6 |
| " " " | 116 | 27 |
| illegible, may be printed at applicant's expense | 108 | 8 |
| printing of, how paid | 112*b* | 1 |
| **Specimens of ingredients, when required** | 56 | 6 |
| " " | 116 | 28 |
| **Supreme Court, District of Columbia,** | | |
| when appeals may be made to | 119 | 48 |
| duties of, on appeals | 119 | 50 |
| to return to Commissioner certificate of decision | 119 | 50 |
| Commissioner to notify parties to appear before | 120 | 51 |
| **Trademarks, registration of,** | | |
| who may have | 125 | 77 |
| declaration, what to set forth | 125 | 77 |
| " to be verified | 125 | 77 |
| term of protection of, rights secured by renewal of | 126 | 78 |
| remedy for infringement of | 126 | 79 |
| wrongful use of, may be enjoined | 126 | 79 |
| what cannot be registered as | 126 | 79 |
| time of receipt for, to be noted | 126 | 80 |
| rules and forms of transfer of | 126 | 81 |
| penalty for fraudulent registration | 127 | 82 |
| former remedies at law and in equity preserved | 127 | 83 |
| when actions not maintainable | 127 | 84 |
| **Withdrawal of Patent Fee** | | |
| when allowed, and in what proportion | 59 | 7 |
| right of, extended to foreigners | 88 | 12 |
| prohibited as to applications subsequent to March 2d 1861 | 108 | 9 |

| | PAGE. | SEC. |
|---|---|---|
| Witnesses in Matters before Patent Office, | | |
| may be compelled to testify | 106 | 1 |
| " " | 119 | 44 |
| penalty for refusing | 106 | 1 |
| not required to attend more than forty miles | 106 | 1 |
| " " | 119 | 45 |
| not compelled to disclose any invention made or owned by him | 106 | 1 |
| " " " | 119 | 45 |
| entitled to fees for attendance | 106 | 1 |
| " " | 119 | 45 |

# LAWS OF CANADA

## RELATING TO

# PATENTS FOR INVENTIONS,

## COPYRIGHTS, TRADE-MARKS,

## AND DESIGNS.

# LAWS OF CANADA

## RELATING TO

# PATENTS FOR INVENTIONS, COPYRIGHTS,

# TRADE-MARKS, AND DESIGNS.

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### PATENT OFFICE CONSTITUTED.


SEC. 1. Minister of agriculture to be commissioner of Patents.
2. Seal ; impressions thereof to be received in evidence.
3. Commissioner to make rules.
SEC. 4. Deputy commissioner and clerks. Employees in Patent Office not to be concerned in patents.
5. Annual report ; publication of specifications.


### WHO MAY OBTAIN PATENTS, FOR WHAT; FORMALITIES.


SEC. 6. Invention patentable if not in public use in Canada for more than one year.
7. Inventions patented abroad, when patentable.
8. Representatives of inventor may have patent.
9. Patents for improvements.
SEC. 10. Joint applications.
11. Declaration of applicant.
12. Applicant to elect a domicile in Canada.
13. Particulars of application.
14. Specification and drawing.
15. Working model ; specimens of ingredients.


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


SEC. 16. Contents of Patents.
17. Duration of Patents. Extension of.
18. Patent or extension, examined by whom.
SEC. 19. Re-issue of patent; when and effect of.
20. Disclaimer, effect of.


### ASSIGNMENT AND INFRINGEMENT OF PATENTS.


SEC. 21. Government may use patented invention.
22. Assignment of patents, registry of.
23. Remedy for infringement of patent.
SEC. 24. Action for infringement. Injunction. Appeal.
25. Court may discriminate, when.
26. Defenses.

## NULLITY, IMPEACHMENT AND AVOIDANCE OF PATENTS.

SEC. 27. When patent declared void or valid in part.
28. Invention to be manufactured in Canada. Patentee not to import into Canada.
28.—2. Extention of term for manufacture.
SEC. 29. Impeachment of Patent. Scire facias.
30. Judgment voiding patent to be filed in Patent Office.
31. Judgment; subject to appeal.

## PATENTS ISSUED UNDER FORMER LAWS.

SEC. 32. Existing patents to remain in force.
32.—2. Extension. Provincial patents to other provinces.
33. Records of provincial patent office to be handed to commissioner.
SEC. 34. Tariff of fees.
35. For copies of drawings.
36. Fees to be in full of all services.
37. Fees to form part of Consolidated Revenue Fund.
38. Return of fees. Withdrawals, effect of.

## MISCELLANEOUS PROVISIONS.

SEC. 39. Caveat may be filed. Effect of.
40. Commissioner may object to grant patent, when.
41. Ground of objection to be given applicant.
42. Appeal by applicant.
43. Arbitration in case of interfering applications.
44. Documents open to inspection.
45. Clerical errors. Effect of.
46. Patent, when may be replaced.
SEC. 47. Use of patented inventions in foreign vessels.
48. Patent not to affect a previous purchaser.
49. Patented articles to be marked.
50. Falsely marking anything as patented.
51. False entry or copy under this act.
52. Repealed enactments.
53. Act, how cited.
54. Commencement of act.

# ACT OF THE PARLIAMENT OF CANADA.

## 35TH VICTORIA.

## CHAP. XXVI. AN ACT RESPECTING PATENTS OF INVENTION.

[*Assented to 14th June*, 1872.]

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

### PATENT OFFICE CONSTITUTED.

**Sec. 1.** [**Minister of Agriculture to be Commissioner of Patents.**] There shall be attached to the Department of Agriculture, as a branch thereof, an office to be called the Patent Office; and the Minister of Agriculture for the time being shall be the Commissioner of Patents; and it shall be the duty of the said Commissioner to receive all applications, fees, papers, documents and models for patents, and to perform all acts and things requisite to the

granting and issuing of patents of invention; and he shall have the charge and custody of the books, records, papers, models, machines, and other things belonging to the said office.

**Sec. 2.** [**Seal; impressions thereof to be received in evidence.**] The Commissioner shall cause a seal to be made for the purposes of this Act, and may cause to be sealed therewith patents and other instruments and copies proceeding from the Patent Office; and all courts, judges and other persons whosoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, copies or extracts certified under the seal of the said office to be copies of or extracts from documents deposited in such office.

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

**Sec. 4.** [**Deputy Commissioner; Clerks. Employees not to be interested in Patents.**] The Deputy of the Minister of Agriculture shall be the Deputy Commissioner of Patents of Invention; and the Governor in Council may, from time to time, appoint such clerks and officers under him as may be necessary for the purposes of this Act, and such clerks and officers shall hold office during pleasure. No officer or employee of the Patent Office shall buy, sell, or acquire, or traffic in an invention patent, or rights to patents therefor; and every such purchase and sale, and every assignment or transfer thereof, by or to any officer or employee as aforesaid, shall be utterly null and void. But this shall not apply to any original inventor, or to the acquisition by bequest.

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

**Amended by act, 1873, sec. 1, post.**

## WHO MAY OBTAIN PATENTS.

**Sec. 6.** [**Invention patentable if not in public use in Canada, for more than one year.**] Any person having invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his invention thereof, and not being in public use, or on sale for more than one year previous to his application, in Canada, with the consent or allowance of the inventor thereof, may, on a petition to that effect presented

to the Commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property therein; and the said patent shall be under the seal of the Patent Office and the signature of the Commissioner, or the signature of another member of the Privy Council, and shall be good and avail to the grantee, his executors, administrators, or assigns for the period mentioned in such patent; but no patent shall issue for an invention having an illicit object in view nor for any mere scientific principle or abstract theorem.

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

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

Amended by act of 1873, sec. 2, post.

Sec. 9. [**Patents for improvements on patented inventions.**] Any person, who has invented any improvement on any patented invention, may obtain a patent for such improvement, but shall not thereby obtain the right of vending or using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement.

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

Sec. 11. [**Declaration of applicant.**] Every inventor, before a patent can be obtained, shall make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is, or, in case of the inventor being deceased, the applicant shall make oath or affirm that the person whose assignee or representative he is, was the inventor of the invention for which the patent is solicited, and that the several allegations in the petition contained are respectively true and correct. Such oath or affirmation may be made before any Justice of the Peace in Canada; but if the inventor or the applicant is not at the time in Canada the oath or affirmation may be made before any Minister Plenipotentiary, *charge d'affaires*, consul, vice-consul or consular agent, holding commission under the Government of the United Kingdom, or any Judge of the country in which the applicant happens at the time to be.

Amended by act of 1873, sec. 3 post.

Sec. 12. [**Applicant to elect a domicile in Canada.**] The petitioner for a patent shall for all the purposes of this Act elect his domicile at some known

and specified place in Canada and mention the same in his petition for a patent.

**Sec. 13.** [**Particulars of application.**] The applicant shall in his petition for a patent, insert the title or name of the invention, and shall with the petition, send in a specification in duplicate.

**Sec. 14.** [**Specification and drawing.**] The specification shall correctly and fully describe the mode or modes of operating contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new and for the use of which he claims an exclusive property and privilege; it shall bear the name of the place where it is made, the date, and be signed by the inventor if he be alive (and if not by the applicant), and two witnesses; in the case of a machine the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same; in the case of a machine, or in any other case where the invention admits of illustration by means of drawings, the applicant shall also with his application send in drawings in duplicate showing clearly all parts of the invention; and each drawing shall bear the signature of the applicant or of his attorney, and shall have written references corresponding with the specification; but the Commissioner may require further drawings or dispense with any of them, as he may see fit; one duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent of which it forms an essential part, and the other duplicate shall remain deposited in the Patent Office.

Amended by act of 1873, sec. 4, post.

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

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

**Sec. 16.** [**Contents of patents.**] Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification,—and shall grant to the patentee, his executors, administrators, and assigns, for the period therein mentioned from the granting of the same, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, said invention, subject nevertheless to adjudication before any Court of competetent jurisdiction.

Amended by act of 1873, sec. 5, post.

**Sec. 17.** [**Duration of patents, and extension.**] Patents of invention issued by the Patent Office shall be valid for a period of five, ten or fifteen years at the option of the applicant; but at or before the expiration of the said five or

ten years the holder thereof may obtain an extension of the patent for another period of five years, and after those second five years, may again obtain a further extension for another period of five years, not in any case to exceed a total period of fifteen years in all; and the instrument delivered by the Patent Office for such extension of time shall be in the form which may be from time to time adopted, to be attached, with reference, to the patent, and under the signature of the Commissioner, or of any other member of the Privy Council in case of absence of the Commissioner.

**Sec. 18.** [**Patent or extension to be examined, by whom.**] Every patent and instrument for the extension of time as aforesaid shall before it is signed by the Commissioner or any other member of the Privy Council, and before the seal hereinbefore mentioned is affixed to it, be examined by the Minister of Justice, who, if he finds it conformable to law shall certify accordingly, and such patent or instrument may then be signed and the seal affixed thereto, and being duly registered, shall avail to the grantee thereof.

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

Amended by act of 1875, sec. 1, post.

**Sec. 20.** [**Disclaimer, effect of.**] Similarly, whenever by any mistake, accident or inadvertence, and without any willful intent to defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the party through whom he claims was the first inventor, or has in the specification claimed that he or the party through whom he claims was the first inventor of any material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no legal right—the patentee may, on payment of the fee hereinafter provided make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof. Such disclaimer shall be in writing, and in duplicate, and attested in the manner hereinbefore prescribed for a patent; one copy to be filed and recorded in the office of the Commissioner, the other copy to be attached to the patent, and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as may relate to the question of unreasonable neglect or delay in making it. In case of the death of the original

patentee, or of his having assigned the patent, a like right shall vest in his assigns or legal representatives respectively, any of whom may make disclaimer. The patent shall thereafter be deemed good and valid for so much of the invention as is truly the disclaimant's own, and not disclaimed, provided it be a material and substantial part of the invention, and definitely distinguished from other parts claimed without right; and the disclaimant shall be entitled to maintain a suit for such part accordingly.

## ASSIGNMENT AND INFRINGEMENT OF PATENTS.

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

**Sec. 22.** [**Patents assignable. Registry of.**] Every patent for an invention, whensoever issued, shall be assignable in law either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and also every grant and conveyance of any exclusive right to make and use, and to grant to others the right to make and use, the invention patented, within and throughout Canada or any part thereof, shall be registered in the office of the Commissioner, in the manner from time to time adopted by the Commissioner of Patents for such registration; and every assignment affecting a patent for invention shall be deemed null and void against any subsequent assignee, unless such instrument is registered as hereinbefore prescribed, before the registering of the instrument under which such subsequent assignee may claim.

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

**Sec. 24.** [**Action for infringement. Injunction. Appeal.**] An action for the infringement of a patent may be brought before any Court of Record having jurisdiction to the amount of damages asked for, and having its sittings within the Province in which the infringement is said to have taken place, and being, at the same time, of the Courts of such jurisdiction within such Province, the one of which the place of holding is nearest to the place of residence or of business of the defendant; and such Court shall decide the case and determine as to costs. In any action for the infringement of a patent, the Court, if sitting, or any Judge thereof in Chambers if the Court be not sitting, may, on the application of the plaintiff or defendant respectively, make such order for an injunction restraining the opposite party from further use, manufacture or sale of the subject-matter of the patent, and for his punishment in the event of disobedience to such order, or for inspection or account and respecting the same and the proceedings in the action, as the Court or Judge may see fit; but from such order, an appeal shall lie under the same

circumstances, and to the same Court, as from other judgments or orders of the Court in which the order was made.

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

**Sec. 26. [Defense.]** The defendant in any such action, may specially plead as a matter of defense, any fact or default which, by this act or by law would render the patent void; and the Court shall take cognizance of that special pleading and of the facts connected therewith, and shall decide the case accordingly.

## NULLITY, IMPEACHMENT, AND AVOIDANCE OF PATENTS.

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

**Sec. 28. 1. [Articles to be made in Canada. Not imported.]** Every patent granted under this Act shall be subject and expressed to be subject to the condition that such patent and all the rights and privileges thereby granted shall cease and determine, and the patent shall be null and void, at the end of two years from the date thereof, unless the patentee, or his assignee or assignees, shall within that period have commenced, and shall, after such commencement, continuously carry on in Canada the construction or manufacture of the invention or discovery patented, in such manner that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price, at some manufactory or establishment for making or constructing it in Canada; and that such patent shall be void if, after the expiration of twelve months from the granting thereof, the patentee, or his assignee or assignees, for the whole or a part of his interest in the patent, imports or causes to be imported into Canada, the invention for which the patent is granted; and provided always, that in case disputes should arise as to whether a patent has or has not become null and void under the provisions of this section, such disputes shall be settled by the Minister of Agriculture or his deputy, whose decision shall be final.

2. **[Extension of term for manufacture.]** Whenever a patentee has been unable to carry on the construction or manufacture of his invention

within the two years hereinbefore mentioned, the Commissioner may grant to the patentee a further delay on his adducing proof to the satisfaction of the Commissioner that he was for reasons beyond his control prevented from complying with the same, but no such further delay shall be thus granted in any case in advance of the time hereinbefore prescribed.

Amended by act of 1875, sec. 2, post.

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

**Sec. 30. [Judgment voiding patent, filed where.]** A certificate of the judgment voiding any patent shall, at the request of any person or party filing it to be of record in the Patent Office, be entered on the margin of the enrolment of the Patent in the Office of the Commissioner, and the patent shall thereupon be and be held to have been void and of no effect, unless and until the judgment be reversed on appeal, as hereinafter provided.

**Sec. 31. [Judgment subject to appeal.]** The judgment declaring any patent void shall be subject to appeal to any Court of Appeal having appellate jurisdiction in other cases over the Court by which the same was rendered.

## PATENTS ISSUED UNDER FORMER LAWS.

**Sec 32. [Existing patents to remain in force.]** All patents issued under any Act of the Legislature of the late Province of Canada or of Nova Scotia, or of New Brunswick, or of British Columbia, and all patents issued for the Provinces of Ontario and Quebec, under any Act of the late Province of Canada, and all patents issued under the "Patent Act of 1869," to the date of the coming into operation of the present Act, shall remain in force for the same term, and for the same extent of territory, as if the Act under which they were issued had not been repealed, but subject to the provisions of this Act in so far as applicable to them.

2. **[Extension of Provincial patents.]** And it shall be lawful for the Commissioner, upon the application of the patentee named in any such patent being the inventor of the subject-matter of the patent, if the subject-matter of the patent has not been known or used, nor with the consent of the patentee on sale in any of the other Provinces of the Dominion, to issue on pay-

ment of the proper fees in that behalf a patent under this Act extending such Provincial patent over the whole of the Dominion, for the remainder of the term mentioned in the Provincial patent.

**Sec. 33.** [**Records of Provincial Patent Offices, where placed.**] All the records of the Patent Offices of the late Province of Canada, and of the Provinces of Ontario and Quebec, or Nova Scotia and New Brunswick, and British Columbia, shall be handed over by the officers in charge of them to the Commissioner of Patents of invention, to form part of the records of the Patent Office for the purposes of this Act.

## TARIFF OF FEES.

**Sec. 34.** [**Tariff of fees.**] The following fees shall be payable to the Commissioner, before an application for any of the purposes hereinafter mentioned shall be entertained; that is to say:

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

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

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

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

**Sec. 36.** [**Fees in full of all services.**] The said fees shall be in full of all services performed under this Act, in any such case, by the Commissioner or any person employed in the Patent Office.

**Sec. 37.** [**Fees, where applied.**] All fees received under this act shall be paid over to the Receiver-General, and form part of the Consolidated Revenue Fund of Canada, except such sums as may be paid for copies of drawings when made by persons not receiving salaries in the Patent Office.

**Sec. 38.** [**Return of fees, when.**] No fee shall be made the subject of ex-

emption in favor of any person; and no fee, once paid, shall be returned to the person who paid it, except,—

1. When the invention is not susceptible of being patented;

2. When the petition for a patent is withdrawn;

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

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

## MISCELLANEOUS PROVISIONS.

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

**Sec. 40.** [**Commissioner may refuse a patent.**] The Commissioner may object to grant a patent in the following cases:

1. When he is of opinion that the alleged invention is not patentable in law;

2. When it appears to him that the invention is already in the possession of the public with the consent or allowance of the inventor;

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

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

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

**Sec. 41.** [**Ground of objection to be given applicant.**] Whenever the Commissioner objects to grant a patent as aforesaid, he shall notify the applicant

to that effect, and shall state the ground or reason therefor with sufficient detail to enable the applicant to answer, if he can, the objection of the Commissioner.

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

**Sec. 43.** [**Arbitration in case of interfering applications.**] In case of interfering applications for any patent, the same shall be submitted to the arbitration of three skilled persons, one of whom shall be chosen by each of the applicants, and the third person shall be chosen by the Commissioner or by his deputy, or the person appointed to perform the duty of that office; and the decision or award of such arbitrators, or any two of them, delivered to the Commissioner in writing, and subscribed by them or any two of them, shall be final as far as respects the granting of the patent.

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

3. [**Their oath of office.**] The arbitrators so named shall, before a judge of any court in any of the Provinces of Canada, subscribe to the following oath: "I, the undersigned (A. B.), being duly appointed an arbitrator under the authority of the forty-third section of the Patent Act of 1872, do hereby solemnly swear (*or affirm, as the case may be*), that I will well and truly perform the duty of such arbitrator on the interfering applications of (C. D. and E. F.) submitted to me."

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

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

**Sec. 44.** [**Documents open to inspection.**] All specifications, drawings,

models, disclaimers, judgments and other papers, except *caveats*, shall be open to the inspection of the public at the Patent Office, under such regulations as may be adopted in that behalf.

Sec. 45. [**Clerical errors.**] Clerical errors happening in the framing or copying of any instrument of the Patent Office, shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the Commissioner.

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

Sec. 47. [**Use of patented invention in foreign vessels.**] No patent shall extend to prevent the use of any invention in any foreign ship or vessel, where such invention is not so used for the manufacture of any goods to be vended within or exported from Canada.

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

Sec. 49. [**Patented articles to be marked; penalty.**] Every patentee under this Act, shall stamp or engrave on each patented article, sold or offered for sale by him, the year of the date of patent applying to such article, thus: "Patented 1872," or as the case may be; and any such patentee selling or offering for sale any such patented article not so marked, shall be liable to the punishment of a fine not to exceed one hundred dollars, and in default of the payment of such fine, to imprisonment not to exceed two months.

Amended by act of 1875, sec. 3, post.

Sec. 50. [**Falsely marking thing as patented, a misdemeanor.**] Whosoever writes, paints, prints, moulds, casts, carves, engraves, stamps, or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole making or selling of such thing without the consent of such patentee—or without the consent of the patentee, writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything not purchased from the patentee, the words, "Patent," "Letters Patent," "Queen's Patent," "Patented," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, or whosoever puts to sale as patented, any article not patented in Canada, for the

purpose of deceiving the public,—shall be deemed guilty of a misdemeanor, and shall on conviction be punished therefor by fine, or by imprisonment, or both, in the discretion of the Court before which the conviction shall be had; but the fine shall not exceed two hundred dollars, nor shall the imprisonment exceed three months.

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

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

**Sec. 53.** [**Short title.**] In citing this Act it shall be sufficient to call it "The Patent Act of 1872."

**Sec. 54.** [**When act commences.**] This Act shall commence and take effect on the first day of September, 1872.

## 36TH VICTORIA.

### CHAP. 44. AN ACT TO AMEND "THE PATENT ACT OF 1872."

[*Assented to 23rd May*, 1873.]

Whereas it is expedient to amend the several sections of "*The Patent Act of* 1872" hereinafter specified; Therefore Her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:

**Sec. 1.** [**Amendment of sec. 5, act 1872.**] The words "in the *Canada Gazette*" in the fourth line of section five of "*The Patent Act of* 1872," are hereby repealed.

**Sec. 2.** [**Amendment of sec. 8, act 1872.**] The word "assigns" in the last line of section eight of the said Act is hereby repealed, and the words "other legal representatives" substituted in lieu thereof.

**Sec. 3.** [**Amendment of sec. 11, act 1872.**] The following words are hereby inserted after the word "of" in the last line but one of section eleven of the

said Act: "a court of record or a public notary, or the mayor, or other chief magistrate of any city, borough, or town corporate in."

**Sec. 4.** [**Addition to sec. 14, act 1872.**] The following words are hereby added and inserted at the end of section fourteen of the said Act: "But the said Commissioner may in his discretion dispense with the said duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing in print or otherwise, to be attached to the Patent, of which they shall form an essential part."

**Sec. 5.** [**Amendment of sec. 16, act 1872.**] The said Act shall be amended by inserting the words "legal representatives" after the word "administrators," in the sixteenth section thereof.

**Sec. 6.** [**Act, how interpreted.**] This Act shall be read and interpreted as forming one and the same Act with the Act hereby amended.

## 38TH VICTORIA.

CHAP. 14. AN ACT STILL FURTHER TO AMEND "THE PATENT ACT OF 1872," AND TO EXTEND THE SAME, AS AMENDED, TO PRINCE EDWARD ISLAND.

[*Assented to 8th April*, 1875.]

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

**Sec. 1.** [**Addition to sec. 19, act 1872.**] The following words are hereby added to section nineteen of "*The Patent Act of* 1872," after the word "patent" in the last line thereof, that is to say, "and the Commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the thing patented (upon payment of the fee for a re-issue for each of such re-issued patents)."

**Sec. 2.** [**Amendment of sec. 28, act 1872.**] The sub-section of section twenty-eighth of "*The Patent Act of* 1872" is hereby repealed, and the following sub-section is hereby substituted therefor, and shall be read as the sub-section of the twenty-eighth section of the said Act.

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

**Sec. 3.** [**Amendment of sec. 49, act 1872.**] The forty-ninth section of "*The Patent Act of* 1872" is hereby repealed, and the following section is hereby substituted therefor, and shall be read as the forty-ninth section of the said Act:

"49. Every patentee under this Act, shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of the patent

applying to such article, thus: "Patented 1872," or as the case may be; or when from the nature of the article this can not be done, by fixing to it, or to every package whereon one or more of such articles is or are enclosed, a label marked with a like notice; and any such patentee selling or offering for sale any such patented article not so marked, or not enclosed in a package so marked shall be liable to the punishment of a fine not to exceed one hundred dollars, and, in default of the payment of such fine, to imprisonment not to exceed two months."

**Sec. 4.** [**Extension of provisions of act of 1872.**] From and after the passing of this Act all and every the provisions of "*The Patent Act of* 1872," as amended by this Act, and of the Acts amending the same, shall have the same force and effect in Prince Edward Island as the same then respectively have in the other Provinces forming this Dominion; and every patent theretofore issued under the said Acts or any of them shall extend over the said Province for the remainder of the term mentioned therein.

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

## PATENTS ISSUED UNDER FORMER LAWS.

**Sec. 6.** [**Existing Provincial Patents to remain in force.**] All patents issued under the said Acts of the General Assembly of Prince Edward Island, or any of them, to the date of the passing of this Act, shall remain in force in the said Province for the same term as if the Act or Acts under which such patents respectively were issued had not been repealed, but subject to all the provisions of this Act, in so far as such provisions, or any of them, may be applicable to such patents respectively.

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

**Sec. 7.** [**Records of Patent Office of Prince Edward Island, where placed.**] All the records of the Patent Office of the Province of Prince Edward Island shall be handed over by the officers in charge of them to the Commissioner of Patents of Invention, to form part of the records of the Patent Office for the purposes of the Act hereby amended and of the Acts amending the same and of this act.

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

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

# TRADE-MARK AND DESIGN ACTS OF CANADA.

## An Act respecting Trade-Marks and Industrial Designs.

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

**Sec. 1.** [**Minister of Agriculture to register trade-marks and designs.**] The Minister of Agriculture shall cause to be kept in his office books to be denominated respectively the "Trade-Mark Register," and "The Register of Industrial Designs," in which any proprietor of a Trade-Mark or of a Design may have the same registered by depositing with the said Minister a drawing and description in duplicate of such Trade-Mark or Design, together with a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof; and the said Minister of Agriculture, on receipt of the fee hereinafter provided, shall cause the said Trade-Mark or Design to be examined, to ascertain whether it resembles any other Trade-Mark or Design already registered; and if he find that such Trade-Mark or Design is not identical with or does not so closely resemble as to be confounded with any other Trade-Mark or Design already registered, he shall register the same, and shall return to the proprietor thereof one copy of the drawing and description, with a certificate signed by the Minister or his Deputy, to the effect that the said Trade-Mark or Design has been duly registered in accordance with the provisions of this Act; and there shall be fur-

ther stated in such certificate the day, month, and year of the entry thereof, in the proper Register; and every such certificate shall be received in all courts of law or of equity in Canada, as evidence of the facts therein alleged, without proof of the signature.

**Sec. 2.** [**Rules and forms, who may make.**] The Minister of Agriculture may, from time to time, subject to the approval of the Governor in Council, make such rules and regulations and adopt forms for the purposes of this Act, and such rules, regulations and forms circulated in print for the use of the public, shall be deemed to be correct for the purposes of this Act, and all documents executed according to the same and accepted by the Minister of Agriculture shall be held valid so far as relates to the official proceedings under this Act.

## TRADE-MARKS.

**Sec. 3.** [**What deemed trade-marks.**] For the purposes of this Act all marks, names, brands, labels, packages or other business devices, which may be adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description by him manufactured, produced, compounded, packed or offered for sale, no matter how applied, whether to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatever containing the same, shall be considered and known as trade-marks, and may be registered for the exclusive use of the party registering the same in the manner hereinafter provided; and thereafter he shall have the exclusive right to use the same, to designate articles manufactured or sold by him, and for the purpose of this Act timber and lumber of any kind upon which labor has been expended by any person in his trade, business, occupation or calling shall be deemed a manufacture, product or article.

**Sec. 4.** [**Trade-marks may be cancelled.**] Any person having registered a trade-mark may petition for the cancellation of the same, and the Minister of Agriculture may cause, on receiving such petition, the said trade-mark to be so cancelled; and the same shall after such cancellation be considered as if it had never been registered under the name of the said party.

**Sec. 5.** [**Registered trade-marks assignable.**] Every Trade-Mark registered in the office of the Minister of Agriculture shall be assignable in law, and on the assignment being produced and the fee hereinafter provided being paid, the Minister of Agriculture shall cause the name of the assignee, with the date of the assignment and such other details as he may see fit, to be entered on the margin of the Register of Trade-Marks on the folio where such Trade-Mark is registered.

**Sec. 6.** [**Conflicting claims to trade-mark, how dealt with.**] If any person shall make application to register, as his own, any trade-mark, which has been already registered, the Minister of Agriculture shall cause all parties interested therein to be notified to appear, in person or by attorney, before him, with their witnesses, for the purpose of establishing which is the rightful owner of such trade-mark and after having heard the parties and their witnesses, the said Minister shall order such entry or cancellation, or both, to be made as he shall deem just; in the absence of the said Minister, his De-

puty may hear and determine the case and make such entry or cancellation or both, as to right and justice may appertain, and similarly, any error in Registering Trade-Marks or any oversight about conflicting registrations of Trade-Marks may be settled in the same manner.

**Sec. 7.** [**Penalty for using another person's trade-mark.**] If any person, other than the party who has registered the same, shall mark any goods or any article of any description whatever with any trade-mark registered under the provisions of this Act, or with any part of such trade-mark, whether by applying such trade-mark or any part thereof to the article itself or to any package or thing containing such article, or by using any package or thing so marked which has been used by the proprietor of such trade-mark, or shall knowingly sell or offer for sale any article marked with such trade-mark, or with any part thereof, with the intent to deceive and to induce persons to believe that such article was manufactured, produced, compounded, packed or sold by the proprietor of such trade-mark, he shall be guilty of a misdemeanor, and on conviction thereof, shall forfeit for each offense, a sum of not less than twenty dollars and not exceeding one hundred dollars, which amount shall be paid to the proprietor of such trade-mark together with the costs incurred in enforcing and recovering the same; provided always that every complaint under this section shall be made by the proprietor of such trade-mark, or by some one acting on his behalf and duly authorized thereto.

**Sec. 8.** [**Penalty for registering another's trade-mark.**] If any person shall knowingly and willfully register as his own any trade-mark, the property of a person not resident in Canada, he shall be guilty of a misdemeanor, and shall be subject and liable to the penalty mentioned in the preceding section; and the entry of every such trade-mark in the Trade-Marks Register shall be cancelled on receipt of a certificate signed by the Clerk of the Court, or the Justices of the Peace before whom the conviction was had, of any such conviction; and one-half of every such penalty shall be paid to the party prosecuting, and the other half to the Crown.

**Sec. 9.** [**Penalty for using trade-marks of persons not resident in Canada.**] If any person shall counterfeit or use the trade-mark of any person not resident of Canada, with intent to deceive the public and lead to the belief that the articles or packages so marked were manufactured or put up by the owner of such trade-mark, although the same is not registered in Canada, he shall, on conviction thereof, forfeit a sum not less than ten dollars nor more than fifty dollars for each offense, with costs, one-half of which penalty shall be paid to the complainant and the other half to the Crown.

**Sec. 10.** [**Complaints for using trade-marks.**] Complaints under either of the two next preceding sections may be brought by any party or person whatever, and the penalties mentioned in the three next preceding sections shall be enforced and recovered in the same manner, and subject to the same provisions as are provided in the sections of this Act respecting the registration and protection of designs.

**Sec. 11.** [**Imitation of trade-mark forbidden.**] The use of any trade-mark either identical with that of any manufacturer, producer, packer or vender, or so closely resembling it as to be calculated to be taken for it by ordinary purchasers, shall be held to be a use of such trade-mark.

**Sec. 12.** [**Action for damages for using trade-mark.**] Notwithstanding anything in the preceding sections contained, a suit may be maintained by any proprietor of a trade-mark against any person using his registered trade mark, or any fraudulent imitation thereof or selling articles bearing such trade-mark, or any such imitation thereof, or contained in packages being or purporting to be his, contrary to the provisions of this Act.

## REGISTRATION OF DESIGNS.

**Sec. 13.** [**Copyright of design, term of.**] The Copyright acquired for an industrial design by the Registration of the same as aforesaid shall be valid for the term of five years.

**Sec. 14.** [**Registration of design, how made.**] Every design to be protected must be registered before publication; and, after Registration, the name of the proprietor, who must be a resident of Canada, shall appear upon the article to which his design applies; if the manufacture be a woven fabric, by printing upon one end; if another substance, at the edge or upon any convenient parts, the letters Rd., with the mention of the year of the Registration; the mark may be put upon the manufacture by making it on the material itself, or by attaching thereto a label containing the proper marks.

**Sec. 15.** [**Proprietor of design.**] The author of the design shall be considered the proprietor thereof, unless he has executed the design for another person, for a good or valuable consideration, in which case such other person shall be considered the proprietor, and shall alone be entitled to register it; but his right to the property shall only be co-extensive with the right which he may have acquired.

**Sec. 16.** [**Designs assignable in law.**] Every design shall be assignable in law, either as to the whole interest or any undivided part thereof, by an instrument in writing, which assignment shall be recorded in the office of the Minister of Agriculture, on payment of the fees hereinafter provided; and every proprietor of a design may grant and convey an exclusive right under any Copyright, to make, use and vend and to grant to others to make, use and vend such design within and throughout Canada or any part thereof, for the unexpired term thereof, or any part thereof; which exclusive grant and conveyance shall be called a license, and shall be recorded in the same manner and within the same delay as assignments.

**Sec. 17.** [**No use of registered design without license.**] During the existence of the right (whether it be of the entire or partial use of such design), no person shall, without the license in writing of the registered proprietor, apply such design, or a fraudulent imitation thereof, to the ornamenting of any article of manufacture, &c., for the purposes of sale, or publish, sell, or expose for sale or use any article of manufacture, &c., to which such design or fraudulent imitation thereof shall have been applied, under penalty of not less than twenty dollars, and not exceeding one hundred and twenty dollars, to the proprietor of the design, and costs—to be recovered by the registered proprietor or his assignee, by suit, in any court, having jurisdiction in suits of a like amount.

**Sec. 18.** [**Penalty for marking an unregistered article as registered.**] Every person placing the words "registered," or the letters "Rd.," upon any

unregistered article, or upon any article, the copyright of which has run out, or advertising the same for sale as a registered article, or unlawfully selling, publishing or exposing for sale such article, knowing the same to have been fraudulently stamped or that the copyright thereof has expired, shall forfeit for every offense a sum not less than four dollars and not exceeding thirty dollars, to be recovered in the same manner as penalties under the next preceding section, and that by any person whatever, who shall receive one-half the amount of the said last mentioned penalty, on the recovery of the amount which the offender may have been condemned to pay.

**Sec. 19.** [**Action of damages for using design without license.**] A suit may be maintained by the proprietor of any design for the damages he has sustained by the application or imitation of the design, for the purpose of sale, against any person so offending, he (the offender) knowing that the proprietor of the design had not given his consent to such application.

**Sec. 20.** [**Proceedings against person fraudulently registering a design.**] If any person, not being the lawful proprietor of a design, be registered as the proprietor thereof, the rightful owner may institute an action in the Superior Court in the Province of Quebec, in the Court of Queen's Bench in the Provinces of Ontario, and in the Supreme Court in the Provinces of Nova Scotia or New Brunswick, as the case may be, and the court having cognizance of such suit may, if it appear that the design has been registered in the name of a wrong person, either direct the registration to be cancelled, or that the name of the lawful proprietor shall be substituted for the name in the register, with costs in its discretion, and on application by the plaintiff supported by affidavit, it shall be lawful for any such court, pending such action or proceedings, at its discretion, to issue an order upon the defendant prohibiting the use of such design, pending such suit or proceedings, under pain of being held in contempt of such court.

**Sec. 21.** [**Alteration in register on order of court.**] The Minister of Agriculture, after due service of such order and payment of the fee hereinafter provided, shall cause such alteration to be made in the register as shall in said order be directed.

**Sec. 22.** [**Limitation of actions.**] All proceedings, under the preceding sections of this Act, shall be brought within twelve months from the commission of the offense, and not after; nor shall any of the clauses of this Act apply to protect any design which does not belong to a person resident within Canada, and is not applied to a subject-matter manufactured in Canada.

**Sec. 23.** [**Certificate on copy returned to the owner.**] On the copy returned to the person registering, a certificate shall be given, signed by the Minister or by his Deputy, that the design has been registered, the date of registration, the name of the registered proprietor, his address, the number of such design, and the number or letter employed to denote or correspond with the registration, which said certificate, in the absence of proof to the contrary, shall be sufficient proof of the design, of the name of the proprietor, of the registration, of the commencement and period of registry, of the person named as proprietor being proprietor, of the originality of the design, and of compliance with the provisions of this Act; and generally the writing so signed shall be received as evidence of the facts therein stated, without proof of the signature.

## GENERAL PROVISIONS.

**Sec. 24.** [**Inspection of registers.**] Any person may be allowed to inspect the Register of Trade-Marks and the Register of Industrial Designs; and the Minister may cause copies or representations of Trade-Marks or Industrial Designs to be delivered, on the applicant for the same paying the fee which shall be deemed sufficient for the purpose of having the same copied or represented.

**Sec. 25.** [**What designs minister may refuse to register.**] The Minister of Agriculture shall have power to refuse to register such designs as do not appear to him to be within the provisions of this Act, or when the design is contrary to public morality or order, subject, however, to appeal to the Governor, in Council.

**Sec. 26.** [**Publication of titles of design.**] The Minister of Agriculture shall, from time to time, cause to be published, in the *Canada Gazette*, the titles of the designs registered and the names and places of abode of the registered proprietors.

**Sec. 27.** [**Clerical errors not to invalidate.**] Clerical errors happening in the drawing up or copying of any instrument shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the Minister of Agriculture.

**Sec. 28.** [**Table of fees; how applied.**] The following fees shall be payable, to wit:

| | |
|---|---|
| On every application to register a design or trade-mark, including certificate | $5 00 |
| For each certificate of registration not already provided for. | 1 00 |
| For each copy of any drawing, the reasonable expenses of preparing the same. | |
| For recording any assignment. | 2 00 |

For office copies of documents or entries, not above mentioned, the following charges shall be exacted:

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

All of which fees shall be paid over by the Minister of Agriculture to the Receiver General of Canada.

**Sec. 29.** [**Repeal of former Acts.**] The Act twenty-fourth Victoria, chapter twenty-first of the Statutes of the late Province of Canada, and the thirtieth Victoria, chapter thirty-first of the Province of New Brunswick, and all other Acts or parts of Acts inconsistent with the present Act, are hereby repealed as to any further registration or the granting of any new exclusive right under the provisions thereof; but all rights heretofore acquired by virtue of such provisions shall remain good and valid and assignable in law, and all penalties and forfeitures incurred or to be incurred under the same may be sued for and enforced, and all prosecutions commenced before the passing of this Act for any such penalties or forfeitures already incurred may be contin-

ned and completed, and entries and registrations under the said Acts respectively may be cancelled, as if the said Acts and parts of Acts had not been repealed.

**Sec. 30.** [**Dep. Minister substituted for Sec'y of Registration and Statistics.**] For all the purposes of the Act of Canada cited in the next preceding section of this Act, so far as the same remains in force after the passing of this Act, the deputy of the Minister of Agriculture shall be and is hereby substituted for the Secretary of the Board of Registration and Statistics mentioned in the said Act, and shall have all the powers and duties of these officers.

**Sec. 31.** [**Short Title.**] In citing this Act it shall be sufficient to call it "The Trade-Mark and Design Act of 1868."

# COPYRIGHT ACT OF CANADA.

## An Act respecting Copyrights.

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

**Sec. 1.** [**Register of Copyrights.**] The Minister of Agriculture shall cause to be kept in his office a book to be called the "Register of Copyrights," in which proprietors of literary, scientific, and artistical works or compositions, may have the same registered in accordance with the provisions of this Act.

**Sec. 2.** [**Rules, &c., who to make.**] The Minister of Agriculture may, from time to time, subject to the approval of the Governor, in Council, make such rules and regulations, and prescribe such forms, as may appear to him necessary and expedient for the purposes of this Act; such regulations and forms being circulated in print for the use of the public, shall be deemed to be correct for the purposes of this Act, and all documents, executed according the same and accepted by the said Minister of Agriculture, shall be held valid so far as relates to all official proceedings under this Act.

**Sec. 3.** [**Who may have copyright.**] Any person resident in Canada or any person being a British subject, and resident in Great Britain or Ireland, who is the author of any book, map, chart, or musical composition, or of any original painting, drawing, statuary, sculpture or photograph, or who invents, designs, etches, engraves, or causes to be engraved, etched or made from his own design, any print or engraving, and the legal representatives of such persons shall have the sole right and liberty of printing, reprinting, publishing, reproducing and vending such literary, scientific or artistical works or compositions, in whole or in part, and of allowing translations to be made of such literary works from one language into other languages for the term of twenty-eight years, from the time of recording the title thereof in the manner hereinafter directed; but no immoral or licentious, treasonable or seditious book or any other such literary, scientific or artistical work or composition shall be the subject of such registration or copyright.

**Sec. 4.** [**Renewal of copyright.**] If at the expiration of the aforesaid term, such author, or any of the authors, where the work has been originally composed and made by more than one person, be still living, and residing in Canada or in Great Britain or Ireland, or being dead, has left a widow or a child, or children living, the same exclusive right shall be continued to such author, or if dead, then to such widow and child or children (as the case may be), for the further term of fourteen years; but in such case within one year after the expiration of the first term, the title of the work secured shall be a second time recorded, and all other regulations herein required to be observed in regard to original copyrights shall be complied with in respect to such renewed copyright.

**Sec. 5.** [**Record of renewal to be published.**] In all cases of renewal of

Copyright under this Act, the author or proprietor shall within two months from the date of such renewal, cause a copy of the record thereof to be published once in the *Canada Gazette*.

**Sec. 6.** [**Deposit of copies, where to be made.**] No person shall be entitled to the benefit of this Act, unless he has deposited in the office of the Minister of Agriculture two copies of such book, map, chart, musical composition, photograph, print, cut, or engraving, and in case of paintings, drawings, statuary and sculptures, unless he has furnished a written description of such works of art, and the Minister of Agriculture shall cause the same to be recorded forthwith in a book to be kept for that purpose, in the manner prescribed by the rules and forms which may be made from time to time, as hereinbefore provided, for which record the person claiming such right as aforesaid, shall pay into the hands of the Minister of Agriculture one dollar, and the like sum for every copy actually given to such person or his legal representatives, and the sums so paid shall be paid over to the Receiver General to form part of the Consolidated Revenue of Canada.

**Sec. 7.** [**Copy for library of parliament.**] The Minister of Agriculture shall cause one of the two copies of such book, map, chart, musical composition, photograph, print, cut or engraving aforesaid, to be deposited in the Library of the Parliament of Canada.

**Sec. 8.** [**Notice of copyright.**] No person shall be entitled to the benefit of this Act, unless he gives information of the copyright being secured by causing to be inserted in the several copies of every edition published during the term secured on the title page, or the page immediately following, if it be a book, or if a map, chart, musical composition, print, cut, engraving or photograph, by causing to be impressed on the face thereof, or if a volume of maps, charts, music or engravings, upon the title or frontispiece thereof, the following words, that is to say: "Entered according to Act of Parliament of Canada, in the year by A. B., in the office of the Minister of Agriculture." But as regards paintings, drawings, statuary and sculptures, the signature of the artist shall be deemed a sufficient notice of such proprietorship.

**Sec. 9.** [**Publication to be in Canada.**] To entitle any such literary production or engraving as is in this Act mentioned, being the work of any such person residing in Great Britain or Ireland, to the protection of this Act, the same shall be printed and published in Canada, and shall in addition to the words directed to be inserted by the last section of this Act, and immediately following thereafter, contain the name and place of abode or business in Canada of the printer and publisher thereof.

**Sec. 10.** [**Penalty for infringement of copyright of books.**] If any other person, after the recording of the title of any book according to this Act, within the term or terms herein limited, prints, publishes or imports, or causes to be printed, published or imported, any copy or any translation of such book without the consent of the person legally entitled to the copyright thereof, first had and obtained by deed duly executed, or, knowing the same to be so printed or imported, publishes, sells or exposes to sale or causes to be published, sold or exposed to sale any copy of such book without such consent in writing, such offender shall forfeit every copy of such book to the person then legally entitled to the copyright thereof; and shall forfeit and pay two dol-

lars, for every such copy which may be found in his possession, either printed or printing, published, imported or exposed to sale, contrary to the intent of this Act; of which penalty one moiety shall be to the use of Her Majesty, and the other to the legal owner of such copyright, to be recovered in any court of competent jurisdiction.

Sec. 11. [**Penalty for infringement of Copyright of painting, &c.**] If any person, after the recording of any painting, drawing, statuary or sculpture work, within the term or terms limited by this Act, reproduces in any manner or causes to be reproduced, made or sold, in part or in the whole, copies of the said works of art, without the consent of the proprietor or proprietors, such offender or offenders, shall forfeit the plate or plates on which such reproduction has been made, and also every sheet thereof, so copied, printed or photographed to the proprietor or proprietors of the copyright thereof, and shall further forfeit two dollars for every sheet of the same reproduction so published or exposed to sale contrary to the true intent and meaning of this Act; and one moiety of such forfeiture shall go to the proprietor or proprietors and the other moiety to the use of Her Majesty, and such forfeiture may be recovered in any court of competent jurisdiction.

Sec. 12. [**Penalty for infringement of copyright of print, &c.**] If any person after the recording of the title of any print, cut, or engraving, map, chart, musical composition or photograph, according to the provisions of this Act, within the term or terms limited by this Act, engraves, etches or works, sells or copies, or causes to be engraved, etched, or copied, made or sold, either in the whole or by varying, adding to or diminishing the main design, with intent to evade the law, or prints or imports for sale, or causes to be printed or imported for sale, any such map, chart, musical composition, print, cut or engraving, or any parts thereof, without the consent of the proprietor or proprietors of the copyright thereof, first obtained as aforesaid, or knowing the same to be so printed or imported without such consent, publishes, sells or exposes to sale or in any manner disposes of any such map, chart, musical composition, engraving, cut, photograph or print, without such consent, as aforesaid, such offender or offenders shall forfeit the plate or plates on which such map, chart, musical composition, engraving, cut, photograph or print has been copied, and also every sheet thereof, so copied or printed as aforesaid, to the proprietor or proprietors of the copyright thereof, and shall further forfeit two dollars for every sheet of such map, musical composition, print, cut or engraving which may be found in his or their possession, printed or published or exposed for sale, contrary to the true intent and meaning of this Act; and one moiety of such forfeiture shall go to the proprietor or proprietors, and the other moiety to the use of Her Majesty, and such forfeiture may be recovered in any court of competent jurisdiction.

Sec. 13. [**Temporary registration to secure copyright.**] A literary work, intended to be published in pamphlet or book form, but which is first published in separate articles in a newspaper or periodical, may be the subject of registration within the meaning of the present Act, while it is so preliminarily published, provided that the title of the manuscript and a short analysis of the work are deposited in the office of the Minister of Agriculture, the registration fee be duly paid, and that every separate article so published is preceded by the words "Registered in accordance with the copyright Act of 1868;"

but the work when published in book or pamphlet form, shall be subject, besides, to the other requirements of this Act.

Sec. 14. [**Copyright of scene or object.**] Nothing herein contained, however, shall prejudice the right of any person to represent any scene or object, notwithstanding that there may be copyright in some other representation of such scene or object.

Sec. 15. [**Copyright of work made for another.**] Whenever the author of a literary, scientific or artistical work or composition which may be the subject of copyright, has executed the same for another person or has sold the same to another person for due consideration, such author shall not be entitled to obtain or to retain the proprietorship of such copyright which is by the said transaction virtually transferred to the purchaser, who may avail himself of such privilege, unless a reserve of the said privilege is specially made by the author or artist in a deed duly executed.

Sec. 16. [**Damages for infringement of copyright.**] If any person prints or publishes any manuscript whatever in Canada, or the same having been printed or published elsewhere, offers it or causes it to be offered for sale in Canada, without the consent of the author or legal proprietor first obtained, such author or proprietor being resident in Canada, or being a British subject resident in Great Britain or Ireland, such person shall be liable to the author or proprietor for all damages occasioned by such injury, to be recovered in any court of competent jurisdiction.

Sec. 17. [**Penalty for falsely pretending to have copyright.**] If any person prints, publishes or reproduces any book, map, chart, musical composition, print, cut or engraving, or other work of art or photograph and not having legally acquired the copyright thereof, inserts therein, or impresses thereon, that the same hath been entered according to this Act, or words purporting the same, every person so offending, shall incur a penalty not exceeding sixty dollars (one moiety thereof to the person who sues for the same, and the other moiety to the use of Her Majesty), to be recovered in any court of competent jurisdiction.

Sec. 18. [**Limitation of actions.**] No action or prosecution for the recovery of any penalty under this Act, shall be commenced more than two years after the cause of action arose.

Sec. 19. [**Repeal of former Acts.**] Chapter eighty-one of the Consolidated Statutes of the late Province of Canada, and chapter one hundred and sixteen of the Revised Statutes of Nova Scotia (third series), and all other Acts or parts of Acts, inconsistent with the provisions of the present Act, are hereby repealed, subject to the provisions of the next section.

Sec. 20. [**Unexpired copyrights continued.**] All copyrights heretofore acquired under the Acts or parts of Acts hereby repealed, shall, in respect to the unexpired terms thereof, continue unimpaired, and shall have the same force and effect as regards the Province or Provinces to which they now extend, and shall be assignable and renewable, and all penalties and forfeitures incurred and to be incurred under the same may be sued for and enforced, and all prosecutions commenced before the passing of this Act for any such penalties or forfeitures already incurred may be continued and completed as if such Acts were not repealed.

Sec. 21. [**Short Title.**] In citing this Act it shall be sufficient to call it "The copyright Act of 1868."

# INDEX.


| | SEC. | PAGE |
|---|---|---|
| Actions, infringements of patents. | | |
| Against whom may be brought | 23 | 9 |
| Judgment in how enforced. | 23 | 9 |
| Jurisdiction in Courts of Records | 24 | 9 |
| Order for injunction or account in wrongful use of | 24 | 9 |
| When maintainable, when patent too broad | 25 | 10 |
| Special pleas allowed in | 26 | 10 |
| Actions, infringement of trade-marks. | | |
| For penalties, who may bring | 10 | 21 |
| For damages, when and by whom | 12 | 22 |
| For wrongful use of designs for damages, who may bring | 19 | 23 |
| Within what time to be brought | 22 | 23 |
| Actions, infringement of copyrights. | | |
| Of copyright of books | 10 | 27 |
| Of copyright of paintings | 11 | 28 |
| Of copyright of prints | 12 | 28 |
| For publishing manuscript. | 16 | 29 |
| For penalties, limitation of. | 18 | 29 |
| Administrators, see Executors. | | |
| Affirmation, see Oath. | | |
| Agriculture, Minister of, to be commissioner of patents | 1 | 4 |
| To determine as to voidance of patent from non-user | 28 | 10 |
| To keep a register of trade-marks or designs | 1 | 19 |
| Duties of, on application for trade-mark or design | 1 | 19 |
| To sign certificate of registration | 1 | 19 |
| To make rules and regulations | 2 | 20 |
| To adopt forms | 2 | 20 |
| When may cancel trade-mark | 4 | 20 |
| To enter assignment of trade-mark | 5 | 20 |
| To determine conflicting applications | 6 | 20 |
| May correct errors in registering | 6 | 20 |
| When to alter register of design | 21 | 23 |
| To give certificate of registration | 23 | 23 |
| May refuse to register designs, when | 25 | 24 |
| To publish title of designs registered | 26 | 24 |
| May correct clerical errors | 27 | 24 |
| To keep "Register of Copyrights" | 1 | 26 |
| To make rules and regulations as to copyrights | 2 | 26 |
| To record articles copyrighted | 6 | 27 |
| To deposit copies of article copyrighted in Library of Parliament | 7 | 27 |
| Appeals from injunction orders | 24 | 9 |
| From commissioner on refusal of patent | 42 | 14 |
| Applications for patents may be made by citizens or aliens | 6 | 5 |
| When joint patent to issue in name of all | 10 | 6 |
| Verification of, what required in | 11 | 6 |
| Petitioner to elect domicile | 12 | 6 |
| Name of invention to be inserted in | 13 | 7 |
| Drawings to be furnished with | 14 | 7 |
| Models to be furnished with | 15 | 7 |
| To be accompanied by specimens | 15 | 7 |
| If rejected, applicant may appeal | 42 | 14 |
| Applications for trade-marks or designs, how made | 1 | 19 |
| To be accompanied by drawings | 1 | 19 |
| Arbitrators on interfering applications, how chosen | 43(1) | 14 |
| When commissioner may appoint | 43(2) | 14 |
| Decision of, to be final | 43 | 14 |
| Oath of | 43(3) | 14 |

| | SEC. | PAGE |
|---|---|---|
| Powers of | 43 (4) | 14 |
| Fees of, how paid | 43 (5) | 14 |
| Art, patent may be granted for. | 6 | 5 |
| Assignee of invention, patent may be granted to | 8 | 6 |
| May surrender or re-issue patent | 19 | 8 |
| May make disclaimer | 20 | 8 |
| Assignee of author, when may have copyright | 15 | 19 |
| Assignment of patent, to officers or employes of patent office, void | 4 | 5 |
| From one joint patentee to another to be registered | 10 | 6 |
| To be in writing | 22 | 9 |
| To be registered, and when | 22 | 9 |
| When void | 22 | 9 |
| Assignment of designs to be in writing | 16 | 22 |
| To be recorded | 16 | 22 |
| Fees for recording | 28 | 24 |
| Assignment of trade-mark, to be registered | 5 | 20 |
| Fees for | 28 | 24 |
| Author of design, to be considered as proprietor | 15 | 22 |
| May assign | 16 | 22 |
| Canada, government of, when may use patented invention | 21 | 9 |
| Patentee, how compensated by | 21 | 9 |
| Caveat, who may file | 39 | 13 |
| What to set forth | 39 | 13 |
| To be preserved in secrecy. | 39 | 13 |
| Rights secured by | 39 | 13 |
| When caveator may be required to complete invention | 39 | 13 |
| Fee on | 34 | 12 |
| Certificate of registration of trade-mark, to be given | 23 | 23 |
| To contain what | 23 | 23 |
| To be received in evidence. | 23 | 23 |
| Fees for | 28 | 24 |
| Claim of specification of patent too broad, when action maintainable | 25 | 10 |
| Clerical errors, may be corrected in instruments as to patents | 45 | 15 |
| Not to invalidate instrument as to trade-mark and designs | 27 | 24 |
| To be corrected | 27 | 24 |
| Commissioner of patents, Minister of Agriculture to be | 1 | 4 |
| General duties of | 1 | 4 |
| To prepare a seal | 3 | 5 |
| To make rules and regulations | 3 | 5 |
| To sign letters patent | 6 | 5 |
| May require drawings to accompany application | 14 | 7 |
| Duties of, as to surrender and re-issue | 19 | 8 |
| To sign extension | 17 | 17 |
| May extend time to put invention in use | 28 (2) | 10 |
| Duties of, in withdrawals, to refund part fee | 38 | 12 |
| Duties of, in cases of interference, on caveat | 39 | 13 |
| Duties of, in filing a caveat | 39 | 13 |
| May refuse to grant a patent, when | 40 | 13 |
| To notify applicant of such objection | 40 | 13 |
| May have clerical errors corrected | 45 | 15 |
| Composition of matter, patent may be granted for | 6 | 5 |
| Specimens of, when required | 15 | 7 |
| Conflicting registrations, of trade-marks, Minister of Agriculture to determine between | 6 | 20 |
| Copies of papers, relating to patents, any one may have | 29 | 11 |
| Certified, to be filed where. | 29 | 11 |
| Fee for | 34 | 12 |
| Clerical errors in, how corrected | 45 | 15 |
| Copies of papers, relating to trade-marks, any one may have | 24 | 24 |
| Fees for | 28 | 24 |
| Copies of papers, relating to copyrights of record of renewal, to be published | 5 | 26 |
| Of article copyrighted, to be deposited with Minister of Agriculture | 6 | 27 |
| Fees for | 6 | 27 |
| Copyright, what may be copyrighted and by whom | 3 | 26 |
| Immoral or seditious work, not entitled to | 3 | 26 |
| May be renewed after expiration of first term | 4 | 26 |
| Renewal to be recorded | 4 | 26 |
| Notice of, to appear on article copyrighted | 8 | 27 |
| Of work of non-resident, to be published in Canada | 9 | 27 |
| Of book published in separate articles, how registered and marked | 13 | 28 |
| Of representation of scene, &c | 14 | 29 |
| When purchaser of work has proprietorship of | 15 | 29 |
| Falsely inserting notice of, penalty | 17 | 29 |
| Former statutes concerning, repealed | 19 | 29 |
| Acquired under former acts, valid | 20 | 29 |
| Act for, how quoted | 21 | 29 |

| | SEC. | PAGE. |
|---|---|---|
| Courts, jurisdiction in patent cases, patent issued subject to adjudication by.. | 16 | 7 |
| What courts of record have, when..... | 24 | 9 |
| May issue injunctions..... | 24 | 9 |
| May order account. ..... | 24 | 9 |
| May punish for disobedience of orders..... | 24 | 9 |
| To take cognizance of special pleas..... | 26 | 10 |
| May adjudge patent void.. | 29 | 11 |
| Jurisdiction in actions respecting designs, what courts may take..... | 20 | 23 |
| May cause wrongful registration to be cancelled... | 20 | 23 |
| Damages for infringement of patent, how recovered... | 23 | 9 |
| Who liable in..... ..... | 23 | 9 |
| Wrongful use of design, when may be recovered.. | 19 | 23 |
| Deputy Minister of Agriculture, to be deputy commissioner of patents..... | 4 | 5 |
| Designs, registration of, fees for | 28 | 24 |
| Proprietor of, to be resident of Canada..... | 14 | 22 |
| To be marked "Rd." with year ..... | 14 | 22 |
| | 14 | 22 |
| How mark to be attached to article of manufacture | 14 | 22 |
| May be assigned..... | 15 | 22 |
| To be registered to assignee | 15 | 22 |
| Assignment of to be recorded | 16 | 22 |
| License to use, may be granted.... ..... | 16 | 22 |
| License to use, to be recorded..... | 16 | 22 |
| Penalty for infringement of | 17 | 22 |
| To be valid five years ..... | 13 | 22 |
| Disclaimer of patent, who may make..... | 20 | 8 |
| To state interest of disclaimant..... ..... | 20 | 8 |
| To be in writing and attested. ... ..... | 20 | 8 |
| To be in duplicate.. ..... | 20 | 8 |
| How far affects pending actions..... | 20 | 8 |
| To be recorded in patent office ..... | 20 | 8 |
| How far affects original patent..... | 20 | 8 |
| Drawings of inventions, commissioners of patents to print, when..... | 5 | 5 |
| To accompany application.. | 14 | 7 |
| To be signed by applicant or attorney..... | 14 | 7 |
| To refer to specification... | 14 | 7 |
| To be annexed to patent... | 14 | 7 |
| To be deposited in patent office ..... | 14 | 7 |
| Executors, patent may be granted to..... | 8 | 6 |
| Extension of patents, when may be obtained..... | 17 | 7 |
| To be signed by commissioner... ..... | 17 | 7 |
| When by member of privy council ..... ..... | 17 | 7 |
| Instrument for to be attached to patent..... | 17 | 7 |
| To be examined by minister of justice.. ..... .. | 17 | 7 |
| To be registered and under seal ..... ..... | 17 | 7 |
| Fees, on petition for a patent.. | 34 | 12 |
| On petition for extension.. | 34 | 12 |
| On lodging a caveat..... | 34 | 12 |
| On asking to register a judgment..... | 34 | 12 |
| On asking to register an assignment..... | 34 | 12 |
| On asking for copy of patent..... | 34 | 12 |
| On petition to re-issue after surrender..... | 34 | 12 |
| For copies of papers ..... | 34 | 12 |
| For copy of drawings..... | 35 | 12 |
| To be paid over to receiver-general ..... ..... | 37 | 12 |
| When to be returned..... | 38 | 12 |
| Of arbitrators ..... | 43(5) | 14 |
| On application to register trade-mark ..... | 28 | 24 |
| For certificate of registration..... | 28 | 24 |
| For copies of papers..... | 28 | 24 |
| For recording assignment.. | 28 | 24 |
| For recording copies of article copyrighted..... | 6 | 27 |
| Foreign patents not to be obtained over twelve months prior to Canadian patent..... | 7 | 6 |
| Canadian patent to expire with foreign..... | 7 | 6 |
| Impeachment of patent, certificate of judgment of, to be filed in patent office.. | 30 | 11 |
| To be entered on margin of patent..... | 30 | 11 |
| Judgment of, may be appealed..... | 31 | 12 |
| What courts may decree... | 29 | 11 |
| Certified copies of papers to be used in..... | 29 | 11 |
| Scire facias to issue for.... | 29 | 11 |
| Improvement, patent may be granted for..... | 6 | 5 |
| Patentee of, not to use original invention..... | 9 | 6 |
| Infringement of patent, see actions and damages. | | |
| Infringement of designs, penalty for..... | 17 | 22 |
| Suit for damages, against whom may be brought.. | 19 | 23 |
| Infringement of trade-marks, what constitutes..... | 11 | 21 |

# INDEX.


| | SEC. | PAGE. |
|---|---|---|
| Proprietor may bring suit for | 12 | 22 |
| Infringement of copyrights. | | |
| Penalty for, of books, &c. | 10 | 27 |
| Penalty for, of paintings, &c | 11 | 28 |
| Penalty for, of maps, photographs, &c | 12 | 28 |
| Interfering applications, for patents to be submitted to arbitrators | 43 | 14 |
| Arbitrators, how chosen | 43 | 14 |
| If either party fails to choose arbitrator, patent to issue to other | 43(2) | 14 |
| Arbitrator on, oath of | 43(2) | 14 |
| Invention, what patentable, what may be patented | 6 | 5 |
| Must be new and useful | 6 | 5 |
| Not known or used by others than inventor | 6 | 5 |
| Not in use or on sale for one year, with inventor's consent | 6 | 5 |
| Not patentable, if illicit object in view | 6 | 5 |
| A mere scientific principle not patentable | 6 | 5 |
| Not if foreign patent obtained more than twelve months prior | 7 | 7 |
| Justice, minister of, to examine patents, when | 18 | 8 |
| To examine extensions, when | 18 | 8 |
| Machine, patent for, patent may be granted for | 6 | 5 |
| Principle and modes of application to be stated | 14 | 7 |
| Manufacture, article of, patent may be granted for | 6 | 5 |
| May be sold notwithstanding patent, when | 7 | 6 |
| Misdemeanor, what is; making or selling articles as patented, when not so | 50 | 15 |
| Imitating mark of patentee | 50 | 15 |
| Altering copies of papers, &c | 51 | 16 |
| Infringement of trademark | 7 | 21 |
| Willfully registering trademark of another | 8 | 21 |
| Models of invention, required on application | 15 | 7 |
| Requisites of | 15 | 7 |
| Oath in patent proceedings, on applications for patent | 11 | 6 |
| Affirmation may be substituted for | 11 | 6 |
| Before whom may be taken | 11 | 6 |
| Petition, see Application. | | |
| Patented articles, to be marked "patented" and with date of patent | 49 | 15 |
| Penalty for neglecting so to do | 49 | 15 |
| Patent office, attached to department of agriculture | 1 | 4 |
| Clerks and officers in, how appointed | 4 | 5 |
| Officers or employes in, to have no interest in patents, except when | 4 | 5 |
| Certificate of judgment of voidance of patent, to be filed in | 30 | 11 |
| All records under former acts to be kept in | 33 | 12 |
| Files of, except caveats, open to inspection | 44 | 14 |
| Patents for inventions, annual list of to be published | 5 | 5 |
| To be under seal of patent office | 6 | 5 |
| To be signed by commissioner of patents | 6 | 5 |
| When by member of privy council | 6 | 5 |
| May issue to assignees or legal representatives | 8 | 6 |
| In joint applications, how to issue | 16 | 7 |
| Issued subject to adjudication by courts | 16 | 7 |
| To refer to specification | 16 | 7 |
| To contain title of invention | 16 | 7 |
| What granted by | 16 | 7 |
| Term of, fifteen years | 17 | 7 |
| May be issued for less term | 17 | 7 |
| Extention of, see Extention. | | |
| To be examined by minister of justice | 18 | 8 |
| How far affected by disclaimer | 20 | 8 |
| When government of Canada may use | 21 | 9 |
| Assignable, in whole or in part | 22 | 9 |
| When void, and for what reasons | 27 | 10 |
| When valid, though claiming too much | 27 | 10 |
| Void, unless invention manufactured within two years from issue | 28 | 10 |
| Void, if imported after twelve months from issue | 28 | 10 |
| Minister of Agriculture to determine whether void | 28 | 10 |
| If issued under former acts, valid | 32 | 11 |
| When provincial patent may be extended under this act | 32 | 11 |
| When commissioner may refuse to grant | 40 | 13 |
| If lost, duplicate to issue | 46 | 15 |
| Not to prevent use of invention on foreign ships, when | 47 | 15 |

| | SEC. | PAGE |
|---|---|---|
| Former acts concerning, how far repealed | 52 | 16 |
| Privy Council, member of, may sign extension, when | 17 | 17 |
| Penalties, in respect to patents. | | |
| For neglecting to stamp date of patent on article sold | 49 | 15 |
| For imitating mark of patentee | 50 | 15 |
| For making or selling article as patented, when not so | 50 | 15 |
| In respect to trade-marks for infringing trade-mark | 7 | 21 |
| For willfully registering trade-mark of another | 7 | 21 |
| For counterfeiting foreign trade-mark | 9 | 21 |
| For using letters "Rd." on unregistered article, &c | 18 | 22 |
| To whom payable | 18 | 22 |
| Any person may bring suit for | 18 | 22 |
| For infringement of designs | 17 | 22 |
| To whom payable | 17 | 22 |
| How recovered | 17 | 22 |
| For infringing copyright of book, &c | 10 | 27 |
| For infringing copyright of painting, &c | 11 | 28 |
| For infringing copyright of maps, &c | 12 | 28 |
| For falsely inserting notice of copyright | 17 | 29 |
| How recovered and distributed | 17 | 29 |
| Limitation of action for | 18 | 29 |
| Incurred under former acts may be sued for | 20 | 29 |
| Proprietor of designs, may bring suit for infringement | 19 | 23 |
| May assign | 16 | 22 |
| May license | 16 | 22 |
| Of trade-marks, may bring suit for infringement | 12 | 22 |
| May assign | 5 | 20 |
| Register of trade-marks, minister of agriculture to keep | 1 | 19 |
| Any person may inspect | 24 | 24 |
| Register of copyrights, minister of agriculture, to keep | 1 | 26 |
| Object of | 1 | 26 |
| Registration of designs, certificate of, to be given | 23 | 23 |
| Remedy for wrongful | 20 | 23 |
| When altered by order of court | 21 | 23 |
| Fees for | 28 | 24 |
| Of trade-marks, how made | 1 | 19 |
| Certificate of, how signed | 1 | 19 |
| May be cancelled | 4 | 20 |
| Conflicting applications for | 6 | 20 |
| Penalty for, when | 8 | 21 |
| Cancellation of | 8 | 21 |
| Fees for | 28 | 24 |
| Under former acts, valid | 29 | 24 |
| Reissue of patent, reissue must be for same invention | 19 | 8 |
| To have same effect as if originally filed | 19 | 8 |
| When may be had, and for what errors | 19 | 8 |
| Renewal of copyrights, to be for fourteen years | 4 | 6 |
| To be recorded | 4 | 6 |
| Copy of record of, to be published | 5 | 6 |
| Report, commissioner to prepare an annual | 5 | 5 |
| Rules and regulations of patent office, how made | 3 | 5 |
| Notice of, to be given concerning copyrights | 3 | 5 |
| Minister of agriculture to make | 2 | 26 |
| To be printed | 2 | 26 |
| Seal of patent office, to be made | 2 | 5 |
| Patent and papers to be sealed with | 2 | 5 |
| Papers certified under to be received in evidence | 2 | 5 |
| To be affixed to extension | 18 | 8 |
| Specifications of patents, commissioner to print, when | 5 | 5 |
| What to set forth | 14 | 7 |
| To be signed by inventor and two witnesses | 14 | 7 |
| To be accompanied by drawings in duplicate | 14 | 7 |
| To accompany application | 13 | 7 |
| To be in duplicate | 13 | 7 |
| Specimens of ingredients to be furnished, on application | 15 | 7 |
| Explosive, only when specially required | 15 | 7 |
| Trade-marks, how registered | 1 | 19 |
| Not to be in use by others at time of application for | 1 | 19 |
| What may be registered as | 8 | 20 |
| Party registering to have exclusive use of | 8 | 20 |
| May be cancelled | 4 | 20 |
| May be assigned | 5 | 20 |
| Penalty for infringement of | 7 | 21 |
| What constitutes infringement of | 11 | 21 |
| Penalty for counterfeiting foreign | 9 | 21 |
| Suit may be brought for infringement of | 12 | 22 |