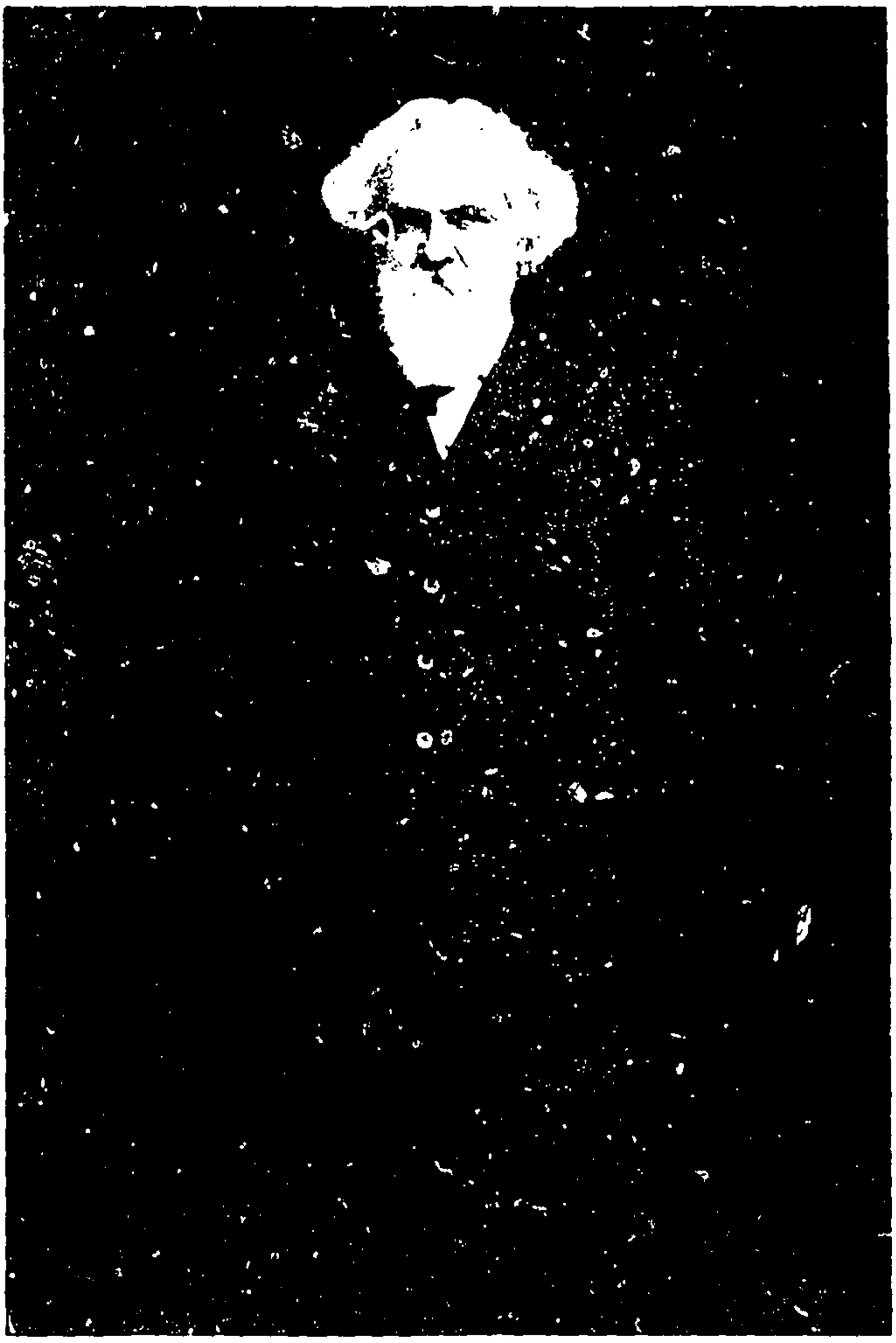


Albert Einstein

TEXT-BOOK

OF

THE LAW OF PATENTS

FOR INVENTIONS

BY

ALBERT H. WALKER

OF THE NEW YORK BAR

FIFTH EDITION

BY

JOHN H. HILLIARD AND EUGENE EBLÉ

OF THE NEW YORK BAR

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PREFACE TO THE FIFTH EDITION

In presenting the Fifth Edition of WALKER ON PATENTS, the editors have felt a deep responsibility toward the imperishable talent and gift of analysis of the late author, Albert H. Walker, which have made the preceding editions of this work a most valued text-book on the subject of Patent Law. It would be impossible conscientiously to undertake an augmentation of Mr. Walker's splendid treatise, approved through many years past by the highest tribunals of the United States without a profound sense of duty to the author, who was inspired in all his works by a self-imposed sense of duty which he felt he owed to his brethren of the profession to guide them in the science of this particular and intricate branch of the law.

In the succeeding pages it has been the effort of the editors to cite all the cases involving questions of law pertaining to patents and to treat in the text such of the cases as required special consideration, either because they established new doctrines or modified or enlarged old doctrines.

The present work takes up Federal decisions where the Fourth Edition concluded. Approximately 3,000 reported cases have been examined and from these all were selected which were deemed essential to bring the work to a state of completeness. New rulings, per-

taining to the law of recovery of damages and profits, the rights of owners of patents in the light of the Sherman Anti-Trust Law, procedure under the present Equity Rules, design patents, the enforcement of contracts for assignments of patent rights, etc., have received especial attention.

The editors trust that they have succeeded in contributing to prior treatises on the subject, something which may prove of value to those who may be interested in this branch of the law either professionally or as students.

JOHN H. HILLIARD.
EUGENE EBLÉ.

NEW YORK,
February 1, 1917.

PREFACE TO THE FIRST EDITION

THE Constitution and the statutes of the United States, together with twelve hundred and forty-six Federal and State judicial decisions, are the principal sources from which the materials for this text-book were drawn. The most extensive treatise heretofore published on the same subject, was published in 1873; but it cited only two hundred and eighty American cases, together with one hundred and sixty-one English adjudications. The inadequacy, to the needs of the profession, of a treatise so limited in scope, was clearly impressed upon me when I entered, in 1877, upon a somewhat extended practice in patent litigation. During the next four years, I was called upon to argue several patent cases in the Supreme Court, and many others in many of the Circuit Courts of the United States; and in preparing those arguments, I was forced to make many laborious researches, from which a complete text-book would have largely relieved me. Under these circumstances, I resolved, early in 1881, to undertake the production of a treatise so much needed by the profession. I began writing on the first day of May of that year, and soon became so much interested in the work, that I largely suspended my active practice of the law, in order to give the book the freshest of my efforts, and thus the greatest degree of merit consistent with my abilities. The resulting treatise covers the entire field

of the patent laws of the United States, as those laws were enacted in the statutes and developed in the decisions, from the foundation of the national government in 1789, down to the first day of September, 1883. How accurately and well it covers that field, is a question which belongs to the bar and to the bench; and to the generous judgment of the bench and of the bar, I commit the result of my long and interesting labor.

A. H. W.

HARTFORD, CONNECTICUT,
September 26, 1883.

PREFACE TO THE SECOND EDITION

THE patent laws of the United States, as those laws exist at this beginning of the second century of the national government, are stated and explained in this edition of this book. The differences between it and the first edition, consist in omitting eleven whole sections which have become obsolete since 1883, together with parts of many other sections for the same reason; and in inserting three new sections, and many new points in many other sections, which have been enacted in the statutes or developed in the decisions since that year; and in so changing or qualifying the statements of law in many other places as to make them conform to those relevant and often radical decisions of the courts which have been rendered since the first edition of the book was published. The work of making these changes began as soon after the publication of the first edition as new decisions were published, and has continued from that time to this, and has involved my careful study and analysis of the more than six hundred new decisions which are incorporated with the more than twelve hundred old ones in the table of cited cases. The generous judgment which has been passed upon the first edition of the work, has been made known through numerous citations of the book in the decisions of the courts, and through numerous letters received by me from my professional brethren. Sincere

thanks for the exceeding generosity of that judgment are now returned; and I am thereby encouraged to propose a third edition of the book in 1895, and a fourth edition at the beginning of the twentieth century.

A. H. W.

HARTFORD, CONNECTICUT,
April 30, 1889.

PREFACE TO THE THIRD EDITION

THE Supreme Court of the United States has lately decided the last of the patent cases, which were taken to that tribunal before the judiciary act of 1891 put a practical period to nearly the whole of its patent law jurisdiction. At this distinguished stage of legal evolution, the existing patent statutes, together with the thousands of patent decisions which have been made by the Supreme Court, and by the lower Federal courts under its guidance, contain materials for a nearly complete and a beautifully symmetrical science of the subject. To the study of the laws thus embodied and developed, I have devoted enthusiastic efforts for twenty years; and during the last eighteen of those years, I have practiced in those laws, in fifteen of the United States. This edition of my book is a result of that experience, and of my careful revision and enlargement of the second edition, into accurate conformity with the present law. The differences between this edition and the second, are far more numerous and important than those between the second and the first. No book so old as the second edition, nor even one a year younger, can be a reliable guide through the patent laws of to-day; but it is not probable that any development of those laws during any six years of the future, until Congress enacts a new system of patent statutes, will be nearly so extensive or important, as that of the six

years which have passed since 1889. Except in the event of such an enactment, a necessity for another edition of this book, cannot now be foreseen; and therefore I present this edition to the bench and to the bar, as probably my final contribution to the literature of the patent law.

A. H. W.

HARTFORD, CONNECTICUT,
November 16, 1895.

PREFACE TO THE FOURTH EDITION

CONGRESS has enacted six statutes amending the patent laws, and the courts have decided two thousand patent cases, since the third edition of this book was published in 1895. Two-thirds of those decisions were confined to questions of fact, the judicial answers to which contain no new material for a law book. But nearly seven hundred of those cases were found, upon careful examination by me, to contain contributions to the patent law. Those contributions, together with the amendments made by the six statutes, have been collected by me, and have been written by my own hand, into this text-book, in their proper places. I have now conducted one side or the other of nearly three hundred patent litigations in most of the States of the Union, and I have delivered many courses of lectures on the patent laws, in Cornell University, and in the University of Michigan. These labors, and the writing, during twenty-three years, of four editions of this text-book, and the studies incident to the litigations, the lectures and the authorship, have made me well acquainted with the patent laws of the United States. The analysis and arrangement of those laws, in the first edition of my book, have proved to be suitable, and will probably prove to be permanent; but the second and third editions were much enriched in detail, by hundreds of new points collected from the

sources of the law; and the fourth edition contains more than six hundred new and material differences from the third. Future years will bring still further evolution of the patent laws; and I hope that future editions of this book, written by my hand, or by the hands of others, will formulate that evolution from period to period.

A. H. W.

PARK ROW BUILDING,
MANHATTAN, N. Y.,
February 1, 1904.

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APP. D. C.: The first forty-four volumes of the reports of the Court of Appeals of the District of Columbia, from the beginning of that Court in 1893, until 1916.

BALDWIN: One volume of reports of decisions in Circuit Courts of the United States, in the third circuit, from 1827 to 1833.

BANN. & ARD.: Five volumes of patent cases, decided by the Circuit Courts of the United States, from 1874 to 1880, and collected by Hubert A. Banning and Henry Arden.

BISSELL: Nine volumes of reports of decisions in District Courts and Circuit Courts of the United States, in the seventh circuit, from 1851 to 1880.

BLACK: The reports of the Supreme Court of the United States, in two volumes, from 1861 to 1862.

BLATCH.: The reports in eighteen volumes, by Samuel Blatchford, of the Circuit Courts of the United States, in the second circuit, from 1845 to 1881.

BOND: Two volumes of reports of decisions in District Courts and Circuit Courts of the United States, in the sixth circuit, from 1856 to 1871.

BROCK.: Two volumes of reports of decisions of Chief Justice Marshall, in Circuit Courts of the United States, in the fourth circuit, from 1802 to 1836.

C. C. A.: The first one hundred and forty-six volumes of Circuit Courts of Appeals reports, from 1891 to 1916, published by the Lawyers' Co-operative Publishing Association. All the cases contained in these volumes are also contained in the "Federal Reporter," and are cited from the "Federal Reporter" in this book, and not from the "C. C. A."; because the "Federal Reporter" is more numerously and widely distributed, and is always cited by the courts, even in the exceptional cases wherein C. C. A. is also cited.

CHASE: One volume of reports of decisions of Chief Justice Chase, in Circuit Courts of the United States, in the fourth circuit, from 1865 to 1869.

CLIFF.: Four volumes of reports of decisions of Justice Clifford, in the Circuit Courts of the United States, in the first circuit, from 1858 to 1878.

COURT OF CLAIMS: The first fifty volumes of the decisions of the Court of Claims of the United States, from 1863 to 1915.

CRANCH: The reports of the Supreme Court of the United States, in nine volumes, from 1801 to 1815.

CRANCH'S C. C. REPORTS: Five volumes of reports by Judge Cranch, of decisions in the United States Circuit Court of the District of Columbia, from 1801 to 1840. These volumes are sometimes cited as 1, 2, 3, 4, 5 D. C. R.

CURTIS: Two volumes of reports, by Justice Curtis, of decisions in the Circuit Courts of the United States, in the first circuit, from 1851 to 1856.

D. C. R.: Volumes 6 and 7 of reports of decisions in the Supreme Court of the District of Columbia, from 1863 to 1873; and volume 21 of reports of decisions in the same court, from 1892 to 1893.

DEADY: One volume of reports by Judge Deady, of decisions in Circuit Courts of the United States, in the ninth circuit, from 1861 to 1869.

DILLON: Five volumes of reports by Judge Dillon, of decisions in sundry Circuit Courts of the United States, in the eighth circuit, from 1870 to 1879.

F. C.: Thirty volumes of "Federal Cases," being a series of secondary reports of decisions in the United States District Courts and the United States Circuit Courts, rendered prior to the time of the "Federal Reporter." All the important patent cases in the "Federal Cases" were previously reported in other reports specified in this table; and they are cited in this book from those other reports, and not from the "Federal Cases."

FISHER: Six volumes of patent cases, decided by the Circuit Courts of the United States, from 1848 to the end of 1873, and collected by S. S. Fisher, from periodicals and manuscripts and other authentic sources.

FISHER'S REPORTS: One volume of patent cases, from 1821 to 1851, collected by W. H. Fisher, from official reports specified in this

table. Those cases are cited in this book from the official reports, and not from this collection of W. H. Fisher.

FLIPPIN: One volume of reports of decisions in Circuit Courts of the United States, in the sixth circuit, from 1859 to 1877.

F. R.: The first two hundred and thirty-five volumes of the Federal Reporter, containing all the decisions of the District Courts of the United States, and of the Circuit Courts of the United States, and of the Circuit Courts of Appeals of the United States, from 1879 to 1916.

GALLISON: Two volumes of reports of decisions in the Circuit Courts of the United States, in the first circuit, from 1812 to 1815.

GILPIN: One volume of reports of decisions in the United States District Court for the Eastern District of Pennsylvania, from 1828 to 1836.

HEMPSTEAD: One volume of reports of decisions in the United States District Court, and the United States Circuit Court, for the District of Arkansas, from 1836 to 1855.

HEYWOOD & HAZLETON: Two volumes of reports of decisions in the Circuit Court of the District of Columbia, from 1840 to 1863.

HOLMES: One volume of reports, by Oliver Wendell Holmes, Jr., of decisions in the Circuit Courts of the United States, in the first circuit, from 1870 to 1875.

HOWARD: The reports of the Supreme Court of the United States, in twenty-four volumes, from 1843 to 1860.

HUGHES: Three volumes of reports by Judge Hughes, of decisions in District Courts and Circuit Courts of the United States, in the fourth circuit, from 1870 to 1879.

LOWELL: Two volumes of reports by Judge John Lowell, of decisions in the United States District Court, for the District of Massachusetts, from 1865 to 1877.

MACKEY: The reports of the Supreme Court of the District of Columbia, in nine volumes, from 1880 to 1892. These volumes are sometimes cited as 12, 13, 14, 15, 16, 17, 18, 19, 20 D. C. R.

MASON: The reports in five volumes, of the United States Circuit Courts, in the first circuit, from 1816 to 1830.

MCALLISTER: One volume of reports of decisions in Circuit Courts of the United States, in the ninth circuit, from 1855 to 1859.

MCARTHUR: The reports of the Supreme Court of the District of Columbia, in three volumes, from 1873 to 1879. These volumes are sometimes cited as 8, 9, 10 D. C. R.

McARTHUR & MACKEY: The reports of the Supreme Court of the District of Columbia, in one volume, from 1879 to 1880. This volume is sometimes cited as 11 D. C. R.

McARTHUR'S PATENT CASES: One volume of reports of patent cases, decided in the Circuit Court of the District of Columbia, from 1840 to 1859, on appeal from the Commissioner of Patents; reported by Frank MacArthur, Examiner of Interferences.

McCRARY: Two volumes of reports by Judge McCrary, of decisions in Circuit Courts of the United States, in the eighth circuit, from 1877 to 1881.

McLEAN: Six volumes of reports, by Justice McLean, of decisions in sundry United States Circuit Courts, from 1829 to 1855.

O. G.: The first two hundred and thirty-four volumes of the Official Gazette of the Patent Office, from 1872 to 1916.

OLCOTT: One volume of reports of admiralty cases, decided in the United States District Courts in New York, from 1843 to 1847.

PAINE: Two volumes of reports of decisions in Circuit Courts of the United States, in the second circuit, from 1810 to 1840.

PETERS: The reports of the Supreme Court of the United States, in sixteen volumes, from 1828 to 1842.

PETERS' C. C. REPORTS: One volume of reports of decisions in Circuit Courts of the United States, in the third circuit, from 1803 to 1818.

ROBB: Two volumes of patent cases, decided prior to 1850, and collected from official reports specified in this table. Those cases are cited in this book from the official reports, and not from Robb's collection.

SAWYER: The reports in seven volumes, by Judge Sawyer, of decisions in Circuit Courts of the United States, in the ninth circuit, from 1870 to 1882.

STORY: Three volumes of reports, by Justice Story, of decisions in the Circuit Courts of the United States, in the first circuit, from 1839 to 1845.

SUMNER: Three volumes of reports, by Charles Sumner, of decisions in Circuit Courts of the United States, in the first circuit, from 1829 to 1839.

TANEY: One volume of reports of decisions of Chief Justice Taney, in Circuit Courts of the United States, in the fourth circuit, from 1836 to 1861.

U. S.: The reports of the Supreme Court of the United States, in one

hundred and fifty volumes, from 1875 to 1916, beginning with 91 U. S. and ending with 240 U. S.

U. S. APP.: Sixty-three volumes of United States Circuit Courts of Appeals reports, from 1891 to 1899. All the cases contained in this series are also contained in the "Federal Reporter," and are cited from the "Federal Reporter" in this book, rather than from "U. S. App.," because the "Federal Reporter" is more widely and numerously distributed, and is always cited by the courts; and because U. S. App. covers only a few years of the work of the Circuit Courts of Appeals.

WALLACE: The reports of the Supreme Court of the United States, in twenty-three volumes, from 1863 to 1874.

WALLACE, JR.: Three volumes of reports of decisions in Circuit Courts of the United States, in the third circuit, from 1842 to 1862.

WASHINGTON: Four volumes of reports of decisions of Justice Washington, in Circuit Courts of the United States, in the third circuit, from 1803 to 1827.

WHEATON: The reports of the Supreme Court of the United States, in twelve volumes, from 1816 to 1827.

WHITMAN: Two volumes of patent cases collected by C. S. Whitman from the official reports of the Supreme Court of the United States, from 1810 to 1874. This collection contains all of the patent cases decided by the Supreme Court, prior to 21 Wallace; but they are cited in this book from the Supreme Court reports, and not from Whitman's collection.

WOODBURY & MINOT: Three volumes of reports in the Circuit Courts of the United States, in the first circuit, from 1845 to 1847.

WOODS: Three volumes of reports by Justice William B. Woods, of decisions in Circuit Courts of the United States, in the fifth circuit, from 1870 to 1879.

WOOLWORTH: One volume of reports of decisions of Justice Miller, in Circuit Courts of the United States, in the eighth circuit, from 1863 to 1869.

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Besser *v.* Merrillat Culver Core Co	226 F. R.	256
Bethlehem Steel Co. *v.* Niles-Bement-Pond Co	166 F. R.	564
Bettendorf Patents Co. *v.* J. R. Little Metal Wheel Co	123 F. R.	53
Bevin *v.* Bell Co	9 Blatch	178
Bevin Bros. Mfg. Co. *v.* Starr Bros. Bell Co	114 F. R.	52, 462
B. F. Avery & Sons *v.* J. I. Case Plow Works	174 F. R.	198, 454
Bibb *v.* Allen	149 U. S.	592
Bicknell *v.* Todd	5 McLean	359
Bidwell *v.* Toledo Consolidated, etc., Ry	72 F. R.	498
Bierce *v.* Stocking	11 Gray (Mass.)	564
Bigelow *v.* Louisville	3 Fisher	365

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Bignall *v.* Harvey	5 Bann. & Ard	93
Bignall *v.* Harvey	18 Blatch	785
Billings & Spencer Co. *v.* Van Wagoner & Williams Hardware Co.	98 F. R.	57
Birdsall *v.* Coolidge	93 U. S.	620
Birdsall *v.* McDonald	1 Bann. & Ard	109, 127
Birdsall *v.* Mfg Co	2 Bann. & Ard	796
Birdsall *v.* Mfg Co	1 Hughes	791
Birdsall *v.* Perego	5 Blatch	366
Birdsell *v.* Shaliol	112 U. S.	718
Birmingham Cement Mfg. Co. *v.* Gates Iron Works	78 F. R.	710
Bischoff *v.* Wethered	9 Wallace	93, 578, 584
Bissell Carpet-Sweeper Co. *v.* Goshen Sweeper Co	72 F. R.	785
Black *v.* Hubbard	3 Bann. & Ard	321
Black *v.* Munson	14 Blatch	617, 618
Black *v.* Stone	33 Alabama	338
Black Diamond Coal Co. *v.* Excelsior Coal Co	156 U. S.	234, 433
Blackledge *v.* Weir & Craig Mfg. Co.	108 F. R.	354
Blades *v.* Rand	27 F. R.	232, 235
Blagrove *v.* Ringgold	2 Cranch's Circuit Court Reports	607
Blair *v.* Jeannette-McKee Glass Works	161 F. R.	238
Blair *v.* Lippincott Glass Co.	52 F. R.	485
Blake *v.* Robertson	94 U. S.	439, 813
Blake *v.* San Francisco	113 U. S.	51
Blakey *v.* Kurtz	78 F. R.	770
Blanchard *v.* Eldridge	1 Wallace, Jr.	484
Blanchard *v.* Putnam	8 Wallace	589, 609
Blanchard *v.* Reeves	1 Fisher	427, 762
Blanchard *v.* Sprague	1 Cliff	376
Blanchard's Gun-Stock Turning Factory *v.* Warner	1 Blatch	312
Blandy *v.* Griffith	3 Fisher	177, 690
Blandy *v.* Griffith	6 Fisher	722, 723, 724
Blauvelt *v.* Interior Conduit & Insulation Co	80 F. R.	380
Blessing *v.* Copper Works	34 F. R.	519, 684
Bliss *v.* Brooklyn	8 Blatch	308
Bliss *v.* Brooklyn	10 Blatch	98

Names of Cases.	Where Reported.	Pages in this book.
Bliss *v.* Brooklyn	4 Fisher	487
Bliss *v.* Haight	3 Fisher	437
Bliss *v.* Merrill	33 F. R.	70
Bliss *v.* Read	106 F. R.	725
Bloomer *v.* Gilpin	4 Fisher	375
Bloomer *v.* McQuewan	14 Howard	193, 259, 310, 311, 320, 361
Bloomer *v.* Millinger	1 Wallace	320
Bloomer *v.* Stolley	5 McLean	310
Blount *v.* Societe	53 F. R.	753, 758, 783
Blumenthal *v.* Burrell	43 F. R.	35
Board of Commissioners *v.* Gorman	19 Wallace	733
Board of Trade *v.* Tucker	221 F. R.	802
Bobbs Merrill Co. *v.* Straus	210 U. S.	391
Boesch *v.* Graff	133 U. S.	326, 348, 622, 623, 735, 836
Bogart *v.* Hinds	25 F. R.	484
Bolte & Weyer Co. *v.* Knight Light Co	180 F. R.	462
Bonnette Arc Lawn Sprinkler Co. *v.* Kochler	82 F. R.	241
Bonsack Machine Co. *v.* Cigarette Co.	64 F. R.	798
Bonsack Machine Co. *v.* Elliot	63 F. R.	4
Bonsack Mach. Co. *v.* Hulse	57 F. R.	344
Bonsack Mach. Co. *v.* Smith	70 F. R.	206, 584
Boomer *v.* Powder Press Co	13 Blatch	786
Booth *v.* Seevers	19 O. G	381
Boss Mfg. Co. *v.* Thomas	182 F. R.	56
Bossert Electric Construction Co. *v.* Pratt Chuck Co	179 F. R.	239
Boston & R. Electric Ry. Co. *v.* Bemis Car-Box Co	80 F. R.	447
Boston & Revere Electric Street-Railway Co. *v.* Bemis Car-Box Co	98 F. R.	730
Boston Electric Co. *v.* Holtzer	41 F. R.	763
Boston Iron Co. *v.* King	2 Cushing (Mass.)	840
Boston Lasting Mach. Co. *v.* Woodward	53 F. R.	243, 443
Boston Lasting Mach. Co. *v.* Woodward	82 F. R.	490
Boston Pneumatic Power Co. *v.* Eureka Patents Co	139 F. R.	402

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Boston Woven Hose & Rubber Co. *v.* Pennsylvania Rubber Co	164 F. R.	249
Boston Woven Hose Co. *v.* Star Rubber Co	40 F. R.	501, 503
Bottle Seal Co. *v.* De La Vergne Co	47 F. R.	684
Bourne *v.* Goodyear	9 Wallace	407
Bowers *v.* Atlantic, Gulf & Pacific Co	104 F. R.	473, 501, 503
Bowers *v.* Lake Superior Contracting Co	149 F. R.	373
Bowers *v.* Pacific Coast Co	81 F. R.	766
Bowers *v.* San Francisco Bridge Co.	69 F. R.	289, 535, 766
Bowers *v.* San Francisco Bridge Co.	91 F. R.	83
Bowers *v.* Von Schmidt	63 F. R.	39, 75, 89, 448
Bowers Dredging Co. *v.* New York Dredging Co	77 F. R.	492, 759, 763, 766
Bowers Dredging Co. *v.* New York Dredging Co	80 F. R.	710, 761
Bowker *v.* Dows	3 Bann. & Ard	495
Bowman *v.* De Graw	60 F. R.	94
Boyce *v.* Stewart-Warner Speedometer Corporation	220 F. R.	103, 165, 754
Boyd *v.* Cherry	50 F. R.	494
Boyd *v.* Janesville Hay Tool Co	158 U. S.	447, 589
Boyd *v.* M'Alpin	3 McLean	338, 762
Boyden *v.* Burke	14 Howard	260
Boyer *v.* Keller Tool Co	127 F. R.	57, 226, 258
Bracewell *v.* Passaic Print Works	107 F. R.	134, 275
Braddock Glass Co. *v.* Macbeth	64 F. R.	801
Bradford *v.* Bradford	5 Connecticut	545
Bradford *v.* Expanded Metal Co.	146 F. R.	131
Bradley *v.* Dull	19 F. R.	352
Bradley *v.* Eccles	126 F. R.	19
Bradley *v.* Eccles	144 F. R.	96
Bradley & Hubbard Mfg. Co. *v.* The Charles Parker Co	17 F. R.	767
Bradley Mfg. Co. *v.* Eagle Mfg. Co.	57 F. R.	543, 544, 545, 546, 642
Bradley Mfg. Co. *v.* Eagle Mfg. Co.	58 F. R.	697
Bragg *v.* City of Stockton	27 F. R.	637
Bragg Mfg. Co. *v.* Hartford	56 F. R.	676, 677
Brainard *v.* Cramme	12 F. R.	4, 277, 304
Brammer *v.* Jones	3 Fisher	776
Brammer *v.* Schroeder	106 F. R.	135, 447

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Brander Hanger Co. *v.* Waterbury Button Co	106 F. R	676
Branson *v.* Kutz	105 F. R	424
Bray *v.* Denning	56 F. R	492
Bray *v.* Hartshorn	1 Cliff	596
Bredin *v.* Solmson	132 F. R	448
Bredin *v.* Solmson	145 F. R	485
Brennan & Co. *v.* Dowagiac Mfg. Co.	162 F. R	808
Brickill *v.* Baltimore	60 F. R	613, 615
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Brickill *v.* Hartford	57 F. R	47, 529, 533, 534, 551, 684
Brickill *v.* New York	112 F. R	380, 827
Bridgeport Wood Finishing Co. *v.* Hooper	5 F. R	81
Briggs *v.* Central Ice Co	54 F. R	563
Briggs *v.* Duell	93 F. R	53, 54
Briggs *v.* United Shoe Machinery Co	239 U. S	469
Brig Struggle *v.* United States	9 Cranch	412
Brill *v.* Delaware County Electric Ry. Co	109 F. R	601
Brill *v.* North Jersey St. Ry. Co	124 F. R	29, 238
Brill *v.* Peckham Motor Truck Co	189 U. S	785
Brill *v.* St. Louis Car Co	80 F. R	182, 762
Brinkerhoff *v.* Aloe	146 U. S	40
Brislin *v.* Carnegie Steel Co	118 F. R	188, 431
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Broadnax *v.* Transit Co	5 Bann. & Ard	301
Bromley Bros. Carpet Co. *v.* Stewart	51 F. R	27
Bronk *v.* Charles H. Scott Co	211 F. R	667
Bronson *v.* Kinzie	1 Howard	186
Brookfield *v.* Elmer Glass Works	132 F. R	787
Brookfield *v.* Novelty Glass Co	124 F. R	55
Brookfield *v.* Novelty Glass Co	132 F. R	798
Brookfield *v.* Novelty Glass Co	170 F. R	644
Brooks *v.* Ashburn	9 Georgia	491
Brooks *v.* Bicknell	3 McLean	275, 318, 558, 775
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Brooks *v.* Sacks	81 F. R.	95
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Brown *v.* Davis	116 U. S.	434, 439
Brown *v.* Deere	6 F. R.	789
Brown *v.* District of Columbia	3 Mackey	491
Brown *v.* District of Columbia	130 U. S.	27, 31
Brown *v.* Duchesne	19 Howard	182, 185, 202
Brown *v.* Hall	6 Blatch	686
Brown *v.* Huntington Piano Co	134 F. R.	44
Brown *v.* Jackson	3 Wheaton	341
Brown *v.* Lanyon	179 F. R.	813, 827
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Brown *v.* Piper	91 U. S.	52, 570, 683, 737
Brown *v.* Puget Sound Reduction Co	110 F. R.	435
Brown *v.* Shannon	20 Howard	469
Brown Bag-Filling Mach. Co. *v.* Drohen	171 F. R.	629, 834
Brown Bag-Filling Mach. Co. *v.* Drohen	175 F. R.	821
Brown H. & C. Mach. Co. *v.* King Bridge Co	107 F. R.	37
Brown Mfg. Co. *v.* Bradley Mfg. Co	51 F. R.	222
Brown Mfg. Co. *v.* Deere	21 F. R.	29
Brown Mfg. Co. *v.* Deere	51 F. R.	722
Brown Mfg. Co. *v.* Mast	53 F. R.	54, 708
Brown & Sharpe Mfg. Co. *v.* Coates Clipper Mfg. Co	195 F. R.	681
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Bruise *v.* Peck	54 F. R.	544
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Brunswick-Balke-Collender Co. *v.* Kochler & Hinrichs	115 F. R.	751, 766
Brunswick-Balke-Collender Co. *v.* Rosatto	159 F. R.	241
Brunswick-Balke-Collender Co. *v.* Wolf, Sayer & Heller	222 F. R.	490

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Brush *v.* Condit	132 U. S.	438
Brush Electric Co. *v.* Accumulator Co	47 F. R.	31, 207, 277, 421
Brush Electric Co. *v.* Accumulator Co	50 F. R.	776
Brush Electric Co. *v.* California Electric Light Co	52 F. R.	341, 357, 358, 364, 369, 375, 486
Brush Electric Co. *v.* Electric Co.	43 F. R.	447
Brush Electric Co. *v.* Electric Co. of San José	49 F. R.	486
Brush Electric Co. *v.* Electric Co. of San José	51 F. R.	734
Brush Electric Co. *v.* Electric Imp. Co	52 F. R.	138, 243, 447
Brush Electric Co. *v.* Ft. Wayne Electric Co	40 F. R.	137, 265, 447
Brush Electric Co. *v.* Ft. Wayne Electric Co	44 F. R.	105
Brush Electric Co. *v.* Julien Electric Co	41 F. R.	31, 207, 421
Brush Electric Co. *v.* Storage Battery Co	64 F. R.	761, 763, 769, 771
Brush Electric Co. *v.* Western Electric Co	43 F. R.	137
Brush Electric Co. *v.* Western Electric Co	76 F. R.	544, 717
Brush-Swan Electric Light Co. *v.* Electric Co	48 F. R.	486
Bryce Bros. *v.* Seneca Glass Co	140 F. R.	115
Buchanan *v.* Perkins Electric Switch Mfg. Co	135 F. R.	50
Buck *v.* Timony	78 F. R.	330
Buckingham *v.* Iron Co	51 F. R.	53
Buerk *v.* Imhaeuser	2 Bann. & Ard	798
Buffington's Iron Building Co. *v.* Eustis	65 F. R.	222, 423
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Bull *v.* Pratt	1 Connecticut	373
Bullock Electric Co. *v.* Westinghouse, etc	129 F. R.	493
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Bullock Printing-Press Co. *v.* Jones	3 Bann. & Ard	787
Bundy Mfg. Co. *v.* Columbian Co.	59 F. R	236
Bundy Mfg. Co. *v.* Detroit Time-Register Co	94 F. R	435, 441
Bundy Mfg. Co. *v.* Time Recorder Co	64 F. R	447
Bunker *v.* Stevens	26 F. R	602
Burdell *v.* Comstock	15 F. R	677
Burdell *v.* Denig	92 U. S	366, 566, 585
Burden *v.* Corning	2 Fisher	272, 691
Burdett *v.* Estey	5 Bann. & Ard	273
Burdett *v.* Estey	15 Blatch	277
Burdett *v.* Estey	3 F. R	828
Burdon Wire & Supply Co. *v.* Williams	128 F. R	422
Burdsall *v.* Curran	31 F. R	547
Burke Electric Co. *v.* Independent Pneumatic Tool Co	234 F. R	118, 119, 217, 536
Burns *v.* Myer	100 U. S	251
Burpee *v.* Guggenheim	226 F. R	355
Burr *v.* De La Vergne	102 N. Y	326
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Burt *v.* Evory	133 U. S	21, 46, 82
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Buser *v.* Novelty Tufting Mach. Co	151 F. R	90, 96
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Bussard *v.* Catalino	2 Cranch's Circuit Court Reports	604
Bussell Trimmer Co. *v.* Stevens	137 U. S	51
Bussey *v.* Mfg. Co	110 U. S	40
Butler *v.* Bainbridge	29 F. R	536, 579
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Butz Thermo-Electric Co. *v.* Electric Co	36 F. R.	444, 446
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Byam *v.* Eddy	2 Blatch.	457
Byam *v.* Farr	1 Curtis.	461
Byerly *v.* Barber Asphalt Paving Co.	230 F. R.	83
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Cadillac Motor Car Co. *v.* Austin	225 F. R.	56
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Cahoone Barnet Mfg. Co. *v.* Rubber & Celluloid Harness Co.	45 F. R.	22, 51, 489
Cain *v.* Park	14 App. D. C.	169
Calculagraph Co. *v.* Automatic Time Stamp Co	187 F. R.	709
Calculagraph Co. *v.* Wilson	132 F. R.	406, 502
Calculagraph Co. *v.* Wilson	136 F. R.	800
Caldwell *v.* Jackson	7 Cranch.	603
Caldwell *v.* Waters	4 Cranch's Circuit Court Reports	778
California Electric Works *v.* Fink	47 F. R.	695
California Electric Works *v.* Henzel	48 F. R.	761, 787
California Paving Co. *v.* Molitor	113 U. S.	739, 798
Callaghan *v.* Myers	128 U. S.	806, 812, 840
Cambria Iron Co. *v.* Carnegie Steel Co.	224 F. R.	827, 828
Cameron Septic Tank Co. *v.* Knoxville	227 U. S.	204
Cammack *v.* Johnson	2 New Jersey Equity	778
Camineyer *v.* Newton	94 U. S.	185, 194
Campbell *v.* American Shipbuilding Co.	179 F. R.	255
Campbell *v.* Bailey	45 F. R.	82
Campbell *v.* City of New York	81 F. R.	561
Campbell *v.* Day	16 Vermont.	338
Campbell *v.* Haverhill	155 U. S.	508, 550, 701
Campbell *v.* Magnet Light Co.	175 F. R.	501
Campbell *v.* New York	35 F. R.	113, 147, 722, 726
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Campbell *v.* New York	105 F. R.	828
Campbell *v.* Ward	12 F. R.	677
Campbell Mfg. Co. *v.* Manhattan Ry. Co	49 F. R.	707
Campbell Printing-Press Co. *v.* Duplex Printing-Press Co	86 F. R.	439, 577
Campbell Printing-Press Co. *v.* Manhattan Ry. Co	49 F. R.	637
Campbell Printing-Press Co. *v.* Marden	64 F. R.	95, 136, 226, 238, 241
Campbell Printing-Press Co. *v.* Prieth	77 F. R.	766
Canan *v.* Mfg. Co	23 F. R.	207
Canda *v.* Michigan Malleable Iron Co	152 F. R.	806, 813
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Canton Steel Roofing Co. *v.* Kanneberg	51 F. R.	641
Cantrell *v.* Wallick	117 U. S.	14, 15, 82, 93, 440
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Carborundum Co. *v.* Electric Smelting, etc., Co	203 F. R.	808, 812, 817
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Carey *v.* Miller	34 F. R.	763
Carey *v.* Spring Bed Co	26 F. R.	778
Card *v.* Standard Coal & Coke Co	202 F. R.	652
Carl L. Jensen Co. *v.* Clay	53 F. R.	225
Carlton *v.* Bokee	17 Wallace	134, 226, 243, 538
Carnegie Steel Co. *v.* Breslin	224 F. R.	238, 447
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Carnegie Steel Co. *v.* Cambria Iron Co	185 U. S.	4, 83, 269, 715
Carnegie Steel Co. *v.* Colorado Fuel & Iron Co	165 F. R.	673
Carnrick *v.* McKesson	8 F. R.	685, 688, 689
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Carter *v.* Fry	54 F. R	766
Carter *v.* Wollschlaeger	53 F. R	753, 757, 758, 772
Carter Crume Co. *v.* Am. Sales Book Co	124 F. R	423
Carter-Crume Co. *v.* Ashley	68 F. R	758, 762, 768
Carter Mach. Co. *v.* Hanes	70 F. R	98, 438
Cartridge Co. *v.* Cartridge Co	112 U. S	275, 461
Carty *v.* Kellogg	7 App. D. C	169
Carver *v.* Hyde	16 Peters	221
Carver *v.* Mfg. Co	2 Story	133, 509
Cary *v.* Lovell Mfg. Co	31 F. R	707
Cary Mfg. Co. *v.* Acme Flexible Clasp Co	108 F. R	799, 801
Cary Mfg. Co. *v.* Acme Flexible Clasp Co	187 U. S	799
Cary Mfg. Co. *v.* De Haven	88 F. R	683
Cary Mfg. Co. *v.* Neal	98 F. R	22
Case *v.* Brown	2 Wallace	234, 433
Case *v.* Morey	1 New Hampshire	328
Case *v.* Redfield	4 McLean	338
Cash Register Co. *v.* Cash Indicator Co	156 U. S	54
Castle *v.* Hutchinson	25 F. R	190
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Celluloid Mfg. Co. *v.* American Zylonite Co	35 F. R	32
Celluloid Mfg. Co. *v.* Arlington Mfg. Co	44 F. R	443
Celluloid Mfg. Co. *v.* Cellonite Mfg. Co	40 F. R	824, 832, 836, 837
Celluloid Mfg. Co. *v.* Cellonite Mfg. Co	42 F. R	243
Celluloid Mfg. Co. *v.* Chandler	27 F. R	603
Celluloid Mfg. Co. *v.* Chrolithion Collar & Cuff Co	23 F. R	29
Celluloid Mfg. Co. *v.* Crane Chemical Co	36 F. R	32

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Celluloid Mfg. Co. *v.* Crofut	24 F. R.	108
Celluloid Mfg. Co. *v.* Eastman Dry Plate Co	42 F. R.	763
Celluloid Mfg. Co. *v.* Mfg. Co	34 F. R.	764
Celluloid Mfg. Co. *v.* Noyes	25 F. R.	53
Celluloid Mfg. Co. *v.* Russell	37 F. R.	215, 536
Celluloid Mfg. Co. *v.* Tower	26 F. R.	46, 708
Celluloid Mfg. Co. *v.* Vulcanite Co.	13 Blatch	648
Celluloid Mfg. Co. *v.* Zylonite Co.	27 F. R.	298
Celluloid Mfg. Co. *v.* Zylonite Co.	30 F. R.	494
Celluloid Mfg. Co. *v.* Zylonite Co.	34 F. R.	516
Central Brass & Stamping Co. *v.* Stuber	220 F. R.	353
Central Foundry Co. *v.* Coughlin	141 F. R.	433, 444
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Cerealine Mfg. Co. *v.* Bates	77 F. R.	269
Cerealine Mfg. Co. *v.* Bates	101 F. R.	216, 269
Chadeloid Chemical Co. *v.* Chicago Wood Finishing Co	180 F. R.	475
Chadeloid Chemical Co. *v.* Johnson	203 F. R.	369, 370, 788
Chadeloid Chemical Co. *v.* F. W. Thurston Co	220 F. R.	225, 422
Chadeloid Chemical Co. *v.* Wilson Renover Co	220 F. R.	564
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Chambers *v.* Smith	5 Fisher	360, 365, 375
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Charles Boldt Co. *v.* Nivison-Weiskopf Co	194 F. R.	22, 56
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Charmbury *v.* Walden	141 F R.	259
Chase *v.* Fillebrown	58 F. R.	73, 83, 537, 557
Chase *v.* Tuttle	27 F. R.	649
Chase *v.* Walker	3 Fisher	326
Chauche *v.* Parc	75 F. R.	328
Cheatham Electric Switching Device Co. *v.* Transit Development Co.	191 F. R.	474
Cheatham Electric Switching Device Co. *v.* Transit Development Co.	209 F. R.	697
Cheever *v.* Wilson	9 Wallace	590

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Cheney Bros. *v.* Weinreb & Weinreb	185 F. R.	217
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Gamewell Fire-Alarm Telegraph Co. *v.* Chillicothe	7 F. R.	510
Gamewell Fire-Alarm Telegraph Co. *v.* Hackensack Improvement Commission	199 F. R.	767

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Gandy *v.* Belting Co	143 U. S.	28, 55, 103, 121, 519
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Garretson *v.* Clark	111 U. S.	813
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General Compressed Air, etc., Co. *v.* American Air Cleaning Co	177 F. R.	431, 432
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General Electric Co. *v.* Am. Brass & Copper Co	209 F. R.	644
General Electric Co. *v.* Brooklyn Heights R. Co	118 F. R.	424
General Electric Co. *v.* Bullock Electric Mfg. Co	152 F. R.	55, 219
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General Electric Co. *v.* Inter. Specialty Co	126 F. R.	238
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General Electric Co. *v.* Morgan-Gardner Electric Co	159 F. R.	463
General Electric Co. *v.* Morgan-Gardner Electric Co	167 F. R.	165
General Electric Co. *v.* New England Electric Mfg. Co	128 F. R.	787
General Electric Co. *v.* Richmond Street & I. Ry. Co	178 F. R.	291
General Electric Co. *v.* Star Brass Works	109 F. R.	694
General Electric Co. *v.* Sutter	186 F. R.	493
General Electric Co. *v.* Wagner Electric Mfg. Co	123 F. R.	715
General Electric Co. *v.* Winsted Gas Co	110 F. R.	464
General Electric Co. *v.* Wise	119 F. R.	776
General Electric Co. *v.* Yost Electric Mfg. Co	131 F. R.	57
General Electric Co. *v.* Yost Electric Mfg. Co	139 F. R.	45
General Electric Co. *v.* Yost Electric Mfg. Co	208 F. R.	682
General Gaslight Co. *v.* Matchless Mfg. Co	129 F. R.	22, 46
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George Frost Co. *v.* Samstag	180 F. R.	32
G. H. Day *v.* Mountain City Mill	225 F. R.	667
Gerard *v.* Safe & Lock Co	48 F. R.	696
Germain *v.* Wilgus	67 F. R.	648
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Goodyear *v.* McBurney	3 Blatch.	485
Goodyear *v.* Mullee	5 Blatch.	490, 800
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Goodyear *v.* Railroad Co	1 Fisher.	346, 751
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Greenwood *v.* Bracher	1 F. R.	760
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Hall Signal Co. *v.* Union Switch & Signal Co	115 F. R.	578
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Hoe *v.* Kahler	12 F. R.	141
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National Folding-Box & Paper Co. *v.* Brown & Bailey Co.	98 F. R.	763
National Folding-Box & Paper Co. *v.* Dayton Paper Novelty Co.	95 F. R.	545, 811

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National Folding-Box & Paper Co. *v.* Dayton Paper-Novelty Co.	97 F. R.	823
National Folding-Box & Paper Co. *v.* Robertson	104 F. R.	785, 795
National Harrow Co. *v.* Quick	74 F. R.	83
National Harrow Co. *v.* Westcott	84 F. R.	49, 58
National Heeling-Mach. Co. *v.* Abbott	70 F. R.	326, 340, 345
National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co.	106 F. R.	22, 55, 83, 94, 136, 231, 239, 247, 447, 453
National Machine Co. *v.* Brown	36 F. R.	87, 601
National Machine Co. *v.* Hedden	29 F. R.	765
National Machine Co. *v.* Thom	25 F. R.	221
National Mach. Co. *v.* Wheeler & Wilson Mfg. Co	72 F. R.	234
National Malleable Castings Co. *v.* American Steel Foundries	182 F. R.	135, 363
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National Malleable Castings Co. *v.* Symington Co	230 F. R.	493
National Malleable Castings Co. *v.* Symington Co	234 F. R.	719
National Mechanical Directory Co. v. Polk	121 F. R.	500
National Metal Weatherstrip Co. *v.* Bredin	186 F. R.	644, 812
National Meter Co. *v.* Thomson Meter Co	106 F. R.	132, 133, 218, 711
National Newsboard Co. *v.* Elkhart Egg Case Co	123 F. R.	35
National Phonograph Co. *v.* Fletcher	117 F. R.	363
National Phonograph Co. *v.* Schlagel	128 F. R.	383
National Pump Cylinder Co. *v.* Gunnison	17 F. R.	304
National Recording Safe Co. *v.* International Safe Co	158 F. R.	549
National Roofing Co. *v.* Garwood	35 F. R.	31
National Rubber Co. *v.* Rubber Shoe Co	41 F. R.	368
National Spring Co. *v.* Mfg. Co	12 Blatch.	289

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National Tooth Crown Co. *v.* Macdonald	117 F. R.	31
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National Tube Co. *v.* Marks	216 F. R.	237
National Typographic Co. *v.* New York Typograph Co	46 F. R.	254, 446, 754, 756
Naylor *v.* Alsop Process Co	168 F. R.	72
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Neale *v.* Walker	1 Cranch's Circuit Court Reports	550
Nebraska *v.* Nebraska Telephone Co	24 American Law Register	192
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Neidich *v.* Fosbenner	108 F. R.	684
Neilson *v.* Bradshaw	16 App. D. C.	167, 168
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Nellis *v.* McLanahan	6 Fisher	510
Nelson *v.* McMann	4 Bann. & Ard	484
Neptune Meter Co. *v* National Meter Co	127 F. R.	34, 51
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New Departure Bell Co. *v.* Bevin Bros. Mfg. Co	73 F. R.	30, 92
New Departure Bell Co. *v.* Hardware Co	62 F. R.	400
New Departure Bell Co. *v.* Hardware Co	69 F. R.	589
New England Motor Co. *v.* B. F. Sturtevant Co	150 F. R.	95
Newell *v.* West	13 Blatch	353
Newgold *v.* American Electrical Novelty & Mfg. Co	108 F. R.	64
Newhall *v.* McCabe Hanger Mfg. Co.	125 F. R.	754
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Newton Mfg. Co. *v.* Wilgus	90 F. R	545
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New York & Baltimore Coffee Polishing Co. *v.* New York Coffee Polishing Co	9 F. R	408, 648
New York Belting Co. *v.* Gutta Percha Mfg. Co	56 F. R	761
New Yerk Belting Co. *v.* New Jersey Car-Spring Co	47 F. R	480, 676
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New York Belting Co. *v.* New Jersey Car-Spring Co	137 U. S	684
New York Belting Co. *v.* Rubber Co	30 F. R	683
New York Belting Co. *v.* Rubber Co	32 F. R	728
New York Belting Co. *v.* Sierer	149 F. R	31
New York Button Works *v.* Crescent Button Co	185 F. R	753
New York Filter Co. *v.* Filter Co	62 F. R	722
New York Filter Co. *v.* Jackson	91 F. R	494
New York Filter Co. *v.* Niagara Falls Water Works Co	77 F. R	772
New York Filter Co. *v.* Schwarzwalder	58 F. R	381, 422
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New York Grape Sugar Co. *v.* American Grape Sugar Co	10 F. R	751, 759, 773

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New York Paper Bag Machine Co. *v.* Union Paper Bag Machine Co	32 F. R.	337, 345
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New York Phonograph Co. *v.* Edison	136 F. R.	365
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United States Packing Co. *v.* Tripp	31 F. R.	545
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United States Seeded Raisin Co. *v.* Phœnix Seeding Co	124 F. R.	476
United States Stamping Co. *v.* Jewett	7 F. R.	323
United States Stamping Co. *v.* King	4 Bann. & Ard	767
United States Stamping Co. *v.* King	17 Blatch	308
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United Wireless Telegraph Co. *v.* National Electric Signalling Co.	198 F. R.	487
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Universal Winding Co. *v.* Willimantic Linen Co	82 F. R.	77, 91, 92
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Urner *v.* Kayton	17 F. R.	829

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Vacuum Cleaner Co. *v.* Dunn	189 F. R.	686
Vacuum Cleaner Co. *v.* Innovation Electric Co	234 F. R.	718
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Voightman *v.* Weis & Ridge Cornice Co	133 F. R.	463
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Wade *v.* Metcalf	129 U. S.	197
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Weber Electric Co. *v.* National Gas & Electric Fixture Co	204 F. R.	59
Weber Electric Co. *v.* Union Electric Co	226 F. R.	256
Webster *v.* New Brunswick Carpet Co	1 Bann. & Ard.	110
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Western Electric Co. *v.* Williams-Abbott Electric Co	83 F. R.	642, 759, 760
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Westinghouse Air-Brake Co. *v.* Great Northern Ry. Co.	88 F. R.	73
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Westinghouse Air-Brake Co. *v.* New York Air-Brake Co	140 F. R	738
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Westinghouse Electric & Mfg. Co. *v.* Condit Electric & Mfg. Co	194 F. R	256
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Weston Electrical Inst. Co. *v.* Empire Electrical Co	166 F. R.	502, 504
Weston Electrical Instrument Co. *v.* Stevens	119 F. R.	215
Weston Electrical Inst. Co. *v.* Stevens	134 F. R.	300
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Willimantic Thread Co. *v.* Clark Thread Co	27 F. R.	621
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Wilson *v.* American Circular Loom Co	187 F. R.	380
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Winchester Repeating Arms Co. *v.* Buengar	199 F. R	396
Winchester Repeating Arms Co. *v.* Olmstead	203 F. R	784
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THE LAW OF PATENTS FOR INVENTIONS

CHAPTER I

THE SUBJECT-MATTER OF PATENTS

1. Constitutional and statutory foundation of the patent laws.
2. Patent law meaning of the word "discovery."
3. Patent law meaning of the word "art."
7. Difference between a "process" and a "principle" inquired into.
8. Illustrated by the case of McClurg *v.* Kingsland.
9. Illustrated by the case of O'Reilly *v.* Morse.
10. Illustrated by the case of Mowry *v.* Whitney.
11. Illustrated by the case of Tilghman *v.* Proctor.
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12. Illustrated by the five cases when compared.
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15. Illustrated by the eighth claim of Morse.
16. Machines, and improvements of machines.
17. Manufactures.
18. Compositions of matter.
19. Distinction between machines, manufactures, and compositions of matter.
20. Designs.
21. Design patents, under statutes earlier than 1873.
22. Ornament and utility.

§ 1. CONGRESS has power to promote the progress of science and useful arts, by securing for limited times to inventors the exclusive right to their respective discoveries.[1] This constitutional law is the foundation of all the patent laws of the United States. In accordance with

[1] Constitution of the United States of America, Article I, Section 8.

the power it confers, and in pursuance of the object it mentions, Congress has, from time to time, enacted certain statutes. The principal enactment, in force at this writing, is Section 4886 of the Revised Statutes of the United States, as amended March 3, 1897. Subject to certain conditions and limitations, hereafter to be explained in this book, that section provides that any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor. Statute law, identical with this, has been in force in the United States ever since April 10, 1790; except that the conditions and limitations attending it have varied somewhat from time to time; and except that compositions of matter were not mentioned in the statute prior to that of February 21, 1793, though they were doubtless covered by the word "manufacture," which the earlier statute contained.

§ 2. The word "discovery" does not have, either in the Constitution or the statute, its broadest signification. It means invention in those documents, and in them it means nothing else.[2] The "discoveries" of inventors are inventions. The same man may invent a machine and may discover an island or a law of nature. For doing the first of these things the patent laws may reward him, because he is an inventor in doing it; but those laws cannot reward him for doing either of the others, because he is not an inventor in doing either.[3] The statute provides that patents may be granted for four classes of things. These are arts, machines, manufactures, and composi-

[2] *In re* Kemper, 1 McArthur's Patent Cases, 4, 1841; Haffcke *v.* Clark, 46 F. R. 772, 1891.

[3] Wall *v.* Leck, 66 F. R. 557, 1895; Thomson-Houston Electric Co. *v.* Nassau Electric R. Co., 107 F. R. 280, 1901.

See Chapter II.

tions of matter. None of these things can be originally made known by discovery, as our continent was. They are not found, but created. They are results of original thought. They are inventions. Laws of nature, on the other hand, can never be invented by man, though they may be discovered by him. They exist as facts at all times whether known or unknown to human knowledge. When discovered, they may be utilized by means of an art, a machine, a manufacture, or a composition of matter. It is the invention of one or more of these, for the purpose of utilizing a law of nature, and not the discovery of that law, that may be rewarded with a patent.[4]

§ 3. The word "art" also has a narrower meaning in the patent laws than it has in the dictionaries. In the dictionaries its significance is "the use of means to produce a result." In the patent laws it covers only a limited meaning of the word process. The generic definition of process is "an operation performed by rule to produce a result." Operations performed by rule may be classified as: 1, operations which consist partly or wholly in the employment of heat, light, electricity, magnetism, chemical action, pneumatics, hydraulics, or some other force producing chemical change; 2, operations which consist entirely of mechanical transactions, and which are only the peculiar functions of the respective machines which are constructed to perform them; 3, operations which consist entirely of mechanical transactions, but which may be performed by hand or by any of several different mechanisms or machines. It is settled that all processes which belong to the first class are subjects of patents;[5]

[4] O'Reilly *v.* Morse, 15 Howard, 112, 1853; Morton *v.* Infirmary, 5 Blatch. 116, 1862.

[5] Cochrane *v.* Deener, 94 U. S. 780, 1876; Tilghman *v.* Proctor, 102 U. S. 728, 1880; Eames *v.* Andrews, 122 U. S. 40, 1887; Fermentation Co. *v.* Maus, 122 U. S.

and that all processes which belong to the second class are unpatentable in the United States.[6] It was formerly debatable whether processes which belong to the third class are subjects of patents or not, but the question has finally been definitely settled in the affirmative.[7] Not only need the process not involve any chemical change or change of substance, but it is enough, it is said, if a new thing is created merely by mechanical readjustments or new juxtaposition of parts.[7a]

It has been held, whenever the question has come before the courts, and may now be considered settled law that a "system" or method of transacting business is neither an "art" nor does it come within any other designation of patentable subject-matter;[8] *e. g.*, a system of

427, 1887; Telephone Cases, 126 U. S. 533, 1888; Westinghouse Electric & Mfg. Co. *v.* Catskill Co., 94 F. R. 868, 1899; Kirchberger *v.* Am. Acetylene Co., 124 F. R. 764, 1903.

[6] Corning *v.* Burden, 15 Howard, 267, 1853; Busch *v.* Jones, 184 U. S. 607, 1902: Carnegie Steel Co. *v.* Cambria Iron Works, 185 U. S. 425, 1902; MacKay *v.* Jackman, 12 F. R. 615, 1882; New *v.* Warren, 22 O. G. 587, 1882; Brainard *v.* Cramme, 12 F. R. 621, 1882; Goss *v.* Cameron, 14 F. R. 576, 1882; Hatch *v.* Moffitt, 15 F. R. 253, 1883; Reay *v.* Raynor, 19 F. R. 310, 1884; Moulton *v.* Commissioner of Patents, 61 O. G. 1480, 1892; Bonsack Machine Co. *v.* Elliot, 63 F. R. 837, 1894; Gindorff *v.* Deering, 81 F. R. 952, 1897; Conroy *v.* Penn Electrical & Mfg. Co., 155 F. R. 421, 1907; American Lava Co. *v.* Steward, 155 F. R. 731, 1907; Denning Wire & Fence Co. *v.* Am. Steel & Wire Co., 169 F. R. 793, 1909; U. S. Consolidated Seeded Raisin Co. *v.* Selma Fruit Co., 195 F. R. 264, 1912; Ball *v.* Coker, 210 F. R., 278, 1913.

[7] Kahn *v.* Starrels, 135 F. R. 532, 1905; General Subconstruction Co. *v.* Netcher, 174 F. R. 236, 1909; Expanded Metal Co. *v.* Bradford, 214 U. S. 366, 1909.

[7a] David E. Kennedy, Inc., *v.* Beaver Tile & Specialty Co., 232 F. R. 477, 1916.

[8] United States Credit System Co. *v.* American Indemnity Co., 51 F. R. 721; United States Credit System Co. *v.* American Credit Indemnity Co., 53 F. R. 818; Hocke *v.* N. Y. Central &

cash registering and checking for hotels apart from the physical means of conducting the system is not the subject of a patent. As to whether or not the means of carrying out the system are patentable, there seems to be no objection in principle or authority.[9] It may be remarked, however, that as a rule such patents have not met with notable success in the courts.[10]

§ 7. It was shown in Section 2 that the discovery of a law of nature is not patentable. That which was so denominated in that section is often spoken of as a "principle," and at other times as a "scientific principle," and again as a "scientific fact," and still again as a "law of nature." By whatever name it is called it is certain that the thing referred to is not a material substance. It is not to be apprehended by the sense of touch, but when discovered finds a lodgment in the mind as a mental conception only. So also, a process is not a substance which can be handled. It is seen only by noting its constituent acts as they are being performed. Principles and processes are therefore alike in that they are intangible, and being so, they have sometimes been mistaken for each other.

Whether a given patent is one for a process or one for a

H. R. R. Co., 122 F. R. 467; Hotel Security Checking Co. *v.* Lorraine Co., 160 F. R. 467, 1908, and cases cited therein; Berardini *v.* Tocci, 190 F. R. 329, 1911.

[9] Rand, McNally & Co. *v.* Exchange Scrip-Book Co., 187 F. R. 984, 1911; Cincinnati Traction Co. *v.* Pope, 210 F. R. 443, 1913.

[10] Hotel Security Checking Co. *v.* Lorraine Co., 160 F. R. 467, 1908, and cases cited; Time Saver Co. *v.* Stamford Trust Co., 176 F. R. 358, 1910; Exchange Scrip-Book Co. *v.* Rand, McNally & Co., 194 F. R. 444, 1912; Exchange Scrip-Book Co. *v.* Rand, McNally & Co., 203 F. R. 278, 1913.

See Mitchell *v.* International Tailoring Co., 170 F. R. 91, 1909, and Section 17, *post*.

principle, is a question upon which its validity may wholly depend. It is therefore important to ascertain what rule governs the decisions of such questions; to ascertain precisely wherein consists the difference between a principle and a process. Any search for that distinction made during the first half of the nineteenth century was necessarily a speculative one, for lack of authoritative adjudged cases from which to reason. Now, however, when engaged in an investigation of the point, we have recourse to five very instructive Supreme Court decisions. The proper method of conducting the inquiry seems to be, to first set down the important relevant points of each of those cases, and then to ascertain what doctrine is consistent with them all. Such hypothetical rules as are found to be inconsistent with either of the cases may safely be rejected as not true rules; but if some one proposition is found to logically underlie all five decisions, it is safe to believe that the Supreme Court will never depart from it.

§ 8. In McClurg *v.* Kingsland [11] it appears that some method was long sought, by means of which rollers or cylinders could be so cast that the metal, when introduced into the moulds, would be given a rotary motion, to the end of throwing the flog or dross into the centre instead of the circumference of the casting. The fact that rotary motion would so result was an understood law of nature, an understood operation of centrifugal force. The problem was to produce such a motion more conveniently and more uniformly than by stirring the liquid metal with a circular movement of an implement inserted therein. That problem was solved in 1834 by James Harley, a workman in a foundry in Pittsburg, Pennsylvania. He discovered that the rotary motion desired, could be imparted to melted metal by injecting that metal into a

[11] McClurg *v.* Kingsland, 1 Howard, 202, 1843.

mould tangentially. A patent was granted to him in 1835, for "an improvement in the mode of casting chilled rollers and other metallic cylinders and cones." Litigation arose on the patent, and coming before the Supreme Court it was held to be a patent for a process.

§ 9. In O'Reilly *v.* Morse[12] it appears that Samuel F. B. Morse was not the discoverer of either of the laws of nature which he utilized in his telegraph. He did, however, invent a machine by means of which those laws could be made to carry information to a distant place. That machine was dependent for success on several laws of nature, and lacking any one of them it would have failed of its result. The chief of these was the electric current discovered by Gray. The one next in importance was that discovered by Œrsted and Arago, and known as electro-magnetism. The eighth claim of Morse's patent was construed, by the Supreme Court, to be a claim for the use of an electric current, for marking intelligible signs at any distance. The Supreme Court held that claim to be void.

§ 10. In Mowry *v.* Whitney,[13] the following matters are set forth. It had long been known that sudden cooling of very hot cast-iron makes it hard, but brittle. On the other hand, the slow cooling of very hot cast-iron was known to make it soft, but tough. This is annealing. Cast-iron car-wheels require hardened peripheries and annealed hubs and plates, because the first have to endure friction and the last two have to endure strain. The early attempts to subject car-wheels to both hardening and annealing produced a weak and worthless article, resulting from the law of the expansion and contraction of metals. The peripheries of the wheels were hardened by

[12] O'Reilly *v.* Morse, 15 Howard, 112, 1853.

[13] Mowry *v.* Whitney, 14 Wallace, 620, 1871.

chilling them, this chilling consisting in surrounding the moulds in which the wheels were cast with a circle of iron, and with only a thin film of sand between it and the peripheries of the wheels. This iron band, being a rapid conductor of heat, caused the peripheries of the wheels to suddenly cool, and thus be hardened, while the plates and hubs, being enclosed in a thick mass of sand, cooled very slowly, and were thus annealed. The sudden cooling of the rims of the wheels, however, materially contracted their circumference, and that contraction forced the still hot plates to contract their diameter. Afterward, when the plates came to cool down, they themselves contracted still more, and thus tended to break away from the rims, which, having entirely cooled some time before, had no more contracting to do. Wheels so made were therefore weak.

In this condition of affairs, Asa Whitney, of Philadelphia, discovered in 1848, that hardness once given to iron will not be destroyed or seriously impaired by the immediate reheating of the iron, and its subsequent very slow cooling; and he also conceived a process by means of which that law of nature could be utilized to obviate the evil explained in the last paragraph. That process consisted in taking the wheels from the moulds, very soon after their rims were chilled, and in putting them immediately into a chamber or furnace which had previously been heated about as hot as the then heat of the wheels, and in thereupon gradually raising the temperature of all parts of the interior of the chamber or furnace and its contents, to an equally high point, and finally in causing all parts of the wheels to cool with equal slowness. In accordance with the law of nature discovered by Whitney, it turned out that the third stage of this process did not destroy or seriously impair the hardness of the peripheries of the wheels which were subjected to it. It did, however,

cause the peripheries of the wheels to re-expand in circumference, and in so doing to stretch the still hot and ductile plates back to nearly the same diameter as that they had before the rims were contracted by the chill. The fourth stage of the process then served to contract all parts of the wheels harmoniously, and the result of the whole process was to remedy the evil at which it was aimed. Mr. Whitney obtained a patent for his invention, and the Supreme Court held it to be a patent for a process, and held it to be valid.

§ 11. The case of Tilghman *v.* Proctor[14] discloses the following facts: The celebrated French chemist, Chevreul, discovered in 1813 that fat is a regular chemical compound, consisting of glycerine and three kinds of fat acids. He also discovered that fat can be separated into those, its constituent elements, by causing them to severally unite with an atomic equivalent of water. In 1853 Richard A. Tilghman, a Philadelphia chemist, discovered that those elements of fat can be caused so to unite with an atomic equivalent of water, by mixing the fat with water, and by thereupon subjecting the mixture to a high degree of heat, and to such a degree of pressure as will prevent the conversion of the water into steam. In 1854 Mr. Tilghman obtained a patent, in the specification of which he announced his discovery, and described a suitable apparatus in which to utilize that discovery in connection with the discoveries of Chevreul, and claimed "the manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure." The Supreme Court held that patent to be a patent for a process and to be valid.

§ 11*a*. The Telephone Cases[15] set forth the following

[14] Tilghman *v.* Proctor, 102 U. S. 707, 1880.

[15] Telephone Cases, 126 U. S. 531, 1888.

fundamental facts. It has been known for centuries, that articulate sounds can be reproduced at a distance from the place where they are originally uttered, by means of two thin diaphragms, made of metal or membrane, and attached at their centres to the respective ends of a tightly drawn cord or wire; and that when a person speaks near and toward one of those diaphragms, the sound vibrations which are produced by his voice cause that diaphragm to vibrate correspondingly; and that those corresponding vibrations are transmitted along the cord or wire to the other diaphragm, and cause it also to vibrate correspondingly; and that the second diaphragm thus vibrating, causes corresponding vibrations in the air adjacent thereto; and that when those vibrations strike upon the drum of the ear of a listener, they cause him to hear what was spoken toward the first diaphragm. Instruments like this are called string telephones, and they utilize that law of nature which causes such diaphragms as those employed therein, to copy and to transmit the vibrations of air which occur adjacent thereto. It has been known ever since 1831, when it was discovered by Faraday, that when an armature is moved in front of an electro-magnet, which is being magnetized by an electric current passing through its coil, the motion modifies the current, and that those modifications correspond to the movements of the armature in duration, in direction, and in strength. And it has long been known that the electric current thus modified, will cause correspondingly modified movements in the armature of another electro-magnet, through the coil of which the electric current thus modified is also passing. At this stage of knowledge of the relevant laws of nature, Alexander Graham Bell invented his telephone. That invention consisted in mounting two such diaphragms as those of the string telephone,

upon two armatures arranged, combined and movable as above described, and thus enabling one of those armatures to transmit, and the other one to receive, such minute and exceedingly variant vibrations as those caused in the air by the human voice; and it also consisted in the process of transmitting sounds, by causing electrical undulations, similar in form to the vibrations of the air caused by the sounds, to occur upon the conducting wire. Mr. Bell obtained a patent for that invention in 1876, and the Supreme Court held it to be a patent for a process, as well as for an apparatus, and held the process claim to be valid.

§ 12. The last five sections present five cases, covering five subject-matters of claim, four of which the Supreme Court held to be patentable processes, and one of which that tribunal held to be an unpatentable principle, or law of nature. To learn the controlling distinction between a claim for a process and a claim for a principle, it is therefore sufficient to ascertain precisely wherein consists the controlling difference between the eighth claim of Morse, on the one hand, and the claims of Harley, Whitney, Tilghman, and Bell on the other.

That difference does not consist in the fact that Harley, Whitney, Tilghman, and Bell each discovered one of the laws of nature which he utilized, while the laws which Morse utilized were discovered by others; because the Supreme Court did not rest its decision in the Morse case on the ground that he was not the discoverer of the electric current, but on the ground that, being a power in nature, it was not patentable to any person. Neither does that difference consist in anything outside of the use of laws of nature, because all five claims extended to accomplishing results by means of such law or laws, regardless of the particular apparatus used in the respective processes. The fact that tangential injection of melted metal into a

cylindrical mould will give that metal a rotary motion; the fact that moderate reheating of a car wheel will not destroy its chill; the fact that very hot water will separate the elements of fat; the fact that mechanical motion may cause electrical undulations—every one of these is just as truly a law of nature, just as truly a "principle," as is the fact of the electric current. Nor was the apparatus described by Harley, Whitney, Tilghman, and Bell, respectively, for the purpose of utilizing the first four of these laws, respectively, claimed as their sole respective inventions, any more than the particular telegraph described by Morse was made essential to his eighth claim.

§ 13. There is apparently but one radical distinction between the claims of the four patents of Harley, Whitney, Tilghman, and Bell, on the one hand, and the eighth claim of Morse on the other. That distinction is as follows: Harley, Whitney, Tilghman, and Bell each produced a process which utilized several laws of nature, and each of them claimed the entire process he produced, including the use of all those laws, in the order and method described. Morse also made an invention which utilized several laws of nature, but instead of claiming his combined and methodical use of all those laws, his eighth claim was construed as confined to one of them alone. This difference, taken in connection with the fact that the Supreme Court sustained the patents of Harley, Whitney, Tilghman, and Bell, and overthrew the eighth claim of Morse, and taken in connection with the fact that no other relevant and important difference can be detected, points to the soundness of the doctrine stated in the next section, and illustrated in the section following that.

§ 14. A patent for a process is a patent for the described combined use of all the laws of nature utilized by that process. A patent for a principle is a patent for one only of

the laws of nature used in a process. If a patent for a principle were granted and sustained, it would be much broader than a patent for a process, because it would cover all processes which aim at the same result, and which use the particular law of nature covered by the patent for a principle, no matter in what combination with other laws. A patent for a process, on the other hand, covers only its own method of using all of the laws of nature which it utilizes. To grant and sustain a patent for a principle, would induce an inventor to guess which of the laws of nature used in his process, will always be found indispensable, and guessing rightly, would enable him, by claiming that particular law, to suppress all subsequent processes using it, and thus to suppress all subsequent invention in the same field, until such time as his patent might expire. A patent for a process, on the contrary, leaves the field open to ingenious men to invent and to use other processes using part of the laws used by the patented process, or using all of them in other combinations and methods.[16]

§ 15. An illustration of the doctrines of the last section exists in the matter of the eighth claim of Morse, when considered in connection with other telegraphs than his. The subject of that claim was construed to be the use of electric current for marking signs at any distance. Electric current is one fact, and electro-magnetism is another. The first was discovered by Gray, in 1729, but the existence of the latter was not known until ninety years later. Morse used both in his telegraph, but his eighth claim was construed to cover the use of electric current with or with-

[16] Westinghouse Electric & Mfg. Co. *v.* Beacon Lamp Co., 95 F. R. 464, 1899; American Bell Telephone Co. *v.* National Telephone Mfg. Co., 109 F. R. 996, 1901; Manhattan General Const. Co. *v.* Helios-Upton Co., 135 F. R. 785, 1905.

out the other. But without electro-magnetism Morse's telegraph would not work. After Morse came Bain, who invented a telegraph which used electric current, but did not use electro-magnetism. Its recording apparatus operated electro-chemically, and not electro-magnetically like that of Morse. Bain's telegraph could work with a much feebler current than could that of Morse, and therefore the relay batteries of the latter were not needed by Bain. The two telegraphs had nothing in common except that both used electric current. If the eighth claim of Morse had been sustained as construed, it would have covered Bain's and every other electric telegraph, capable of marking signs at a distance. On the other hand, had that claim been so drawn as to cover the combined use of all the laws of nature utilized by the telegraph of Morse, when used as he used them, then it would have been a claim for a process, and not being obnoxious to either of the weighty objections which are set forth in the opinion of the Supreme Court, it would doubtless have been sustained by that tribunal. In that case, however, it would not have been infringed by the telegraph of Bain, nor by any other which, like his, dispensed with one or more of the laws of nature necessary to the process of Morse.

§ 16. Machines, and improvements of machines constitute the subjects of a majority of the American patents heretofore granted. A machine is a combination of heterogeneous mechanical parts, adapted to receive energy, and to apply it to the production of some energetic result or results. All the parts of a machine may be old, while the machine as a whole, and also the sub-combinations which are contained therein, are proper subjects of patents.[17] An improvement of a machine may consist of an addition thereto, or in a subtraction therefrom, or in sub-

[17] Cantrell *v.* Wallick, 117 U. S. 694, 1886.

stituting for one or more of its parts something different, or in so rearranging its parts as to make it work better than before. Whether or not a given improvement is a patentable one will always depend upon several considerations. In order to be so it must, first of all, be an invented improvement,[18] as distinguished from one otherwise produced. This point of law is explained at large in the next chapter. So also it is explained in the chapter on infringement, what improvements can be used, and what improvements cannot be used, without infringing the patents for the machines improved upon, if the latter are patented. It is enough to say in this chapter, that patents are not void merely because they cover processes or things which include old inventions,[19] and that an improvement may or may not be an invention, and in either case may or may not be an infringement of a patent covering the machine improved.

§ 17. The word "manufacture" has a much narrower signification in the American patent laws than it has in those of England. In the latter it includes not only everything made by the hand of man, but also includes processes of manufacture. According to the former, processes are patentable because they are arts, while some of the things made by the hand of man are patentable as machines, and some others are patentable as compositions of matter, and some others are patentable as designs. Whatever is made by the hand of man, and is neither of these, is a manufacture, in the sense in which that word is used in the American patent laws.[20] In spite of the *dictum* of Justice Grier

[18] Cochrane *v.* Waterman, 1 McArthur's Patent Cases, 53, 1844.

[19] Cantrell *v.* Wallick, 117 U. S. 694, 1886.

[20] Johnson *v.* Johnston, 60 F. R. 620, 1894; Cincinnati Traction Co. *v.* Pope, 210 F. R. 443, 1913; International Mausoleum Co. *v.* Sievert, 213 F. R. 225, 1914.

in the jail case,[21] this term has lately been held to include building structures.[22] The question has not, however, been directly passed upon by the Supreme Court and so of course cannot be regarded as judicially settled.

§ 18. The phrase "composition of matter," as used in the statutes, covers all compositions of two or more substances. It includes, therefore, all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids. To be a proper subject of a patent, a composition of matter must, like a process, a machine, or a manufacture, be able to endure the relevant tests of invention, novelty, and utility, which are stated in the next three chapters of this book.

§ 19. The distinction between a machine and a manufacture cannot be so stated that its application to every case would be clear and satisfactory to every mind. The same remark is true of the distinction between manufactures and compositions of matter. In most instances, however, when something is invented by the mind and constructed by the hand of man, its classification under some one of these heads is sufficiently obvious. If an inventor is certain that his invention belongs to one or another of the three classes of things, but is uncertain as to which, no evil need result from the doubt. No inventor needs

[21] Jacobs *v.* Baker, 7 Wallace, 297, 1868.

[22] Crier *v.* Innes, 170 F. R. 324, 1909, in which case, however, it was expressly held that the sarcophagus covered by the patent was not a species of architecture; Riter-Conley Mfg. Co. *v.* Aiken (roof structure for sheds), 203 F. R. 699, 1913; Aiken *v.* Riter-Conley Mfg. Co., 205 F. R. 531, 1912; International Mausoleum Co. *v.* Sievert, 213 F. R. 225, 1914.

See Turner *v.* Quincy Market Cold Storage & Warehouse Co., 225 F. R. 41, 1915. *Contra* American Disappearing Bed Co. *v.* Arnælsteen, 182 F. R. 324, 1910, reviewing the subject.

to state or to know whether the thing he has produced is a machine, a manufacture, or a composition of matter, provided he knows that it is one or the other of these. A seventeen-year patent may be lawfully granted for a thing which falls under either designation, but it never becomes vitally important to determine to which one of the three classes a particular thing really belongs.[22a]

§ 20. Designs are patentable under Section 4929 of the Revised Statutes; as amended May 9, 1902. That section provides that any person who has invented any new, original, and ornamental design for an article of manufacture may, subject to certain conditions and limitations stated in the statute, obtain a patent therefor.[23] The original Section 4929, provided that any person who, by his own industry, genius, efforts, and expense, had invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief, any new and original design for the printing of woollen, silk, cotton, or other fabrics, any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture, or any new, useful, and original shape or configuration of any article of manufacture, might, subject to certain conditions and limitations stated in that statute, obtain a patent therefor. That original section was almost a literal transcript of Section 71 of the Consolidated Patent Act of 1870,[24] except that in the latter the word "pattern" is found in the connection in which the word "patent" is printed in Section 4929. The change from "pattern" to "patent" was doubtless an error of the printers of the

[22a] See 1 Hopkins on Patents, Section 32.

[23] 32 Statutes at Large, Pt. 1, Ch. 783, p. 193.

[24] 16 Statutes at Large, Ch. 230, p. 209.

Revised Statutes. Those statutes were enacted as printed, and not as is the custom with shorter edicts, as engrossed in writing. The word "patent" is meaningless in that connection, and patterns, though not mentioned in the section, were doubtless covered by its other provisions.

§ 21. In like manner as Section 4929 of the Revised Statutes was enacted to take the place of Section 71 of the Patent Act of 1870, the latter was passed to take the place of Section 11 of the Patent Act of 1861.[25] The Act of 1870 differed from its predecessor mainly in conferring upon any person, the rights to design patents which the Act of 1861 gave only to citizens and to aliens who, having resided one year in the United States, had taken an oath of intention to become citizens. Section 11 of the Act of 1861 was a modification of Section 3 of the Patent Act of 1842,[26] which latter was the first American statute authorizing patents for designs.

§ 22. The amended Section 4929 of the Revised Statutes,[26a] differs from the original section, in using the word "ornamental" to specify one characteristic which every design must have, and in omitting the word "useful," from its former place among the characersitics which some designs were required to have, by the original Section 4929. But the word "useful" in the original section, did not have the meaning of the word "utilitarian." The presence of utility in a design, did not impart patentability thereto; and the absence of utility therefrom, did not deprive it of that privilege.[27]

[25] 12 Statutes at Large, Ch. 88, p. 248.

[26] 5 Statutes at Large, Ch. 263, p. 543.

[26a] Act of May 9, 1902, 32 Stat. 193, Ch. 783.

[27] Smith *v.* Whitman Saddle Co., 148 U. S. 678, 1893; Theberath *v.* Trimming Co., 15 F. R. 250, 1883; Westinghouse Electric Mfg. Co. *v.* Triumph Electric Co., 97 F. R. 102, 1899; Pelouze Scale & Mfg.

Consequently an article which is ordinarily not visible in its ordinary use is not proper subject-matter for a design patent.[28] Nor is an article patentable as a design, the essential element of which is a mechanical construction which causes the article to assume an ornamental shape.[29] The design patent may, however, be made to cover the ornamental shape, as it is of course no objection that it is at the same time useful.[30] It is questionable, however, whether an article to which ornamentation would give no value is proper subject-matter of a design patent, as for example, a horseshoe calk,[31] a pickaxe, a plough or other articles coming within such a category.[32]

Co. *v.* American Cutlery Co., 102 F. R. 918, 1900; Rowe *v.* Blodgett & Clapp Co., 112 F. R. 61, 1901; Marvel Co. *v.* Pearl, 114 F. R. 946, 1902; Eaton *v.* Lewis, 115 F. R. 635, 1902.

[28] Rowe *v.* Blodgett & Clapp Co., 112 F. R. 61, 1901; Bradley *v.* Eccles, 126 F. R. 945, 1903; Williams Calk Co. *v.* Kemmerer, 145 F. R. 928, 1906; Williams *v.* Syracuse & S. R. Co., 161 F. R. 571, 1908.

[29] Royal Metal Mfg. Co. *v.* Art Metal Works, 130 F. R. 778, 1904.

[30] Weisgerber *v.* Clowney, 131 F. R. 477, 1904.

[31] Williams Calk Co. *v.* Kemmerer, 145 F. R. 928, 1906.

[32] Theodore W. Foster & Bro. *v.* Tilden-Thurber Co., 200 F. R. 54, 1912.

CHAPTER II

INVENTION

23. Invention necessary to patentability.
24. Many negative rules, but no affirmative rule, for determining the presence or absence of invention.
25. Mere skill is not invention.
26. Circumstances indicating difference between invention and skill.
27. Excellence of workmanship is not invention.
28. Substitution of materials is not invention.
29. Exceptions to the last rule.
30. Enlargement is not invention.
31. Change of degree is not invention.
31*a*. Exception to the last rule.
32. Aggregation is not invention.
33. Simultaneousness of action is not necessary to invention.
34. Duplication is not generally invention.
35. Omission is not generally invention.
36. Substitution of equivalents is not generally invention.
37. New combination without new mode of operation, is not invention.
38. Using old thing for new and analogous purpose is not invention.
39. Cases to which the last rule does not apply.
40. Doubts relevant to invention, when otherwise insoluble, are solved by ascertaining comparative utility.
41. Form.
41*a*. Proportion.
42. Questions of invention are questions of fact.
43. Questions of invention are investigated in the light of the state of the prior art.
44. Joint and sole inventions.
45. How made.
46. How distinguished.
47. Suggestions to an inventor.
48. Information sought by an inventor.
49. Mechanical skill not necessary to invention.
50. Sole patent to one joint inventor is void.
51. Joint patent to sole inventor and another is void.

§ 23. It has been shown that the word "discovered," in Section 4886 of the Revised Statutes, has the meaning

of the word "invented."[1] It follows that patents are grantable for things invented, and not for things otherwise produced,[2] even where the production required ability of a high order.[3] Novelty and utility must indeed characterize the subject of a patent, but they alone are not enough to make anything patentable; for the statute provides that things to be patented must be invented things, as well as new and useful things.[4] And except in the few cases where definite rules of law have been laid down for the determination of the question, invention is a question of fact.[5] The courts have therefore declared that not all improvement is invention, and entitled to protection as such, but that to be thus entitled, a thing must be the product of some exercise of the inventive faculties.[6] And the law stated in this section applies not only to processes, machines, manufactures, and compositions of matter, but also to designs.[7] But a patent may be sus-

[1] Section 2 of this book.

[2] *In re* Snyder, 10 App. D. C. 144, 1897; Lamb Knit Goods Co. *v.* Lamb Glove & Mitten Co., 120 F. R. 272, 1902.

[3] Fowler *v.* City of New York, 121 F. R. 749, 1903.

[4] Thompson *v.* Boisselier, 114 U. S. 11, 1884; Gardner *v.* Herz, 118 U. S. 191, 1885; Klein *v.* City of Seattle, 77 F. R. 204, 1896; Tiemann *v.* Kraatz, 85 F. R. 439, 1898; Goss Printing-Press Co. *v.* Scott, 103 F. R. 657, 1900.

[5] Proudfit Loose Leaf Co. *v.* Kalamazoo Loose Leaf Binder Co., 230 F. R. 120, 1915.

See Section 42.

[6] Pearce *v.* Mulford, 102 U. S. 112, 1880; Atlantic Works *v.* Brady, 107 U. S. 199, 1882; Slawson *v.* Railroad Co., 107 U. S. 649, 1882; Morris *v.* McMillin, 112 U. S. 247, 1884; Hollister *v.* Benedict Mfg. Co., 113 U. S. 59, 1885; Stephenson *v.* Railroad Co., 114 U. S. 149, 1885; Munson *v.* New York City, 124 U. S. 601, 1888; Pattee Plow Co. *v.* Kingman & Co., 129 U. S. 294, 1889; Watson *v.* Railway Co., 132 U. S. 161, 1889; Hill *v.* Wooster, 132 U. S. 700, 1890; Burt *v.* Evory, 133 U. S. 349, 1890; Magin *v.* Karle, 150 U. S. 391, 1893; Risdon Locomotive Works *v.* Medart, 158 U. S. 81, 1895.

[7] Smith *v.* Saddle Co., 148 U. S.

tained for an invention which resided in a theory, without a reduction to actual practice, at the time the patent was granted, if that theory afterward proves to be correct,[8] and also where the correctness of the theory is self-evident.[9] Not only the first and the last, but every intermediate step of advance, which rises to the dignity of invention, in a particular art, is entitled to the protection of a patent.[10] And invention may result from long consideration, or from a flash of thought.[11]

§ 24. The abstract rule stated in the last section is as certainly true as it is universally just, but its application to particular cases cannot be made without the guidance of more concrete propositions. In delivering an opinion of the Supreme Court, in January, 1885, Justice MATTHEWS used some language which may be thought to establish an affirmative rule by which to determine the

679, 1893; Western Electric Mfg. Co. *v.* Odell, 18 F. R. 322, 1883; Osborn *v.* Judd, 29 F. R. 96, 1886; Meers *v.* Kelly, 31 F. R. 153, 1887; Untermeyer *v.* Freund, 37 F. R. 343, 1889; Redway *v.* Stove Co., 38 F. R. 583, 1889; Dukes *v.* Bauerle, 41 F. R. 783, 1890; Foster *v.* Crossin, 44 F. R. 63, 1890; Eclipse Mfg. Co. *v.* Adkins, 44 F. R. 282, 1890; Cahoone Mfg. Co. *v.* Harness Co., 45 F. R. 585, 1891; Anderson *v.* Saint, 46 F. R. 760, 1891; Eagle Pencil Co. *v.* American Pencil Co., 53 F. R. 388, 1892; Cary Mfg. Co. *v.* Neal, 98 F. R. 617, 1899; General Gaslight Co. *v.* Matchless Mfg. Co., 129 F. R. 137, 1904; Ashley *v.* Samuel C. Tatum Co., 189 F. R. 357, 1911; Mygatt *v.* M. Schauffer-Flaum Co., 191 F. R. 836, 1911; Charles Boldt Co. *v.* Nivison-Weiskoff Co., 194 F. R. 871, 1912; Charles Boldt Co. *v.* Turner Bros. Co., 199 F. R. 139, 1912.

[8] Telephone Cases, 126 U. S. 535, 1888.

[9] Heath *v.* Hildreth, 1 McArthur's Patent Cases, 19, 1841; Screw Co. *v.* Sloan, 1 McArthur's Patent Cases, 210, 1853; *In re* Seely, 1 McArthur's Patent Cases, 249, 1853; Chandler *v.* Ladd, 1 McArthur's Patent Cases, 493, 1857.

[10] National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 698, 1901.

[11] Snyder *v.* Fisher, 78 O. G. 486, 1897.

presence or absence of invention in every case. Speaking of a simple device which the court held not to be an invention, he said that it "seems to us not to spring from that intuitive faculty of the mind put forth in search for new results or new methods, creating what had not before existed, or bringing to light what lay hidden from vision; but, on the other hand, to be the suggestion of that common experience which arose spontaneously, and by a necessity of human reasoning, in the minds of those who became acquainted with the circumstances with which they had to deal."[12] This language may be thought to mean that whatever new and useful process, machine, manufacture, composition of matter, or design is produced by intuition is an invention, and that whatever such thing is produced by reason is not an invention. But such an interpretation of the language would not be right. Intuition may sometimes reach to a single brilliant result; but intuition can never conceive or correlate the mazes of movements and mechanisms which constitute a modern automatic machine. To enforce such a rule as that hypothetically implied in the language of Justice MATTHEWS would be to deny invention to those marvelous combinations of numerous metallic devices which compose American automatic machinery, and which work with such complexity and yet with such precision that they seem themselves to be endowed with reason. But fortunately the supposed interpretation of that language is evidently not the meaning of the court. The court does not deny invention to all the products of pure reason in the useful arts. It merely finds want of invention in those things which are conceived "spontaneously and by a necessity of human reasoning" in the minds of those who have their attention directed to the subject.

[12] Hollister *v.* Benedict Mfg. Co., 113 U. S. 72, 1885.

In a later case the Supreme Court, speaking by Justice BROWN of the meaning of the word "invention," said: "The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition."[13] Thus it has been settled by the Supreme Court that the ideal line which separates things invented from things otherwise produced can never be concisely defined; and that there is no affirmative rule by which to determine the presence or absence of invention in every case; and that such questions are to be determined by means of several negative rules which operate by a process of exclusion. Each of those rules applies to a large class of cases, and all of them are entirely authoritative and sufficiently clear. To formulate those rules, and to state their qualifications and exceptions, and to classify and cite the adjudged cases from which those rules, qualifications, and exceptions are deducible, is the scope of several sections which immediately follow.

§ 25. It is not invention to produce a process, machine, manufacture, composition of matter or design which any skillful mechanic, electrician, chemist, or other expert

[13] McClain *v.* Ortmayer, 141 U. S. 427, 1891.

would produce whenever required to effectuate a given result.

In holding a patent to be void the Supreme Court, speaking by Justice BRADLEY, delivered a paragraph of very instructive argument in support of the rule of this section: a paragraph so valuable as to call for its verbatim quotation in this text.

"The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It

embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith." [14]

This opinion of Justice BRADLEY is now a classic. Many federal judges, during twenty years, have administered it as law; and some have paraphrased it in sound and suggestive language of their own. For example, Judge PHILLIPS has said that: "In this day of increasing demand for new and enlarged mechanical appliances, the first natural result is the production of a large class of skilled and experienced mechanics and artisans, and, second, a more studious and constant development in applied mechanics. And, as such advance plainly points out, to the attentive and assiduous workman, the natural, larger, practical adaptation of existing, known mechanical devices; to invest each one of these developments with the immunity of a monopolizing patent, would not only be a perversion of the term "invention," but would utterly extinguish the doctrine of mechanical equivalents." [15] And Judge COXE has said that a chemical patent is addressed to accomplished chemists; and "That which seems, to the ordinary layman, to involve the exercise of extraordinary mental power, is to these men nothing but the everyday work of laboratory routine." [16] And Judge TOWNSEND has said that an electrical patent should be stripped of the dazzling halo which conventionally adorns appliances designed to deal with that mysterious agent, electricity; when a court is called on to decide the question of the presence or absence of invention, in an electrical patent.[17]

[14] Atlantic Works *v.* Brady, 107 U. S. 199, 1882.

[15] Tiemann *v.* Kraatz, 85 F. R. 439, 1898.

[16] Badische Anilin & Soda Fabrik *v.* Kalle, 94 F. R. 173, 1899.

[17] Perkins Electric Switch Mfg.

Nearly a hundred other cases, involving the rule of this section, have now been adjudicated and reported. The question whether a particular process, machine, manufacture, composition of matter or design, evinces invention, or only shows skill, may sometimes be decided by reasoning by analogy from some of those cases; and therefore those of them which were decided by the Supreme Court are cited on this page in a note.[18]

The absence of invention may be established in some cases, by evidence that a considerable number of persons who were not inventors, acting independently of each other, and without receiving any information from the patentee or his patent, did in fact contrive the improvement claimed therein, not long after he produced it.[19] And where that does not happen to be the case, want of invention can be proved by teaching a mechanic or other person the whole or a part of the prior art, and by proving that, without exercising any invention, he promptly pro-

Co. *v.* Gibbs Electric Mfg. Co., 87 F. R. 923, 1898.

[18] The Corn-Planter Patent, 23 Wallace, 232, 1874; Vinton *v.* Hamilton, 104 U. S. 491, 1881; Tack Co. *v.* Mfg. Co., 109 U. S. 119, 1883; Morris *v.* McMillin, 112 U. S. 244, 1884; Hollister *v.* Benedict Mfg. Co., 113 U. S. 72, 1885; Yale Lock Co. *v.* Greenleaf, 117 U. S. 554, 1886; Pomace Holder Co. *v.* Ferguson, 119 U. S. 335, 1886; Weir *v.* Morden, 125 U. S. 98, 1888; Brown *v.* District of Columbia, 130 U. S. 87, 1889; Day *v.* Railroad Co., 132 U. S. 102, 1889; Butler *v.* Steckel, 137 U. S. 29, 1890; Shenfield *v.* Nashawannuck Mfg. Co., 137 U. S. 59. 1890; Consolidated Roller Mill Co. *v.* Walker, 138 U. S. 132, 1891; Cluett *v.* Claflin, 140 U. S. 180, 1891; Magowan *v.* Belting Co., 141 U. S. 343, 1891; Pope Mfg. Co. *v.* Gormully Mfg. Co., 144 U. S. 259, 1892; Ryan *v.* Hard, 145 U. S. 246, 1892; Duer *v.* Lock Co., 149 U. S. 222, 1893; Leggett *v.* Standard Oil Co., 149 U. S. 295, 1893; Sargent *v.* Covert, 152 U. S. 516, 1894; Palmer *v.* Corning, 156 U. S. 342, 1895.

[19] Bromley Bros. Carpet Co. *v.* Stewart, 51 F. R. 915, 1892; Haslem *v.* Pittsburgh Plate Glass Co., 71 O. G. 1770, 1894.

duced the patented improvement, without any knowledge on the subject except what he had thus learned.[20] But it does not tend to prove want of invention, to show that a skillful mechanic who had seen the patented thing, can reconstruct some older thing so as to make it similar to that covered by the patent.[21]

§ 26. But if a particular result was long desired and sometimes sought, but never attained, want of invention cannot be predicated of a device or process which first reached that result, on the ground that the simplicity of the means is so marked that many believe they could readily have produced it if required.[22] That is the opinion of many relevant to some real inventions, because solved problems often seem easy to persons who could never have solved them, and true inventions sometimes seem obvious to persons who could never have produced them.[23] This doctrine does not contradict that of the last section. It only teaches us that the fact upon which the doctrine of the last section is founded cannot be proved by subsequent opinion, when that opinion is inconsistent with prior attempts and failures.

In The Loom Co. *v.* Higgins,[24] Justice BRADLEY remarked that: "It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is

[20] National Co. *v.* Belcher, 68 F. R. 668, 1895.

[21] Beach *v.* Box-Machine Co., 63 F. R. 601, 1894; National Co. *v.* Belcher, 71 F. R. 879, 1896.

[22] The Barbed Wire Patent, 143 U. S. 283, 1892; Gandy *v.* Belting Co., 143 U. S. 594, 1892; Krementz *v.* Cottle Co., 148 U. S. 560, 1893; Potts *v.* Creager, 155 U. S. 609, 1895; Du Bois *v.* Kirk, 158 U. S. 63, 1895; Hanifen *v.* Armitage, 117 F. R. 849, 1902.

See Section 42.

[23] Railroad Supply Co. *v.* Hart Steel Co., 222 F. R. 261, 1915.

[24] Loom Co. *v.* Higgins, 105 U. S. 591, 1881.

evidence of invention." The exception to this rule, which Justice BRADLEY contemplated, doubtless refers to cases, the result wherein was never before attained only because it was never before desired. In the circuit court cases which support the doctrine of this section, the proviso that the thing or process which the patentee was the first to produce, had been previously sought for by others in vain, is never overlooked, but, on the contrary, is always treated as a material element in the proposition.[25] So also, the statement of Justice BRADLEY would still have been correct, if it had omitted the words which it contains to designate novelty of result; for where a new organization of old elements produces a new mode of operation, and a beneficial result, there may be a patentable invention,[26] whether that result is new or is old.

A qualification of the rule of this section consists in the subordinate point, that where several improvements have mutually contributed to introduce an unused invention into public favor, and where it does not appear that either of those improvements alone would have produced that

[25] Terry Clock Co. *v.* New Haven Clock Co., 4 Bann. & Ard. 121, 1879; Wallace *v.* Noyes, 13 F. R. 180, 1882; Ward *v.* Plow Co., 14 F. R. 696, 1883; Davis *v.* Fredericks, 19 F. R. 99, 1884; Patterson *v.* Duff, 20 F. R. 641, 1884; Brown Mfg. Co. *v.* Deere, 21 F. R. 713, 1884; McFarland *v.* Spencer, 23 F. R. 151, 1885; Celluloid Mfg. Co. *v.* Chrolithion Collar & Cuff Co., 23 F. R. 397, 1885; Sewing Machine Co. *v.* France, 24 F. R. 596, 1884; Asmus *v.* Alden, 27 F. R. 687, 1886; Adee *v.* Peck, 42 F. R. 499, 1890; American Cable Ry. Co. *v.* New York, 56 F. R. 150, 1893; Stohlmann *v.* Parker, 53 F. R. 925, 1893; Westinghouse *v.* Air-Brake Co., 59 F. R. 581, 1893; Electric Ry. Co. *v.* Jamaica R. R. Co., 61 F. R. 670, 1894; Brill *v.* North Jersey St. Ry. Co., 124 F. R. 778, 1903.

[26] Dowagiac Mfg. Co. *v.* Minnesota Moline Plow Co., 118 F. R. 139, 1902; St. Louis Street, etc., Co. *v.* Am. Street, etc., Co., 156 F. R. 574, 1907; Steiner & Voegtly Hardware Co. *v.* Tabor Sash Co., 178 F. R. 831, 1910.

See Section 37.

result, no presumption in favor of either of those improvements being an invention, arises out of the commercial success of the invention thus improved.[27] And another qualification resides in holding that the rule of the section does not apply where the prior attempts were unsuccessful because they were unskillful,[28] or because those who made them, did not know and understand the prior art.[29]

§ 27. It is not invention to produce an article which differs from some older thing only in excellence of workmanship.[30]

The distinction between this rule, and the rule of Section 25, resides in the fact that mechanical skill is treated as ability to plan improvement; while excellence of workmanship is contemplated as ability to execute improvement already planned, but not well executed by him who planned it. This subject does not require an elaborate explanation; because it is evident that invention does not reside in taking an article so irregular or rough, that it never could have found a sale in the market, and exercising upon that article such superiority of workmanship as to make it commercial.[31]

§ 28. It is not invention to substitute superior for inferior materials, in making one or more or all of the parts of a machine or manufacture.

[27] Corbin Lock Co. *v.* Eagle Lock Co., 37 F. R. 338, 1889.

See Section 40.

[28] Butler *v.* Steckel, 137 U. S. 29, 1890; American Feather Duster Co. *v.* Levy, 43 F. R. 383, 1890; Mahon *v.* McGuire Mfg. Co., 51 F. R. 684, 1892; Johnson Co. *v.* Steel Co., 67 F. R. 942, 1895.

[29] Mast Foos & Co. *v.* Stover Mfg. Co., 177 U. S. 493, 1900; New Departure Bell Co. *v.* Bevin Bros. Mfg. Co., 73 F. R. 475, 1896.

[30] Edison *v.* American Mutoscope Co., 114 F. R. 935, 1902.

[31] Risdon Locomotive Works *v.* Medart, 158 U. S. 81, 1895; Buzzell *v.* Fifield, 7 F. R. 467, 1881; Hatch *v.* Moffitt, 15 F. R. 252, 1883; Lee *v.* Upson Hart Co., 42 F. R. 531, 1890.

In most of the cases which embody this rule, the substitution of materials was both new and useful; and in some of those cases, the increase of utility due to the substitution, was decidedly high. But the courts held the respective improvements to be the result of judgment and skill in the selection and the adaptation of materials, and not the product of the inventive faculties of those who made them.[32]

There being no invention in substituting superior for inferior materials, there is certainly none in selecting from a number of materials recommended by a prior patentee, that one which is best adapted to the purpose in view;[33] and none in substituting one well-known form of a particular material, for another well-known form of the same material.[34]

§ 29. Important exceptions have, however, been estab-

[32] Hotchkiss *v.* Greenwood, 11 Howard, 248, 1850; Hicks *v.* Kelsey, 18 Wallace, 670, 1873; Terhune *v.* Phillips, 99 U. S. 593, 1878; Gardner *v.* Herz, 118 U. S. 192, 1885; Brown *v.* District of Columbia, 130 U. S. 87, 1889; Florsheim *v.* Schilling, 137 U. S. 76, 1890; Hoff *v.* Iron Clad Mfg. Co., 139 U. S. 329, 1891; Ryan *v.* Hard, 145 U. S. 245, 1892; *In re* Maynard, 1 McArthur's Patent Cases, 536, 1857; Post *v.* Hardware Co., 26 F. R. 616, 1886; Forschner *v.* Baumgarten, 26 F. R. 858, 1886; J. L. Mott Iron Works *v.* Cassidy, 31 F. R. 47, 1887; National Roofing Co. *v.* Garwood, 35 F. R. 658, 1888; Kilbourne *v.* Bingham Co., 47 F. R. 57, 1891; Vulcanized Fiber Co. *v.* Taylor, 49 F. R. 744, 1891; Thomson-Houston Electric Co. *v.* Lorain Steel Co., 117 F. R. 254, 1902; National Tooth Crown Co. *v.* Macdonald, 117 F. R. 617, 1902; Drake Castle Pressed Steel Lug Co. *v.* Brownell & Co., 123 F. R. 87, 1903; Lafferty Mfg. Co. *v.* Acme, etc., Co., 138 F. R. 729, 1905; New York Belting Co. *v.* Sierer, 149 F. R. 756, 1906; Cover *v.* American Thermo-Ware Co., 188 F. R. 670, 1911.

[33] Welling *v.* Crane, 14 F. R. 571, 1882.

[34] Brush Electric Co. *v.* Julien Electric Co., 41 F. R. 693, 1890; Brush Electric Co. *v.* Accumulator Co., 47 F. R. 50, 1891.

lished to the general rule of the last section. If the substitution of materials involved a new mode of construction, or if it developed new properties and uses of the article made, it may amount to invention.[35] And substitution of materials may constitute invention, where it produces a new mode of operation, or results in a new function,[36] or in the first practical success in the art in which the substitution is made,[37] or in increased efficiency or in a decided saving in cost of operation.[38] So also, where the excellence of the material substituted could not be known beforehand, and where practice shows its superiority to consist not only in greater cheapness and greater durability, but also in more efficient action, the substitution of a superior for an inferior material amounts to invention.[39]

It may or may not be invention to substitute one material for another, as an agent in performing a process, or as an ingredient of a composition of matter. The question of invention in any such case, is to be decided by some other rule or rules, than that of the substitution of materials.

§ 30. It is not invention to so enlarge and strengthen a

[35] Smith *v.* Dental Vulcanite Co., 93 U. S. 496, 1876; Fairbanks Wood Rim Co. *v.* Moore, 78 F. R. 490, 1897; Badische Anilin & Soda Fabrik *v.* Kalle, 94 F. R. 164, 1899; Hogan *v.* Westmoreland Specialty Co., 163 F. R. 289, 1908; Archer *v.* Imperial Machine Co., 207 F. R. 81, 1913.

[36] Potts *v.* Creager, 155 U. S. 609, 1895; Wickelman *v.* A. B. Dick Co., 88 F. R. 264, 1898.

[37] Edison Electric Light Co. *v.* U. S. Electric Lighting Co., 52 F. R. 308, 1892; George Frost Co. *v.* Cohn, 119 F. R. 505, 1902; Western Tube Co. *v.* Rainer, 156 F. R. 49, 1907.

[38] George Frost Co. *v.* Samstag, 180 F. R. 739, 1910.

[39] Dalton *v.* Nelson, 13 Blatch. 357, 1876; Celluloid Mfg. Co. *v.* American Zylonite Co., 35 F. R. 301, 1888; Celluloid Mfg. Co. *v.* Crane Chemical Co., 36 F. R. 110, 1888; King *v.* Anderson, 90 F. R. 503, 1898.

See Section 31*a*,

machine that it will operate on larger materials than before.[40]

In Phillips *v.* Page[41] the patent covered the first circular sawmill which was adapted to sawing logs. Its utility was great, and was unquestioned. Machines like it, except that they were much smaller in every part, had been used before, to saw lath and other slender articles out of small blocks of wood. The Supreme Court therefore held that Mr. Page did not invent a circular sawmill, but merely constructed one, by copying on a larger scale the prior machine for sawing lath.

In the case of the Planing Machine Co. *v.* Keith,[42] the patent covered the Woodbury planing machine, a machine which differed from the older Woodworth planing machine in one respect only. Woodworth used rollers to press the boards against the bed of the machine, whereas Woodbury used pressure bars for that purpose. The Supreme Court held the Woodbury patent to be void because Alfred Anson, of Norwich, Connecticut, had previously invented and constructed a machine for dressing window-sash, which had pressure bars like Woodbury, instead of pressure rollers like Woodworth. This decision was made notwithstanding the fact that the Anson machine was too small and too weak for general planing work upon boards and planks. And this rule has been applied, and is well illustrated, in several other Supreme Court cases.[43]

§ 31. It is not invention to change the size or degree of

[40] American Well Works *v.* F. C. Austin Mfg. Co., 98 F. R. 993, 1900.

[41] Phillips *v.* Page, 24 Howard, 164, 1860.

[42] Planing Machine Co. *v.* Keith, 101 U. S. 490, 1879.

[43] Peters *v.* Active Mfg. Co., 129 U. S. 530, 1889; Morgan Envelope Co. *v.* Albany Paper Co., 152 U. S. 430, 1894.

a thing, or of any feature or function of a machine or manufacture.[44]

In Glue Co. *v.* Upton [45] the patent covered pulverized glue made from flake glue by grinding it in any suitable manner. It had several points of superiority over all former kinds of glue, but the Supreme Court held that, not being a product of invention, the patent covering it was void.

In Guidet *v.* Brooklyn [46] the patent covered paving-stones of a certain shape and with rough sides. Paving-stones of the same shape, but with sides less rough, had been known before. To make the sides of the prior stones rougher was held by the Supreme Court to be a change in degree only, and therefore not patentable.

In Estey *v.* Burdett,[47] one of the claims of the patent involved, depended upon concentrating certain valve openings into a smaller space than had theretofore been occupied by them. The Supreme Court held that there was no invention in that change.

In Preston *v.* Manard [48] the alleged invention consisted in making the reel of a fountain hose-carriage of larger diameter than were the reels of former hose-carriages, in

[44] Baldwin *v.* Kresl, 76 F. R. 826, 1896; Thomson-Houston Electric Co. *v.* Nassau Electric R. Co., 98 F. R. 111, 1899; Rumford Chemical Works *v.* N. Y. Baking Powder Co., 125 F. R. 231, 1903; Neptune Meter Co. *v.* National Meter Co., 127 F. R. 563, 1904; Sloan Filter Co. *v.* Portland Gold Mining Co., 139 F. R. 23, 1905; Yost Electric Mfg. Co. *v.* Perkins Electric S. Mfg. Co., 179 F. R. 511, 1910; Neureuther *v.* Mineral Point Zinc Co., 179 F. R. 850, 1910; Young *v.* Burley, 200 F. R. 258, 1912; Hyde *v.* Minerals Separation Co., Ltd., 214 F. R. 100, 1914.

[45] Glue Co. *v.* Upton, 97 U. S. 6, 1877.

[46] Guidet *v.* Brooklyn, 105 U. S. 552, 1881.

[47] Estey *v.* Burdett, 109 U. S. 640, 1884.

[48] Preston *v.* Meuard, 116 U. S. 663, 1886.

order to allow the water to pass through the hose when partly wound upon the reel. The Supreme Court held that there resided no invention in that improvement.

In French *v.* Carter,[49] the patent claimed a roof for a vault, which consisted, like an earlier roof, of two gable-stones, and two sloping roof-stones, and one cap-stone; and which differed from the earlier roof in that its roof-stones were narrower, and its cap-stone was wider, than the corresponding stones of the earlier vault. The Supreme Court held that these differences of degree did not constitute invention.

In American Road Machine Co. *v.* Pennock & Sharp Co.,[50] the patent claimed various combinations, in each of which a very heavy hand-wheel was the distinguishing element. The extra weight of the wheel gave it a useful momentum in the combination; but the Supreme Court held that it was not invention to increase the weight of a hand-wheel for that purpose.

Circuit Court cases which have been decided by skillful judges furnish still other illustrations of the rule of this section.[51]

It may or may not be invention to change the degree of heat, or other agent, used in a process,[52] or to change the amount of an ingredient used in a composition of matter,[53]

[49] French *v.* Carter, 137 U. S. 239, 1890.

[50] American Road Machine Co. *v.* Pennock & Sharp Co., 164 U. S. 26, 1896.

[51] Stow *v.* City of Chicago, 3 Bann. & Ard. 91, 1877; White *v.* Lee, 14 F. R. 790, 1882; Woonsocket Rubber Co. *v.* Candee, 23 F. R. 797, 1885; Smith *v.* Murray, 27 F. R. 69, 1886; Hurd *v.* Snow, 35 F. R. 423, 1888; Blumenthal *v.* Burrell, 43 F. R. 669, 1890; Murphy *v.* Trenton Rubber Co., 45 F. R. 571, 1891; Caverly *v.* Deere, 52 F. R. 763, 1892.

[52] Musgrave & Nye *v.* Commissioner of Patents, 78 O. G. 2047, 1897; De Lamar *v.* De Lamar Mining Co., 117 F. R. 240, 1902.

[53] National Newsboard Co. *v.*

or to change the size of a feature of a design. The question of presence or absence of invention, in every such case, is to be decided by the application of some other rule or rules, than that of this section.

§ 31*a*. A meritorious exception, to the rule of the last section, is involved in the adjudicated validity of the Edison incandescent light patent.[54] The carbon filament which constitutes the only new part of the combination of the second claim of that patent, differs from the earlier carbon burners of Sawyer and Man, only in having a diameter of one-sixty-fourth of an inch or less, whereas the burners of Sawyer and Man had a diameter of one-thirty-second of an inch or more. But that reduction of one-half in diameter increased the resistance of the burner four-fold, and reduced its radiating surface two-fold, and thus increased eight-fold, its ratio of resistance to radiating surface. That eight-fold increase of proportion, enabled the resistance of the conductor of electricity from the generator to the burner, to be increased eight-fold, without any increase of percentage of loss of energy in that conductor, or decrease of percentage of development of heat in the burner; and thus enabled the area of the cross section of that conductor to be reduced eight-fold, and thus to be made with one-eighth of the amount of copper or other metal, which would be required if the reduction of diameter of the burner from one-thirty-second to one-sixty-fourth of an inch had not been made. And that great reduction in the size and cost of conductors, involved also a great difference in the composition of the electric energy employed in the system; that difference consisting

Elkhart Egg Case Co., 123 F. R. 432, 1903.

[54] Edison Electric Light Co. *v.* U. S. Electric Lighting Co., 52 F. R. 300, 1892; also see Toledo Computing Scale Co. *v.* Computing Scale Co., 208 F. R. 410, 1913.

in generating the necessary amount of electrical energy with comparatively high electro-motive force, and comparatively low current, instead of contrarywise. For this reason, the use of carbon filaments, one-sixty-fourth of an inch in diameter or less, instead of carbon burners one-thirty-second of an inch in diameter or more, not only worked an enormous economy in conductors, but also necessitated a great change in generators, and did both according to a philosophy, which Edison was the first to know, and which is stated in this paragraph in its simplest form and aspect, and which lies at the foundation of the incandescent electric lighting of the world.

Another exception based on similar principles to the last is found where an old result is accomplished in a more facile, economical and efficient way. Cheapness of construction, simplicity of construction, and operation and ease of operation as compared with prior structures are all indications of invention.[55]

§ 32. Aggregation is not invention; either in processes,[56] machines,[57] or manufactures.[58]

In Hailes *v.* Van Wormer [59] the patents passed upon, covered certain self-feeding coal stoves. These stoves were

[55] James Heekin Co. *v.* Baker, 138 F. R. 63, 1905; Electric Candy Machine Co. *v.* Morris, 156 F. R. 972, 1905; National Tube Co. *v.* Aiken, 163 F. R. 254, 1908; Acme Steel Goods Co. *v.* Am. Metal Fasteners Co., 206 F. R. 478, 1913.

See Section 29.

[56] *In re* Mond, 16 App. D. C. 354, 1900.

[57] Overweight Counterbalance El. Co. *v.* Henry Vogt Mach. Co., 102 F. R. 961, 1900; Brown H. & C. Mach. Co. *v.* King Bridge Co., 107 F. R. 504, 1901; National Tube Co. *v.* Aiken, 163 F. R. 254, 1908; Gas Machinery Co. *v.* United Gas Improvement Co., 228 F. R. 684, 1915.

[58] Antisdel *v.* Chicago Hotel Cabinet Co., 89 F. R. 312, 1898.

[59] Hailes *v.* Van Wormer, 20 Wallace, 353, 1873; also, Warner Instrument Co. *v.* Stewart & Clark Mfg. Co., 185 F. R. 507, 1911.

better than any which preceded them, because they contained more good things than were ever before assembled in that kind of heater. All of the things so assembled were old. The superiority of the patented stoves arose from the fact that sundry good features, theretofore scattered through several, were in them gathered into one such article of manufacture. The things so united did not, however, perform any joint function, but each did only what it had formerly done in former stoves. The Supreme Court held the whole to be a mere aggregation of devices, and not to be invention.

The case of Reckendorfer *v.* Faber [60] was based upon patents for a new and useful article, of which many millions of specimens had been made and sold since those patents were granted. That article was a piece of soft rubber united to one end of a lead pencil. The Supreme Court called attention to the fact that there was no joint operation performed by the pencil and the rubber, and therefore held the patents to be void for want of invention.

In Pickering *v.* McCullough [61] Justice MATTHEWS said: "In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of invention, seized each of every part, *per my et per tout*, and not mere tenants in common, with separate interests and estates. It must form either a new machine of a distinct character and function, or produce a result due to the joint and cooperating action of all the elements, and which is not the mere adding together of separate contributions."

The first of these sentences has been thought to imply a severer doctrine than the second, and some of the lower

[60] Reckendorfer *v.* Faber, 92 U. S. 357, 1875.

[61] Pickering *v.* McCullough, 104 U. S. 318, 1881.

courts have inclined to ascribe to the opinion a milder signification than the first sentence standing alone may appear to warrant.

The Circuit Court of Appeals for the third circuit has said that: "If, instead of an extract, the whole opinion be read, in connection with the authorities which are cited in it, it may be readily perceived that the substance of the doctrine intended to be affirmed, is that a combination, to be patentable, must produce a new and useful result as the product of the combination, and not a mere aggregate of several results, each the complete result of one of the combined elements." And that: "If it were essential to a valid patent for any combination whatever, that the mode of operation of every element included in the combination should be changed by each of the others, it would have been impossible to sustain several combination patents which have in fact been upheld, as, indeed, it would be difficult to conceive of any mechanical combination which would be both possible and patentable."[62]

And Judge McKENNA expressly declined, when strenuously urged by counsel so to do, to recognize as an established rule of law, that in all cases where the action of each of the combined devices remains its own individual action, there is no patentable combination.[63]

And while the language above quoted from Pickering *v.* McCullough has been often quoted since it was delivered,

[62] National Cash Register Co. *v.* American Cash Register Co., 53 F. R. 371, 1892.

[63] Bowers *v.* Von Schmidt, 63 F. R. 582, 1894; also, Pelton Water Wheel Co. *v.* Doble, 190 F. R. 760, 1911; Krell Auto Grand Piano Co. *v.* Story & Clark Co., 207 F. R. 946, 1913; International Mausoleum Co. *v.* Sievert, 213 F. R. 225, 1914; Railroad Supply Co. *v.* Hart Steel Co., 222 F. R. 261, 1915; New York Scaffolding Co. *v.* Whitney, 224 F. R. 452, 1915; E. E. Johnson Co. *v.* Grinnell Washing Machine Co. (citing many cases), 231 F. R. 988, 1916.

there is no case in which the severer doctrine of the first sentence of that language has been applied to defeat any patent or claim which could have endured the milder doctrine of the second of those sentences, or the milder doctrine held in the three last-mentioned cases. Indeed, the Supreme Court has shown its preference for the milder view, by substantially quoting the second sentence of Justice MATTHEWS,[64] while omitting the first sentence from all of its later decisions.

The law of this subject is well settled, and the dividing line between combinations and aggregations is well established. Every case must fall on one side or the other of that line, and no case can stand upon it. But the facts in particular cases, which will arise hereafter, will often make it difficult to determine upon which side of the line those cases respectively belong.[65] Such decisions may sometimes be made by direct analysis without extensive comparisons with precedents; but in other cases, reasoning by analogy from precedents may be helpful to just decisions, and therefore the Supreme Court cases, which have not been already mentioned as relevant to the subject, and also some others are collected by name in a note.[66]

[64] Brinkerhoff *v.* Aloe, 146 U. S. 516, 1892.

[65] Standard Oil Co. *v.* Southern Pacific Railroad Co., 48 F. R. 110, 1891.

[66] Tack Co. *v.* Mfg. Co., 109 U. S. 120, 1883; Bussey *v.* Mfg. Co., 110 U. S. 145, 1883; Phillips *v.* Detroit, 111 U. S. 607, 1883; Stephenson *v.* Railroad Co., 114 U. S. 158, 1884; Beecher Mfg. Co. *v.* Atwater Mfg. Co., 114 U. S. 523, 1884; Thatcher Heating Co. *v.* Burtis, 121 U. S. 293, 1886; Hendy *v.* Iron Works, 127 U. S. 375, 1887; Royer *v.* Roth, 132 U. S. 201, 1889; Fond Du Lac County *v.* May, 137 U. S. 407, 1890; Union Edge Setter Co. *v.* Keith, 139 U. S. 539, 1891; Adams *v.* Stamping Co., 141 U. S. 539, 1891; Wright *v.* Yuengling, 155 U. S. 53, 1894; Richards *v.* Elevator Co., 158 U. S. 301, 1895; and 159 U. S. 486, 1895; Office Specialty Mfg. Co. *v.* Fenton Metallic Mfg. Co., 174 U. S. 492, 1899; Anton *v.* Grier Bros.

§ 33. The rule of the last section does not state nor imply that all the parts of a patentable combination must act at the same time. The fact on that point is no criterion by means of which to distinguish invention from aggregation. Justice CURTIS, in a Circuit Court case,[67] stated the true doctrine on this subject, and stated it with marked lucidity, saying: "To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If those elementary parts are so arranged that the successive action of each contributes to produce some one practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole, a valid claim for thus combining those elementary parts may be made." And that view of the law has also been taken in more recent times.[68] Nor is it necessary that all the parts of a machine combination should co-operate all the time. "It is enough that, in the normal and progressive use of the machine, they do so some of the time."[69]

§ 34. It is not invention to duplicate one or more of the parts of a machine or a manufacture; unless the duplication causes a new mode of operation, or produces a new unitary result.

Co., 185 F. R. 796, 1911; Gould & Eberhardt *v.* Cincinnati Shafer Co., 194 F. R. 680, 1912; Sheffield Car Co. *v.* D'Arcy, 194 F. R. 686, 1912; Houser *v.* Starr, 203 F. R. 264, 1913; H. J. Heinz Co. *v.* Cohn, 207 F. R. 547, 1913; Ball *v.* Coker, 210 F. R. 278, 1913.

[67] Forbush *v.* Cook, 2 Fisher, 669, 1857.

[68] Holmes Alarm Tel. Co. *v.* Domestic Tel. Co., 42 F. R. 226, 1890; San Francisco Bridge Co. *v.* Keating, 68 F. R. 353, 1895; E. J. Manville Mach. Co. *v.* Excelsior Needle Co., 167 F. R. 538, 1909; Novelty Glass Mfg. Co. *v.* Brookfield, 170 F. R. 946, 1909.

[69] Sanders *v.* Hancock, 128 F. R. 424, 1904; National Tube Co. *v.* Aiken, 163 F. R. 254, 1908.

In Dunbar *v.* Myers [70] the patent was based on a circular sawmill adapted to sawing lumber into thin sheets to be used for the backs of picture-frames and mirrors. It differed from former machines used for the same purpose, mainly in the fact that it had a plate on each side of the saw for the purpose of expanding the saw kerf and thus keeping the sawed parts away from the sides of the saw, whereas earlier machines had such a plate only on one side of the saw. The two plates of the patented machine differed from each other in diameter and in one or two other respects, but the function performed by each of them was substantially identical with that performed by the other. The Supreme Court therefore held the claim which covered the additional plate to be void for want of invention.

In Slawson *v.* Grand Street R. R. Co.[71] the patented improvement consisted merely in putting an additional pane of glass in the fare-box of a street car, on the side next to the passengers, so that they could see into the box, as well as the driver, for whose use one pane of glass was already in the side of the box next to him. The Supreme Court said that the putting in of that additional pane of glass required no more invention than the putting of an additional window in a room opposite one already there.

Millner *v.* Voss [72] was decided by Judge BOND in Virginia. The patent involved, purported to cover an arrangement of furnaces and flues in a tobacco-curing house. It appeared to differ from prior arrangements only in the fact that each of the furnaces had two or more fire-places of

[70] Dunbar *v.* Myers, 94 U. S. 197, 1876.

[71] Slawson *v.* Grand Street R. R. Co., 107 U. S. 653, 1882.

[72] Millner *v.* Voss, 4 Hughes, 262, 1882.

different sizes on each side of a chimney, whereas former arrangements had but one. Judge BOND wittily said that, "Where one stove is found to be unequal to the heating of a room, to put another beside it, even though smaller, requires no invention." Mr. Millner's patent was therefore held to be void.

And the rule of this section has been applied in cases not so simple as those above mentioned;[73] and may be applied still more widely hereafter.

The first exception which belongs to the general rule of this section, is illustrated by the Parker water-wheel. Before the date of that invention, it was customary to place a single turbine, upon a vertical shaft, in such a way that the pressure of the water was partly exerted endwise of the shaft; and that pressure, in addition to the weight of the shaft, and of the wheel, had to be sustained by the bearing of the shaft. Parker placed two such wheels in a pair, face to face, on the same shaft, and the water entered between them, so that the downward pressure of the water upon one wheel was balanced by the upward pressure of the water upon the other wheel. In this case the duplication of the wheel caused a new mode of operation; and the patent was held to be valid.[74]

The second exception which belongs to the general rule of this section, is illustrated by the Goss printing-press. The distinguishing characteristic of that press, consists in mounting one prior "straight-run" web-perfecting printing-press, on top of another like press, so that the two printed webs can be brought flatwise together, without any edgewise movement of either. Thus a new uni-

[73] Electrical Accumulator Co. *v.* Julien Electric Co., 38 F. R. 138, 1889; Sugar Apparatus Co. *v.* Yaryan Mfg. Co., 43 F. R. 149, 1890.

[74] Parker *v.* Hulme, 1 Fisher, 44, 1849.

tary result was obtained; and the patent on the duplex press, was held to be valid.[75]

§ 35. It is not invention to omit one or more of the parts of a machine or manufacture, unless that omission causes a new mode of operation of the parts retained.

Stow *v.* Chicago,[76] decided by Judge BLODGETT, is the case which perhaps most exactly corresponds with this rule. The patent in that case covered a wood pavement like that of Nicholson, except that it omitted the board foundation and also the board strips of that earlier pavement. Judge BLODGETT held that those omissions constituted no invention, saying: "A reconstruction of a machine, so that a less number of parts will perform all the functions of the greater, may be invention of a high order, but the omission of a part, with a corresponding omission of function, so that the retained parts do just what they did before in the combination, cannot be other than a mere matter of judgment, depending upon whether it is desirable to have the machine do all, or less, than it did before." These views were also reiterated and reinforced by the same judge many years after they were stated and applied by him in the leading case.[77]

And the Supreme Court, when the latter case reached that tribunal, affirmed Judge BLODGETT's decision;[78] and has since rendered several decisions to the same effect.[79]

[75] Goss Printing-Press Co. *v.* Scott, 108 F. R. 260, 1901.

[76] Stow *v.* Chicago, 3 Bann. & Ard. 92, 1877.

[77] McClain *v.* Ortmayer, 33 F. R. 287, 1888; see Brown *v.* Huntington Piano Co., 134 F. R. 735, 1904, where omission of parts was held to constitute invention; also J. Stevens Arms & Tool Co. *v.* Davenport, 134 F. R. 869, 1905.

[78] McClain *v.* Ortmayer, 141 U. S. 425, 1891.

[79] Hat Pouncing Machine Co. *v.* Hedden, 148 U. S. 489, 1893; Giles *v.* Heysinger, 150 U. S. 632, 1893; Olin *v.* Timken, 155 U. S. 148, 1894; Richards *v.* Chase Elevator Co., 159 U. S. 477, 1895.

The exception which is stated in the general rule of this section was judicially applied, and is well illustrated, in a case decided by Judge NATHANIEL SHIPMAN, where invention was found to reside in so reorganizing a meat-mincing machine, as to dispense with some of its parts, and as to cause the parts retained to do the work of the original machine.[80]

And the same exception is illustrated in a later case, in the Circuit Court of Appeals for the second circuit.[81] And in a case which involved a process patent, the Supreme Court has decided that invention resided in omitting one of the steps in an old process, where the resulting new process was the result of careful and long-continued experiment, and where its utility was decidedly greater than that of the old process.[82] And Judge GILBERT has held that it is invention to omit, from a prior process, a step which those skilled in its performance considered essential, but which the inventor proved to be useless.[83] It is not invention, however, merely to make in one piece what was formerly made in two.[84]

§ 36. It is not invention to change a process, machine, manufacture or composition of matter, by substituting an equivalent for either of its parts; unless the new part, not

[80] Enterprise Mfg. Co. *v.* Sargent, 28 F. R. 187, 1886; Dunn Mfg. Co. *v.* Standard Computing Scale Co., 163 F. R. 521, 1908.

[81] Consolidated Store Service Co. *v.* Siegel-Cooper Co., 107 F. R. 716, 1901; Dececo Co. *v.* Gilchrist Co., 125 F. R. 293, 1903.

[82] Lawther *v.* Hamilton, 124 U. S. 1, 1887.

[83] Pacific Contracting Co. *v.* Bingham, 62 F. R. 283, 1894.

[84] General Electric Co. *v.* Yost Electric & Mfg. Co., 139 F. R. 568, 1905; Sheffield Car Co. *v.* D'Arcy, 194 F. R. 686, 1912; Milwaukee Co. *v.* Avery, 209 F. R. 616, 1913; Enterprise Mfg. Co. *v.* Wm. Shakespear Co., 220 F. R. 304, 1915; Pedersen *v.* Dundon, 220 F. R. 309, 1915; Stuber *v.* Central Brass and Stamping Co., 224 F. R. 712, 1915.

only performs the function of the part for which it was substituted, but also performs another function, by another mode of operation.[85]

What is signified in the patent law by the word "equivalent" is explained in detail in the chapter on infringement. The subject is of double importance, because it relates sometimes to the validity and sometimes to the infringement of patents. A. B. may contrive and may patent a process, machine, manufacture, or composition of matter, which differs from the prior patented invention of C. D. in one part only. If the courts decide that the new part inserted, is an equivalent of the old part omitted, then the contrivance of A. B. will be an infringement; and it will not be an invention, save in the exceptional case stated in the rule. If, on the other hand, the courts hold that the part inserted is not an equivalent of the old part omitted, then the machine of A. B. may be an invention, and it will not be an infringement of any claim covering the entire machine of C. D.

§ 37. It is not invention to combine old devices into a new machine or manufacture[86] or design,[87] without producing any new mode of operation.

[85] Smith *v.* Nichols, 21 Wallace, 119, 1874; Crouch *v.* Roemer, 103 U. S. 797, 1880; Cochrane *v.* Waterman, 1 McArthur's Patent Cases, 54, 1844; *In re* Hebbard, 1 McArthur's Patent Cases, 550, 1857; Perry *v.* Foundry Co., 12 F. R. 436, 1882; Celluloid Mfg. Co. *v.* Tower, 26 F. R. 451, 1885; Tiemann *v.* Kraatz, 85 F. R. 440, 1898; Grimes *v.* Allen, 102 F. R. 615, 1900; Westinghouse Electric & Mfg. Co. *v.* New England Granite Co., 103 F. R. 967, 1900; Ajax Metal Co. *v.* Brady Brass Co., 155 F. R. 409, 1907.

[86] Burt *v.* Evory, 133 U. S. 349, 1890; Florsheim *v.* Schilling, 137 U. S. 77, 1890; Morgan Envelope Co. *v.* Albany Paper Co., 40 F. R. 582, 1889; Mahon *v.* McGuire Mfg. Co., 51 F. R. 684, 1892.

See Section 26.

[87] General Gaslight Co. *v.* Matchless Mfg. Co., 129 F. R. 137, 1904; Graff, Washbourne & Dunn *v.* Webster, 195 F. R. 522, 1912.

This rule differs from that of Section 32 in not depending upon absence of joint mode of operation, but only upon antiquity of mode of operation. For this reason, while the invalidity of a patent, under the rule of Section 32, can be shown, where it exists, from the face of the patent; the invalidity of a patent under the rule of this section requires outside evidence for its establishment, and depends upon the state of the prior art for its applicability.[88] The meaning and scope of this rule, like all the primary rules of this chapter, require illustration and example for full comprehension; and such examples and illustrations are abundantly supplied by the adjudicated cases.

Stimpson *v.* Woodman [89] involved a patent for a machine for pebbling leather. It gave the leather the pebbled surface by means of a roller, which had the counterpart of that surface engraved or sunk on its periphery. The same kind of roller had previously been used for the same purpose by hand, and the same kind of machine had been used for compressing leather, except that the roller in it was smooth. The Supreme Court held that the change involved in putting the old figured hand roller in the place of the plain roller of the machine, involved no invention, and that the patent was void, if the facts were as stated.

Heald *v.* Rice [90] was based on a patent which covered a certain previously known straw-feeding attachment in combination with a certain previously known return-flue boiler, that straw-feeding attachment having been previously combined with a fire-box boiler. The utility of the return-flue boiler in that combination was much greater

[88] Brickill *v.* Hartford, 57 F. R. 217, 1893.

[89] Stimpson *v.* Woodman, 10 Wallace, 117, 1869.

[90] Heald *v.* Rice, 104 U. S. 754, 1881.

than that of the fire-box boiler, but the Supreme Court nevertheless held that there was no invention in the union of the former with the straw-feeding attachment.

Hall *v.* Macneale [91] shows the following state of facts. The patentee first made safe doors, the plates of which were held together by cored conical arbors, having screw threads cut on their exterior surfaces, and later he made other safe doors, the plates of which were held together by solid conical arbors which had no such screw threads as the cored conical arbors had, and he afterward obtained a patent for the combination of the plates of safe doors with solid conical arbors having such screw threads. The Supreme Court, speaking by Justice BLATCHFORD, said that "There was no invention in adding to the solid conical bolt the screw thread of the cored conical bolt."

Many Circuit Court cases also involve the doctrine of this section. In one such case [92] Justice BLATCHFORD held a patent to be void for want of invention, which covered a combination of a whip socket having an annular recess in it, with a flexible elastic ring held in that recess by its own elasticity, and provided on its inner edge with non-contiguous projections, separated so that they could not be pressed into contact with each other by the insertion of the whip handle into the ring. That decision was based on the fact that a prior whip socket having an annular recess, had been combined with a plain rubber ring in that recess, and on the further fact that flexible elastic rings constructed like those of the patent had been combined with a whip socket which had no annular recess, but which clamped that ring between the upper end of that socket and a cap above it. Judge JOHN LOWELL likewise decided

[91] Hall *v.* Macneale, 107 U. S. 90, 1882.

[92] Searls *v.* Merriam, 22 O. G. 1040, 1882.

three similar cases. In one of them [93] he held it to be no invention to give paper collars the same kind of surface that had theretofore been impressed upon other articles of paper. In another [94] he decided that embossed lines on writing paper being old, and ogee lines on other paper being old, there was no invention in embossing ogee lines on writing paper to serve as guides to the eye of the writer. In a third case [95] he held that soft base-balls having been covered with a double cover, and hard base-balls having been covered with a single cover, there was no invention in covering a hard base-ball with a double cover. And other still later cases illustrate the same doctrine.[96]

But while a new combination with an old mode of operation is not invention, an old combination with a new mode of operation may be an invention. The Supreme Court found that the Henry Adams corn sheller was an invention, and was patentable to him, although his father, Augustus Adams, had previously made corn shellers from which that of Henry differed only in reversing the direction of revolution of one of its parts. That part was the revolving beater, which Augustus Adams made to turn in the direc-

[93] Union Paper Collar Co. *v.* Leland, 1 Bann. & Ard. 491, 1874.

[94] Cone *v.* Morgan Envelope Co., 4 Bann. & Ard. 109, 1879.

[95] Mahn *v.* Harwood, 3 Bann. & Ard. 517, 1878.

[96] Yale Lock Mfg. Co. *v.* National Bank, 17 F. R. 533, 1883; Kaaps *v.* Hartung, 23 F. R. 187, 1885; Troy Machinery Co. *v.* Bunnell, 27 F. R. 810, 1886; Union Edge Setter Co. *v.* Keith, 31 F. R. 46, 1887; Washburn & Moen Mfg. Co. *v.* Barbed Wire Co., 33 F. R. 273, 1888; Low *v.* Stove Co., 36 F. R. 903, 1888; Rodebaugh *v.* Jackson, 37 F. R. 886, 1889; Royer *v.* Coupe, 38 F. R. 115, 1889; Royer *v.* Belting Co., 40 R. F. 160, 1889; Gates Iron Works *v.* Fraser, 42 F. R. 49, 1890; Abbott Machine Co. *v.* Bonn, 51 F. R. 223, 1892; Hunt *v.* Garsed, 51 F. R. 678, 1892; Electric Ry. Co. *v.* Jamaica R. R. Co., 61 F. R. 655, 1894; National Harrow Co. *v.* Westcott, 84 F. R. 671, 1898; Kursheedt Mfg. Co. *v.* Naday, 103 F. R. 948, 1900.

tion opposite to the desired motion of the ears of corn, expecting it to knock back any ear that might ride upon another, and thus tend to prevent choking the shelling devices. This mode of operation was not successful, and Henry Adams reversed the revolution of the beater so that its wings moved in the same direction as that of the ears of corn, and thus drove them forward into the shelling devices. The old combination, with that new mode of operation, was entirely successful, and the patent thereon was therefore held to be valid.[97]

A new combination, with a new mode of operation, may be invention; even if all the parts thereof are old, and even if the function of the combination, is also old.[98] As applied to designs a design patent may involve invention even though it is made up of features which are separately found in prior patents and articles of the same class.[99] There are several cases which contain dicta contrary to this rule; but those dicta must have resulted from incomplete thinking. In each of many arts, many patents have been granted, on a corresponding number of new combinations of old parts, for performing precisely the same function. The earlier of those combinations may be useful; but not useful enough, because not rapid enough.

[97] Keystone Mfg. Co. *v.* Adams, 151 U. S. 142, 1894.

[98] Deere & Co. *v.* Rock Island Plow Co., 84 F. R. 176, 1898; Hale & Kilburn Co. *v.* Oneonta, etc., Ry. Co., 124 F. R. 514, 1903; Western Electric Co. *v.* North Electric Co., 135 F. R. 79, 1905; Buchanan *v.* Perkins Electric, etc., Co., 135 F. R. 90, 1905; Lavigne Mfg. Co. *v.* John F. McCanna Co., 194 F. R. 112, 1911; E. H. Freeman Electric Co. *v.* Johns-Pratt Co., 204 F. R. 288, 1913; Proudfit Loose Leaf Co. *v.* Kalamazoo Loose Leaf Binder Co., 230 F. R. 120, 1915; Diamond Rubber Co. *v.* Consolidated Tire Co., 220 U. S. 428, 1911.

[99] Bush & Lane Piano Co. *v.* Becker Bros., 209 F. R. 233, 1913; Ashley *v.* Weeks-Numan Co., 220 F. R. 899, 1915; Grelle *v.* City of Eugene, 221 F. R. 68, 1915.

To deny the quality of invention, to all the later, different, and far superior combinations for doing the same thing, would be unreasonable, and unjust, and plainly contrary to Section 4886 of the Revised Statutes.

The same principles apply to process patents and a process consisting of a number of steps may be valid even though each of the steps was old.[100]

§ 38. It is not invention to use an old process,[101] machine,[102] manufacture,[103] composition of matter,[104] or design,[105] for a new and analogous purpose.

[100] Victor Talking Machine Co. *v.* American Graphophone Co., 189 F. R. 359, 1911.

[101] King *v.* Gallun, 109 U. S. 99, 1883; Miller *v.* Forec, 116 U. S. 27, 1885; Dreyfus *v.* Searle, 124 U. S. 63, 1887; Crescent Brewing Co. *v.* Gottfried, 128 U. S. 169, 1888; Marchand *v.* Emken, 132 U. S. 195, 1889; Lovell Mfg. Co. *v.* Cary, 147 U. S. 637, 1893; De Lamar *v.* De Lamar Mining Co., 110 F. R. 538, 1901; Farrell *v.* Boston & M. Copper & Silver Mining Co., 121 F. R. 841, 1903; Baker *v.* F. A. Duncombe Mfg. Co., 146 F. R. 744, 1906.

[102] Pennsylvania Railroad Co. *v.* Truck Co., 110 U. S. 494, 1883; Blake *v.* San Francisco, 113 U. S. 679, 1884; Hendy *v.* Iron Works, 127 U. S. 375, 1888; Aron *v.* Railway Co., 132 U. S. 84, 1889; Howe Machine Co. *v.* Needle Co., 134 U. S. 397, 1890; Fond Du Lac County *v.* May, 137 U. S. 406, 1890; Bussell Trimmer Co. *v.* Stevens, 137 U. S. 433, 1890; Wollensak *v.* Sargent, 151 U. S. 227, 1894; Gates Iron Works *v.* Fraser, 153 U. S. 347, 1894; Mast Foos & Co. *v.* Stover Mfg. Co., 177 U. S. 485, 1900; Lettelier *v.* Mann, 91 F. R. 914, 1899; American Well Works *v.* F. C. Austin Mfg. Co., 98 F. R. 994, 1900.

[103] Peters *v.* Active Mfg. Co., 129 U. S. 530, 1889; Peters *v.* Hanson, 129 U. S. 541, 1889; St. Germain *v.* Brunswick, 135 U. S. 230, 1890; Patent Clothing Co. *v.* Glover, 141 U. S. 563, 1891; Ansonia Co. *v.* Electrical Supply Co., 144 U. S. 18, 1892; Neptune Meter Co. *v.* National Meter Co., 127 F. R. 563, 1904; Morton Trust Co. *v.* American Car & Foundry Co., 169 F. R. 109, 1909; Lewis Construction Co. *v.* Semple, 177 F. R. 407, 1910.

[104] Browning *v.* Colorado Telephone Co., 61 F. R. 845, 1894.

[105] Smith *v.* Saddle Co., 148 U. S. 679, 1893; Cahoone Barnet Mfg. Co. *v.* Rubber & Celluloid

In Tucker *v.* Spalding [106] the patent covered a combination of a circular disk with removable saw teeth. There was a prior combination of a circular disk with removable cutters for the purpose of cutting tongues and grooves. The Supreme Court held that if what the latter combination did, was in its nature the same as sawing, and if its structure and its action suggested to the mind of the ordinarily skillful mechanic this double use to which it could be adapted without material change, then the combination of the patent was but a double use of the older combination, and was therefore not an invention, and not patentable.

Brown *v.* Piper[107] is a case in which the Supreme Court held that a patent for an apparatus for preserving fish and other articles in a close chamber by means of a freezing mixture having no contact with the atmosphere of the preserving chamber, covered nothing but a double use of the well known ice-cream freezer.

In Roberts *v.* Ryer [108] the same tribunal decided that to change the form and proportions of the compartments of a refrigerator, so as to utilize the descending instead of the ascending current of endlessly circulating air, was but a double use of that refrigerator.

More than forty other cases also embody the rule of this section, and apply it to particular new uses of old inventions.[108a]

Harness Co., 45 F. R. 582, 1891; Bevin Bros. Mfg. Co. *v.* Starr Bros. Bell Co., 114 F. R. 362, 1902; Phœnix Knitting Works *v.* Hygienic Fleeced Underwear Co., 194 F. R. 703, 1911.

[106] Tucker *v.* Spalding, 13 Wallace, 543, 1871; Conley *v.* King Bridge Co., 175 F. R. 79, 1909; F. E. Myers & Bro. *v.* Fairbanks, Morse & Co., 194 F. R. 971, 1912; Mallon *v.* Gregg & Co., 137 F. R. 68, 1908 (containing very clear statement of the principle).

[107] Brown *v.* Piper, 91 U. S. 37, 1875.

[108] Roberts *v.* Ryer, 91 U. S. 157, 1875.

[108a] Bean *v.* Smallwood, 2 Story, 408, 1843; Meyer *v.* Pritchard, 1

§ 39. It may be invention, to use an old process, machine, manufacture, composition of matter, or design, for

Bann. & Ard. 261, 1874; Adams *v.* Loft, 4 Bann. & Ard. 496, 1879; Royer *v.* Mfg. Co., 20 F. R. 853, 1884; Howe Machine Co. *v.* Needle Co., 21 F. R. 630, 1884; Spill *v.* Celluloid Mfg. Co., 21 F. R. 639, 1884; Celluloid Mfg. Co. *v.* Noyes, 25 F. R. 319, 1885; Aaron *v.* Manhattan Ry. Co., 26 F. R. 317, 1886; Marchand *v.* Emken, 26 F. R. 629, 1886; Shenfield *v.* Mfg. Co., 27 F. R. 808, 1886; Gloucester Isinglass & Glue Co. *v.* Le Page, 30 F. R. 370, 1887; Ansonia Brass & Copper Co. *v.* Electrical Supply Co., 32 F. R. 81, 1887; Acme Hay Harvesting Co. *v.* Martin, 33 F. R. 249, 1888; Mann's Car Co. *v.* Monarch Car Co., 34 F. R. 130, 1888; Babcock & Wilcox Co. *v.* Pioneer Iron Works, 34 F. R. 338, 1888; Rubber Harness Trimming Co. *v.* Rubber Comb Co., 35 F. R. 498, 1888; Hale & Kilbourn Mfg. Co. *v.* Hartford Mattress Co., 36 F. R. 762, 1888; Schmid *v.* Mfg. Co., 37 F. R. 345, 1889; Foster *v.* Crossin, 44 F. R. 62, 1890; American Road Machine Co. *v.* Pennock & Sharp Co., 45 F. R. 255, 1890; Watson *v.* Stevens, 47 F. R. 117, 1891; Whitcomb *v.* Coal Co., 47 F. R. 660, 1891; Zinsser *v.* Krueger, 48 F. R. 298, 1891; Buckingham *v.* Iron Co., 51 F. R. 236, 1892; Steiner Extinguisher Co. *v.* Adrian, 52 F. R. 733, 1892; Steiner Extinguisher Co. *v.* Adrian, 59 F. R. 132, 1893; Forgie *v.* Oil-Well Supply Co., 57 F. R. 747, 1893; Consolidated Bunging Apparatus Co. *v.* Brewing Co., 60 F. R. 93, 1894; Adams Electric Ry. Co. *v.* Lindell Ry. Co., 63 F. R. 990, 1894; Thomson-Houston Electric Co. *v.* Western Electric Co., 70 F. R. 96, 1895; Rose *v.* Hirsh, 71 F. R. 881, 1896; Schreiber & Sons Co. *v.* Grimm, 72 F. R. 671, 1896; Dunbar *v.* Eastern Elevating Co., 81 F. R. 201, 1897; Palmer *v.* John E. Brown Mfg. Co., 84 F. R. 454, 1897; Frederick R. Stearns Co. *v.* Russell, 85 F. R. 230, 1898; Capital Sheet Metal Co. *v.* Kinnear & Gager Co., 87 F. R. 333, 1898; Edison Electric Light Co. *v.* E. G. Bernard Co., 88 F. R. 276, 1898; Solvay Process Co. *v.* Michigan Alkali Co., 90 F. R. 818, 1898; Briggs *v.* Duell, 93 F. R. 974, 1899; Thomson-Houston Electric Co. *v.* Rahway E. L. & P. Co., 95 F. R. 660, 1899; Indiana Novelty Mfg. Co. *v.* Crocker Chair Co., 103 F. R. 496, 1900; Standard Caster & Wheel Co. *v.* Caster Socket Co., 113 F. R. 162, 1901; Johnson Co. *v.* Toledo Traction Co., 119 F. R. 892, 1903; Antisdel *v.* Bent, 122 F. R. 811, 1903; Bettendorf Pat-

a new and non-analogous purpose.[108b] The question whether a particular new use is analogous, or is non-analogous, to some old use of the same process or thing, is a question, the answer to which depends on the particular facts of the case in which it arises.[109] The decision of such a case can be reached by comparing the facts thereof, with the facts of some of the cases wherein the new uses were held to be analogous, and also with the facts of some of the cases, in which the new uses were held to be non-analogous, to the old uses of the same processes of things. The first of those classes of cases have already been cited,[110] and the second class are cited now.[111] Where a new use of

ents Co. *v.* J. R. Little Metal Wheel Co., 123 F. R. 433, 1903; Wm. B. Mershon & Co. *v.* Bay City Box & Lumber Co., 189 F. R. 741, 1910; O'Brien-Worthen Co. *v.* Steffel, 209 F. R. 847, 1913.

[108b] Potts *v.* Creager, 155 U. S. 608, 1895; Cash Register Co. *v.* Cash Indicator Co., 156 U. S. 502, 515, 1895; Hale & Kilburn Mfg. Co. *v.* Oneonta, etc., Ry., 124 F. R. 514, 1903.

[109] Briggs *v.* Duell, 93 F. R. 974, 1899; Herman *v.* Youngstown Car Mfg. Co., 191 F. R. 579, 1911.

[110] Section 38.

[111] Potts *v.* Creager, 155 U. S. 608, 1895; Cash Register Co. *v.* Cash Indicator Co., 156 U. S. 515, 1895; Rapid Service Store Ry. Co. *v.* Taylor, 43 F. R. 253, 1887; Mack *v.* Optical Mfg. Co., 52 F. R. 821, 1892; Brown Mfg. Co. *v.* Mast, 53 F. R. 585, 1892; Loewer *v.* Ford, 55 F. R. 62, 1893; New Departure Bell Co. *v.* Bevin Mfg. Co., 64 F. R. 863, 1894; Collins *v.* Gleason, 68 F. R. 915, 1895; Thomson-Houston Electric Co. *v.* Elmira & Horseheads Ry. Co., 69 F. R. 264, 1895; American Pneumatic Tool Co. *v.* Fisher, 69 F. R. 332, 1895; Hillborn *v.* Hale & Kilburn Mfg. Co., 69 F. R. 963, 1895; Taws *v.* Laughlins & Co., 70 F. R. 107, 1895; American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 70 F. R. 991, 1895; Tannage Patent Co. *v.* Zahn, 70 F. R. 1004, 1895; Thomson-Houston Electric Co. *v.* Winchester Ave. Ry. Co., 71 F. R. 195, 1895; Brownson *v.* Dodson-Fisher-Brockmann Co., 71 F. R. 517, 1895; A. B. Dick Co. *v.* Wichelman, 74 F. R. 799, 1895; Consolidated Car Heating Co. *v.* American Electric Heating Corp., 82 F. R. 997, 1897; Electric Smelting & Aluminum Co. *v.* Car-

an old thing consists in combining it with other things in a new organization, invention may be present in the combination, though absent from the separate parts.[112]

§ 40. Want of invention, if it really exists in a particular process or thing, can nearly always be detected by one or another of the foregoing rules. When a case arises to which neither of them applies, and relevant to which the mind remains in uncertainty, that uncertainty may be removed by means of the rule in Smith *v.* The Dental Vulcanite Co.[113] namely: When the other facts in the

borundum Co., 102 F. R. 631, 1900; National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 702, 1901; Diamond Drill & Machine Co. *v.* Kelly Bros., 120 F. R. 292, 1903; Forsythe *v.* Garlock, 142 F. R. 461, 1905; General Electric Co. *v.* Bullock Electric Mfg. Co., 152 F. R. 427, 1907; National Tube Co. *v.* Aiken, 163 F. R. 254, 1908; Wayne Mfg. Co. *v.* Benbow-Brammer Mfg. Co., 168 F. R. 271, 1909; Ramsay *v.* Lynn, 187 F. R. 218, 1909; H. J. Heinz Co. *v.* Cohn, 207 F. R. 547, 1913.

[112] Telephone Cases, 126 U. S. 572, 1887.

[113] Smith *v.* Dental Vulcanite Co., 93 U. S. 495, 1876; Hollister *v.* Benedict Mfg. Co., 113 U. S. 72, 1884; Adams *v.* Stamping Co., 141 U. S. 542, 1891; Magowan *v.* Belting Co., 141 U. S. 343, 1891; Gandy *v.* Belting Co., 143 U. S. 594, 1892; Barb Wire Patent, 143 U. S. 284, 1892; Sessions *v.* Romadka, 145 U. S. 44, 1892; Topliff *v.* Topliff, 145 U. S. 164, 1892; Hat Pouncing Machine Co. *v.* Hedden, 148 U. S. 489, 1893; Krementz *v.* Cottle Co., 148 U. S. 560, 1893; Duer *v.* Lock Co., 149 U. S. 223, 1893; Keystone Mfg. Co. *v.* Adams, 151 U. S. 143, 1894; Olin *v.* Timken, 155 U. S. 155, 1894; Potts *v.* Creager, 155 U. S. 609, 1895; Canda *v.* Michigan Malleable Iron Co., 124 F. R. 486, 1903; Julius King Optical Co. *v.* Billhoeffer, 124 F. R. 521, 1903; Brookfield *v.* Novelty Glass Co., 124 F. R. 551, 1903; Dececo Co. *v.* Gilchrist Co., 125 F. R. 293, 1903; Union Biscuit Co. *v.* Peters, 125 F. R. 601, 1903; Farmers' Mfg. Co. *v.* Spruks Mfg. Co., 127 F. R. 691, 1904; Warren Featherbone Co. *v.* American Featherbone Co., 133 F. R. 304, 1904; Milner Seating Co. *v.* Yesbera, 133 F. R. 916, 1904; Comptograph Co. *v.* Mechanical Accountant Co., 145 F. R. 331, 1903; Voightman *v.* Weiss & Ridge Cornice Co., 148 F. R. 848, 1903; Am. Caramel

case leave the question of invention in doubt, but only then,[114] the fact that a process or machine, or other subject of a patent, has gone into general use, and has displaced other processes or things which had previously been employed for analogous uses, is sufficient to turn the scale in favor of the existence of invention. The same rule holds in case of a design patent.[114a]

In fact it has been announced as a rule of law in the ninth circuit that it is proper to charge a jury that the fact that a device has gone into general use and has supplanted other devices used for a similar purpose is sufficient evidence of invention in the absence of evidence to show

Co. *v.* Thomas Mills & Bro., 149 F. R. 743, 1906; Consolidated Rubber Tire Co. *v.* Firestone T. & R. Co., 151 F. R. 237, 1907; Wagner Typewriter Co. *v.* Wyckoff, Seamans & Benedict, 151 F. R. 585, 1907; Am. Graphophone Co. *v.* Universal Talking Machine Co., 151 F. R. 595, 1907; St. Louis Street, etc., Co. *v.* Am. Street, etc., Co., 156 F. R. 574, 1907; O'Rourke Engineering Construction Co. *v.* M'Mullen, 160 F. R. 933, 1908; Morton *v.* Llewellyn, 164 F. R. 693, 1908; Electric Controller, etc., Co. *v.* Westinghouse Electric, etc., Co., 171 F. R. 83, 1909; Poole Bros. *v.* Isaac H. Blanchard Co., 204 F. R. 285, 1913; Stebler *v.* Riverside Heights Orange Growers Association, 205 F. R. 735, 1913; Barry *v.* Harpoon Castor Mfg. Co., 209 F. R. 207, 1913; Railroad Supply Co. *v.* Hart Steel Co., 222 F. R. 261, 1915; Cadillac Motor Car Co. *v.* Austin, 225 F. R. 983, 1915; Computing Scale Co. *v.* Automatic Scale Co., 204 F. R. 609, 1907; Diamond Rubber Co. *v.* Consolidated Tire Co., 220 U. S. 428, 1911.

See Section 26.

[114] Boss Mfg. Co. *v.* Thomas, 182 F. R. 811, 1910; Republic Rubber Co. *v.* G. & J. Tire Co., 212 F. R. 170, 1914; Hyde *v.* Minerals Separation, Ltd., 214 F. R. 100, 1914; Jackson Skirt & Novelty Co. *v.* Rosenbaum, 225 F. R. 531, 1915; Keene *v.* New Idea Spreader Co., 231 F. R. 701, 1916; Apple *v.* American Shoe Machinery & Tool Co., 232 F. R. 603, 1916.

[114a] Scofield *v.* Brown, 158 F. R. 305, 1907; Charles Boldt Co. *v.* Nivison-Weiskoff Co., 194 F. R. 871, 1912; Theodore W. Foster & Bros. Co. *v.* Tilden Thurber Co., 200 F. R. 54, 1912.

that the success was due to any other cause than that of the merits of the device.[115]

Conversely the fact that, although a large market has been created, the patent has had no commercial success in its field is entitled to weight on the question of invention.[116] But the fact that a machine or other article has been forced into extensive sale, by judicious advertising and business energy,[117] or by reason of the fact that it is made more cheaply than before,[118] or the fact that the patented invention constitutes only a part of the complete device,[119] will usually be sufficient to offset the showing made by the extensive use. Another strong circumstance to establish the quality of invention is the fact that the patentee has succeeded after others seeking the same result have failed.[120] And a closely analogous circumstance to prove invention is public acquiescence in the inventor's

[115] Sherman-Clay & Co. *v.* Searchlight Horn Co., 214 F. R. 86, 1914.

[116] Ideal Stopper Co. *v.* Crown Cork & Seal Co., 131 F. R. 244, 1904; Fielding *v.* Crouse-Hinds Electric Co., 148 F. R. 230, 1906; Adt *v.* Bay State Optical Co., 226 F. R. 925, 1915.

[117] McClain *v.* Ortmayer, 141 U. S. 427, 1891; Fox *v.* Perkins, 52 F. R. 213, 1892; Billings & Spencer Co. *v.* Van Wagoner & Williams Hardware Co., 98 F. R. 732, 1899; Stillwell *v.* McPherson, 207 F. R. 837, 1913.

See Diamond Rubber Co. *v.* Consolidated Tire Co., 220 U. S. 428, 1911; Epstein *v.* Dryfoos, 229 F. R. 756, 1914; Apple *v.* American Shoe Machinery & Tool Co., 232 F. R. 603, 1916; Johnson *v.* Lambert, 234 F. R. 886, 1916.

[118] General Electric Co. *v.* Yost Electric Mfg. Co., 131 F. R. 874, 1904; Heckin Co. *v.* Baker, 138 F. R. 63, 1905; Robins Conveying Belt Co. *v.* American Road Machine Co., 145 F. R. 923, 1906.

[119] De Mayo Coaling Co. *v.* Michener Stowage Co., 231 F. R. 736, 1916.

[120] Boyer *v.* Keller Tool Co., 127 F. R. 130, 1904; Albright *v.* Langfeld, 131 F. R. 473, 1904; Kotten *v.* Knight, 137 F. R. 597, 1905; American Caramel Co. *v.* Mills & Bro., 149 F. R. 743, 1906; Amer. Graphophone Co. *v.* Universal Talking Machine Co., 151 F. R. 595, 1907; Hall Signal Co.

rights over an extended period of time.[121] The same principles apply to design patents.[122]

§ 41. To change the form of a machine or manufacture is sometimes invention, and sometimes it is not invention. Where a change of form is within the domain of mere construction, it is not invention;[122a] but where it involves a change of mode of operation, or of function, or of result, it is invention, unless it is held to be otherwise in pursuance of some rule other than any that relates to form.[122b]

§ 41*a*. To change the proportions of a machine or manufacture will seldom, or never amount to invention; but it may be invention to change the proportions of the ingredients of a chemical combination, or other composition of matter. For example, Charles Goodyear invented soft vulcanized rubber, consisting of crude India rubber and sulphur in the proportion of one part of sulphur to five parts of rubber, mixed and subjected to a high degree of heat; and afterward Nelson Goodyear invented hard vulcanized rubber, consisting of equal, or comparatively

r. General Railway Signal Co., 169 F. R. 290, 1909; Novelty Glass Mfg. Co. *r.* Brookfield, 170 F. R. 946, 1909; New York Scaffolding Co. *r.* Whitney, 224 F. R. 452, 1915; Expanded Metal Co. *r.* Bradford, 214 U. S. 366, 1909.

[121] Keasby & Mattison Co. *r.* Philip Carey Mfg. Co., 139 F. R. 571, 1905; Mahony *r.* Malcolm, 143 F. R. 124, 1905.

[122] Scofield *r.* Browne, 158 F. R. 305, 1907.

[122a] J. J. Warner Co. *r.* Rosenblatt, 80 F. R. 542, 1897; National Harrow Co. *r.* Wescott, 84 F. R. 670, 1898.

[122b] Winans' *r.* Denmead, 15 Howard, 341, 1853; Davis *r.* Palmer, 2 Brock, 310, 1827; Mabie *r.* Haskell, 2 Cliff. 510, 1865; Aiken *r.* Dolan, 3 Fisher, 204, 1867; United States Bung Mfg. Co. *r.* Independent Bung Co., 31 F. R. 76, 1887; Electrical Accumulator Co. *r.* Julien Electric Co., 38 F. R. 143, 1889; Parker *r.* Dickinson, 38 F. R. 413, 1889; Hammond Buckle Co. *r.* Goodyear Rubber Co., 58 F. R. 413, 1893; Goldie *r.* Iron Co., 64 F. R. 237, 1894; Diamond State Iron Co. *r.* Goldie, 84 F. R. 975, 1898.

equal, parts of sulphur and crude rubber mixed and subjected to a high degree of heat. In this case, the change in proportion of the two materials resulted in two entirely distinct articles, having entirely distinct modes of operation and functions; and the later article was well held to be an invention.[123]

§ 42. A question of invention is a question of fact and not of law;[124] though it is to be determined by means of the rules of law set forth in this chapter. In applying those rules, patents are not held void for want of invention except where invention is clearly absent.[125] And invention is not clearly absent from the subject of a patent, however simple,[126] unless that subject was logically deducible from the prior art.[127]

§ 43. Every inventor or constructor is presumed by the law to have borrowed from another, whatever he produces that was actually first invented and constructed or used by that other, in the United States;[128] or was previously patented[129] or described in a printed publication[130] in

[123] Goodyear *v.* Vulcanite Co., 2 Fisher, 312, 1856.

[124] Poppenhusen *v.* Fakke, 5 Blatch. 49, 1862; Shuter *v.* Davis, 16 F. R. 564, 1883; Keene *v.* New Idea Spreader Co., 231 F. R. 701, 1916.

See Section 23.

[125] Reiter *v.* Jones, 35 F. R. 421, 1888; Marvin *v.* Gotshall, 36 F. R. 908, 1888; Hunt Bros. Fruit Packing Co. *v.* Cassidy, 53 F. R. 260, 1892.

[126] Weber Electric Co. *v.* National Gas & Electric Co., 204 F. R. 79, 1913; Ferro Concrete Construction Co. *v.* Concrete Steel Co., 206 F. R. 666, 1913; Expanded Metal Co. *v.* Bradford, 214 U. S. 366, 1909.

See Section 26.

[127] Williams *v.* American String Wrapper Co., 86 F. R. 641, 1898.

[128] Mast, Foos & Co. *v.* Stover Mfg. Co., 177 U. S. 493, 1900; Crompton *v.* Knowles, 7 F. R. 203, 1881; Williams *v.* Rubber Shoe Co., 54 F. R. 499, 1893; Allen *v.* Steele, 64 F. R. 795, 1894.

[129] Duer *v.* Lock Co., 149 U. S. 223, 1893.

[130] French *v.* Carter, 137 U. S. 239, 1890.

any country, after having been invented by another. But a mere application for a patent is not a part of the prior art, since an application is confidential and the public cannot be informed of its contents until a patent issues upon it.[131] It follows that such of the foregoing rules as involve an inquiry into the state of the art to which the thing or process in controversy pertains, may involve an inquiry into the date and the character of inventions which were in fact unknown to the patentee, when he produced that thing or process. Where those prior inventions are proved by prior patents, those patents are the record evidence of those parts of the prior art which they present. The rights under the later patent are subject to what this record evidence actually shows. To change this record, by making theoretical modifications of these earlier patents, would be the same in principle, as to change by interpolation or modification, any other evidence between the parties.[132]

§ 44. It was shown in Section 23 that patents are grantable for nothing but inventions. It is also the law that they can be granted only to those who invented the inventions they respectively cover, or to the assignees or legal representatives of those persons.[133] The subjects of assignments and devolutions of inventions and patents are explained in the chapter on title; but this is the proper place in which to treat the subjects of joint invention and sole invention.

[131] Sundh Electric Co. *v.* Interborough Rapid Transit Co., 198 F. R. 94, 1912; Vacuum Engineering Co. *v.* Dunn, 209 F. R. 219, 1913; Patents Selling & Exporting Co. *v.* Dunn, 213 F. R. 40, 1914; Mergenthaler Linotype Co. *v.* International Typesetting Machine Co., 229 F. R. 168, 1914.

[132] Western Electric Co. *v.* Home Tel. Co., 85 F. R. 656, 1898.

[133] Kennedy *v.* Hazelton, 128 U. S. 672, 1888; Eager *v.* United States, 35 Court of Claims, 567, 1900.

§ 45. If A. B. notices the need of a new machine to perform a particular function, and thereupon conceives the plan of such a machine, and proceeds to embody that plan in a successful working structure, and does all this without assistance from any other person, then it is clear that he is a sole inventor of that machine. If, on the other hand, C. D. notices the need of a new machine to perform a particular function, and calls the attention of E. F. to the matter, and a successful invention is, after many conversations between the two, embodied in a working machine constructed by the hands of both, then it may be that C. D. is the sole inventor, or it may be that E. F. is the sole inventor, or it may be that both are joint inventors of the machine they produce.

§ 46. Every machine, before it can be used, must be constructed as well as invented. If one man does all the inventing and another does all the constructing, the first is the sole inventor. But where two or more persons exercised their inventive faculties in the mutual production of a new and useful process, machine, manufacture, composition of matter, or design, those persons are joint inventors thereof, regardless of whether one, or part, or all, or neither of those persons constructed or helped to construct the first specimen of that thing, or performed or helped to perform the first instance of that process. And the fact that one of two joint inventors conceived the best thought that went into the invention does not invalidate the patent issued to them jointly, where the claim covers a series of steps or a number of elements in a combination.[134] Nor is a patent to joint inventors invalidated by the fact that one of them only first perceived the crude form of the elements and the possibility of their adapta-

[134] Quincy Mining Co. *v.* Krause, 151 F. R. 1012, 1907.

tion to accomplish the result desired.[135] In fact the conception of the entire device may be due to one, but if the other makes suggestions of practical value which assist in working out the main idea and making it operative, or contributes an independent part of the entire invention which helps to create the whole, he is a joint inventor even though his contribution be of minor importance.[136] But if the contribution is the subject of a separate claim in the patent such person is not a joint inventor.[137]

§ 47. The case of the Agawam Co. *v.* Jordan[138] is not inconsistent with what is advanced at the close of the last section. The defendant in that case did not set up a joint invention by the patentee and another, but set up an alleged sole invention by that other of the thing patented. The most that it could get its witness to testify, however, was that he suggested to the patentee one of the parts of one of the combinations secured by the patent, but that the patentee himself contrived the devices by means of which that part was incorporated into that combination. The patentee did not claim the suggested part as his invention, but only claimed several new combinations of old devices, and among the number, a combination of several things, one of which was said to have been suggested by the defendant's witness. In that state of facts it was clear that the latter was neither sole nor joint inventor of anything covered by the patent, and accord-

[135] Vrooman *v.* Penhallow, 179 F. R. 296, 1910.

[136] De Laski & Thropp C. W. T. Co. *v.* Wm. R. Thropp & Sons Co., 218 F. R. 458, 1914; Wm. R. Thropp & Sons Co. *v.* De Laski & Thropp, etc., Co., 226 F. R. 941, 1915.

[137] De Laski & Thropp C. W. T. Co. *v.* Wm. R. Thropp & Sons Co., 218 F. R. 458, 1914.

[138] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868. See also Lloyd *v.* Antisdel, 95 O. G. 1646, 1901.

ingly the Supreme Court so decided. Other authority to the same effect is found in the note.[139]

And the case of Forgie *v.* Oil Well Supply Co.[140] is also consistent with the views of the last section. In that case Forgie wanted a machine by means of which to exert great power horizontally, and it occurred to him that a lifting jack might be somehow used for the purpose. With this view he called on Barrett, who was the inventor and manufacturer of a particularly good lifting jack, and presented his case to him. Barrett thereupon caused his lifting jack to be reconstructed on a plan prescribed by himself, and thereafter made a number of the reconstructed tools for Forgie, who sold them to others who, like himself, wanted such a machine. They filled the vacant place by entirely successful operation, and became very popular. Thereupon Forgie applied for and obtained a patent on the reconstructed machine as his own invention; but the Circuit Court of Appeals for the third circuit held the patent to be void, because the machine had been produced by Barrett, and not by Forgie.

§ 48. In order to make an invention of importance, a considerable fund of general knowledge must be possessed by the inventor. Where that fund was acquired before he undertook his invention, it is easy to see that those who imparted it, are not thereby made joint inventors with him. Though not quite so obvious, it is equally certain that if, pending his experiments, an inventor seeks and secures one point of information from a scientist, and another from a machinist, and a third from a book, he is not, on account of having done the first two, any less a

[139] Novelty Glass Mfg. Co. *v.* Brookfield, 170 F. R. 946, 1909; Cheshire *v.* Cox Multi-Mailer Co., 229 F. R. 415, 1915.

[140] Forgie *v.* Oil Well Supply Co., 58 F. R. 871, 1893. See also Upson Nut Co. *v.* H. Chapin Sons Co., 117 F. R. 320, 1902.

sole inventor than he is on account of having done the last.[141]

§ 49. To constitute a man an inventor, it is not necessary for him to have skill enough to embody his invention in a working machine, or in a model, or even in a drawing. If a man furnishes all the ideas needed to produce the invention aimed at, he may avail himself of the mechanical skill of others, to practically embody or represent his contrivance, and still be the sole inventor thereof.[142] But it is not invention to conceive a result, and then employ another to produce that result.[143]

§ 50. Under the statute, only he or they who have invented a particular process or thing can lawfully receive a patent therefor, except in a case where the patentee is an assignee or legal representative of the true inventor or inventors. The patent must disclose the real inventor, and must be founded on his right as such. It follows that if one of two or more persons obtains a patent for a process or thing which was jointly invented by them all, that patent is not valid.[144] In such a case it is not true that the patentee invented the thing patented. He only helped to invent it. If he could have a valid patent for that thing or process, each of his co-inventors could do likewise, and each of several persons would possess the exclusive right to the same. As to each other, such a state of affairs among patentees would be impossible, and as to the public it would be intolerable.

[141] O'Reilly *v.* Morse, 15 Howard, 62, 1853.

[142] Sparkman *v.* Higgins, 1 Blatch. 209, 1846; Stearns *v.* Davis, 1 McArthur's Patent Cases,. 696, 1859; Smith *v.* Stewart, 55 F. R. 483, 1893; Huebel *v.* Barnard, 90 O. G. 751, 1899.

[143] Streat *v.* White, 35 F. R. 426, 1888.

[144] Arnold *v.* Bishop, 1 McArthur's Patent Cases, 36, 1841; H. T. Slemmer's Appeal, 58 Penn. 164, 1864; Newgold *v.* American Electrical Novelty & Mfg. Co., 108 F. R. 959, 1901.

It has been held, however, that where the application for such a patent has been assigned prior to issuance of the patent, the patent is not invalid by reason of each of joint inventorship on the ground that the patent, having been granted to an assignee, the reason for the rule does not exist.[145]

§ 51. So also, if several persons obtained a joint patent for what was invented solely by one of them, that patent is void.[146] And where several independent inventions are claimed by several different claims in a joint patent, and where one of those inventions was made by one of the joint applicants for the patent, without any co-operation of another joint applicant, the claim of the patent which covers that invention, is void.[147] There is no statutory authority to grant a patent or a claim to a non-inventor jointly with an inventor, without an assignment or a death, any more than there is to grant a patent to a non-inventor alone. But very convincing evidence is required to establish the invalidity of a patent on the ground stated in this section.[148]

[145] De Laski & Thropp C. W. T. Co. *v.* Wm. R. Thropp & Sons Co., 218 F. R. 458, 1914.

[146] Ransom *v.* New York, 1 Fisher, 269, 1856; Hotchkiss *v.* Greenwood, 4 McLean, 461, 1848; Barrett *v.* Hall, 1 Mason, 473, 1818; Royer *v.* Coupe, 29 F. R. 363, 1886; Stewart *v.* Tenk, 32 F. R. 665, 1887; Welsbach Light Co. *v.* Cosmopolitan Incandescent Gaslight Co., 100 F. R. 650, 1900.

[147] Heulings *v.* Reid, 58 F. R. 868, 1893; Welsbach Light Co. *v.* Cosmopolitan Gaslight Co., 104 F. R. 86, 1900.

[148] Button Fastener Co. *v.* Lucas, 28 F. R. 371, 1886; Schlicht & Field Co. *v.* Machine Co., 36 F. R. 585, 1888; Priestly *v.* Montague, 47 F. R. 651, 1891.

CHAPTER III

NOVELTY

52. Novelty necessary to patentability.
53. Novelty defined.
54. Not negatived by prior knowledge or use in a foreign country.
55. Not negatived by any private patent granted in a foreign country.
56. Prior printed publications.
57. Fullness of prior patents and printed publications.
58. Novelty not negatived by any prior abandoned application.
59. Qualification of the last rule.
60. Successful prior applications.
61. Novelty not negatived by any unpublished drawing, or prior model.
62. Novelty not negatived by anything substantially different.
63. Abandoned experiments.
64. Novelty in cases of designs.
65. Novelty not negatived by anything apparently similar, but comparatively useless.
66. Novelty not negatived by antiquity of parts.
67. Novelty not negatived by prior accidental and not recognized production.
68. Novelty not negatived by anything neither designed, nor apparently adapted, nor actually used for the same purpose.
69. Comparative dates.
70. Dates of patented inventions.
71. Novelty is negatived by one instance of prior knowledge and use in this country.
72. Novelty is negatived by prior existence and knowledge in this country.
73. Inventor's lack of knowledge of anticipating matter is immaterial.
74. Old thing derived from new source, is not novel.
75. Questions of novelty are questions of fact.
76. Burden of proof relevant to novelty, and want of novelty.

§ 52. THE statutes of the United States have always provided that anything to be patentable must be new. Statements that some things are not patentable because,

though new in a commercial sense, they are not new in the eye of the patent law, occur in a few reported cases. In every such instance, however, it would have been more accurate to say that some things are not patentable because, though new things, they are not invented things. Such things lack patentability not because they lack newness, but because they lack invention. The subject belongs to the domain of invention and not to that of novelty, and it is therefore treated in the second chapter of this book. With this explanation, it is not untrue nor misleading to say that whatever is really new, is new in the eye of the patent law. Therefore in order to negative novelty or as it is usually expressed, to "anticipate" an invention, it is necessary that all of the elements of the invention or their equivalents be found in one single description or structure where they do substantially the same work in substantially the same way.[1]

§ 53. Many things are new in the eye of the patent statutes, in addition to those things which are really new. The word has therefore a broader signification in those statutes than it has in the dictionaries; but that broader meaning is not capable of a short definition. Novelty is the conventional name of the statutory newness, but that name does not indicate the boundaries of the thing which it denotes. Those boundaries can be delineated only by enumerating and explaining those classes of facts which fall within them, but which fall without the boundaries of actual newness; those classes of facts which negative newness, but which do not negative novelty.

§ 54. Novelty is not negatived by prior knowledge and prior use in a foreign country, of the subject of a United

[1] Ottumwa Box Car Loader Co. *v.* Christy Box Car Loader Co., 215 F. R. 362, 1914; Ventilated Cushion & Spring Co. *v.* D'Arcy, 232 F. R. 468, 1916.

States patent; provided that subject had nowhere been patented to another, and nowhere been described in a printed publication when it was invented by the applicant for that patent.[2]

In former editions of this book, this rule was coupled with the additional proviso; that the patentee, at the time of making his application for a United States patent, believed himself to be the first inventor of the thing covered thereby.[3] That proviso was based on Section 4923 of the Revised Statutes; but it now appears that that section does not attend to any case in which a person, at the time of making his application for a patent, does not believe himself to be the first inventor of the thing covered thereby. On the contrary, that section leaves that class of cases to the operation of Section 4886 of the Revised Statutes. That section prescribes that a patent may be obtained by any person who has invented any subject of a patent, not known or used by others in this country, and not patented or described in any printed publication anywhere, before his invention thereof; but it does not couple that permission with the condition that the patentee, at the time of making his application for a patent, shall believe himself to be the first inventor of the thing covered thereby. Accordingly, it has now been held by the Circuit Court of Appeals for the first circuit, that novelty is not negatived by prior knowledge and use in a foreign country, of the subject of a United States patent, where that prior knowledge and use became known to the applicant for that patent, between the time when he made his invention, and the time when he made his application, and which information prevented him from believing him-

[2] Revised Statutes, Section 4886; Westinghouse Electric & Mfg. Co. *v.* Saranac Lake Electric Light Co., 108 F. R. 226, 1901.

[3] See third edition.

self, at the time of making his application, to be the first inventor of the invention covered thereby.[4]

Prior knowledge, possessed in this country, by some other person than the applicant for a particular patent, that the subject of that patent was known and used in some foreign country, before its invention here, is not such knowledge in this country as will negative the novelty of the patent covering that subject.[5] And this rule is not altered by the fact that one who acquired the prior knowledge of the foreign use came to the United States and disclosed his knowledge to others before the date of invention of the United States applicant,[5a] provided of course that the United States applicant did not learn of the disclosure before his date of conception. If such were the case he would not, of course, be an inventor of the thing disclosed.

§ 55. Novelty is not negatived by any United States patent which was issued after the contested invention was made, though applied for before that event,[6] nor by any prior private patent granted in any foreign country,[7] nor by any public patent granted in England, unless the latter was sealed before the person obtaining the Amer-

[4] American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 80 F. R. 398, 1897.

[5] Doyle *v.* Spalding, 19 F. R. 746, 1884.

[5a] Revised Statutes, Section 4923; Westinghouse Machine Co. *v.* General Electric Co., 207 F. R. 75, 1913. See Vacuum Engineering Co. *v.* Dunn, 209 F. R. 219, 1913.

[6] American Roll Paper Co. *v.* Weston, 45 F. R. 689, 1891; Diamond Drill & Machine Co. *v.* Kelly Bros., 120 F. R. 287, 1902; Anderson *v.* Collins, 122 F. R. 458, 1903; Eck *v.* Kutz, 132 F. R. 758, 1904 (but such a patent is admissible on the issue of priority of invention, ib.); Gray Telephone Pay Station Co. *v.* Baird Mfg. Co., 174 F. R. 417, 1909; Sundh Electric Co. *v.* Interborough Rapid Transit Co., 198 F. R. 94, 1912; Turner Brass Works *v.* Appliance Mfg. Co., 203 F. R. 1001, 1909; Vacuum Engineering Co. *v.* Dunn, 209 F. R. 219, 1913.

[7] Brooks *v.* Norcross, 2 Fisher, 661, 1851.

ican patent made the invention.[8] In neither of those three cases can it be truly said that the invention was antecedently patented, and therefore such transactions do not come within the statute. A French patent becomes effective to negative novelty as soon as it is sealed and enrolled, and it matters not for such a purpose that it was afterward permitted to lapse for non-payment of the annual fee, or was never printed, or that the device was not commercially successful.[9] The date of a German patent for purposes of anticipation is the "ausgegeben" or publication date.[10] But though novelty is not negatived by any United States patent, issued after the contested invention was made; novelty may be negatived by the prior art, as that art was shown in the specification or the drawing of the application for such a patent, if that application was filed in the Patent Office before the contested invention was made,[11] and provided that there had been prior to the invention of the patent in suit some actual use of the invention. For a mere application in the Patent Office, while it may be sufficient to prove the date of invention of a patent, cannot of itself be used to anticipate another patent as it is not of itself a part of the prior art.[11a] And novelty is negatived by a full description, in the specification of a prior public patent, of the subject cov-

[8] Siemens *v.* Sellers, 123 U. S. 283, 1887; Bliss *v.* Merrill, 33 F. R. 40, 1887; Electrical Accumulator Co. *v.* Julien Electric Co., 38 F. R. 141, 1889; American Roll Paper Co. *v.* Weston, 45 F. R. 691, 1891.

[9] Sirocco Engineering Co. *v.* B. F. Sturtevant Co., 220 F. R. 137, 1914.

[10] Merrell-Soule Co. *v.* Powdered Milk Co. of America, 222 F. R. 911, 1915.

[11] Millett *v.* Duell, 96 O. G. 1242, 1901.

[11] Thomson-Houston Electric Co. *v.* Ohio Brass Co., 130 F. R. 542, 1904; Alvord v. Smith & Watson Iron Works, 216 F. R. 150, 1914; Sundh Electric Co. *v.* Interborough Rapid Transit Co., 222 F. R. 334, 1911.

ered by an American patent, even though that subject was not covered by any of the claims of the prior patent, and therefore not patented to the prior inventor.[12] This rule must result from the fact that whatever is well described in a public patent is set forth to the public, whether it is claimed by the patentee or not. Indeed novelty is negatived by a prior patent which shows the invention in its drawings and describes it in its specification, but does not even state its use.[13]

§ 56. A printed publication is anything which is printed, and, without any injunction of secrecy, is distributed to any part of the public in any country; and such a publication may negative novelty.[14] Indeed, it seems reasonable that no actual distribution need occur, but that exposure of printed matter for sale is enough to constitute a printed publication. But the mere existence of a printed thing is not a printed publication,[15] though its deposit in a public library is.[16] A drawing, in a prior patent or printed publication, if its meaning is really undeniable, may negative novelty in a later patent on a machine, manufacture, or design.[17]

Inasmuch as drawings can generally give information which is as clear as that which words alone can give, relevant to the construction and character of a machine, or manufacture, or design, there is no reason for their not having the same effect on the novelty of subsequent pat-

[12] United States Bung Mfg. Co. *v.* Independent Bung Co., 31 F. R. 79, 1887; Saunders *v.* Allen, 60 F. R. 613, 1894.

[13] Stow *v.* Chicago, 104 U. S. 547, 1881.

[14] Rosenwasser *v.* Spieth, 129 U. S. 47, 1889.

[15] Britton *v.* White Mfg. Co., 61 F. R. 95, 1894.

[16] John Crossley & Sons *v.* Hogg, 83 F. R. 489, 1897.

[17] Millett *v.* Duell, 96 O. G. 1242, 1901; Britton *v.* White Mfg. Co., 61 F. R. 96, 1894; Keene *v.* New Idea Spreader Co., 231 F. R. 701, 1916.

ents. No injustice can result from this rule; because in order to have any effect on such novelty, drawings as well as words, must be able to endure the test stated in the next section.

§ 57. Novelty is not negatived by any prior patent or printed publication, unless the information contained therein, is full enough and precise enough to enable any person skilled in the art to which it relates, to perform the process or make the thing covered by the patent sought to be anticipated.[18] Testimony is not admissible to show that a prior patent or printed publication is out of conformity with the intention of its author,[19] or to explain an otherwise uninforming statement by evidence of some apparatus or article not in itself competent as an anticipation.[20] Nothing can be used for that purpose except what is disclosed on the face of the patents.[21] And expert testimony, though admissible on the question of the meaning of a prior patent or publication, is not weighty, unless it is supported by reasoning; and is not conclusive in court, even if so supported.[22] A prior patent or publication needs not to have been reduced to practice, or to be more than a paper proposition, in order to negative the novelty of a later patent,[23] even though the devices of the

[18] Seymour *v.* Osborne, 11 Wallace, 516, 1870; Cawood Patent, 94 U. S. 704, 1876; Downton *v.* Milling Co., 108 U. S. 466, 1882; Eames *v.* Andrews, 122 U. S. 66, 1886; Carnegie Steel Co. *v.* Cambria Iron Co., 89 F. R. 737, 1898; Westinghouse Electric & Mfg. Co. *v.* Saranac Lake Electric Light Co., 168 F. R. 227, 1901; Hess-Bright Mfg. Co. *v.* Standard Roller-Bearing Co., 177 F. R. 435, 1910.

[19] Badische Anilin & Soda Fabrik *v.* Kalle, 94 F. R. 168, 1899; and 104 F. R. 808, 1900.

[20] Loew Filter Co. *v.* German-American Filter Co., 164 F. R. 855, 1908; Naylor *v.* Alsop Process Co., 168 F. R. 911, 1909.

[21] Beckwith *v.* Malleable Iron Range Co., 174 F. R. 1001, 1910.

[22] Hanifen *v.* Godshalk Co., 84 F. R. 652, 1898.

[23] E. M. Miller Co. *v.* Meriden

prior patents be incapable of successful operation. It is sufficient if the prior patents embody the elements and disclose the principle of operation of the patent in suit.[24] This doctrine has been applied to the proof of anticipation by prior structures,[25] but its application to such cases is doubtful.[25a] And a difference, which consists of a mere omission of something which a skillful mechanic would supply, is not fatal to anticipation.[26] The phrase "skillful mechanic," as used in this connection, does not include mechanics who are skillful only in methods of servile imitation. It refers only to mechanics who know how to vary form without varying substance, and who, in constructing a machine or manufacture, from a printed description, or from Patent Office drawings, could readily, and would freely, alter proportions and change details in order to adapt the contrivance to a particular use, or in order to secure greater merit of workmanship for the thing constructed.

But prophetical suggestions and surmises in prior patents or publications, of what results can be achieved in a particular art, are not enough to negative the novelty of any patent on an invention which can accomplish that result.[26a]

Bronze Co., 80 F. R. 525, 1897; Ideal Stopper Co. *v.* Crown Cork & Seal Co., 131 F. R. 244, 1904. See Timolat *v.* Phila. Pneumatic Tool Co., 131 F. R. 257, 1904.

[24] Westinghouse Air Brake Co. *v.* Christensen Eng. Co., 128 F. R. 437, 1904; Van Epps *v.* United Box Board & Paper Co., 143 F. R. 869, 1906; Hyde *v.* Minerals Separation, Ltd., 214 F. R. 100, 1914. *Contra* Hale & Kilburn Mfg. Co. *v.* Oneonta, etc., Ry. Co., 129 F. R. 598, 1904.

[25] Merrimac Mattress Mfg. Co. *v.* Feldman, 133 F. R. 64, 1904.

See Section 67, *post*.

[25a] See Kings County, etc., Co. *v.* U. S. Consolidated, etc., Co., 182 F. R. 59, 1910.

[26] Chase *v.* Fillebrown, 58 F. R. 378, 1893; Ideal Stopper Co. *v.* Crown Cork & Seal Co., 131 F. R. 244, 1904.

[26a] Westinghouse Air-Brake Co. *v.* Great Northern Ry. Co., 88 F. R. 263, 1898; Asbestos Shingle,

And a claim for an article of manufacture may be anticipated by a prior patent or printed publication, which describes the article, without describing any process of making it; provided a knowledge of the article would teach a skillful mechanic some process of making it.[27]

§ 58. Novelty is not negatived by any prior abandoned application for a patent.[28] Abandoned applications for patents are not, by the statutes, made bars to patents to later applicants. They furnish no evidence that the processes or things they describe were ever made or used anywhere. Being only pen and ink representations of what may have existed only as mental conceptions of the men who put them upon paper, they do not prove that the processes or things which they depict were ever known in any country. Nor can they be classed among printed publications, for they are usually in writing, and are not published by the Patent Office. It is true that certified copies of abandoned applications are sometimes obtained, and may be published by those who obtain them, but such a publication will operate as of its own date, and not as of the date of the application.

§ 59. When there is evidence that he who made and abandoned an application for a patent, made also some effort to carry his invention into practical use, then that application is admissible in evidence to aid the court to determine the date and the nature of the invention which was sought to be embodied in a working form. If, however, upon the whole of the evidence, it appears that what the

etc., Co. *v.* H. W. Johns-Mansville Co., 184 F. R. 620, 1910.

[27] Cohn *v.* Corset Co., 96 U. S. 366, 1876; *In re* Schaeffer, 2 App. D. C. 8, 1893.

[28] Corn-planter Patent, 23 Wallace, 211, 1874; N. W. Extinguisher Co. *v.* Phila. Extinguisher Co., 1 Bann. & Ard. 177, 1874; Lyman Ventilating & Refrigerator Co. *v.* Lalor, 1 Bann. & Ard. 403, 1874; Interurban Ry. & Terminal Co. *v.* Westinghouse Electric & Mfg. Co., 186 F. R. 166, 1911.

inventor did, outside of his abandoned application, did not amount to enough to negative the novelty of a subsequent patent to a later inventor, then that abandoned application becomes immaterial to that issue.[29]

§ 60. Novelty is not negatived by any successful application for a patent, nor by any documents pertaining thereto, different from the letters patent issued in pursuance thereof.[30] When such an application, or such a document, is offered to prove the existence of something which is not shown by the letters patent themselves, the justice and propriety of this rule is apparent. But a successful application may be properly used to prove the date of the invention set forth therein, and claimed in the resulting patent.[31]

§ 61. Novelty of a machine or manufacture, is not negatived by any prior unpublished drawings, no matter how completely they may exhibit the patented invention,[32] nor by any prior model, no matter how fully it may coincide with the thing covered by the patent.[33] The reason of this rule is not stated with fullness in either of the cases which support it, but that reason is deducible from the statute and from the nature of drawings and of

[29] Corn-planter Patent, 23 Wallace, 211, 1874.

[30] Howes *v.* McNeal, 5 Bann. & Ard. 77, 1880.

[31] Westinghouse *v.* Gas Co., 43 F. R. 588, 1890; Barnes Co. *v.* Walworth Co., 51 F. R. 88, 1892; 60 F. R. 606, 1894; Sundh Electric Co. *v.* Interborough Rapid Transit Co., 198 F. R. 94, 1912.

[32] Ellithorp *v.* Robertson, 4 Blatch. 309, 1859; Draper *v.* Potomska Mills, 3 Bann. & Ard. 214, 1878; Detroit Lubricator Mfg. Co. *v.* Renchard, 9 F. R. 293, 1881; Odell *v.* Stout, 22 F. R. 159, 1884; Pennsylvania Diamond Drill Co. *v.* Simpson, 29 F. R. 291, 1886.

[33] Cahoon *v.* Ring, 1 Cliff. 593, 1861; Stainthorp *v.* Humiston, 4 Fisher, 107, 1864; Johnson *v.* McCullough, 4 Fisher, 170, 1870; Stillwell & Bierce Mfg. Co. *v.* The Cincinnati Gas Light & Coke Co., 1 Bann. & Ard. 610, 1875; Bowers *v.* Von Schmidt, 63 F. R. 577, 1894.

models. The statute provides, relevant to the newness of patentable machines and manufactures, that they shall not have been previously known or used by others in this country.[34] Now, it is clear that to use a model or a drawing is not to use the machine or manufacture which it represents; and it is equally obvious that to know a drawing or a model is not the same thing as knowing the article which that drawing or model more or less imperfectly pictures to the eye. It follows that neither of those things can negative the newness required by the statute. Nor is the statutory provision on this point lacking in good reasons to support it. Private drawings may be mislaid or hidden, so as to preclude all probability of the public ever deriving any benefit therefrom; and even if they are seen by several or by many, they are apt to be understood by few or by none. Models also are liable to be secluded from view and to suffer change, and thus to fail of propagation. Moreover, if a patent could be defeated by producing a model or a drawing to correspond therewith, and by testifying that it was made at some sufficiently remote point of time in the past, a strong temptation would be offered to perjury. Several considerations of public policy and of private right combine, therefore, to justify the rule of this section.

The word "model" it should be noted as used in the foregoing connection is used in the limited sense of a "pattern, a copy, a representation usually upon a reduced scale" and not in the sense of an operative structure identical with the structure of the patent.[35]

§ 62. Novelty is not negatived by anything not substantially identical with the subject of the patent, even though

[34] Revised Statutes, Section 4886.

[35] American Writing Machine Co. *v.* Wagner Typewriter Co., 151 F. R. 576, 1906.

the function of the prior process or thing was identical with that of the patented matter. This rule follows from the doctrine that a valid patent may be granted for a new means of producing an old result.[36] But substantial identity in some respects, is consistent with substantial difference in others. For novelty is negatived by a prior process or mechanism which included the subject of the patent, though it also included some other process or device. But if a patented process or thing possesses distinct and apparently important characteristics not possessed by any alleged anticipation, the defense for want of novelty will fail.[37] But a prior process or thing, which will not defeat a patent for want of novelty, may defeat it for want of invention.[38] It will do so wherever the observed difference corresponds in character with either of those differences between a patented process or thing, and the prior art, which in the second chapter of this book were shown not to constitute invention.

Several judicial opinions contain the statement that "That which infringes, if later, would anticipate, if earlier." But that epigrammatic formula is too broad, and those who have used it must have overlooked the distinction between primary patents and secondary patents. That which would infringe a primary patent, if later, may or may not anticipate that patent, if earlier. Where an inventor believes his invention to be primary, but thinks it may possibly turn out to be secondary, he may properly make his claim in a form that can be construed to fit his invention, in either event. Afterward, when he seeks to suppress a different but competing contrivance, as being

[36] O'Reilly *v.* Morse, 15 Howard, 62, 1853.

[37] Los Alamitos Sugar Co. *v.* Carroll, 173 F. R. 280, 1909.

[38] Untermeyer *v.* Freund, 58 F. R. 209, 1893; Universal Winding Co. *v.* Willimantic Linen Co., 82 F. R. 239, 1897.

an infringement of his claim, when broadly construed; that contrivance may be held to infringe, if later, while not being held to anticipate, if earlier. If the competing contrivance turns out to be earlier, it may have no effect upon his patent, except to relegate it to the secondary position in the art, and thus to limit its claim so narrowly that the competing contrivance does not infringe it. The distinction between primary patents and secondary patents is further developed in Sections 184, 359, 362 and 362a of this book.

§ 63. The rule of Section 62 will probably govern every case which justly comes within the doctrine that novelty is not negatived by any unsuccessful abandoned experiment. That rule is more comprehensive and reliable than that doctrine, because the latter is subject to such qualifications and explanations that its practical utility in deciding cases is but small. A thing may have been abandoned and still negative the novelty of a thing independently invented long after that abandonment.[39] Such will be the result if the earlier thing was identical with the later, and was used long enough to show that it would work.[39a]

If an experimental machine or manufacture was unsuccessful in the hands of its contriver, that fact must have been due either to one or more faults of principle, or to one or more faults of construction, or to one or more

[39] Waterman *v.* Thomson, 2 Fisher, 463, 1863; Shoup *v.* Henrici, 2 Bann. & Ard. 249, 1876; N. W. Extinguisher Co. *v.* Phila. Extinguisher Co., 1 Bann. & Ard. 177, 1874; McNish *v.* Everson, 5 Bann. & Ard. 484, 1880; Merrimac Mattress Mfg. Co. *v.* Feldman, 133 F. R. 64, 1904.

[39a] Gayler *v.* Wilder, 10 Howard, 477, 1850; Sayles *v.* Railway Co., 4 Fisher, 588, 1871; Stephenson *v.* Railroad Co., 14 F. R. 459, 1881; Electrical Accumulator Co. *v.* Julien Electric Co., 38 F. R. 131, 1889; American Roll Paper Co. *v.* Weston, 51 F. R. 240, 1892.

faults of each of these kinds. If partly or wholly due to any fault of principle, that very fact shows that the unsuccessful device was substantially different from subsequent successful patented things. For that reason alone it would have failed to negative the novelty of those things, even if it had not been unsuccessful. If, on the other hand, a prior device was unsuccessful merely because its construction was weak, it is far from certain that it will not be held to negative the novelty of subsequent devices identical with it in plan, mode of operation, and function.[39b]

The truth, therefore, appears to be that an unsuccessful abandoned experimental machine or manufacture, may possibly negative the novelty of a later invention, and that where it fails to have that effect, it would have failed, even if it had been neither unsuccessful nor abandoned. Novelty is to be ascribed to new things, regardless of whether old and different things were successful or unsuccessful, abandoned or not abandoned. Novelty is to be denied to old things, regardless of the accidents which caused earlier specimens of the same things to fail to operate, or caused their use to be discontinued.

But a court is not called upon to struggle to decipher an anticipation, in the unfinished work and the surmises of earlier students of the same subject.[39c] And unsuccessful abandoned experiments in processes, cannot be properly held to constitute prior uses of successful patented processes in the same art.[40]

[39b] Pickering *v.* McCullough, 104 U. S. 319, 1881; Merrimac Mattress Mfg. Co. *v.* Feldman, 133 F. R. 64, 1904; Van Epps *v.* United Box Board & Paper Co., 143 F. R. 869, 1906.

[39c] American Graphophone *v.* Leeds, 87 F. R. 877, 1898; Warren Bros. *v.* City of Owosso, 166 F. R. 309, 1909.

[40] Westinghouse Electric & Mfg. Co. *v.* Beacon Lamp Co., 95 F. R. 464, 1899; Consolidated Contract Co. *v.* Hassam Paving Co., 227 F. R. 436, 1915.

§ 64. A design as in the case of any other subject-matter of a patent must possess novelty.[41] The question of the novelty of a design, is to be determined by the comparative appearance of that design and of prior designs, in the eyes of average observers, and not by their comparative appearance in the eyes of experts making analytical inspections.[42] Nor is the novelty of any design negatived by the fact that all of its features can be collected out of scattered prior designs.[43]

§ 65. Novelty is not negatived by anything beneficially incapable of the function of the subject of the patent, even though apparently similar thereto.[44]

In Morey *v.* Lockwood[45] the prior Mau syringe was set up to negative the novelty of the syringe of Dr. Davidson and his brother. The latter is the well-known soft rubber bulb apparatus. The former was exactly like it, except that the central part was a soft rubber cylinder with metallic heads, instead of a soft rubber bulb. The theoretical mode of operation of the two syringes was the same. But the Mau apparatus proved to be of no practical value, and very few specimens of it were ever sold; because the metallic heads of the cylinder strongly counteracted the

[41] Weisgerber *v.* Clowney, 131 F. R. 477, 1904.

[42] Perry *v.* Starrett, 3 Bann. & Ard. 489, 1878; Foster *v.* Crossin, 23 F. R. 402, 1885; Kraus *v.* Fitzpatrick, 34 F. R. 39, 1888; Redway *v.* Ohio Stove Co., 38 F. R. 583, 1889; Paine *v.* Snowden, 46 F. R. 189, 1891; Anderson *v.* Saint, 46 F. R. 763, 1891.

[43] Simpson *v.* Davis, 12 F. R. 144, 1882; Stearns *v.* Beard, 46 F. R. 193, 1891; New York Belting Co. *v.* New Jersey Car Spring Co., 48 F. R. 557, 1891; Matthews & Willard Mfg. Co. *v.* American Lamp & Brass Co., 103 F. R. 639, 1900.

[44] Crown Cork & Seal Co. *v.* Ideal Stopper Co., 123 F. R. 666, 1903; Kirchberger *v.* Am. Acetylene Co., 124 F. R. 764, 1903; Dececo Co. *v.* Gilchrist Co., 125 F. R. 293, 1903; Farmers' Mfg. Co. *v.* Spruks Mfg. Co., 127 F. R. 691, 1904.

[45] Morey *v.* Lockwood, 8 Wallace, 230, 1868.

user's efforts to compress its rubber walls. For these reasons, the Supreme Court held that it did not negative the novelty of the Davidson patent.

The Wood Finishing Co. *v.* Hooper[46] is a case the patent involved in which, covered the employment of finely powdered flint, quartz, or feldspar, mixed with oil or other fluent substance, for the purpose of filling the pores of the surface of wood. A prior patent had been granted for the employment of silicious marl or infusorial earth for the same purpose. It was shown that all five of these substances consisted mainly of silica, but that the first three differed from the last two in being non-absorbent instead of porous, and in consisting of angular instead of rounded particles. These two differences made the first three substances very valuable for wood-filling, whereas the others were not valuable for that purpose. Judge NATHANIEL SHIPMAN, therefore, decided that the prior patent did not negative the novelty of the later one.

Matheson *v.* Campbell[47] is a case which was based on a patent for a black dye stuff named "naphthol-black." A prior dye stuff, named "azo-black," though made from a different starting material, was chemically identical with "naphthol-black," or was at least chemically equivalent thereto. But the two dye stuffs were not beneficially alike; because "azo-black" rubbed off very badly, and "naphthol-black" was so superior thereto, that the latter dye stuff entirely superseded the former, in actual use. Judge TOWNSEND, therefore, decided that "azo-black" did not negative the novelty of "naphthol-black."

It has been held that novelty is not negatived by a prior patent which describes a device which is so similar to the patent in suit as to constitute an equivalent, if

[46] Bridgeport Wood Finishing Co. *v.* Hooper, 5 F. R. 63, 1880.

[47] Matheson *v.* Campbell, 77 F. R. 282, 1896.

the prior patent gives no indication that the inventor of the prior patent contemplated that his invention is capable of the use of the patent in suit.[48]

§ 66. Novelty is not negatived by antiquity of parts.[49] This rule follows from the doctrine which allows patents for new combinations of old elements or ingredients. In such cases the whole is different from the sum of all its parts, much as this printed page is different from what it would be, if the same words were arranged in alphabetical order.

If, however, a new assemblage of old things amounts only to aggregation and not to combination,[50] or if it results in no new mode of operation,[51] the patent which covers it will be void for want of invention, though not void for want of novelty.

§ 67. Novelty is not negatived by any prior accidental occurrence or production, the character and function of which was not recognized until later than the date of the patented invention sought to be anticipated thereby.[52]

[48] Canda *v.* Michigan Malleable Iron Co., 124 F. R. 486, 1903.

[49] Bates *v.* Coe, 98 U. S. 48, 1878; Imhaeuser *v.* Buerk, 101 U. S. 660, 1879; Parks *v.* Booth, 102 U. S. 104, 1880; Cantrell *v.* Wallick, 117 U. S. 694, 1885; Johnson *v.* Railroad Co., 33 F. R. 501, 1888; Consolidated Roller Mill Co. *v.* Coombs, 39 F. R. 32, 1889; Bryam *v.* Friedberger, 82 O. G. 1420, 1897; A. B. Dick Co. *v.* Belke & Wagner Co., 86 F. R. 149, 1897; German-American Filter Co. *v.* Erdrich, 98 F. R. 308, 1899; Goss Printing-Press Co. *v.* Scott, 103 F. R. 657, 1900; Lowrie *v.* Meldrum, 124 F. R. 761, 1904; St. Louis Street, etc., Co. *v.* Am. Street, etc., Co., 156 F. R. 574, 1907.

[50] Adams *v.* Stamping Co., 141 U. S. 542, 1891; Campbell *v.* Bailey, 45 F. R. 565, 1891.

[51] Burt *v.* Evory, 133 U. S. 349, 1890; Florsheim *v.* Schilling, 137 U. S. 77, 1890.

[52] Tilghman *v.* Proctor, 102 U. S. 711, 1880; Ransom *v.* New York, 1 Fisher, 256, 1856; Pelton *v.* Waters, 1 Bann. & Ard. 399, 1874; Andrews *v.* Carman, 2 Bann. & Ard. 277, 1876; Pittsburgh Reduction Co. *v.* Cowles Electric

The reason of this rule arises out of that point of patent law policy, which rewards persons for teaching the public how to perform processes and construct things which nobody else in the United States knew how to perform or to construct, and relevant to which no adequate information could be found in any public patent or printed publication anywhere in the world. But novelty is negatived by proof of prior use of a process, where that use was understood in point of method, though not correctly understood in point of result.[53]

§ 68. Novelty is not negatived by anything which was neither designed, nor apparently adapted, nor actually used, to perform the function of the thing covered by the patent, though it might have been made to perform that function by means not substantially different from that of the patented invention; [54] but this rule cannot govern any

Co., 55 F. R. 307, 1893; Chase *v.* Fillebrown, 58 F. R. 377, 1893; Taylor Burner Co. *v.* Diamond, 72 F. R. 184, 1896; National Harrow Co. *v.* Quick, 74 F. R. 240, 1896; Wickelman *v.* A. B. Dick Co., 88 F. R. 266, 1898; Tannage Patent Co. *v.* Donallan, 93 F. R. 821, 1899; Ajax Metal Co. *v.* Brady Brass Co., 155 F. R. 409, 1907; Western Tube Co. *v.* Rainer, 156 F. R. 49, 1907; Hillard *v.* Fisher Book Typewriter Co., 159 F. R. 439, 1908; Edison Electric Lighting Co. *v.* Novelty Incandescent Lamp Co., 167 F. R. 977, 1909; Anthracite Separator Co. *v.* Pollock, 175 F. R. 108, 1909; Byerly *v.* Barber Asphalt Paving Co., 230 F. R. 995, 1916; Toch *v.* Zibell Damp Resisting Paint Co., 233 F. R. 993, 1916.

[53] Dorlon *v.* Guie, 25 F. R. 816, 1885; Schultz Belting Co. *v.* Belting Co., 40 F. R. 156, 1889.

[54] Topliff *v.* Topliff, 145 U. S. 161, 1892; Carnegie Steel Co. *v.* Cambria Iron Co., 185 U. S. 422, 1902; Knickerbocker Co. *v.* Rogers, 61 F. R. 297, 1894; Kinnear & Sager Co. *v.* Capital Sheet-Metal Co., 81 F. R. 492, 1897; Bowers *v.* San Francisco Bridge Co., 91 F. R. 410, 1898; National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 702, 1901; United Shirt & Collar Co. *v.* Beattie, 149 F. R. 736, 1906; Am. Sales Book Co. *v.* Carter-Crume Co., 150 F. R. 333, 1906.

case which lacks either of the circumstances upon which it is founded, for negation of novelty is not averted by the mere fact that the inventor of the prior device did not design it to perform the function of the patented device,[55] nor by the mere fact that its ability to perform that function is not apparent to every beholder, nor by the mere fact that it was never actually used for that purpose, nor by any two of these facts combined. The same principle applies to a prior patent. Although a prior patent may incidentally show a similar arrangement of parts, if that arrangement is not claimed nor designed to perform the function of the later patent, it cannot act as an anticipation.[56]

§ 69. Novelty is not negatived by anything which was invented, patented, or described in a printed publication prior to the granting of the patent sought to be anticipated, or even prior to the application therefor, unless the anticipating event occurred prior to the date of the invention secured by that patent.[57]

One apparent exception to this rule has been stated in one leading case by the Supreme Court,[58] and indorsed in another good precedent by Judge McKinnon.[59] In those instances it was said that where two patents for the

[55] Leonard *v.* Lovell, 29 F. R. 315, 1886.

[56] Gray Telephone Pay Station Co. *v.* Baird Mfg. Co., 174 F. R. 417, 1909; Beckwith *v.* Malleable Iron Range Co., 174 F. R. 1001, 1910; Kryptok Co. *v.* Stead Lens Co., 207 F. R. 85, 1913; A. R. Mosler & Co. *v.* Lurie, 209 F. R. 364, 1913; Munising Paper Co. *v.* American Sulphite Pulp Co., 228 F. R. 700, 1915.

[57] Cochrane *v.* Deener, 94 U. S. 791, 1876; Elizabeth *v.* Pavement Co., 97 U. S. 130, 1877; Clark Thread Co. *v.* Willimantic Linen Co., 140 U. S. 486, 1891; Pacific Cable Ry. Co. *v.* Butte City Ry. Co., 58 F. R. 422, 1893; Western Electric Co. *v.* Capital Telephone & Telegraph Co., 86 F. R. 771, 1898.

[58] Suffolk Co. *v.* Hayden, 3 Wallace, 315, 1865.

[59] McMillin *v.* Rees, 5 Bann. & Ard. 269, 1880.

same invention are granted to the same inventor, the last, and not the first, is void, even where the last was first applied for. The exception is, however, only apparent, because the patent last applied for is as much entitled to date from the making of the invention as the other. The date of invention assignable to the two patents being exactly the same, the first patent will negative the novelty of the last, regardless of which was first applied for. The saying of the Supreme Court in this matter is not inconsistent with the rule that, in the absence of other evidence of the dates of invention, the first application must be taken to represent the first invention,[60] because the fact of an identical inventor is evidence in such cases that the date of invention was identical.

And the saying in Suffolk Co. *v.* Hayden has no applicability to a case where an inventor takes out a patent which describes and claims what was described but not claimed in a prior patent of his, because in such a case the prior patent is not for the same invention as the last.[61]

Where several patents are granted to one inventor on different inventions in the same art, the dates of their applications, instead of the dates of the patents themselves, in the absence of evidence of the dates of the making of the respective inventions, determine the relative rank of those patents in the art to which they belong.[62]

When two applications by the same inventor are filed

[60] Pope Mfg. Co. *v.* Gormully Mfg. Co., 144 U. S. 244, 1892; Pennington *v.* King, 7 F. R. 462, 1881.

[61] Suffolk Co. *v.* Hayden, 3 Wallace, 315, 1865; Singer *v.* Braunsdorf, 7 Blatch. 521, 1870; Wheeler *v.* McCormick, 11 Blatch. 334, 1873; Graham *v.* McCormick, 5 Bann. & Ard. 244, 1880; McMillin *v.* Rees, 5 Bann. & Ard. 269, 1880; Graham *v.* Mfg. Co., 11 F. R. 138, 1880; Victor Talking Machine Co. *v.* American Graphaphone Co., 140 F. R. 860, 1905.

[62] Barbed Wire Patent, 143 U. S. 281, 1892.

contemporaneously, one with generic claims and the other with specific claims, the inventor does not lose his right to the generic patent because it happens to issue after the issuance of the specific patent.[63] The same rule applies when the patentee files an application for an improvement after he files an application for his generic invention and the patent on the former is issued first, and it is not necessary for the application of the rule that there be in the later application an express disclaimer of the invention of the first.[64]

It has been held that where several applications describe the same structure or process, but no one of the issued patents claims any invention claimed in any of the others and they are all pending at the same time, the applications and patents cannot be used to anticipate each other.[65]

In the absence of proof as to the date of actual invention, the date of issue is proof of that fact, and where two patents are issued on the same day, the earlier in number must be regarded as the senior and earlier in publication.[66] The exception to this rule is where the patentee had an application pending for the later numbered patent at the time when the earlier numbered patent issued, both of which patents were the result of a divided application.[67]

§ 70. In order to apply the rule of the last section, it is necessary to fix the date of the invention covered by the patent sought to be anticipated. In cases where the invention may be exhibited in a drawing or in a model, it

[63] Badische Anilin & Soda Fabrik *v.* Klipstein & Co., 125 F. R. 543, 1903.

[64] Cleveland Foundry Co. *v.* Detroit Vapor Stove Co., 131 F. R. 853, 1904.

[65] Century Electric Co. *v.* Westinghouse Electric & Mfg. Co., 191 F. R. 350, 1911.

[66] Crown Cork & Seal Co. *v.* Standard Stopper Co., 136 F. R. 841, 1905.

[67] Benjamin Electric Mfg. Co. *v.* Dale Co., 158 F. R. 617, 1907.

will date from the completion of such a model or such a drawing as is sufficiently plain to enable those skilled in the art to understand the invention;[68] and patented inventions always date at least as early as the dates of the execution of the original applications therefor, provided the original applications exhibit the inventions with the above-mentioned extent of sufficiency.[69] In cases where a patented invention was explained in words, without the aid of any model or any drawing, it will date from the completion of such a written description as would teach others how to make and use the invention described. In cases where the inventor makes a specimen of the thing invented, before he makes any model, or drawing, or written description to represent that thing, the invention will date from the completion of that specimen. Perfection is not necessary to such a specimen in order to entitle it to such an effect. Substantial completeness is enough.[70] And where the distinguishing characteristic of an invention, consists of a composition of matter capable of considerable variations in its ingredient, the invention will date from the time when the first of those variations was reduced to successful practice.[71]

No invention ought to date from any day wherein it

[68] Loom Co. *v.* Higgins, 105 U. S. 594, 1881; Deering *v.* Harvester Works, 155 U. S. 298, 1894; Heath *v.* Hildreth, 1 McArthur's Patent Cases, 24, 1841; Perry *v.* Cornell, 1 McArthur's Patent Cases, 78, 1847; Farley *v.* Steam Gauge Co., 1 McArthur's Patent Cases, 621, 1859; Hubel *v.* Dick, 28 F. R. 139, 1886; Von Schmidt *v.* Bowers, 80 F. R. 140, 1897; Moline Plow Co. *v.* Rock Island Plow Co., 212 F. R. 727, 1914.

[69] Kearney *v.* Railroad Co., 32 F. R. 322, 1887; National Machine Co. *v.* Brown, 36 F. R. 321, 1888.

[70] National Cash Register Co. *v.* Store Service Co., 60 F. R. 603, 1894; Coffee *v.* Guerrant, 68 O. G. 279, 1894.

[71] American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 80 F. R. 401, 1897.

had no existence or representation outside of the mind of the inventor, no matter how clear or how complete his mental conception of its character and mode of operation may have been. Mental conceptions are not useful inventions until they are so embodied that the world could use them after the deaths of the persons who conceived them.[72] To allow inventions to take date from mental conceptions, would strongly tempt inventors to commit perjury in order to appear to anticipate real anticipations of their patents.

Whether an oral description given by the inventor to another, of a subsequently patented invention, can give that invention a date earlier than that to which it would otherwise be entitled, depends upon the nature of the invention and the capacity of the hearer to understand it and remember it. Where an invention is abstruse or is complicated, and where it is not certain that the hearer understood it and has remembered it well enough to communicate it to the world in case of the inventor's death, the invention ought not to date from such a description.[73] But where it is shown that the person to whom such an oral description was given, understood it completely, and has remembered it accurately, a patented invention may date back to that oral description.[74] In such cases it is

[72] Clark Thread Co. *v.* Willimantic Linen Co., 140 U. S. 489, 1891; Voightman *v.* Perkinson, 138 F. R. 56, 1905; Killeen *v.* Buffalo Furnace Co., 140 F. R. 33, 1905; Corrington *v.* Westinghouse Air Brake Co., 178 F. R. 711, 1910.

[73] Stephens *v.* Salisbury, 1 McArthur's Patent Cases, 385, 1855,

[74] Philadelphia & Trenton R. R. *v.* Stimpson, 14 Peters, 448, 1840; Stephens *v.* Salisbury, 1 McArthur's Patent Cases, 385, 1855; Hill *v.* Dunklee, 1 McArthur's Patent Cases, 483, 1857; Davidson *v.* Lewis, 1 McArthur's Patent Cases, 599, 1858; McCormick Machine Co. *v.* Harvester Works, 42 F. R. 153, 1890; Merrow *v.* Shoemaker, 59 F. R. 122, 1893; Westinghouse Electric & Mfg. Co. *v.* Roberts, 125 F. R. 6, 1903.

not necessary that all the mechanical details shall be expressed in the disclosure or even have been thought out.[75] The reason for allowing a patented invention to date back to an oral or a written description, or to a drawing or a model, as the case may be, while an unpatented invention, which is set up to negative the novelty of a patented invention, is not allowed to date back to either of those things, resides in the fact that those things are incipient in their nature, and in the principle that an invention which is ultimately developed and given to the world in a patent, ought equitably to date from such an incipiency, while the rights of a patentee ought not to be impaired by a similar incipiency which was never developed into a patent.[76]

When a patent is questioned in point of novelty, and when that question depends upon the date of the invention claimed in that patent, it is not material whether the event, which constituted that invention, occurred in the United States or in some other country.[77]

For a very complete discussion of the whole subject of priority of date of invention as between two inventors, see the opinion of Judge COLT in Automatic Weighing Machine Co. *v.* Pneumatic Scale Corporation.[78]

§ 71. Novelty is negatived by prior knowledge and use in this country, by even a single person, of the thing patented.[79] This rules applies even to cases where that knowl-

[75] Westinghouse Electric & Mfg. Co. *v.* Stanley Inst. Co., 133 F. R. 167, 1904.

[76] Bowers *v.* Von Schmidt, 63 F. R. 577, 1894.

[77] Hanifen *v.* E. H. Godshalk Co., 78 F. R. 811, 1896; Hanifen *v.* Price, 96 F. R. 441, 1899; Welsbach Light Co. *v.* American Incandescent Lamp Co., 98 F. R. 616, 1899; Badische Anilin & Soda Fabrik *v.* Klipstein & Co., 125 F. R. 543, 1903.

[78] Automatic Weighing Machine Co. *v.* Pneumatic Scale Corporation, 166 F. R. 288, 1909; McCreery Engineering Co. *v.* Mass. Fan Co , 195 F. R. 498, 1912.

[79] Coffin *v.* Ogden, 18 Wallace, 120, 1873; Brush *v.* Condit, 132

edge and use were purposely kept secret; [80] and it applies no matter whether or not the prior structure was used.[81]

In Gayler *v.* Wilder [82] the Supreme Court announced an exception to this rule, but in a later case it intimated a denial, or at least a doubt, of the validity of that exception.[83] According to the opinion of a majority of the court in the first case, a single instance of prior knowledge and use will not negative novelty, if that use had ceased when the patent was granted, and that knowledge was forgotten until called to mind by the reinvention. A recent case holds that under the rule of Gayler *v.* Wilder the prior use must be so far understood and practiced or persisted in as to become an established fact, accessible to the public and contributing definitely to the sum of human knowledge, and that the prior use must have been of an article which was complete and capable of producing the result accomplished by the patented article and not merely one which by modification could be made to perform the same function.[84] The latter proposition is a reiteration of one of the doctrines of Coffin *v.* Ogden.

This is the doctrine that novelty is not negatived by a forgotten art, even if that art is remembered again by one who formerly knew it, when his mind is prompted by new knowledge of its reinvention by another. This doctrine is

U. S. 39, 1889; Toch *v.* Zibbell Damp Resisting Paint Co., 231 F. R. 711, 1916.

[80] Reed *v.* Cutter, 1 Story, 598, 1841.

[81] Bedford *v.* Hunt, 1 Mason, 301, 1817; Rich *v.* Lippincott, 2 Fisher, 2, 1853; Imperial Brass Mfg. Co. *v.* Nelson, 194 F. R. 165, 1912.

[82] Gayler *v.* Wilder, 10 Howard, 477, 1850.

[83] Coffin *v.* Ogden, 18 Wallace, 125, 1873; for a further discussion of the doctrine and as to what is meant by the word "forgotten" in connection with it see Buser *v.* Novelty Tufting Machine Co., 151 F. R. 478, 1907.

[84] Diamond Patent Co. *v.* S. E. Carr Co., 217 F. R. 400, 1914.

applicable to a forgotten "art" or "process"; because a process is intangible and exists only while its constituent acts are being performed. But the doctrine of lost or forgotten arts is not applicable to a machine or a manufacture, which still exists in its entirety, and can be found whenever it is diligently sought, and can be understood whenever it is intelligently inspected. In Gayler *v.* Wilder, the doctrine was applied to the use of gypsum in the spaces between the walls of iron safes. But the doctrine is not applicable to any composition of matter, which is patentable independent of any environment, and which still exists, and can be found and identified, when it is sought and analyzed. Nor is the doctrine applicable to a design, which may have remained forgotten and unseen in a book in a library for many years, but which can be found by regular searching, and can be appreciated when it is found.

§ 72. Novelty is also negatived by evidence that even one specimen of the thing patented, existed and was known in this country prior to its invention by the patentee, even though it was not used prior to that time.[85] This rule results from the statute which provides that things, in order to be patentable, must not have been known or used by others in this country.[86] If, however, the identity of the patented and the prior article can be known only by actual use, and if the prior article never was actually used till after the date of the patented invention, then its prior existence will not negative novelty.[87] In that case though

[85] Corn-Planter Patent, 23 Wallace, 220, 1874; Parker *v.* Ferguson, 1 Blatch. 408, 1849; Pitts *v.* Wemple, 2 Fisher, 15, 1855; Stitt *v.* Railroad Co., 22 F. R. 650, 1884; Universal Winding Co. *v.* Willimantic Linen Co., 82 F. R. 239, 1897; see Lincoln Iron Works *v.* M'Whirter Co., 142 F. R. 967, 1905.

[86] Revised Statutes, Section 4886.

[87] Sayles *v.* Railway Co., 4 Fisher, 588, 1871; Stitt *v.*

its existence was known prior to the invention of the patented thing, it was not known to be what the patented thing afterward was. Knowledge, in order to negative novelty, must include knowledge of the character, as well as knowledge of the existence, of the prior thing.

§ 73. Negation of novelty is not averted by the fact that the inventor had no knowledge of the anticipating matter when he made the invention covered by the patent.[88] The patent laws do not reward people for producing things which, though new to them, are old to others in this country.

§ 74. Negation of novelty in a machine is not averted by the fact that the anticipating machine operated upon a different material.[89] And negation of novelty in a manufacture or a composition of matter, is not averted by the fact that the anticipating substance was made by a different process, or derived from a different source, from that which produced the patented substance; for it does not make an old thing new to derive it from a new and unexpected quarter [90] or to make it by a new and improved method.[91]

§ 75. Questions of novelty are questions of fact.[92] This point is very obvious, except in cases where the prior thing is a patent or printed publication. In those cases it may be supposed that questions of novelty are questions of law

Railroad Co., 22 F. R. 650, 1884.

[88] Derby *v.* Thompson, 146 U. S. 481, 1892; Many *v.* Sizer, 1 Fisher, 19, 1849; New Departure Bell Co. *v.* Bevin Bros. Mfg. Co., 73 F. R. 476, 1896; Universal Winding Co. *v.* Willimantic Linen Co., 82 F. R. 240, 1897.

[89] United States Peg Wood, S. & L. B. Co. *v.* B. F. Sturtevant Co., 122 F. R. 472, 1903.

[90] Cochrane *v.* Badische Anilin & Soda Fabrik, 111 U. S. 311, 1883; Badische Anilin & Soda Fabrik *v.* Cummins, 4 Bann. & Ard. 490, 1879.

[91] Cottle *v.* Krementz, 31 F. R. 42, 1887; Societe Fabriquer de Produits Chimiques, etc., *v.* Geo. Lueders & Co., 135 F. R. 102, 1904.

[92] Battin *v.* Taggert, 17 Howard, 74, 1854; Turrill *v.* Railroad Co., 1 Wallace, 491, 1863.

arising on the construction of documents. The point has, however, been settled by the Supreme Court, in a case involving the consideration of a prior patent, and bearing with equal logical force upon a prior printed publication.[93] In that case it was held that the question whether the novelty of a patent is negatived by a prior patent, depends not upon the construction of the latter, but depends rather upon the outward embodiment of the terms contained in the latter document; and that such outward embodiment is to be properly sought, like the explanation of latent ambiguities arising from the description of external things, by evidence *in pais*. The court accordingly indorsed the proposition that such questions belong to the province of evidence, and not to that of construction; and said that even where no testimony is required to explain the terms of art or the description contained in the respective documents, the question is still to be treated as a question of fact.

§ 76. The burden of proof of a want of novelty rests upon him who avers it, and every reasonable doubt should be resolved against him.[94] Novelty can only be negatived by proof which puts the fact beyond a reasonable doubt.[95] But such proof can be made with less evi-

[93] Bischoff *v.* Wethered, 9 Wallace, 812, 1869.

[94] Coffin *v.* Ogden, 18 Wallace, 120, 1873; Cantrell *v.* Wallick, 117 U. S. 696, 1885; Parham *v.* Machine Co., 4 Fisher, 482, 1871; Webster Loom Co. *v.* Higgins, 4 Bann. & Ard. 88, 1879; Shirley *v.* Sanderson, 8 F. R. 908, 1881; Green *v.* French, 11 F. R. 591, 1882; Duffy *v.* Reynolds, 24 F. R. 858, 1885; Dreyfus *v.* Schneider, 25 F. R. 481, 1885; Osborne *v.* Glazier, 31 F. R. 404, 1887; Smith *v.* Davis, 34 F. R. 785, 1888; Howard *v.* Plow Works, 35 F. R. 745, 1888; Pacific Cable Ry. Co. *v.* Butte City Ry. Co., 55 F. R. 764, 1893; Kinnear & Gager Co. *v.* Capital Sheet-Metal Co., 81 F. R. 492, 1897; Cleveland Foundry Co. *v.* Kauffman, 135 F. R. 360, 1905.

[95] Barbed Wire Patent, 143 U. S. 284, 1892; Wood *v.* Mill Co., 4 Fisher, 560, 1871; Hawes *v.* Antisdel, 2 Bann. & Ard. 10, 1875; Bignall *v.* Harvey, 5 Bann. & Ard.

dence, where anticipation is probable, than where it is less to be expected.[96] And testimony of want of novelty is not overthrown, by *prima facie* improbability that has been explained away;[97] or by innocent errors on collateral points;[98] or even by impeaching a principal witness, if his testimony is shown to be true by other evidence, which his bad character could not vitiate.[99] The unsupported oral testimony of one witness is seldom strong enough to negative the novelty of the patent beyond a reasonable doubt;[100] and the oral testimony of many witnesses, if unsupported by any evidence consisting of documents or things, must be very reasonable and very strong, in order to negative novelty.[101] This rule of reasonable

636, 1880; Worswick Mfg. Co. *v.* Buffalo, 20 F. R. 126, 1884; Thayer *v.* Hart, 20 F. R. 694, 1884; Everest *v.* Oil Co., 20 F. R. 849, 1884; American Bell Telephone Co. *v.* People's Telephone Co., 22 F. R. 313, 1884; McDonald *v.* Whitney, 24 F. R. 600, 1885; Jennings *v.* Kibbe, 24 F. R. 698, 1885; Wetherell *v.* Keith, 27 F. R. 364, 1886; Hobbie *v.* Smith, 27 F. R. 659, 1886; Cohansey Mfg. Co. *v.* Wharton, 28 F. R. 191, 1886; American Bell Telephone Co. *v.* Globe Telephone Co., 31 F. R. 733, 1887; Hunt Bros. Packing Co. *v.* Cassidy, 53 F. R. 260, 1893; Dodge *v.* Post, 76 F. R. 809, 1896; National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 703, 1901; Young *v.* Wolfe, 120 F. R. 959, 1903.

[96] Lee *v.* Upson & Hart Co., 43 F. R. 670, 1890; Rochester Coach Lace Co. *v.* Schaefer, 46 F. R. 190, 1891; Moline Plow Co. *v.* Parlin & Orendorff Co., 84 F. R. 351, 1897.

[97] Parlin & Orendorff Co. *v.* Moline Plow Co., 89 F. R. 330, 1898; Diamond Drill & Machine Co. *v.* Kelly Bros., 120 F. R. 299, 1903.

[98] Simmonds *v.* Morrison, 44 F. R. 762, 1891.

[99] Olin *v.* Timken, 155 U. S. 152, 1894; Timken *v.* Olin, 37 F. R. 207, 1888.

[100] Bowman *v.* DeGraw, 60 F. R. 911, 1894; Mast, Foos & Co. *v.* Dempster Mill Mfg. Co., 82 F. R. 332, 1897; Single Track Overhead Ry. Mfg. Co. *v.* Roden, 98 F. R. 619, 1895; Peters *v.* Union Biscuit Co., 120 F. R. 683, 1903.

[101] Barbed Wire Patent, 143 U. S. 284, 1892; Deering *v.* Harvester Works, 155 U. S. 300, 1894;

doubt applies where the question of novelty depends upon the identity of the patented thing or process with the alleged anticipation; as well as where that question depends upon the existence or the priority of the latter.[102]

Where an anticipating fact prior to the date of a patent is proved beyond reasonable doubt, the burden is shifted to the plaintiff to prove, by convincing preponderance of evidence, that his invention was made still earlier than that fact occurred; and if the plaintiff does not introduce enough evidence to strongly outweigh whatever evidence is introduced to the contrary, the patent must be held to be void for want of novelty.[103]

The "reasonable doubt" rule is not however entirely approved. In fact the degree of proof required to establish anticipation or prior invention is stated in such

American Roll Paper Co. *v.* Weston, 59 F. R. 150, 1893; Knickerbocker Co. *v.* Rogers, 61 F. R. 297, 1894; Pratt *v.* Sencenbaugh, 64 F. R. 781, 1893; Campbell Printing-Press Co. *v.* Marden, 64 F. R. 785, 1894; Wickes *v.* Lockwood, 65 F. R. 611, 1895; Singer Mfg. Co. *v.* Schenck, 68 F. R. 194, 1895; Rodwell *v.* V. F. Tuckfarber Co., 127 F. R. 138, 1903; Parker *v.* Stebler, 177 F. R. 210, 1910; Emerson & Norris Co. *v.* Simpson Bros. Corporation, 202 F. R. 747, 1913; Greenwald Bros. *v.* LaVogue Petticoat Co., 226 F. R. 448, 1915.

[102] Pittsburgh Reduction Co. *v.* Aluminum Co., 55 F. R. 308, 1892; Simonds Rolling-Mach. Co. *v.* Hathorn Mfg. Co., 93 F. R. 961, 1899.

[103] Clark Thread Co. *v.* Willimantic Linen Co., 140 U. S. 492, 1891; Caverly *v.* Deere, 52 F. R. 760, 1892; Curtis *v.* Atlanta Street Railway Co., 56 F. R. 600, 1892; Simmons *v.* Standard Oil Co., 62 F. R. 930, 1894; Ecaubert *v.* Appleton, 67 F. R. 925, 1895; Brooks *v.* Sacks, 81 F. R. 405, 1897; Rogers *v.* Fitch, 81 F. R. 962, 1897; Wheaton *v.* Kendall, 85 F. R. 672, 1898; Westinghouse Electric & Mfg. Co. *v.* Saranac Lake Electric Light Co., 108 F. R. 222, 1901; Westinghouse Electric & Mfg. Co. *v.* Catskill Illuminating & Power Co., 121 F. R. 832, 1903; Sacks *v.* Kufferle, 127 F. R. 569, 1904; (beyond reasonable doubt) Columbus Chain Co. *v.* Standard Chain Co., 148 F. R. 622, 1906; New England Motor Co. *v.* B. F.

various ways that it is useless to attempt to make a general statement. It may be remarked that if the "reasonable doubt" rule is applied in its full sense as the phrase is used in criminal law it has few parallels in civil jurisprudence. Some of the phrases used in defining the degree of proof required are found in the note.[104]

An exception to the "reasonable doubt" rule has been noted in the ninth circuit where the question of priority of invention is at issue, and where at the time of issuance of the patent in suit the defendant had an application pending for the same invention and no interference was declared.[105]

Sturtevant Co., 150 F. R. 131, 1906; (if not with equal certainty, then to the satisfaction of the court) Consolidated Ry., etc., Co. *v.* Adams & Westlake Co., 161 F. R. 343, 1908; Torrey *v.* Hancock, 184 F. R. 61, 1910.

[104] (Full, unequivocal and convincing) Westinghouse Elec. & Mfg. Co. *v.* Stanley Inst. Co., 133 F. R. 167, 1904; (proofs which satisfy the court, ib.); (beyond reasonable doubt) Pettibone, etc., Co. *v.* Pennsylvania Steel Co., 133 F. R. 730, 1904; (strong and convincing) Chisholm *v.* Fleming, 133 F. R. 924, 1905; (clear and satisfactory, no hard and fast rule) Sipp Electric, etc., Co. *v.* Atwood-Morrison Co., 142 F. R. 149, 1905; (beyond fair doubt) Bradley *v.* Eccles, 144 F. R. 90, 1906; (exceptionally clear and convincing) United F. R. 736, 1906; (beyond reasonable doubt) Buser *v.* Novelty Tufting Machine Co., 151 F. R. 478, 1907; (so clear and satisfactory as to convince the court beyond a reasonable doubt) Parker *v.* Stebler, 177 F. R. 210, 1910; T. B. Wood's Sons Co. *v.* Valley Iron Works, 191 F. R. 196, 1911; DeLavel Separator Co. *v.* Iowa Dairy Separator Co., 194 F. R. 423, 1912; (clear, unequivocal and convincing) DeLaski & Thropp, etc., Co. *v.* Fisk Rubber Co., 203 F. R. 986, 1913; (beyond a reasonable doubt) H. J. Heinz Co. *v.* Cohn, 207 F. R. 547, 1913; (a high degree of proof) Wright *v.* Brownlee, 212 F. R. 157, 1914; Drum *v.* Turner, 219 F. R. 188, 1914.

[105] Wilson & Willard Mfg. Co. *v.* Bole, 227 F. R. 607, 1915.

CHAPTER IV

UTILITY

77. Utility necessary to patentability.
78. Utility is negatived by lack of function.
79. Perfection not necessary to utility.
80. Beauty has utility.
81. Utility is negatived where function is evil.
82. Functions which sometimes work evil, and sometimes work good.
83. Functions thought by some to be good, and by others to be bad.
84. Good functions in wrong places.
85. Doubts relevant to utility to be solved against infringers.

§ 77. THE useful arts are those that Congress is authorized by the Constitution to promote, and accordingly the statute includes utility among the qualities which a process or a thing must have in order to be patentable.[1] To possess utility, a thing or a process must be capable of producing a result, and that result must be a good result. Both these elements inhere in the meaning of the word; and they are so distinct as to require separate explanation.

Utility, whatever the term may have meant in connection with design patents, is not required under the present law as an element of a design patent.[2] And although the present statute has dropped the specific provision that a new shape or configuration given to an article shall be patentable as a design, a design which consists merely of a new and ornamental shape is still patentable

[1] Revised Statutes, Section 4886.

[2] Revised Statutes, Sec. 4929, as amended May 9, 1902, Ch. 783, 32 Stat. 193; H. S. Earle Mfg. Co. *v.* Clark & Parsons Co., 154 F. R. 851, 1907.

as such.[3] And although the word useful has also been dropped from the statute it is not necessary that the thing to be patented shall have been made for the sole purpose of ornament.[4]

§ 78. Utility is absent from all processes and devices which cannot be used to perform their specified functions, and patents for such subjects are therefore void.[5] This rule applies even to cases in which, by simply adding new elements to useless contrivances, highly useful inventions are produced.

In Burrall *v.* Jewett,[6] the patent covered the cylinder of a threshing-machine, having rows of teeth inserted in its convex surface and revolving within a barrel which had no teeth. The contrivance was confessedly useless. After the patent for it was granted, the patentee, or some other person, by simply inserting rows of teeth in the concave surface of the barrel, produced the successful threshing-machine, which has everywhere succeeded the ancient flail. The law applicable to these facts was stated by Chancellor WALWORTH in the following terms: "The patent is void if the machine will not answer the purpose for which it was intended, without some addition, adjustment, or alteration, which the mechanic who is to construct it must introduce of his own invention, and which had not been invented or discovered by the patentee at the time his patent was issued."

In Bliss *v.* Brooklyn[7] the patent covered a certain hose-

[3] Theodore W. Foster & Bro. Co. *v.* Tilden-Thurber Co., 200 F. R. 54, 1912.

[4] Mygatt *v.* Schaffer, 218 F. R. 827, 1914; Ashley *v.* Weeks-Numan Co., 220 F. R. 899, 1915.

[5] Coupe *v.* Royer, 155 U. S. 574, 1895; Bliss *v.* Brooklyn, 10 Blatch. 522, 1873; Rowe *v.* Blanchard, 18 Wisconsin, 465, 1864; Carter Machine Co. *v.* Hanes, 70 F. R. 864, 1895.

[6] Burrall *v.* Jewett, 2 Paige, 143, 1830.

[7] Bliss *v.* Brooklyn, 10 Blatch. 522, 1883.

coupling. The contrivance was worthless, because it proved on trial to be inoperative. The subsequent addition of a lug to one of its parts, transferred the coupling into a useful invention. Judge BENEDICT nevertheless held the patent to be invalid for want of utility.

§ 79. If, however, an invention performs a good function, though but imperfectly, its utility is not negatived by the fact that it is susceptible of improvement, which will make it operate much better,[8] nor by the fact that some prior invention performed the same function quite as well,[9] or even performed it with superior excellence.[10] Nor is utility negatived by later inventions which are so much superior to the patented process or thing, that they entirely superseded the use of the latter.[11] Indeed, patents are never held to be void for want of utility, merely because the things covered by them perform their functions but poorly.[12] In such cases no harm results to the public from the exclusive right, because few will use the invention, and because those who do use it without permission, will seldom or never be obliged to pay for that use, anything beyond the small benefit they may really have realized therefrom.[13]

§ 80. Utility in a manufacture, is not negatived by the fact that it has no function except to decorate the object to

[8] Wheeler *v.* Reaper Co., 10 Blatch. 189, 1872; Mergenthaler Co. *v.* Press Pub. Co., 57 F. R. 505, 1893; Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 848, 1901.

[9] Seymour *v.* Osborne, 11 Wallace, 516, 1870; Shaw *v.* Lead Co., 11 F. R. 715, 1882.

[10] Bell *v.* Daniels, 1 Fisher, 375, 1858.

[11] Railway Co. *v.* Sayles, 97 U. S. 559, 1878; Poppenhusen *v.* Comb Co., 2 Fisher, 72, 1858; McComb *v.* Ernest, 1 Woods, 203, 1871.

[12] Vance *v.* Campbell, 1 Fisher, 485, 1859; Conover *v.* Roach, 4 Fisher, 16, 1857.

[13] Gibbs *v.* Hoefner, 19 F. R. 324, 1884.

which it is designed to be attached.[14] In such case utility resides in beauty. Whatever is beautiful is useful, because beauty gives pleasure, and pleasure is a kind of happiness, and happiness is a kind of utility.

§ 81. Utility is negatived if the function performed by an invention is injurious to the morals, the health, or the good order of society.[15] An invention to improve the art of forgery, or one to facilitate the spread of a contagious disease, or one to render air or water intoxicating, would of course be unpatentable for want of utility. The more completely such an invention could perform its function, the more objectionable it would be in this respect. But utility is not negatived by the fact that the article covered by a patent is an imitation of a natural substance,[16] except where the imitation is a fraudulent counterfeit.[17]

§ 82. An important question relevant to utility in this aspect, may hereafter arise and call for judicial decision. It is perhaps true, for example, that the invention of Colt's revolver was injurious to the morals, and injurious to the health, and injurious to the good order of society. That instrument of death may have been injurious to morals, in tending to tempt and to promote the gratification of private revenge. It may have been injurious to health, in that it is very liable to accidental discharge, and to thereby cause wounds, and even homicide. It may also have been injurious to good order, especially in the newer parts of the country, because it facilitates and increases private warfare among frontiersmen. On the other hand,

[14] Magic Ruffle Co. *v.* Douglas, 2 Fisher, 330, 1863.

[15] Bedford *v.* Hunt, 1 Mason, 301, 1817; National Device Co. *v.* Lloyd, 40 F. R. 89, 1889; Reliance Novelty Co. *v.* Dworzek, 80 F. R. 902, 1897; Schultze *v.* Holtz, 82 F. R. 448, 1897.

[16] *In re* Corbin and Martlett, 1 McArthur's Patent Cases, 521, 1857.

[17] Rickard *v.* DuBon, 103 F. R. 868, 1900.

the revolver, by furnishing a ready means of self-defense, may sometimes have prompted morals and health and good order. By what tests, therefore, is utility to be determined in such cases? Is it to be done by balancing the good functions with the evil functions? Or is everything useful within the meaning of the law, if it is used, or is designed and adapted to be used, to accomplish a good result, though in fact it is oftener used, or is as well or even better adapted to be used, to accomplish a bad one? Or is utility negatived by the mere fact that the thing in question is sometimes injurious to morals, or to health, or to good order? The third hypothesis cannot stand, because if it could, it would be fatal to patents for steam-engines, dynamos, electric railroads, and indeed many of the noblest inventions of the nineteenth century. The first hypothesis cannot stand, because if it could it would make the validity of the patents to depend on a question of fact, to which it would often be impossible to give a reliable answer. The second hypothesis is the only one which is consistent with the reason of the case, and with the practical construction which the courts have given to the statutory requirement of utility.[18]

§ 83. Another question revelant to utility of function will sooner or later demand the attention of counsel and of courts. A particular invention may invariably perform one specific function, which function is deemed good in some quarters, and in other quarters is thought to be bad. The function performed by a newly invented smoking-pipe, would be thought by many persons to be only evil, and that continually: would be deemed by many moralists to be injurious to the morals, and by many physicians to be injurious to the health of the people. On the

[18] Fuller *v.* Berger, 120 F. R. 275, 1903; Mills *v.* Industry Novelty Co., 230 F. R. 463, 1916.

other hand, there are many other persons who would regard such an invention as truly useful. Personal opinion cannot control the decision of such a question, for if it could there would be no stability to the jurisprudence of the subject. Nor ought former custom to be the criterion, for if it were, each age would be hampered by a prior and lower civilization. It seems, therefore, that in such cases of divided personal opinion on ethical questions, the only criterion of decision is the average public sentiment of the time when such a question arises.[19] Accordingly, the courts at present uphold patents which relate to tobacco, and will probably always sustain the utility of inventions which perform functions that average public sentiment is willing to have performed.

§ 84. Utility is negatived by the fact that the patented process or thing is injurious to the thing to which it is applicable,[20] and also by the fact that the function performed by the patented part of a machine, though good in itself, is injurious to the utility of the machine as a whole.[21] The first of these points is well illustrated by the first case cited in this section: a case based on a patent for a process of treating leather to an application of fat liquor. The second point is equally well illustrated by the second case: a case based on a patent for a locomotive spark arrester. To arrest sparks is in itself a good thing to do, but where it must be done in such a way as to stop or seriously retard the locomotive, it is not desirable to attempt it. Therefore a device which would arrest sparks, but only at the expense of retarding the locomotive, from the smoke-pipe of which they issued, was rightly held to be wanting in utility.

[19] Pope Mfg. Co. *v.* Gormully, 144 U. S. 233, 1892.

[20] Klein *v.* Russell, 19 Wallace, 433, 1873.

[21] Wilton *v.* Railroad Co., 1 Brightley's Federal Digest, 618, 1849.

§ 85. A patent is *prima facie* evidence of utility,[22] and doubts relevant to the question should be resolved against infringers,[23] because it is improbable that men will render themselves liable to actions for infringement, unless infringement is useful.[24] In fact if the defendant has adopted the distinctive features of a patented device he is estopped to deny its utility.[25]

[22] Vance *v.* Campbell, 1 Fisher, 483, 1859; Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 848, 1901; Kennicott Co. *v.* Holt Ice & Cold Storage Co., 239 F. R. 157, 1915.

[23] Western Electric Co. *v.* La Rue, 139 U. S. 608, 1891; Whitney *v.* Mowry, 4 Fisher, 215, 1870.

[24] Lehnbeuter *v.* Holthaus, 105 U. S. 94, 1881; Gandy *v.* Belting Co., 143 U. S. 595, 1892; La Rue *v.* Electric Co., 31 F. R. 82, 1887; Westinghouse Electric & Mfg. Co. *v.* Beacon Lamp Co., 95 F. R. 464, 1899; Goss Printing-Press Co. *v.* Scott, 108 F. R. 258, 1901; Grever *v.* United States Hoffman Co., 202 F. R. 923, 1913.

[25] F. D. Cummer & Son Co. *v.* Atlas Dryer Co., 193 F. R. 993, 1912; Boyce *v.* Stewart-Warner Speedometer Corporation, 220 F. R. 118, 1914.

CHAPTER V

ABANDONMENT

86. The several sorts of abandonment.
87. Abandonment of inventions.
88. Actual abandonment of inventions.
89. Actual abandonment by express declaration.
90. Actual abandonment by formal disclaimer.
91. Actual abandonment resulting from laches before application.
92. Actual abandonment resulting from laches after application and before issue of letters patent.
93. Constructive abandonment before application.
94. "Public use," defined and delineated.
95. Experimental use.
96. "On sale," delineated and defined.
97. Sale of inchoate right to a patent.
98. Degree of identity necessarily involved between the thing constructively abandoned and the thing patented.
99. Making, works no constructive abandonment.
100. Public knowledge, works no constructive abandonment.
101. Public use or sale in a foreign country.
103. Constructive abandonment after application, and before issue of letters patent.
104. Rules of constructive abandonment are inflexible.
104*a*. Constructive abandonment in four new classes of cases.
105. Surrender of letters patent.
106. Abandonment of invention after letters patent, unknown to the law.
107. Acquiescence in unlicensed use of patented invention.
108. Questions of abandonment are questions of fact.

§ 86. AN inventor may abandon an unsuccessful endeavor to make an invention; or having made an invention, he may abandon it to the public; or having made an invention and having applied for a patent thereon, he may abandon that application with or without abandon-

ing that invention. Transactions of the first sort are commonly called unsuccessful abandoned experiments. They confer no rights upon those who make them, and they affect no rights of any other person.[1] Transactions of the third sort are treated in the chapter on applications; the sixth chapter of this book. Transactions of the second sort require treatment in respect that they are inventions; and also require separate treatment in respect that they are abandoned. Treatment of the first sort takes no account of the fact of abandonment, because abandoned inventions have the same effect on the rights of subsequent inventors that they would have if they had not been abandoned.[2] That subject, therefore, does not belong to this chapter. It is treated in the chapters on invention and letters patent, where the state of the art is a very important factor in the discussion; and also in the chapter on novelty, where anticipation is the point of inquiry. Treatment of the second sort indicated above, is the special function and scope of this chapter. Abandoned inventions are here considered with regard to the effect abandonment of them has upon the rights of their inventors, and with regard to the rules by means of which abandonment is to be affirmed or denied in particular cases.

§ 87. Abandonment of an invention may be actual, or it may be constructive. It is actual when it is the result of intention.[3] It is constructive when it is the result of some statute which operates regardless of the intention of the inventor. The two sorts require and will receive separate

[1] Deering *v.* Harvester Works, 155 U. S. 302, 1894; American Bell Telephone Co. *v.* Cushman Telephone Co., 35 F. R. 734, 1888; Brush Electric Co. *v.* Ft. Wayne Electric Co., 44 F. R. 284, 1890; Ecaubert *v.* Appleton, 67 F. R. 922, 1895.

[2] Olds *v.* Brown, 41 F. R. 703, 1890.

[3] Mast, Foos & Co. *v.* Dempster Mill Mfg. Co., 82 F. R. 331, 1897.

treatment in this chapter, but there are some points of fact and of law which apply equally to both. Either kind may occur before any application for a patent is made, or may occur after such an application, and before any letters patent are issued.[4] So also, either actual or constructive abandonment of an invention, is fatal to the validity of any patent that may afterward be granted therefor. The inchoate right to a patent when once abandoned can never be resumed; for where gifts are once made to the public, they become absolute and irrevocable.[5]

§ 88. Actual abandonment of an invention occurs whenever there is an entire relinquishment of all expectation of securing a patent therefor, and an accompanying formation of an expectation that the invention will always be free to the public.[6] Such a relinquishment may be shown by direct, or by circumstantial evidence.[7] It may be proved by things done or omitted by the inventor, or it may be proved by his omission or delay to do what the law requires to be done in order to secure letters patent. The burden of proof is on the party seeking to prove the abandonment and it must be proven beyond a reasonable doubt.[8] And the fact which constitutes an actual abandonment of an invention, may have occurred within two years before the inventor endeavored to recall that abandonment by filing an application for a patent on that invention.[9]

[4] Rifle & Cartridge Co. *v.* Arms Co., 118 U. S. 24, 1885.

[5] Pennock *v.* Dialogue, 2 Peters, 1, 1829; Kendall *v.* Winsor, 21 Howard, 328, 1858; Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 96, 1876; Planing Machine Co. *v.* Keith, 101 U. S. 484, 1879; Consolidated Fruit Jar Co. *v.* Stamping Co., 27 F. R. 377, 1886.

[6] Babcock *v.* Degner, 1 McArthur's Patent Cases, 616, 1859.

[7] Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 850, 1901.

[8] Kellogg Switchboard & S. Co. *v.* International Telephone Mfg. Co., 158 F. R. 104, 1907.

See Section 108, *post*.

[9] Mast, Foos & Co. *v.* Dempster

§ 89. An inventor abandons his invention to the public when he makes an express declaration to that effect.[10] And a declaration that a particular invention is open to anybody, is a declaration of abandonment of any special right thereto.[11]

§ 90. So also an inventor will be held to abandon a particular invention, when he formally disclaims it in an application for a patent for some other invention; [12] and where he cancels from an application, a claim for that invention, and substitutes no other claim for the same invention, before his patent is issued; [13] and also when he formally disclaims a particular invention or claim, in a separate paper filed for that purpose. The Supreme Court decided in 1854, that no abandonment results from the mere fact that the inventor described the invention in an application for a patent, without either claiming or disclaiming the same.[14] When the cited case was tried in the court below, the judge charged the jury "That a description, by the applicant for a patent, of a machine, or a part of a machine, in his specification, unaccompanied by a notice that he has rights in it as an inventor, or that he desires to secure title to it as a patentee, is a dedication of it to the public." But when the case reached the Su-

Mill Mfg. Co., 82 F. R. 331, 1897; Warren Bros. *v.* City of Owosso, 166 F. R. 309, 1909.

[10] Kendall *v.* Winsor, 21 Howard, 328, 1858; Rifle & Cartridge Co. *v.* Arms Co., 118 U. S. 24, 1885.

[11] Westinghouse Electric & Mfg. Co. *v.* Saranac Lake Electric Light Co., 108 F. R. 224, 1901, and 113 F. R. 885, 1902.

[12] Leggett *v.* Avery, 101 U. S. 259, 1879.

[13] Yale Lock Co. *v.* Berkshire Bank, 135 U. S. 403, 1890; Pittsburgh Reduction Co. *v.* Cowles Electric Co., 55 F. R. 320, 1893.

[14] Battin *v.* Taggert, 17 Howard, 83, 1854; also Kinnear Mfg. Co. *v.* Wilson, 142 F. R. 970, 1905; Victor Talking Machine Co. *v.* Am. Graphophone Co., 145 F. R. 350, 1906; Victor Talking Machine Co. *v.* Duplex Phonograph Co., 177 F. R. 248, 1909.

preme Court, that instruction was decided to be erroneous, and a new trial was therefore awarded. The paramount precedent thus established has been followed by the Supreme Court, in a recent case, by holding that a particular combination, which was described in an original patent, but neither claimed nor disclaimed therein, was lawfully claimed in a reissue of that patent.[15] This holding constituted a decision that no abandonment results from the mere fact that the inventor described the invention in an application for a patent, without either claiming or disclaiming the same; for the Supreme Court has always held that an abandonment of a right to a patent on a particular invention, whenever it occurs, is absolute and irrevocable.[16]

§ 91. Abandonment is also proved by evidence that the inventor is chargeable with laches or lack of diligence, relevant to applying for a patent.[17] Long delay constitutes laches, unless there was some reason which rendered that delay consistent with an expectation to finally secure a patent.[18] Extreme poverty of the inventor is such a reason; [19] but poverty which was not sufficient to prevent the inventor from securing patents on other inventions,[20]

[15] Topliff *v.* Topliff, 145 U. S. 165, 1892.

[16] Pennock *v.* Dialogue, 2 Peters, 1, 1829; Kendall *v.* Winsor, 21 Howard, 328, 1858; Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 96, 1876; Planing Machine Co. *v.* Keith, 101 U. S. 484, 1879.

[17] Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 96, 1876; Craver *v.* Weyhrich, 31 F. R. 607, 1887; Wright *v.* Postel, 44 F. R. 352, 1890.

[18] Eck *v.* Kutz, 132 F. R. 758, 1904; International Tel. Mfg. Co. *v.* Kellogg S. B. & S. Co., 171 F. R. 651, 1909; Curtain Supply Co. *v.* National Lock Washer Co., 174 F. R. 45, 1909.

[19] Smith *v.* Dental Vulcanite Co., 93 U. S. 491, 1876; Celluloid Mfg. Co. *v.* Crofut, 24 F. R. 796, 1885.

[20] Rifle & Cartridge Co. *v.* Arms Co., 118 U. S. 24, 1885; Wickersham *v.* Singer, 1 McArthur's Patent Cases, 689, 1859.

or from spending money for an education,[21] is not such a reason. The fact that during all, or during much of the delay the inventor was within the rebellious Southern Confederacy, and therefore unable to apply for a United States patent, has also been repeatedly held to be such a reason.[22] Mental disorder which was great enough to generally incapacitate the inventor for business during the time of the delay, is also such a fact as will negative laches,[23] and physical disorder ought, under the same circumstances, to have the same effect. Also where the inventor's working hours were compelling and he was consequently unable to readily confer with his solicitor, but in spite of which he made his best efforts, he is not chargeable with lack of diligence.[24] In short, the entire question is one of fact in the particular case and the circumstances surrounding the inventor must always be taken into account.[25]

Neither can laches be predicated of any delay caused by absorbing misfortune,[26] nor of any neglect of which the patent solicitor was guilty,[27] nor of any delay which was caused by the experiments of the inventor in making or perfecting his invention.[28] The latter proposition, however, does not go to the extent of permitting the inventor to wait until everything in the nature of an accessory improvement that makes the machine commercially

[21] Craver *v.* Weyhrich, 31 F. R. 607, 1887.

[22] Johnsen *v.* Fassman, 1 Woods, 142, 1871; Knox *v.* Loweree, 1 Bann. & Ard. 589, 1874.

[23] Ballard *v.* Pittsburg, 12 F. R. 784, 1882.

[24] Courson *v.* O'Connor, 227 F. R. 890, 1915.

[25] Courson *v.* O'Connor, 227 F. R. 890, 1915. See Section 108, *post.*

[26] Beedle *v.* Bennett, 122 U. S. 76, 1886.

[27] Birdsall *v.* McDonald, 1 Bann. & Ard. 165, 1874; Howes *v.* McNeal, 3 Bann. & Ard. 376, 1878.

[28] Agawan Co. *v.* Jordan, 7 Wallace, 583, 1868; Von Schmidt *v.* Bowers, 80 F. R. 143, 1897.

better has been perfected. When the inventor has grasped the idea and put it into mechanical form, he must be diligent in making his application.[29] As between two inventors the question is not one of relative diligence but it is a question of the actual diligence of the owner of the patent in suit without reference to the degree of diligence practiced by the alleged prior inventor, so that if the former is the prior inventor and has used proper diligence he is entitled to the patent.[30] Nor does delay constitute laches when it was caused by the fact that the invention could only be used in connection with one covered by another patent, and by the fact that the inventor failed to make any arrangement with the owner of that patent for the joint use of the two inventions.[31] If under such circumstances the inventor waits till the older patent expires before securing his patent, his delay is amply accounted for by his desire to enjoy for the full statutory term of a patent the practically exclusive right to his invention. To predicate abandonment of delay suffered for such a purpose would be logically impossible.

But a delay of years, between reduction to practice and filing an application for a patent, which is taken for the purpose of profiting, first from secrecy, and finally from a patented monopoly, is a delay which constitutes actual abandonment, even if the inventor intended to apply for a patent, when he could maintain secrecy no longer.[32]

§ 92. Abandonment is also established by evidence that an inventor is chargeable with laches relevant to prosecut-

[29] Universal Adding Machine Co. *v.* Comptograph Co., 146 F. R. 981, 1906.

[30] Continental Rubber Works *v.* Single Tube Automobile, etc., Co., 178 F. R. 452, 1910.

[31] Webster *v.* New Brunswick Carpet Co., 1 Bann. & Ard. 84, 1874.

[32] *In re* Mower, 15 App. D. C. 144, 1899.

ing or renewing his application after it has been rejected or withdrawn.[33] For example, where an application for a patent is rejected when it ought to be allowed, and where the inventor long acquiesces in that erroneous rejection, supposing it to be right, he cannot, on receiving better information, renew his application or file another, and thereupon secure a valid patent.[34] In such a case the desire of the inventor to secure a patent may never have left him, but there was doubtless a complete, though perhaps reluctant, relinquishment of all expectation of so doing. An abandonment of an invention is not less real because it was unnecessary. But Congress by a special act may waive an abandonment and authorize a patent to issue for the abandoned invention.[35] And laches cannot be predicated of any delay which was incurred by an applicant as the result of slowness of procedure in his case in the Patent Office, whether that slowness was due to neglect [36] or to routine.[37] Nor can laches be predicated of any delay to take a particular step, in prosecuting an application, where that delay was not longer than the time allowed by the statute, or by the rules of the Patent Office, for that particular step in such a prosecution.[38]

§ 93. Constructive abandonment of inventions prior to applications for letters patent, is the offspring of certain

[33] Planing Machine Co. *v.* Keith, 101 U. S. 484, 1879; Rifle & Cartridge Co. *v.* Arms Co., 118 U. S. 22, 1885.

[34] Marsh *v.* Commissioner, 3 Bissell, 321, 1872; Consolidated Fruit Jar Co. *v.* Stamping Co., 27 F. R. 377, 1886.

[35] Graham *v.* Johnston, 21 F. R. 42, 1884.

[36] Sayles *v.* Railroad Co., 2 Fisher, 523, 1865.

[37] American Bell Telephone Co. *v.* United States, 68 F. R. 542, 1895.

[38] Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 852, 1901; Columbia Motor Car Co. *v.* C. A. Duerr & Co., 184 F. R. 893, 1911.

See Section 146.

statutes, the earliest of which was the Patent Act of 1836.[39] Sections 6 and 7 of that Act authorized the Commissioner of Patents to grant a patent only where the alleged invention had not been in public use or on sale with the applicant's consent or allowance, prior to the application. Section 15 provided that in suits for infringement, judgment should be rendered for the defendant if he should have pleaded and proved that the thing patented had been in public use or on sale with the consent or allowance of the patentee before his application for a patent. Section 7 of the Patent Act of 1839 [40] provided that no patent should be held to be invalid by reason of purchase, sale, or use of the thing covered thereby, prior to the application for a patent, except on proof of abandonment of such invention to the public, or on proof that such purchase, sale, or use had been for more than two years prior to such application for a patent. This provision of the Act of 1839 was in one respect restrictive of the enactments just cited from the statute of 1836, and in one respect it enlarged their operation. Its effect was to amend those enactments in the same way that it would have done if it had inserted the words "for more than two years" in the proper place in their phraseology, and had also canceled the qualification which related to consent and allowance.[41] This phrase "for more than two years" means earlier than two years,[42] so that the law which the two statutes established on the subject is expressed in the following sentence. A patent is void if the invention covered thereby was in public use or on sale earlier than two years before the application for that patent. And that continued to be the law of the

[39] 5 Statutes at Large, Ch. 357, p. 117.

[40] 5 Statutes at Large, Ch. 80, p. 354.

[41] Andrews *v.* Hovey, 123 U. S. 267, 1887; 124 U. S. 694, 1887.

[42] Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 94, 1876.

United States on the subject, under the Consolidated Patent Act of July 8, 1870,[43] and also under the Revised Statutes.[44] The two years contemplated by this law are ascertained by measuring backward from the date of the filing of the application in the Patent Office;[45] but where a second or renewed application is filed to take the place of another which described and claimed the same invention, and which was withdrawn or relinquished with intent to file the second application, the two years are ascertained by measuring backward from the date of the filing of the first application.[46] An application which described a particular invention, takes date on the day of its filing, whether or not it claimed that invention at that time.[47]

§ 94. What is "public use," within the meaning of the statute? This question has now received light from a sufficient number of decisions, affirming or negativing the fact of public use in particular cases, to make it possible to deduce a nearly complete answer from judicial authorities.

If the inventor allows his invention to be used by other persons generally, either with or without compensation, then it will be in public use within the meaning of the statute.[48] And the use is public, which follows a transfer of the thing used from its inventor to the user, without

[43] 16 Statutes at Large, Ch. 230, p. 198.

[44] Revised Statutes, Section 4886, 29 Statutes at Large, Ch. 391; Anderson *v.* Eiler, 46 F. R. 778, 1891; *In re* Drawbaugh, 67 O. G. 929, 1894; Eastman *v.* Mayor, etc., of City of New York, 134 F. R. 844, 1904.

[45] Campbell *v.* New York, 35 F. R. 504, 1888.

[46] International Crown Co. *v.* Richmond, 30 F. R. 778, 1887; Hayes-Young, etc., Co. *v.* St. Louis Transit Co., 137 F. R. 80, 1905.

See Section 145.

[47] Edison *v.* American Mutoscope Co., 110 F. R. 662, 1901.

[48] Elizabeth *v.* Pavement Co., 97 U. S. 135, 1877.

reserving any control over it, and without expecting to make any change in it, or without any restriction.[49]

If the inventor uses his invention for profit, and not by way of experiment, that is a public use,[50] unless actual use resulting in profit is necessary to show the inventor how to perfect his invention, and unless he does perfect it in accordance with the teachings of such use;[51] but experimental use becomes public use when it extends further, either in time, or in number of instances, than is reasonably required to test the invention.[52] Nor will the fact that the inventor is but an employee in the place where he uses his invention, or the fact that the profit goes primarily to his employer, oust the operation of this rule.[53]

To constitute public use, it is not necessary that more than one specimen of the thing invented should have been publicly used,[54] nor that more than one person should have known of that use.[55] Nor is it necessary to public use that the article used could have been seen by the public eye, if the ordinary use of such articles is veiled from view.[56]

A design is in public use whenever any article which embodies it, or any picture of it, is exhibited for the purpose of making its character publicly known.

§ 95. Experimental use is never public use within the

[49] Root *v.* Third Avenue Railroad Co., 146 U. S. 221, 1892; Delemater *v.* Heath, 58 F. R. 416, 1893.

[50] Elizabeth *v.* Pavement Co., 97 U. S. 137, 1877; Jenner *v.* Bowen, 139 F. R. 556, 1905.

[51] Sprague *v.* Mfg. Co., 12 F. R. 724, 1882.

[52] International Tooth Crown Co. *v.* Gaylord, 140 U. S. 63, 1891.

[53] Worley *v.* Tobacco Co., 104 U. S. 340, 1881.

[54] Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 94, 1876; Jones *v.* Barker, 11 F. R. 597, 1882; National Cash Register Co. *v.* American Cash Register Co. (containing history of the statute), 178 F. R. 80, 1910.

[55] Egbert *v.* Lippmann, 104 U. S. 336, 1881.

[56] Egbert *v.* Lippmann, 104 U. S. 336, 1881; International Tooth Crown Co. *v.* Gaylord, 140 U. S. 58, 1891.

meaning of the statute, if it is conducted in good faith for the purpose of testing the qualities of the invention, and for no other purpose not naturally incidental to that.[57] In such a case it is immaterial whether the experimental use disclosed a necessity for improvement, or disclosed no such necessity; and it is also immaterial whether the use was conducted with secrecy or not. It may indeed have been had in the open air, and have continued every day for several years, and have been known to hundreds of persons, and have incidentally inured to the profit of the user and of the public, and still not be a public use, within the meaning of the statute, if the nature of the invention was such that only long-continued out-door use could show whether the invention possessed utility, or show in what respects, if any, it required to be improved.[58] In the case of a patented machine designed to manufacture articles the inventor may make as many articles as are necessary to enable him to observe and remedy the defects in his machine, and he is not thus brought within the statute merely because the articles themselves may be perfect or because he makes the best possible use of them by selling them.[59]

The liberal ideas which underlie the decision just cited will doubtless be applied to every variety of invention, as occasion serves, and will be found elastic enough to cover every meritorious case. Indeed, Judge JOHN LOWELL went still further in the direction of liberally allowing scope to experimental use, and decided that such use is not

[57] Beedle *v.* Bennett, 122 U. S. 77, 1886; Harmon *v.* Struthers, 43 F. R. 443, 1890; Pacific Cable Railroad Co. *v.* Butte City Ry. Co., 55 F. R. 765, 1893; Harmon *v.* Struthers, 57 F. R. 641, 1893; International Tel. Mfg. Co. *v.* Kellogg S. B. & S. Co., 171 F. R. 651, 1909.

[58] Elizabeth *v.* Pavement Co., 97 U. S. 134, 1877.

[59] Bryce Bros. *v.* Seneca Glass Co., 140 F. R. 161, 1905.

public use within the meaning of the law, where, in order to test its comparative as well as its absolute utility, and in order to convince others of its merits, an inventor allows them to use his invention after he has himself become satisfied that it is useful.[60]

But where the main object of the use was profit, and improvement was only an incidental aim, the use is not experimental in the eye of the law;[61] though incidental profit is not inconsistent with use being only experimental;[62] and absence of profit is not inconsistent with use being not experimental, but public.[63]

The use of a minor invention in a large machine, may be a public use thereof, though the use of the machine as a whole is experimental.[64]

Evidence of the experimental character of any use which occurred earlier than two years before the application for a patent, must be full, unequivocal, and convincing, or it cannot prevail to save that patent from invalidity.[65]

Public use by a stranger, without the knowledge of the inventor, more than two years before the inventor applies for a patent, generally has the same operation of constructive abandonment, that public use by the inventor himself would have;[66] but Judge WHEELER decided, that where

[60] Sinclair *v.* Backus, 5 Bann. & Ard. 81, 1880.

[61] Smith & Griggs Mfg. Co. *v.* Sprague, 123 U. S. 256, 1887; Penn Electrical & Mfg. Co. *v.* Conroy, 159 F. R. 943, 1908; Star Mfg. Co. *v.* Crescent Forge & Shovel Co., 179 F. R. 856, 1910.

[62] Westinghouse Electric & Mfg. Co. *v.* Saranac Lake Electric Light Co., 108 F. R. 230, 1901; 113 F. R. 888, 1902.

[63] Thomson-Houston Electric Co. *v.* Lorain Steel Co., 117 F. R. 252, 1902.

[64] Thomson-Houston Electric Co. *v.* Lorain Steel Co., 110 F. R. 654, 1901; 117 F. R. 249, 1902.

[65] Smith & Griggs Mfg. Co. *v.* Sprague, 123 U. S. 264, 1887; Swain *v.* Holyoke Machine Co., 111 F. R. 408, 1901.

[66] Andrews *v.* Hovey, 123 U. S. 267, 1887; 124 U. S. 694, 1887;

the inventor continued his experiments legitimately, until less than two years before he applied for his patent, that patent will not be defeated by the fact that another person constructed, and still another used, his invention, without his knowledge, more than two years before the application for the patent was made.[67]

This holding has been more or less doubted, but at any rate it is safe to say that a fraudulent, surreptitious and piratical use of the invention by a stranger, taking place before the two-year period, does not operate to show an abandonment. This doctrine is discussed by the Circuit Court of Appeals of the second circuit in Eastman *v.* Mayor, etc., of the city of New York,[68] and while it is upheld on the authorities, its correctness is strongly doubted by Judge COXE who delivered the opinion, and the "fraudulent, surreptitious and piratical use" is confined to that arising out of a breach of trust.

§ 96. What is being "on sale," within the meaning of the statute? The answer to this question also, can now be accurately delineated in nearly or quite all of its boundaries.

A single instance of sale of one specimen of the thing invented is enough to constitute putting the invention on sale,[68a] and it is immaterial if the purchase price is not paid more than two years before the application.[69] Indeed a device will be on sale within the meaning of the law, if it is offered for sale, whether any specimen of it is actually sold or not.[70] If, however, the nature of the invention is such

Glauber *v.* H. Mueller Mfg. Co. (reviewing previous cases on general subject of prior public use), 169 F. R. 110, 1909.

[67] Campbell *v.* New York, 47 F. R. 515, 1891.

[68] Eastman *v.* Mayor, etc., of City of New York, 134 F. R. 844, 1904.

[68a] Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 94, 1876.

[69] Anderson *v.* Munroe, 55 F. R. 405, 1893.

[70] Plimpton *v.* Winslow, 14

that the inventor is obliged to put it into the hands of others for crucial experiment, he may sell specimens to those others for that purpose, and such a sale will not be obnoxious to the law now under consideration.[71] But if the invention could have been tested by the inventor on his own premises, as well as by anyone there or elsewhere, then either an absolute or a conditional sale of a specimen of the thing invented, will be putting the invention on sale, unless there is unequivocal evidence that the sale was made for the purpose of experimental use.[72]

Where an inventor furnishes a specimen of his invention for use on approval, to be paid for if successful, there is an instance of being "on sale" if the use is successful and the specimen is paid for [73]; but if the use is unsuccessful and is abandoned, there is no instance presented of being "on sale," even if the specimen was partly or wholly paid for, while being constructed.[74] A sale for the purpose of testing the commercial merits of an invention, will constitute being "on sale; [75] but where a specimen of an invention is built or made to order, it is not "on sale" till it is completed, delivered, and accepted.[76] This proposition is of

F. R. 921, 1883; Covert *v.* Covert, 106 F. R. 188, 1901; Wende *v.* Horine, 225 F. R. 501, 1915; Burke Electric Co. *v.* Independent Tool Co., 234 F. R. 93, 1916.

[71] Graham *v.* McCormick, 5 Bann. & Ard. 244, 1880; Graham *v.* Mfg. Co., 11 F. R. 142, 1880.

[72] Henry *v.* Soapstone Co., 5 Bann. & Ard. 108, 1880; De Lamater *v.* Deeley, 53 F. R. 380, 1892.

[73] Craig *v.* Michigan Lubricator Co., 72 F. R. 173, 1896.

[74] Huntington Dry-Pulverizer Co. *v.* Newell Universal Mill Co., 109 F. R. 269, 1901; Wm. B. Mershon & Co. *v.* Bay City Box & Lumber Co., 189 F. R. 741, 1910.

[75] Smith & Davis Mfg. Co. *v.* Mellon, 58 F. R. 707, 1893.

[76] Campbell *v.* New York, 36 F. R. 261, 1888; National Cash Register Co. *v.* American Cash Register Co., 178 F. R. 79, 1910; McCreery Engineering Co. *v.* Mass. Fan Co., 195 F. R. 498, 1912; Burke Electric Co. *v.* Independent Pneumatic Tool Co., 234 F. R. 93, 1916.

course all the more true if the acceptance of the specimen or specimens is subject to approval by the buyer of a sample to be submitted.[77]

§ 97. An assignment of the inchoate right to an invention, is not such a sale as will be obnoxious to the statute now under explanation.[78] So far from furnishing evidence of abandonment, the sale of the inchoate right to a patent indicates an expectation that such a patent will be obtained, and that right be thus translated into a legal title.

§ 98. Precise identity between the thing covered by the patent, and the thing which the inventor allowed to be in public use or on sale more than two years before he applied for that patent, is not necessary to constitute constructive abandonment of the invention covered by the latter. It is enough if the two devices are substantially the same,[79] or if the advance from one to the other did not amount to invention,[80] but it is not enough that the two devices perform the same function, and are somewhat similar in construction and in mode of operation.[81]

§ 99. No constructive abandonment results from any mere making of a specimen of an invented thing more than two years before the application for a patent.[82] But where an invention consists in a process of making a thing, the making of a specimen of that thing, by that process, is a use of that process, and is therefore subject to the rules which govern using, and not to that which applies to making only.

[77] Burke Electric Co. *v.* Independent Pneumatic Tool Co., 232 F. R. 145, 1916.

[78] Elm City Co. *v.* Wooster, 6 Fisher, 452, 1873.

[79] Hall *v.* Macneale, 107 U. S. 90, 1882; Theberath *v.* Trimming Co., 15 F. R. 251, 1883.

[80] International Tooth Crown Co. *v.* Gaylord, 140 U. S. 62, 1891.

[81] Draper *v.* Wattles, 3 Bann. & Ard. 618, 1878.

[82] Comstock *v.* Sandusky Seat Co., 3 Bann. & Ard. 188, 1878; Campbell *v.* New York, 36 F. R. 261, 1888.

§ 100. Public knowledge of an invention, acquired with the consent of the inventor, prior to his application for a patent, was formerly fatal to the validity of any patent granted for that invention. The Patent Act of 1793 [83] provided that to be patentable, a thing must not have been known before the making of an application for a patent thereon. The Supreme Court construed that enactment to mean only that the invention must not have been known to the public with the consent of the inventor.[84] The Patent Act of 1836 repealed all prior statutes on the subject of patents, and did not provide that any unfavorable effect on an inventor's right should result from public knowledge of his invention, acquired at any time after its production by him.[85] Nor has any later statute made any such provision.

§ 101. A public use or a sale of a specimen of a newly invented thing, occurring in any foreign country after its invention by an applicant for an American patent, but more than two years before his application is made, will not have the same effect upon such a patent, that it would have had if that public use or that sale had occurred in the United States. The language of Section 4886 of the Revised Statutes, contains no restriction as to the country wherein the public use or the sale of a newly invented thing, more than two years prior to an application for a patent thereon, must occur, in order to constitute constructive abandonment of that invention; and it was held by one Circuit Court, that no such restriction exists.[86] But the Supreme Court reversed that decision, and decided that Sections 4886, 4887, 4920 and 4923 of the Re-

[83] 1 Statutes at Large, Ch. 11, Section 1, p. 318.

[84] Pennock *v.* Dialogue, 2 Peters, 18, 1829.

[85] Elizabeth *v.* Pavement Co., 97 U. S. 136, 1877.

[86] Gandy *v.* Belting Co., 28 F. R. 570, 1886.

vised Statutes, taken together, show that the right of an inventor, to obtain a United States patent, is not lost by reason of the fact that his invention was in public use or on sale, in some foreign country, more than two years before his application for a United States patent thereon.[87]

§ 103. Constructive abandonment of an invention, after an application for a patent thereon, necessarily results from constructive abandonment of that application, in certain classes of cases which are explained in the chapter on applications.[88] In still another class of cases, constructive abandonment of an invention, after an application for a patent thereon, necessarily results from a particular kind of constructive abandonment of that application, unless a new application is filed within a certain time after such abandonment. That class of cases is the following: Where an applicant omits to pay the final fee within six months from the time at which his application was allowed, and notice thereof sent to him or to his agent, and where he also omits to make any new application for a patent on the same invention within two years after such an allowance, he loses all right to obtain a patent for that invention.[89] The two-year period begins to run from the date of the allowance, whether or not the fee is paid.[90] Only one renewal application may be made.[91]

§ 104. The statutory law relevant to constructive abandonment, resulting from a public use or from a sale of a newly invented thing, more than two years before an ap-

[87] Gandy *v.* Belting Co., 143 U. S. 592, 1892.

[88] Section 147 of this book.

[89] Revised Statutes, Section 4897.

[90] Weston Electrical Inst. Co. *v.* Empire Electrical Inst. Co., 136 F. R. 599, 1905.

[91] Weston Electric Inst. Co. *v.* Empire Electrical Inst. Co., 131 F. R. 90, 1904.

plication for a patent, is a law which operates inflexibly upon all cases coming within it. Its effect cannot be obviated by any evidence showing reasons for the delay, however ample and meritorious those reasons may be.[92] The rule of this section doubtless applies also to the constructive abandonment explained in the last.

§ 104*a*. Constructive abandonment of inventions prior to applications for letters patent, in two new classes of cases, is enacted by the Patent Act of 1897; and in two other new classes of cases, by the Patent Act of 1903.

The first of these classes of cases is confined to patents applied for after 1897. Constructive abandonment of any invention claimed in such a patent, will be found to have occurred, if its inventor did not make his application for that patent, until more than two years after some person, not in privity with him, received a patent on the same subject in some country, or until more than two years after that subject was described in some printed publication somewhere.[93]

The second class of cases is confined to patents which were applied for after 1897, and on or before March 3, 1903. Constructive abandonment of any invention claimed in such a patent, will be found to have occurred, if its inventor did not make his application for that patent, till more than seven months after he, or some person in privity with him, filed an application for a patent on the same invention, in some foreign country, and if a foreign patent was granted on that foreign application.[94]

[92] Sisson *v.* Gilbert, 9 Blatch. 189, 1871; Jenner *v.* Bowen, 139 F. R. 556, 1905.

[93] 29 Statutes at Large, p. 692, Ch. 391. Sections 1, 3, and 8 construed together.

[94] 29 Statutes at Large, p. 692, Ch. 391. Sections 3 and 8 construed together, and with Section 1 of Ch. 1019 of 32 Statutes at Large.

The third class of cases is confined to patents applied for after March 3, 1903; on processes, machines, manufactures, or compositions of matter. Constructive abandonment of any invention claimed in such a patent, will be found to have occurred, if its inventor did not make his application for that patent, till more than twelve months after he, or some person in privity with him, filed an application for a patent on the same invention, in some foreign country, and if a foreign patent was granted on that foreign application.[95] In the computation of the twelve months' period the day of filing the foreign application is excluded.[96]

The fourth class of cases is confined to patents on designs, applied for after March 3, 1903. Constructive abandonment of any invention claimed in such a patent, will be found to have occurred, if its inventor did not make his application for that patent, till more than four months after he, or some person in privity with him, filed an application for a patent on the same invention, in some foreign country, and if a foreign patent was granted on that foreign application.[97]

An application for a patent in the United Kingdom of Great Britain and Ireland, is filed within the meaning of the law of this section, at the time of the filing of a provisional specification in the British Patent Office, in cases where a provisional specification is filed in that office, in advance of the complete specification.[98]

§ 105. Surrender of an invention may be effected after the grant of letters patent therefor, by means of a formal

[95] 32 Statutes at Large, Part 1, p. 1225, Ch. 1019, Section 1.

[96] Hess-Bright Mfg. Co. *v.* Standard Roller Bearing Co., 171 F. R. 114, 1909.

[97] 32 Statutes at Large, Part 1, p. 1225, Ch. 1019, Section 1.

[98] *In re* Swinburne, 19 App. D. C. 565, 1902.

surrender of those letters patent. A proceeding of the kind was mentioned by the Supreme Court as being undoubtedly proper as early as 1832,[99] and an actual surrender of the sort was tacitly approved by that tribunal about twenty years later.[100]

§ 106. No abandonment of an invention after the issue of letters patent thereon has ever been judicially decided to exist in the United States. The Patent Act of 1832[101] provided that a certain class of aliens might obtain United States patents who had theretofore been excluded from that privilege; but it coupled with that provision an enactment that every patent granted by virtue of that Act should cease and determine in case of failure on the part of the patentee to introduce the invention into public use in the United States within one year from the issuing of the patent, or in case of a discontinuance of such public use for any period of six months, or in case of failure on the part of the patentee to become a citizen of the United States. In providing such a rule of constructive abandonment for a certain class of aliens, Congress showed that it did not overlook the subject of non-user of patented inventions; and in omitting to provide any such rule for citizens of the United States, Congress showed that it did not intend constructive abandonment to result from non-user in their cases. Even as to aliens, the policy of the law upon the point was soon changed. The Act of 1836 repealed all former patent statutes, and did not reenact the provision just cited from the Act of 1832, nor put any corresponding restrictions upon any class of patentees. Nor has any later statute contained any pro-

[99] Grant *v.* Raymond, 6 Peters, 240, 1832.

[100] Battin *v.* Taggert, 17 Howard, 74, 1854.

[101] 4 Statutes at Large, Ch. 203, p. 577.

vision of the kind. The fair inference from this course of legislation seems to be that Congress does not intend any patent right to be lost on any ground of non-user of that right. Even before Congress had thus indicated its intention on the subject, Justice WASHINGTON instructed a jury that no disuser of an invention, after it is patented, can amount to an abandonment, so as to deprive the patentee or his assignees of their exclusive right to it for the term of the patent.[102] So, also, the Supreme Court has held that no presumption arises against a patent, from any use of the invention by the public after the patent is granted.[103] Since no abandonment of an invention, after it is patented, can arise out of any existing statute, nor be based on any non-user by the patentee, or on any user by the public, we are shut up to the conclusion that no such abandonment is known to our laws.

§ 107. Acquiescence by a patentee in unlicensed use of his invention during the life of the patent, has sometimes been said or been intimated by courts to amount to an abandonment of the patent and of the invention. Four cases containing such statements or suggestions are to be found in the reports. In two of them the judges made their observations on the subject, in spite of their decisions that no such question was involved in the pleadings. In the other two cases the views of the judges were inserted in charges to juries, but inasmuch as the juries found for the respective plaintiffs, it seems that there were no facts in the cases which called for such statements in the charges. The opinions of the four judges on the point seem, therefore, to be no more weighty than the reasons which sup-

[102] Gray *v.* James, 1 Peters C. C. Rep. 403, 1817.

[103] Shaw *v.* Cooper, 7 Peters, 320, 1833; Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 869, 1901.

port them. But no reasons applicable to the subject of abandonment of a patent are contained in either of the cases, though one of them contains statements of reasons adapted to support the doctrine of estoppel. Nor do the four cases agree among themselves relevant to the character or to the quantity of acquiescence needed to support an hypothesis of abandonment of a patent. In Wyeth *v.* Stone [104] Justice STORY intimated that such acquiescence must be without objection, and must continue for a series of years. In Ransom *v.* New York,[105] Judge HALL placed no such limitation as the last of these upon the doctrine, and if he hinted at the first of them he hinted but vaguely. In Bell *v.* Daniels,[106] Judge LEAVITT said that it would require a strong case to prove abandonment of a patent actually granted. In Williams *v.* Railroad Co.,[107] Judge WALLACE said: "Neither does mere delay or acquiescence establish an abandonment or dedication of the patent. There must be an acquiescence in the appropriation of the right of such a character as reasonably to induce the belief that the owner intended to relinquish it to the public use." The opinions cited in this section, so far as they disagree with the statutes and decisions cited in the last, do not agree in that disagreement, and they seem insufficient to outweigh, or even to modify, the doctrine set forth in that section.

§ 108. Questions relevant to actual or to constructive abandonment of inventions are questions of fact;[108] and every reasonable doubt relevant to any such question

[104] Wyeth *v.* Stone, 1 Story, 282, 1840.

[105] Ransom *v.* New York, 1 Fisher, 273, 1856.

[106] Bell *v.* Daniels, 1 Bond, 219, 1858.

[107] Williams *v.* Boston & Albany Railroad Co., 4 Bann. & Ard. 441, 1879.

[108] Battin *v.* Taggert, 17 Howard, 84, 1854; Kendall *v.* Winsor, 21 Howard, 330, 1858. See Section 91.

should be solved in favor of the patent, for the law does not favor forfeiture.[109]

[109] Pitts *v.* Hall, 2 Blatch. 238, 1851; McCormick *v.* Seymour, 2 Blatch. 256, 1851; Birdsall *v.* McDonald, 1 Bann. & Ard. 165, 1874; Comstock *v.* Sandusky Seat Co., 3 Bann. & Ard. 188, 1878; Anderson *v.* Eiler, 46 F. R. 779, 1891; Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 850, 1901; Victor Talking Machine Co. *v.* Duplex Phonograph Co., 177 F. R. 248, 1909; Interurban Ry. & Terminal Co. *v.* Westinghouse Electric & Mfg. Co., 186 F. R. 166, 1911.

See Section 88.

CHAPTER VI

APPLICATIONS

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§ 109. An application for a patent consists of the following transactions: The deposit in the Patent Office of a written petition to the Commissioner of Patents; the like deposit of a written specification of the invention; the making of an oath; the payment of the Patent Office fee; and in some cases the deposit of a drawing; and in some cases the deposit of a model; and in some other cases the deposit of specimens.[1] Applications and proceedings on applications are primarily governed by the provisions of the Revised Statutes. Where those provisions do not cover a particular point, that point is governed by the rules of the Patent Office.[2] Every such rule, unless it is inconsistent with law, is as authoritative as the Revised Statutes themselves.[3]

§ 110. The petition is a communication, signed by the applicant and addressed to the Commissioner of Patents, stating the name, present nationality, residence, and present post office address of the petitioner; and requesting the grant of a patent for the invention therein designated by name, and by a reference to the specification for a full disclosure thereof.[4] The petition must be the petition of the inventor, and not of an assignee of the inventor, though it may properly request that the patent, when

[1] Revised Statutes, Sections 4888, 4889, 4890, 4891, 4892, 4893, 4933; Rules of Practice of the United States Patent Office, revised Jan. 1, 1916, Rules 30, 56, 57, 58, 59.

[2] Revised Statutes, Section 483.

[3] United States *v.* Commissioner of Patents, 22 O. G. 1365, 1882; United States *v.* Commissioner of Patents, 104 O. G. 856, 1903; Steinmetz *v.* Allen, 192 U. S. 543, 1904.

[4] Patent Office Rules 33, 86.

granted, shall be granted to an assignee.[5] If, however, the inventor becomes insane or dies before executing a petition, the petition may be made and signed by his guardian, conservator, or representative in trust for his estate, in case of his insanity;[6] or by his executor or administrator in case of his death.[7] And if the inventor was not domiciled in the United States, at the time of his death, the executor or administrator, duly authorized under the law of any foreign country to administer upon his estate, and whose authority is proved by a certificate of a diplomatic or consular officer of the United States, may make and sign the petition.[8]

§ 111. The specification properly consists of six parts.[9] 1. The preamble. 2. A general statement of the nature and object of the invention. 3. A brief description of the drawings, if drawings are made. 4. A detailed description of the invention. 5. The claim or claims. 6. The signature of the applicant. Prior to the amendment of Section 4888 of the Revised Statutes in 1915 two witnesses were required, but that requirement was dispensed with by the Act of March 3, 1915, amending that section.[10]

§ 112. The preamble states the name, present nationality, residence, and present post office address, of the applicant; and where the applicant is acting as representative of an insane or deceased inventor, the preamble states his name, and his nationality and residence at the time of his making the invention, and states also that the ap-

[5] Revised Statutes, Section 4895.

[6] Revised Statutes, Section 4896, as amended, 35 Statutes, 246.

[7] Revised Statutes, Section 4896, and as amended Feb. 28, 1899, in 30 Statutes at Large, Ch. 227, and as amended May 23, 1908, 35 Stat. 245.

[8] Revised Statutes, Section 4896, as amended, 35 Statutes, 246.

[9] Patent Office Rule 39.

[10] Act Mar. 3, 1915, Chap. 94, Section 1, 38 Statutes, 958.

plicant is acting in his capacity as guardian, conservator, representative in trust, executor, or administrator, as the case may be. The preamble also states the title of the invention, in order to connect it by name, with the same title in the petition.

§ 113. The general statement of the nature and object of the invention is a convenient mode of introducing the detailed description. Every such statement should be free from any particularity or limitation which, if imported, by implication, into one or more of the claims, might operate to reduce the area covered by the patent, to territory more narrow than the state of the prior art required.

§ 114. The description of the drawings states what each figure is, but does not state the details of the figures; those details being passed over in that description, to be attended to in the detailed description of the invention.

§ 115. The detailed description of the invention must be full enough, and clear enough, and concise enough, and exact enough, to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make and use the invention, if it is a machine or a manufacture, or to compound the invention, if it is a composition of matter, or to perform the invention, if it is a process,[11] or to identify the invention, if it is a design. If the description falls below this standard, the patent, if granted, will be void.[12] But this standard may be reached, in the case of a design, by a reference to the drawing or photograph [13] annexed to the specification. In the statute

[11] Revised Statutes, Section 4888; Bradford *v.* Expanded Metal Co., 146 F. R. 984, 1906.

[12] O'Reilly *v.* Morse, 15 Howard, 62, 1853.

[13] Dobson *v.* Dornan, 118 U. S. 14, 1885; Anderson *v.* Saint, 46 F. R. 760, 1891.

See Section 174.

by which this standard is established, the phrase "any person skilled in the art or science" includes persons of ordinary and fair information and skill in the relevant art or science; and that phrase is not confined to the most eminent scientists, or to the most competent experts, in that science or art.[14]

The description, in a case of a manufacture, and particularly in a case of a machine, must make constant reference to the drawings, by means of reference letters or reference numerals, incorporated in the description, and placed upon the face of the drawings.[15] Numerals are every way better than letters for this purpose, and are preferred by the Patent Office.[16] They are unlimited in number; instead of being only twenty-six. They are distinguishable from each other in sound; instead of being often indistinguishable, when separately pronounced, as several pairs of the letters of the alphabet are. They are always alike; instead of being printed sometimes as Roman letters and sometimes as Italics, and in either event, sometimes as small letters, and sometimes as capitals.

The statute also says that in case of a machine, the applicant 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.[17] These provisions must be read in the light of their avowed object. That object is identification. The first provision cannot mean that the inventor must infallibly explain the law of nature which makes his machine work; for if it means that, neither Morse nor Bell complied with it when describing the telegraph or the telephone,[18] and, indeed, neither

[14] Tannage Patent Co. *v.* Zahn, 66 F. R. 989, 1895.

[15] Patent Office Rule 38.

[16] Patent Office Rule 38.

[17] Revised Statutes, Section 4888.

[18] Emerson Co. *v.* Nimocks, 99 F. R. 739, 1900; National Meter

Morse nor Bell nor any man could have done so. The second provision cannot mean that every inventor must infallibly judge which of several forms of his machine will eventually be found to work best, for if it means that, it requires what is often impossible: requires the inventor to foresee the ultimate effects of new and comparatively untried causes. The first provision means that the essential distinctive characteristic of the machine shall be explained; [19] and the second provision means that the inventor shall state the mode which he contemplates to be the best.[20] Inasmuch as the validity of a patent depends on the sufficiency of the description, the subject of this section is treated with more detail in the chapter on letters patent, the seventh of this book. Enough has been outlined in this connection, to show what kinds of statements those descriptions need to contain.

§ 116. The claim or claims constitute a necessary part of every specification. The statutory requirement in this regard is, that the applicant "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention." [21] The practice of the Patent Office has always been to require the claim or claims to be made in that part of the specification which immediately precedes the signatures.

It is a practice of some solicitors of patents to write claims in vague phraseology, with an idea that vagueness is elasticity, and that elasticity is excellence. They stretch their claims to catch infringers; and are apt to stretch them

Co. *v.* Thomson Meter Co., 106 F. R. 538, 1900.

[19] National Meter Co. *v.* Thomson Meter Co., 106 F. R. 538, 1900.

[20] Carver *v.* Mfg. Co., 2 Story, 432, 1843; Page *v.* Ferry, 1 Fisher, 309, 1857; Vrooman *v.* Penhallow, 179 F. R. 296, 1910.

[21] Revised Statutes, Section 4888.

to the breaking point, by making them vague and elastic enough to cover inventions in the prior art, and to be invalidated thereby.[22] It is a practice of some solicitors, to multiply claims, with variant language. Thus they hope to hit every competitor, with one claim or another; or to divert them all from competition, by a multiplicity of appearances. But the courts have frequently expressed their disapprobation of multiplying claims unnecessarily,[23] and such multiplication is dangerous to the validity of patents.[24]

It is a proper practice to make a generic claim and also a specific claim, in an application for a patent on a generic invention, even where only one species is described in the specification.[25] In such a case, if the inventor's understanding that his invention is primary, turns out to be true, both claims will be valid. But if some invention is afterward discovered in the prior art, which relegates the patent to a secondary place, the specific claim may stand and be valid, though the generic claim is too broad to be maintained.

§ 117. In a case where the description sets forth an entire machine, the applicant may lawfully make a claim co-extensive with the description, if the machine as a whole possesses novelty. But such a claim ought seldom to be the only one in a patent; because, for reasons stated in the chapter on infringement, it can, in most cases, be readily evaded. The proper practice is to fix upon the new parts, or new combinations, which the described machine con-

[22] Bracewell *v.* Passaic Print Works, 107 F. R. 473, 1901.

[23] Westinghouse Air-Brake Co. *v.* New York Air-Brake Co., 112 F. R. 431, 1901.

[24] Carlton *v.* Bokee, 17 Wallace, 463, 1873.

[25] Hill *v.* Hodge, 12 App. D. C. 530, 1898; J. L. Owens Co. *v.* Twin City Separator Co., 168 F. R. 259, 1909; Ryder *v.* Townsend, 188 F. R. 792, 1911; Zittlosen Mfg. Co. *v.* Boss, 219 F. R. 887, 1914.

tains, and to make a separate claim for each of those parts, and for each of those combinations.[26]

But one patent or claim having been granted to an inventor, upon a particular part or combination, as performing particular functions, no valid claim or patent can be afterward granted to him, on the same part or combination, as performing a part only of the functions called for by the claim of the first patent.[27] And it is advisable to take out all patents, on the same day, on different combinations of parts, some of which are in each of the different combinations. To secure a particular part of a machine, a claim must specify that part; and to secure a particular combination of some of the parts of a machine, a claim must specify all of those parts, and the description must explain their joint mode of operation, and must state their joint function.[28]

And a part or a combination may be claimed separately, though it cannot do useful work separately from the residue of the machine or apparatus of which it constitutes a part.[29] Otherwise an infringer might take the most important part of an invention, and by changing the method of adapting it to its environment, might avoid

[26] Gill *v.* Wells, 22 Wallace, 24, 1874; Adams *v.* Jones, 1 Fisher, 530, 1859; National Malleable Casting Co. *v.* American Steel Foundries, 182 F. R. 626, 1910.

[27] Miller *v.* Eagle Co., 151 U. S. 199, 1894.

[28] Parks *v.* Booth, 102 U. S. 102, 1880; Forbush *v.* Cook, 2 Fisher, 669, 1857.

[29] Hancock Inspirator Co. *v.* Jenks, 21 F. R. 915, 1884; Rapid Service Store Ry. Co. *v.* Taylor, 43 F. R. 251, 1887; Roberts *v.* Nail Co., 53 F. R. 920, 1892; Holloway *v.* Dow, 54 F. R. 516, 1893; Brammer *v.* Schroeder, 106 F. R. 929, 1901; Thompson-Houston Electric Co. *v.* Black River Traction Co., 135 F. R. 759, 1905; Kenney Mfg. Co. *v.* J. L. Mott Iron Works, 137 F. R. 431, 1905; Clark Blake & Razor Co. *v.* Gillette Safety Razor Co., 194 F. R. 421, 1912; National Malleable Castings Co. *v.* American Steel Foundries, 182 F. R. 626, 1910.

any charge of infringement. The invention of a needle with an eye near the point, is the one essential element of all sewing machines. But the possible mechanisms for operating such a needle are many, and if its inventor had been obliged to make his own mechanism a part of every claim in which his needle was an element, his patent would have been destitute of value to him; [30] though his invention was one of the most valuable in the history of mankind.

It is not necessary, however, that a claim specify all the various means shown in the specification and drawings for connecting the various parts of the combination, as it is to be interpreted to include such connections of the several parts as are necessary to make them operative.[30a]

§ 117*a*. A part of a machine when claimed alone, may be specified by the use of its name in the claim, where no other part of the machine has a similar name; but where the use of a name alone, is not sufficiently specific to show what part of the machine is referred to, that object can be accomplished by mentioning, in the claim, the reference letter or numeral, which is used to indicate that part in the description and in the drawings. Such a use of a reference letter or numeral does not necessarily confine the claim to a part having all the characteristics of the part which, in the drawings, is indicated by the letter or numeral; [30b] because a claim which expressly covers a particular device, impliedly covers any equivalent of that device; and other devices will be held to be equivalent

[30] Deering *v.* Winona Harvester Works, 155 U. S. 302, 1894; Chambers-Bering-Quinlan Co. *v.* Faries, 75 F. R. 663, 1896.

[30a] Duncan *v.* Stockham, 204 F. R. 781, 1912; Jones *v.* Evans, 215 F. R. 586, 1914.

[30b] Campbell Printing-Press Co. *v.* Marden, 64 F. R. 785, 1894; National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 715, 1901.

or not equivalent, by means of certain tests, which are explained in the chapter on infringement, and which are quite foreign to the question whether a particular device is designated in a claim by a reference letter or numeral, or by a name alone, or in some other way.

It is true that where the particular characteristics of the parts of the combination shown in the drawings of a patent, are all that differentiate it from the prior art; and where those parts are specified in an amended claim by reference letters or numerals, in pursuance of a rejection by the Patent Office of a prior claim which was broad enough to cover the prior art; the amended claim is limited to a combination of parts having those particular characteristics; for if not so restricted, the effect would be to make the claim co-extensive with what the Patent Office rejected.[31] But the same thing is true, in an otherwise similar case, where the parts of the combination are specified, in an amended claim, by names alone, or in any other way.[32] The breadth or the narrowness of a claim as the case may be, does not depend upon any artificial rule of interpretation;[33] and to narrow a broad invention by reference letters or numerals alone, would be to frame and enforce such a rule.

Where some of the parts of a combination operate therein to give motion to other parts, which do the final work of the combination, it is proper to specify the former by the use of such terms as "means," "mechanism," or "devices" for giving that motion,[34] except when these

[31] Knapp *v.* Morss, 150 U. S. 228, 1893; Lehigh Valley R. R. Co. *v.* Kearney, 158 U. S. 469, 1895.

[32] McCormick Harvesting Mach. Co. *v.* C. Aultman & Co., 69 F. R. 393, 1895.

[33] Topliff *v.* Topliff, 145 U. S. 171, 1892.

[34] Brush Electric Co. *v.* Ft. Wayne Electric Light Co., 40 F. R. 833, 1889; Brush Electric Co. *v.* Western Electric Co., 43

terms are applied to an element or part which constitutes the essence of the invention. If they are used under such circumstances the claim will be regarded as functional.[35] But such general language will not include all means, mechanism, or devices which can perform that function, but only those which are shown in the patent, and their equivalents.[36] And in this case also, the question whether other means, mechanism, or devices are equivalents of those shown in the patent, will be determined by the established rules on that subject, rather than by any apparent precision or elasticity of the language used in the claims to designate the parts involved in the inquiry.

§ 118. In cases where the description sets forth a manufacture, there ought to be a separate claim for each of its patentable features, or at least for the article without any dispensable feature; for if there is but one claim, and if all those features are covered by it, then those persons who manage to dispense with even the least of them, incur no liability by making, using, or selling articles which possess all the others.[37]

§ 119. In cases where the description relates to a composition of matter, the claim should cover that composition in its entirety, and should, either expressly, or

F. R. 537, 1890; Brush Electric Co. *v.* Electric Imp. Co., 52 F. R. 975, 1892.

[35] Davis Sewing Machine Co. *v.* New Departure Mfg. Co., 217 F. R. 775, 1914.

[36] Dudley E. Jones Co. *v.* Munger Mfg. Co., 49 F. R. 64, 1891; Williams *v.* Steam Gauge & Lantern Co., 47 F. R. 323, 1891; Colts Patent Firearms Mfg. Co. *v.* Wesson, 127 F. R. 333, 1903; American Can Co. *v.* Hickmott Asparagus Co., 142 F. R. 141, 1905; Union Match Co. *v.* Diamond Match Co., 162 F. R. 148, 1908; Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

[37] Prouty *v.* Ruggles, 16 Peters, 336, 1842.

by reference to the description, specify the respective proportions which the different ingredients bear to each other.[38] But where some of the described ingredients may be dispensed with, the applicant, if he states that fact in the description, may have a separate claim for a composition of matter composed only of the residue; or he may have a single claim covering the indispensable ingredients, whether with or without the others.[39]

§ 120. In cases where the description relates to a process, the claim should cover all the necessary occurrences in that process, and cover no more. If it covers less it will be void for want of utility; and if it covers more, it can be evaded by persons who omit any one which is unnecessary, when using the others.

§ 120*a*. In cases where the description and its accompanying drawing or photograph represent a design, the claim may identify its subject by a reference to that drawing or photograph.[40] But where a claim for a design ends with the words "substantially as shown" that claim refers to the description as well as to the drawing.[41] And a design patent may contain a claim for the entire design, with other claims for such of the parts of the design as are independently patentable.[42] But several unconnected ornaments cannot lawfully be aggregated and claimed together in one claim.[43]

§ 121. The signatures of the applicant must embody

[38] Tyler *v.* Boston, 7 Wallace, 327, 1868; Panzl *v.* Battle Island Paper Co., 138 F. R. 48, 1905.

[39] Rubber Co. *v.* Goodyear, 9 Wallace, 788, 1869.

[40] Dobson *v.* Dornan, 118 U. S. 14, 1885.

See Section 174.

[41] Whittall *v.* Lowell Mfg. Co., 79 F. R. 789, 1897.

[42] Dobson *v.* Hartford Carpet Co., 114 U. S. 446, 1885; Britton *v.* White Mfg. Co., 61 F. R. 95, 1894.

[43] Dukes *v.* Bauerle, 41 F. R. 781, 1890.

the full name and must be legibly written.[44] Witnesses to the drawing are not required since the Act of March 3, 1915, amending Section 4889 of the Revised Statutes went into effect.[45] The grammatical construction of the prior statutory provisions, relevant to signatures, seems to indicate that the document signed by the applicant, and not the signature of that applicant, is the thing which is to be attested by the two witnesses. In cases where language of similar character has been used in statutes which prescribe the mode of attesting wills, it has been decided to be immaterial, whether the witnesses sign before or sign after the execution of the document;[46] but where such statutes have provided for attesting the signatures rather than the will, it is the law that the document is void if the witnesses sign before the testator.[47] It was the practice of the Patent Office when witnesses were required, to regard the attestation as being attestation of the signatures, and, accordingly, to require two witnesses for each signature, in cases of joint applications for joint letters patent. The same two witnesses could indeed attest all the signatures; but where one witness attested the signature of one joint inventor, and another witness attested the signature of the other, of two joint inventors, the Patent Office held the attestation to be insufficient. It has been held that, where one of the witnesses has signed the drawing with the names of the inventors and has also signed the name of the attorney in fact, there is a presumption that he had authority to do so, and that as it did not appear that the Commissioner was misled on the merits, or that there was any fraud or

[44] Patent Office Rule 40.

[45] Act Mar. 3, 1915, Chap. 94, Sec. 1, 38 Statutes at Large, 958.

[46] O'Brien *v.* Gallagher, 25 Conn. 229, 1856.

[47] Wharton on Evidence, Section 888.

intent to deceive, such facts did not operate to defeat the patent.[48]

§ 122. The oath is not required by the statute to be in writing, nor to be recorded. It may be taken anywhere in the United States, before any person authorized by law to administer oaths at that place; or, when the applicant resides in a foreign country, it may be taken before any minister, chargé d'affaires, consul, or commerical agent, holding commission under the government of the United States, or before any notary public, judge, or magistrate, having an official seal, and authorized to administer oaths in the foreign country in which the applicant may be, and whose authority may be proved by a certificate of a diplomatic or consular officer of the United States.[49]

Recital in the letters patent, that the required oath was made by the applicant, is, in the absence of fraud, conclusive evidence of that fact.[50] The presence, in the files of the Patent Office, of a paper purporting to be the oath in a given case, but void for lack of a jurat, or for some other fault, is a harmless circumstance.[51] In such a case the law presumes that the oath recited in the letters patent was made orally, or was embodied in some other paper. It is presumed that the Commissioner will never issue a patent till he is satisfied that the applicant has somehow made

[48] Hallock *v.* Babcock, 121 F. R. 226, 1903; Patterson *v.* United States, 202 F. R. 208, 1913.

[49] Revised Statutes, Section 4892, as amended in 32 Statutes at Large, Part 1, p. 1225, Ch. 1019, Section 2.

[50] Seymour *v.* Osborne, 11 Wallace, 516, 1870; Wayne Mfg. Co. *v.* Coffield Motor Washer Co., 227 F. R. 987, 1915.

[51] Crompton *v.* Belknap Mills, 3 Fisher, 536, 1869; De Florez *v.* Reynolds, 14 Blatch. 506, 1878; Hoe *v.* Kahler, 12 F. R. 111, 1882; Hancock Inspirator Co. *v.* Jenks, 21 F. R. 914, 1884; Empire Cream Separator Co. *v.* Sears, Roebuck & Co., 157 F. R. 238, 1907.

oath to the facts to which the statute requires him to swear. When the Commissioner is so satisfied, and recites the fact in the letters patent, all inquiry on the subject is foreclosed, except in cases of actual fraud.[52] Rule 47 of the Patent Office provides, however, that the oath or affirmation is to be attested in all cases by the proper official seal of the officer before whom it is taken. That implies that the Commissioner requires the oath to be put into writing. If, however, he were to waive that requirement in a given case, and were to content himself with an oral oath, and were to recite in the patent that the required oath was made, the law would still have been complied with.

§ 123. The statute requires an applicant to make oath to the statement that he does verily believe himself to be the first inventor of the invention for which he solicits a patent, and to state of what country he is a citizen.[53] In the expression "described *and* claimed" found in the form of oath prescribed by the Patent Office (Rule 46) the word "and" is construed as a disjunctive, and accordingly the oath applies to what is described and also to what is claimed, and is not limited merely to what is both described and claimed.[54] The Patent Office rule requires that the statement mentioned shall also be made in the oath; and that the applicant shall also state in the oath, where he resides; and that the invention has not been patented to himself, or to any other person with his consent or knowledge, in any country, more than two years prior to his application, or on an application filed in any

[52] Wayne Mfg. Co. *v.* Coffield Motor Washer Co., 227 F. R. 987, 1915.

[53] Revised Statutes, Section 4892, as amended in 32 Statutes at Large, Part 1, Ch. 1019, Section 2.

[54] Crompton & Knowles Loom Works *v.* Stafford Co., 205 F. R. 925, 1913.

foreign country, by any person in privity with him, more than twelve months prior to his application; and that, to the best of his knowledge and belief, the invention has not been in public use or on sale in the United States, nor described in any printed publication or patent in any country, for more than two years prior to his application in this country.[55]

The Patent Office rule also requires certain other statements to be made in oaths, in certain special cases.[55]

The statute of 1836, which was in force till the approval of the Act of 1870, required the applicant to make oath or affirmation of what country he was a citizen,[56] whereas the Act of 1870, and the Revised Statutes, require only his statement on that subject. The old law governs all applications made before July 8th, 1870; and under it Justice GRIER decided, for certain reasons which have not existed since 1870, that where an applicant mentioned a wrong country in his oath, that error rendered his patent void, even though it arose from an erroneous opinion relevant to what constituted citizenship of the United States.[57] But under the statute of 1870, re-enacted in the Revised Statutes, such an error does not invalidate a patent.[58]

When an application for a patent is made by an executor or administrator of a deceased inventor, the statute directs the oath to be so varied in form that it can be made by him.[59] Whether, in such a case, it is necessary for the applicant to swear that he believes that the deceased be-

[55] Patent Office Rule 46.

[56] 5 Statutes at Large, Ch. 357, Section 6, p. 119.

[57] Child *v.* Adams, 1 Fisher, 193, 1854.

[58] Tonduer *v.* Chambers, 37 F. R. 337, 1889.

[59] Revised Statutes, Section 4896, as amended in Act May 23, 1908, 35 Stat. 245.

lieved himself to be the first inventor, or whether it is necessary for the applicant to swear that he believes that the deceased was in fact the first inventor of the invention, is an unsettled question. If the first is the true view, then an executor may obtain, without perjury, a patent for an invention which he may know to have been previously used in the United States. If the second is the true view, then an executor may be unable to obtain, without perjury, a patent for an invention never before known or used in this country, and not previously patented or described in any printed publication, in this or any foreign country, and not known or believed by its inventor, to have been previously known or used anywhere in the world. In the first of these contingencies, a wrong may result to the public, and in the last, a wrong may result to the beneficiaries of the deceased.

§ 124. An affirmation in judicial form may always be substituted for any oath required by any United States statute.[60] Nor is this rule confined, as it is in the statutes of some of the States, to cases where the affiant informs the magistrate that he has scruples of conscience against taking an oath.

§ 125. The Patent Office fee, due with the application for a patent for a process, machine, manufacture, or composition of matter, is fifteen dollars, and a final fee of twenty dollars is payable after such a patent has been allowed and before it is issued. The fees for patents for designs, vary with the length of the terms of the patents applied for. For such a patent for three years and six months, the fee is ten dollars: for such a patent for seven years, the fee is fifteen dollars: for such a patent for fourteen years, the fee is thirty dollars.[61] Fees for design

[60] Revised Statutes, Section 1.

[61] Revised Statutes, Section 4934.

patents are required to be paid in advance.[62] The final fee, above mentioned, must be paid within six months after the patent is allowed, and notice thereof is sent to the applicant or his agent; and the patent must issue within three months after the fee is paid; and if that fee is not paid within the six months, the statute provides that the patent shall be withheld.[63] The Commissioner of Patents has no jurisdiction to do what the statute forbids. Therefore if he were to issue a patent on an application, the final fee for which was not paid till more than six months after the patent was allowed, he would be acting without authority, and the patent would, for that reason, be void. At common law, a month is a lunar, not a calendar month.[64] Many of the States have reversed this definition by statute, and though Congress has never done so, the Supreme Court of the United States has reached that good result by judicial interpretation; and the word "month" wherever it occurs in the patent laws, must now be taken to mean a calendar and not a lunar month.[65]

§ 126. Drawings are required by the statute to be furnished by applicants for patents, in all cases wherein the invention admits of representation by drawings.[66] The statutory requirement relevant to the character of such drawings, is merely that they shall be signed by the applicant or by his attorney in fact. The Patent Office rules require, in addition, that drawings must show every feature of the invention covered by the claims; and when the invention consists of an improvement on an old machine, must exhibit, in one or more views. the invention itself,

[62] Patent Office Rule 190.

[63] Revised Statutes, Section 4885, as amended by Act May 23, 1908, 35 Stat. 246.

[64] Blackstone, Book 2, Ch. 9.

[65] Guaranty Trust Co. *v.* Railroad Co., 139 U. S. 145, 1891.

[66] Revised Statutes, Section 4889.

disconnected from the old structure, and also, in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.[67] Those rules also describe numerous other characteristics for drawings,[68] which must be carefully followed, in order to secure favorable action from the Patent Office.

To be as useful as possible, all drawings for letters patent ought to show the true positions and proportions of the parts of the devices which they purport to delineate so far as necessary to show the invention; but it is not necessary that they be accurate enough to be used as working drawings, from which to construct specimens of those inventions.[69]

Drawings in applications filed prior to July 8, 1870, and after July 4, 1836, were required to have "written references."[70] The object of such references was to connect the various parts of the drawings with the corresponding parts of the specification; but it was a sufficient compliance with that statute, where those references were made on the drawings, though not made in the specifications.[71] The present statute says nothing about any references, or other means of connecting drawings with specifications; but the Patent Office rules require that they shall be connected by figures adjacent to the different views, and by letters or numerals adjacent to the different parts of the drawings, and by incorporating those figures and letters or numerals in the descriptive part of the specification.[72]

[67] Patent Office Rule 50.

[68] Patent Office Rule 52.

[69] American Hide and Leather Splitting Machine Co. *v.* Machine Co., 4 Fisher, 284, 1870; Royer *v.* Coupe, 29 F. R. 369, 1886; Wold *v.* Thayer & Chandler, 148 F. R. 227, 1906; Manhattan Book Casing Mach. Co. *v.* E. C. Fuller Co., 204 F. R. 286, 1913.

[70] 5 Statutes at Large, Ch. 357, Section 6, p. 119.

[71] Emerson *v.* Hogg, 2 Blatch. 1, 1845.

[72] Patent Office Rule 38.

§ 127. A model of the invention is required by the statute to be furnished by the applicant, in all cases wherein the invention admits of representation by model, provided the Commissioner requires a model.[73] This proviso was not in the statute of 1836, but it was inserted in that of 1870, in order to enable the Commissioner to dispense with models, in all cases where their utility is inferior in value to their cost, and to the room they would occupy in the Patent Office. Under the operation of the proviso, models are at present called for by the Commissioner in very few of the cases which admit of representation thereby.

§ 128. Specimens of compositions of matter, and of the ingredients thereof, are required by the statute to be furnished by applicants for patents for such compositions of matter, in all cases where the Commissioner calls for such specimens.[74] He always does call for at least a specimen of the composition, put up in proper form to be preserved, unless that composition is in its nature perishable.[75]

§ 129. An application for a patent dates from its filing in the Patent Office, and not from the day of its execution by the applicant, nor from the day of the deposit of a model in the Patent Office, nor from the day of the deposit of anything there less than the full application,[76] but where an application is divided by filing a new one for part of its subject, the new one will date from the date of the old one.[77] In the absence of other evidence, the date of the application for a particular patent, is taken to be identical

[73] Revised Statutes, Section 4891; Patent Office Rule 56.

[74] Revised Statutes, Section 4890.

[75] Patent Office Rule 62.

[76] Draper *v.* Wattles, 3 Bann. & Ard. 618, 1878; Henry *v.* Francestown Soap Stone Stove Co., 5 Bann. & Ard. 108, 1880; Campbell *v.* New York, 35 F. R. 504, 1888.

[77] Smith & Griggs Mfg. Co. *v.* Sprague, 123 U. S. 250, 1887; H. J. Heinz Co. *v.* Cohn, 207 F. R. 547, 1913.

with the date of the letters patent itself.[78] Letters patent, and printed certified Patent Office copies of letters patent, not old enough to have expired, always have upon them, in the space under the title, a memorandum that the application therefor was filed on a particular specified day. But no such memorandum is evidence of the fact it recites, unless admitted for the purpose without objection.[79] It is not evidence at common law, nor in pursuance of any statute. That section of the Revised Statutes [80] which gives evidential character to certain certified copies, does not include any such memorandum, because it is no part of the letters patent upon which it is placed, and because it is not a copy of any record, book, paper, or drawing belonging to the Patent Office. It is an indication of what some such record, book, or paper appears to show, but it is not evidence of its own accuracy, nor is it covered by the certificate attached to the document upon which it is placed. Even where the application date is regularly proven by competent evidence, the proof of date must be supplemented by proof of the condition of the application at that date, at any rate if the patent was issued after the date of issuance of the patent in suit and was not pleaded.[81]

§ 129*a*. A register of attorneys is kept in the Patent Office, of all persons who are entitled to represent applicants before the Patent Office, in the presentation and prosecution of applications for patents.[82] No person whose

[78] *Worley v. Tobacco Co.*, 104 U. S. 342, 1881; *Fay v. Mason*, 120 F. R. 511, 1903.

[79] *Drewsen v. Hartje Paper Co.*, 131 F. R. 734, 1904; *Twentieth Century Motor Car & Supply Co. v. Holcomb Co.*, 220 F. R. 669, 1915.

[80] *Revised Statutes*, Section 892; see Section 506.

[81] *Roth v. Harris*, 168 F. R. 279, 1909; *Sundh Electric Co. v. Interborough Rapid Transit Co.*, 198 F. R. 94, 1912.

[82] Patent Office Rule 17.

name is not on that register, is permitted to prosecute such an application, except on an invention which he himself has made, or which has been assigned to him.[83] Any attorney at law in good standing in any court of record, anywhere in the United States or any Territory thereof, will, upon his written request, be admitted to that register, when he furnishes a certificate of the clerk of such court, duly authenticated under the seal of the court, that he is an attorney in good standing therein. And any person, not an attorney at law, will likewise be admitted, upon his written application, when he files proof to the satisfaction of the Commissioner of Patents, that he is a person of good moral character and good repute, and that he is competent to render valuable services in assisting applicants, in the presentation and prosecution of applications before the Patent Office.[84]

Any person may be expelled from the Patent Office register, when he is shown to be incompetent or disreputable, or to be guilty of gross misconduct.[85] Such a showing cannot be made *ex parte;* but only at a hearing before the Commissioner of Patents, on charges of which the accused person has had notice, and to which he is given an opportunity to reply, by evidence and argument, in person and by an attorney.[86] No appeal lies from any action of the Commissioner of Patents on such charges;[87] but that action, if adverse to the accused, must be approved by the Secretary of the Interior before it is enforced.[88] That approval may be given by an indorsement upon the recorded judg-

[83] Patent Office Rule 17; 23 Statutes at Large, Ch. 98, Section 5.

[84] Patent Office Rule 17.

[85] Revised Statutes, Section 487, and 23 Statutes at Large, Ch. 98, Section 5.

[86] Rule 9 of the Interior Department.

[87] Weddeburn *v.* Bliss, 12 App. D. C. 500, 1898.

[88] Revised Statutes, Section 487.

ment of the Commissioner, and without any hearing before the Secretary himself.[89]

§ 130. Those transactions which constitute an original application for a patent, have thus far constituted the subjects explained in this chapter. While such an application is pending in the Patent Office, the Commissioner of Patents has no authority to furnish a copy of any paper which belongs to it, to anyone, except the applicant, or his attorney or agent. And no Patent Office official has any authority to give to any person any information about any pending application; except so far as the rules of the Patent Office authorize the giving of certain limited information specified therein, to those who make or who represent an interfering application.[90]

When an application is made by any person, it becomes the duty of the Commissioner to cause an examination thereof, and of the invention covered thereby. If upon such examination, it appears that the applicant is justly entitled to a patent under the law, it is the duty of the Commissioner to issue one to him for that invention.[91] The statute does not prescribe that the Commissioner shall cause this examination to be made by any particular subordinate, and he may overrule the decision of any subordinate to whom he may have committed the matter.[92]

The examination may extend not only to the novelty of the invention covered by the application, but also to any other question upon which its patentability may depend. In examining any question of fact in that subject, the Patent Office officials are not confined to technical evi-

[89] Weddeburn *v.* Bliss, 12 App. D. C. 500, 1898.

[90] United States *v.* The Commissioner of Patents, 54 O. G. 267, 1890.

[91] Revised Statutes, Sections 4893, 4886.

[92] Hull *v.* Commissioner of Patents, 7 O. G. 559, 1875; 8 O. G. 46, 1875.

dence, but may base their judgments upon any books, publications or records which they think proper.[93] But they should not take any notice of any statement which may be made, relevant to the question of patentability of any pending application, by any person not in privity therewith; except so far as they may consult with each other on such questions. When such a statement is received in writing by the Commissioner of Patents, or any other Patent Office official, it may properly be returned to the sender as impertinent. Citizens have no right to intervene in such cases.[94]

§ 131. Whenever, after an examination, any application for a patent is rejected, it is the duty of the Commissioner to notify the applicant thereof, giving him the reasons for such rejection, together with such information and references, as may be useful in judging of the propriety of prosecuting the application, or of altering the specification; and if, after receiving such a notice, the applicant persists in his request for a patent, with or without altering his specification, it thereupon becomes the duty of the Commissioner to cause a re-examination of the case.[95] Every applicant who has been twice required to divide his application under Rule 41 of the Patent Office is entitled to an appeal to the examiners-in-chief.[96] Prior to the revision of the Patent Office Rules of January 1, 1916, one requirement of division was sufficient to entitle the applicant to such an appeal.

§ 132. If, without amending his specification, the applicant persists in his request for a patent, and if the application is again rejected by the primary examiner, to whom

[93] Drawbaugh *v.* Seymour, 77 O. G. 318, 1896.

[94] United States *v.* Allen, 101 O. G. 1133, 1902.

[95] Revised Statutes, Section 4903; Patent Office Rule 65.

[96] Patent Office Rule 133; Steinmetz *v.* Allen, 192 U. S. 543, 1904.

the Commissioner referred the case, then the applicant may appeal to the board of examiners-in-chief;[97] and if unsuccessful there, he may appeal to the Commissioner.[98] If the Examiner refused to forward the appeal and the Commissioner refused to compel him to do so, the proper remedy is to apply to the Court of Appeals of the District of Columbia for a writ of mandamus to compel him to do so, as appeal does not lie in such case.[99] Such an appeal may be heard by the Commissioner, or by the Assistant Commissioner, or the First Assistant Commissioner, under assignment by the Commissioner to that duty.[100] If an appeal is thus heard by the Assistant Commissioner, no appeal from his decision lies to the Commissioner. And no decision of any Commissioner or any Assistant Commissioner of Patents, can be reconsidered and set aside by any successor, except for fraud, clerical error apparent on the face of the record, or newly discovered evidence, presented under circumstances which would justify a new trial in an action at law.[101]

And all appeals must be heard on the case as submitted to the primary examiner.[102] No appeal, therefore, should be taken until the application is in such a condition that the patent will issue, if the decision of the primary examiner is reversed.[103] If that decision is reversed by the board of examiners-in-chief, the primary examiner can require no amendment,[104] but must pass the case for

[97] Revised Statutes, Section 4909.

[98] Revised Statutes, Section 4910.

[99] *Ex Parte* Frasch, 192 U. S. 566, 1904.

[100] United States *v.* Duell, 95 O. G. 1049, 1901, Act July 16, 1914, c. 141, Sec. 1, 38 Statutes, 491.

[101] *In re* Hoeveler & McTighe, 21 D. C. Rep. 107, 1892.

[102] Hammond's Appeal, 2 O. G. 57, 1872.

[103] Mewes' Appeal, 2 O. G. 617, 1872.

[104] Brunner's Appeal, 1 O. G. 303, 1872.

issue. If the board affirms the decision of the primary examiner, the Commissioner will not reverse the board on any question of fact, unless its decision was clearly against the weight of evidence.[105] If the Commissioner affirms the decision of the board, because the patent ought not, in his judgment, to issue, he need assign but one reason for that opinion. The applicant cannot demand of him that he pass upon any other question.[106] And the Commissioner may, at any time before the issue of a patent, reverse his own or any other favorable Patent Office action thereon,[107] except that of a predecessor of himself, or of a predecessor of the Assistant Commissioner,[108] and may thereupon reject the application.

In Lowry v. Allen [109] *it is held that Rule* 124 of the Patent Office providing that no appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same is not in violation of Sections 482, 4904, 4910, 4911 of the Revised Statutes as those statutes provide only for appeals on questions of priority of invention and appeals on other questions are left by Section 483 to the regulation of the Patent Office.[109]

When the Primary Examiner refused to transmit an appeal to the examiners-in-chief the Commissioner in a proper case is charged with the duty of compelling him to do so.[110]

[105] Hazelip *v.* Richardson, 10 O. G. 747, 1876.

[106] Commissioner of Patents *v.* Whiteley, 4 Wallace, 532, 1866.

[107] United States *v.* Butterworth, 3 Mackey, 233, 1884.

[108] *In re* Hoeveler & McTighe, 21 D. C. Rep. 107, 1892.

[109] Lowry *v.* Allen, 203 U. S. 476, 1906.

[110] Steinmetz *v.* Allen, 192 U. S. 543, 1904.

§ 133. When the Commissioner of Patents, or the Assistant Commissioner, finally rejects an application for a patent, the applicant may appeal to the Court of Appeals of the District of Columbia,[111] but not to the Secretary of the Interior;[112] and if the Commissioner refuses to allow that appeal, he may be compelled to do so, by a writ of mandamus, granted by that court, upon the petition of the applicant.[113] No appeal lies to that court from a rejection of an amendment; but only from final rejections of specifications as originally filed, or as amended by leave of the Patent Office;[114] nor from any decision requiring a division of an application;[115] mandamus to the Commissioner is the proper remedy to compel an appeal in the patent office in a proper case;[116] nor from any denial of a rehearing;[117] nor from any rejection of a second application, of the same applicant, for a patent on the same subject, as that of an application previously rejected.[118] Such an appeal must be taken within the time provided for it by the rules of the court.[119] To sum up appeals to the Court of Appeals of the District of Columbia from the Commissioner of Patents is limited to two classes of decisions, namely, "a final rejection of an application for a patent, and a final award of priority to one of the parties in an interference case."[119a] In appeals in interference

[111] 27 Statutes at Large, Ch. 74, Section 9, p. 436; Revised Statutes, Section 4911; Revised Statutes relating to the District of Columbia, Section 780.

[112] Butterworth *v.* Hoe, 112 U. S. 50, 1884.

[113] Commissioner of Patents *v.* Whiteley, 4 Wallace, 533, 1866.

[114] *In re* Chinnock, 21 D. C. Rep. 594, 1893.

[115] *In re* Frasch, 20 App. D. C. 301, 1902; see *Ex Parte* Frasch, 192 U. S. 566, 1904.

[116] U. S. *ex rel.* Steinmetz *v.* Allen, 192 U. S. 543, 1904.

[117] *In re* Messenger, 12 App. D. C. 536, 1898.

[118] *In re* Barratt, 14 App. D. C. 255, 1899.

[119] *In re* Hien, 166 U. S. 432, 1897.

[119a] *In re* Fullagar, 32 App. D. C. 222.

cases the court will not pass on the patentability of the alleged invention.[119b]

Where an appeal is taken to the Court of Appeals of the District of Columbia, the applicant is required to give notice thereof to the Commissioner, and to file in the Patent Office, within such time as the Commissioner shall appoint, his reasons for the appeal, specifically set forth in writing.[120]

The court before hearing the appeal, gives notice to the Commissioner of the time and place thereof, and the Commissioner is required, thereupon, to give like notice to all persons who appear to be interested in the case. The appellant is required to lay before the court, at the hearing, certified copies of all the papers in the case, and the Commissioner is required to furnish the court with a full written statement of the grounds of his decision; 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.[121]

None of the papers which go from the applicant, or from the Commissioner, to the court on an appeal, are kept secret in the court;[122] though the papers of which they are copies, and all the other papers in the case, are kept concealed from the public in the Patent Office, until the case is finally disposed of there, after the court has rendered its decision.

The court hears the case on the papers which were before the Commissioner, and confines its revision of the Commissioner's decision, to the points set forth in the

[119b] Schupphaus *v.* Stevens, 95 O. G. 1452.

[120] Revised Statutes, Section 4912.

[121] Revised Statutes, Section 4913.

[122] *In re* Drawbaugh, 66 O. G. 1451, 1894.

appellant's reasons of appeal. The court will not review any point of Patent Office practice, unless some substantial right was affected, and there was an abuse of discretion, involved in what was done in the Patent Office, in respect thereto.[123] Where all those who passed upon an application in the Patent Office, reached the same conclusion on the questions involved therein, the appellant must make out a very clear case of error, in order to obtain a reversal of the decision from which he appealed.[124] Having decided the questions involved, the court gives the Commissioner a certificate of its proceedings and decision, which, being entered of record in the Patent Office, governs the further proceedings in the case. No such decision, however, precludes any person from contesting the validity of any patent issued in pursuance thereof, in any court wherein that validity may be called in question.[125] And no such decision, if adverse to the applicant, deprives the Commissioner of jurisdiction to grant a patent for the same invention, on a later and proper application of the same inventor.[126]

§ 134. Whenever a patent or a reissue is refused by the Commissioner of Patents, or by the Court of Appeals of the District of Columbia,[127] on appeal from the Commissioner, the applicant may file a bill in equity in any United States court having or acquiring jurisdiction of the parties.[128] The only way in which any United States Dis-

[123] *In re* Frasch, 20 App. D. C. 301, 1902.

[124] *In re* Beswick, 16 App. D. C. 350, 1900; Howard *v.* Hey, 18 App. D. C. 142, 1901; Ries *v.* Kirkegaard, 30 App. D. C. 199; Onderdonk *v.* Parker, 31 App. D. C. 214.

[125] Revised Statutes, Section 4914; Fry *v.* Quinlan, 13 Blatch. 205, 1875.

[126] United States *v.* Colgate, 32 F. R. 624, 1884.

[127] Prindle *v.* Brown, 155 F. R. 531, 1907.

[128] Revised Statutes, Section 4915, and Section 629, ¶ 9; Bernardin *v.* Northall, 78 O. G. 1742,

trict Court can acquire jurisdiction of the Commissioner, is by his voluntary appearance therein and submission thereto,[129] but the Supreme Court of the District of Columbia has jurisdiction over him, for the purposes of this law, by virtue of his official residence in Washington, in that District.[130] The complainant in such a bill should be the inventor-applicant, or, in case of an assignment of the invention, he should be the assignee, because the latter is considered to be an applicant within the meaning of the law on this subject.[131] If there is no opposing party, a copy of the bill is required to be served on the Commissioner; but the Secretary of the Interior is not a proper party to such a bill.[132] And the Commissioner is not a proper party,[133] where there is a party whose interests are those which are adverse to the interests of the complainant; [134] and in that case the bill may be filed in any District Court of the United States for the judicial district or division wherein the defendant can be served with process regardless of his place of residence;[135] or in the Supreme Court of the District of Columbia, if that party is an inhabitant of that District.[136] In either case,

1897, Ingersoll *v.* Holt, 104 F. R. 682, 1900; McKnight *v.* Metal Volatilization Co., 128 F. R. 51, 1904; Dover *v.* Greenwood, 143 F. R. 136, 1905.

[129] Illingworth *v.* Atha, 42 F. R. 144, 1890.

[130] Butterworth *v.* Hill, 114 U. S. 129, 1885.

[131] Gay *v.* Cornell, 1 Blatch. 508, 1849; Smith *v.* Thompson, 177 F. R. 721, 1910. *Contra*, Wende *v.* Horine, 191 F. R. 620, 1911.

[132] Kirk *v.* Commissioner of Patents, 37 O. G. 451, 1886.

[133] Mergenthaler Co. *v.* Seymour, 66 O. G. 1311, 1894.

[134] Graham *v.* Teter, 25 F. R. 555, 1885.

[135] Thoma *v.* Perri, 205 F. R. 632, 1913. *Contra*, Arbetter Felling Machine Co. *v.* Lewis Blind Stitch Machine Co., 230 F. R. 992, 1915, holding that the suit can be brought only in the district of which the defendant is an inhabitant.

[136] 24 Statutes at Large, Ch. 373, p. 552.

the jurisdiction is unaffected by the fact that the complainant is an inhabitant of the same jurisdiction.[137]

One to whom the patent has been awarded after interference proceedings is, of course, a proper party defendant, and this is so at any time before the patent has actually issued, even though the successful contestant has assigned the application.[138] The reason given for this ruling is that under Section 4895 of the Revised Statutes the Commissioner has full discretion as to whether the patent shall issue to the applicant or his assignee.

Where either class of the conditions mentioned are fulfilled, the court has jurisdiction to adjudge that the applicant is entitled to receive a patent for his invention, as specified in his final claims, or any part thereof, as the facts in the case may appear to be, but not as specified in any claim which the applicant relinquished in the Patent Office, or in any new claim which he never presented there.[139] And such an adjudication, if made, authorizes the Commissioner to issue such a patent, on the applicant's filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of the law;[140] and it then becomes the duty of the Commissioner to issue the patent.[141] But no court has any jurisdiction to restrain the Commissioner from issuing a patent to the defendant, in any such case as those treated in this section.[142]

[137] Bernardin *v.* Northall, 78 O. G. 1742 1897.

[138] Thoma *v.* Perri, 205 F. R. 632, 1913.

[139] Durham *v.* Seymour, 71 O. G. 601, 1895.

[140] Revised Statutes, Section 4915.

[141] Butterworth *v.* Hoe, 112 U. S. 62, 1884; Vermont Farm Machine Co. *v.* Marble, 20 F. R. 118, 1884.

[142] Whipple *v.* Miner, 15 F. R. 117, 1883; Illingworth *v.* Atha, 42 F. R. 141, 1890; Richards *v.* Meissner, 158 F. R. 109, 1907; Richards *v.* Meissner, 162 F. R. 485, 1908.

In order to decide the issues of such a bill in equity as is treated in this section, the court, where the bill is pending, will take testimony, and any other admissible evidence, according to the course of courts of equity; and will also consider whatever was before the Patent Office in the proceedings which resulted in the refusal to grant a patent; and, if the case has been before the Court of Appeals of the District of Columbia, will also consider the proceedings which took place in that tribunal.[143] The proceeding, however, is not revisory of the Patent Office proceeding, but is an original suit in equity and testimony taken in an interference proceeding, although between the same parties, is incompetent, except as permitted by the rules regulating the admission of secondary evidence.[144] The burden is on the complainant to prove the truth of his bill, by evidence that is clear and conclusive[145] even though the defendant default.[146] But although such a suit is an original one, it may not be resorted to as a concurrent remedy with an appeal to the Court of Appeals of the District of Columbia in any case where such an appeal lies; because, where that remedy exists, it must be exhausted before the ultimate redress of a bill in equity can be invoked.[147] It has been said, however, that the burden of

[143] Butterworth *v.* Hoe, 112 U. S. 61, 1884; Gandy *v.* Marble, 122 U. S. 439, 1886.

[144] Benardin *v.* Northall, 78 O. G. 1742, 1897; Wheaton *v.* Kendall, 85 F. R. 671, 1898; Dover *v.* Greenwood, 154 F. R. 854, 1907; Dover *v.* Greenwood (containing discussion), 177 F. R. 946, 1910; Appert *v.* Brownsville Plate Glass Co., 144 F. R. 115, 1904; Hansen *v.* Slick, 216 F. R. 164, 1914.

[145] Durham *v.* Seymour, 71 O. G. 604, 1895; Standard Cartridge Co. *v.* Peters Cartridge Co., 77 F. R. 630, 1896; Ingersoll *v.* Holt, 104 F. R. 682, 1900; Gillette *v.* Sindelbach, 146 F. R. 758, 1906; Western Electric Co. *v.* Fowler, 177 F. R. 224, 1910.

[146] Davis *v.* Garrett, 152 F. R. 723, 1907.

[147] Kirk *v.* Commissioner of Patents, 37 O. G. 451, 1886.

proof is strongly on the plaintiff by reason of the decisions of the Court of Appeals.[148]

Where the Commissioner withholds a patent by virtue of his general, supervisory authority, the remedy now under consideration is the only one to which the applicant can resort, for no appeal lies to the Court of Appeals of the District of Columbia, nor can any writ of mandamus be granted by that tribunal, to compel the Commissioner to issue a patent in such a case,[149] or in any case where the law submits to his discretion, the question involved in his decision.[150]

In previous editions of this book it has been stated that where a patent is refused because of an adverse decision of an interference, and where an applicant files a bill in equity to procure a patent, on the ground that the decision of the question of priority in the interference was wrong, the court will dismiss the bill if it finds the alleged invention to have been not patentable to either of the parties in the interference, regardless of any question of priority between those parties, for which proposition the case of Hill *v.* Wooster [151] was cited. It has, since the Fourth Edition of this book was issued, been held that Hill *v.* Wooster did stand for the proposition above stated and that in an action brought under Section 4915 of the Revised Statutes, not only priority between the patents involved in the interference may be determined but also patentability.[152]

[148] Richards *v.* Meissner, 158 F. R. 109, 1907; Laas *v.* Scott, 161 F. R. 122, 1908; Richards *v.* Meissner, 163 F. R. 957, 1908; Greenwood *v.* Dover (discussing authorities), 194 F. R. 90, 1911.

[149] Hull *v.* Commissioner of Patents, 7 O. G. 559, 1875; 8 O. G. 46, 1875.

[150] *Ex rel.* Bigelow, 2 McArthur, 30, 1875.

[151] Hill *v.* Wooster, 132 U. S. 693, 1890.

[152] Davis *v.* Garrett, 152 F. R. 723, 1907; Hansen *v.* Slick, 216 F. R. 164, 1914. *Contra* Richards *v.* Meissner, 163 F. R. 957, 1908.

The remedy delineated in this section must be invoked within one year after the last official action on the application, unless the complainant satisfies the court in which it is invoked, that the longer delay was unavoidable.[153]

In an action of the kind under discussion it has been held that acquisition pending suit of the issued patent in interference by the adverse party does not cause the suit to abate.[154]

§ 135. The right to amend applications for patents is one of great value and frequent exercise, but it has never been expressly established by any statute. No statute prior to that of 1836 even mentioned the subject, and that statute only provided that whenever it appeared to the Commissioner, that one or more of the claims of an application were inadmissible for want of novelty, or that the description was defective and insufficient, he should notify the applicant thereof, and should furnish him with such information as might be useful in judging of the propriety of altering his specification, so as to exclude that part of the subject-matter found not to be new.[155] No change relevant to this point was made in the statute till 1870, when, in the place of the foregoing provision, it was enacted that whenever any claim was rejected, for any reason whatever, the Commissioner should notify the applicant thereof, and should furnish him with such information as might be useful in judging of the propriety of altering his specification.[156] The present statute

[153] Gandy *v.* Marble, 122 U. S. 439, 1886; Revised Statutes, Section 4894; Westinghouse Electric & Mfg. Co. *v.* Ohio Brass Co., 186 F. R. 518, 1911.

[154] Schmertz Wire-Glass Co. *v.* Pittsburgh Plate Glass Co., 168 F. R. 73, 1909; Schmertz Wire-Glass Co. *v.* Western Glass Co., 178 F. R. 973, 1909.

[155] 5 Statutes at Large, Ch. 357; Section 7, p. 120.

[156] 16 Statutes at Large, Ch. 230, Section 41, p. 204.

on the subject is substantially identical with that of 1870.[157]

There is no apparent material difference, at this point, between any of the three statutes, unless the provision in that of 1836, relevant to the nature of the amendment contemplated by that section, constitutes a limitation not found in either of the others. The two later statutes provide that the Commissioner shall furnish the applicant with such information as may be useful in judging of the propriety of altering his specification. The earlier statute adds to that provision the words: "to embrace only that part of the invention or discovery which is new." All three of the statutes recognize the right of an applicant to alter his specification, after rejection of any claim therein. They differ from each other only in regard to the kind of information which they require the Commissioner to furnish the applicant, to guide him in the exercise of that right. Neither of them furnishes the foundation of that right, nor limits that right to cases where the application has been rejected. They all provide a proceeding for such cases, but neither of them negatives the existence of such a right in other cases.

§ 136. The real foundation of the right to amend applications for patents, is found in Section 4888 of the Revised Statutes, a section substantially identical with Section 26 of the Patent Act of 1870, and with the second sentence of Section 6 of the Patent Act of 1836, and with the middle part of Section 3 of the Patent Act of 1793. Ever since 1793, one or another of these four enactments has been in force, and has provided, in substance, that before any inventor shall receive a patent for his invention, he shall file in the Patent Office a full, clear, and exact written description of that invention. Ever since 1836, one or another

[157] Revised Statutes, Section 4903.

of the three statutes first mentioned has been in force, and has additionally provided that before any inventor shall receive a patent, he shall particularly point out and claim the part or combination which he claims as his invention. Now when a statute enacts that a thing shall be done before a particular event can occur, it implies that it can be done prior to such an event. An inventor may therefore do those things before he receives a patent. If he fails in his first attempt to furnish a proper and adequate description, or to furnish proper and adequate claims, he may try again, and, if necessary, still again and again. If he finally succeeds in both, the Commissioner acquires jurisdiction to grant him a patent, provided all the other requirements of the law are also complied with. The statute does not attend to the details of this matter. It only provides that at some time before a patent is issued, a proper description and a proper claim shall be filed in the Patent Office. To what extent these things must be done at first, and to what extent and under what circumstances they may be done by way of amendment of the original papers, are questions which are to be determined in the light of the decisions of the courts, made under general judicial authority; and of the rules of the Patent Office, made under Section 483 of the Revised Statutes. To ascertain, therefore, what may, and what may not, be done by way of amendments of applications, the true recourse is to those decisions and those rules.

§ 137. The applicant may amend before or after the first rejection, and he may amend as often as the examiner presents any new references or reasons for rejection; but after such action on all the claims as entitles the applicant to an appeal to the board of examiners-in-chief, no amendment is allowed, unless the applicant convinces the examiner or the Commissioner, that there was a sufficient

excuse for the delay in presenting it.[158] Amendments not affecting the merits may be made after the patent is allowed, and even after the final fee is paid, provided those amendments are approved first by the examiner, and then by the Commissioner.[159]

§ 138. It was formerly held, that whenever an inventor filed an application for a patent, he was regarded as applying for such a patent as would cover every patentable thing represented in the specification, drawing or model of that application.[160] If, therefore, his claims as first submitted to the Commissioner did not cover every such thing, he was allowed to amend them to whatever extent was necessary to make them do so, or he was allowed to add other claims to accomplish that purpose. But the law of the subject has more lately been laid down on stricter lines.

The general rule is that no amended or new claim can be allowed, unless it is for the "same invention" as the original application.[161] It has been decided that this quoted phrase is not confined in its meaning to whatever invention was actually claimed by the inventor in his original application, and that claims may be broadened, while applications are pending.[162] And now the Supreme Court itself, has held that where the original specification and drawings of an application, suggested the claims which were finally made, those claims were properly made in amendment of the original application.[163] Inasmuch as

[158] Patent Office Rule 68.

[159] Patent Office Rule 78.

[160] Singer *v.* Braunsdorf, 7 Blatch. 532, 1870.

[161] Railway Co. *v.* Sayles, 97 U. S. 554, 1878; Eagleton Mfg. Co. *v.* West Mfg. Co., 111 U. S. 490, 1884; Beach *v.* Box-Machine Co., 63 F. R. 604, 1894; Michigan Central R. R. Co. *v.* Car-Heating Co., 67 F. R. 126, 1895.

[162] Rocker Spring Co. *v.* Thomas, 68 F. R. 200, 1895.

[163] Hobbs *v.* Beach, 180 U. S. 397, 1901; Kirchberger *v.* Am. Acetylene Burner Co., 128 F. R. 599, 1904.

it has also been decided, that a drawing may be amended in the light of the specification, even to the extent of inserting in it, the distinguishing characteristic of the invention, when that was accidentally omitted from the original drawing;[164] Judge WHEELER appears to have been right in holding, that the claims of an application may be amended into conformity with whatever inventions were described in the original specification.[165]

Some decisions have held, however, that matter may be introduced by way of amendment even though the matter introduced would create another and different invention than that originally described, provided a new or "supplemental" oath is filed setting forth that the new matter is part of the original invention.[166] A supplemental oath is not, however, necessary to cover claims additional to those originally filed, where the additional claims are within the invention as originally disclosed.[167]

[164] Consolidated Brake-Shoe Co. *v.* Detroit S. & S. Co., 59 F. R. 903, 1894.

[165] John R. Williams Co. *v.* Miller, Du Brul & Peters Mfg. Co., 107 F. R. 292, 1901; Cleveland Foundry Co. *v.* Detroit Vapor Stove Co., 131 F. R. 853, 1904; Keasby & Mattison Co. *v.* Carey Mfg. Co., 139 F. R. 571, 1905; Cutter Hammer Mfg. Co. *v.* Union Electric Mfg. Co., 147 F. R. 266, 1906; Mine & Smelter Supply Co. *v.* Braeckel Concentrator Co., 197 F. R. 897, 1912 (discussing the subject and authorities); Boyce *v.* Stewart-Warner Speedometer Corporation, 220 F. R. 118, 1914; Proudfit Loose Leaf Co. *v.* Kalamazoo Loose Leaf Binder Co., 230 F. R. 120, 1915. See the very doubtful qualification of this rule in Kirchberger *v.* American Acetylene Burner Co., 128 F. R. 599, 1904.

[166] Am. Lava Co. *v.* Steward, 155 F. R. 731, 1907; General Electric Co. *v.* Morgan-Gardner Electric Co., 159 F. R. 951, 1907; Ney Mfg. Co. *v.* G. A. Swineford Co., 211 F. R. 469, 1913. See Steward *v.* American Lava Co., 215 U. S. 161, 1909.

[167] General Electric Co. *v.* Morgan-Gardner Electric Co., 167 F. R. 52, 1908; American Steel Foundries *v.* Wolff Truck Frame Co. (discussing the question), 189 F. R. 601, 1911.

§ 139. An applicant must amend his specification and drawings, whenever such amendment is required to correct inaccuracy or unnecessary prolixity therein, or to secure correspondence between the claims and the other parts of the specification and the drawings.[168] So also, unless the original drawings conform to certain standards of artistic excellence set forth in the rules, the applicant must furnish amended drawings which do conform to those requirements.[169]

§ 140. An interference is a judicial proceeding carried on in the Patent Office, for the purpose of determining the question of priority between two or more parties, each of which is seeking a patent for the same invention; or between two or more parties, at least one of which is seeking a patent for an invention already covered by a patent which has not yet expired.[170] The proceedings in interferences are governed by an elaborate code of Patent Office rules, which are as binding as the law itself,[171] and to which the practitioner, in such cases, will necessarily resort for detailed information.[172] It is unnecessary to explain those rules in this text-book, but it is expedient to set down in this connection the relevant rules of law, which rest directly upon the statutes and decisions for their sanction.

§ 141. There is no limit to the number of interferences to which an application may be subjected; and if a patent is issued without going through every such proceeding,

[168] Patent Office Rule 71.

[169] Patent Office Rules 49 to 55.

[170] Revised Statutes, Section 4904; Patent Office Rule 93; United States *v.* Commissioner of Patents, 7 O. G. 603, 1875; Hisey *v.* Peters, 71 O. G. 893, 1895; Bernardin *v.* Seymour, 10 App. D. C. 308, 1897.

[171] Arnold *v.* Bishop, 1 McArthur's Patent Cases, 31, 1841; United States *v.* Marble, 2 Mackey, 12, 1882.

[172] Patent Office Rules 93 to 132, and 146 to 150.

previously ordered by the Commissioner, that patent will be void.[173] The ordinary rules of evidence, which are applied in United States equity courts, are used in interference cases.[174] These include the rules which relate to dispensing with evidence of facts of public notoriety.[175] The doctrines of estoppel also apply in these contests, in the same manner in which they apply in other litigious proceedings.[176]

Every witness who is not a party to the interference, is protected, by a statute, from being compelled to disclose any secret invention made or owned by himself;[177] but that statute does not allow a party to an interference to refuse to answer any question relevant to the invention in interference.[178]

Any question of invention, or utility which the Commissioner may find in a case in interference, should be decided by him, before he decides the question of priority in the interference.[179] But evidence that some other person preceded all the parties to an interference, in making the invention in interference, is inadmissible.[180]

The first applicant in interference is the senior party in the proceeding, even where a patent has been somehow issued to a later applicant; and the first applicant has a *prima facie* case of priority, which entitles him to a decision in his favor, unless it is overcome by a proper weight of evidence for a junior party.[181] A preponderance of evi-

[173] Potter *v.* Dixon, 2 Fisher, 381, 1863.

[174] Berry *v.* Stockwell, 9 O. G. 404, 1876; Neilson *v.* Bradshaw, 16 App. D. C. 95, 1900.

[175] Anson *v.* Woodbury, 12 O. G. 1, 1877.

[176] Berry *v.* Stockwell, 9 O. G. 404, 1876.

[177] Revised Statutes, Section 4908.

[178] Dorman *v.* Keefer, 49 F. R. 462, 1892.

[179] Oliver *v.* Felbel, 20 App. D. C. 262, 1902.

[180] Foster *v.* Antisdel, 14 App. D. C. 552, 1899.

[181] Hunter *v.* Stikeman, 13 App.

dence is enough for that purpose;[182] except where the senior party has already received a patent on the invention in interference, in which case the evidence for the junior party must be strong enough to remove all reasonable doubt.[183]

§ 141*a*. The decision of an interference, depends on dates of conception, drawing, model, disclosure, practice, and application for a patent; and sometimes on the presence or absence of laches.

A conception of an invention occurs, when a person definitely thinks out its theoretical character, mode of operation, and function. But the date of that conception cannot be fully proved by the oral testimony of the conceiver.[184] Where the conception occurred in a foreign country, it receives a conventional date, contemporaneous with its communication to some one in the United States.[185] A drawing of an invention is admissible in evidence in an interference; if it is explained well enough to leave no doubt of what it represents. A model of an invention has the same standing as a drawing in this respect. A disclosure of an invention, consists in making it known to another person, well enough to preserve its plan for the benefit of others, if the inventor were to die without doing anything further.[186]

D. C. 219, 1898; Esty *v.* Newton, 14 App. D. C. 52, 1899; Michle *v.* Read, 18 App. D. C. 128, 1901.

[182] Wurts *v.* Harrington, 79 O. G. 337, 1897.

[183] Neilson *v.* Bradshaw, 16 App. D. C. 92, 1900; Kelly *v.* Fynn, 16 App. D. C. 573, 1900; Reichenbach *v.* Kelley, 17 App. D. C. 333, 1901; Locke *v.* Boch, 17 App. D. C. 83, 1900; Fefel *v.* Stocker, 17 App. D. C. 317, 1900; Sharer *v.* McHenry, 19 App. D. C. 158, 1901.

[184] Mergenthaler *v.* Scudder, 11 App. D. C. 278, 1897; Petrie *v.* De Schweinitz, 19 App. D. C. 389, 1902.

[185] Harris *v.* Stern and Lotz, 105 O. G. 747, 1903.

[186] Eastman *v.* Houston, 95 O. G. 2066, 1901.

A process is reduced to practice, when it is successfully performed. A machine is reduced to practice, when it is constructed, assembled, and adjusted ready for trial or use.[187] A manufacture is reduced to practice, when it is completely manufactured. A composition of matter is reduced to practice, when it is completely composed. A design is reduced to practice, when it is embodied in the thing or picture in which it consists. A reduction to practice, in order to be credited to a party in an interference, must have been performed by that party, or by his agent at his instance.[188]

§ 141*b*. An application for a patent is equivalent to a reduction to practice, in interferences; and such an application is often designated as a "constructive reduction to practice." To be entitled to that standing, an application need not be free from need for amendment; [189] provided it shows the invention in interference, when properly amended.[190] In the absence of other evidence, an invention in interference takes date from the date of filing the application in interference.[191] Other evidence, which may carry the date of invention back beyond the date of the application in interference, may consist of proof of either of the following facts:

The same invention was described in an earlier application of the same applicant; [192] provided that application has not been abandoned.[193] That earlier application may

[187] Mason *v.* Hepburn, 13 App. D. C. 86, 1898; Hunter *v.* Stikeman, 13 App. D. C. 218, 1898; Lindemeyr *v.* Hoffman, 18 App. D. C. 1, 1901; Roe *v.* Hanson, 19 App. D. C. 564, 1902.

[188] Hunter *v.* Stikeman, 13 App. D. C. 226, 1898.

[189] Croskey *v.* Atterbury, 76 O. G. 165, 1896.

[190] Hulett *v.* Long, 15 App. D. C. 284, 1899.

[191] McCormick *v.* Cleal, 12 App. D. C. 337, 1898.

[192] Cain *v.* Park, 14 App. D. C. 42, 1899.

[193] Carty *v.* Kellogg, 7 App.

have been the original application for the original patent, where an application for a reissue is in interference.[194]

The same invention was the subject of an application for a patent in some foreign country, which affords similar privileges to citizens of the United States; provided the application in this country, was filed within twelve months, in case of a process, machine, manufacture, or composition of matter, or within four months, in case of a design, from the earliest date at which any such foreign application was filed.[195]

The invention was reduced to practice, before the application in interference, or before the application for the patent in interference, as the case may be, was filed in the Patent Office; [196] provided the invention was not concealed, after it was reduced to practice, until after it was patented to the other party in interference.[197]

The invention was conceived, before the application in interference, or the application for the patent in interference, as the case may be, was filed in the Patent Office;[198] provided the conceiver, if a junior applicant, is not justly chargeable with laches, intervening after the earliest date to which the senior applicant is entitled, and before the date of his own reduction to practice, or his own application, as the case may be.[199]

D. C. 547, 1896; Ostergren *v.* Tripler, 17 App. D. C. 561, 1901.

[194] Austin *v.* Johnson, 18 App. D. C. 83, 1901.

[195] 32 Statutes at Large, Part 1, p. 1225, Ch. 1019, Section 1.

[196] Wurts *v.* Harrington, 10 App. D. C. 149, 1897.

[197] Mason *v.* Hepburn, 13 App. D. C. 95, 1898; Thomson *v.* Weston, 19 App. D. C. 380, 1903.

[198] Reed *v.* Cutter, 1 Story, 598, 1841; McCormick Mach. Co. *v.* Minneapolis Harvester Works, 42 F. R. 154, 1890.

[199] Marvel *v.* Decker, 13 App. D. C. 562, 1898; Griffen *v.* Swenson, 15 App. D. C. 135, 1899; Jackson *v.* Getz, 16 App. D. C. 344, 1900; Austin *v.* Johnson, 95 O. G. 2685, 1901; Miehle *v.* Read, 96 O. G. 426, 1901; Stapleton *v.*

Each party in an interference is entitled to invoke the date of his application as the date of his invention; and he is also entitled to invoke, as the date of his invention, the date of the earliest of the events, which the facts of the case permit him to invoke, among those which are precisely defined in the last four paragraphs, respectively.

§ 141c. The facts defined in the last of those four paragraphs sometimes include the presence or absence of laches, after the earliest date to which a senior applicant is entitled, and before the date of the junior applicant's reduction to practice, or the date of his application for a patent, as the case may be. Any considerable delay during that time, constitutes laches; unless it is accounted for by facts which exclude the theory of neglect. The fact that the junior applicant was diligently at work on some other invention or worthy enterprise, during that time, does not exclude the theory of neglect.[200] Indeed, nothing but impossibility can be relied on to prevent delay, during the time in view, from being held to constitute such laches, as will deprive a junior applicant of the date of his conception as the date of his invention.

But laches is not chargeable to the junior party to an interference, on account of any delay which occurred before the earliest date to which the other party is entitled;[201] nor on account of any mere delay which occurred after his reduction to practice and before his application; [202] nor on account of any delay which occurred after his application was filed in the Patent Office. And laches is not charge-

Kinney, 96 O. G. 1432, 1901; Wyman *v.* Donnelly, 104 O. G. 310, 1903.

[200] Croskey *v.* Atterbury, 9 App. D. C. 208, 1896; Stapleton *v.* Kinney, 18 App. D. C. 394, 1901.

[201] Yates *v.* Huson, 8 App. D. C. 93, 1896.

[202] Wurts *v.* Harrington, 79 O. G. 338, 1897; Loomis *v.* Hauser, 99 O. G. 1172, 1902; Oliver *v.* Felbel, 20 App. D. C. 262, 1902.

able to the senior applicant in interference on account of any delay whatever.

Dates of drawing, model, and disclosure, are significant in interferences, only as they help to prove the dates of conception; or relate to the question of laches of the junior applicant, after his conception, and before his application or reduction to practice.

The question of priorities as between interfering patents and interfering inventions is so thoroughly discussed in the cases of Laas *v.* Scott,[203] and Automatic Weighing Machine Co. *v.* Pneumatic Scale Corporation [204] that the reader is referred to these cases as a complete exposition of the entire law on the subject.

§ 141*d*. And any party aggrieved by a decision of the Commissioner of Patents, in any interference case, may appeal therefrom to the Court of Appeals of the District of Columbia.[205] The statute which provides for such appeals, is constitutional, for the decisions appealed from, are judicial.[206] Such an appeal is confined to the final decision of the Commissioner on the question of priority; [207] except where the court finds that there is no interference to be decided.[208] Where all the tribunals, which passed on a particular interference in the Patent Office, reached the same conclusion thereon; the court will reverse that con-

[203] Laas *v.* Scott, 161 F. R. 122, 1908.

[204] Automatic Weighing Machine Co. *v.* Pneumatic Scale Corporation, 166 F. R. 288, 1909.

[205] 27 Statutes at Large, Ch. 74, Section 9, p. 436.

[206] United States *v.* Duell, 172 U. S. 576, 1899.

[207] Westinghouse *v.* Duncan, 66 O. G. 1010, 1894; Hisey *v.* Peters, 71 O. G. 893, 1895; Dodge *v.* Fowler, 11 App. D. C. 592, 1897; Hill *v.* Hodge, 12 App. D. C. 528, 1898; Hulett *v.* Long, 89 O. G. 1141, 1899; Newton *v.* Woodward, 16 App. D. C. 572, 1900; Schupphaus *v.* Stevens, 17 App. D. C. 555, 1901.

[208] Bechman *v.* Wood, 89 O. G. 2459, 1899.

clusion, only in case a very clear error is found therein.[209] Even after the Court of Appeals has decided an interference; the Commissioner may consider any question of non-patentability in the subject of the interference, and may still refuse a patent to the successful interferor, on the ground of want of patentability to any person.[210]

§ 142. No decision of the Commissioner of Patents,[211] or the Courts of Appeals of the District of Columbia,[212] in any interference case, is pleadable as *res judicata* in any action in any court;[213] but such a decision will be followed by all the courts, unless it is shown to be wrong, by evidence which puts the point beyond a reasonable doubt.[214] Where such a decision is made between two or more applications, a patent is granted to the inventor decided to be first, and no patent is granted to either of the others. If it is made between an application and a patent, and is made in favor of the application, the Commissioner will grant a patent thereon, but he cannot recall the patent

[209] Glenn *v.* Adams, 12 App. D. C. 175, 1898; McBerty *v.* Cook, 16 App. D. C. 136, 1900.

[210] Hill *v.* Hodge, 12 App. D. C. 528, 1898.

[211] Union Paper Bag Machine Co. *v.* Crane, 1 Bann. & Ard. 494, 1874; Gloucester Isinglass Co. *v.* Brooks, 19 F. R. 427, 1884; Hubel *v.* Tucker, 24 F. R. 701, 1885; Kirk *v.* Du Bois, 33 F. R. 252, 1887; John R. Williams Co. *v.* Du Brul & Peters Mfg. Co., 107 F. R. 293, 1901; Davis & Roesch T. C. Co. *v.* National Steam Specialty Co., 164 F. R. 191, 1908; Turner Brass Works *v.* Appliance Mfg. Co., 164 F. R. 195, 1908; Roth *v.* Harris, 168 F. R. 279, 1909.

[212] Bernardin *v.* Northall, 78 O. G. 1742, 1897.

[213] Eck *v.* Kutz, 132 F. R. 758, 1904; Computing Scale Co. *v.* Standard Computing Scale Co., 195 F. R. 508, 1912.

[214] Morgan *v.* Daniells, 153 U. S. 123, 1894; Hisey *v.* Peters, 71 O. G. 894, 1895; Standard Cartridge Co. *v.* Peters Cartridge Co., 77 F. R. 630, 1896; R. Thomas & Sons Co. *v.* Electric Porcelain & Mfg. Co., 111 F. R. 929, 1901; Roth *v.* Harris, 168 F. R. 279, 1909.

already issued. In such a case, the rival inventors may litigate their interference controversy anew, on the equity side of any United States District Court which has or can acquire jurisdiction of the parties.[215] That kind of litigation constitutes the subject of the chapter on interfering patents; the thirteenth chapter of this book. Or the question of priority between the two inventors may be litigated afresh in any infringement suit, brought by one of them against the other. If, in such a case as that under present consideration, it had happened that the successful applicant had filed his application before the interfering patent was granted, that patent would not have been granted at all, unless the Patent Office decision on the interference had been reversed by some higher authority. In that event, the successful applicant would not have been liable to any interference suit, nor any infringement suit, brought against him by his rival; for his rival would, in that event, have no patent upon which to base a suit of either of those kinds. For this reason, as well as for others, every inventor who desires to secure a patent for an invention, should make his application therefor soon after making that invention. This is the more urgent since the abolition of caveats as stated in the next section, as the inventor is now deprived of that means of preventing the issuance of an interfering patent.

§ 143. Caveats have since the publication of the Fourth Edition of this book been abolished[216] and are now of little more than academic interest, but for the sake of completeness the discussion of the subject is retained in this edition. "A caveat is a document in which an inventor states the function, and the distinguishing characteristics, of the invention to which it refers, and prays protection for his

[215] Revised Statutes, Section 4918.

[216] Act of January 25, 1910, 36 Statutes, 813, Chap. 414.

right thereto, until he shall have matured that invention. A caveat remains in force only one year; and while it is in force, its only statutory function is to prevent the issuing of any patent to another, for the same invention, until after the caveator has notice of the interfering application, and has thus had an opportunity to file an application himself, and so delay the issuing of a patent to his competitor until an interference proceeding in the Patent Office shall have decided the question of priority.[217] If an invention is fully described in a caveat, then that caveat will constitute evidence showing that invention to have been made at least as early as the caveat was filed. This, however, is an incidental and not a statutory function of such a document, and it cannot be performed by any caveat which is not complete enough in its description to enable a skillful mechanic, without inventing anything himself, to construct a specimen of the invention to which the caveat refers. But even where a caveat does not reach that standard, it constitutes evidence that the invention had reached the stage of development shown in the caveat, at the time the caveat was executed.[218]

"Omission to file a caveat does not impair the ultimate rights of an inventor,[219] and omission to consider a caveat does not invalidate a patent granted to another in pursuance of the oversight.[220]

"But whether an immature invention is provisionally protected by a caveat or not, it should not be made the subject of an application for a patent until it reaches

[217] Revised Statutes, Section 4902; 32 Statutes at Large, p. 1225, Ch. 1019, Section 4; Bell *v.* Daniels, 1 Fisher, 372, 1858.

[218] Jones *v.* Wetherell, 1 McArthur's Patent Cases, 413, 1855.

[219] Heath *v.* Hildreth, 1 McArthur's Patent Cases, 25, 1841.

[220] Cochrane *v.* Waterman, 1 McArthur's Patent Cases, 59, 1844.

maturity; for it has happened in the past, and may happen hereafter, that a patent, granted on an application based on an immature invention, is not strong enough or broad enough to give any valuable exclusive right, while being significant enough to weaken or to narrow the operation of any subsequent patent granted to the same inventor, on a mature invention, in the same department of the useful arts."

§ 144. No appeal lies from any decision of the Court of Appeals of the District of Columbia, on an appeal to that tribunal from the Commissioner of Patents.[221] But an appeal does lie from any decision of any United States District Court, or of the Supreme Court of the District of Columbia, on any bill in equity which may be filed to compel the issuance of a patent, after an unsuccessful appeal to the Court of Appeals of the District of Columbia, from the rejection of an application by the Commissioner of Patents. Where such a bill is filed and adjudicated in some District Court of the United States, an appeal lies from its decision to the Circuit Court of Appeals of the circuit to which that District Court belongs.[222] And where such a bill is filed and adjudicated in the Supreme Court of the District of Columbia, an appeal lies to the Court of Appeals of the District of Columbia.[223] But no appeal lies in such a case, from the latter tribunal to the Supreme Court of the United States.[224]

§ 145. An application for a patent may be abandoned. That abandonment may be actual, or it may be constructive. The facts which constitute an actual abandonment of an application, may also constitute an actual abandon-

[221] Rousseau *v.* Brown, 104 O. G. 1122, 1903; Judic. Code, 250, 251.

[222] Judicial Code, Section 128.

[223] 27 Statutes at Large, Ch. 74, Section 7, p. 435.

[224] Durham *v.* Seymour, 161 U. S. 235, 1896; Frasch *v.* Moore, 211 U. S. 1, 1908; Johnson *v.* Mueser, 212 U. S. 283, 1909; Judicial Code Sections 250, 251.

ment of the invention covered thereby; and a constructive abandonment of an application, may or may not work a constructive abandonment of the invention.[225]

Actual abandonment of an application does not always follow from the fact that the applicant withdrew it from the Patent Office. If, when withdrawing it, he intended to file a new application for the same invention, and accordingly does so, the two are held to constitute one continuous application within the meaning of the law.[226] This doctrine applies, even if the new application is not filed till long after the old one was withdrawn, provided there was no laches chargeable to the applicant on account of the delay.[227] When the two applications are continuous the two years' public use or sale which may avoid the patent must be reckoned from the presentation of the first application, and not from the filing of subsequent applications or amendments.[228] When, however, the first application is abandoned, a contrary rule prevails.[229]

But this principle is not to be construed as holding that a subsequent patent for an invention described but not claimed in an earlier patent to the same patentee may be a continuation of the former.[230]

And where an application covers two inventions, one of

[225] Hayes Young Tie Plate Co. *v.* St. Louis Transit Co., 137 F. R. 80, 1905.

[226] Godfrey *v.* Eames, 1 Wallace, 317, 1863; International Crown Co. *v.* Richmond, 30 F. R. 779, 1886; Dederick *v.* Fox, 56 F. R. 715, 1892; Clark Blade & Razor Co. *v.* Gillette Safety Razor Co., 194 F. R. 421, 1912.

[227] Howes *v.* McNeal, 3 Bann. & Ard. 376, 1878.

[228] Hayes-Young, etc., Co. *v.* St. Louis Transit Co., 137 F. R. 80, 1905; Victor Talking Machine Co. *v.* Am. Graphaphone Co., 145 F. R. 350, 1906; Corrington *v.* Westinghouse Air Brake Co., 178 F. R. 711, 1910.

[229] Hayes-Young, etc., Co. *v.* St. Louis Transit Co., 137 F. R. 80, 1905.

[230] Model Bottling Machinery Co. *v.* Anheuser-Busch Brewing Ass'n, 190 F. R. 573, 1911.

which is withdrawn therefrom by division, and made the subject of a divisional application; that new application relates back to the original application from which it was carved, and is not chargeable with any diminution of significance, on account of the transaction.[231]

Nor does actual abandonment of an application necessarily follow from the fact that it was rejected by the Patent Office, and then allowed to lie dormant by the applicant. If, in such a case, the applicant always expected to secure a patent, either on the original application or on another, and if, without laches, he made and prosecuted another application for the same invention, and secured a patent thereon; the two applications are considered, in the eye of the law, to be one.[232]

Laches, if it intervenes, between a withdrawn or rejected application and a new application covering the same invention, will, however, be fatal to any claim of continuity.[233] It will constitute evidence that the first application was actually abandoned, and equally good evidence of the actual abandonment of the invention itself.[234]

Where an inventor makes two original applications for a patent, and afterward withdraws one of them; he does not thereby abandon the invention described therein.[235]

§ 146. Constructive abandonment of an application occurs whenever one year intervenes between the filing of the application and its being made complete enough to en-

[231] Stirling Co. *v.* St. Louis Brewing Ass'n, 79 F. R. 80, 1897.

[232] Smith *v.* Dental Vulcanite Co., 93 U. S. 500, 1876; Blandy *v.* Griffith, 3 Fisher, 617, 1869; Graham *v.* McCormick, 5 Bann. & Ard. 244, 1880; Ligowski Clay-Pigeon Co. *v.* Clay-Bird Co., 34 F. R. 334, 1887.

[233] Bevin *v.* Bell Co., 9 Blatch. 61, 1871; Weston *v.* White, 13 Blatch. 452, 1876.

[234] Planing Machine Co. *v.* Keith, 101 U. S. 484, 1879.

[235] Edison *v.* American Mutoscope Co., 110 F. R. 662, 1901.

title it to examination, according to the rules of the Patent Office; and such an abandonment also occurs if the applicant allows one year to pass without regularly prosecuting his application, after any particular action is taken thereon by the Patent Office, and notified to him; provided, in either case, the Commissioner of Patents is not convinced that the delay was unavoidable.[236] If he is so convinced he may condone the delay by granting a patent; and if he grants a patent, his decision on the point is conclusive.[237]

So, also, constructive abandonment of his application occurs when an applicant fails to pay the final fee within six months from the time at which a patent is allowed, and notice of such allowance is sent to him or to his agent.[238]

The period of time, no matter how long, consumed by an applicant in the prosecution of his application, cannot, however, be construed as an abandonment either of his invention or of his application, nor can it work to his prejudice provided he complies with the regulations of the Patent Office in regard to the limitations of time of taking such action in respect to his application as may be required.[239] Such a record does not, however, improve the chances of the patent before the courts, especially where the art has made extensive progress while the application was pending in the Patent Office.[240]

§ 147. Constructive abandonment of an application

[236] Revised Statutes, Section 4894; as amended in 29 Statutes at Large, Ch. 391, Section 4; Kirk *v.* Commissioner of Patents, 37 O. G. 451, 1885; *Ex parte* Messenger, 78 O. G. 1903, 1897.

[237] M'Millin *v.* Barclay, 5 Fisher, 199, 1871; *contra*, holding the decision merely presumptively correct, Hayes-Young, etc., Co. *v.* St. Louis Transit Co., 137 F. R. 80, 1905.

[238] Revised Statutes, Section 4885, as amended 35 Stat. 246.

[239] Columbia Motor Car Co. *v.* C. A. Duerr & Co., 184 F. R. 893, 1911.

See Section 92.

[240] Hestonville M. & F. Pas-

will work constructive abandonment of the invention covered thereby, where the abandonment of the application arose from either of the causes stated in the first paragraph of Section 146; if no new application is filed soon enough to independently avoid the statute relevant to public use or sale more than two years before application for a patent;[241] and probably, also soon enough to independently avoid those causes of constructive abandonment of inventions, which are stated in Section 104*a* of this book.

But constructive abandonment of an application, arising out of the cause stated in the last paragraph of Section 146, will not put into operation the statute relevant to public use or sale more than two years before application;[242] and probably will not put into operation, either of those causes of constructive abandonment of inventions, to which Section 104*a* of this book is devoted.

§ 148. Patents are authorized by law, only on compliance with the statutory prerequisites to their issue. The Commissioner has therefore no jurisdiction to grant any patent, except where all those prerequisites have been substantially performed. If he inadvertently grants a patent in any other case, he exceeds his jurisdiction, and it is therefore open to every person who is sued as an infringer of that patent, to successfully defend against such an action, by pleading and proving the particular fault or omission with which the applicant was chargeable.[243]

senger Ry. Co. *v.* McDuffee, 185 F. R. 788, 1910.

[241] Lindsay *v.* Stein, 10 F. R. 913, 1882; Western Electric Co. *v.* Sperry Electric Co., 58 F. R. 191, 1893; Lay *v.* Indianapolis Brush & Broom Mfg. Co., 120 F. R. 836, 1903.

[242] Ligowski Clay-Pigeon Co. *v.* American Clay-Bird Co., 34 F. R. 328, 1888.

[243] Grant *v.* Raymond, 6 Peters, 218, 1832; Parks *v.* Booth, 102 U. S. 101, 1880; Ransom *v.* New York, 1 Fisher, 257, 1856.

See Section 440.

CHAPTER VII

LETTERS PATENT

149. No exclusive right to inventions at common law.
149*a*. Exclusive possession by secrecy.
150. Constitutional exclusive right to inventions in the United States.
151. Patents are property.
152. Dignity of property in patents.
152*a*. Continuation of the same subject.
153. Patents are not odious monopolies.
155. *Patent rights* are beyond State interference.
156. Patent rights are not subject to common-law executions, but may be subjected to creditors' bills in equity.
157. Patent rights are as exclusive of the government, as they are of any citizen.
158. Patents do not cover specimens purchased of the inventor, or made with his knowledge and consent, before application therefor.
159. The foregoing rule has no application to patents for processes.
160. Territorial scope of United States patents.
161. Operation of United States patents on the decks of ships.
162. Duration of patents.
163. Duration of United States patents for inventions first patented in a foreign country, according to the statute of 1870.
170. Beginning of the terms of United States patents.
171. To whom letters patent are granted by the government.
172. Letters patent as documents.
173. The specification.
174. The description.
175. The description.
176. The claim or claims.
177. The claim or claims.
177*a*. Generic claims and specific claims.
178. Particularity in descriptions and claims, are conditions precedent to validity.
179. Questions of sufficiency of particularity of descriptions and claims, are questions of fact, and not of law.

180. Plurality of inventions in a single letters patent.
180*a*. Double patenting.
181. Construction of letters patent.
182. Claims to be construed in the light of descriptions.
182*a*. Construction of claims which employ reference letters or numerals.
183. Construction of functional claims.
184. Claims construed in the light of the prior state of the same art.
184*a*. The prior state of other arts.
185. Proper liberality of construction.
185*a*. Breadth of construction as governed by extent of use of patent.
186. Proper strictness of construction.
186*a*. Construction in the light of acquiescence on part of owner of patent.
187. Construction in the light of application papers.
187*a*. Patent Office limitations.
188. Construction in the light of contemporaneous statutes.
189. Questions of construction are questions of law, and not of fact.
190. Letters patent presumed to be for same invention as the application therefor.
191. Letters patent are constructive notice of their contents to every person.
191*a*. Taxation of patents.

§ 149. No inventor has any special right to his invention at common law.[1] This is not a virtue in that law. It is an imperfection; an omission. That omission is due to the fact that the common law came into being in the middle ages, and in England. New and useful inventions were seldom produced in those ages, and most of those which were produced, were produced in Italy or on the continent of Europe. There was little or no occasion or opportunity in England, for the creation or recognition of any exclusive, or otherwise paramount, customary right in inventions. Even in those countries where new and useful things were more frequently invented, their

[1] Brown *v.* Duchesne, 19 Howard, 195, 1856; Dable Grain Shovel Co. *v.* Flint, 137 U. S. 41, 1890; Brill *v.* St. Louis Car Co., 80 F. R. 910, 1897.

inventors were oftener persecuted as heretics than rewarded as benefactors. Despotic kings were wont, in many countries, to confer monopolies upon their favorites, regardless of any meritorious right to the things monopolized; and it sometimes happened, in England and elsewhere, that, in pursuance of this practice, a monopoly of an invention was granted to its true inventor. Such a grant, however, was always a matter of kingly grace, and never a matter of legal right. In the reign of James the First, the English parliament limited this exercise of royal prerogative to cases of inventions, and thus laid the foundation of the patent laws of England. The limiting statute did not purport to confer upon inventors, any inchoate right which they might perfect and make absolute by proceeding in any manner pointed out by law. It recognized the power of the king to secure to any inventor, an exclusive right to his invention, if his royal pleasure prompted him so to do.[2] But the exercise of that power was so infrequent for more than a century, that Blackstone, in his Commentaries on the Laws of England, devoted but one sentence to the branch pertaining to patents for inventions.

§ 149*a*. Some inventors sometimes attempt to reap reward for their inventions by means of secrecy, instead of by means of patents. Such attempts are legitimate; but they are not applicable to designs, and are seldom applicable to machines or manufactures. Where an invention consists in a process, secrecy may be applicable, if it can be maintained; and it may also be applicable in the case of a composition of matter, where the ingredients thereof are not apt to be ascertained by analysis of the resulting product. But inventors can seldom practice their inventions, on a profitable scale, without any as-

[2] McKeever *v.* United States, 14 Court of Claims, 417, 1878.

sistance from other persons; and such assistance can seldom be rendered, without an adequate knowledge of the invention in which it is employed. For these reasons secrecy is liable to be lost by betrayal; and betrayal is a risk that inventors can seldom afford to take. Where an inventor does take that risk, and does incur betrayal of his secret invention, he naturally hopes to get some remedy in some court. To that end, he may begin an action at law for damages, for breach of the express or the implied contract, which was broken by the betrayal. But that remedy is valueless, where the betrayer has no property upon which to levy an execution. An action in equity, to restrain the betrayer from all further betrayal of the unpatented secret, would probably be entertained; but it would probably be ineffective to prevent the secret from becoming generally known among competitors. And no action at law or in equity, could be maintained against a competitor, for practicing a betrayed invention, unless he was a party to the betrayal.

§ 150. In the United States of America, the superior right of an inventor to his invention has a far better foundation than could be furnished by the prerogative of any king. That foundation is the consent of the people of the United States: a consent primarily expressed in the Federal Constitution, and elaborately defined in the Federal Statutes. The Constitution was established as the supreme law of the United States, on the twenty-first day of June, 1788. It conferred power upon Congress to promote the progress of the useful arts, by securing, for limited times, to inventors, the exclusive right to their respective inventions.[3] In exercise of that power, Congress, on the tenth day of April, 1790, enacted the first Federal statute on the subject; and provided therein that

[3] Article 1, Section 8.

the exclusive right in contemplation, should be secured to the respective inventors, by means of a written grant from the United States, to be named letters patent.[4] It is the office of this chapter to explain the nature, the extent, and the duration of the right secured by such a document; to outline the general form and necessary characteristics of such a document itself; and to set forth the rules by which such documents are properly construed.

§ 151. Patent rights are property,[5] and the very essence of the rights conferred by the patent is the exclusion of others from its use.[6] The owner of a patent is both legally and equitably entitled to the same protection for that property, that the owner of any other species of property may enjoy;[7] and he cannot be constitutionally deprived of that property without due process of law.[8] Due process of law includes the constitutional judgments and decrees of courts; but it does not include any act of Congress, or of any other legislature.[9] Patent rights, once vested, are therefore incapable of being divested by act

[4] 1 Statutes at Large, Ch. 7, p. 109.

[5] Brown *v.* Duchesne, 19 Howard, 195, 1856; Seymour *v.* Osborne, 11 Wallace, 533, 1870; Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 96, 1876; Cammeyer *v.* Newton, 94 U. S. 226, 1876; James *v.* Campbell, 104 U. S. 357, 1881; Marsh *v.* Nichols, 128 U. S. 612, 1888; Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

See Section 290 as to their status under the Bankruptcy Act.

[6] Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908; Herman *v.* Youngstown Car Mfg. Co., 191 F. R. 579, 1911.

[7] McCormick Machine Co. *v.* Aultman, 169 U. S. 609, 1898; Thomson *v.* Citizens' National Bank, 53 F. R. 252, 1892; Westinghouse Air-Brake Co. *v.* Chicago Brake & Mfg. Co., 85 F. R. 795, 1898.

[8] Fifth Amendment to the Constitution.

[9] Barron *v.* Baltimore, 7 Peters, 247, 1833; Kent's Commentaries, Lecture 24, p. 13; Taylor *v.* Porter, 4 Hill (N. Y.), 147, 1843.

of Congress,[10] except of course by the exercise of the power of eminent domain.[11] Nor can Congress do indirectly, that which it is forbidden to do with directness. It cannot destroy nor seriously impair the value of a patent right, under the guise of altering or repealing the existing remedies applicable to its enforcement, any more than it can so treat any other kind of property.[12]

The question of just what considerations determine the situs of a patent right has apparently not yet been directly passed upon or otherwise clearly stated. On this point, however, reference may be had to the cases cited in the note.[13]

§ 152. The right of property which an inventor has in his invention, is excelled, in point of dignity, by no other property right whatever. It is equalled, in point of dignity, only by the rights which authors have in their copyrighted books. The inventor is not the pampered favorite or beneficiary of the government, or of the nation. The benefits which he confers, are greater than those which he receives. He does not cringe at the feet of power, nor secure from authority an unbought privilege. He walks everywhere erect, and scatters abroad the knowledge which he created. He confers upon mankind a new means of lessening toil, or of increasing comfort; and what he gives cannot be destroyed by use, nor lost by misfortune. It is henceforth an indestructible heritage of posterity. On the other hand, he receives from the government, nothing which cost the government or the people a dollar

[10] McClurg *v.* Kingsland, 1 Howard, 202, 1843.

[11] See Sections 157 and 391.

[12] Green *v.* Biddle, 8 Wheaton, 75, 1823; Bronson *v.* Kinzie, 1 Howard, 317, 1843.

[13] Non-Magnetic Watch Co. *v.* Association, 44 F. R. 6, 1890; Standard Gas Power Co. *v.* Standard Gas Power Co., 224 F. R. 990, 1915.

or a sacrifice. He receives nothing but a contract, which provides that for a limited time he may exclusively enjoy his own. Compared with those who acquire property by devise or inheritance; compared with those who acquire by gift or marriage; compared with those who acquire property by profits on sales, or by interest on money; the man who acquires property in inventions, by creating things unknown before, occupies a position of superior dignity. Even the man who creates value by manual labor, though he rises in dignity above the heir, the donee, the merchant, and the money-lender, falls in dignity below the author and the inventor. The inventor of the reaper is entitled to greater honor than his father who used the grain cradle; and the inventor of the grain cradle is entitled to greater honor than his ancestors, who, for a hundred generations, had used the sickle. Side by side stand the inventor and the author. Their labor is the most dignified and the most honorable of all labor; and the resulting property is most perfectly theirs.

FRANCIS BACON gave the weight of his opinion, to views somewhat similar to the foregoing. The following is a translation of one of his Latin paragraphs:

"The introduction of great inventions appears one of the most distinguished of human actions, and the ancients so considered it; for they assigned divine honors to the authors of inventions, but only heroic honors to those who displayed civil merit; such as the founders of cities and empires, legislators, the deliverers of their country from lasting misfortunes, the quellers of tyrants, and the like. And if any one rightly compare them, he will find the judgment of antiquity to be correct; for the benefits derived from inventions may extend to mankind in general, but civil benefits to particular lands alone; the latter, moreover, last but for a time the former forever. Civil refor-

mation seldom is carried on without violence and confusion, while inventions are a blessing and a benefit without injuring or afflicting any." [14]

§ 152*a*. Section 152 of this book is the same in all its editions. During the twenty years which have passed since the first edition, that section has occasionally been quoted in the speeches of statesmen and advocates, when they were eulogizing the patent laws of the United States. Many years before he wrote his Novum Organum, FRANCIS BACON, in the preface to his Treatise on Interpreting Nature, wrote a paragraph which may have been influential toward causing the parliament to establish the patent laws of England, in the celebrated statute of James the First. The following is a copy of that paragraph:

"Now among all the benefits that could be conferred upon mankind, I discovered none so great as the discovery of new arts for the bettering of human life. For I saw that among the rude people of early times, inventors and discoverers were reckoned as gods. It was seen that the works of founders of States, lawgivers, tyrant-destroyers, and heroes cover but narrow spaces, and endure but for a time; while the work of the inventor, though of less pomp, is felt everywhere, and lasts forever."

Some Federal judges also, in recent years, have written sentences similar, in spirit, to the paragraphs of FRANCIS BACON.

Thus Judge BUFFINGTON: "While the motive and reward of the inventor is monetary, his work, measured by beneficent results, may arise to the dignity of the humane." [15] And thus Judge BRAWLEY: "The protection and hope of profit, held out by our patent laws, inspires

[14] Novum Organum, Book 1, Section CXXIX.

[15] Brislin *v.* Carnegie Steel Co., 118 F. R. 589, 1902.

that stimulating energy which leads to experiment, invention, and all the resulting benefits." [16] And thus Judge GROSSCUP: "Inventive genius has given to mankind most of its present material civilization. The magnificent flower of civilization, everywhere surrounding us, has opened from germs that were fructified from the brains of inventors." [17]

§ 153. "Letters patent are not to be regarded as monopolies, created by the executive authority at the expense and to the prejudice of all the community except the persons therein named as patentees, but as public franchises granted to inventors of new and useful improvements, for the purpose of securing to them, as such inventors, for the limited term therein mentioned, the exclusive right and liberty to make and use, and vend to others to be used, their own inventions, as tending to promote the progress of science and the useful arts, and as matter of compensation to the inventors, for their labor, toil and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress." Such is the accepted doctrine as formulated by Justice CLIFFORD when speaking for the Supreme Court.[18] The same ideas were more concisely expressed in an earlier case by Justice DANIEL.[19] Speaking of the inventor's exclusive right, he said: "This was at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incen-

[16] Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 870, 1901.

[17] Westinghouse Air-Brake Co. *v.* Chicago Brake & Mfg. Co., 85 F. R. 794, 1898.

[18] Seymour *v.* Osborne, 11 Wallace, 533, 1870.
See Section 151.

[19] Kendall *v.* Winsor, 21 Howard, 322, 1858.

tive to further efforts for the same important objects." Writing an opinion of the Supreme Court, and referring to the doctrine of patents, Justice MILLER said: "It is no longer a scarcely recognized principle, struggling for a foothold, but it is an organized system, with well-settled rules, supporting itself at once by its utility, and by the wealth which it creates and commands." [20] These opinions of the Supreme Court agree, therefore, in holding, with all fair and thoughtful men, that patent rights are not hurtful monopolies, but are rights of property at once dignified, honorable, and strong.

§ 155. It was said in previous editions of this book that no State has any power to make any law "interfering with" the sale of any patent right, and a number of state court decisions were cited which sustained the proposition as thus stated.[21] This question has since come before the Supreme Court in two cases wherein was involved the validity of a statute of Kansas which provided that no person should sell any patent right without first filing in the office of the District Court of the County duly authenticated copies of the letters patent and making oath that the letters are genuine and have not been revoked or annulled, and that the seller had full authority to transfer them. The Supreme Court overruled the previous cases above referred to and also some cases in the lower Federal Courts to the same effect, and held the Statute valid on the ground that it was a reasonable regulation to protect

[20] Merrill *v.* Yeomans, 94 U. S. 573, 1876.

[21] *Ex parte* Robinson, 2 Bissell, 313, 1870; Hollida *v.* Hunt, 70 Ill. 110, 1873; Helm *v.* First National Bank, 43 Ind. 167, 1873; Hascall *v.* Whitman, 19 Me. 102, 1873; Crittenden *v.* White, 23 Minn. 24, 1876; Cranson *v.* Smith, 37 Mich. 310, 1877; Tennessee *v.* Butler, 71 Tenn. 222, 1879; Wilch *v.* Phelps, 14 Neb. 134, 1883; Castle *v.* Hutchinson, 25 F. R. 394, 1885; Commonwealth *v.* Petty, 96 Ky. 452, 1895; Ball *v.* Coker, 168 F. R. 304, 1909.

the citizens of the State from fraud.[22] The court said in one of those cases, Allen *v.* Riley:

"The act must be a reasonable and fair exercise of the power of the State for the purpose of checking a well-known evil and to prevent, so far as possible, fraud and imposition in regard to the sales of rights under patents. Possibly Congress might enact a statute which would take away from the States any power to legislate upon the subject, but it has not as yet done so. It has simply provided that every patent, or interest therein, shall be assignable in writing, leaving to the various States the power to provide for the safeguarding of the interests of those dealing with the assumed owner of a patent, or his assignee. To deal with that subject has been the purpose of the acts passed by the various States, among them that of the State of Kansas, and we think that it was within the powers of the State to enact such statute. The expense of filing copies of the patent and the making of affidavits in the various counties of the State in which the owner of the rights desired to deal with them is not so great in our judgment as to be regarded as oppressive or unreasonable, and we fail to find any other part of the act which may be so regarded. Some fair latitude must be allowed the States in the exercise of their powers on this subject. It will not do to tie them up so carefully that they cannot move, unless the idea is that the States have positively no power whatever on the subject. This we do not believe, at any rate in the absence of Congressional legislation. The mere provision in the Federal statute for an assignment and its record as against subsequent purchasers, etc., is not such legislation as takes away the rights of the States to legislate on the subject

[22] Allen *v.* Riley, 203 U. S. 347, 1906; also, John Woods & Sons *v.* Carl, 203 U. S. 358, 1906; Ozan Co. *v.* Union, 207 U. S. 251, 1907.

themselves in a manner neither inconsistent with nor opposed to the Federal statute. We think the judgment is right, and it is affirmed."

Every State has power to regulate the making, the selling and the using of the things covered by any patent, to the same extent that it lawfully regulates the making, selling, and using of unpatented things. Things covered by patents are as much subject to the law of common carriers, the revenue laws, and the police powers, of a State or municipality, as any other things. Where a patented invention is used by the owner of the patent which covers it, or by a licensee under that patent, in a public business, like the telephone business, for example; that user may be compelled, by writ of mandamus, to impartially serve all those who properly request such service to be furnished to them.[23] Nor does a patent on a sewing-machine, for example, exempt the patentee from any State tax on the machines he may make, use or sell within the boundaries of that State.[24] And a patent for a dynamite powder, or for a deadly poison, or for an explosive oil, does not oust nor affect the power of local authorities to prescribe the place and manner of the manufacture, storage and sale of those dangerous substances.[24a] Neither does a patent on a medicine, authorize the patentee to prescribe or administer that medicine, without conforming to the medical practice laws of the State,

[23] Ohio *v.* Bell Telephone Co., 36 Ohio State Reports, 296, 1880; Missouri *v.* Bell Telephone Co., 24 American Law Register, 573, 1885; Nebraska *v.* Nebraska Telephone Co., 24 American Law Register, 262, 1885; Bell Telephone Co. *v.* Pennsylvania, 7 Eastern Reporter, 672, 1886; Telegraph Co. *v.* Telephone Co., 91 Vt. 243, 1888; Delaware Telephone Co. *v.* Delaware, 50 F. R. 677, 1892.

[24] Weber *v.* Virginia, 103 U. S. 347, 1880.

[24a] Patterson *v.* Kentucky, 97 U. S. 505, 1878.

in which he undertakes thus to practice his invention.[25] Nor does a patent on a process or a machine, which may be used in some kind of gambling, protect the patentee against prosecution under State laws, for thus using his invention.[26]

The reason why a State has complete power of regulation over the sale of a patented thing, and is restricted in its power of regulation over the sale of the patent covering that thing, is explainable as follows. A patentee has two kinds of rights in his invention. He has a right to make, use, and sell specimens of the invented thing; and he has a right to prevent all other persons from doing either of those acts. The first of these rights is wholly independent of the patent laws; while the second exists by virtue of those laws alone.[27] A patentee therefore holds the first of these rights subject not only to the police powers, but to the taxing powers, of the State, and to the law regulating common carriers; while the second, being the creature of the laws of Congress, is wholly beyond State control or interference, by anti-trust laws,[28] or otherwise except in the exercise of the police powers of the State.

§ 156. Patent rights, being, as they are, intangible property, cannot be seized and sold under the authority of any writ of *fieri facias*, or other common-law execution.[29] They may, however, be reached by a creditor's bill in

[25] Jordan *v.* Dayton, 4 Ohio, 295, 1831.

[26] Vannini *v.* Paine, 1 Har. (Del.) 65; Heaton-Peninsular Button-Fastener Co. *v.* Eureka Specialty Co., 77 F. R. 294, 1896.

[27] Bloomer *v.* McQuewan, 14 Howard, 539, 1852; United States *v.* Bell Telephone Co., 167 U. S. 238, 1897; Jewett *v.* Atwood Suspender Co., 100 F. R. 647, 1900; Victor Talking Mach. Co. *v.* The Fair, 123 F. R. 426, 1903.

[28] Columbia Wire Co. *v.* Freeman Wire Co., 71 F. R. 306, 1895.

[29] Stevens *v.* Cady, 14 Howard, 528, 1852; Stevens *v.* Gladding, 17 Howard, 447, 1854.

equity,[30] and thus be applied to the payment of the debts of the owners; the same as trust property, choses in action, or stock of a debtor in a corporation, may be reached and applied. A court of equity may, in pursuance of its powers in such cases, decree that the debtor patentee pay the judgment upon which the bill is based, or, in default thereof, that his patent right be sold under the direction of the court, and an assignment thereof be executed by him, and, in default of his executing such an assignment, that some suitable person be appointed trustee to execute the same in his place,[31] or that the master in chancery of the court shall perform that function.[32]

§ 157. Previous editions of this book stated that patent rights are exclusive, not only of citizens and residents of the United States, but also of the government itself, and of its agents; that the government has no more right than any private citizen, to make, use, or sell a patented invention, without the license of the patentee;[33] and that when the government grants letters patent for an invention, it confers upon the patentee an exclusive property therein, which cannot be appropriated or used by the government itself, without just compensation, any more than land which has been patented to a private purchaser can, without compensation, be appropriated or used by the government.[34] These statements were

[30] Newton *v.* Buck, 72 F. R. 780, 1896.

[31] Ager *v.* Murray, 105 U. S. 126, 1881; Underfeed Stoker Co. *v.* American Ship Windlass Co., 165 F. R. 65, 1908; Ball *v.* Coker, 168 F. R. 304, 1909.

[32] Wilson *v.* Fire Alarm Co., 52 O. G. 901, 1890.

[33] United States *v.* Burns, 12 Wallace, 252, 1870; Cammeyer *v.* Newton, 94 U. S. 234, 1876; Solomons *v.* United States, 137 U. S. 346, 1890; Belknap *v.* Schild, 161 U. S. 16, 1896; see sections 392 and 393.

See Harley *v.* U. S., 198 U. S. 234, 1905.

[34] James *v.* Campbell, 104 U. S. 356, 1881; United States *v.*

correct when made and are correct now, but in 1910 Congress passed an act providing for compensation for the appropriation of patent rights, as follows:

"That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover a reasonable compensation for such use by suit in the Court of Claims: *Provided, however*, That said Court of Claims shall not entertain a suit or reward compensation under the provisions of this Act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of the United States: *Provided further*, That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for infringement, as set forth in Title Sixty of the Revised Statutes, or otherwise: *And provided further*, That the benefits of this Act shall not inure to any patentee, who, when he makes such claim is in the employment or service of the Government of the United States; or the assignee of any such patentee; nor shall this Act apply to any device discovered or invented by such employee during the time of his employment or service." [35]

This Statute is held by the Supreme Court in Crozier *v.* Krupp [36] to be an authorization to appropriate under the law of eminent domain a license to use the invention of any United States patent. The court recognizes the doctrine held before the passage of the Act that an inventor was entitled to sue in the Court of Claims to recover a license

Palmer, 128 U. S. 271, 1888; International Postal Supply Co. *v.* Bruce, 114 F. R. 511, 1902.

[35] 36 Statutes, 851, Chap. 423, Laws 1910.

[36] Crozier *v.* Krupp, 224 U. S. 290, 1912; see sections 392 and 393.

fee for the use of his patent when the use was by virtue of a contract between the inventor and the government,[37] and holds that the act extends this right to an inventor whose invention has been used by the government, without his consent,—in other words, when the government has committed a tort in so doing. As to the right to an injunction against an officer of the government to enjoin him from using the invention for the benefit of the government the court said:

". . . in view of the subject-matter of the controversy and the right of the United States to exert the power of eminent domain as to that subject, at most and in any event the injunction could rightfully only have been made to operate until the United States had appropriated the right to use the patented inventions, and as that event has happened the injunction, if granted, would no longer have operative force. It follows that the decree of the Court of Appeals must be reversed with directions to that court to affirm the decree of the Supreme Court of the District of Columbia dismissing the bill, without prejudice however to the right of the defendant here, who was the complainant below, to proceed in the Court of Claims in accordance with the provisions of the act of 1910."

It may accordingly be considered to be the law that an officer of the Government cannot be sued in such a case as the above. The doctrine has however, been carried still further in the case of Marconi Wireless Telegraph Co. *v.* Simon,[37a] where it was held that one who contracts to supply to the government articles that, if supplied to a private party, would be an infringement, is immune from

[37] Crozier *v.* Krupp, 224 U. S. 290, 1912; United States *v.* Anciens Etablissements, 224 U. S. 309, 1912.

[37a] Marconi Wireless Telegraph Co. *v.* Simon, 227 F. R. 906, 1915 (affirmed 231 F. R. 1021).

injunction. It was said in the opinion that the contractor in such case was supplying goods to a lawful licensee. This holding should not, however, necessarily preclude a recovery from the contractor of damages and profits, although it has been held that it does so;[38] and on the assumption that the contractor was not an infringer because the government was not one and that, as said in the cases cited in the last reference, the contractor is supplying goods to a lawful licensee, the holding would seem to be correct. On the contrary, however, it does not appeal to our sense of justice that a third party without the consent of the patentee, should be permitted to retain to himself profits which he has acquired by carrying out his contract with the government when he would not be permitted to retain them had he been carrying out the contract with a private party or had been using the patent for his own benefit. It is obvious, however, that if the outcome of a contract with the government to supply the latter with patented articles was likely to be a suit by the patentee for the recovery of damages and profits, the operation of the statute would be considerably hampered.

§ 158. As provided by the Revised Statutes no patent right covers any use or sale of any specimen of the patented thing which was purchased of the inventor, or made by another with his knowledge and consent, before his application for a patent therefor.[39]

An application of the rule of the Statute is made

[38] Marconi Wireless Telegraph Co. *v.* Simon (D. C.), 227 F. R. 906, 1915 (affirmed 231 F. R. 1021); also International Curtis, etc., Co. *v.*-William Cramp & Sons etc., Co., 202 F. R. 932, 1912; International Curtis, etc., Co. *v.* William Cramp & Sons etc., Co., 232 F. R. 166, 1916.

[39] Revised Statutes, Section 4899; Wade *v.* Metcalf, 129 U. S. 202, 1889; Dable Grain Shovel Co. *v.* Flint, 137 U. S. 41, 1890.

where, while an application is pending the applicant submits to the Federal Government plans of his device with the purpose of procuring the Government to advertise for open bids. In such case, the contract of the successful bidder being legal when made, and made with the consent of the patentee, no injunction will issue even after the issuance of the patent.[40] Nor will any action for damages lie on behalf of a patentee against one who has wilfully by obstructive tactics as by filing an interference caused issuance of the patent to be delayed.[41] Where another than the inventor, surreptitiously obtains knowledge of an invention, and, without the consent of the inventor, makes a specimen of the invented thing before any patent thereon is applied for, that specimen is covered by a patent for that invention, as truly and as fully as it would be if it had been made by an infringer after the date of that patent.

The word "person" in the statute referring to those who obtain rights to the subsequently patented article is to be interpreted literally and is not confined merely to those in privity with the inventor by virtue of a purchase or series of purchases, as for instance when the patented article has become affixed to realty by the operation of a state law.[41a]

Where another than the first inventor, re-invents and constructs a specimen of an invention, before any patent is applied for thereon, and does so without any knowledge of the inventor, or of his doings, and without the knowledge or consent of the inventor himself, he cannot invoke

[40] Sub-Target Gun Co. *v.* Hollifield Target Practice Rod Co., 175 F. R. 119, 1910.

[41] B. F. Avery & Sons *v.* J. I. Case Plow Works, 174 F. R. 147, 1909.

[41a] Federal Construction Co. *v.* Park Improvement Co., 166 F. R. 128, 1908.

the rule stated at the beginning of this section; because knowledge and consent of the inventor is an express element in the statute which supports that rule. But it is probable that the specific thing, so constructed, is taken out of the operation of a patent afterward applied for, by the direct action of the fifth amendment to the Constitution of the United States. That amendment provides that no person shall be deprived of property without due process of law. Things independently re-invented and innocently made, before the first inventor applied for a patent thereon, are the lawful property of him who thus made them. To deprive him of the right to use and to sell those things, would be to lessen or to destroy their value, and thus to deprive him of property rights. If such an act is ever done at the suit of the first inventor, after he gets his patent, it will be done by virtue of that patent. Now, a patent is the creature of a statute. No statute is "due process of law," [42] and no patent can be "due process of law" unless a creature can be greater than its creator: unless a statute can authorize a contract to accomplish, upon the rights of third parties, a result which the statute itself is forbidden to accomplish. If this reasoning and this conclusion are correct, it will not follow therefrom, that such a re-inventor may construct any specimen of the invention after the first inventor has obtained a patent thereon. To deprive a re-inventor of such a privilege, is not to deprive him of property, for no re-inventor has any property right in an invention which he was the second in the United States to make, any more than he would have if he had learned of that invention from a newspaper or from a book.

§ 159. The rule stated at the head of the last section

[42] Barron *v.* Baltimore, 7 Peters, 247, 1833; Taylor *v.* Porter, 4 Hill (N. Y.), 147, 1843.

does not apply to any process patent. Section 4899 of the Revised Statutes, treats only of machines or other patentable articles, and confers exemption from the operation of patents upon nothing but specific things. Now, a process is neither an article nor a thing. It is a series of acts. It is therefore outside the language of the law on this subject. It is also outside the reason of that law. That reason is as follows: Where another than the first inventor of a particular tangible thing, buys from the inventor a specimen of that thing, or makes such a specimen with his consent, or re-invents and makes such a specimen independently of the first inventor, that specimen ought to be exempt from any patent afterward applied for by the first inventor; because, if it is not so exempt, it will become worthless in the hands of one who honestly expended of his substance to procure it, and who procured it without violating any patent or any law. Processes are not subjects of these considerations. A process cannot be purchased. The right to practice a patented process can indeed be purchased; but the right to practice an unpatented process, while it remains unpatented, cannot be the subject of a sale, because that right belongs to every one without any purchase. So also, if an inventor of a process consents that another person may practice that process, before the inventor applies for a patent, that fact furnishes no reason why that person should be allowed to practice that process, against the will of that inventor, after the date of his patent. To deprive such a person of such a privilege, is not to deprive him of the use of a thing. It is only to deprive him of the privilege of repeating a series of acts. These considerations apply also to cases where a re-inventor produces and practices a process, after its production by the first inventor, and before any application is made for a patent thereon, and without any

knowledge of the first inventor or his doings. Such a re-inventor has no more natural right to practice that process, after a patent is granted to the first inventor, than any other person has. He has no such right growing out of the fact that he was a re-inventor, because the patent laws do not reward re-inventors, and because patents to first inventors are exclusive of re-inventors, as well as of other persons. He has no such right growing out of rights of property, because to deprive him of the privilege of repeating the process is not to deprive him of the use of any tangible property, and because he has no tangible property in the process itself.

§ 160. Every United States patent is in general co-extensive, in point of the territory it covers, with the territory covered by the jurisdiction of the United States.[43] Every such patent, therefore, covers the use of the patented thing in or under the tide-waters of the United States; and that, too, even in cases where the government has granted, to others than the patentee, the exclusive right to do, at a particular place, the particular thing which the patented invention is adapted to accomplish.[44] In the case just cited, the complainant had a patent on a certain submarine telegraph cable; and the defendant had a grant from Congress, giving it the sole right, for fourteen years, to lay, construct, land, maintain, and operate telegraphic cables in and over the waters, reefs, islands, shores, and lands over which the United States have jurisdiction, from the shores of Florida to the Island of Cuba. Under these circumstances, Justice BLATCHFORD decided that the defendant acquired, by its grant, no right to use the patented cables of the complainant; and he intimated that the complainant acquired by

[43] Revised Statutes, Section 4884. See Section 706*a*.

[44] Colgate *v.* Ocean Telegraph Co., 17 Blatch. 310, 1879.

this patent, no right to use his cables between Florida and Cuba. His Honor supported this intimation by saying that no patent confers upon its owner any right to make or use his invention in the house of another; and he supported his decision by saying that the fact just mentioned does not confer upon another than the patentee any right to make or use the invention of the latter in the house of the former.

§ 161. No United States patent right extends to the mere use of the patented invention on any foreign ship while temporarily in a harbor of the United States for the purposes of commerce; though such a right would be infringed by making or selling the patented article on board any foreign vessel while in either of our ports.[45] United States patent rights extend to the decks of United States ships, even when those ships are on the high seas, as fully as they extend to the solid earth of the United States.[46]

§ 162. The regular duration of a United States patent for a process, machine, manufacture, or composition of matter, is seventeen years from the date of issue. Section 4884 of the Revised Statutes provides that every patent shall grant to the patentee, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use, and vend the invention covered thereby. The phrase "every patent" is not to be understood in its literal signification. It means every patent, the duration of which is not otherwise prescribed by statute. In the latter category, design patents fall. Such patents are grantable for fourteen years, or for seven years, or for three years and six months, as the applicant may in his application elect.[47]

[45] Brown *v.* Duchesne, 19 Howard, 196, 1856.

[46] Gardner *v.* Howe, 2 Cliff. 464, 1865.

[47] Revised Statutes, Section 4931.

In the same category, also, fall some patents, which were granted for inventions for which their owners had previously obtained one or more foreign patents.

§ 163. "Every patent granted for an invention which has previously been patented in a foreign country, shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years." [48]

This law applies to certain patents which were granted after July 8, 1870, on applications which were filed before January 1, 1898; but it does not apply to any patent granted on an application filed on or after that date for the reason that in the amendment of Section 4887 of the Revised Statutes by the Act of March 3, 1897, in effect January 1, 1898,[49] the provision above quoted was omitted. On September 14, 1902, however, the Treaty of Brussels of December 14, 1900, went into effect, whereby it was provided as follows:

"Art. 4 *bis*. Patents applied for in the different contracting States by persons admitted to the benefit of the convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.

"This provision shall apply to patents existing at the time of its going into effect.

"The same rule applies, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion."

The question came up in a number of cases the decisions

[48] 16 Statutes at Large, Ch. 230, Section 25, p. 201; Revised Statutes, Section 4887.

[49] 29 Statutes at Large, p. 694, Ch. 391, Sections 3 and 8.

of which are cited in the note [50] as to whether or not the quoted provision of the Treaty superseded Section 4887 regarding the term of domestic patents. In Cameron Septic Tank Co. *v.* Knoxville [51] it was finally decided that they did not, as Article 4 *bis* of the Treaty above quoted was not self-executing and it was not made effective by the Act of March 3, 1903.[52]

And this law applies only to cases wherein the foreign patent was taken out by the United States patentee; or with his knowledge and consent by some other person; [53] or by some person in privity with him.[54]

This law applies to a case where a foreign patent was granted before the granting of the corresponding United States patent, even if the foreign patent was made a secret one at the request of the applicant therefor; [55] but it does not apply to a case where a foreign patent was dated before the granting of the corresponding United States patent, but not sealed or published until afterward; [56] though it does apply to a case where the United

[50] United Shoe Machinery Co. *v.* Duplessis Shoe Machinery Co., 148 F. R. 31, 1906; United Shoe Machinery Co. *v.* Duplessis Shoe Machinery Co., 155 F. R. 842, 1907; Hennebique Construction Co. *v.* Myers, 172 F. R. 869, 1909; Malignani *v.* Jasper Marsh Consol. etc., Co., 180 F. R. 442, 1910; Commercial Acetylene Co. *v.* Searchlight Gas Co., 197 F. R. 908, 1912; Commercial Acetylene Co. *v.* Schroeder, 203 F. R. 276, 1913; Merrell-Soule Co. *v.* Powdered Milk Co., 215 F. R. 922, 1914.

[51] Cameron Septic Tank Co. *v.* Knoxville, 227 U. S. 39, 1913.

[52] 32 Statutes, 1225, Chap. 1019.

[53] Hobbs *v.* Beach, 180 U. S. 397, 1901; John R. Williams Co. *v.* Miller, Du Brul & Peters Mfg. Co., 108 F. R. 968, 1901.

[54] John R. Williams Co. *v.* Miller, Du Brul & Peters Mfg. Co., 115 F. R. 526, 1902.

[55] Gramme Electrical Co. *v.* Electric Co., 17 F. R. 838, 1883.

[56] Gold & Stock Telegraph Co. *v.* Telegram Co., 23 F. R. 340, 1885; Emmerson *v.* Lippert, 31 F. R. 911, 1887; Seibert Oil Co. *v.* Powell Co., 35 F. R. 591, 1888;

States patent was granted after the foreign patent was sealed, upon an application filed before that event.[57]

And this law does not apply to a case where the invention, claimed in the United States patent, was not claimed, but only described, in the prior foreign patent;[58] and it does not apply to a case where the foreign patent never became operative, on account of non-compliance with some condition of the law under which it was issued;[59] though it does apply to a case where the foreign patent granted an exclusive right to make, but granted no exclusive right to use or sell, the invention covered by the United States patent.[60]

And finally, this law applies to such claims of a United States patent as correspond with any invention described in the prior foreign patent, even where some of its claims do not thus correspond.[61]

In a case to which this law applies, the United States patent will not expire with the first term of the foreign patent, if the foreign patent was, or hereafter shall be, extended before the expiration of its first term, in pursuance of a statute which was in force when the United States patent was applied for and when it was issued,

Holmes Alarm Tel. Co. *v.* Telephone Co., 42 F. R. 228, 1890; American Bell Telephone Co. *v.* Cushman, 57 F. R. 843, 1893; Edison Electric Light Co. *v.* Waring Electric Co., 59 F. R. 364, 1894; Waring Electric Co. *v.* Edison Electric Light Co., 69 F. R. 645, 1894.

[57] Bate Refrigerating Co. *v.* Sulzberger, 157 U. S. 1, 1895; Bate Refrigerating Co. *v.* Gillett, 13 F. R. 553, 1882; Gramme Electrical Co. *v.* Electric Co., 17 F. R. 838, 1883; Edison Electric Light Co. *v.* United States Electric Lighting Co., 35 F. R. 135, 1888.

[58] Westinghouse Electric & Mfg. Co. *v.* Stanley Instrument Co., 138 F. R. 823, 1905.

[59] Societe Anonyme, etc., *v.* General Electric Co., 97 F. R. 605, 1899.

[60] Atlas Glass Co. *v.* Simonds Mfg. Co., 102 F. R. 643, 1900.

[61] Western Electric Co. *v.* Citizens' Telephone Co., 106 F. R. 218, 1901.

and which conferred an absolute right to such an extension, and if the extension or extensions of the foreign patent cover a continuous space of time.[62] And it has been decided in several Circuit Courts, that the United States patent will not expire with the first term of the foreign patent, if the foreign patent might have been extended before the expiration of its first term, in pursuance of a statute which was in force when the United States patent was applied for and when it was issued, and which conferred an absolute right to such an extension, whether the foreign patent was actually extended or not.[63] But the contrary of this proposition has been held by another Circuit Court.[64] It has also been decided on the Circuit, that where the patentee has no absolute right to an extension of the first term of his foreign patent, no such extension has any effect upon the duration of his United States patent.[65]

The termination of a foreign patent, prior to its appointed end, because of an omission of the patentee to do what the foreign laws require in order to keep it in force, has no effect upon the duration of a corresponding United States patent.[66] Nor will any such effect result from the expiration of a prior foreign patent, on account of the expiration of a patent of another foreign country on the same invention.[67] Where the corresponding foreign

[62] Bate Refrigerating Co. *v.* Hammond, 129 U. S. 151, 1889.

[63] Consolidated Roller-Mill Co. *v.* Walker, 43 F. R. 581, 1890; Pohl *v.* Heyman, 58 F. R. 568, 1893.

[64] Bonsack Mach. Co. *v.* Smith, 70 F. R. 395, 1895.

[65] Henry *v.* Tool Co., 3 Bann. & Ard. 501, 1878.

[66] Pohl *v.* Anchor Brewing Co., 134 U. S. 381, 1890; Holmes Protective Co. *v.* Alarm Co., 21 F. R. 458, 1884; Paillard *v.* Bruno, 29 F. R. 864, 1886; Victor Talking Mach. Co. *v.* Hoschke, 158 F. R. 309, 1907 (Canadian Patent); Leeds & Catlin *v.* Victor Talking Mach. Co., 213 U. S. 301, 1909.

[67] Edison Electric Light Co. *v.*

patent terminated before the United States patent for the same invention was applied for, the latter is void *ab initio*;[68] though where the foreign patent terminated while the application for the corresponding United States patent was pending in the Patent Office, the latter patent is not thus void, but is limited by the foreign patent, the same that it would have been limited, if it had been issued the same day that it was applied for.[69] And a repeal *ab initio*, of a foreign patent which would otherwise limit the duration of a corresponding United States patent, restores the latter to its full term of seventeen years.[70]

It is not necessary to the validity of a United States patent granted for an invention which was previously patented in a foreign country, that it shall appear on its face to be so limited as to expire at the same time with the foreign patent which limits its life.[71] The statute is satisfied when the courts decline to enforce it after the expiration of that foreign patent, whether or not it appears on its face to be so limited.[72]

And the duration of a patent should never be limited because of the expiration of a foreign patent, if there is any doubt about the invention covered by the two patents being substantially the same.[73] But differences of

Perkins Electric Lamp Co., 42 F. R. 327, 1890.

[68] Huber *v.* Nelson Mfg. Co., 148 U. S. 275, 1893.

[69] Welsbach Light Co. *v.* Apollo Incandescent Gaslight Co., 96 F. R. 335, 1899.

[70] Bate Refrigerating Co. *v.* Gillett, 20 F. R. 192, 1884.

[71] Telephone Cases, 126 U. S. 572, 1888; Bate Refrigerating Co. *v.* Hammond, 129 U. S. 151, 1889.

[72] New American File Co. *v.* Nicholson File Co., 8 F. R. 816, 1881; Canan *v.* Mfg. Co., 23 F. R. 185, 1885.

[73] Brush Electric Co. *v.* Julien Electric Co., 41 F. R. 696, 1890; Brush Electric Co. *v.* Accumulator Co., 47 F. R. 52, 1891; Aquarama Co. *v.* Old Mill Co., 124 F. R. 229, 1903.

description or of details, do not necessarily involve differences of invention;[74] and the true test of identity consists in ascertaining and deciding whether the practice of what is described in the foreign patent, would constitute an infringement of the United States patent.[75] In other words, the court "must look through the mere form of phraseology and determine what was the essence of the invention of the foreign patent."[76]

A foreign patent for an apparatus for performing a method is not for the same invention as a domestic patent for performing the method.[77] Stated more broadly, where dependent and related inventions are covered by a United States patent, as, for example, an invention of a machine combined with an invention of a process, a foreign patent for either invention does not affect the other.[78] And to go still further such claims as cover inventions patented in the foreign patent will expire with the foreign patent, while the remaining claims will remain in force till the expiration of the United States patent.[78a]

The law set forth in this section applies to no patent which was originally granted prior to July 8, 1870; and applies to no reissue of any patent which was originally

[74] Siemens *v.* Sellers, 123 U. S. 283, 1887; Commercial Mfg. Co. *v.* Fairbank Co., 135 U. S. 192, 1890; Thomson-Houston Electric Co. *v.* McLean, 153 F. R. 883, 1907.

[75] Commercial Mfg. Co. *v.* Fairbank Co., 135 U. S. 194, 1890; Accumulator Co. *v.* Julien Electric Co., 57 F. R. 609, 1893.

[76] Commercial Acetylene Co. *v.* Searchlight Gas Co., 188 F. R. 85, 1911.

[77] Acme Acetylene Appliance Co. *v.* Commercial Acetylene Co., 192 F. R. 321, 1911.

See Leeds & Catlin *v.* Victor Talking Machine Co., 213 U. S. 301, 1909.

[78] Leeds & Catlin *v.* Victor Talking Machine Co., 213 U. S. 301, 1909; Fireball Gas Co. *v.* Commercial Acetylene Co., 239 U. S. 156, 1915.

[78a] Leeds & Catlin *v.* Victor Talking Machine Co., 213 U. S. 301, 1909.

granted before that date, even though the reissue itself was granted after that date;[79] and applies to no patent, the original application for which was filed after 1897.

§ 170. The terms of all United States patents begin at their respective dates.[80] These dates cannot be later than nine months after the day on which the respective applications are allowed.[81] Subject to that limitation, patents are dated and issued on the fourth Tuesday after the Patent Office receives the final fees therefor, respectively; except where those fees are received on Friday, Saturday, or Monday, and in those cases the patents are dated and issued on the fifth Tuesday thereafter.[82]

The former provision that "every patent shall bear date as of a day not later than six months from which it was passed and allowed and notice thereof was sent to the applicant or his agent" was, however, directory merely; and so when, as was customary with the Patent Office when an excess of work had accumulated, the patent was re-allowed and issued on a later date, it will not be held void for that reason.[83]

§ 171. The grantee of the government, in cases of letters patent for inventions, may be any person who is the inventor;[84] or may be his assignee;[85] or an assignee of an assignee;[86] or an assignee who has assigned the invention;[87]

[79] Badische Anilin & Soda Fabrik *v.* Hamilton Mfg. Co., 3 Bann. & Ard. 235, 1878.

[80] Rein *v.* Clayton, 37 F. R. 355, 1889.

[81] Revised Statutes, Section 4885, as amended 35 Stat. 246.

[82] Patent Office Rule 167.

[83] Western Electric Co. *v.* North Electric Co., 135 F. R. 79, 1905.

[84] Revised Statutes, Section 4886.

[85] Revised Statutes, Section 4895.

[86] Selden *v.* Gas Burner Co., 19 Blatch. 544, 1881; Elliott-Fisher Co. *v.* Underwood Typewriter Co., 176 F. R. 372, 1909.

[87] Consolidated Electric Light Co. *v.* Edison Electric Light Co., 25 F. R. 719, 1885; Consolidated

or a guardian or conservator of an insane inventor, or the representative in trust of his estate;[88] or if an inventor dies before any patent is granted for his invention, the right to obtain the patent devolves 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 invention, then in trust for his devisees.[89] In this last case the patent may be granted to the executor by his proper personal name, without any declaration that he takes in his representative capacity;[90] and the same thing is equally true in cases where the patent is granted to an administrator. The assignee to which a patent is granted may be a corporation, as well as a natural person; and may be a partnership as well as a plurality of persons.[91]

Where an inventor applies for a patent to be issued to himself, and then dies before any patent is granted; the patent may be granted in his name as patentee, and will be valid notwithstanding his prior death; and the title thereto will vest in his executor or administrator, if there is any, whoever he may be; and if there is no executor or administrator, the title will ultimately vest in the heirs or legatees of the inventor, whoever they may be.[92]

Where an inventor assigns his invention before making an application for a patent, and then makes such an appli-

Electric Light Co. *v.* McKeesport Light Co., 34 F. R. 335, 1888.

[88] 30 Statutes at Large, p. 915, Ch. 227.

[89] Revised Statutes, Section 4896; as amended by Act of Feb. 28, 1889, and by Act of May 23, 1908.

[90] Stimpson *v.* Rogers, 1 Blatch. 336, 1879; Northwestern Fire Extinguisher Co. *v.* Philadelphia Extinguisher Co., 1 Bann. & Ard. 177, 1874.

[91] Fruit-Cleaning Co. *v.* Fresno Home Packing Co., 94 F. R. 849, 1899.

[92] De La Vergne Machine Co. *v.* Featherstone, 147 U. S. 211, 1893.

cation, coupled with a request that the patent be granted to the assignee, and accompanied with an entry of the assignment on the records of the Patent Office, and then dies before any patent is granted; there appears to be no reason why the patent should not be granted to the assignee, though the statute literally provides that in all cases where the inventor dies before the patent is granted, the right to the patent devolves on his executor or administrator in trust for his heirs or devisees.[92a] But this statute must receive a reasonable construction, and it is not reasonable to hold that the death of an inventor, who has sold and assigned his inchoate right to a patent, should operate to divest his assignee of that right, and devolve it upon another person, in trust for still another party. Nor is there any propriety, in such a case, in granting the patent to the executor or administrator, on the theory that he will take as trustee for the assignee. The assignee requires no trustee, for his inchoate title is a legal, and not a merely equitable one;[93] and the executor or administrator, if he takes at all, must take as trustee for the heirs or devisees of the inventor.

Where an inventor assigns his invention and dies before making any application for a patent, a difficulty arises for which the statute affords no clear solution. In such a case, it is provided that the application must be made and sworn to by the executor or administrator, for an assignee cannot apply for a patent except on the oath of the inventor himself.[94] It is also provided, that where an executor or administrator applies for a patent, he must take that patent, if granted, in trust for the heirs or devisees

[92a] Revised Statutes, Section 4896, as amended by Act May 23, 1908, 35 Stat. 245.

[93] Hendrie *v.* Sayles, 98 U. S. 549, 1878. See Section 274.

[94] Revised Statutes, Sections 4895, 4896, Act May 23, 1908.

of the inventor.[95] Now under these circumstances, the law must do one of three things. It must ignore this last provision, and hold that the executor or administrator takes in trust for the assignee; or it must impose a trust upon a trust, by holding that the executor or administrator takes in trust for the heirs or devisees, and they take in trust for the assignee; or it must deprive the assignee of his right altogether. The first alternative flies in the face of the statute, and the third flies in the face of justice. The second is consistent with conscience, and can probably be adopted and enforced by courts of equity.

§ 172. Letters patent are documents consisting of the grant and the specification; and where drawings form a part of the application, they also form a part of the letters patent, and will be examined to ascertain the true meaning of the terms used in describing the invention.[96] The grant is a paper, issued in the name of the United States, under the seal of the Patent Office, and signed by the Commissioner of Patents.[97] It contains a short title of the invention, and purports to grant to the patentee, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use, and vend the invention, throughout the United States and the territories thereof; and it refers to the specification, for the particulars of the invention covered by the grant,[98] and each of the three rights granted by letters patent is a separate substantive right.[99]

[95] Revised Statutes, Section 4896, as amended 35 Stat. 245.

[96] Steiner & Voeghtly Hardware Co. *v.* Tabor Sash Co., 178 F. R. 831, 1910.

[97] Revised Statutes, Section 4883, as amended April 11, 1902, in 32 Statutes at Large, Pt. 1, Ch. 417, p. 95.

[98] Revised Statutes, Sections 4883, 4884.

[99] Adams *v.* Burke, 17 Wall. 453, 1873; Tuttle *v.* Matthews, 28 F. R. 98, 1886.

Letters patent are valid where the grant is signed by an Acting Commissioner of Patents; and letters patent, so signed, are admissible in evidence without any pleading or proof of his title to his office. Courts take judicial notice of the persons who preside over the departments or bureaus of the government, whether permanently or temporarily; and the production of their commissions is not necessary to support their official acts.[100] So also, since July 11, 1890, the Assistant Commissioner of Patents has had jurisdiction to sign the grants of letters patent for inventions, whenever the Commissioner has assigned him to perform that function.[101]

A misnomer of the patentee, in a grant, does not invalidate the patent, if he can be identified by means of any description which the letters patent may contain.[102] If the letters patent contains no means for correcting the misnomer, it may be corrected by the proper officers of the government, whenever those officers become convinced of the mistake.[103]

But regularly executed letters patent cannot be altered in character by the Commissioner of Patents, except after a surrender, and by means of a reissue, and any such alteration otherwise made, is void for want of jurisdiction in the Commissioner to make it.[104] But where an alteration has been actually made by the Commissioner of Patents, at the request of the patentee, and where some party has relied upon the validity of that alteration, to the extent of embarking in business because of it, the patentee may

[100] York & Maryland Line Railroad Co. *v.* Winans, 17 Howard, 30, 1854.

[101] United States *v.* Duell, 95 O. G. 1052, 1901.

[102] Northwestern Fire Extinguisher Co. *v.* Philadelphia Extinguisher Co., 1 Bann. & Ard. 177, 1874.

[103] Bell *v.* Hearne, 19 Howard, 262, 1856.

[104] Edison Electric Light Co. *v.*

be estopped from denying that validity, as against that particular party.[105]

§ 173. The word "specification," whenever it is used in the statute without the word "claim," covers both the claim and the description; and whenever it is used with the word "claim," it covers the description only.[106] The first is its more general meaning, and to avoid confusion it is never used in any other sense in this book. The proper characteristics of specifications are herein explained by explaining the proper characteristics of descriptions and claims, which are the component parts of specifications.

§ 174. The description of the invention, which forms a part of every specification, is required to set forth that invention, and the manner and process of making 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 and use the same; and in case of a machine, the description is required to explain the principle thereof, and the mode of applying that principle which the inventor believes to be the best.[107] Where the essence of the invention is the location, form, size or any other characteristic of the means employed, the patent must distinctly specify the peculiarities which characterize the invention.[108] The pointing out of a form, composition or construction of a mechanical element in accordance with the statute when those characteristics are not essential to the combination

U. S. Electric Lighting Co., 52 F. R. 312, 1892.

[105] Edison Electric Light Co. *v.* Buckeye Electric Co., 59 F. R. 699, 1894.

[106] Wilson *v.* Coon, 18 Blatch. 532, 1880.

[107] Revised Statutes, Section 4888; Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

[108] Am. Lava Co. *v.* Steward, 155 F. R. 731, 1907.

or improvement is not a limitation and does not deprive the inventor of his full right to equivalents or preclude him from claiming other modes of application.[109] Where the patent is an improvement on a prior patent which is referred to in the improvement patent, the latter should be read in connection with the former.[110] The phrase "any person skilled in the art or science" is not confined to the most eminent scientists, nor the most able experts in that science or art; but it also indicates persons whose skill may stop short of the highest excellence.[111]

It is not necessary that the description should be intelligible to every intelligent man, nor to every skillful mechanic. If it can be understood by those who possess full knowledge of the prior inventions in the same department of art or science, it is full, clear, concise, and exact enough to comply with the statute.[112] In explaining this point of law, Justice BRADLEY, in the first cited decision, used a particularly felicitous illustration. His Honor said: "When an astronomer reports that a comet is to be seen with the telescope, in the constellation of Auriga, in so many degrees of declination, and so many hours and minutes of right ascension, it is all Greek to the unskilled in science; but other astronomers will instantly direct their telescopes to the very point in the heavens where the stranger has made his entrance into our system. They understand the language of their brother scientist. If a mechanical engineer invents an improvement on any of the appendages of a steam-engine, such as the valve-

[109] J. L. Owens Co. *v.* Twin City Separator Co., 168 F. R. 259, 1909.

[110] Los Alamitos Sugar Co. *v.* Carroll, 173 F. R. 280, 1909.

[111] Tannage Patent Co. *v.* Zahn, 66 F. R. 989, 1895.

[112] Loom Co. *v.* Higgins, 105 U. S. 580, 1881; Celluloid Mfg. Co. *v.* Russell, 37 F. R. 679, 1889; Lalance & Grosjean Mfg. Co. *v.* Haberman Mfg. Co., 55 F. R. 296, 1893; Weston Electrical Instrument Co. *v.* Stevens, 119 F. R. 184, 1902.

gear, the condenser, the steam-chest, the walking-beam, the parallel motion, or what not, he is not obliged, in order to make himself understood, to describe the engine, nor the particular appendage to which the improvement refers, nor its mode of connection with the principal machine. These are already familiar to others skilled in that kind of machinery. He may begin at the point where his invention begins, and describe what he has made that is new, and what it replaces of the old."

These observations are particularly applicable to descriptions of machinery; but they also suggest the true principles on which to judge of the sufficiency of descriptions of processes, manufactures, and compositions of matter.[113]

A patent for a process, must not only distinguish its new elements from the old elements with which they are employed, but also must describe the new elements so definitely, as to furnish a clear chart for their practical introduction into the art to which the process pertains.[114] If there is enough in the patent to indicate to those skilled in the art a mechanism whereby the process may be carried out, it is sufficient even though no specific mechanism is described.[115] The patentee is not, of course, confined to the particular apparatus which he describes as a means of carrying out his process.[116] In a case of an article of manufacture, where proportion is important to operativeness, the proper proportions may be indicated in any way that is substantially correct, and need not be stated mathematically.[117] And where proportions must vary with circumstances, such a description is sufficient, if it states the proportions proper under ordinary circum-

[113] Seabury *v.* Am Ende, 152 U. S. 567, 1894.

[114] Cerealine Mfg. Co. *v.* Bates, 101 F. R. 280, 1900.

[115] Expanded Metal Co. *v.* Bradford, 214 U. S. 366, 1909.

[116] Moore Filter Co. *v.* Tonopah-Belmont Development Co., 201 F. R. 532, 1912.

[117] Edison Electric Light Co. *v.*

stances, and points out the direction in which they must be varied when circumstances are changed.[118] In a case of a composition of matter, the description of a patent should state the component parts thereof, and the proportions in which they are to be mixed or combined, and should do this with clearness and precision, and should not leave the public to ascertain any such fact by experiment.[119]

A patent for a design must conform to the same standards[120] but a verbal description is not necessary if the drawing is sufficiently clear.[121] It is held, however, that where there is a sufficient written specification the patentee is entitled to enjoin the making of articles which "contain the dominant features of the design," as specified in the description. In other words, where there is no written description the patentee is limited to the precise article shown in the drawing, but the scope of the claim may be broadened if the dominant features of the design are specified in a written description.[122]

§ 175. An inventor need not explain in his description, or know in point of fact, what laws of nature those are which cause his invention to work;[123] nor is a patent

U. S. Electric Lighting Co., 52 F. R. 309, 1892.

[118] Consolidated Valve Co. *v.* Valve Co., 113 U. S. 177, 1884.

[119] Wood *v.* Underhill, 5 Howard, 1, 1847; Tyler *v.* Boston, 7 Wallace, 327, 1868; Matheson *v.* Campbell, 69 F. R. 603, 1895; Burke Electric Co. *v.* Independent Pneumatic Tool Co., 232 F. R. 145, 1916.

[120] James E. Tompkins Co. *v.* New York Woven Wire Mattress Co., 159 F. R. 133, 1907.

[121] Cheney Bros. *v.* Weinreb & Weinreb, 185 F. R. 531, 1910; National Casket Co. *v.* New York & Brooklyn Casket Co., 185 F. R. 533, 1911; Ashley *v.* Samuel C. Tatum Co., 186 F. R. 339, 1911; Phœnix Knitting Works *v.* Louer Bros., 194 F. R. 700, 1910; Bush & Lane Piano Co. *v.* Becker Bros., 209 F. R. 233, 1913.

Contra, Phœnix Knitting Works *v.* Rich, 194 F. R. 708, 1911.

[122] Ashley *v.* Weeks-Numan Co., 220 F. R. 899, 1915.

[123] St. Louis Stamping Co. *v.* Quinby, 4 Bann. & Ard. 195, 1879; Haffcke *v.* Clark, 46 F. R. 770, 1891; Dixon-Woods Co. *v.* Pfeifer, 55 F. R. 395, 1893; Hemolin Co. *v.* Harway etc.,

void on the ground that the principle of the invention is not fully understood; or if understood by anyone, not understood alike by all,[124] and was not understood correctly by the inventor himself,[125] or that all its advantages and possibilities were not understood by or known to the inventor.[126] Neither is any description insufficient in the eye of the law, on account of any mere errors it may be found to contain, where those errors would at once be detected and their remedies be known, by any person skilled in the art, when making specimens of the invention set forth, or when practicing that invention, if that invention is a process; [127] nor where such errors consist in mistaken statements of immaterial facts; [128] nor where

Mfg. Co., 138 F. R. 54, 1905; Van Epps *v.* United Box Board & Paper Co., 143 F. R. 869, 1906; Commercial Acetylene Co. *v.* Avery Portable Light Co., 166 F. R. 907, 1909; Diamond Rubber Co. *v.* Consolidated Tire Co., 220 U. S. 428, 1911; Toch *v.* Zibell Damp Resisting Paint Co., 233 F. R. 993, 1916.

[124] Knickerbocker Co. *v.* Rogers, 61 F. R. 297, 1894; National Meter Co. *v.* Thomson Meter Co., 106 F. R. 538, 1900.

[125] United States Mitis Co. *v.* Carnegie Steel Co., 89 F. R. 346, 1898; Emerson Co. *v.* Nimocks, 99 F. R. 739, 1900; Cleveland Foundry Co. *v.* Detroit Vapor Stove Co., 131 F. R. 853, 1904; (process) U. S. Mitis Co. *v.* Midvale Steel Co., 135 F. R. 103, 1904; Hemolin Co. *v.* Harway etc., Mfg. Co., 138 F. R. 54, 1905; Malignani *v.* Jasper Marsh, etc., Co., 180 F. R. 442, 1910.

[126] Westmoreland Specialty Co. *v.* Hogan, 167 F. R. 327, 1909; Morgan Engineering Co. *v.* Alliance Mach. Co., 176 F. R. 100, 1909; Mead-Morrison Mfg. Co. *v.* Exeter Machine Works, 225 F. R. 489, 1915; Wayne Mfg. Co. *v.* Coffield Motor Co., 227 F. R. 987, 1915; Kellog Switchboard Co. *v.* Dean Electric Co., 182 F. R. 991, 1910.

See Section 180.

[127] Singer *v.* Walmsley, 1 Fisher, 559, 1860; Kendrick *v.* Emmons, 2 Bann. & Ard. 210, 1875; Matheson *v.* Campbell, 78 F. R. 910, 1897; Brunswick-Balke-Collender Co. *v.* Backus, etc., Co., 153 F. R. 288, 1907.

[128] Maryland Hominy Co. *v.* Dorr, 46 F. R. 776, 1891; Electric Smelting & Aluminum Co. *v.*

such errors relate to the degree of efficiency of the invention;[129] nor where they consist in deficient description of the functions of some parts of a machine.[130] Nor need a description state every use to which the described and claimed invention is applicable, in order to cover every such use.[131] Neither is it necessary in a description in a patent for a process, to set forth all the modes in which that process may be performed, nor all the kinds of apparatus which may be used in performing it, in order to cover that process with the patent. It is enough to describe one particular mode and one particular apparatus by means of which the process may be performed with at least some beneficial result.[132] Nor is a description fatally defective merely because it omits to mention something which contributes only to the degree of benefit, provided the invention will work beneficially without it.[133]

But the omission of anything absolutely material to the utility of the invention described, is a fatal defect in a description,[134] unless that omission would naturally be

Carborundum Co., 102 F. R. 620, 1900.

[129] Michaels *v.* Roessler, 34 F. R. 325, 1888.

[130] McCormick Harvesting Mach. Co. *v.* Aultman, 69 F. R. 378, 1895.

[131] Pike *v.* Potter, 3 Fisher, 55, 1859; Williams Patent Crusher Co. *v.* St. Louis Pulverizer Co., 104 F. R. 799, 1900; Sanitary Fireproofing, etc., Co. *v.* Spricker-hoff, 139 F. R. 801, 1905; Kuhlman Electric Co. *v.* General Electric Co., 147 F. R. 709, 1906; General Electric Co. *v.* Bullock Electric Mfg. Co., 152 F. R. 427, 1907; Warren S. P. Co. *v.* Balke & Knowles S. P. Works, 163 F. R. 263, 1908; Forest City Foundry & Mfg. Co. *v.* Barnard, 176 F. R. 561, 1910; O'Brien-Worthen Co. *v.* Stempel, 209 F. R. 847, 1913; Kennicott Co. *v.* Holt Ice & Cold Storage Co., 230 F. R. 157, 1915.

[132] Tilghman *v.* Proctor, 102 U. S. 728, 1880; Pittsburgh Reduction Co. *v.* Cowles Co., 55 F. R. 316, 1893; Rapid Service Store Co. *v.* Taylor, 43 F. R. 251, 1890.

[133] Sewall *v.* Jones, 91 U. S. 185, 1875.

[134] Carr *v.* Rice, 1 Fisher, 204,

supplied by any person skilled in the art when making the invention, if it be a thing, or when using it, if it be a process. Accordingly, it has been held that where one element of a new combination covered by a patent must have a certain form in order to operate in that combination, and where another form of that element is known to persons skilled in the art, a description is insufficient which merely states that such old element is a part of the combination, without saying or showing which of its known forms is applicable to the case.[135] As was said in an important case of recent date, "A patent is granted for solving a problem, not for stating one. Its description must explain the invention itself, the manner of making it, and the mode of putting it in practice. In the absence of knowledge on these points, the invention is not available to the public without further experiments and further exercise of inventive skill." [136] On the other hand, no excess of description is injurious to the validity of a patent, unless the redundant matter was introduced with fraudulent intention.[137]

§ 176. The claim or claims of a specification are necessarily inserted in order to conform to the statutory requirement that the patentee shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention.[138] A distinct and formal claim is necessary to ascertain the scope of a patented invention,[139] and a patent grants no exclusive right, except to what is thus distinctly claimed.[140] To use

1856; Stirling Co. *v.* Rust Boiler Co., 144 F. R. 849, 1906.

[135] Schneider *v.* Thill, 5 Bann. & Ard. 565, 1880.

[136] Columbia Motor Car Co. *v.* C. A. Duerr & Co., 184 F. R. 893, 1911.

[137] Sewall *v.* Jones, 91 U. S. 186, 1875.

[138] Revised Statutes, Section 4888.

[139] Grant *v.* Walter, 148 U. S. 554, 1893.

[140] McClain *v.* Ortmayer, 141

the words of the Supreme Court, "the claims measure the invention." [141]

A claim covers and secures a process, a machine, a manufacture, a composition of matter, or a design, and never, the function or result of either.[142] A claim may cover the entire process, machine, manufacture, or composition of matter, which is set forth in the description, or it may cover such parts, or such sub-processes, or such combinations, as are new and useful inventions; and the specification may contain a claim for the whole, and other claims for separate parts, and still other claims for separate sub-processes or combinations.[143] And the subject of a claim needs not to be operative alone,[144] for utility is justly ascribed to things which have their use in co-operating with other things to perform a useful work. But in order to be sustained, each claim must be able to withstand the tests of invention, of novelty, and of utility, which are stated in the second, third, and fourth chapters of this book, respectively.

Since all inventions, devices and improvements disclosed by the specification and not covered by a claim

U. S. 424, 1891; Ashton Valve Co. *v.* Muffler Co., 8 U. S. App. 226, 1893; United States Peg Wood Co. *v.* B. F. Sturtevant Co., 122 F. R. 472, 1903.

[141] Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

[142] Corning *v.* Burden, 15 Howard, 252, 1853; O'Reilly *v.* Morse, 15 Howard, 62, 1853; Carver *v.* Hyde, 16 Peters, 513, 1842; Le Roy *v.* Tatham, 14 Howard, 156, 1852.

[143] Railroad Co. *v.* Dubois, 12 Wallace, 47, 1870; National Machine Co. *v.* Thom, 25 F. R. 500, 1885.

[144] Deering *v.* Winona Harvester Works, 155 U. S. 302, 1894; Hancock Inspirator Co. *v.* Jenks, 21 F. R. 915, 1884; Rapid Service Store Co. *v.* Taylor, 43 F. R. 251, 1890; Roberts *v.* Nail Co., 53 F. R. 920, 1892; Holloway *v.* Dow, 54 F. R. 516, 1893; Chambers-Bering-Quinlan Co. *v.* Faries, 75 F. R. 663, 1896.

are dedicated to the public,[145] all claims are required to be definite, so that the public may know what they are prohibited from doing during the existence of the patent, and what they are to have at the end of the term, as a consideration for the grant.[146] The necessary degree of particularity in claims may be reached in various modes. Where the invention is an entire machine, the claim is sufficient if it is clearly co-extensive with the machine; and where the invention is a part of a machine or manufacture, that part must be clearly indicated in the claim which covers it.[147] Claims for combinations of a plurality of the described devices, but less than all of them, should use the word "combination," and should state the devices of which it is composed.[148] But though this degree of obvious certainty is highly desirable in a combination claim, it is not absolutely necessary to the validity of such an one; for a claim may declare that it covers so much of the described mechanism as effects a particular specified result, without specifying those parts themselves. In such a case it is a question of fact to be determined in court, if necessary, which parts those are which effect that result and are therefore covered by the claim.[149] So, also, two or more claims in substance may sometimes be combined in one claim in form.[150] This may be accomplished in different ways, and among others by inserting in the claim the words "with or without" before the name or other designation of one or more

[145] O. H. Jewell Filter Co. *v.* Jackson, 140 F. R. 340, 1905.
See Section 186.

[146] Brooks *v.* Fiske, 15 Howard, 212, 1853; Buffington's Iron Bldg. Co. *v.* Eustis, 65 F. R. 807, 1895.

[147] Seymour *v.* Osborne, 11 Wallace, 516, 1870.

[148] Brown Mfg. Co. *v.* Bradley Mfg. Co., 51 F. R. 226, 1892.

[149] Silsby *v.* Foote, 14 Howard, 218, 1852; Fay *v.* Cordesman, 109 U. S. 420, 1883; Hoe *v.* Knap, 27 F. R. 208, 1886.

[150] Telephone Cases, 126 U. S. 537, 1888.

of the enumerated parts of the process, machine, combination, manufacture, or composition of matter covered by that claim.[151] The claim of the Charles Goodyear rubber patent had this characteristic. It was a claim for vulcanized India rubber, whether with or without other ingredients, chemically altered by the application of heat, substantially as described.[152]

A process and its product, though they may be secured by separate claims in one patent,[153] cannot be covered by one claim.[154] "A new product having definite characteristics by which it may be identified and which distinguish it apart from the process by which it was produced may be properly described by such characteristics and when so claimed and described the claims are not limited to the process." [155] The same court which made the statement above quoted also said: "It is also a well-recognized rule that, although a product has definite characteristics by which it may be identified apart from the process, still if in a claim for the product it is not so described but is set forth in the terms of the process, nothing can be held to infringe the claim which is not made by the process" citing Cochrane *v.* Badische Anilin & Soda Fabrik.[155a]

[151] Tuck *v.* Bramhill, 6 Blatch. 95, 1868.

[152] Rubber Co. *v.* Goodyear, 9 Wallace, 795, 1869.

[153] Kirchberger *v.* American Acetylene Burner Co., 128 F. R. 599, 1904; Sanitas Nut Food Co. *v.* Voight, 139 F. R. 551, 1905; Downes *v.* Teter-Heany Development Co., 150 F. R. 122, 1907; Pressed Prism Plate Glass Co. *v.* Continuous Glass Press Co., 150 F. R. 355, 1907; Asbestos Shingle, etc., Co. *v.* H. W. Johns-Mansville Co., 184 F. R. 620, 1910; Hide-Ite Leather Co. *v.* Fiber Products Co., 226 F. R. 34, 1915.

See Steinmetz *v.* Allen, 192 U. S. 543, 1904, and compare present Patent Office Rule 41 with the previous rule.

[154] Durand *v.* Schulze, 61 F. R. 820, 1894.

[155] Maurer *v.* Dickerson, 113 F. R. 870, 1901; Hide-Ite Leather Co. *v.* Fiber Products Co., 226 F. R. 34, 1915.

[155a] Cochrane *v.* Badische Anilin

It is not easy to deduce the correct rule of law which is discussed in the foregoing paragraph. The leading case in the Supreme Court on the subject appears to be Plummer *v.* Sargent.[155b] The patent in that case contained claims both for a process of bronzing iron and for the bronzed iron itself. The claim for the product was as follows: "What I claim and desire to secure by letters patent is the new manufacture hereinabove described consisting of iron ornamented in imitation of bronze by the application of oil and heat, substantially as described." Because the product claim called for iron ornamented "by the application of oil and heat," no bronzed iron would infringe which was not made by that process even though the product was of the composition theretofore unknown and which possessed all the qualities to give it the character of an invention. The court, however, said: "Although there are two patents, one for a process and the other for a product, there is in effect but one invention; and it may be assumed that the new article of manufacture called Tucker Bronze is a product which results from the use of the process described in the patent and not one which may be produced in any other way so that whatever likeness may appear between the product of the process described in the patent and the article made by the defendants their identity is not established, unless it is shown that they are made by the same process." As is pointed out in Lamb Knit Goods Co. *v.* Lamb Glove Co.[155c] a patent which discloses an invention of a new product is valid, provided it discloses a method of making the product and will be infringed by a similar product

& Soda Fabrik, 111 U. S. 293, 1884.

[155b] Plummer *v.* Sargent, 120 U. S. 442, 1897.

[155c] Lamb Knit Goods Co. *v.* Lamb Glove Co., 120 F. R. 267, 1902.

even though the latter be made by some other method than that described in the patent. It is likewise true as is pointed out in Sanitas Nut Food Co. *v.* Voight,[155d] that a patent which discloses and claims an invention of a process is not invalid because the process results in the production of an old and well-known product. It is therefore not apparent why the case of Plummer *v.* Sargent has been cited on the broad proposition that a patent which contains a claim for a product and a claim for a process of making the product is not infringed by a product which answers the product claim, but which is not made in infringement of the process claimed.[155e] Difficulty in identifying the products should not be permitted to cause to be created a rule of law which prevents a patentee from securing his full rights to his invention of a product.

Nor is any claim limited to any name it employs to designate anything to which it refers, where that name is not accurately representative of the thing which appears, in the description of the patent, to be designated thereby.[156] But where an invention consists of an article, made of a specific material; the claim must specify that material, and will be void if it generalizes, by words which cover

[155d] Sanitas Nut Food Co. *v.* Voight, 139 F. R. 551, 1905.

[155e] See Accumulator Co. *v.* Julien Electric Co., 57 F. R. 605, 1893; Carl L. Jensen Co. *v.* Clay, 59 F. R. 290, 1893; Oval Wood Dish Co. *v.* Dandy Creek, etc., Mfg. Co., 60 F. R. 285, 1894; Palmer Pneumatic Tire Co. *v.* Lozier, 90 F. R. 732, 1898; Chadeloid Chemical Co. *v.* F. W. Thurston Co., 200 F. R. 685, 1915; but see Downes *v.* Teter-Heany Development Co., 150 F. R. 122, 1907, where the court appears to have given great weight to the fact that the product claims ended with the words "substantially as described" and therefore inferred that these words meant that the product described was necessarily the result of the method described and claimed in the patent.

[156] Stetson *v.* Herreshoff Mfg. Co., 113 F. R. 952, 1902.

materials useless for the purpose, as well as the specific material described in the patent.[157]

§ 177. Letters patent may be valid as to one or more claims while being invalid as to one or more other claims in the same specifications.[158] In contemplation of law each claim of a patent is considered as setting forth a complete and independent invention,[159] and so where a patent contains two claims which are alike, except that the narrower one of them calls for an unpatentable addition to what is called for by the other, the narrower claim is void.[160] But two claims which may appear to be alike will, if practicable, be construed to differ rather than agree, because there is a presumption that no applicant will do so useless and inexpedient an act as to repeat a claim.[161]

Letters patent which contain a needless multiplication of nebulous claims, calculated to mislead the public, are void for that reason, if for no other.[162] But a patent is

[157] Consolidated Electric Light Co. *v.* McKeesport Light Co., 159 U. S. 465, 1895.

[158] Russell *v.* Place, 94 U. S. 606, 1876.

[159] Railroad Supply Co. *v.* Hart Steel Co., 222 F. R. 261, 1915; Veneer Machinery Co. *v.* Grand Rapids Chair Co., 227 F. R. 419, 1915; Leeds & Catlin *v.* Victor Talking Machine Co., 213 U. S. 301, 1909; Kennicott Co. *v.* Holt Ice & Cold Storage Co., 230 F. R. 157, 1915.

[160] Featherstone *v.* Cycle Co., 53 F. R. 116, 1892; Packard *v.* Lacing-Stud Co., 70 F. R. 68, 1895; Consolidated Car Heating Co. *v.* American Electric Heating Co., 82 F. R. 994, 1897.

[161] Campbell Printing-Press Co. *v.* Marden, 64 F. R. 784, 1894; National Cash Register Co. *v.* American Cash Register Co., 53 F. R. 370, 1892; Lamson Consolidated Store Service Co. *v.* Hillman, 123 F. R. 419, 1903; Ryder *v.* Schlichter, 126 F. R. 487, 1903; Boyer *v.* Keller Tool Co., 127 F. R. 130, 1904; Bullock Electric Mfg. Co. *v.* Crocker-Wheeler Co., 141 F. R. 101, 1905; Wm. B. Scaife & Sons Co. *v.* Falls City Woolen Mills, 209 F. R. 210, 1913; Automatic Recording Safe Co. *v.* Burns Co., 231 F. R. 985, 1916.

[162] Carlton *v.* Bokee, 17 Wallace, 463, 1873.

not void merely because it contains a plurality of claims, each of which covers the same thing, and covers nothing else, where there is no evidence that the plural claims were made with intention to mislead.[163] In the absence of such evidence, the surplus claims may be dismissed from consideration as redundant.[164]

If all the claims of a particular patent are void, either for want of particularity or for want of invention, novelty, or utility, or for any other reason or reasons, that patent is also void, even though one or more valid claims might have been made and allowed on the basis of the descriptive part of the specification.[165]

And any claim which is broader than the described invention, is void; even where that invention is valuable, and could have supported a valuable claim.[166]

§ 177*a*. Inventions like animals, are divisible into classes; and their classes are divisible into orders; and their orders are divisible into genuses; and their genuses are divisible into species; and their species are divisible into varieties. Every invention belongs to a variety; whether it was the first invention in that variety or not. In either case it belongs to a species; whether or not it was the first representative of that species. In either case it belongs to a genus; whether it was, or was not, the first invention in that genus. In either case it belongs to an order; whether it was the first invention in that order, or was preceded therein, by some other. And in either case it belongs to a class; whether or not it stands at the head of the class to which it belongs.

[163] Tompkins *v.* Gage, 5 Blatch. 270, 1861.

[164] Hillborn *v.* Hale & Kilburn Mfg. Co., 69 F. R. 961, 1895.

[165] Wisner *v.* Grant, 5 Bann. & Ard. 215, 1880.

[166] Edison *v.* American Mutoscope Co., 114 F. R. 934, 1902; State Bank of Chicago *v.* Hillmans, 180 F. R. 732, 1910.

Very few patents are still in force which stand at the heads of their classes, or even at the heads of the orders which they were the first to represent. But some patents are still living at the heads of their genuses; and many are still living at the heads of their species; and very many more at the heads of their varieties. A patent which stands at the head of its genus, must also stand at the head of every species in that genus. Such a patent may properly have a generic claim, and it may also have one specific claim. Logically, it might have a specific claim for each species which it describes; but the Patent Office properly requires a separate application for a separate patent, for each species which the inventor will secure to himself; while allowing him to insert his proper generic claim in whichever of those applications he selects for that honor. So also the Patent Office will properly allow a claim on a variety of an invention, in the same patent with a broader claim for a species, and a still broader claim for a genus; provided that variety belongs to the particular species which is covered by the specific claim.

§ 178. The statutory requirements relevant to particularity in the descriptions and claims of letters patent, are conditions precedent to the authority of the Commissioner of Patents to issue such documents; [167] and if such a document is issued, the description or claims in which do not conform to these requirements, then that document is void.[168] But where the inventions, which are covered by part of the claims of a patent, are sufficiently described, those claims may be valid, though other claims in the same patent are void for want of sufficient description.[169]

[167] Seymour *v.* Osborne, 11 Wallace, 516, 1870.

[168] O'Reilly *v.* Morse, 15 Howard, 62, 1853; Ames *v.* Howard, 1 Sumner, 482, 1833.

[169] Bene *v.* Jeantet, 129 U. S. 683, 1888.

Such invalidity does not depend on the intention of the inventor, but is a legal inference from his failure to give to his description and claims the statutory particularity.[170] It is a question of jurisdiction in the Commissioner of Patents; not a question of fraudulent intent in the delinquent patentee. The Commissioner is authorized to issue letters patent only on adequate specifications. If he issues them on inadequate specifications, their invalidity cannot be removed by showing that the inadequacy arose from ignorance and not from fraud. This point of law is not shaken by the fact that Section 4920 of the Revised Statutes, in providing for special defences to patent suits, under the general issue in pleading, provides that among such defences the defendant may prove "that for the purpose of decciving the public, the description filed by the patentee in the Patent Office was made to contain less than the whole truth relative to the invention or discovery, or more than is necessary to produce the desired effect." The defences provided for in Section 4920 are not all the defences that may be interposed in infringement cases. They are merely the defences that may be interposed under the general issue. The defence of insufficient specification, as well as any other legal defence, may be interposed by a special plea,[171] or under the Equity Rules promulgated in 1912 by special matter in the answer.

§ 179. It is a question of fact for a jury in an action at law, or for a chancellor in an action in equity, to determine whether the specification, including the claim, of a patent conforms to the statutory requirements relevant to particularity.[172] That question is, in both

[170] Grant *v.* Raymond, 6 Peters, 218, 1832.

[171] Reckendorfer *v.* Faber, 92 U. S. 347, 1875.

[172] Battin *v.* Taggert, 17 Howard, 74, 1854.

tribunals, a question of evidence, and not a question of construction.[173]

§ 180. A patent which describes, and separately claims, two or more related inventions, is not void on that account; [174] but if a patent were to be granted for two or more unrelated inventions, it might be held, for that reason, to be invalid,[175] though no patent has ever yet been held void for containing and claiming more than one invention.

Prior to the Supreme Court decision of Steinmetz *v.* Allen,[176] Patent Office Rule 41 provided among other things that claims for a machine could not be combined in a single application either with claims for the product of the machine or with claims for the process carried out by the machine. The Supreme Court, however, in the Steinmetz case held that the Patent Office could not arbitrarily create such a rule, since it was a question of fact in each case as to whether or not the invention of the machine was so related to the invention of the process, or was so independent of it that the two inventions should or should not be combined in one application. The court based its view that related inventions could be combined in one application on its construction of Section 4886 of the Revised Statutes. Rule 41 has since been amended and the provisions above noted removed.

On the other hand, two or more related patents may lawfully be granted for different parts of one extensive machine.[177] In such cases it is proper to describe the

[173] Fisk, Clark & Flagg *v.* Hollander, MacArthur & Mackay, 355, 1883.

[174] Hogg *v.* Emerson, 11 Howard, 587, 1850; Steinmetz *v.* Allen, 192 U. S. 543, 1904.

[175] Wilkins Shoe Button Fastener Co. *v.* Webb, 89 F. R. 989, 1898.

[176] Steinmetz *v.* Allen, 192 U. S. 543, 1904. See Section 183.

[177] Graham *v.* McCormick, 11 F. R. 859, 1880; Graham *v.* Mfg.

whole machine in each of the specifications, and to picture the whole machine in each set of drawings, thus causing the separate letters patent to differ from each other only in their claims.[178] A plurality of patents cannot, however, be granted for different uses of the same invention.[179] Indeed, all the uses of an invention are covered and secured by a single letters patent for that invention.[180]

This principle, however, applies only when the property or function is inherent in the invention or is described or claimed therein, but where such property or function is not inherent in the invention and is not described or claimed, and especially where other properties or functions are described as essential, it is significant proof that the undescribed property is not a part of the invention.[181]

Co., 11 F. R. 138, 1880; Thomson-Houston Electric Co. *v.* Elmira & H. Ry. Co., 71 F. R. 405, 1896.

[178] M'Millin *v.* Rees, 5 Bann. & Ard. 269, 1880; Ide *v.* Trorlicht, Duncker & Renard Carpet Co., 115 F. R. 145, 1902; Anderson *v.* Collins, 122 F. R. 458, 1903; Century Electric Co. *v.* Westinghouse Electric & Mfg. Co., 191 F. R. 350, 1911.

[179] McComb *v.* Brodie, 1 Woods, 153, 1871; Thomson-Houston Electric Co. *v.* Elmira & H. Ry. Co., 71 F. R. 406, 1896.

[180] Roberts *v.* Ryer, 91 U. S. 157, 1875; Western Electric Co. *v.* La Rue, 139 U. S. 606, 1891; Potts *v.* Creager, 155 U. S. 606, 1893; Ligowski Clay-Pigeon Co. *v.* Clay-Bird Co., 34 F. R. 331, 1888; Thompson *v.* Gildersleeve, 34 F. R. 45, 1888; Stegner *v.* Blake, 36 F. R. 183, 1888; Thompson *v.* Donnell Mfg. Co., 40 F. R. 383, 1889; Steiner Extinguisher Co. *v.* Adrian, 52 F. R. 733, 1892; New Departure Bell Co. *v.* Mfg. Co., 64 F. R. 862, 1894; Wright & Colton Wire-Cloth Co. *v.* Wire-Cloth Co., 67 F. R. 792, 1895; National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 709, 1901; Dowagiac Mfg. Co. *v.* Superior Drill Co., 115 F. R. 886, 1902; Jackson Fence Co. *v.* Peerless Wire Fence Co., 228 F. R. 691, 1915 (see Section 175, *ante*); Gear *v.* Fairmount Electric & Mfg. Co., 231 F. R. 728, 1916; Acme Truck & Tool Co. *v.* Meredith, 183 F. R. 124, 1910.

See Section 175.

[181] Electric Storage Battery Co. *v.* Gould Storage Battery Co., 158

§ 180*a*. Only one valid original patent can be granted to an inventor on one invention; and if a plurality of such patents are thus granted, all except the first are void.[182] Where a plurality of similar or approximating original patents have been granted to an inventor, the question of the identity or the non-identity of the inventions may therefore arise; and when such a question arises, it must be determined by the application of the relevant rule of law. The rule for ascertaining whether a reissue patent is for "the same invention" within the meaning of the reissue statute, is not applicable to determining the question of identity between two original patents; because a reissue patent is held to be for "the same invention," within that meaning, where that invention was described in the original patent, and appears therein to have been intended to be secured thereby, whether it was thus secured or not;[183] and because a man does not have two original patents for the same invention, unless each of those patents purports to secure to him a monopoly of that invention. And no monopoly of any invention is secured to any patentee, by any patent, otherwise than by a claim in that patent, which is co-extensive with that invention.[184] Therefore the rule for ascertaining the iden-

F. R. 610, 1907; O'Brien-Worthen Co. *v.* Stempel, 209 F. R. 847, 1913.

See Section 364.

[182] Suffolk Co. *v.* Hayden, 3 Wallace, 315, 1865; Miller *v.* Eagle Co., 151 U. S. 197, 1894.

[183] Parker & Whipple Co. *v.* Yale Clock Co., 123 U. S. 99, 1887; Freeman *v.* Asmus, 145 U. S. 240, 1892; Corbin Lock Co. *v.* Eagle Lock Co., 150 U. S. 42, 1893.

[184] M'Millin *v.* Rees, 5 Bann. & Ard. 269, 1880; Delaware Coal & Ice Co. *v.* Packard, 5 Bann. & Ard. 296, 1880; Blades *v.* Rand, 27 F. R. 97, 1886; Roemer *v.* Peddie, 27 F. R. 702, 1886; Allison *v.* Brooklyn Bridge, 29 F. R. 517, 1886; McBride *v.* Plow Co., 44 F. R. 77, 1890; Maddock *v.* Coxon, 45 F. R. 579, 1891.

tity or the non-identity of the invention or inventions of a plurality of resembling original patents granted to one inventor, is the same as the rule for ascertaining the identity or non-identity of the invention or inventions of a plurality of resembling original patents granted to a plurality of inventors. And that rule consists in comparing the claims of the patents in question, and finding identity or non-identity of invention, according as those claims are found to be co-extensive or not co-extensive.[185]

Claims are co-extensive which cover the same combination, of the same number, of the same parts, with the same features; though the functions which are mentioned in the claims are not co-extensive.[186] That was held to be the character of the respective claims of two patents to the same inventor, in the case of Miller *v.* Eagle Co.;[187] and therefore the second of those patents was held to have been granted for the same invention as the first, and to be void. But two claims are not co-extensive, which specify different combinations of parts of a process, machine, or manufacture, even where some of those parts

[185] Gold & Silver Ore Co. *v.* Disintegrating Ore Co., 6 Blatch. 311, 1869; Morris *v.* Kempshall Mfg. Co., 20 F. R. 121, 1884; Pentlarge *v.* New York Bushing Co., 20 F. R. 314, 1884; Nathan Mfg. Co. *v.* Craig, 49 F. R. 370, 1892; Dederick *v.* Fox, 56 F. R. 718, 1893; Stonemetz Mach. Co. *v.* Brown Mach. Co., 57 F. R. 605, 1893; Ryan *v.* Newark Spring Mattress Co., 96 F. R. 103, 1899; Tesla Electric Co. *v.* Scott, 97 F. R. 598, 1899.

[186] Miller *v.* Eagle Co., 151 U. S. 189, 1894; Thomson-Houston Electric Co. *v.* Hoosick Ry. Co., 82 F. R. 466, 1897; Thomson-Houston Electric Co. *v.* Union Ry. Co., 86 F. R. 636, 1898; Thomson-Houston Electric Co. *v.* Jeffrey Mfg. Co., 101 F. R. 121, 1900.

[187] Thomson-Houston Electric Co. *v.* Elmira & H. Ry. Co., 71 F. R. 406, 1896; Thomson-Houston Electric Co. *v.* Ohio Brass Co., 80 F. R. 728, 1897; Western Electric Co. *v.* Home Telephone Co., 85 F. R. 657, 1898.

are in each of the combinations;[188] because the claim which specifies fewest of those parts, may be infringed by what will not infringe any claim specifying more of those parts.[189] That was held to be the character of the respective claims of two patents to the same inventor, in the case of Suffolk Co. *v.* Hayden; and therefore the second of those patents was held to have been granted for another invention than the first, and to be valid. And two claims are not co-extensive, where one of them specifies all the features of any or all of the parts of its subject, while the other omits one of those features;[190] because the latter may be infringed by processes or mechanisms which lack that feature, while the former cannot.[191] Of course a later application which specifies

[188] Suffolk Co. *v.* Hayden, 3 Wallace, 315, 1865; Wheeler *v.* McCormick, 11 Blatch. 334, 1873; Graham *v.* McCormick, 5 Bann. & Ard. 244, 1880; Graham *v.* Crawford Mfg. Co., 11 F. R. 138, 1880; National Mach. Co. *v.* Wheeler & Wilson Mfg. Co., 72 F. R. 199, 1896; Allington & Curtis Mfg. Co. *v.* Glor, 83 F. R. 1014, 1897; Allington & Curtis Mfg. Co. *v.* Globe Co., 89 F. R. 865, 1898; Palmer *v.* John E. Brown Mfg. Co., 92 F. R. 929, 1899; Ryan *v.* Newark Spring Mattress Co., 96 F. R. 103, 1899; Dayton Fan & Motor Co. *v.* Westinghouse Electric & Mfg. Co., 118 F. R. 563, 1902.

[189] Vance *v.* Campbell, 1 Black, 430, 1861; Eames *v.* Godfrey, 1 Wallace, 78, 1863; Case *v.* Brown, 2 Wallace, 320, 1864; Dunbar *v.* Myers, 94 U. S. 187, 1876; Fuller *v.* Yentzer, 94 U. S. 297, 1876; Fay *v.* Cordesman, 109 U. S. 420, 1883; Rowell *v.* Lindsay, 113 U. S. 102, 1884; Sargent *v.* Lock Co., 114 U. S. 86, 1884; Shepard *v.* Carrigan, 116 U. S. 597, 1885; Yale Lock Co. *v.* Sargent, 117 U. S. 378, 1885; Derby *v.* Thompson, 146 U. S. 482, 1892; Weatherhead *v.* Coupe, 147 U. S. 335, 1893; Dobson *v.* Cubley, 149 U. S. 120, 1893.

[190] Ryan *v.* Newark Spring Mattress Co., 96 F. R. 103, 1899.

[191] Prouty *v.* Ruggles, 16 Peters, 341, 1842; Sharp *v.* Reissner, 119 U. S. 636, 1886; McClain *v.* Ortmayer, 141 U. S. 425, 1891; Wright *v.* Yuengling, 155 U. S. 52, 1894; Black Diamond Coal Co. *v.* Excelsior Co., 156 U. S. 617, 1895.

broad claims which cover the specific invention of an earlier application is void to the extent of the broad claims.[192]

Where a plurality of approximating original patents have been granted to an inventor; and where the question of identity of subject has been decided in the negative, or must evidently be so decided; the question may arise whether the ascertained difference between the two subjects is a patentable difference.[193] In investigating that question, the patent which was applied for last, even if granted first, will be treated as the junior patent; since the dates of the applications, and not the dates of the patents, control in determining the legal effect to be given to two patents issued at different dates, to the same inventor, and the order in which they are to be considered.[194]

§ 181. To construe letters patent, is to determine precisely what inventions they cover and secure. Nothing described in letters patent, is secured thereby, unless it is covered by a claim,[195] and no element not mentioned in a claim can be read into it even though the element appears in the specification.[196] And a claim which is clearly

[192] Otis Elevator Co. *v.* Portland Co., 127 F. R. 557.

[193] Reynolds *v.* Standard Paint Co., 68 F. R. 487, 1895; Russell *v.* Kern, 72 O. G. 590, 1895.

[194] Barbed Wire Patent, 143 U. S. 281, 1892.

[195] Railroad Co. *v.* Mellon, 104 U. S. 118, 1881; M'Millin *v.* Rees, 5 Bann. & Ard. 269, 1880; Delaware Coal & Ice Co. *v.* Packard, 5 Bann. & Ard. 296, 1880; Blades *v.* Rand, 27 F. R. 97, 1886; Roemer *v.* Peddie, 27 F. R. 702, 1886; Allison *v.* Brooklyn Bridge, 29 F. R. 517, 1886; McBride *v.* Plow Co., 44 F. R. 77, 1890; Maddock *v.* Coxon, 45 F. R. 579, 1891; Thomson-Houston Electric Co. *v.* Elmira & H. Ry. Co., 71 F. R. 404, 1896; Monroe *v.* McGreer, 81 F. R. 956, 1897.

[196] Duncan *v.* Cincinnati Butchers' Supply Co., 171 F. R. 656, 1909.

narrower than the invention which it was designed to cover, cannot be broadened by construction to correspond with that invention.[197] Nor can a claim, which is broader than the state of the art will allow to the invention described, be narrowed by a construction out of harmony with its language.[198] A newly discovered method of use for a machine cannot be availed of to affect the construction of a claim when the patent on its face gives no indication of such method.[199] The construction of letters patent depends therefore upon the construction of their respective claims;[200] and the established rules by means of which claims are properly construed may constitute the next subject of discussion.

§ 182. The phrase "substantially as described," or its equivalent, when such a phrase occurs in a claim, throws the investigator back to the description for means of construction;[201] and that phrase is always implied in claims wherein it is not expressed.[202] The words "substantially

[197] Smith *v.* Macbeth, 67 F. R. 140, 1895; New Home Sewing Machine Co. *v.* Singer Mfg. Co., 68 F. R. 226, 1895; United States Glass Co. *v.* Atlas Glass Co., 88 F. R. 500, 1898; Computing Scale Co. v. Keystone Store-Service Co., 88 F. R. 791, 1898; Hardison *v.* Brinkman, 156 F. R. 962, 1907.

[198] Edison *v.* American Mutoscope Co., 114 F. R. 934, 1902.

[199] U. S. Peg-Wood Co. *v.* B. F. Sturtevant Co., 125 F. R. 378, 1903.

[200] Maddock *v.* Coxon, 45 F. R. 579, 1891.

[201] Seymour *v.* Osborne, 11 Wallace, 516, 1870; Corn-Planter Patent, 23 Wallace, 181, 1874; Telephone Cases, 126 U. S. 537, 1887; Consolidated Roller Mill Co. *v.* Walker, 138 U. S. 133, 1891; Westinghouse *v.* Boyden Power Brake Co., 170 U. S. 558, 1898; U. S. Consolidated Seeded Raisin Co. *v.* Selma Fruit Co., 195 F. R. 264, 1912.

[202] Matthews *v.* Schoneberger, 4 F. R. 635, 1880; Westinghouse *v.* Air Brake Co., 2 Bann. & Ard. 57, 1875; Olds *v.* Brown, 41 F. R. 704, 1890; Foos Mfg. Co. *v.* Thresher Co., 44 F. R. 599, 1891; Bundy Mfg. Co. *v.* Columbian Co., 59 F. R. 294, 1894; O. H. Jewell Filter Co. *v.* Jackson, 140 F. R.

as specified" mean substantially as specified in regard to the particular matter which is the subject of the claim; [203] and the same rule applies with the same force to the words "substantially as described." [204] But neither

340, 1905; National Tube Co. *v.* Mark, 216 F. R. 507, 1914.

Some courts have, contrary to the statement in the text, given a special significance to this phrase to the extent of introducing a qualification into an element of a claim, resulting in so narrowing the claim that the claim is saved from invalidity. Sanders *v.* Hancock, 128 F. R. 424, 1904. Other courts have even gone to the extent of reading into a claim a complete new element if necessary to make the claim operative. Wellman *v.* Midland Steel Co., 106 F. R. 226, 1901; McCaslin *v.* Link Belt Mach. Co., 139 F. R. 393, 1905. In American Can Co. *v.* Hickmott Asparagus Co., 142 F. R. 141, 1905, it is stated that these words "refer to the whole claim and impart nothing into it not already there, either to narrow it, so as to escape anticipation or to broaden it, so as to establish infringement." But the Supreme Court has said in Singer Mfg. Co. *v.* Cramer, 192 U. S. 265, in regard to the words "substantially as specified" as late as the year nineteen hundred and four:

"And this view is supported by the claim in question. It contains words of limitation. It is recited therein that the combination is to be 'substantially as specified,' that is, as described in the specification and shown in the drawings." And again:

"To prevent a broadening of the scope of the invention beyond its fair import, in the light of the circumstances surrounding the issuance of the patent, the words of limitation contained in the claim must be given due effect, and, giving them such effect, the statement in the first claim of the elements entering into the combination must be construed to refer to elements in combination having substantially the form and construction substantially as described in the specification and shown in the drawing."

[203] Lake Shore R. R. Co. *v.* Car Brake Shoe Co., 110 U. S. 235, 1883; Page Fence Co. *v.* Land, 49 F. R. 943, 1891; Edison Electric Light Co. *v.* U. S. Electric Lighting Co., 52 F. R. 309, 1892; McKay & Copeland Lasting Machine Co. *v.* Claflin, 58 F. R. 354, 1893; Reece Button-Hole Mach. Co. *v.* Globe Mach. Co., 61 F. R. 961, 1894; Diamond Drill & Mach. Co. *v.* Kelly Bros., 120 F. R. 293, 1903.

[204] Paul Boynton Co. *v.* Morris

of those phrases will import into a claim any unessential feature of the subject thereof; [205] nor even a detail, which was said to be best in the specification, but was afterward found to be useless.[206] The implication of such a phrase, where it is not expressed, follows from the rule that while descriptions are considered in this connection only for the purpose of construing claims,[207] a claim should always be construed in the light of the description; [208] and the certainty of that implication indicates the propriety of omitting, for the sake of brevity, all such phrases from claims. An uncommon word in a claim is to be construed in the light of the description, rather than in the light of the dictionary; [209] because the patentee presumably

Chute Co., 87 F. R. 227, 1898; Carnegie Steel Co. *v.* Brislin, 124 F. R. 213, 1903; Lowrie *v.* Meldrum Co., 124 F. R. 761, 1903; Brill *v.* North Jersey St. Ry. Co., 124 F. R. 778, 1903; General Electric Co. *v.* International Specialty Co., 126 F. R. 755, 1903; Superior Hay Stacker Mfg. Co. *v.* Dain Mfg. Co., 208 F. R. 549, 1913; O. H. Jewell Filter Co. *v.* Jackson, 140 F. R. 340, 1905.

[205] Campbell Printing-Press Co. *v.* Marden, 64 F. R. 786, 1894; Temple Pump Co. *v.* Mfg. Co., 30 F. R. 442, 1887; Edison Electric Light Co. *v.* U. S. Electric Lighting Co., 52 F. R. 309, 1892; Pacific Cable Ry. Co. *v.* Butte City Ry. Co., 55 F. R. 763, 1893.

[206] American Dunlop Tire Co. *v.* Erie Rubber Co., 66 F. R. 558, 1895.

[207] Pitts *v.* Wemple, 1 Bissell, 87, 1855.

[208] Smith *v.* Dental Vulcanite Co., 93 U. S. 493, 1876; Howe Machine Co. *v.* National Needle Co., 134 U. S. 395, 1890; Pacific Cable Railway Co. *v.* Butte City Ry. Co., 58 F. R. 423, 1893; Mossberg *v.* Nutter, 135 F. R. 95, 1905. Robins Conveying Belt Co. *v.* Am. Road Mach. Co., 145 F. R. 923, 1906; 1900 Washer Co. *v.* Cramer, 169 F. R. 629, 1909; Fowler & Wolfe Mfg. Co. *v.* National Radiator Co., 172 F. R. 661, 1909; Houser *v.* Starr, 203 F. R. 264, 1913; Diamond Patent Co. *v.* S. E. Carr Co., 217 F. R. 400, 1914; O. H. Jewell Filter Co. *v.* Jackson, 140 F. R. 340, 1905.

[209] Standard Paint Co. *v.* Bird, 65 F. R. 510, 1894; Blair *v.* Jeannetter-McKee Glass Works, 161 F. R. 355, 1908.

knew the description, and may not have known the dictionary; and because the reader of a patent may reasonably be expected to consult the description, before he consults the dictionary, when engaged in trying to learn the meaning of one of its claims. The claims whenever possible are to be construed so as to cover the real invention as found in the specification and drawings, and this is particularly so in the case of a meritorious invention.[210]

The phrase "for the purpose set forth" is never implied in a claim, because an inventor is entitled to the exclusive use of his invention for all purposes, whether he sets them all forth in his specification or not.[211] And such a phrase ought never to be expressed in a claim, because it cannot impart validity to a claim otherwise void,[212] and because it may enable persons to avoid infringement, who would otherwise infringe.[213]

The phrase "in mechanism" is used in many claims, with a purpose to limit the claim in which it is used, to

[210] See Sections 185, 186. Mossberg *v.* Nutter, 135 F. R. 95, 1905; Stirling Co. *v.* Standard Snuff Co., 137 F. R. 94, 1905; Columbia Wire Co. *v.* Kokomo Steel & Wire Co., 143 F. R. 116, 1905; Maunula *v.* Sunell, 155 F. R. 535, 1907; O. H. Jewel Filter Co. *v.* Jackson, 140 F. R. 340, 1905; Electric Candy Machine Co. *v.* Morris, 156 F. R. 972, 1905; Bossert Electric Construction Co. *v.* Pratt Chuck Co., 179 F. R. 385, 1910; Malignani *v.* Jasper Marsh, etc., Co., 180 F. R. 442, 1910; Kryptok Co. *v.* Stead Lens Co., 207 F. R. 85, 1913; Thacher *v.* Transit Const. Co., 234 F. R. 640, 1916.

[211] Roberts *v.* Ryer, 91 U. S. 157, 1875; Muller *v.* Lodge & Davis Mach. Tool Co., 77 F. R. 627, 1896; National Hollow Brake Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 709, 1901; Dowagiac Mfg. Co. *v.* Superior Drill Co., 115 F. R. 886, 1902.

See Sections 175 and 180.

[212] Crescent Brewing Co. *v.* Gotfried, 127 U. S. 168, 1888.

[213] Keystone Bridge Co. *v.* Iron Co., 95 U. S. 278, 1877.

the subject of that claim where that subject is employed as a part of a particular mechanism. Such a limitation is effective to exclude later employment of the subject of the claim in other mechanism, and thus to negative infringement; but such a limitation is not effective to exclude earlier employment of the subject of the claim in other mechanism, and thus to avert negation of novelty.[214] Novelty depends on character, and not on environment; but infringement is made to depend on environment by a patentee himself, where he limits his claim to the employment of his invention as part of a particular mechanism.

The drawings attached to letters patent may be referred to for explanation of anything which the description leaves obscure,[215] but not to supply a total omission of description,[216] or to contradict any plain statement therein.[217]

And neither drawings nor descriptions can enlarge claims.[218] Claims may be narrowed by limitations in the description,[219] and also by importation by construction of described elements which are necessary to invention

[214] Frederick R. Stearns & Co. *v.* Russell, 85 F. R. 224, 1898.

[215] Hogg *v.* Emerson, 11 Howard, 587, 1850.

[216] Gunn *v.* Savage, 30 F. R. 369, 1887; Wilkin *v.* Covel, 46 F. R. 926, 1891; Windle *v.* Parks, etc., Mach. Co., 134 F. R. 381, 1904.

[217] Elgin Butter Tub Co. *v.* Creamery Package Mfg. Co., 80 F. R. 294, 1897.

[218] Railroad Co. *v.* Mellon, 104 U. S. 112, 1881; White *v.* Dunbar, 119 U. S. 51, 1886; Howe Machine Co. *v.* National Needle Co., 134 U. S. 394, 1890; McClain *v.* Ortmayer, 141 U. S. 419, 1891; Cincinnati Ry. Supply Co. *v.* Am. Hoist, etc., Co., 143 F. R. 322, 1905; National Enameling & Stamping Co. *v.* New England Enameling Co., 151 F. R. 19, 1906.

[219] Sargent *v.* Lock Co., 114 U. S. 86, 1884; Crawford *v.* Heysinger, 123 U. S. 606, 1887; McClain *v.* Ortmayer, 141 U. S. 419, 1891.

or novelty as well as operativeness;[220] or are necessary to operativeness alone;[221] but not such as are necessary only to invention or novelty.[222]

§ 182*a*. Reference letters or numerals, when used in a claim to indicate, or help indicate, a part or combination covered thereby, do not limit that claim to the specific mechanism shown in the patent; unless the claim must be thus limited by the prior state of the art.[223] But where the novelty of a part or combination, shown in the drawings of a patent, resides entirely in all its particular characteristics, and where that part or combination is specified in a claim by reference letters or numerals, that claim is limited to a part or com ·nation having those particular characteristics; for if not thus restricted, the claim would be void for want of novelty.[224] But the same rule applies, in an otherwise similar case, for the same reason, where the part or combination, covered by a claim, is indicated therein in some other way than by reference letters or numerals. A rule which would give, to a reference letter

[220] Hartshorn *v.* Barrel Co., 119 U. S. 679, 1886; Consolidated Roller-Mill Co. *v.* Walker, 138 U. S. 132, 1891.

[221] Thomson-Houston Electric Co. *v.* Union Ry. Co., 86 F. R. 637, 1898; Canda *v.* Michigan Malleable Iron Co., 124 F. R. 486, 1903.

[222] McCarty *v.* Lehigh Valley Railroad Co., 160 U. S. 116, 1895; Metallic Extraction Co. *v.* Brown, 110 F. R. 665, 1901.

[223] Campbell Printing-Press Co. *v.* Marden, 64 F. R. 785, 1894; McCormick Harvesting Mach. Co. *v.* Aultman & Co., 69 F. R. 393, 1895; Muller *v.* Lodge & Davis Mach. Tool Co., 77 F. R. 629, 1896; Bonnette Arc Lawn Sprinkler Co. *v.* Koehler, 82 F. R. 431, 1897; Ross-Moyer Mfg. Co. *v.* Randall, 104 F. R. 359, 1900; Electric Candy Machine Co. *v.* Morris, 156 F. R. 972, 1905; Brunswick-Balke-Collender Co. *v.* Rosatto, 159 F. R. 729, 1908; Curry *v.* Union Electric Welding Co., 230 F. R. 422, 1916.

[224] Knapp *v.* Morss, 150 U. S. 228, 1893; Lehigh Valley Railroad Co. *v.* Kearney, 158 U. S. 469, 1895; Schaum *v.* Riehl, 124 F. R. 320, 1903.

or numeral in a claim, a more narrowing effect than is called for by the prior state of the art, would be an artificial rule of interpretation; but the object of the patent law is to secure to inventors what they have invented, and that object is not to be defeated by the application of any such rule.[225]

The foregoing principles, however, should not be confused with the rule that every part specifically referred to by a letter is deemed material according to the well known doctrine, and where for instance an element is described as a "vessell A, A,′ C, C,′" the vessel must possess the characteristics A, A′ and C, C,′ or their equivalents.[226]

§ 183. Claims which are functional in form; that is to say, claims which literally purport to cover a result rather than a process or a thing, are properly construed to cover only the process or the thing which produces that result, for otherwise such claims would be void.[227] And a claim which literally purports to cover a process performed by machinery, is properly construed to cover the machinery itself, and not any process performed thereby.[228] It has, however, been held that if a process claim be combined with a claim for a machine the process must be

[225] Topliff *v.* Topliff, 145 U. S. 171, 1892.

[226] Empire Cream Separator Co. *v.* Electric Candy Machine Co., 166 F. R. 764, 1909.

[227] Fuller *v.* Yentzer, 94 U. S. 288, 1876; Westinghouse *v.* Boyden Power Brake Co., 170 U. S. 557, 1898; Parham *v.* Machine Co., 4 Fisher, 468, 1871; Hitchcock *v.* Tremaine, 4 Fisher, 508, 1871; Coes *v.* Collins Co., 9 F. R. 905, 1882; Henderson *v.* Stove Co., 2 Bann. & Ard. 608, 1877; Palmer *v.* Gatling Gun Co., 8 F. R. 513, 1881; Columbus Watch Co. *v.* Robbins, 64 F. R. 395, 1894; Continental Automobile Co. *v.* A. G. Spalding & Bros., 177 F. R. 693, 1910.

[228] Smith & Egge Mfg. Co. *v.* Bridgeport Chain Co., 46 F. R. 395, 1891.

capable of being carried out by other means than the machine of the patent and such means must be known, otherwise the process claim will be regarded as a claim for the function of the machine and hence invalid.[229] Where a claim ascribes a function, to any of the things which it specifies, that ascription is a limitation of that claim.[230] And where a claim defines its subject by reference to the character which results from making it by a particular process, that claim is limited to the article as thus produced.[231]

So also a claim for an article of manufacture, which designates its distinguishing thing by naming the material of which it is made, but which uses a generic name for that purpose; will be limited by construction, to the specific material specified in the description.[232]

§ 184. The prior state of the art, to which an invention belongs, must be considered in construing any claim for that invention,[233] although the art may have been advanced to that stage, by a prior invention of the same inventor.[234] The leading cases on this subject are McCor-

[229] Am. Lava Co. *v.* Steward, 155 F. R. 731, 1907.
See Section 180.

[230] Masseth *v.* Larkin, 111 F. R. 409, 1901.

[231] Expanded Metal Co. *v.* Board of Education, 103 F. R. 286, 1900.

[232] Consolidated Electric Lighting Co. *v.* McKeesport Light Co., 159 U. S. 465, 1895; American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 70 F. R. 989, 1895.

[233] Carlton *v.* Bokee, 17 Wallace, 463, 1873; Washing-Machine Co. *v.* Tool Co., 20 Wallace, 342, 1873; Florsheim *v.* Schilling, 137 U. S. 71, 1890; The Roller Mill Patent, 156 U. S. 269, 1895; Dederick *v.* Seigmund, 51 F. R. 235, 1892; Brush Electric Co. *v.* Electric Imp. Co., 52 F. R. 972, 1892; Boston Lasting Mach. Co. *v.* Woodward, 53 F. R. 481, 1893; Stirrat *v.* Excelsior Mfg. Co., 61 F. R. 981, 1894; Simplex Railway Appliance Co. *v.* Wands, 115 F. R. 521, 1902.

[234] Celluloid Mfg. Co. *v.* Cellonite Mfg. Co., 42 F. R. 906, 1890.

mick *v.* Talcott,[235] and Railway Co. *v.* Sayles,[236] and Morley Machine Co. *v.* Lancaster,[237] and Kokomo Fence Machine Co. *v.* Kitselman.[238]

The doctrine of the McCormick case is as follows: The original inventor of a machine will have a right to treat as infringers all who make machines operating on the same principle, and performing the same functions, by analogous means, or equivalent combinations; even though the infringing machine be an improvement on the original, and patentable as such. But if the invention claimed, be itself but an improvement on a known machine, by a mere change of form or combination of parts, the patentee 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 improvement cannot invoke the doctrine of equivalents to suppress any other improvement which is not a mere colorable invasion of the first.

The doctrine of the Sayles case is as follows: If one inventor, in a particular art, precedes all the rest, and strikes out something which underlies all that they produce, he subjects them to tribute. But if the advance toward the thing desired is gradual, so that no one can claim the complete whole, then each inventor is entitled to the specific form of device which he produced, and every other inventor is entitled to his own specific form, so long as it differs from those of his competitors and does not include theirs.

The doctrine of the Morley case is as follows: Where

[235] McCormick *v.* Talcott, 20 Howard, 402, 1857.

[236] Railway Co. *v.* Sayles, 97 U. S. 554, 1878.

[237] Morley Machine Co. *v.* Lancaster, 129 U. S. 273, 1889.

[238] Kokomo Fence Machine Co. *v.* Kitselman, 189 U. S. 8, 1903.

an invention is primary, any subsequent improvement which employs substantially the same means, to accomplish the same result, is within the scope of a proper patent on the primary invention, although the subsequent contrivance may contain valuable improvements; but secondary patents must be more narrowly construed than primary patents.

The doctrine of the Kokomo case is as follows: A patent which is the first to give to the world, an invention for doing a particular part of the world's work, is a primary patent, and is entitled to have a broad construction; but a patent which is not thus primary, is limited to the identical means, and mode of operation which it describes.

The meaning of these four cases seems to be that every inventor is entitled to claim whatever he was the first to invent. If A. B. is the first to invent mechanism to perform a particular work, and if his mechanism is substantially incorporated into subsequent machines which do that work, then A. B. is entitled to such a construction of his patent as will be infringed by those later machines; but if C. D. is a mere improver on A. B.'s machine, C. D. is not entitled to such a construction of his patent, as will cover the machines of still later inventors, who have improved on A. B.'s machine in a substantially different manner. It follows from these doctrines that C. D.'s patent must be construed in the light of A. B.'s machine, and indeed of every other similar and older structure; which is the same thing as saying that every patent must be construed in the light of the state of the art, at the time the invention it covers was produced.

The state of a particular art, at the time of a particular invention, includes whatever inventions, belonging to that art, had been already invented and used in the United States, or patented, or described in any printed publica-

tion, in any country.[239] And an invention is patented in the eye of this law, where it is fully shown in the drawings of a patent, though not described in the specification.[240] Patents take rank in an art in the order of their numbers;[241] except where that order is different from the order of the dates upon which they were applied for, in which case they take rank in the order of those dates.[242]

§ 184*a*. The prior state of other arts, may also be considered in construing a claim; because that construction may depend on the area of the territory which was open to the claimant to cover; and because that territory may have been reduced by inventions in other arts, as well as in the art to which the claimed invention belongs.[243] But an invention which was not designed by its maker, nor actually used, nor apparently adapted to perform the function of the claimed invention, but which was used in a remote art, under radically different conditions, to per-

[239] Section 43 of this book.

[240] Wright *v.* Yuengling, 155 U. S. 53, 1894.

[241] Underwood *v.* Gerber, 149 U. S. 224, 1893; Writing Mach. Co. *v.* Elliott & Hatch Co., 106 F. R. 508, 1900.

[242] Barbed Wire Patent, 143 U. S. 281, 1892.

[243] Crescent Brewing Co. *v.* Gottfried, 128 U. S. 169, 1888; Peters *v.* Active Mfg. Co., 129 U. S. 537, 1889; Peters *v.* Hanson, 129 U. S. 541, 1889; Aron *v.* Manhattan Railway Co., 132 U. S. 85, 1889; St. Germain *v.* Brunswick, 135 U. S. 231, 1890; Gates Iron Works *v.* Fraser, 153 U. S. 347, 1894; Steiner Fire Extinguisher Co. *v.* Adrian, 52 F. R. 731, 1391, and 59 F. R. 133, 1893; Forgie *v.* Oil Well Supply Co., 57 F. R. 747, 1893; Schreiber & Sons *v.* Grim, 65 F. R. 221, 1895, and 72 F. R. 671, 1896; Frederick R. Stearns & Co. *v.* Russell, 85 F. R. 226, 1898; Solvay Process Co. *v.* Michigan Alkali Co., 90 F. R. 818, 1898; Thomson-Houston Electric Co. *v.* Rahway Electric Co., 95 F. R. 660, 1899; Indiana Novelty Mfg. Co. *v.* Crocker Chair Co., 103 F. R. 496, 1900; Farrell *v.* Boston, etc., Silver Mining Co., 121 F. R. 847, 1903.

form another function, does not limit the scope of the invention as claimed.[244]

§ 185. "While it is undoubtedly true that a patentee may so restrict his claim as to cover less than what he invented, or may limit it to one particular form of a machine, excluding all other forms, though they also embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise."[245] "Patents for inventions are to receive a liberal construction, and under the fair application of the rule, *ut res magis valeat quam pereat*, are, if practicable, to be so interpreted as to uphold and not to destroy the right of the inventor."[246] "A patent should be construed in a liberal spirit to sustain the just claims of the inventor. This principle is not to be carried so far as to exclude what is in it, or to interpolate anything which it does not contain. But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius, and his labors."[247] "The court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language which he has employed."[248] "In a case of doubt, where the claim is fairly susceptible of two constructions, that one will be adopted, which will preserve to the patentee his actual invention."[249] "The object of the patent law is to secure

[244] National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 702, 1901; Electric Candy Machine Co. *v.* Morris, 156 F. R. 972, 1905.

[245] Winans *v.* Denmead, 15 Howard, 330, 1853.

[246] Turrill *v.* Railroad Co., 1 Wallace, 491, 1863.

[247] Rubber Co. *v.* Goodyear, 9 Wallace, 788, 1869.

[248] Klein *v.* Russell, 19 Wallace, 433, 1873.

[249] McClain *v.* Ortmayer, 141 U. S. 425, 1891.

to inventors, a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."[250]

These are the declarations of the Supreme Court relevant to the proper liberality to be observed in construing patents. That liberality as often shows itself in a narrow construction as in a broad one; for narrow construction may be as necessary to establish the validity of a patent, as a broad construction is to lay the foundation for proof of its infringement.[251] Therefore when it becomes necessary to construe a claim narrowly, in order that its novelty may not be negatived by the prior art, or its validity otherwise overthrown, courts will give such a narrow construction, if they can do so consistently with the language of the claim and of the description.[252] On the other hand, a claim will not be narrowed by importing into it, by construction, any dispensable element, in order to enable an infringer to escape the consequences of his infringement.[253]

§ 185*a*. It has been held in several circuits that when no practical use has been made of the patent the claims will be narrowly construed, the reason for so holding

[250] Topliff *v.* Topliff, 145 U. S. 171, 1892.

[251] McEwan Bros. Co. *v.* McEwan, 91 F. R. 790, 1899.

[252] Klein *v.* Russell, 19 Wallace, 433, 1873; Jones *v.* Barker, 11 F. R. 600, 1882; Stevenson *v.* Magowan, 31 F. R. 826, 1887; Consolidated Roller-Mill Co. *v.* Coombs, 39 F. R. 30, 1889; Steam Gauge and Lantern Co. *v.* Williams, 50 F. R. 931, 1892; Van Ness *v.* Layne, 213 F. R. 804, 1914; Fowler & Wolfe Mfg. Co. *v.* M'Crum-Howell Co., 215 F. R. 905, 1914.

[253] Lamson Cash Reg. Co. *v.* Keplinger, 45 F. R. 249, 1890.

But see Crown Cork & Seal Co. *v.* Sterling Cork & Seal Co., 217 F. R. 381, 1914.

being that in such a case the patent lacks the support that comes from public acquiescence.[254] And as a corollary to this proposition it is held that where the invention is a practical success and constitutes a distinct advance in the art the claims are entitled to a liberal construction.[255]

Nor will claims be narrowed where the proceedings in the Patent Office clearly show that the inventor intended to claim and the Patent Office intended to grant the broader monopoly.[256]

In view of the principles of the doctrine of equivalents as laid down in the cases cited in Section 359 of this book it is not clear what the Supreme Court meant when it said in Continental Paper Bag Co. *v.* Eastern Paper Bag Co:[257]

"The invention, of course, must be described and the mode of putting it to practical use, but the claims measure the invention. They may be explained and illustrated by the description. They cannot be enlarged by it. Yale Lock Co. *v.* Green-Leaf, 117 U. S. 554. Snow *v.* Lake Shore &c. Railway Co., 121 U. S. 617, is a case where a claim was limited by a description of the device, with reference to drawings. The court, in rejecting the contention that the description of the particular device was to be taken as a mere recommendation of the patentee of

[254] Boston Woven Hose & Rubber Co. *v.* Pennsylvania Rubber Co., 164 F. R. 557, 1908; National Malleable Castings Co. *v.* Buckeye Malleable Iron & Coupler Co., 171 F. R. 847, 1909; Westinghouse Electric & Mfg. Co. *v.* Toledo P. C. & L. Ry. Co., 172 F. R. 371, 1909; F. Wesel Mfg. Co. *v.* Printing Machinery Co., 218 F. R. 178, 1914.

[255] Hall Signal Co. *v.* General Ry. Signal Co., 169 F. R. 290, 1909; Goodwin Film & Camera Co. *v.* Eastman Kodak Co., 213 F. R. 231, 1914.

[256] Wm. B. Scaife & Sons Co. *v.* Falls City Woolen Mills, 209 F. R. 210, 1913.

[257] Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

the manner in which he contemplated to arrange the parts of his machine, said there was nothing in the context to indicate that the patentee contemplated any alternative for the arrangement of the parts of the device. Therein the description is distinguished from the description in the Liddell patent. Liddell was explicit in the declaration that there might be alternatives for the device described and illustrated by him. He was explicit in saying that *in place of the device for controlling the movement of the* forming plate relatively to the cylinder that the plate might "be moved or operated by any other suitable means."

While it is true that by statutory provision [258] an inventor, in the case of a machine patent, "shall explain . . . the best mode in which he has contemplated applying that principle," it is not clear how this requirement has any bearing on the scope of his claims. The court has apparently given a broader construction to a patent in which the inventor has stated as a conclusion that there might be alternatives for the device described and shown by him, than it would have done had that statement been absent.

§ 186. "The developed and improved condition of the patent law, leaves no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits those rights. The genius of the inventor should not be restrained by vague and indefinite descriptions of claims in existing patents, from the right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he

[258] Revised Statutes, Section 4888.

has invented, and for what he claims a patent."[259] "As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public."[260] "It is well known that the terms of the claim in letters patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the Office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts, therefore, should be careful not to enlarge, by construction, the claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms."[261]

"In view of the statute, the practice of the Patent Office, and the decisions of this Court, we think that the scope of letters patent should be limited to the invention covered by the claim, and that though the claim may be illustrated, it cannot be enlarged by the language used in other parts of the specification." [262] "Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from what its words express. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is

[259] Merrill *v.* Yeomans, 94 U. S. 573, 1876.

[260] Keystone Bridge Co. *v.* Iron Co., 95 U. S. 278, 1877.

See Section 176.

[261] Burns *v.* Myer, 100 U. S. 672, 1879.

[262] Railroad Co. *v.* Mellon, 104 U. S. 118, 1881.

unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." [263] "Since the inventor must particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery; the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is." [264] "We know of no principle of law which would authorize us to read into a claim, an element which is not present, for the purpose of making out a case of novelty or infringement." [265]

These are the declarations of the Supreme Court relevant to the proper strictness to be observed in construing patents; and they apply to primary patents as much as to secondary patents.[266] Therefore, when a claim clearly covers a combination of certain elements, it cannot, by construction, be so altered as to cover more elements, so as not to be invalid,[267] or to cover fewer elements, and thus be rendered more likely to be infringed,[268] or to cover other elements in place of some that may be omitted, but which are not equivalents therefor.[269] So, also, a claim for a process, substantially as described, cannot be construed

[263] White *v.* Dunbar, 119 U. S. 51, 1886.

[264] Howe Machine Co. *v.* National Needle Co., 134 U. S. 394, 1890.

[265] McCarty *v.* Lehigh Valley Railroad Co., 160 U. S. 116, 1895.

[266] Groth *v.* Postal Supply Co., 61 F. R. 287, 1894.

[267] McCarty *v.* Lehigh Valley Railroad Co., 160 U. S. 116, 1895; Morgan Envelope Co. *v.* Albany Paper Co., 152 U. S. 429, 1894; Stiles *v.* Rice, 29 F. R. 445, 1887; Wollensak *v.* Sargent, 41 F. R. 55, 1890; Westinghouse *v.* Edison Electric Light Co., 63 F. R. 592, 1894; Anderson Foundry & Mach. Works *v.* Potts, 108 F. R. 384, 1901.

[268] Shepard *v.* Carrigan, 116 U. S. 597, 1885; Sutter *v.* Robinson, 119 U. S. 541, 1886; McClain *v.* Ortmayer, 141 U. S. 425, 1891.

[269] Sackett *v.* Smith, 42 F. R. 852, 1890.

to cover an incidental process set forth in the description, but merely recommended there, instead of being required, or being stated to be essential to the principal process of the patent.[270] Likewise a patentee of a manufacture is not restricted to a construction which he describes in the specification merely as "preferable," unless specifically limited by the claims.[271] And so in the case of a patent for a process where the use of a specified chemical agent is described as "preferable" to a method which the defendant uses.[272] In fact as the Supreme Court has said: "An inventor must describe what he conceives to be the best mode, but he is not confined to that. If this were not so most patents would be of little worth." [273] And so in case of a patent for a machine.[274] Nor can a claim for a dye stuff as produced from any one of many substances, be construed to be confined to that dye stuff as produced from only one of those substances, where it is proved that none of the others will produce it.[275]

§ 186*a*. The acts and conduct of the owner of a patent may also give a construction to a claim which will avoid infringement. For instance, where the patentee had for a number of years placed a certain construction on a claim, with knowledge that the defendant during that time had been selling a device for a similar purpose to that of the complainant, but which did not infringe the claim as so construed, complainant was held to be stopped from

[270] Sewell *v.* Jones, 91 U. S. 185, 1875; Holliday *v.* Pickhardt, 29 F. R. 858, 1887.

[271] Smeeth *v.* Perkins & Co., 125 F. R. 285, 1903; Rollman Mfg. Co. *v.* Universal Hardware Co., 207 F. R. 97, 1913.

[272] Fullerton Walnut Growers Ass'n *v.* Anderson Barngrover Mfg. Co., 166 F. R. 443, 1908.

[273] Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

[274] Steiger *v.* Waite Grass Carpet Co., 194 F. R. 878, 1912.

[275] Matheson *v.* Campbell, 78 F. R. 910, 1897.

claiming infringement.[276] This holding may perhaps more properly be placed on the ground of laches. The doctrine applies also to the case of an assignor of a patent who is sued for infringement by the assignee.[277]

§ 187. Letters patent may be construed in the light of the contemporaneous intention of the inventor and of the Patent Office; and to this end recourse may be had to the files of the application papers to see what changes were made in the description and claims while the application was pending in the Patent Office.[278] Where the change made in the Patent Office was a broadening one, it cannot be construed away in order to ascribe validity to the patent.[279] But no subsequent application by the same inventor for another patent is admissible in this behalf;[280] except where the patent contains a disclaimer of matter said therein to be claimed in another patent or application of the same inventor, in which case that other patent or application is admissible to aid in ascertaining the scope of the disclaimer.[281]

§ 187*a*. Where an applicant, on the rejection of his application, inserted in consequence of that rejection,

[276] Westinghouse Elec. & Mfg. Co. *v.* Wagner Co., 129 F. R. 604, 1904; McGill *v.* Whitehead & Hoag Co., 137 F. R. 97, 1905.

[277] Hurwood Mfg. Co. *v.* Wood, 138 F. R. 835, 1905.

[278] Crawford *v.* Heysinger, 123 U. S. 602, 1887; Trader *v.* Messmore, 1 Bann. & Ard. 639, 1875; Bate Refrigerating Co. *v.* Eastman, 24 F. R. 649, 1885; Williams *v.* Rubber Shoe Co., 49 F. R. 251, 1892; Western Engineering & Const. Co. *v.* Risdon Iron & Locomotive Works, 174 F. R. 224, 1909.

[279] Morgan Envelope Co. *v.* Albany Paper Co., 152 U. S. 420, 1894; Johnson *v.* Olsen, 61 F. R. 833, 1894.

[280] Edison Electric Light Co. *v.* U. S. Electric Lighting Co., 47 F. R. 462, 1891.

But see Lewis Blind-Stitch Mach. Co. *v.* Arbetter Felling Mach. Co., 208 F. R. 992, 1913.

[281] National Typographic Co. *v.* New York Typograph Co., 46 F. R. 115, 1891.

limitations and restrictions into his specification, for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been if such limitations and restrictions were not contained in it,[282] and this is particularly so where the broad construction claimed would have put the application in interference with another pending application.[283] And where an applicant materially modified a claim, in obedience to a requirement of the Patent Office, it will not be construed as it would have been if it had not been modified,[284] even where the modification was made under protest, accompanied by notice that the applicant would insist that the modification should be construed away, after the granting of the patent.[285]

But the applicant is not precluded from securing by an amended claim every improvement and combination that he has invented and that is not disclosed by the referen-

[282] Roemer *v.* Peddie, 132 U. S. 317, 1889; Hubbell *v.* United States, 179 U. S. 80, 1900; Greene *v.* Buckley, 135 F. R. 520, 1904; St. Louis Street, etc., Co. *v.* Am. Street, etc., Co., 156 F. R. 574, 1907; Johnson Furnace & Eng. Co. *v.* Western Furnace Co., 178 F. R. 819, 1910; Campbell *v.* American Shipbuilding Co., 179 F. R. 498, 1910; Cotto-Waxo Chemical Co. *v.* Perolin Co. of America, 185 F. R. 267, 1911; W. W. Sly Mfg. Co. *v.* Russell & Co., 189 F. R. 61, 1911; O'Brien-Worthen Co. *v.* Stempel, 209 F. R. 847, 1913; Ventilated Cushion & Spring Co. *v.* D'Arcy (citing authorities in the Sixth Circuit), 232 F. R. 468, 1916.

[283] Ajax Forge Co. *v.* Morden Frog, etc., Works, 156 F. R. 594, 1907.

[284] Phœnix Caster Co. *v.* Spiegel, 133 U. S. 368, 1890; Williams *v.* Rubber Shoe Co., 49 F. R. 251, 1892; Motion Picture Patents Co. *v.* Independent Moving Pictures Co., 200 F. R. 411, 1912; Grever *v.* United States Hoffman Co., 202 F. R. 923, 1913.

[285] Thomas *v.* Rocker Spring Co., 77 F. R. 431, 1896; Victor Talking Mach. Co. *v.* Am. Graphophone Co., 151 F. R. 601, 1907; Gray Telephone Pay Station Co. *v.* Baird Mfg. Co., 174 F. R. 417, 1909; Sharp & Smith *v.* Physicians & Surgeons Appliance Co., 174 F. R. 424, 1909.

ces on which the original claim was rejected.[286] And it has been held that where his claims as restricted by amendment have been rejected by the Examiner but finally allowed on appeal on the broad ground that the basic idea involved invention, the amendments do not restrict the claim to the precise construction therein described.[287] It may be remarked that of late years courts generally have been disposed to give much consideration to the fact that an applicant for practical reasons of expediency is often compelled to unduly narrow his claims while the application is pending, and in such cases lean as far as possible in the direction of liberality where the limitations imposed by the Patent Office appear to have been unwarranted. It may be noted that the Court of Appeals of the second circuit gives effect to limitations imposed by the Patent Office only in so far as an estoppel has been created.[288]

Neither can a patentee, who canceled a claim in his application, after it was rejected by the Patent Office for want of invention or for want of novelty, afterward successfully contend that some other claim of his patent shall be construed to be co-extensive with the one rejected,[289]

[286] Wayne Mfg. Co. *v.* Benbow-Brammer Mfg. Co., 168 F. R. 271, 1909; Vrooman *v.* Penhallow, 179 F. R. 296, 1910; Drum *v.* Turner, 219 F. R. 188, 1914; New York Scaffolding Co. *v.* Whitney, 224 F. R. 452, 1915; Weber Electric Co. *v.* Union Electric Co., 226 F. R. 482, 1915.

[287] Gray Telephone Pay Station Co. *v.* Baird Mfg. Co., 174 F. R. 417, 1909.

[288] Westinghouse Electric, etc., Co. *v.* Condit Electrical Mfg. Co., 194 F. R. 427, 1911. See notes 286 and 287 above.

[289] Royer *v.* Coupe, 146 U. S. 532, 1892; Corbin Cabinet Lock Co. *v.* Eagle Lock Co., 150 U. S. 40, 1893; Douglas *v.* Abraham, 50 F. R. 422, 1892; J. L. Mott Iron Works *v.* Standard Mfg. Co., 53 F. R. 821, 1893; Kelly *v.* Clow, 89 F. R. 306, 1898; Cotto-Waxo Chemical Co. *v.* Perolin Co. of America, 185 F. R. 267, 1911; Besser *v.* Merillat Culvert Core Co., 226 F. R. 783, 1915; Com-

even though the cancellation was the result of an adverse decision on an interference proceeding.[290] But the doctrine of limitation by amendment applies only to material modifications which alter the mode of operation, and so if the mode of operation is not affected the limitation can properly be disregarded.[291] Nor can a disclaimer, which was inserted by an applicant in his application in pursuance of a requirement of the Patent Office, be eliminated from his patent by construction.[292] And where an applicant canceled a portion of his application, in pursuance of a decision in the Patent Office that it could not be covered in any application with the other portions thereof, a patent granted upon the application thus reduced, cannot be construed to be co-extensive with what it would have been but for such cancellation.[293] So also, where an applicant filed two applications for two patents on related subjects, and withdrew one of them, as a condition of the allowance of the other, the patent granted on the allowed application will not be construed as covering the subject of the application which was withdrawn.[294] And these rules apply even where the action of the Patent Office was erroneous, or that of the applicant unnecessary.[295] It has been held, however, that in order that pro-

puting Scale Co. *v.* Automatic Scale Co., 204 U. S. 609, 1907.

But see Veneer Machinery Co. *v.* Grand Rapids Chair Co., 227 F. R. 419, 1915; Bullock Electric Mfg. Co. *v.* Crocker-Wheeler Co., 141 F. R. 101, 1905.

[290] Marshall & Stearns Co. *v.* Murphy Mfg. Co., 199 F. R. 772, 1912.

[291] Automatic Recording Safe Co. *v.* Bankers' Registering Safe Co., 224 F. R. 506, 1915.

[292] Stahl *v.* Williams, 52 F. R. 651, 1892.

[293] Macbeth *v.* Gillinder, 54 F. R. 170, 1889.

[294] Frederick R. Stearns & Co. *v.* Russell, 85 F. R. 225, 1898.

[295] Lapham Dodge Co. *v.* Severin, 40 F. R. 763, 1889; Shaw Stocking Co. *v.* Pearson, 48 F. R. 236, 1891.

ceedings in the Patent Office shall positively operate as an estoppel they must relate to the "pith and marrow" of an alleged improvement.[296]

But merely incidental amendments, which are not made in pursuance of any references or real reasons given by the Patent Office, but are made in deference to Patent Office preferences for particular phraseology, will not be construed to limit claims so as to make them narrower than the inventions they were designed to cover.[297] And no amendment made to meet an objection of the Patent Office, will be construed to disclaim the patentee's actual invention, if that construction can be avoided without doing violence to the obvious meaning of the language.[298] Furthermore, concessions addressed to the Examiner made in arguments of the applicant which are not carried into the claims do not limit the claims as finally allowed,[299] and an amendment proposed but subsequently withdrawn cannot be construed to impose a limitation on the claim as issued.[300]

§ 188. The laws which were in force when any particular patent was granted, are the laws according to which it must be construed;[301] and a special statute relevant to any particular patent is ingrafted on the general patent

[296] U. S. Peg-Wood Co. *v.* B. F. Sturtevant Co., 125 F. R. 382, 1903.

[297] Rhodes *v.* Lincoln Press Drill Co., 64 F. R. 220, 1894; Hillborn *v.* Hale & Kilburn Mfg. Co., 69 F. R. 960, 1895; Consolidated Fastener Co. *v.* Columbian Fastener Co., 79 F. R. 798, 1897.

[298] Westinghouse *v.* Brake Co., 66 F. R. 1006, 1895.

[299] Boyer *v.* Keller Tool Co., 127 F. R. 130, 1904; Fullerton Walnut Growers Ass'n *v.* Anderson Barngrover Mfg. Co., 166 F. R. 443, 1908; M'Cormick W. P. Cement Co. *v.* Medusa Concrete Waterproof Co., 222 F. R. 288, 1915.

[300] Diamond Match Co. *v.* Ruby Match Co., 127 F. R. 341, 1904.

[301] McClurg *v.* Kingsland, 1 Howard, 202, 1843.

statutes, and must be construed harmoniously with them.[302]

§ 189. Since letters patent are contracts,[303] questions of construction are questions of law for the judge, not questions of fact for the jury.[304] As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such words and phrases.[305] Such is especially the case when electric, magnetic and chemical patents are involved.[306] Some courts have held that it is proper to disregard patents put in evidence to prove anticipation when they are not explained.[307] Experts are not required and in fact the use of their testimony is discouraged in cases in which the

[302] Evans *v.* Eaton, 3 Wheaton, 454, 1818; Bloomer *v.* McQuewan, 14 Howard, 539, 1852.

[303] Denning Wire & Fence Co. *v.* Am. Steel & Wire Co., 169 F. R. 793, 1909; Century Electric Co. *v.* Westinghouse Electric Mfg. Co., 191 F. R. 350, 1911; Fried, Krupp Aktien-Gesellschaft *v.* Midvale Steel Co., 191 F. R. 588, 1911; O'Brien-Worthen Co. *v.* Stempel, 209 F. R. 847, 1913; Am. Roll Gold Leaf Co. *v.* W. H. Coe Mfg. Co., 212 F. R. 720, 1914; Railroad Supply Co. *v.* Hart Steel Co., 222 F. R. 261, 1915; O. H. Jewell Filter Co. *v.* Jackson, 140 F. R. 340, 1905.

[304] Winans *v.* Denmead, 15 Howard, 330, 1853; Coupe *v.* Royer, 155 U. S. 565, 1894; Prepayment Car Sales Co. *v.* Orange County Traction Co., 221 F. R. 939, 1915; Brothers *v.* Lidgerwood Mfg. Co., 223 F. R. 359, 1915. See Section 499.

[305] Loom Co. *v.* Higgins, 105 U. S. 580, 1881; Fay *v.* Mason, 127 F. R. 325, 1903; Charmbury *v.* Walden, 141 F. R. 373, 1905; Fried, Krupp Aktien-Gesellschaft *v.* Midvale Steel Co., 191 F. R. 588, 1911.

[306] Sundh Electric Co. *v.* General Electric Co., 204 F. R. 277, 1913.

[307] Benbow-Brammer Mfg. Co. *v.* Heffron-Tanner Co., 144 F. R. 429, 1906; Bell *v.* MacKinnon, 148 F. R. 205, 1906; General Electric Co. *v.* Germania Electric Co., 174 F. R. 1013, 1909.

mechanical details are simple and the issue of infringement sharply defined.[308] The judges are not obliged to follow blindly the testimony of experts. They may disregard it if it appears to them to be unreasonable.[309] While the testimony of experts relevant to the meaning of particular words or phrases in letters patent, is to this extent admissible, such testimony is inadmissible on the question of the construction of the letters patent as a whole.[310]

§ 190. In the absence of contrary evidence, the invention covered by a particular letters patent is presumed to be identical with that covered by the application on which those letters patent were granted.[311]

§ 191. All persons are chargeable with notice of the contents of all letters patent of the United States, because those letters patent are matters of public record.[312] But those letters patent are so numerous and so various, and many of them are so abstruse and so complicated, that it is far beyond the power of the strongest intellect, to learn in a lifetime the contents of them all.

More than four hundred thousand letters patent of the United States were in force in 1903; and nearly as many others expired before the end of that year. The unexpired patents contained more than two millions of claims; the validity of each of which depends on the question whether its subject was a new and useful invention, as compared with all prior patents and printed publications anywhere in the world. And the question whether any process can

[308] Fay *v.* Mason, 127 F. R. 325, 1903; Hardinge Conical Mill Co. *v.* Abbe Engineering Co., 195 F. R. 936, 1912.

[309] Winans *v.* Railroad Co., 21 Howard, 88, 1858.

[310] Corning *v.* Burden, 15 Howard, 252, 1853.

[311] Loom Co. *v.* Higgins, 105 U. S. 580, 1881.

[312] Boyden *v.* Burke, 14 Howard, 575, 1852.

be performed, or any machine, manufacture, composition of matter or design, can be copied, made, used or sold, without infringing any unexpired United States patent, is a question which depends on its non-conformity with every one of the two millions of claims of those patents. To investigate and answer such of these questions as arise in a particular manufacturing enterprise, or in a particular litigation, is a work which can be done only by a patent expert; and a patent expert who performs that work in a large variety of complicated cases, in many different arts, must employ extensive information, exercise penetrating power of analysis, and carry as best he may, a heavy responsibility.

§ 191*a*. Property in patents is not taxable by state authority; because such taxation would constitute interference with rights created by national authority, and would, therefore, be contrary to the Constitution of the United States.[313] Patents for inventions are taxable by national authority; though no statute providing for any such taxation has ever been enacted by Congress. Such taxation, if it were to be prescribed, would be direct taxation as distinguished from being a duty, impost or excise;[314] and would, therefore, necessarily be apportioned among the several States, in proportion to their respective populations as ascertained by the last preceding national census.[315] That constitutional plan of direct taxation would operate so unequally, if it were to be applied to property in patents, that no enlightened statesman or publicist would support any proposal to enact a national statute providing for such taxation. For these reasons,

[313] M'Culloch *v.* Maryland, 4 Wheaton, 436, 1819.

[314] Pollock *v.* Farmers' Loan & Trust Co., 158 U. S. 601, 1895.

[315] Constitution of the United States, Article 1, Section 9.

the freedom from taxation, which letters patent of the United States have had, from the beginning of their issuance in the eighteenth centu y, will undoubtedly continue as long as the Constitution of the United States continues unchanged in respect of the subject of taxation, and in respect of the relations of the Nation to the States.

CHAPTER VIII

DISCLAIMERS

192. Statutory authorization of disclaimers.
193. Statutory prescriptions, relevant to disclaimers.
194. Errors which justify disclaimers.
195. Mistakes of fact, relevant to novelty.
196. Mistakes of law, relevant to invention.
197. Claims void for want of utility.
198. Proper disclaimers.
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200. Immaterial parts.
201. Reissue claims.
202. Fraudulent or deceptive intention.
203. Effect of unreasonable delay to file a disclaimer.
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205. Costs, where a necessary disclaimer has not been filed.
206. Extent of disclaimant's interest.
207. Construction of letters patent after a disclaimer.
208. Disclaimers filed pending litigation.
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§ 192. THE statutory provisions relevant to disclaimers originated in 1837, and have never been substantially changed. Sections 7 and 9 of the Patent Act of that year,[1] embodied those provisions; and those sections continued in force till July 8, 1870, when they were substantially re-enacted as Sections 54 and 60 of the Consolidated Patent Act of that date.[2] In 1874, the latter sections were, in their turn, re-enacted, without any material change, as Sections 4917 and 4922 of the Revised Statutes. It would have been better statute writing, if those two sections had

[1] 5 Statutes at Large, Ch. 45, Sections 7 and 9, p. 193.

[2] 16 Statutes at Large, Ch. 230, Sections 54 and 60, p. 206; Taylor *v.* Archer, 8 Blatch. 318, 1871.

always been blended together into one clear and comprehensive paragraph. Referring to the same subject, and standing, as they always have, in the same statute, they must undoubtedly be construed together;[3] and the law they embody, must be set forth, by extracting from both sections, all the material meaning of both, and by incorporating that meaning, together with the case law of the subject, into one systematic explanation. Let that therefore be the present attempt.

§ 193. Whenever through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has, in his specification, claimed materially more than that of which he was the first inventor, his patent shall be valid for whatever is justly his own; and every such patentee, his executors, administrators, or 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 such part, if it is a material and substantial part of the thing patented, and is definitely distinguishable from the parts claimed without right. 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 was entered in the Patent Office, before the commencement of the suit. But no patentee shall be entitled to maintain any such suit, if he has unreasonably neglected or delayed to enter a disclaimer. And any such patentee, his heirs or assigns, whether of the whole or of any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the subject-matter of the patent, as he shall not choose to longer claim, stating therein the extent of his interest in such patent. Such disclaimer

[3] Hailes *v.* Stove Co., 123 U. S. 588, 1887; Sessions *v.* Romadka, 145 U. S. 41, 1892.

shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and shall thereafter be considered a part of the original specification, to the extent of the interest possessed by the disclaimant 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.[4]

§ 194. The primary fact which brings the law stated in the last section into play, is the claiming by a patentee of materially more in his patent than he was entitled to claim.[5] Such errors may spring from inadvertence. That is to say, they may spring from failure, on the part of the writer of the claims, to exercise proper care in penning them. So also, they may arise from accident: from chances against which even diligent care cannot always guard. But mistake is the most common source of such errors; and such errors may arise from mistake of fact or from mistake of law.[6]

§ 195. Mistakes of fact, relative to how much of a described process, machine or manufacture was first invented by its patentee, frequently follow from lack of full information touching what was previously invented by others. Litigation may alone disclose the fact that the patentee's claims are too numerous or too broad to be consistent with novelty. Whenever this occurs, it is clear that the patentee ought no longer to appear to hold an exclusive right to anything which he was not the first to invent. To this end, the statute provides that he must disclaim

[4] Revised Statutes, Sections 4917 and 4922 blended together.

[5] Hailes *v.* Stove Co., 123 U. S. 588, 1887; Brush Electric Co. *v.* Ft. Wayne Electric Light Co., 40 F. R. 835, 1889.

[6] Electrical Accumulator Co. *v.* Julien Electric Co., 38 F. R. 134, 1889.

that part, within a reasonable time, or, in default thereof, must suffer the statutory consequences. On the other hand, it is equally clear, that if the patentee is willing to eliminate from his claims, everything which later information shows had been invented before him, he ought to be allowed to retain his exclusive right to the residue. To this end, the statute provides that if within a reasonable time, he disclaims what was another's, he shall be enabled to enforce his patent as far as it covers what was his own invention. But a disclaimer cannot confine a claim to ground which does not appear in the patent to constitute an invention; even where that ground is narrower than that which was originally claimed in the patent.[7]

§ 196. A mistake of law, which consists in claiming something not patentable, may also be remedied by disclaimer.[8] The law which permits a patentee to disclaim, is remedial. It is intended for the protection of the patentee, as well as for the protection of the public. The evil to be remedied is the same, where a patentee has claimed more than he ought, whether that result sprang from the fact that another invented it before him, or sprang from the fact that what he produced was not an invention at all. For this reason, the Supreme Court held that the eighth claim of Morse might be disclaimed, after having been held void for want of patentability, with the same effect as though it had been held void for want of novelty. The same reason would also permit a patentee to disclaim any claim which is void for want of invention. Indeed the statute expressly applies to such a case, for no man can be the first inventor of anything which is not an invention. He may be its first discoverer, if it is a law of nature, or its first constructor, if it is a

[7] Hailes *v.* Albany Stove Co., 123 U. S. 587, 1887.

[8] O'Reilly *v.* Morse, 15 Howard, 120, 1853.

product of mere mechanical skill, but its first inventor he cannot be. And a mistake of law, which consisted in unlawfully claiming, in separate claims, in one patent, several independent inventions, may be remedied by disclaiming enough claims to give to the patent the necessary unity.[9]

§ 197. There appears to be no warrant in the statute, for disclaiming any claim which is void for want of utility, and for no other cause. An inventor of a new thing may generally ascertain its character in point of utility before applying for a patent. If he can do so, he ought to do so, and thus shield the public from a waste of time involved in examining and judging useless contrivances. Where a patent has but one claim, and where the matter covered by that claim is useless, no disclaimer could make that patent valid. Where a part only of the claims of a patent are void for want of utility, and for no other cause, the void claims are not injurious to the valid ones, and therefore no disclaimer is needed in any such case.[10]

And no disclaimer is necessary where some, but not all, of the claims of a patent are void, by reason of constructive abandonment, resulting from public use or sale of the subjects of those particular claims, more than two years prior to the application for the patent.[11]

Where two patents are applied for on the same day, and are granted on the same invention; the owner of them has the lawful power to choose which one of those patents he will retain, but he must somehow relinquish the other.[12] He cannot rid

[9] Sessions *v.* Romadka, 145 U. S. 40, 1892; Manhattan General Const. Co. *v.* Helios-Eyton Co., 135 F. R. 785, 1905.

[10] See Section 205.

[11] Whitney *v.* B. & A. R. Co., 50 F. R. 72, 1892.

[12] Electrical Accumulator Co. *v.* Brush Electric Co., 52 F. R. 138, 1892.

himself of his superfluous patent, in such a case, by means of a disclaimer under the disclaimer statutes; but he can undoubtedly do so by means of a surrender of his superfluous patent, uncoupled with any application for a reissue thereof.

§ 198. The statute provides that a disclaimer, to be effective, must leave claimed by the patent, at least one definitely distinguishable and material part of the original subject of the patent. That result is commonly accomplished by disclaiming one or more claims, while leaving one or more other and independent claims undisturbed in the patent. But that result can be sometimes accomplished in some other way.

For example, where two or more claims in substance, are combined in one claim in form, by the use of the words "with or without" or by use of the word "or" alone, a disclaimer may be made to expunge one of those inventions from that claim, without disturbing any other.[13]

And where a patent contains a proper specific claim, and also a generic claim which covers not only the subject of the specific claim, but also covers other matter which requires to be disclaimed, that result can be accomplished by a disclaimer of the generic claim, without any injury resulting to the specific claim, from that disclaimer.[14]

And where an invention is limited by the prior art, in some particular in which the patent states that it is not limited, that statement may be removed by a disclaimer, so as to confine the construction of the claim of the pat-

[13] Tuck *v.* Bramhill, 6 Blatch. 95, 1868; Taylor *v.* Archer, 8 Blatch. 318, 1871; Electrical Accumulator Co. *v.* Julien Electric Co., 38 F. R. 134, 1889.

[14] Graham *v.* Earl, 82 F. R. 740, 1897.

ent, to the boundaries to which the invention is limited by the prior art.[15]

And where the actual invention of a patentee, consisted of the parts specified in a combination claim, plus some other element specified in the description, as being usable with the parts specified in the claim, the claim may be restored to its proper limits, by the addition of that element thereto, by means of a disclaimer; if that result can be accomplished by disclaiming such statements in the description, as indicate that that element can be omitted from the subject of the patent.[16]

§ 199. Where the invention of a patentee consisted in a combination of less than all of the parts specified in a combination claim in his patent, he cannot disclaim the surplus parts, and afterward hold as infringers, those who make, use or sell the other parts alone, in addition to thus holding those who make, use or sell all the parts of the original claim; because that operation would broaden the patent instead of narrowing it; and because that result would be contrary to the purpose of the statutes of disclaimers.[17]

And where the only invention left to a patentee by the prior art, is shown in the drawings of his patent, but is not mentioned in the description, or attended to in any claim of that document; that invention is not such a part of the subject of the patent, as can be monopolized by disclaiming all that the patent described.[18]

§ 200. There is one difference between the two dis-

[15] Carnegie Steel Co. *v.* Cambria Iron Co., 185 U. S. 436, 1902; Schwarzwalder *v.* New York Filter Co., 66 F. R. 152, 1895.

[16] Hurlbut *v.* Schillinger, 130 U. S. 463, 1889.

[17] Cercaline Mfg. Co. *v.* Bates, 77 F. R. 883, 1897.

[18] Hailes *v.* Albany Stove Co., 123 U. S. 587, 1887.

claimer sections of the Revised Statutes, which it is proper to mention and explain in this place. Section 4917 contemplates disclaimers as being proper whenever a patentee has claimed more than that of which he was the first inventor; while Section 4922 attends only to cases wherein the excess is a material or substantial part of the thing patented. This qualification should be inserted in the two sections, as construed together, because Section 4922 is the only one that prescribes any evil result from a failure to disclaim. Neither section visits any infliction on the patentee, for omitting to disclaim anything which is an immaterial part of the thing patented. If, therefore, a patentee omits to disclaim such a part when he discovers it to have been known before his invention thereof, or learns that it is not an invention at all, he thereby loses no right, and incurs no inconvenience.[19] To file a disclaimer, in such a case, is an act which is at once harmless and unnecessary.

§ 201. Reissue patents, as well as original patents, are entitled to the benefits of the law relevant to disclaimers; and that too, even where the matter disclaimed was not claimed in the original, but only in a reissue granted upon its surrender.[20] But no claim which was in an original patent, and is absent from a reissue thereof, can be reclaimed by a disclaimer of the changes made by the reissue.[21] Where an original patent was surrendered, and then reissued in several divisions; that is to say, where several reissue patents were granted for separate inven-

[19] Hall *v.* Wiles, 2 Blatch. 199, 1851; Peek *v.* Frame, 5 Fisher, 212, 1871.

[20] O'Reilly *v.* Morse, 15 Howard, 62, 1853; Gage *v.* Herring, 107 U. S. 646, 1882; Yale Lock Co. *v.* Sargent, 117 U. S. 553, 1886; Schillinger *v.* Gunther, 17 Blatch. 69, 1879; Tyler *v.* Galloway, 12 F. R. 567, 1882.

[21] McMurray *v.* Mallory, 111 U. S. 109, 1883.

tions described in an original patent, a suit based upon one of those divisions will be unaffected by the fact that a claim in another division is invalid for want of novelty, or for want of invention. The statute relevant to disclaimers has no application to such cases.[22]

§ 202. Fraudulent or deceptive intention, if it existed on the part of a patentee, when claiming materially more than that of which he was the first inventor, or when claiming that which was not patentable, will rightly prevent him from receiving any benefit from a disclaimer. The statutory provision is in harmony with the principles of equity: a system which always declines to extract persons from trouble which arose from their own moral turpitude.

§ 203. The statement in Section 4917, that under the circumstances therein mentioned, a patentee's patent shall be valid as to all that part of the invention which is truly and justly his own, is to be construed in connection with the provision in Section 4922, that the patentee shall not be entitled to recover in any suit, if he unreasonably neglects or delays to enter a disclaimer. When so construed, the two sections enact that where a patentee claims materially more than that which he was the first to invent, his patent is void, unless he has preserved the right to disclaim the surplus; and that he may fail to preserve that right, by unreasonable neglect or delay to enter a disclaimer in the Patent Office.

This enactment is in harmony with that point in the common law which made a patent wholly void, if any claim in it, was out of conformity with the actual invention of the inventor on whose application it was granted.[23]

§ 204. Neglect or delay to file a necessary disclaimer, be-

[22] Elastic Fabrics Co. *v.* Smith, 100 U. S. 111, 1879.

[23] Hailes *v.* Albany Stove Co., 123 U. S. 588, 1887.

gins when knowledge is brought home to the patentee, that the inventor upon whose account the patent was granted, was not the first inventor of a particular thing claimed in the patent, and material to the subject of the patent as a whole.[24] If, however, there is reasonable ground for difference of opinion relevant to the question whether the prior patent, or prior printed publication, or the prior process, or the prior thing, so brought home to the knowledge of the patentee, really negatives the novelty of anything claimed by him, then unreasonable delay to file a disclaimer will not begin until that question is finally settled by the courts.[25] Even a still further very short delay is not fatal to the right to disclaim;[26] and if the patent has expired when the occasion for a disclaimer is established, *no disclaimer can be filed or is necessary.*[27] The question whether the delay to enter a disclaimer, in a particular case, was or was not unreasonable, is a mixed question of law and fact, to be decided by the jury in accordance with proper instructions from the court.[28] In the case of Seymour *v.* McCormick,[29] the Supreme Court, when speaking of the question of the necessity for a disclaimer in that case, and of the question of unreasonable delay in entering one, said: "Under the circumstances, the question is one of law." The peculiar collocation of the paragraph, has caused some courts to suppose that

[24] O'Reilly *v.* Morse, 15 Howard, 121, 1853; Singer *v.* Walmsley, 1 Fisher, 558, 1860; Parker *v.* Stiles, 5 McLean, 44, 1849.

[25] Seymour *v.* McCormick, 19 Howard, 106, 1856; Potter *v.* Whitney, 1 Lowell, 87, 1866; Hill *v.* Biddle, 27 F. R. 561, 1886.

[26] Kittle *v.* Hall, 30 F. R. 39, 1887.

[27] Yale Lock Co. *v.* Sargent, 117 U. S. 553, 1885.

[28] Brooks *v.* Jenkins, 3 McLean, 449, 1844; Washburn *v.* Gould, 3 Story, 122, 1844; Burden *v.* Corning, 2 Fisher, 477, 1864; Office Specialty Co. *v.* Globe Co., 65 F. R. 605, 1895.

[29] Seymour *v.* McCormick, 19 Howard, 106, 1856.

the question thus characterized, was the question of delay;[30] but really it must have been the question of necessity. The latter depended wholly upon the construction of the patent, and was therefore a question of law. Whether or not a particular instance of delay was unreasonable, must largely depend upon the circumstances which surrounded the person chargeable therewith. What those circumstances were is a question of fact. Whether they constitute an excuse for the delay is a question of law. Whether or not a particular instance of delay to enter a necessary disclaimer was unreasonable, is therefore a mixed question of law and of fact.

§ 205. No costs can be recovered by the plaintiff in any infringement suit, the final decision of which shows a necessity for a disclaimer, unless such a disclaimer was entered in the Patent Office before the commencement of the suit.[31] This rule applies even to cases where the delay to enter the disclaimer was not unreasonable.[32] But a verdict on all the claims of a patent entitles the plaintiff to costs, even if, after that verdict, he files a disclaimer to one or more of the claims of that patent.[33] Failure on the part of the plaintiff to enter the proper disclaimer does not, however, entitle the defendant to costs as the effect of the failure to disclaim is negative merely.[34]

The case where a disclaimer is necessary to save the patent must, however, be distinguished from the case

[30] Singer *v.* Walmsley, 1 Fisher, 558, 1860; Parker *v.* Stiles, 5 McLean, 44, 1849.

[31] Revised Statutes, Section 4922; Reed *v.* Cutter, 1 Story, 591, 1841; Burdett *v.* Estey, 5 Bann. & Ard. 309, 1880; Proctor *v.* Brill, 16 F. R. 791, 1883; Novelty Glass Mfg. Co. *v.* Brookfield, 172 F. R. 221, 1909.

[32] O'Reilly *v.* Morse, 15 Howard, 121, 1853; Yale Lock Co. *v.* Sargent, 117 U. S. 553, 1885.

[33] Peck *v.* Frame, 5 Fisher, 212, 1871.

[34] Novelty Glass Mfg. Co. *v.* Brookfield, 172 F. R. 221, 1909.

where a disclaimer would be merely proper, as, for instance where a claim is invalid for incompleteness of description, as in the latter case the foregoing rule as to costs does not apply.[35]

Judge JOHN LOWELL remarked that where a plaintiff sues on a part of the claims of his patent only, the defendant will not be permitted to raise any issue relevant to the validity of any other claim, with intent to show a necessity for a disclaimer, and thus to escape costs.[36] His Honor based this opinion on the fact that more expense might be incurred in litigating such a collateral issue, than would be justified by the amount of the costs depending upon its decision. But general rules of law can hardly be based on considerations of what is expedient in a part only of the cases to which those rules purport to apply. It may happen that the costs involved in a particular litigation are large, while the expense involved in proving a necessity for a disclaimer of some one claim of the patent is small. The difference between the two sums may sometimes be measured by thousands of dollars. A judgment or a decree may be largely lessened, and justly lessened, if a defendant is permitted to prove a necessity for a disclaimer of a claim not sued upon. In view of these considerations, it is possible that the law will finally be settled otherwise than as Judge LOWELL's remark would seem to forecast.

§ 206. Disclaimers are required to state the extent of the interest which is held by the disclaimant in the patent involved.[37] If, however, the disclaimant is the original patentee, and the disclaimer states that fact, and is silent

[35] National Electric Signalling Co. *v.* De Forest Wireless Telegraph Co., 140 F. R. 449, 1905. See Section 197.

[36] American Bell Telephone Co. *v.* Spencer, 8 F. R. 512, 1881.

[37] Revised Statutes, Section 4917.

respecting any transfer of any part of it, the fair implication is that he still owns the whole, and that implication is a sufficient statement of the interest of the patentee.[38] So also, if an executor or administrator, in whose name a patent has been granted, states in his disclaimer that he is the patentee, and refers to the patent as showing his interest, that is a sufficient statement of his interest in the patent.[39] But if only one of several joint owners or owners in common of a patent, should file a disclaimer, no other owner could avail himself of its benefits, nor could it affect a suit brought by all the owners jointly.[40]

§ 207. The construction of a patent, after a disclaimer has been properly entered, must be the same that it would have been if the matter so disclaimed had never been claimed.[41] The mere fact of disclaimer is no evidence that the matter disclaimed is a part of the prior art.[42] And where a disclaimer disclaims a particular thing specifically, that thing cannot afterward be covered by the patent as being an equivalent of another thing which was not disclaimed.[43] No disclaimer, in order to be effectual, needs to eliminate anything from the description; though no harm will follow from such elimination, if it is confined to matter which is disclaimed, and which is not needed to show the nature of the invention which, after disclaimer, the patent continues to cover.[44]

§ 208. Disclaimers may be filed pending a suit on the

[38] Silsby *v.* Foote, 14 Howard, 221, 1852.

[39] Brooks *v.* Jenkins, 3 McLean, 432, 1844.

[40] Wyeth *v.* Stone, 1 Story, 294, 1840.

[41] Dunbar *v.* Myers, 94 U. S. 187, 1876; Schwarzwalder *v.* Filter Co., 66 F. R. 157, 1895; Bracewell *v.* Passaic Print Works, 107 F. R. 467, 1901.

[42] Manhattan General Const. Co. *v.* Helios-Upton Co., 135 F. R. 785, 1905.

[43] Cartridge Co. *v.* Cartridge Co., 112 U. S. 639, 1884.

[44] Schillinger *v.* Gunther, 17 Blatch. 69, 1879.

patent,[45] even though an appeal has been had;[46] but the plaintiff, even if he prevails in the suit, can recover no costs.[47] The filing of a disclaimer at that stage of affairs does not affect the pending action; except so far as it may bear upon the question whether or not there was unreasonable delay before filing it.[48] That question is an open one until decided on its merits, regardless of whether the disclaimer was filed before or after the bringing of the suit.[49] The sooner a necessary disclaimer is filed, the less danger exists that the preceding delay will be held unreasonable. For that reason, and for that reason alone, it is sometimes wiser to file a disclaimer pending a suit than to wait till the case is heard, or still longer, till it is decided.

§ 209. An important question arises when a District Court, before any disclaimer has been filed, decides that a part of the claims of the patent in suit are valid, and have been infringed by the defendant, while another part are void for want of novelty, or for want of invention, and ought therefore to be disclaimed. Ought the judge in such a case, to enter a decree for an injunction and an account on the valid claims, and allow the complainant to disclaim the others or not, as he deems most prudent; or should he decline to enter any decree till the complainant shall have filed a disclaimer? The second of these courses has been the practice in the first circuit,[50] in

[45] Filley *v.* Stove Co., 30 F. R. 434, 1887; Simplex R'y Appliance Co. *v.* Pressed Steel Car Co., 189 F. R. 70, 1911.

[46] Sample *v.* Am. Soda Fountain Co., 134 F. R. 402, 1905.

[47] Smith *v.* Nichols, 21 Wallace, 117, 1874; Suddard *v.* American Motor Co. (in which the subject is discussed at length), 163 F. R. 852, 1908.

[48] Revised Statutes, Section 4917; Sessions *v.* Romadka, 145 U. S. 41, 1892; Tuck *v.* Bramhill, 6 Blatch. 95, 1868.

[49] Reed *v.* Cutter, 1 Story, 590, 1841.

[50] Suddard *v.* American Motor Co., 163 F. R. 852, 1908.

the sixth,[51] and, prior to the decision of Page Machine Co. *v.* Dow, Jones & Co.,[52] in the second circuit;[53] prior to the Page Machine Co. case one of the judges in the second circuit criticised that practice as arbitrary and unjust,[54] and in at least one case in the sixth circuit the practice has not been followed by the Circuit Court, the reason being given that such a requirement would deprive the complainant of the benefit of an appeal from the decree in so far as it held the disclaimed claim invalid.[55] The same reason is stated in the Page Machine Co. case. And one of the Judges of the third circuit has held the first course to be the proper practice.[56]

[51] Odell *v.* Stout, 22 F. R. 169, 1884; Herman *v.* Youngstown Car Mfg. Co., 191 F. R. 579, 1911; F. D. Cummer & Son Co. *v.* Atlas Dryer Co., 193 F. R. 993, 1912; Houser *v.* Starr, 203 F. R. 264, 1913.

[52] Page Machine Co. *v.* Dow, Jones & Co., 168 F. R. 703, 1909.

[53] Myers *v.* Frame, 8 Blatch. 446, 1871; Burdett *v.* Estey, 15 Blatch. 349, 1878; Christman *v.* Rumsey, 17 Blatch. 148, 1879; Tyler *v.* Galloway, 12 F. R. 567, 1882; Brainard *v.* Cramme, 12 F. R. 621, 1882; Matthews *v.* Spangenberg, 14 F. R. 350, 1882; Hake *v.* Brown, 37 F. R. 783, 1889; Union Paper Bag Mach. Co. *v.* Waterbury, 39 F. R. 392, 1889; Steam Gauge & Lantern Co. *v.* Kennedy, 41 F. R. 39, 1889; Smead *v.* School District, 44 F. R. 617, 1890.

[54] Brush Electric Co. *v.* Accumulator Co., 47 F. R. 56, 1891; Ballard *v.* McCluskey, 58 F. R. 884, 1893.

[55] Plecker *v.* Poorman, 147 F. R. 528, 1905.

[56] Williams *v.* McNeely, 64 F. R. 768, 1894.

CHAPTER IX

REISSUES

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246. Reissues for single devices.

247. Reissues as affected by substitution of equivalents.
248. Reissues entitled to a liberal construction.
249. Reissued patents may be valid as to some claims while void to as others.
250. Executors, administrators, and assigns may procure reissues.
251. One of several executors may procure a reissue.
252. Rights of assignees in reissues.
253. The rights of grantees in reissues.
254. The legal effect of reissued patents.

§ 210. In 1821 James Grant, of Providence, Rhode Island, received letters patent of the United States for an improved mode of manufacturing hat bodies. In 1825 he presented a petition to Henry Clay, Secretary of State, stating that the specification of his patent was defective, and praying that his patent might be canceled, and a new and correct one granted, embracing the same improvements, so far as they were set forth in certain new specifications, drawings and explanations which accompanied the petition. Though there was, at that time, no statute which authorized any such proceeding, yet, on the advice of William Wirt, the Attorney General, and in the name of John Quincy Adams, the President of the United States, Mr. Clay canceled the letters patent of Mr. Grant, and thereupon issued to him new letters patent, for the same invention, and for the residue of the term covered by the original document. Annexed to the new letters, and forming part thereof, were the new specifications, drawings and explanations, which had accompanied Mr. Grant's petition.

In the case of Grant *v.* Raymond,[1] the validity of this proceeding was called in question in the Supreme Court, and was argued in the negative by Daniel Webster. The

[1] Grant *v.* Raymond, 6 Peters, 243, 1832.

Supreme Court sustained the validity of the reissued patent, on the general spirit and object of the patent law, not on its letter. In delivering the opinion Chief Justice MARSHALL said: "If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the Act does not in terms authorize a new patent, even in that case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has innocently been committed by the inventor himself?" And his Honor further said: "If, by an innocent mistake, the instrument introduced to secure his privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a Court of Equity might interpose to restrain him."

In pursuance of the doctrines of the first four sentences quoted above from Chief Justice MARSHALL, the Commissioner may cancel a patent and issue a corrected one in its stead, where the first one was caused, by an inadvertent error in the Patent Office, to grant less to the inventor than he had applied for and was entitled to receive, and where the inventor refuses to accept the patent thus limited.[2]

And it was in accordance with the same doctrine, that the Commissioner of Patents once reissued a patent to correct an error in its drawing, without making any

[2] Railway Register Mfg. Co. *v.* Railroad Co., 23 F. R. 593, 1885.

change in specification; [3] for the reissue in that case was not provided for by the statute.[4]

§ 211. In accordance with the spirit of the decision in Grant *v.* Raymond, and within a few months after that decision was made, Congress enacted a statute to regulate the granting of reissued letters patent.[5] That statute provided, in effect, that whenever any patent should be invalid or inoperative, because the inventor, by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, failed to conform his specification to the then existing statutory requirements; it should be lawful for the Secretary of State, upon the surrender to him of such patent, and the delivery to him of a sufficient statutory specification, to cause a new patent to be granted to the same inventor, for the same invention, and for the residue of the term of the original patent. That statute also provided that the right to receive a reissue, should extend to executors, administrators or assigns; and that the reissue patent should be liable to the same defences as the original; and that no public use of the invention, after the grant of the original patent, should prejudice the right of the patentee to recover for infringement of the reissue patent, committed after the grant thereof.

§ 212. The Patent Act of 1836 [6] repealed all prior statutes relevant to patents, and provided a more elaborate system in place of the repealed laws. Section 13 of that Act referred to reissues, and provided, in effect, that whenever any patent should be inoperative or invalid because the inventor had, by inadvertence, accident, or mistake, and without any fraudulent or deceptive inten-

[3] Hobbs *v.* Beach, 180 U. S. 394, 1901.

[4] Revised Statutes, Section 4916.

[5] 4 Statutes at Large, Ch. 162, Section 3, p. 559.

[6] 5 Statutes at Large, Ch. 357, p. 117.

tion, made his description or specification defective or insufficient, or had claimed in his specification more than he had a right to claim as new; it should be lawful for the Commissioner of Patents, upon the surrender to him of such patent, to cause a new patent to be issued to the same inventor, for the same invention, in accordance with the inventor's corrected description and specification, and for the residue of the term of the original patent. This statute also provided that the right to receive a reissue should extend to executors, administrators and assigns, and that the reissued patent, together with the corrected description and specification, should have the same effect in law, on the trial of all actions thereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent.

§ 213. The Patent Act of 1837 [7] made some additions to the statute of 1836, relevant to reissues. Section 5 recognized a right in a patentee to demand and receive several reissued patents for distinct parts of the subject-matter of his surrendered patent. And Section 8 provided, that whenever a patent should be returned for reissue, the claims thereof should be subject to revision and restriction, in the same manner as were original applications for patents; and that the Commissioner should not grant any reissue, until the applicant should have entered a disclaimer, or altered his claim, in accordance with the decision of the Commissioner; and that the applicant, if dissatisfied with such decision, should have the same remedy by way of appeal, that the law provided in cases of original applications.

§ 214. The Patent Act of 1870 [8] substantially re-enacted

[7] 5 Statutes at Large, Ch. 45, p. 191.

[8] 16 Statutes at Large, Ch. 230, p. 198.

the law of reissues as it had been embodied, for more than thirty years, in the statutes of 1836 and 1837, but re-enacted that law with a few modifications and additions. Where the old law used the phrase "defective or insufficient description or specification," the new law used the words "defective or insufficient specification." Where the old statute made it lawful for the Commissioner to reissue a patent, the new statute made it obligatory upon him to do so. Where the old law recognized a right in a patentee to demand and receive several reissue patents in the place of one surrendered patent, the new law provided that the Commissioner might, in his discretion, cause several such patents to be issued upon the demand of the applicant. The provision of the old statute, that the applicant, if dissatisfied with the decision of the Commissioner, should have the same remedy and be entitled to the same privileges and proceedings, as were provided by law in the case of original applications for patents, was omitted in the new statute; but its effect was retained, by expressly mentioning reissues in those sections of the new statute, which provided for that remedy, and for those privileges and proceedings.[9] Section 33 of the new statute provided further, that where a patent was to be reissued to an assignee of the inventor, the application should be made, and the specification be sworn to, by the inventor, if he be living. The Patent Act of March 3, 1871,[10] prescribed that the provision of Section 33, just mentioned, should not be construed to apply to any patent, issued and assigned before July 8, 1870; the date of the approval of the Act of which that section formed a part. Another new provision of the statute of 1870, was

[9] 16 Statutes at Large, Ch. 230, Sections 46 to 52, p. 204; Ingersoll *v.* Holt, 104 F. R. 682, 1900.

[10] 16 Statutes at Large, Ch. 132, p. 583.

as follows: "No new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except by each other; but where 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." [11]

§ 215. Section 4916 of the Revised Statutes is substantially a copy of Section 53 of the Statute of 1870. Section 4895 of the Revised Statutes, re-enacted the provision above cited from Section 33 of the Act of 1870, coupled with the statutory construction of that provision, which was contained in the Patent Act of 1871, and which was above explained. Sections 46 to 52 of the Act of 1870, were re-enacted as Sections 4909 to 4915 of the Revised Statutes. Thus the law of reissues underwent no change when the Revised Statutes were approved. The reissue provisions which were embodied in the Act of 1870, are still the statutes which govern the subject.

The meritorious ground for reissues, as stated by the Supreme Court in Grant *v.* Raymond, has now been set forth; and the subsequently enacted and gradually developed statutory law on the subject has been explained. To explore the great mass of relevant adjudicated cases, and to extract from those cases the detailed doctrines of the law of reissues, is the engaging work upon which it is now in order to enter.

§ 216. To be the subject of a reissue under the statutory law, a patent must be invalid, or it must be at least inoperative.[12] All patents that are invalid, are also in-

[11] 16 Statutes at Large, Ch. 132, Section 53, p. 206.

[12] Act of 1832, Section 3; Act of 1836, Section 13; Act of 1870, Sec-

operative. If the two words had, in the statutes, been always connected with the word "and," there would be ground for an argument that they were used synonymously. In fact, however, they have always been connected with the word "or," thus indicating that they were not intended to signify the same thing. What they do respectively mean is to be ascertained by considering other provisions of the statute; namely, those provisions which indicate the causes from which either invalidity or inoperativeness must have sprung, in order to make patents reissuable. To have that effect, either of those faults must have resulted from a defective or insufficient specification, or from the patentee claiming more than he had a right to claim as new. This last cause of fault was first mentioned in the statute of 1836. In the following year Congress provided that patents should no longer be held to be invalid on that ground, provided proper disclaimers were reasonably entered.[13] Ever since 1837, therefore, faults in patents, arising from patentees claiming more than they had a right to claim, have generally been curable by disclaimers.[14]

§ 216*a*. But in some cases, the matter in a patent, which the patentee had no right to claim as new, is so blended with the other matter in the patent, that it cannot be simply cut away by a disclaimer, and can best be removed by rewriting part or all of the specification, and a narrow reissue obtained. In such cases the remedy by reissue is undoubtedly lawful, but it cannot be invoked after an excessively unreasonable delay to invoke it;[15] though

tion 53; Revised Statutes, Section 4916.

[13] 5 Statutes at Large, Ch. 45, Sections 7 and 9, p. 193.

[14] Certain distinctions between reissues and disclaimers are brought out in the case of Motion Picture Patents Co. *v.* Laemmle, 214 F. R. 787, 1914.

[15] Pelzer *v.* Meyberg, 97 F. R. 969, 1899.

the strict two-year rule of Miller *v.* Brass Co., hereinafter discussed in connection with broadened reissues, does not apply,[16] and such delay will not be held to begin till the patentee is informed of the facts which make a narrower claim necessary.[17] The remedy by disclaimer, where it can be applied, is better than the other, because the remedy by reissue involves the loss of the rights of action under the patent, for infringements committed before the reissue is granted.

§ 217. The meaning of the word "specification" is that of the words "description and claim" when it is used, in the statutes, separately from both those words.[18] In the reissue section of the Statute of 1836, the word "description" was used in connection with the word "specification," and thus limited the meaning of the latter to the signification of the word "claim." [19] On the other hand, in the fourth sentence of Section 4916 of the Revised Statutes the word "specification" is used in immediate connection with the word "claim," and is therefore limited, in that place, to the meaning of the word "description."

The word "defective" and the word "insufficient" are not synonymous in this statute, as at first thought they may appear to be. The former word means "bad," and

[16] Conroy *v.* Penn Electrical & Mfg. Co., 173 F. R. 299, 1909; Sirocco Engineering Co. *v.* B. F. Sturtevant Co., 173 F. R. 378, 1909; Specialty Machine Co. *v.* Ashcroft Mfg. Co., 213 F. R. 35, 1914.

[17] Matthews *v.* Flower, 25 F. R. 834, 1885; Electrical Accumulator Co. *v.* New York & Harlem R. R. Co., 50 F. R. 82, 1892; Steiner & Voegtly Hardware Co. *v.* Tabor Sash Co., 178 F. R. 831, 1910. See Autopiano Co. *v.* American Player Action Co., 222 F. R. 276, 1915.

[18] Wilson *v.* Coon, 18 Blatch. 535, 1880; M'Dowell *v.* Ideal Concrete Machine Co., 187 F. R. 814, 1911.

[19] Wilson *v.* Coon, 18 Blatch. 536, 1880.

the latter means "lacking." A description may be complete, while it is obscure in some of its parts. In such a case, it is defective. On the other hand, it may be perfectly clear, as far as it goes, while omitting all references to some parts of the thing described. In such a case it is insufficient. So also, a claim may mistily cover the whole invention described, but being liable to be misunderstood, it is defective. On the other hand, it may be entirely clear, while it is narrower than the invention, and therefore insufficient to cover and secure the latter.

§ 218. From the foregoing it follows that, ever since 1836, those patents which were invalid or inoperative by reason of defective or insufficient descriptions or claims, have been reissuable under the statutes; provided their faults arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention. This proviso is equally imperative in all cases.[20] Assuming it to be satisfied in all, and passing the provisions relevant to reissues when the patentee has claimed too much, it appears that the remaining faults which make patents reissuable, under the statutes, are four in number: 1. Invalidity arising from defective description. 2. Invalidity arising from insufficient description. 3. Invalidity arising from defective claims. 4. Inoperativeness arising from insufficient claims.

§ 218*a*. Invalidity arising from defective description, or from insufficient description, or from defective claims, where that invalidity arose by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, may undoubtedly be remedied by a reissue, where the reissue does not add nor broaden any claim.[21] No

[20] Coon *v.* Wilson, 113 U. S. 277, 1884; Parker & Whipple Co. *v.* Yale Clock Co., 123 U. S. 103, 1887.

[21] Hart & Hegeman Mfg. Co. *v.* Anchor Electric Co., 92 F. R. 658, 1899.

reissue of this class has ever been held to be void, as a reissue, in any adjudicated case. Such reissues are indeed particularly consistent with the policy of the patent law, because they improve the information of an invention, which the public can derive from a patent, and thus increase the benefit which the public will enjoy on account of the patent after it shall have expired. There appears to be no reason why the remedy of reissue may not be invoked, in a case of this class, at any time during the life of a patent.[22]

§ 219. Claims are the only operative parts of specifications. If an inventor has produced two or more inventions so allied that they may properly be secured to him in one letters patent, and if he fully describes all of those inventions in the descriptive part of his specification, but covers only one of them by his claims, then his patent is operative as to one of those inventions, and inoperative as to the others. Inoperativeness of that kind is sufficient to lay the foundation of a right to a reissue.[23] And where an inventor claims his invention only in combination with something else, his patent is inoperative as to that invention alone.[24] Reissues granted in these classes of cases are called broadened reissues. Though the statute does not, under that name, authorize reissues of that kind, they are authorized by the general terms of the law;[25] and have been upheld by the Supreme Court in many

[22] Sewing Machine Co. *v.* Frame, 24 F. R. 596, 1884.

[23] Thompson *v.* Wooster, 114 U. S. 115, 1884; Anilin *v.* Higgin, 15 Blatch. 291, 1878; Wilson *v.* Coon, 18 Blatch. 535, 1880; Giant Powder Co. *v.* Nitro Powder Co., 19 F. R. 510, 1884; Fay *v.* Mason, 120 F. R. 510, 1903.

[24] Jenkins *v.* Stetson, 32 F. R. 400, 1887; Universal Caster & Foundry Co. *v.* M. B. Schenck Co., 165 F. R. 344, 1908.

[25] Miller *v.* Brass Co., 104 U. S. 354, 1881; A. D. Howe Machine Co. *v.* Coffield Motor Washer Co., 197 F. R. 541, 1912.

cases;[26] and have been expressly approved by that tribunal.[27]

§ 220. Inadvertence, accident or mistake, must have been the source of the fault in letters patent, in order to make them reissuable under the statute.[28] Such inadvertence or accident may have been suffered, or such mistake may have been committed, by the patentee or by the Commissioner of Patents.[29] The statute is satisfied on this point, where the patent was inoperative by reason of insufficient claims, if those claims were made too few or too narrow because the patentee was mistaken about the state of the art,[30] or because the patentee or his solicitor, when concerting the claims, inadvertently failed to make them as extensive as the invention.[31] So also, the statute is satisfied, where the patent was inoperative by reason of insufficient claims, if those claims were made too narrow because the Commissioner, on account of an erroneous opinion entertained by him, refused to allow them to be made as broad as they ought to have been,[32] or because of an erroneous decision made by him in an interference

[26] Battin *v.* Taggert, 17 Howard, 74, 1854; Morey *v.* Lockwood, 8 Wallace, 230, 1868; Rubber Co. *v.* Goodyear, 9 Wallace, 788, 1869; Corn-Planter Patent, 23 Waliace, 217, 1874; Marsh *v.* Seymour, 97 U. S. 356, 1877.

[27] Topliff *v.* Topliff, 145 U. S. 170, 1892.

[28] Revised Statutes, Section 4916; Fay *v.* Mason, 120 F. R. 510, 1903; Stafford Co. *v.* Coldwell-Gildard Co., 202 F. R. 744, 1913.

[29] Grant *v.* Raymond, 6 Peters, 218, 1832.

[30] National Spring Co. *v.* Mfg. Co., 12 Blatch. 89, 1874; Bowers *v.* San Francisco Bridge Co., 69 F. R. 644, 1895; Dunbar *v.* Eastern Elevating Co., 75 F. R. 570, 1896; Autopiano Co. *v.* American Player Action Co., 222 F. R. 276, 1915.

[31] Miller *v.* Brass Co., 104 U. S. 352, 1881. In connection with the subject-matter of this section see M'Dowell *v.* Ideal Concrete Machine Co., 187 F. R. 814, 1911.

[32] Morey *v.* Lockwood, 8 Wallace, 230, 1868.

proceeding.[33] But the statute is not satisfied where the applicant or his attorney cancels a rejected claim and afterward seeks to reclaim it by a reissue;[34] or to make a new claim which, though narrower than the rejected claim, is broader in the same direction than the claim in the patent;[35] even where the rejected claim was canceled from a prior application of the same inventor, and not from the particular application for the orginal of the reissue.[36] Nor is the statute satisfied in any case where the new claims of the reissue were intentionally omitted from the original patent,[37] or where a disclaimer is sought to be narrowed by means of a reissue,[38] nor where the claim was merely for the function of a machine to do what had previously been done by hand.[39]

§ 221. Many courts have recognized the fact that patents have been reissued by the Commissioner of Patents in some cases where there was no statutory ground therefor; that is to say, in some cases where the patents surrendered were neither invalid nor inoperative; or if invalid or inoperative, were not so by reason of a defective or insufficient specification; or if invalid or inoperative by reason of a defective or insufficient specification, were not so because of inadvertence, accident, or mistake. It is,

[33] American Shoe-tip Co. *v.* Protector Co., 2 Bann. & Ard. 551, 1877.

[34] Union Paper Bag Mach. Co. *v.* Waterbury, 39 F. R. 392, 1889; Moneyweight Scale Co. *v.* Toledo Computing Scale Co., 187 F. R. 826, 1911; Grand Rapids Show Case Co. *v.* Baker, 216 F. R. 341, 1914.

[35] Denton *v.* Commissioner of Patents, 83 O. G. 1347, 1898.

[36] Yale Lock Co. *v.* Berkshire Bank, 135 U. S. 379, 1890.

[37] Dobson *v.* Lees, 137 U. S. 265, 1890.

[38] Westinghouse Electric & Mfg. Co. *v.* Stanley Electric Mfg. Co., 115 F. R. 810, 1902; Franklin & Co. *v.* Illinois Moulding Co., 128 F. R. 48, 1904.

[39] Penn Electrical Mfg. Co. *v.* Conroy, 185 F. R. 511, 1911.

however, still an unsettled question, whether the decision of the Commissioner, that the existence of the statutory ground for a reissue exists when he grants a reissue, is conclusive; or is a subject of review and possible reversal in a suit for infringement of a reissue. It has been held in so far as the findings of the commissioner are based on disputed questions of fact they are not reviewable, "but in so far as they depend upon the legal interpretation and effect of admittedly genuine documents or other undisputed evidence, they are reviewable in court."[40] Another court states that it is proper to review the decision of the Patent Office as to matters apparent from the record,[41] which includes the question of sameness of invention if it so appears.[42] In the first two editions of this book, the then existing deliverances of the courts upon this subject, were marshalled and explained on the sides of the question which they respectively support; because in the years of those editions, the question was one of practical importance. But the decision of the Supreme Court in Miller *v.* Brass Co., which was made early in 1882, on another part of the law of reissues, operated so strongly to discourage patentees from surrendering their original patents and applying for reissues thereof, that only forty-two hundred reissues have been granted during the thirty-five years which have passed since then; though nearly one million original patents have been issued during that time. And the few hundred reissues which have not now expired, were granted with more circumspection than was formerly exercised in the Patent Office, in such

[40] General Electric Co. *v.* Richmond Street & Ry. Co., 178 F. R. 84, 1909.

[41] Grand Rapids Show Case Co. *v.* Baker, 216 F. R. 341, 1914; Wayne Mfg. Co. *v.* Coffield Motor Washer Co., 227 F. R. 987, 1915.

[42] Wayne Mfg. Co. *v.* Coffield Motor Washer Co., 227 F. R. 987, 1915.

cases; so that the question whether the courts have any authority to review the decision of the Commissioner of Patents, that some statutory ground exists therefor, when he grants a reissue, is a question of much diminished import. If any lawyers have occasion to argue, or any judges have occasion to decide, that question hereafter, they may consult the principal cases which support the negative,[43] and the principal cases which support the affirmative of the issue.[44]

[43] Philadelphia & Trenton Railroad Co. *v.* Stimpson, 14 Peters, 448, 1840; Stimpson *v.* Railroad Co., 4 Howard, 404, 1846; Seymour *v.* Osborne, 11 Wallace, 516, 1870; Collar Co. *v.* Van Dusen, 23 Wallace, 558, 1874; Ball *v.* Langles, 102 U. S. 129, 1880; Topliff *v.* Topliff, 145 U. S. 171, 1892; Smith *v.* Merriam, 6 F. R. 713, 1881; Selden *v.* Gas Burner Co., 9 F. R. 390, 1881; Peoria Target Co. *v.* Cleveland Target Co., 58 F. R. 239, 1893; Beach *v.* American Box Machine Co., 63 F. R. 603, 1894; American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 70 F. R. 991, 1895; Beach *v.* Hobbs, 82 F. R. 925, 1897; Justi *v.* Clark, 108 F. R. 667, 1901; Asbestos Shingle, etc., Co. *v.* H. W. Johns-Manville Co., 184 F. R. 620, 1910; John Kitchen, Jr., Co. *v.* Levison, 188 F. R. 658, 1911.

[44] Burr *v.* Duryee, 1 Wallace, 571, 1863; Rubber Co. *v.* Goodyear, 9 Wallace, 795, 1869; James *v.* Campbell, 104 U. S. 371, 1881; Mahn *v.* Harwood, 112 U. S. 359, 1884; Coon *v.* Wilson, 113 U. S. 277, 1884; Yale Lock Co. *v.* Berkshire Bank, 135 U. S. 378, 1890; Dobson *v.* Lees, 137 U. S. 265, 1890; Electric Gas Co. *v.* Boston Electric Co., 139 U. S. 502, 1891; Huber *v.* Nelson Mfg. Co., 148 U. S. 290, 1893; Olin *v.* Timken, 155 U. S. 148, 1894; Eby *v.* King, 158 U. S. 371, 1895; Whitely *v.* Swayne, 4 Fisher, 123, 1865; Wicks *v.* Stevens, 2 Bann. & Ard. 318, 1876; Odell *v.* Stout, 22 F. R. 161, 1885; Peoria Target Co. *v.* Cleveland Target Co., 47 F. R. 737, 1891; Featherstone *v.* Cycle Co., 57 F. R. 635, 1893; Idealite Co. *v.* Protection Light Co., 103 F. R. 973, 1900; Westinghouse Electric & Mfg. Co. *v.* Stanley Electric Mfg. Co., 115 F. R. 810, 1902; S. Franklin & Co. *v.* Illinois Moulding Co., 138 F. R. 58, 1905; McDowell *v.* Ideal Concrete Machine Co., 187 F. R. 814, 1911; Moneyweight Scale Co. *v.* Toledo Computing Scale Co., 187 F. R. 826, 1911.

§ 226. Miller *v.* Brass Co.[45] is a celebrated case, which introduced a new doctrine into the patent laws of the United States. That doctrine is precisely this. The right to obtain a broadened reissue, is lost by a lapse of some time, after the date of the original, and before the application for that reissue. If that doctrine has any prototype in any prior deliverance of any United States judge, that prototype must be found in a charge which Chief Justice TANEY delivered to a jury somewhat early in his judicial career.[46] In that case, the third paragraph of his Honor's instruction was as follows: "The plaintiff, at the time of his application for the patent of 1834, had a right to surrender the patent of 1829, and take out a corrected one, if the said patent was invalid, either by reason of the defective description of the improvement, or by reason of his having claimed as new, more than he was entitled to; provided, the error had arisen from inadvertence or mistake, and the plaintiff proceeded to correct it within a reasonable time after it was discovered." The last proviso of this instruction differs from the doctrine of Miller *v.* Brass Co., in that the latter makes the fatal lapse of time to begin at the date of the original patent, whereas the former makes it begin when the fault of the original patent is discovered. This difference is a substantial one; because reissuable faults in letters patent are often, and perhaps generally, of such a character that they can be detected only by persons learned in the patent law; and because a patentee may honestly keep his patent by him for years, without subjecting it to professional scrutiny. The doctrine of Miller *v.* Brass Co. must therefore find its foundation and genesis elsewhere than in the

[45] Miller *v.* Brass Co., 104 U. S. 350, 1882.

[46] Knight *v.* Railroad Co., Taney's Circuit Court Decisions, 107, 1840.

opinion of Chief Justice TANEY; and elsewhere than in any United States decision made and reported before that doctrine was promulgated in that case in January, 1882.

But that doctrine has been emphatically reaffirmed by the Supreme Court in the use of the following language: "We deem it proper to say, once for all, that the views announced in Miller *v.* Brass Co., on the subject of reissuing patents for the purpose of extending and enlarging the claim, were deliberately expressed and are still adhered to."[47]

The Supreme Court has also decided and announced that the rule in Miller *v.* Brass Co. is not qualified by any question relevant to the presence or absence of intervening rights of other inventors, accruing between the date of the original patent, and the date of the application for a reissue thereof;[48] for "it is not alone those persons who are shown to have taken action upon the faith that the patent defines the character of the invention who may raise the objection to a change in its claims which makes it cover other ground than that claimed before."[48a] And that court has also held that the operation of the rule is not ousted by the fact that the invention sought to be covered by a broadened reissue, had, during the preceding life of the original patent, been apparently, though erroneously, secured to the same patentee, in another patent.[49]

§ 227. The length to which delay must be drawn out, in order to lose the right to apply for a broadened reissue, cannot be fixed and laid down for all cases. Where the specification is complicated, and the claim is ambiguous

[47] Mahn *v.* Harwood, 112 U. S. 358, 1884.

[48] White *v.* Dunbar, 119 U. S. 52, 1886.

[48a] Milloy Electric Co. *v.* Thomson-Houston Electric Co., 148 F. R. 843, 1906.

[49] Hartshorn *v.* Barrel Co., 119 U. S. 674, 1886.

or involved, the patentee may be entitled to greater indulgence than he would be if the case were simpler or clearer; and the courts will always exercise a proper liberality on this point in favor of patentees.[50] In Miller *v.* Brass Co. itself, the delay continued for fifteen years. In three later Supreme Court cases, the delay was for fifteen, fourteen, and thirteen years, respectively.[51] In still later Supreme Court cases much shorter delays have been held to be fatal to broadened reissues;[52] and indeed, in one simple case where adverse rights had intervened, a delay of ninety-seven days was decided to have a fatal effect on such a reissue.[53] The general rule is that a delay for two years or more invalidates a broadened reissue, unless that delay is accounted for and excused by special circumstances.[54] What special circumstances will have that effect, cannot now be stated, because none such have yet been found by the Supreme Court to have that operation, and because one case in which a Circuit Court sustained so late a broadened reissue,[55] on account of such circumstances, was disapproved in the Supreme Court.[56] In a later case a delay of nearly three years was excused; because the inventor was in poor health, and at times mentally deranged, and once wholly insane, during the delay.[57]

[50] Mahn *v.* Harwood, 112 U. S. 361, 1884.

[51] Johnson *v.* Railroad Co., 105 U. S. 539, 1881; Mathews *v.* Machine Co., 105 U. S. 54, 1881; Bantz *v.* Frantz, 105 U. S. 160, 1881.

[52] Leggett *v.* Standard Oil Co., 149 U. S. 292, 1893; Dunham *v.* Dennison Mfg. Co., 154 U. S. 110, 1894.

[53] Coon *v.* Wilson, 113 U. S. 277, 1884.

[54] Wollensak *v.* Reiher, 115 U. S. 101, 1884; Hoskin *v.* Fisher, 125 U. S. 222, 1887; Topliff *v.* Topliff, 145 U. S. 171, 1892; Franklin & Co. *v.* Illinois Moulding Co., 128 F. R. 48, 1904.

[55] Hartshorn *v.* Roller Co., 18 F. R. 92, 1883.

[56] Hartshorn *v.* Barrel Co., 119 U. S. 674, 1886.

[57] Whitcomb *v.* Coal Co., 47 F. R. 658, 1891.

But the reception of erroneous advice from a solicitor of patents, not to apply for a particular reissue, is no excuse for waiting a long time, and then doing so.[58] A delay of less than two years is enough to defeat a broadened reissue in a plain case, even in the absence of intervening rights;[59] and in such a case, six months is probably as long a delay as can be excused,[60] though seven months' delay was excused in one peculiar case.[61]

A decision even on an appeal from an order granting or denying a preliminary injunction to the effect that two patents are for the same invention and that there is therefore a case of double patenting makes it urgent on the later patentee to take immediate steps to procure a reissue.[62]

§ 229. The statutory provision which makes a patent void, if the invention it covers was in public use or on sale more than two years before that patent was applied for, is a matter which does not apply to reissue patents, and the applications therefor.[63] The reissue application is considered as appended to the original application,[64] and the two years cease to run with the filing of the latter.

§ 230. A surrender of a patent, when made with an application for a reissue, need not be made in writing; and therefore the statement in a reissue that it is a reissue of a

[58] Wollensak *v.* Sargent, 151 U. S. 227, 1894.

[59] Farmers' Mfg. Co. *v.* Corn-Planter Co., 128 U. S. 506, 1888; New *v.* Warren, 22 O. G. 588, 1882; Haines *v.* Peck, 26 F. R. 625, 1884; Union Paper Bag Machine Co. *v.* Waterbury, 39 F. R. 391, 1891.

[60] McArthur *v.* Supply Co., 19 F. R. 263, 1884.

[61] Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 852, 1901.

[62] Thomson-Houston Electric Co. *v.* Western Electric Co., 158 F. R. 813, 1907.

[63] Shaw *v.* Lead Co., 11 F. R. 714, 1882.

[64] Grant *v.* Raymond, 6 Peters, 218, 1832.

surrendered former reissue, is not negatived by the production of a document purporting to be a surrender of the original patent, and apparently intended to have been a surrender of the former reissue.[65] The presumption that the proper patent was surrendered, by parol if not otherwise, is not negatived by proof of an ineffectual attempt to surrender it in writing.

§ 231. Patents surrendered prior to July 8, 1870, were thereby canceled in law, whether a reissue was granted thereon or not.[66] Patents surrendered since July 8, 1870, were also canceled thereby if reissues were granted thereon, but not otherwise.[67] But a surrendered patent cannot be enforced while the application for a reissue is pending.[68] After an application for a reissue has been rejected or withdrawn, the original patent stands unaffected by anything that occurred in the Patent Office while the application for the reissue was pending there.[69]

No damages or profits can ordinarily be recovered, for any infringement of a surrendered patent committed prior to its cancellation, by means of any judgment or decree entered after that time; but money recovered or voluntarily paid, on account of such infringement, prior to such cancellation, cannot be recovered back.[70] Nor will any such cancellation have any effect upon any unpaid judgment or decree which was entered before that cancellation took effect. The right of the patentee, in such

[65] Dental Vulcanite Co. *v.* Wetherbee, 2 Cliff. 563, 1866.

[66] Moffitt *v.* Garr, 1 Black, 273, 1861; Peck *v.* Collins, 103 U. S. 664, 1880.

[67] 16 Statutes at Large, Ch. 132, Section 53, p. 206; Revised Statutes, Section 4916; Allen *v.* Culp, 166 U. S. 505, 1897.

[68] Burrell *v.* Hackley, 35 F. R. 833, 1888; Coffield *v.* Fletcher Mfg. Co., 167 F. R. 321, 1909.

[69] McCormick Machine Co. *v.* Aultman, 169 U. S. 606, 1898.

[70] Moffitt *v.* Garr, 1 Black, 273, 1861; Eby *v.* King, 158 U. S. 373, 1895.

a case, rests upon his judgment or decree, and not on his patent.[71]

The only exception yet established, to what the last paragraph states is the ordinary rule relevant to profits and damages which accrued from the infringement of a surrendered patent before its cancellation, was established in a case where the defendant infringer was himself the patentee, and where the plaintiffs were his equitable grantees, as to that part of the territory of the United States, included within the boundaries of Connecticut and New York. In that case, the patentee infringed his grantees' rights, and afterward surrendered and reissued the patents involved. The Supreme Court decided that the defendant held his patents, all the time in trust for the plaintiffs, to the extent of their territory; and that he must therefore account to them for the profits which he had made from the use of the trust property, within that territory, regardless of the fact that he had surrendered and reissued those patents, after making a part of those profits.[72]

§ 232. A reissue patent may be surrendered and again reissued, under the same circumstances as those which make an original patent reissuable,[73] and the last reissue may be identical with the original patent.[74] So also, a patent might be reissued during its extended term, as well as during its first term, when, as formerly, extensions of patents were provided for by law.[75] No reissue can be

[71] Mevs *v.* Conover, 125 U. S. 144, 1876.

[72] Littlefield *v.* Perry, 21 Wallace, 205, 1874.

[73] French *v.* Rogers, 1 Fisher, 136, 1851; Selden *v.* Gas Burner Co., 9 F. R. 390, 1881.

[74] Giant Powder Co. *v.* Nitro Powder Co., 19 F. R. 510, 1884; Celluloid Mfg. Co. *v.* Zylonite Co., 27 F. R. 291, 1886; Sawyer Spindle Co. *v.* Eureka Spindle Co., 33 F. R. 836, 1888.

[75] Wilson *v.* Rousseau, 4 Howard, 646, 1846; Gibson *v.* Harris, 1 Blatch. 167, 1846.

granted of a patent after its final expiration; even where that expiration resulted from the fact that the same invention had been patented in a foreign country before it was patented in the United States; and from the fact that the foreign patent has expired, though the United States patent sought to be reissued, does not appear, on its face, to have done so.[76]

§ 233. Only "the same invention" can be covered by a reissued patent.[77] This quoted phrase occurs, in this relation, in all the relevant statutory provisions, now or heretofore in force in the United States. But not any of those statutes obviously indicates whether the phrase refers to whatever invention was made by the patentee, and actually described in his original application; or refers to whatever invention was substantially suggested, indicated or described in the patentee's original letters patent, drawing or model; or refers to whatever invention was described or indicated in the original letters patent or drawing of the patentee; or refers to whatever invention was described by him in his original letters patent; or refers to whatever invention was actually claimed by the inventor in his original patent; or refers to whatever invention was described in the original letters patent, and appears therein to have been intended to be secured thereby. During many years, debate ranged in the courts around these various constructions; and large masses of *obiter dicta* and some actual adjudications can be collected out of the books, in favor of each

[76] C. W. Simons' Appeal, 11 O. G. 1107, 1877.

[77] Patent Act of 1832, Section 3; Patent Act of 1836, Section 13; Patent Act of 1870, Section 53; Revised Statutes, Section 4916; M'Dowell *v.* Ideal Concrete Machine Co. (discussing question and citing authorities), 187 F. R. 814, 1911; Stafford Co. *v.* Coldwell-Gildard Co., 202 F. R. 744, 1913.

of them. But the Supreme Court put a period to the controversy in the case of the Parker & Whipple Co. *v.* the Yale Clock Co. decided in 1887.[78] That decision adopted the last of the above stated constructions, and thus established the meaning of the phrase "the same invention" to be whatever invention was described in the original letters patent, and appears therein to have been intended to be secured thereby. This rule has already been repeatedly reaffirmed and reapplied by the Supreme Court,[79] and is now as well established as its companion rule in Miller *v.* Brass Co. Therefore no reissue claim can stand any longer upon a model alone, nor even alone upon a drawing of an original patent;[80] and indeed neither models, drawings, nor descriptions, nor all of them together, can support a reissue claim, except where the description in the original letters patent shows that the invention covered by that claim was intended to be secured in the original.[81]

§ 239. The last clause of Section 4916 of the Revised Statutes provides, that "where 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

[78] Parker & Whipple Co. *v.* Yale Clock Co., 123 U. S. 99, 1887.

[79] Hoskin *v.* Fisher, 125 U. S. 223, 1887; Flower *v.* Detroit, 127 U. S. 571, 1887; Pattee Plow Co. *v.* Kingman & Co., 129 U. S. 294, 1889; Freeman *v.* Asmus, 145 U. S. 240, 1895; Corbin Cabinet Lock Co. *v.* Eagle Lock Co., 150 U. S. 42, 1893.

[80] Hailes *v.* Stove Co., 123 U. S. 587, 1887.

[81] Carpenter Machine Co. *v.* Searle, 52 F. R. 814, 1892; Ide *v.* Trorlicht, Duncker & Renard Carpet Co., 115 F. R. 147, 1902; United States Whip Co. *v.* Hassler, 134 F. R. 398, 1905; Weston Electrical, etc., Co. *v.* Stevens, 134 F. R. 574, 1904; Stafford Co. *v.* Coldwell-Gildard Co., 202 F. R. 744, 1913; Marvel Buckle Co. *v.* Alma Mfg. Co., 180 F. R. 1002, 1910.

omitted from the specification by inadvertence, accident, or mistake." The meaning of that clause is not perfectly known; but it is known not to enlarge the power of the Commissioner, in reference to the invention for which a reissue may be granted.[82]

§ 240. The provision, first enacted in 1870,[83] that "no new matter shall be introduced into the specification" is merely another way of saying that a reissued patent shall be for the same invention as the original.[84] That provision, therefore, neither enlarged nor restricted the reissuability of letters patent; and, accordingly, it is not new matter, within its meaning, to state a new use of the invention shown in the original;[85] nor to explain, in a reissue, the operation of a device which in the original was only described;[86] nor to vary the description of anything described in the original.[87]

§ 242. Reissued patents, which were granted on the surrender of former reissues, must be able to endure comparison, on the point of identity of invention, not only with the original letters patent, but also with the surrendered reissues, which preceded them.[88]

§ 243. There is a legal presumption that the necessary identity of invention exists in all reissued patents; and that presumption controls the point, unless the contrary is shown to be true.[89] That can be done

[82] Powder Co. *v.* Powder Works, 98 U. S. 128, 1878.

[83] 16 Statutes at Large, Ch. 230, Section 53, p. 206.

[84] Powder Co. *v.* Powder Works, 98 U. S. 138, 1878.

[85] Broadnax *v.* Transit Co., 5 Bann. & Ard. 611, 1880.

[86] Putnam *v.* Yerrington, 2 Bann. & Ard. 243, 1876; Potter *v.* Stewart, 18 Blatch. 561, 1881.

[87] O'Reilly *v.* Morse, 15 Howard, 62, 1853.

[88] Knight *v.* Railroad Co., Taney's Circuit Court Decisions, 106, 1840.

[89] O'Reilly *v.* Morse, 15 Howard, 62, 1853; Klein *v.* Russell, 19 Wallace, 433, 1873.

only by introducing the original letters patent in evidence.[90]

§ 244. To omit from a reissue, anything which the original specification stated to be essential to the invention, is fatal to identity of invention.[91] Indeed, it has been held in one case that the omission of one bolt from a reissue patent for a reaper and mower, was enough to negative identity with the original, because, with the bolt, the machine was a reaper only, and not a mower.[92] A process is not the same invention as a machine which may perform that process;[93] and a process consisting of one stage is not the same as a process consisting of that stage and one or more others.[94] Where, however, an original patent described and claimed several different inventions, one or more of those inventions may be omitted from the claims of a reissue of that patent.[95] It is necessary to the requisite identity of invention, that the reissue should claim no invention not described and intended to be claimed in the original; but it is not necessary to that identity, that the original should describe or claim no invention not described or claimed in the reissue.

§ 245. A sub-combination may be claimed in a reissue, if it was shown in the original as performing the same function; even though it was claimed in the original only as a part of a larger combination.[96] But a sub-combina-

[90] Seymour *v.* Osborne, 11 Wallace, 516, 1870.

[91] Gill *v.* Wells, 22 Wallace, 1, 1874; Russell *v.* Dodge, 93 U. S. 460, 1876; Atwood *v.* Portland Co., 10 F. R. 286, 1880.

[92] Kirby *v.* Mfg. Co., 10 Blatch. 307, 1872.

[93] Eachus *v.* Broomall, 115 U. S. 436, 1885.

[94] Wood-Paper Patent, 23 Wallace, 599, 1874.

[95] Rubber Co. *v.* Goodyear, 9 Wallace, 788, 1869.

[96] Battin *v.* Taggert, 17 Howard, 74, 1854; Corn-Planter Patent, 23 Wallace, 181, 1874; Jordan *v.* Dobson, 4 Fisher, 232, 1870; Pearl *v.* Ocean Mills, 2 Bann. & Ard. 469, 1877; Herring *v.* Nelson, 3 Bann.

tion cannot be legally claimed in a reissue, if it is there shown to perform a substantially different function from any which it could perform in its original environment.[97] In the former case, the invention, consisting of the sub-combination, existed in the original specification. In the latter case, the sub-combination may have existed in the original, but it did not compose, in that place, the same invention which it constitutes in the reissue.

§ 246. A single device may also be made the subject of a separate claim in a reissue, though in the original it was claimed only in combination with other devices; provided that device was a new and useful invention of the patentee, and might have been separately claimed by him in the original patent, and appears therein to have been intended to be secured thereby.[98]

§ 247. Whether a patentee, in effecting a reissue, may describe an equivalent of one of the elements of the originally patented combination, and may claim the combination broadly enough to cover that equivalent, is a question which depends upon the effect, in particular cases, of the application of the rule in Miller *v.* Brass Co. Where such a reissue is applied for promptly after the granting of the original patent, it may be sustained;[99] but the right to obtain such a reissue, is lost by long lapse of time after the date of the original, and before the application for that reissue.[100]

& Ard. 55, 1877; Kerosene Lamp Heater Co. *v.* Littell, 3 Bann. & Ard. 312, 1878; Turrell *v.* Spaeth, 3 Bann. & Ard. 461, 1878; Odell *v.* Stout, 22 F. R. 163, 1884; Jenkins *v.* Stetson, 32 F. R. 398, 1887.

[97] Gill *v.* Wells, 22 Wallace, 24, 1874; Johnson *v.* Railroad Co., 105 U. S. 539, 1881.

[98] Parker & Whipple Co. *v.* Yale Clock Co., 123 U. S. 87, 1887; Gallahue *v.* Butterfield, 10 Blatch. 237, 1872.

[99] McArthur *v.* Supply Co., 19 F. R. 263, 1884.

[100] White *v.* Dunbar, 119 U. S. 51, 1886.

§ 248. Reissue patents are not to be held void for want of identity with the originals, where a liberal construction of the two documents can avert that result.[101] Courts are accordingly inclined, where claims apparently illegal are inserted in reissue patents, to modify those claims by construction, in order to make them conform to propriety.[102] This inclination is not, however, to be relied upon, in a case where a patent was surrendered and reissued solely to broaden its claim, and where the broadened claim is void for want of novelty, as well as for want of identity with the original invention.[103] The claims of the reissued patent will be given the due effect intended and expressed in the proceeding.[104]

§ 249. Where some, but not all, of the claims of a reissue patent are void because they are obnoxious to the doctrine of Miller *v.* Brass Co., or because they are not for the same invention as the original; that fact does not vitiate the other claims of that patent. The reissue will, in either of those cases, have whatever validity it would have had if it had not contained the invalid claims, provided there is no unreasonable delay to file a proper disclaimer of them.[105]

§ 250. Executors, administrators, or assigns have the

[101] Milligan & Higgins Glue Co. *v.* Upton, 1 Bann. & Ard. 505, 1874.

[102] Mfg. Co. *v.* Ladd, 102 U. S. 412, 1880; Brainard *v.* Cramme, 12 F. R. 624, 1882.

[103] Wisner *v.* Grant, 7 F. R. 922, 1880.

[104] Thomson-Houston Electric Co. *v.* Black River Traction Co., 135 F. R. 759, 1905.

[105] Gage *v.* Herring, 107 U. S. 640, 1882; Gould *v.* Spicer, 15 F. R. 344, 1882; Cote *v.* Moffitt, 15 F. R. 345, 1882; Schillinger *v.* Brewing Co., 24 O. G. 495, 1883; National Pump Cylinder Co. *v.* Gunnison, 17 F. R. 812, 1883; Havemeyer *v.* Randall, 21 F. R. 405, 1884; International Terra Cotta Co. *v.* Maurer, 44 F. R. 622, 1890; Rawson & Morrison Mfg. Co. *v.* C. W. Hunt Co., 147 F. R. 239, 1906.

same right to surrender and reissue a patent, that the patentee himself has; [106] except that the application must be made, and the new specification be signed, by the inventor himself if living,[107] and sane.[108] The title to the reissued patent will, in such a case, vest at once in the assignee, by operation of the assignment of the original patent, and without the execution of any new document.[109]

§ 251. Where several executors are appointed in a will, but only one of them receives letters testamentary, a patent of the testator may be lawfully reissued to that executor, and the legal title to the reissued patent will thereupon vest exclusively in him.[110] A grant of a reissue to a person as administrator, is conclusive evidence in an infringement suit that the person was in fact administrator; [111] and the same rule doubtless applies as well to executors. A reissue to a person in trust for the heirs at law of the patentee, will confer the legal title to the reissue upon that person, and the equitable title upon the persons beneficially interested, whoever they may be.[112]

§ 252. An assignee of a patent is a person to whom the entire legal interest, or an undivided part of the entire legal interest, in a patent has been duly assigned by an instrument in writing. A grantee differs from an assignee

[106] Revised Statutes, Section 4916.

[107] Revised Statutes, Section 4895.

[108] Whitcomb *v.* Coal Co., 47 F. R. 659, 1891.

[109] Woodworth *v.* Hall, 1 Woodbury & Minot, 248, 389, 1846; McBurney *v.* Goodyear, 11 Cushing (Mass.), 569, 1853.

[110] Rubber Co. *v.* Goodyear, 9 Wallace, 788, 1869.

[111] Woodworth *v.* Hall, 1 Woodbury & Minot, 248, 389, 1846; Goodyear *v.* Hullihen, 3 Fisher, 251, 1867.

[112] Woodworth *v.* Stone, 3 Story, 752, 1845; Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co., 1 Bann. & Ard. 177, 1874.

in that the rights conveyed to him are confined to a part or to parts of the territory of the United States. A licensee is one who receives either an exclusive or a concurrent right to make or to use or to sell the thing covered by the patent.[113] A reissue may be granted to an assignee of the executor or administrator of the patentee;[114] or to an assignee of an assignee;[115] or indeed to an assignee of any degree, however far removed from the original patentee by mesne assignments;[116] and if the reissued patent recites those assignments, it becomes at least *prima facie* evidence thereof, in an infringement suit.[117] If a patent is owned jointly by two or more patentees, or by two or more assignees, or by one or more patentees and one or more assignees, all the owners must join in a reissue, or must ratify it, or it will be void; but neither grantees nor licensees are required to do either.[118] The right of a patentee or assignee to receive a reissue is not affected by his having made grants, or issued licenses under his patent;[119] but where a patentee grants away his rights in a part of the territory of the United States, and afterward conveys the residue to another vendee, it is doubtful whether that vendee is entitled to apply for a reissue.[120]

§ 253. Grantees may continue to hold their rights under an original patent after it is surrendered and re-

[113] Sections 274, 287, and 296 of this book.

[114] Carew *v.* Fabric Co., 1 Holmes, 45, 1871.

[115] Swift *v.* Whisen, 2 Bond, 115, 1867.

[116] Selden *v.* Gas Burner Co., 9 F. R. 390, 1881.

[117] Middletown Tool Co. *v.* Judd, 3 Fisher, 141, 1868; Hoffheins *v.* Brandt, 3 Fisher, 218, 1867.

[118] Potter *v.* Holland, 4 Blatch. 206, 1858; Forbes *v.* Stove Co., 2 Cliff. 379, 1864; Meyer *v.* Bailey, 2 Bann. & Ard. 73, 1875.

[119] Smith *v.* Mercer, 3 Penn. L. J. Reports, 529, 1846.

[120] Commissioner of Patents *v.* Whiteley, 4 Wallace, 522, 1866.

issued by the patentee or assignee; or they may take corresponding rights under the reissued patent. They have their choice between the two.[121] It follows from this rule, that in theory at least, a given invention may be the subject of letters patent in one part of the United States, at the same time that it is free to the public in other parts of the country. If this were a practical result, it would be highly unjust, because it would operate to prohibit given manufactures in one State, while in another State the same pursuits would be free to all. In fact, however, patentees or assignees seldom surrender any claims which it is worth while for any interested person to retain; and, on the other hand, grantees are generally ready to ratify and adopt broadened reissues. It may hereafter happen, that in order to retain his rights of action for accrued damages or profits, or in order to avoid the risk of exchanging a valid original patent for a reissue patent of uncertain validity, now and then a grantee will elect to continue to hold under the original, while the patentee holds under a reissue patent. If such cases become numerous and important, they will probably lead to a change in the statute. The remedy would be to enact that, in such cases, all the assignees and grantees must join in the surrender, in order to authorize a reissue.

§ 254. The legal effect of a valid reissue patent has always been the same under the different statutes which have, from time to time, been in force. The provision of the Revised Statutes upon the subject is as follows: "Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter aris-

[121] Washburn *v.* Gould, 3 Story, 122, 1844; Woodworth *v.* Stone, 3 Story, 749, 1856; Potter *v.* Holland, 4 Blatch. 206, 1858.

ing, as if the same had been originally filed in such corrected form." [122]

It follows from this provision, that a reissued patent cannot be affected, in point of novelty, by anything done after the date of the original application. Novelty still dates from the original invention.[123] Nor will any invention produced after that time, be taken into account as showing the state of the art, and therefore as being relevant to the question of construction of a reissued patent.[124] On the other hand, when reissued patents are introduced in evidence to negative the novelty or limit the scope of other patents, they operate as of their own dates, and not as of the dates of the originals.[125]

It also follows from said statutory law, that persons who use or sell, after the date of a reissued patent, specimens of the thing covered by it, are liable as infringers; even though those persons made or bought, or used those specimens before that date, and when, on account of the omission to cover them by the original patent, they had a legal right to appropriate the invention.[126]

[122] Revised Statutes, Section 4916.

[123] Grant *v.* Raymond, 6 Peters, 218, 1832.

[124] Carroll *v.* Morse, 9 O. G. 453, 1876.

[125] United States Stamping Co. *v.* King, 17 Blatch. 64, 1879.

[126] Stimpson *v.* Railroad Co., 4 Howard, 380, 1846; Agawam Co. *v.* Jordan, 7 Wallace, 609, 1868; Carr *v.* Rice, 1 Fisher, 211, 1856; Bliss *v.* Brooklyn, 8 Blatch. 534, 1871; Coffield Motor Washer Co. *v.* A. D. Howe Co., 172 F. R. 668, 1909.

CHAPTER X

EXTENSIONS

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§ 255. THE constitutional provision relevant to the duration of patent rights, is that such rights, when granted, shall be granted for limited times.[1] The Patent Act of 1790 [2] provided, that under the circumstances and conditions prescribed therein, the Secretary of State, and the

[1] Constitution of the United States, Article I, Section 8.

[2] 1 Statutes at Large, Ch. 7, Section 1, p. 109.

Secretary of War, and the Attorney General, or any two of them, might issue letters patent for an invention, for any term not exceeding fourteen years. The same provision was made in the Patent Act of 1793.[3] Under that law, patents were generally, if not universally, granted for the full fourteen years; but whether so granted or not, there was, prior to 1832, no mention in the statutes of any way in which any patent, once granted, could be extended, and its duration thus prolonged. In July of the last-mentioned year, it was enacted: "That application to Congress to prolong or renew the term of a patent, shall be made before its expiration." [4] The same section also provided a method of proceeding, to be followed by applicants in such cases. The entire section was, however, merely a self-imposed limitation on a constitutional power of Congress; and it was repealed by the Patent Act of July 4, 1836.[5] Since that date, the extending of patents by Congress, has been regulated by no other law than the Constitution.

§ 256. Patents may be extended by Congress at any time, either before or after their expiration.[6] This power was exercised as early as 1808.[7] In one later case such an extension was granted nearly three years before the then existing exclusive right was to expire;[8] and in another, more than twenty-one years intervened between the expiration of the original term of the patent, and the granting of the extension.[9] Congressional extensions, when

[3] 1 Statutes at Large, Ch. 11, Section 1, p. 321.

[4] 4 Statutes at Large, Ch. 162, Section 2, p. 559.

[5] 5 Statutes at Large, Ch. 357, Section 21, p. 125.

[6] Bloomer *v.* Stolley, 5 McLean, 161, 1850; Jordan *v.* Dobson, 2 Abbott, 407, 1870; The Fire Extinguisher Case, 21 F. R. 42, 1884.

[7] Evans *v.* Jordan, 9 Cranch, 199, 1815.

[8] Bloomer *v.* McQuewan, 14 Howard, 539, 1852.

[9] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868.

granted, are usually granted for the term of seven years; but they may lawfully be granted for any limited length of time, whether longer or shorter than that.

§ 257. Some special acts, for the extension of patents, merely extend their duration by a simple legislative edict, and do no more.[10] Others instruct the Commissioner of Patents to ascertain the truth relevant to sundry questions of fact mentioned therein; and authorize him to decide whether in view of those facts, and of sundry considerations of justice and of public policy, the patent ought to be extended; and direct him to extend it, if his decision is in the affirmative.[11] When patents are extended in this latter method, those provisions of the special act which limit the operation of the extension, need not be recited in the certificate of extension, which the Commissioner indorses upon the patent or otherwise puts forth. The law reads the certificate in the light of that statute, without any such recital.[12]

§ 258. Special Acts of Congress granting or authorizing extensions of patents, come within the general rule, that the validity of a statute cannot be questioned in courts, on any allegation that its passage was procured by fraud or bribery.[13] Such Acts are considered as engrafted on the general patents laws, and are to be construed in connection with them.[14] Although the Constitution authorizes Congress to grant exclusive rights in inventions only to inventors, Congress may provide, when exercising its power in

[10] Bloomer *v.* McQuewan, 14 Howard, 539, 1852; Woodworth *v.* Edwards, 3 Woodbury & Minot, 123, 1847.

[11] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868.

[12] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868.

[13] Gibson *v.* Gifford, 1 Blatch. 529, 1850.

[14] Bloomer *v.* McQuewan, 14 Howard, 539, 1852; Jordan *v.* Dobson, 2 Abbott, 408, 1870.

particular cases, that assignees of the inventors shall have the same rights under the extended term, that they had under the original term of the patent extended.[15]

§ 259. Patent Office extensions of patents, were first authorized by the Patent Act of July 4, 1836.[16] By the Patent Act of March 3, 1861, they were prohibited, as to all patents thereafter granted.[17] The last extension of the kind, was granted in 1875, and expired in 1882. But Congress is now being asked, by a number of able and influential patent lawyers, to enact a general statute, authorizing the Commissioner of Patents or some other tribunal, to extend such patents as may be found, on judicial investigation, to be ethically entitled thereto. For this reason, and because many of the rules and doctrines of law, which were established in suits for infringements of Patent Office extensions, are equally applicable to suits based on Congressional extensions, it is expedient to explain those rules and doctrines in this book.

§ 260. The Patent Act of 1836 provided[18] that, whenever any patentee of an invention should desire an extension of his patent, he might make application therefor in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and that the Commissioner should thereupon, and on the payment of a specified fee, cause to be published a notice of the application, and of the time and place when and where the same would be considered. The Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, were constituted a board to hear and decide upon the evidence

[15] Blanchard's Gun-Stock Turning Factory *v.* Warner, 1 Blatch. 259, 1848.

[16] 5 Statutes at Large, Ch. 357, Section 18, p. 124.

[17] 12 Statutes at Large, Ch. 88, Section 16, p. 249.

[18] 5 Statutes at Large, Ch. 357, Section 18, p. 124.

produced before them, both for and against the extension. If, upon such hearing in any particular case, it appeared to the board, having a due regard to the public interest, that it was 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 upon its introduction into public use; the statute made it the duty of the Commissioner to 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. The statute also provided that no such extension should be granted after the expiration of the term for which it was originally issued; and that when so extended, a patent should have the same effect in law as though it had been originally granted for the term of twenty-one years; and that the benefit of such renewal should extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.

The Patent Act of 1848[19] amended the above provisions by vesting the power of the board, in the Commissioner of Patents alone; and by directing him to take into consideration the original patentability and novelty of the inventions covered by patents sought to be extended, as well as to be governed by the rules and principles that had theretofore governed the board.

No other change was ever made in the statute relevant to the subject, until in 1861 it was repealed as to future patents. As to patents granted before March 2, 1861, it was re-enacted in the Patent Act of 1870,[20] and again

[19] 9 Statutes at Large, Ch. 47, Section 1, p. 231.

[20] 16 Statutes at Large, Ch. 230, Sections 63 to 67, p. 208.

re-enacted in the Revised Statutes.[21] In both these re-enactments, one provision is found, which did not exist in the former law, namely, the provision that the application should be filed not more than six months nor less than ninety days before the expiration of the original term of the patent.

§ 261. All the statutes which provided for extensions of patents, specified "patentees" as being persons entitled to apply for extensions, and mentioned no others. When the first of those statutes was enacted in 1836, nobody but an inventor or his executor or administrator, could be a patentee. In 1837, however, Congress enacted, that any patent thereafter issued, might be made and issued to the assignee or assignees of the inventor.[22] In all subsequent cases, where that course was pursued, the inventors and the patentees were not the same persons; but no corresponding change was ever made in the statutes relevant to extensions. The question has therefore arisen, whether, in such cases, it was the inventor who had a right to apply for an extension, or whether the patentee was the person who had that right, or whether both the inventor and the patentee must have joined in such an application. Where the inventor would have an equitable interest in the extension if granted, it was proper for him to apply for that extension alone.[23] When granted, the legal title to such an extension would vest in the patentee, because such an extension was in the nature of an amendment of his patent; but the equitable title might vest wholly in the inventor, or vest partly in the inventor and partly in the patentee, or vest partly in the inventor and

[21] Revised Statutes, Sections 4924 to 4928.

[22] 5 Statutes at Large, Ch. 45, Section 6, p. 193.

[23] Sayles *v.* Dubuque & Sioux City Railroad Co., 5 Dillon, 220, 1878.

partly in third persons, according to the equitable facts of each case. When the inventor would have no equitable interest in the extension if granted, no extension could be obtained, either on his application, or on that of the patentee, or on that of both together; because it was not the intention or scope of the statute to grant extensions of patents for the sole benefit of others than the inventors of the things secured thereby.[24]

Whether the executor or administrator of an inventor-patentee, had a right to apply for an extension, was the first of the ten questions which were submitted to the Supreme Court in the celebrated case of Wilson *v.* Rousseau. That question was argued in the affirmative by Webster, Seward, and Latrobe, and decided in the affirmative by the court.[25]

Where a joint patent was taken out by joint inventors, all had to join in an application for an extension of that patent, if all were living; and if any were dead, the legal representatives of the deceased had to unite in such an application.[26]

§ 262. No Patent Office extension was ever grantable after the expiration of the original term.[27] Such extensions could be granted at any time before the midnight at the end of the last day of that term; because fourteen-year patents did not expire till the last hour of the fourteenth anniversary of the day of their respective dates.[28] Patents limited in law to the term of fourteen years from the date of earlier foreign patents, were extendible, at the

[24] Wilson *v.* Turner, Taney's Circuit Court Decisions, 292, 1845.

[25] Wilson *v.* Rousseau, 4 Howard, 673, 1846.

[26] Wickersham's Case, 4 O. G. 155, 1873.

[27] Act of 1836, Section 18; Act of 1870, Section 63; Revised Statutes, Section 4924.

[28] Johnson *v.* McCullough, 4 Fisher, 170, 1870.

discretion of the Commissioner of Patents, as well as those not so limited;[29] but in such a case the extension had to be granted before the expiration of the foreign patent, even though the extended patent purported on its face to run for some time longer.[30]

§ 263. Whether an inventor-patentee needed to possess any interest in the first term of his patent at the time of applying for an extension thereof, was the fifth question submitted to the Supreme Court in the case of Wilson *v.* Rousseau.[31] That question was decided in the negative. Even where the assignee of the first term of a patent surrendered and reissued it, the inventor-patentee had a right to ignore the reissue, and to apply for and receive an extension of the original patent.[32]

§ 264. It was against the policy of the law, if not against its letter, to extend any patent, in the extension of which, if granted, the inventor would have no property right. The right to an extension was given by the law, chiefly with a view to the advantage of the inventor, and not of his assignee or grantee.[33] It never was necessary, however, that the inventor should be in a condition to receive the legal title to the extension, or even that the entire equitable estate in it should belong to him. An interest in the proceeds of the exclusive right during the extended term, was enough to satisfy the policy of the law in this respect.[34] Even where the original patent was granted to an assignee, and where the extension was, therefore,

[29] Tilghman *v.* Mitchell, 9 Blatch. 27, 1871.

[30] New American File Co. *v.* Nicholson File Co., 8 F. R. 816, 1881.

[31] Wilson *v.* Rousseau, 4 Howard, 673, 1846.

[32] Potter *v.* Braunsdorf, 7 Blatch. 97, 1869; Crompton *v.* Belknap Mills, 3 Fisher, 536, 1869.

[33] Wilson *v.* Turner, Taney's Circuit Court Decisions, 292, 1845.

[34] Gear *v.* Grosvenor, 1 Holmes, 215, 1873.

in point of legal title, a prolongation of his patent, the extension was held to be valid, because the inventors had interests in its proceeds.[35] Moreover, inventors were presumed in law to have had a sufficient interest to support extensions actually granted, unless the contrary was proved to have been the fact.[36]

§ 265. The certificate of extension, which was provided for by the statute,[37] was generally indorsed on the original parchment letters patent; but where the original document was lost or was out of the control of the person applying for the extension, that certificate was indorsed upon a certified copy of the letters patent and was equally valid.[38]

§ 266. Jurisdiction to extend a particular patent, was acquired by the Commissioner, under the statutes in force prior to July 8, 1870, whenever the proper person filed an application for such an extension, and paid the requisite fee; [39] provided the application was filed, and the fee paid, long enough before the expiration of the original term of the patent, to enable the Commissioner to investigate the matter in the way prescribed by statute.[40] After July 8, 1870, the law remained the same on this point, except that under the statute of that date, and under the Revised Statutes, the application had to be filed not more than six months, nor less than ninety days before the first term of the patent would expire.[41] The jurisdiction always depended, therefore, upon the application being filed and the fee paid by the proper person at the proper

[35] Sayles *v.* Dubuque & Sioux City Railroad Co., 5 Dillon, 220, 1878.

[36] Ruggles *v.* Eddy, 10 Blatch. 56, 1872.

[37] Patent Act of 1836, Section 18.

[38] Potter *v.* Braunsdorf, 7 Blatch. 108, 1869.

[39] Gear *v.* Grosvenor, 1 Holmes, 218, 1873.

[40] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868.

[41] 16 Statutes at Large, Ch. 230, Section 63, p. 208; Revised Statutes, Section 4924.

time. The decision of the Commissioner, relevant to the existence of his jurisdiction, was never conclusive in any case.[42] The validity of a Patent Office extension, was therefore open to inquiry in an infringement suit, when it was questioned on the theory that the person who applied for it, was not such a person as had the legal right to do so. In deciding that question, however, the courts regarded with respect the practical construction of the statute, which was necessarily involved in the granting of the extension.[43] Indeed the Supreme Court has held that the practical construction given to a statute, by the executive branch of the government charged with its execution, is entitled to great weight, when the true meaning of that statute is drawn into judicial inquiry.[44]

§ 267. The meritorious facts which entitled an inventor-patentee to a Patent Office extension were that, without fault or neglect on his part, he had failed to obtain from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and upon its introduction into public use.[45] Unlike the foundation facts which entitle a patentee to a reissue, these points were not required by the statute to exist absolutely. The statutory provision was that they should appear to the satisfaction of the Commissioner of Patents. It was therefore immaterial whether the courts were satisfied of their existence or not. The fact that a particular extension was granted, showed that the Commissioner was satisfied of the existence of those facts in that case; and evidence that they did not in fact exist,

[42] Wilson *v.* Rousseau, 4 Howard, 687, 1846.

[43] Brooks *v.* Bicknell, 3 McLean, 250, 1843.

[44] Grant *v.* Raymond, 6 Peters, 244, 1832.

[45] Patent Act of 1836, Section 18; Patent Act of 1870, Section 66; Revised Statutes, Section 4927.

was therefore inadmissible in a suit for infringement of the patent during that extension.[46]

§ 268. The statute made it the duty of the Commissioner to advertise all applications for extensions, and to refer such cases to the principal examiner having in charge the class of inventions to which the patent sought to be extended belonged, and having received the report of the examiner, to hear and decide each particular case at the time and place designated in the advertisement. All these provisions were *directory*, and *none* of them were jurisdictional. The validity of no extension could therefore be affected by proof, in an infringement suit, that some or all of those acts were omitted by the Commissioner, or were irregularly performed.[47]

§ 269. No fraud, practiced upon or by the Commissioner, relevant to securing or granting an extension, could ever become the subject of inquiry in any suit for infringement. The decision of the Commissioner, in granting an extension, did not, however, foreclose all inquiry into allegations of fraud, as it did into allegations of inadvertence, error, or ministerial irregularity. The law was not so absurd as to make a man's own decision that he had committed no fraud, and suffered none to be committed upon him, a conclusive adjudication of that point. But charges so grave were thought to deserve a special proceeding for their investigation. They were not to be bandied about as collateral makeweights in infringement suits. When investigated, they had to be investigated in a special proceeding brought to repeal the grant of the extension.[48]

[46] Clum *v.* Brewer, 2 Curtis, 506, 1855; Jordan *v.* Dobson, 2 Abbott, 408, 1870.

[47] Brooks *v.* Jenkins, 3 McLean, 435, 1844; Colt *v.* Young, 2 Blatch. 473, 1852; Tilghman *v.* Mitchell, 9 Blatch. 27, 1871.

[48] Rubber Co. *v.* Goodyear, 9

§ 270. "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." [49] This enactment, in almost precisely the same words, was always found in statutes providing for extensions of patents.[50] The purport of this law was never learned from its perusal.

The duty of ascribing a definite meaning to the enactment, devolved upon the courts. But the clause was so ambiguous that the judges could not agree in its construction. The provision was enacted in 1836, but it was still a subject of controversy in the Supreme Court, more than thirty-seven years later. When more than forty years had passed after its enactment, a text-writer collated the adjudicated cases, and stated the full adjudicated meaning of the statutory language. That meaning was then found to be as follows.

§ 271. Every person who, at the beginning of any extended term of any patent, had a right to use a particular specimen of any thing covered by that patent, had the same right to use that specimen during that extended term, unless his right was expressly limited so as not to include that term; and if such a person was the owner of such a specimen, he might sell it to be used by others during that extension.[51]

Wallace, 796, 1869; Mowry *v.* Whitney, 14 Wallace, 434, 1871.

[49] Revised Statutes, Section 4928.

[50] Patent Act of 1836, Section 18; Patent Act of 1870, Section 67.

[51] Wilson *v.* Rousseau, 4 Howard, 677, 1846; Bloomer *v.* McQuewan, 14 Howard, 539, 1852; Chaffee *v.* Belting Co., 22 Howard, 217, 1859; Bloomer *v.* Millinger, 1 Wallace, 340, 1863; Mitchell *v.* Hawley, 16 Wallace, 544, 1872; Eunson *v.* Dodge, 18 Wallace, 414, 1873; Paper-Bag Cases, 105 U. S. 766, 1881; Woodworth *v.* Curtis, 2 Woodbury & Minot, 524, 1847; Goodyear *v.* Rubber Co., 1 Cliff. 349, 1859; Wooster *v.* Sidenberg, 13 Blatch.

The limitations expressed in this rule are not to be overlooked. 1. It applied only to persons whose right to use existed at the beginning of the extension. It was therefore possible for patentees to avoid the rule altogether, by making their licenses expire one day before the end of the existing terms of their respective patents. 2. The rule conferred no right upon any person on account of his having had a right to make or sell specimens of the patented thing. 3. The rule did not apply to any patent for a process.[52] 4. The rule conferred no right under an extension, that did not exist under the former term. Accordingly, if the former right was subject to a royalty, the right under the extension was subject to the same royalty.[53] 5. The rule conferred no right to make or use or sell any new specimen of the patented thing;[54] though it did confer a right to repair the articles to which it applied.[55] 6. The rule did not apply where the right to use, when granted by the patentee, was expressly limited to the existing term of the patent.[56] The right provided by the rule was a property right; and the specimens to which it referred, and the right to use those specimens, might be transferred by sale, devise, or assignment in insolvency.[57]

88, 1875; Black *v.* Hubbard, 3 Bann. & Ard. 39, 1877.

[52] Wetherell *v.* Zinc Co., 6 Fisher, 50, 1872.

[53] Union Mfg. Co. *v.* Lounsbury, 41 New York, 363, 1869.

[54] Hodge *v.* Railroad Co., 6 Blatch. 165, 1868; Wood *v.* Railroad Co., 2 Bissell, 62, 1868.

[55] Wilson *v.* Simpson, 9 Howard, 109, 1850; Aiken *v.* Print Works, 2 Cliff. 435, 1865; Farrington *v.* Detroit, 4 Fisher, 216, 1870.

[56] Mitchell *v.* Hawley, 16 Wallace, 544, 1872.

[57] Woodworth *v.* Curtis, 2 Woodbury & Minot, 524, 1847.

CHAPTER XI

TITLE

272. The nature of titles, and the methods of their acquisition.
273. Title by occupancy.
274. Title by assignment.
274*a*. Special tenures and incomplete estates.
275. Characteristics, authentication, and effect of assignments.
276. Consideration for assignments.
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281. Recording and notice.
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290. Title by bankruptcy.
291. Title by death.
292. Tenancy in common.
294. Rights of tenants in common as against each other.
295. Partition, and removal of clouds.

§ 272. TITLES to patent rights are capable of two independent classifications. One relates to the nature of title, and the other relates to the methods by which title may be acquired. In the first of these aspects, titles are divisible into those which are purely legal, those which are purely equitable, and those which are both legal and equitable. In the second aspect, they are divisible into those: 1. By occupancy. 2. By assignment. 3. By grant. 4. By creditor's bill. 5. By bankruptcy. 6. By death. Titles which are both legal and equitable may be

acquired in either of these methods. Titles which are purely equitable may be acquired by either, except the first; and those which are purely legal may be transferred by either, except the first, fourth and fifth. It is the plan of this chapter to treat the subject of title under this six-fold division; and, in general, to treat it with a view to title which is both legal and equitable, and is therefore complete; but also, to incorporate into that treatment such statements as may show the relations which purely legal and purely equitable titles bear to each other and to the law, and to conclude the whole with a discussion of such points as relate to patents owned contemporaneously by a plurality of persons.

§ 273. Title by occupancy is that title to a patent which any person may acquire by inventing any new and useful process, machine, manufacture, composition of matter or design, and by applying for and obtaining a patent thereon. During the time between the day of invention and the date of letters patent therefor, that title is inchoate.[1] Such an inchoate right may be assigned; and an assignment thereof will convey the legal title to the letters patent, as soon as the letters patent are granted;[2] whether or not the assignment requests the Commissioner of Patents to issue the letters patent to the assignee.[3] This rule applies not only to cases where the assignments are recorded before the granting of the patents,[4] but also to cases where, though executed before, they are not recorded till after that event.[5] So also, it applies to cases

[1] Gayler *v.* Wilder, 10 Howard, 493, 1850; Hendrie *v.* Sayles, 98 U. S. 551, 1878.

[2] See Section 274.

[3] Harrison *v.* Morton, 83 Md. 477, 1896.

[4] Consolidated Electric Light Co. *v.* Edison Electric Light Co., 25 F. R. 719, 1885.

[5] United States Stamping Co. *v.* Jewett, 7 F. R. 869, 1880.

where applications are divided after they are assigned,[6] and to cases where the assignments are executed after the applications for patents are rejected, and before those rejections are reversed.[7] The inchoate right to a Patent Office extension of a patent, when such a right was provided by law,[8] was also a proper subject of assignment, even while it remained inchoate;[9] and such an assignment also operated to convey the legal title to such an extension, whenever such an extension was granted by the Commissioner of Patents.[10] An assignment of an inchoate title to a patent, which does not request the Commissioner to issue the letters patent to the assignee, will convey not only the equitable title but also the legal title thereto, as soon as the letters patent are granted.[11]

The title by occupancy, which an inventor acquires when he invents, is not affected by the fact that he is at the time in the employ of another;[12] for persons employed, as much as employers, are entitled to their own independent inventions.[13] The original title of a patentee to a patent issued to him, is presumed to continue till he is shown to have parted with it;[14] and the grantee named in a reissue patent is presumed to be the lawful owner of that patent until he is shown not to have owned the patent which he surrendered in order to obtain that reissue, or

[6] Puetz *v.* Bransford, 31 F. R. 461, 1887.

[7] Gay *v.* Cornell, 1 Blatch. 510, 1849.

[8] From July 4, 1836, to March 2, 1875.

[9] Nicholson Pavement Co. *v.* Jenkins, 14 Wallace, 456, 1871.

[10] Railroad Co. *v.* Trimble, 10 Wallace, 380, 1870.

[11] See Section 274.

[12] Hapgood *v.* Hewitt, 119 U. S. 226, 1886; Solomons *v.* United States, 137 U. S. 346, 1890; Dalzell *v.* Dueber Mfg. Co., 149 U. S. 320, 1893.

[13] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868.

[14] Fischer *v.* Neil, 6 F. R. 89, 1881.

is shown to have parted with the title to the reissue after that date.[15]

§ 274. An assignment of a patent is an instrument in writing, which, in the eye of the law, purports to convey the entire title to that patent, or to convey an undivided share in that entire title.[16] An assignment may purport to convey the ownership of the patent, or an undivided share of that ownership, or it may purport to convey the exclusive right, or an undivided share thereof, to make, use and sell the invention throughout the United States. Such a document, in the latter form, is as truly an assignment, as is a document which employs the other phraseology.[17] And an assignment in either form, is not less an assignment because it is coupled with a license back to the assignor.[18]

There has been some doubt as to whether an assignment of a pending application without a request to the Commissioner of Patents that the patent issue in the name of the assignee conveyed more than the equitable title to the patent. It now appears to be settled that such an assignment carries with it the whole interest, legal and equitable.[19]

Assignments of legal titles to patents must be in writing,

[15] Washburn & Moen Mfg. Co. *v.* Haish, 4 F. R. 900, 1880.

[16] Gayler *v.* Wilder, 10 Howard, 477, 1850; Waterman *v.* Mackenzie, 138 U. S. 255, 1891; Pope Mfg. Co. *v.* G. & J. Mfg. Co., 144 U. S. 249, 1892.

[17] Rapp *v.* Kelling, 41 F. R. 792, 1890; Johnson Signal Co. *v.* Union Signal Co., 59 F. R. 23, 1893; Paulus *v.* M. M. Buck Mfg. Co., 129 F. R. 594, 1904.

[18] Pope Mfg. Co. *v.* Clark, 46 F. R. 792, 1891; Russell *v.* Kern, 58 F. R. 384, 1892; Sirocco Engineering *v.* Monarch Ventilator Co., 184 F. R. 84, 1910; Lock Joint Pipe Co. *v.* Melber, 234 F. R. 319, 1916.

[19] Wende *v.* Horine, 191 F. R. 620, 1911; Hildreth *v.* Auerbach, 200 F. R. 972, 1912; Individual Drinking Cup Co. *v.* Osmun-Cook Co. (reviewing authorities on both sides of the question), 220 F. R. 335, 1915.

because the statute provides no other method of effecting such an assignment;[20] and because, since patent rights are creatures of statutes and not of common law, the transfer of the legal title thereto cannot be regulated by the rules of the latter system.[21] An equitable title may be created by parol,[22] and may be transferred by the same method.[23] But a recital in a writing that a particular person is an owner with the subscriber of a patent granted to the latter, is not even an equitable assignment.[24] Persons who issue signed assignments in blank, are estopped from denying the propriety of the filling, when the filled assignments are invoked by purchasers for valuable considerations, who had no notice of any fraud or error in the filling.[25]

§ 274*a*. Titles conveyed by assignments are usually unconditional, but they may also be held upon special tenures. One instance of such a tenure is presented where the assignment contains a condition that the assignee shall pay a specified royalty to the assignor during the life of the patent assigned,[26] and shall make enough of the patented articles to supply the demand therefor;[27] or shall sell the patent and pay the proceeds to the assignor

[20] Revised Statutes, Section 4898; Jewett *v.* Atwood Suspender Co., 100 F. R. 648, 1900.

[21] Gayler *v.* Wilder, 10 Howard, 498, 1850; Atherton Mach. Co. *v.* Atwood-Morrison Co., 102 F. R. 949, 1900.

[22] Dalzell *v.* Dueber Mfg. Co., 149 U. S. 320, 1893; Whiting *v.* Graves, 3 Bann. & Ard. 225, 1878; Cook *v.* Sterling Electric Co., 118 F. R. 47, 1902; Prest-O-Lite Co. *v.* Avery Portable Lighting Co., 164 F. R. 60, 1908.

[23] Whitney *v.* Burr, 115 Ill. 293, 1885; Burr *v.* De La Vergne, 102 N. Y. 422, 1886; Searle *v.* Hill, 73 Iowa, 367, 1887; Jones *v.* Reynolds, 120 N. Y. 215, 1890; Schmitt *v.* Nelson Valve Co., 125 F. R. 754, 1903.

[24] Kearney *v.* Railroad Co., 27 F. R. 701, 1886.

[25] National Heeling-Mach. Co. *v.* Abbott, 70 F. R. 56, 1895.

[26] Littlefield *v.* Perry, 21 Wallace, 220, 1874; Boesch *v.* Graff, 133 U. S. 701, 1890.

[27] Dow *v.* Harkin, 67 N. H. 383, 1892.

or to others for his benefit;[28] or shall not make any assignment of the patent, or license under it.[29] Where a title is to be held upon such a special tenure, the condition of that tenure should be stated in the assignment conveying the title; but the tenure may be expressed, and the condition be defined, in a separate unrecorded paper, with equal effect upon the parties, to the assignment;[30] though not with any effect upon purchasers from the assignee, who never had any notice of the special tenure, or of the condition upon which it was established. The burden of proving non-compliance with such a condition, rests upon him who asserts it;[31] but where non-compliance is proved, and no intervening rights are involved, the title reverts to the assignor by operation of law.[32]

Where an assignment conveys a title to a patent, to be held permanently, upon condition of the payment of certain notes given for the purchase thereof, it is said that the non-payment of the notes will cause the title to revert to the assignor, but the reversion of the title will not discharge the notes.[33]

Other estates than a complete one, may be created in patents by assignments. An estate for years and an estate in remainder are examples of these.[34] But a paper giving an unassignable exclusive right for a term of years, and limited to less than the entire rights of the patent, is only a license.[35]

[28] Jonathan Mills Mfg. Co. *v.* Whitehurst, 56 F. R. 594, 1893.

[29] Platt *v.* Fire Extinguisher Co., 59 F. R. 901, 1894.

[30] Pierpoint Boiler Co. *v.* Penn Iron & Coal Co., 75 F. R. 292, 1896.

[31] De Beaumont *v.* Williames, 71 F. R. 812, 1896.

[32] Pierpoint Boiler Co. *v.* Penn Iron & Coal Co., 75 F. R. 293, 1896.

[33] Ockington *v.* Law, 66 Maine, 551, 1877; but see Section 276.

[34] Solomons *v.* United States, 21 Court of Claims, 481, 1886.

[35] Moore Mfg. & Foundry Co.

§ 275. The patent assigned ought to be described in the assignment by its number and date, and by the name of the patentee, and by the name of the invention which it purports to cover; but an assignment will be valid though it is lacking or erroneous in one or more of these particulars, if the description which it contains excludes doubt as to the patent intended to be conveyed,[36] as for example of all the property of the assignor "including good will, patents, trade marks," etc., even though such an assignment could not be recorded.[37] An assignment of an invention or patent for a machine will not convey any patent for a process, in the performance of which that machine finds its only utility.[38]

An assignment by a natural person requires no other authentication than the assignor's signature; and where such an assignment is executed by an attorney in fact, it must be executed in the name of the assignor, and cannot lawfully be executed by the attorney in his own name.[39] Where a power of attorney provides that assignments made under it, must be approved by the giver of the power; an assignment made without any such approval is void.[40] Though an assignment is fully executed by the signature of the assignor; its subsequent proof is facilitated by a certificate of acknowledgment, made by a notary public or other magistrate, under the statute of 1897; for such a

v. Cronk Hanger Co., 69 F. R. 999, 1895.

[36] Case *v.* Morey, 1 New Hampshire, 349, 1818; Holden *v.* Curtis, 2 New Hampshire, 63, 1819; Harmon *v.* Bird, 22 Wendell (N. Y.), 113, 1839; Hill *v.* Thuermer, 13 Indiana, 351, 1859; Aeolian Co. *v.* Hallet & Davis Piano Co., 134 F. R. 872, 1905.

[37] Delaware Seamless Tube Co. *v.* Shelby Steel Tube Co., 160 F. R. 928, 1908.

[38] Downton *v.* Mfg. Co., 9 F. R. 402, 1879; Downton *v.* Allis, 9 F. R. 771, 1881.

[39] Machesney *v.* Brown, 29 F. R. 145, 1886.

[40] Chauche *v.* Pare, 75 F. R. 285, 1896.

certificate is *prima facie* evidence of the genuineness, and of the execution, of the assignment to which it is attached or otherwise made applicable.[41] The designation of the assignee in an assignment, is sufficient where the person intended can be identified, even where evidence outside of the assignment is required for that purpose.[42]

A patent may be assigned to a partnership, by the partnership name, even where that name is artificial, and does not contain the name of any partner;[43] and a patent may likewise be assigned, in the partnership name, by the partnership to which it has belonged.

An assignment by a corporation needs not to be authenticated by its corporate seal, but is properly executed, if executed in the name and by the authority of the corporation, and by a proper officer, who signs for the corporation, and signs as an officer thereof.[44] An assignment to a corporation confers no title upon any stockholder therein;[45] and an assignment to a corporation, which is not organized till after the date of the assignment, will, at least by way of estoppel, inure to its benefit when organized, and will be good as against the assignor.[46]

A married woman, an infant, or a person under guardianship may be the assignee of an invention or of a patent. Such persons may also assign their inventions or patents by complying, not only with the United States law which requires assignments of patents to be in writing, but also with those laws of their particular States which

[41] 29 Statutes at Large, p. 693, Ch. 391, Section 5.

[42] Fisk, Clark & Flagg *v.* Hollander, MacArthur & Mackay, 360, 1883.

[43] Fresno Home-Packing Co. *v.* Fruit-Cleaning Co., 101 F. R. 826, 1900.

[44] Gottfried *v.* Miller, 104 U. S. 527, 1881.

[45] Gottfried *v.* Miller, 104 U. S. 528, 1881.

[46] Dyer *v.* Rich, 1 Metcalf (Mass.), 180, 1840.

govern analogous acts of such persons, in respect of other personal property.[47]

§ 276. An assignment for which the consideration was never paid, and which was never acted upon by either of the parties thereto, conveys no title to the assignee;[48] but no assignment, which has been acted upon by the parties thereto, can be revoked on the ground of a partial failure to pay the promised price.[49] And total failure to pay any consideration for an assignment, does not derogate from the rights of those who take title under it, without any notice of that failure.[50] Where no rights have accrued to any third party under an unrecorded assignment, the assignee may restore the title to the assignor, by burning the assignment up, or otherwise completely destroying it, for the avowed purpose of its cancellation.[51]

§ 276*a*. The consideration of the validity or invalidity, under the anti-trust laws, of price and use restrictions on patented articles and processes is taken up in another part of this book.[52] There is, however, a large class of contracts consisting generally of those that seek to impose upon an inventor an obligation to assign to another certain or all inventions which he may make, that have received the attention of courts of equity with reference to the common-law principle governing the validity of contracts in restraint of trade, and also with reference to the equitable defence to suits for specific performance of unconscionableness of the contract sought to be enforced. It may be safely stated that any contract which broadly

[47] Fetter *v.* Newhall, 17 F. R. 343, 1883.

[48] Railroad Co. *v.* Trimble, 10 Wallace, 380, 1870; Buck *v.* Timony, 78 F. R. 488, 1897.

[49] Hartshorn *v.* Day, 19 Howard, 222, 1856; Mackaye *v.* Mallory, 12 F. R. 328, 1882.

[50] Piaget Novelty Co. *v.* Headley, 108 F. R. 870, 1901.

[51] Winfrey *v.* Gallatin, 72 Mo. App. 191, 1897.

[52] See Sections 315 *et seq.*

obligates an inventor to assign without further consideration than the mere payment of money or the transfer of property to the inventor, all inventions which he may make during his lifetime, is invalid.[53] It may be gathered from the cases, however, that broadly speaking, if the purpose intended and effected by the contract is the protection of the other's business from advantages that have or may be gained by the inventor from his relations with the other, the contract is not void.[54] It is not necessary that there be a grant from the inventor, as for instance the assignment of a patent or a business.[55]

In *Hulse* v. *Bonsack Mach. Co.*[56] the court said:

"We have seen the reason for the adoption of this form of contract by the company. It was to protect it from improvements discovered by its own servants, under its pay, in cigarette machines. The company lets them into an intimate knowledge of its cigarette machines, affords them the opportunity of discovering any needed improvements in them, gives them at hand the means of testing any improvements which may suggest themselves. Naturally it seeks to protect itself from an abuse of these results. The protection sought is a fair one for the interests of the company. . . . In the most recent cases the validity of contracts in partial restraint of trade is tested, not by any inflexible rule, but by their reasonableness

[53] Littlefield *v.* Perry, 21 Wallace, 205, 226, 1874; Westinghouse Air Brake Co. *v.* Chicago Brake Mfg. Co., 85 F. R. 786, 1898.

[54] Littlefield *v.* Perry, 21 Wallace, 205, 226, 1874; Hulse *v.* Bonsack Mach. Co. (and cases cited), 65 F. R. 864, 1895; Fairchild *v.* Dement, 154 F. R. 200, 1908; A. B. Dick Co. *v.* Fuller, 198 F. R. 404, 1912; Thompson *v.* Automatic Fire Protector Co., 211 F. R. 120, 1914.

[55] Lion Tractor Co. *v.* Bull Tractor Co., 231 F. R. 156, 1916.

[56] Hulse *v.* Bonsack Mach. Co., 65 F. R. 864, 1895.

when considered in connection with the protection necessary for the particular business and the modern methods of conducting the enterprise."

In line with the general principle stated, a contract by an inventor to assign all inventions already made by him as well as all future inventions which he may make for an indefinite period relating to the same subject-matter, is valid.[57] If the assignee has acquired or is to acquire the prior invention it is proper for him to protect himself against the acquisition by his rivals of improvements. And so a contract of employment which provides that the employee shall assign to the employer all inventions made during the term of the employment which relate to specified articles manufactured by the employer, is valid.[58] And the contract will be enforced with respect to an invention which relates both to the specified articles and other articles, but only so far as it concerns the specified articles.[59] A contract to assign inventions to a corporation formed or to be formed by the inventor and others for the purpose of carrying on a business to which the inventions specified relate, is valid and will be specifically enforced.[60] The assignment of a patent by an agreement which provides for the assignment of all future improvements thereon to be made by the patentee is valid, for without the improvements the value of the basic patent might be wholly destroyed.[61] An interest of the inventor in the future profits of a corporation or partnership is

[57] Reece Folding Machine Co. *v.* Fenwick, 140 F. R. 287, 1905; A. B. Dick Co. *v.* Fuller, 198 F. R. 404, 1912.

[58] Lion Tractor Co. *v.* Bull Tractor Co., 231 F. R. 156, 1916.

[59] Wright *v.* Vocalion Organ Co., 148 F. R. 209, 1906.

[60] Davis & Roesch Temperature, etc. Co. *v.* Tagliabue, 148 F. R. 705, 1906; Fairchild *v.* Dement, 164 F. R. 200, 1908.

[61] Westinghouse Air Brake Co. *v.* Chicago Air Brake & Mfg. Co., 85 F. R. 786, 1898.

also sufficient to sustain the validity of such a contract.[62]

In *A. B. Dick Co.* v. *Fuller*[63] it was urged that the contract of assignment of future inventions was invalid because it covered all inventions relating to the subject-matter of certain patents assigned and was not confined to improvements. The court, however, held that if the contract were construed as confined to such inventions, improvements or otherwise, as bore some relation to the processes already assigned, the contract was valid and stated that the same reasoning which would sustain the validity of a contract to assign future improvements would apply to such a contract as the one in question, namely, that the future inventions, while they might not be improvements, would nevertheless form a possible basis for hostile competition. Indeed it would seem that the reason was all the more forcible in the case of such a contract. The ownership by a stranger of the improvement could not be the basis of hostile competition during the life of the basic patent, but could only prevent the use of the improvement by the owner of the basic patent. A patented invention for a similar purpose as that of the basic patent but not in the nature of an improvement could be utilized with perfect freedom by one acquiring it and thus be a source of competition to the owner of the basic patent. It should be noted that in the A. B. Dick Co. case above referred to the court considered the validity of a contract to assign all inventions affecting inventions or improvements in any article made by the assignee, but as the question was not involved did not pass upon it.

§ 277. Rights of action for past infringements of a patent are not conveyed by any mere assignment of that

[62] Aspinwall Mfg. Co. *v.* Gill, 32 F. R. 697, 1887.

[63] A. B. Dick Co. *v.* Fuller, 198 F. R. 404, 1912.

patent;[64] but they may be conveyed by any assignment which purports to convey them, whether that document purports also to convey the patent,[65] or purports to convey the rights of action alone.[66]

§ 278. The construction of assignments depends primarily upon the meaning of all the language in which they are composed, rather than upon that of any particular words they contain;[67] and if that language is clear in the eye of the law, its effect cannot be varied by any parol evidence;[68] but if that language is ambiguous, it may be construed in the light of certain classes of parol proof. The parties will never be permitted to testify what they intended to signify by the language they used, because if they were, assignors might narrow, and assignees might widen, the scope of the rights conveyed, by simply making oath to alleged former states of their own minds. Perjury could seldom be detected in such a case, and such a rule would put property at the mercy of avarice. Nor is any evidence admissible which merely shows that one of the parties to an assignment made such declarations, or did such acts, in pursuance of that assignment, as indicate that he understood the document in a sense most favorable to himself. If such evidence were admissible, the honest mistake of an assignor, in construing his contract, would often deprive an assignee of rights which he had honestly bought; and the honest mistake of an assignee would often

[64] Moore *v.* Marsh, 7 Wallace, 515, 1868; May *v.* County of Juneau, 30 F. R. 245, 1887; Koalatype Co. *v.* Hoke, 30 F. R. 444, 1887; May *v.* County of Saginaw, 32 F. R. 629, 1888; Superior Drill Co. *v.* Ney Mfg. Co., 98 F. R. 734, 1899.

[65] Hamilton *v.* Rollins, 3 Bann. & Ard. 160, 1877; Jones *v.* Berger, 58 F. R. 1007, 1893.

[66] Hayward *v.* Andrews, 12 F. R. 786, 1882.

[67] Washburn *v.* Gould, 3 Story, 122, 1844.

[68] Railroad Co. *v.* Trimble, 10 Wallace, 367, 1870; Ralya *v.* Atkins, 157 Ind. 336, 1901.

deprive an assignor of rights which he never had sold. But parol evidence is admissible to construe an ambiguous assignment, if that evidence shows the existence of such collateral documents, or surrounding circumstances, attending the execution of that assignment, as throw light upon the meaning of its words;[69] or show that both parties to that assignment, practically construed it, after its execution, and in so doing construed it alike.[70] If ambiguities still remain in an assignment, after all other recognized methods of solving them have been employed, they are to be solved against the grantor, in a suit between him and the grantee, or their respective privies, as he is supposed to have written the document, and therefore to be chargeable with the obscurity;[71] but as between the grantee or his privies, and strangers to the assignment, ambiguities in such cases are solved against the grantee.[72]

§ 279. Reformation of an assignment may be had by means of a bill in equity filed for that purpose, if that assignment does not conform to the mutual intention of the parties to its execution; but neither party can secure such reformation on proof of what his intention was, unless he also proves that the intention of the other party was the same.[73] But no reformation of an assignment can affect the right of any innocent purchaser, for a valua-

[69] Read *v.* Bowman, 2 Wallace, 591, 1864; Phelps *v.* Classen, 1 Woolworth, 212, 1868; Wetherill *v.* Zinc Co., 6 Fisher, 50, 1872; Lowry *v.* Cowles Co., 56 F. R. 492, 1893, and 68 F. R. 366, 1895.

[70] Topliff *v.* Topliff, 122 U. S. 131, 1886; Wilcoxen *v.* Bowles, 1 Louisiana An'l, 230, 1846; Parrott *v.* Wikoff, 1 Louisiana An'l, 232, 1846; Coleman *v.* Grubb, 23 Penn. St. 409, 1854; Levy *v.* Dattlebaum, 63 F. R. 994, 1894.

[71] Smith *v.* Selden, 1 Blatch. 475, 1849; May *v.* Chaffee, 2 Dillon, 385, 1871; Falley *v.* Giles, 29 Indiana, 114, 1867; Keith *v.* Engineering Co., 136 Cal. 181, 1902.

[72] Levy *v.* Dattlebaum, 63 F. R. 994, 1894.

[73] Downton *v.* Allis, 9 F. R. 771, 1881.

ble consideration, who had no notice, at the time of his purchase, that the mutual intention of the parties was different from the assignment which passed between them.[74] Where several patents are sold, but one of them is omitted by mistake from the assignment which was intended to convey them all; the assignee has an equitable right to have the assignment reformed, so as to convey the omitted patent, and that equitable right is transferable from him, in the same ways in which other equitable rights in patents may be transferred.[75]

§ 280. No extension of a patent is conveyed by an assignment of the first term thereof.[76] Nor is any extension, which is not provided for by the general law when an assignment is made, covered by the word "renewal" in such an assignment. In such a case, that word is held to mean "reissue" and not to mean "extension."[77] But if, at the time such an assignment is made, the patent statutes do provide for extensions of patents of the class to which the assigned patent belongs, then the word "renewal" is a sufficient word to convey such an extension.[78] An assignment of an invention, without limitation or qualification, will convey, not only the original term, but also any Patent Office extension, of the patent granted for that invention.[79] Whether such an assignment will convey any Congressional extension is an undecided point. An affirmative decision upon it will not necessarily follow the rule in Hendrie *v.* Sayles, but it is not improbable

[74] Gibson *v.* Cook, 2 Blatch. 149, 1850; Woodworth *v.* Cook, 2 Blatch. 151, 1850.

[75] Newton *v.* Buck, 77 F. R. 614, 1896.

[76] Wilson *v.* Rousseau, 4 Howard, 646, 1846.

[77] Wilson *v.* Rousseau, 4 Howard, 646, 1846.

[78] Pitts *v.* Hall, 3 Blatch. 201, 1854; Goodyear *v.* Cary, 4 Blatch. 303, 1859; Chase *v.* Walker, 3 Fisher, 122, 1866.

[79] Hendrie *v.* Sayles, 98 U. S. 554, 1878.

that the courts will take the step required to pass from the one doctrine to the other, whenever the question arises.

§ 281. Recording in the Patent Office, within three months after its date, is necessary to the validity of an assignment or grant of a patent as against any subsequent purchaser or mortgagee, for a valuable consideration, without notice.[80] This statutory provision operates to give constructive notice to subsequent purchasers and mortgagees, of the assignments which are duly recorded thereunder; but it does not apply to any assignment executed prior to the granting of letters patent, unless that assignment is one upon which a patent is to be issued to the assignee, and also identifies with certainty the invention conveyed thereby.[81] Nor is an instrument which does not purport to convey any existing interest in any patent or application an "assignment, grant or conveyance" within the meaning of the statute, and consequently the recording of such an instrument does not operate as constructive notice to subsequent purchasers of the legal title.[82] But where an assignment conveys a patent, and also conveys all improvements that the assignor may thereafter make on the invention claimed therein, the due recording of that assignment operates to give constructive notice of the sale of that patent, and, it has been held, of the sale of those improvements.[83] The correctness of the proposition that such an assignment is constructive

[80] Revised Statutes, Section 4898.

[81] Wright *v.* Randel, 8 F. R. 599, 1881; New York Paper Bag Co. *v.* Union Paper Bag Co., 32 F. R. 788, 1887.

[82] National Cash Register Co. *v.* New Columbus Watch Co., 129 F. R. 114, 1904.

[83] Aspinwall Mfg. Co. *v.* Gill, 32 F. R. 701, 1887; Westinghouse Air-Brake Co. *v.* Chicago Brake & Mfg. Co., 85 F. R. 792, 1898. See Davis & Roesch, etc., Co. *v.* Tagliabue, 150 F. R. 372, 1906.

notice of the sale of improvements which may thereafter be made is somewhat doubtful.[84] The provision of Section 4898 of the Revised Statutes, relevant to recording assignments of patents, does not apply to those conveyances, by operation of law, of the patents and patent rights of bankrupts, to trustees in bankruptcy, which are provided for by the bankrupt law of 1898;[85] any more than it did to the corresponding conveyances, which were provided for by the bankrupt law in the Revised Statutes.[86] Neither does that provision apply to any assignment which conveyed accrued rights of action only.[87] In such a case, the assignee, in order to protect his right, should give the infringer notice of the assignment; so that if the infringer afterward pays the assignor, or pays some subsequent assignee, for that right of action, he will do so at his peril, and will not discharge his liability to the first assignee.[88] Recording an assignment of a patent is not necessary to its validity, as between the parties to that assignment;[89] nor as against an infringer of the patent;[90]

[84] Eastern Dynamite Co. *v.* Keystone Powder Mfg. Co., 164 F. R. 47, 1908.

[85] 30 Statutes at Large, p. 565, Ch. 541, Section 70. See Bankruptcy Act of 1910, Section 8, 36 Statutes, 838.

[86] Prime *v.* Mfg. Co., 16 Blatch. 456, 1879.

[87] Gear *v.* Fitch, 3 Bann. & Ard. 573, 1878.

[88] Woodbridge *v.* Perkins, 3 Day (Connecticut), 364, 1809; Vanbuskirk *v.* Hartford Fire Insurance Co., 14 Connecticut, 144, 1841; Campbell *v.* Day, 16 Vermont, 558, 1844; Clodfelter *v.* Cox, 1 Sneed (Tenn.), 330, 1853; Loomis *v.* Loomis, 26 Vermont, 198, 1854; Murdock *v.* Finney, 21 Missouri, 138, 1855; McWilliams *v.* Webb, 32 Iowa, 577, 1871.

[89] Holden *v.* Curtis, 2 New Hampshire, 61, 1819; Case *v.* Redfield, 4 McLean, 527, 1849; Black *v.* Stone, 33 Alabama, 327, 1858; Moore *v.* Bare, 11 Iowa, 198, 1860; Turnbull *v.* Plow Co., 6 Bissell, 229, 1874.

[90] Brooks *v.* Byam, 2 Story, 525, 1843; Pitts *v.* Whitman, 2 Story, 609, 1843; Boyd *v.* M'Alpin, 3 McLean, 427, 1844; Case *v.* Redfield, 4 McLean, 526, 1849; McKernan

nor as against an innocent purchaser for a valuable consideration without notice, who takes his assignment within three months after the date of the prior unrecorded assignment;[91] nor as against any subsequent purchaser who had actual notice thereof, when purchasing;[92] nor as against any subsequent purchaser who paid no valuable consideration for the assignment which he took.[93] A merely good consideration will, therefore, not support an assignment as against any prior unrecorded assignment of the same patent, given for a valuable consideration.

The notice which will protect a prior unrecorded assignment, against a subsequent assignment for a valuable consideration, may be actual, or it may be constructive only. Such constructive notice may be based on any fact within the knowledge, or means of knowledge, of the purchaser of the unrecorded assignment, and which fact should logically lead him, upon inquiry, to a knowledge of the existence and purport of that assignment itself.[94] For example, such constructive notice may be based on any statement of fact of that kind, which is in any paper in the chain of title through which the subsequent assignee derives his own claim.[95] And such constructive notice may be based on the fact that the subsequent assignee was informed, at the time of his purchase, that the prior assignee was making, using, or selling specimens of the

v. Hite, 6 Indiana, 428, 1855; Sone *v.* Palmer, 28 Missouri, 539, 1859.

[91] Gibson *v.* Cook, 2 Blatch. 144, 1850.

[92] Peck *v.* Bacon, 18 Connecticut, 377, 1847; Continental Windmill Co. *v.* Empire Windmill Co., 8 Blatch. 295, 1871; Ashcroft *v.* Walworth, 1 Holmes, 152, 1872.

[93] Saxton *v.* Aultman, 15 Ohio State, 471, 1864.

[94] Westinghouse Air-Brake Co. *v.* Chicago Brake & Mfg. Co., 85 F. R. 796, 1898.

[95] Jonathan Mills Mfg. Co. *v.* Whitehurst, 72 F. R. 501, 1896.

invention covered by the patent involved. For such making, using, or selling is such a possession of the invention, as charges all purchasers who are cognizant thereof, with notice of whatever title the maker, user, or seller may possess.[96] Whether such constructive notice may also be based on the fact that the subsequent purchaser was a corporation in which the assignor was a director, is a question upon which the precedents are now opposing.[97] Where title has once vested in a subsequent purchaser, for a valuable consideration, without notice of a prior, unrecorded assignment more than three months old; that title becomes absolute and may be purchased by persons who had actual knowledge of the prior assignment.[98] If this rule were otherwise, titles thus derived might become valueless for want of qualified purchasers.[99]

The foregoing parts of this section contemplate cases where the things covered by several assignments of the same assignors, are unquestionably identical; and where there is no ground for controversy relevant to the respective dates of the conflicting transactions. Where either or both of these circumstances are otherwise, other points of law will also arise. Where, for example, the subsequent assignment purported to convey no more than the right, title, and interest of the assignor, in the specified patent, that assignment can never prevail against any prior unrecorded assignment which left any interest in the

[96] Prime *v.* Mfg. Co., 16 Blatch. 455, 1879; Dueber Watch Case Co. *v.* Dalzell, 38 F. R. 597, 1889.

[97] Continental Windmill Co. *v.* Empire Windmill Co., 8 Blatch. 295, 1871; Cutter Co. *v.* Sheldon, 10 Blatch. 1, 1872; Davis Wheel Co. *v.* Davis Wagon Co., 20 F. R. 700, 1884.

[98] Wright *v.* Randel, 8 F. R. 599, 1881; National Heeling-Mach. Co. *v.* Abbott, 70 F. R. 55, 1895.

[99] Varick *v.* Briggs, 6 Paige (N. Y.), 329, 1837; Empire State Nail Co. *v.* Faulkner, 55 F. R. 824, 1893.

assignor;[100] if indeed it can prevail against one which left no such interest.[101]

The date of an assignment is the day of its delivery, and not the date which appears upon its face, if the latter differs from the former;[102] and the three months within which, after that date, an assignment is required to be recorded, are calendar months.[103]

§ 282. Warranty of title is implied in every assignment of a patent right; unless that assignment purports to convey merely the right of the assignor; or unless it is otherwise limited to narrower ground than the entire patent right which it describes. Every such assignment will therefore transfer whatever title the assignor may subsequently acquire by purchase or otherwise.[104] But an assignment of the right, title, and interest of the assignor without anything more, will not operate to convey any title which is subsequently acquired by him.[105]

§ 283. No warranty of validity is implied in any assignment of a patent right. If the assignor knows the patent to be invalid, at the time he makes the assignment, he is guilty of fraud, and the assignee may have relief against him, on that ground; but if both parties are equally innocent of knowledge of invalidity, the loss consequent on any

[100] Brown *v.* Jackson, 63 Wheaton, 449, 1818; Ashcroft *v.* Walworth, 1 Holmes, 152, 1872; Turnbull *v.* Plow Co., 6 Bissell, 230, 1874; Regan Vapor Engine Co. *v.* Pacific Gas Engine Co., 47 F. R. 513, 1891.

[101] Oliver *v.* Piatt, 3 Howard, 363, 1845; May *v.* Le Claire, 11 Wallace, 232, 1870.

[102] Dyer *v.* Rich, 1 Metcalf (Mass.), 180, 1840.

[103] Guaranty Trust Co. *v.* Railroad Co., 139 U. S. 145, 1890.

[104] Sherman *v.* Champlain Transportation Co., 31 Vt. 175, 1858; Faulks *v.* Kamp, 17 Blatch. 433, 1880; Brush Electric Co. *v.* California Electric Light Co., 52 F. R. 963, 1892.

[105] Perry *v.* Corning, 7 Blatch. 195, 1870.

invalidity afterward brought to light, must fall upon the then owner of the patent.[106]

Some State courts have held that, when sued by an assignor for the purchase price of a patent, any assignee may defend on any ground of invalidity which he can prove to exist. This view is based on the theory that in such a case there is a failure of consideration. This theory is not correct, because an assignor may lose, and an assignee may gain as much on account of the assignment of an invalid patent as on account of a valid one. An assignment of an invalid patent is a sufficient consideration to support a promissory note, in any case where there is neither warranty nor fraud.[107] To allow an assignee, who has made profit from the patent assigned, to defend against a suit for the promised price, on the ground of some defect he has been able to discover in the patent, would be unjust.[108] Such a rule might enable an assignee to reap enormous gains from practically exclusive rights, and then to avert payment for those rights, on some far-fetched ground of invalidity, which never for one moment had disturbed his exclusive possession of the patented privilege. Even where an assignee is not shown to have derived any benefit from the assignment of a particular patent, he ought not to be permitted to defend against a suit for the price he promised to pay therefor; because that assignment operated, at least to prevent the assignor from making, using, or selling specimens of the patented thing. It is perfectly well settled that loss or disadvantage to the promisee, is a sufficient consideration to support a con-

[106] Hiatt *v.* Twomey, 1 Devereux & Battle's Equity Cases (N. C.), 315, 1836; Cansler *v.* Eaton, 2 Jones' Equity Cases (N. C.), 499, 1856.

[107] Thomas *v.* Quintard, 5 Duer (N. Y.), 80, 1855.

[108] Milligan *v.* Mfg. Co., 21 F. R. 570, 1884.

tract, even where that contract resulted in no benefit to the promisor.[109]

§ 284. Express warranties of validity may be incorporated in assignments of patents; and where so incorporated, they will subject assignors to actions for damages, if the patents assigned are found to be in fact invalid.[110] Parol warranties of validity, when they accompany written assignments of patents, are inadmissible as foundations for actions for damages based on alleged invalidity of those patents;[111] but such parol statements may be admissible as aiding to prove fraud, in a case where other evidence shows that the assignor knew the patent to be invalid when he made the assignment.[112] In such a case, however, the assignee's right of action rests upon the fraud and not upon the parol warranty.[113]

§ 285. Equitable titles to patent rights may arise in different ways. Such a title accrues to an assignee when a patent is granted to an inventor,[114] or to a subsequent assignee chargeable with notice,[115] for an invention made or completed or patented, after the execution of an assignment adapted to convey it; and a document which conveys a patent, and which also purports to convey all improvements on the invention covered thereby, which may thereafter be made by the assignor, is an example

[109] Parsons on Contracts, Book 2, Ch. 1, Section 2.

[110] Wright *v.* Wilson, 11 Richardson (S. C. Law Reports), 151, 1856.

[111] Van Ostrand *v.* Reed, 1 Wendell (N. Y.), 432, 1828; Jolliffe *v.* Collins, 21 Missouri, 341, 1855.

[112] McClure *v.* Jeffrey, 8 Indiana, 83, 1856.

[113] Rose *v.* Hurley, 39 Indiana, 78, 1872.

[114] Littlefield *v.* Perry, 21 Wallace, 226, 1874; Nesmith *v.* Calvert, 1 Woodbury & Minot, 34, 1845; Continental Windmill Co. *v.* Empire Windmill Co., 8 Blatch. 295, 1871.

See Section 274.

[115] Pontiac Boot Co. *v.* Merino Shoe Co., 31 F. R. 286, 1887.

of such an assignment.[116] An improvement on an invention covered by a patent, may be an addition thereto, which is adapted to increase its value. Or it may be a substitute therefor, which is adapted to supplant it entirely, by performing its function more efficiently or more inexpensively.[117]

An equitable title accrues to an inventor when a patent is granted to his assignee, in pursuance of an assignment, which was accompanied by a contract providing that the assignee should pay to the inventor all or some portion of the proceeds of the patent.[118] Such a title accrues to an assignee of a term for years, in a patent right, if that term is limited to expire before the expiration of the existing term of the patent.[119] Such a title accrues to a consolidated corporation in patents owned by its constituent corporations.[120] Such a title accrues to an employer, where an employee makes an invention in pursuance of a contract to invent for that employer;[121] but in order that the employer may acquire such title the employment must be specifically for the purpose.[121a] Such a contract may be an oral one, and not be within the statute of frauds.[122] And such a title will doubtless arise out of any contract which purports to give a person a beneficial

[116] Aspinwall Mfg. Co. *v.* Gill, 32 F. R. 699, 1887.

See Section 592, *post*.

[117] Westinghouse Air-Brake Co. *v.* Chicago Brake & Mfg. Co., 85 F. R. 790, 1898.

[118] Sayles *v.* Dubuque & Sioux City Railroad Co., 5 Dillon, 563, 1878.

[119] Cook *v.* Bidwell, 8 F. R. 452, 1881.

[120] Edison Electric Light Co. *v.* New Haven Electric Co., 35 F. R. 236, 1888.

[121] Bonsack Mach. Co. *v.* Hulse, 57 F. R. 523, 1893; Hulse *v.* Bonsack Mach. Co., 65 F. R. 864, 1894.

[121a] Johnson Furnace & Engineering Co. *v.* Western Furnace Co., 178 F. R. 819, 1910.

[122] Dalzell *v.* Dueber Mfg. Co., 149 U. S. 320, 1893.

interest in a patent right; but which does not amount to an assignment or grant of legal title, nor to a license to make, to use, or to sell the invention. So also, any facts which would create a constructive or a resulting trust, if they related to other kinds of intangible personal property, will doubtless have the same effect upon property in patents when they relate thereto. And finally, an equitable title may arise to unspecified persons, when a patent is assigned to some specified person as trustee, without any statement in the assignment, of the character of the trust, or of the identity of the beneficiaries thereof.[123] In such a case, both those points can be established by parol evidence, and the equitable title of the beneficiaries may thereupon be enforced against the trustee.[124]

§ 286. In whatever way an equitable title to a patent right may have arisen, it can be translated into a legal title in a proper case,[125] by means of a bill for specific performance of contract or other action in equity;[126] and where no affirmative relief is sought by the holder of an equitable title to a patent, such a title will be upheld by a court of equity, as against all claims made under the naked legal title.[127] But if the holder of the legal title assigns the patent to a purchaser for a valuable consideration, without notice of the equitable title, such a purchaser will take the entire ownership of the patent, freed from the prior equitable encumbrance.[128] One district judge has

[123] National Heeling-Mach. Co. *v.* Abbott, 70 F. R. 54, 1895.

[124] Railroad Co. *v.* Durant, 95 U. S. 576, 1877.

[125] Kennedy *v.* Hazelton, 128 U. S. 667, 1888; Westinghouse Air-brake Co. *v.* Chicago Brake & Mfg. Co., 85 F. R. 796, 1898.

[126] Hapgood *v.* Rosenstock, 23 F. R. 87, 1885; New York Paper Bag Machine Co. *v.* Union Paper Bag Machine Co., 32 F. R. 783, 1887.

[127] Cook *v.* Sterling Electric Co., 118 F. R. 47, 1902.

[128] Hendrie *v.* Sayles, 98 U. S. 549, 1878.

decided this point the other way, holding that the maxim *caveat emptor* applies to such a case.[129] But that decision was rendered before that in Hendrie *v.* Sayles; and was made in evident forgetfulness of the really applicable maxim that, "between equal equities the law will prevail;" and of the well-established doctrine, that, if a purchaser for a valuable consideration, without notice of a prior equitable right, obtains a legal title at the time of his purchase, he will be entitled to priority in equity, as well as in law.[130] The maxim of *caveat emptor* applies where a seller has no title whatever.[131] When a seller has the legal title, but not the equitable, then the other maxim governs the rights of assignees. But the first of two purely equitable assignments will prevail over the second, whether the taker of the second had notice of the other or not.[132]

§ 287. A grant, from one person to another, of a patent right, is a conveyance in writing of the entire right, or of an undivided interest therein, within and throughout a certain specified portion of the territory of the United States.[133] The title to the subject-matter of letters patent is not divisible in any other category than a territorial one;[134] and therefore grants cannot be made to convey one of several inventions covered by a patent;[135] nor to convey an exclusive right to make, use and sell a patented

[129] Consolidated Fruit Jar Co. *v.* Whitney, 2 Bann. & Ard. 385, 1876.

[130] Bispham's Principles of Equity, Section 40; McMichael & Wildman Mfg. Co. *v.* Ruth, 128 F. R. 706, 1904.

[131] Abbett *v.* Zusi, 5 Bann. & Ard. 38, 1879.

[132] Harrison *v.* Morton, 83 Md. 747, 1896.

[133] Gayler *v.* Wilder, 10 Howard, 494, 1850; Moore *v.* Marsh, 7 Wallace, 521, 1868; Littlefield *v.* Perry, 21 Wallace, 219, 1874.

[134] Goodyear *v.* Railroad Co., 1 Fisher, 627, 1853; Suydam *v.* Day, 2 Blatch. 21, 1846; Washing Machine Co. *v.* Earle, 3 Wallace, Jr., 320, 1861.

[135] Pope Mfg. Co. *v.* Gormully Mfg. Co., 144 U. S. 250, 1892.

invention for one of several purposes to which it is applicable. The rules which relate to the form, authentication, construction, revocation, reformation and effect of assignments, refer with equal force to grants; except as otherwise stated or implied in this section, and except as the explained nature of a grant clearly indicates otherwise. In addition to those rules, there are several which refer to grants and not to assignments; and to the latter it is now in order to attend.

A grant is not void for ambiguity where it purports to convey all of the territory of the United States except a number of counties theretofore conveyed to others, but not specified in the grant; because the reservation is such an one as is capable of being made certain by competent evidence.[136] It is not inconsistent with the character of a document as a grant, that it contains a clause of forfeiture in case of non-payment of royalties, or a clause providing that the grantor shall prosecute and defend suits relating to the exclusive right granted.[137] And a grant is not forfeited by failure to pay a royalty; or to keep some other promise made by the grantee therein, unless the grant provides that such a failure shall work such a forfeiture.[138] Nor is it inconsistent with a grant that it is subject to an outstanding license;[139] or that the document limits the exercise of the exclusive right to the making, using and selling of a particular number of specimens of the patented invention involved.[140] But no instrument

[136] Washburn & Moen Mfg. Co. *v.* Haish, 4 F. R. 908, 1880.

[137] Littlefield *v.* Perry, 21 Wallace, 220, 1874.

[138] Atkins *v.* Park, 61 F. R. 957, 1894.

[139] Russell *v.* Kern, 58 F. R. 384, 1893.

[140] Wilson *v.* Rousseau, 4 Howard, 646, 1846; Waterman *v.* Mackenzie, 138 U. S. 256, 1891; Washburn *v.* Gould, 3 Story, 122, 1844; Ritter *v.* Serrell, 2 Blatch. 379, 1852.

can be a grant which reserves a right to the grantor to make, but not to sell or use,[141] or to sell, but not to make or use,[142] specimens of the patented thing, within the territory covered by the instrument.

§ 288. A grant of an exclusive right to make, use, and sell a particular patented invention, within a particular part of the United States, confers the right to use and sell, anywhere within the United States, those specimens of that invention which are made and sold under the grant, and within the territory covered thereby.[143] And an agreement between owners, not to permit any sale or use of the subject of their patent, in the territory of each other, is not binding upon purchasers of the patented articles, from either of those owners, even where the purchasers knew of the agreement.[144]

A lawful sale in a foreign country, of an article patented in that country, and also in the United States, does not authorize the use or sale in the United States of the article thus sold in the foreign country,[145] even though the maker and seller in the foreign country had the right from the United States patentee to there make and sell, and the article is used only for personal use and not for profit.[146] And a patentee owning a United States patent, and also a patent of some foreign country, on the same article, may couple his sales of that article in any foreign country, with a restriction prohibiting its importation into the United States; and that restriction will be binding upon

[141] Waterman *v.* Mackenzie, 138 U. S. 256, 1891.

[142] Pitts *v.* Jameson, 15 Barbour (N. Y. Supreme Court), 315, 1853.

[143] Adams *v.* Burke, 17 Wallace, 453, 1873; Hobbie *v.* Jennison, 149 U. S. 355, 1893; Keeler *v.* Folding Bed Co., 157 U. S. 659, 1895.

[144] Jackson *v.* Vaughan, 73 F. R. 837, 1896.

[145] Boesch *v.* Graff, 133 U. S. 703, 1890.

[146] Daimler Mfg. Co. *v.* Conklin, 170 F. R. 70, 1909.

all persons in the United States who have knowledge or other notice thereof.[147]

§ 288*a*. A mortgage may be executed to cover an entire patent, or an undivided part thereof; or the entire right, or an undivided interest therein, within a certain specified part of the United States. And the due recording of such a mortgage in the Patent Office makes the title of the mortgagee complete; so that he is entitled to grant licenses, receive royalties, bring suits against infringers, and recover profits or damages from them, as long as his mortgage continues in force; and it will continue in force until it is ended by a payment of the debt secured thereby, at the time provided for therein, or by redemption, on a bill in equity, within a reasonable time thereafter.[148] But such a mortgage will not affect an outstanding license, particularly where the mortgagee is chargeable with notice thereof.[149]

§ 289. A creditor's bill may operate to transfer a complete title, or an equitable title, to a patent right, whenever a judgment is obtained against its owner, and an execution issued on that judgment is returned *nulla bona;* and the court in which the creditor's bill is filed may appoint a trustee or master to execute a proper assignment.[150] But a suit, instituted by the filing of such a bill, is not a patent suit in such a sense as to confer jurisdiction on a Federal court.[151] Where jurisdiction is not conferred upon such a court by variant citizenship, or other cause known to the law, it will be necessary to proceed in some court of

[147] Dickerson *v.* Matheson, 57 F. R. 524, 1893; Dickerson *v.* Tinling, 84 F. R. 192, 1897.

[148] Waterman *v.* Mackenzie, 138 U. S. 256, 1891.

[149] Waterman *v.* Shipman, 55 F. R. 984, 1893.

[150] Ager *v.* Murray, 105 U. S. 126, 1881; Wilson *v.* Fire Alarm Co., 151 Mass. 515, 1890.

[151] Ryan *v.* Lee, 10 F. R. 917, 1882.

a State. In such of the States as have preserved equity pleadings and proceedings, a creditor's bill is the proper document to file in such a court, when pursuing such relief; but in the States which have adopted codes of civil procedure, in place of the common law and equity plans of judicature, the end in view may be reached by proceedings supplementary to executions.[152] Or where the unsatisfied judgment was entered for costs against an unsuccessful patentee, his patents may be reached and sold to raise money to pay that judgment, by means of a petition in the same suit in which it was entered.[153]

§ 290. Adjudication of bankruptcy and appointment and qualification of the trustee of the estate of a bankrupt, operates, under the bankrupt law of 1898, to vest in such trustee, and his successor and successors if he shall have any, whatever title the bankrupt had, in any patent or patent right or right of action thereunder, at the date on which he was adjudged a bankrupt.[154] The rights so acquired include any estoppel which may have existed in the bankrupt's favor against his assignor,[155] as is likewise true in the case of a purchase from a receiver, at least when the suit in which the receiver was appointed was instigated by the person against whom the estoppel is invoked.[156] The bankrupt law of 1867, excepted from the corresponding transfer of property, which was provided for by that law, all patents and other property held in trust by the bankrupt; [157] but the bankrupt law

[152] Pacific Bank *v.* Robinson, 57 California, 522, 1881; Newton *v.* Buck, 77 F. R. 615, 1896.

[153] Maitland *v.* Gibson, 79 F. R. 136, 1897.

[154] 30 Statutes at Large, p. 565, Ch. 541, Section 70. But see the Bankruptcy Act of 1910 and L. E. Waterman Co. *v.* Kline, 234 F. R. 891, 1916.

[155] Fishel Nessler Co. *v.* Fishel & Co., 204 F. R. 790, 1913.

[156] Schiebel Toy & Novelty Co. *v.* Clark, 217 F. R. 760, 1914.

[157] Revised Statutes, Section 5053.

of 1898 contains no such exception. A title to a patent passed to an assignee in bankruptcy, under the law of 1867, subject to his election not to accept it, if in his opinion it was worthless, or would be burdensome and unprofitable.[158] And it is probable that the same rule will be adjudged to be applicable to the bankrupt law of 1898. Under the latter statute a pending application is neither a "patent right" within the meaning of clause 2 of the statute, nor "property" within the meaning of clause 5 thereof and so does not pass to the trustee.[159]

Corresponding proceedings in insolvency under State laws, do not have the operation of bankruptcy proceedings in this particular. They do not confer upon the assignee in insolvency any legal title to the patent rights of the insolvent.[160] But a State court which has jurisdiction of such proceedings may compel the insolvent to execute such an assignment to the assignee in insolvency, as will convey the same rights to the latter, as those which, without such a document, are conveyed to a trustee in bankruptcy under the bankrupt law of 1898;[161] for a State may subject the patent rights of an insolvent citizen, to the payment of his debts.[162]

And the title to the patents of dissolved corporations will generally pass, under the operation of State laws, to the receivers, or other officials who are appointed to wind up their affairs.[163]

[158] Sessions *v.* Romadka, 145 U. S. 37, 1892.

[159] *In re* Dann, 129 F. R. 495, 1904. But see *In re* Myers *v.* Wolf Mfg. Co., 205 F. R. 289, 1913.

[160] Ashcroft *v.* Walworth, 1 Holmes, 154, 1872; McCulloh *v.* Association, 45 F. R. 479, 1891; Newton *v.* Buck, 72 F. R. 780, 1896.

[161] Ager *v.* Murray, 105 U. S. 131, 1881; Jewett *v.* Atwood Suspender Co., 100 F. R. 647, 1900.

[162] Barton *v.* White, 144 Mass. 283, 1887.

[163] McCulloh *v.* Association, 45 F. R. 479, 1891.

§ 291. Death of an inventor, before the grant of a patent for his invention, causes a transfer of his inchoate title to his executor or administrator, in trust for the heirs at law of the deceased in case he dies intestate, or in trust for his devisees in case he leaves a will disposing of the invention.[164] Such an inchoate title has several of the same qualities, in the hands of the executor or administrator, that it had in the hands of the deceased. If it was an unassigned inchoate title in the hands of the inventor, it is likewise so in the hands of his legal representative. If the deceased had parted with the equitable title, and had, at his death, only the inchoate legal title, the equitable title will be unaffected by the death of the inventor, and will remain the property of its purchaser.[165] So also, if the inventor had parted, prior to his death, with the inchoate legal title, and retained the equitable title, then the latter, and not the former, will devolve upon his executor or administrator.

Death of the owner of any legal or equitable title to a patent right already in existence, causes a transfer of that title to his executor or administrator, in like manner as it causes the transfer of any other intangible personal property of the deceased.[166] Such a legal representative may convey the title by assignment or by grant, by means of any suitable instrument in writing, and in pursuance of such general or special authority from the probate court as is prescribed, in that behalf, by the laws of the particular

[164] Revised Statutes, Section 4896, as amended by Act of May 23, 1908, Chap. 188, Section 4896, 35 Stat. 245; De La Vergne Mach. Co. *v.* Featherstone, 147 U. S. 209, 1893.

[165] Northwestern Extinguisher Co. *v.* Philadelphia Extinguisher Co., 1 Bann. & Ard. 177, 1874.

[166] Brooks *v.* Jenkins, 3 McLean, 441, 1844; Hodge *v.* North Missouri Railroad Co., 1 Dillon, 104, 1870; Shaw Valve Co. *v.* New Bedford, 19 F. R. 753, 1884; Bradley *v.* Dull, 19 F. R. 913, 1884.

State whose court that tribunal is.[167] Where there are several joint executors or administrators, the assignment or grant of one of them is legally the assignment or grant of them all; [168] and if an administrator denominates himself an executor, or if an executor calls himself an administrator, in such a document, that document will be none the less efficacious to convey the title which he holds in his true capacity.[169] Where the executor or administrator takes no action relevant to a patent which belonged to him whose estate is being administered, and is discharged after settling the estate; the ownership of the patent devolves on those who are the heirs at law of the deceased.[170]

§ 292. Tenancy in common, in a patent right, will arise whenever the sole owner of such a right, in all or in part of the territory of the United States, conveys to another an undivided interest in the whole or in part of the right which he owns. Mutual ownership of the same sort arises when a plurality of persons are joint inventors of a process or thing, for which they obtain a joint patent; [171] and also when a plurality of persons obtain, by one assignment or grant, the undivided ownership of a patent, or the undivided ownership of a patent right in a part of the territory of the United States. The ordinary incidents of tenancy in common therefor appertain to such ownership and each owner becomes entitled to use the invention without accounting to the other.[172]

[167] Brooks *v.* Jenkins, 3 McLean, 441, 1844.

[168] Wintermute *v.* Redington, 1 Fisher, 239, 1856.

[169] Newell *v.* West, 13 Blatch. 114, 1875.

[170] Winkler *v.* Studebaker Mfg. Co., 105 F. R. 190, 1900.

[171] Drake *v.* Hall, 220 F. R. 905, 1914.

[172] Drake *v.* Hall, 220 F. R. 905, 1914; Central Brass & Stamping Co. *v.* Stuber, 220 F. R. 909, 1915.

§ 294. One tenant in common of a patent right may exercise that right to any extent he pleases, without the consent of any co-tenant. He may make, use and sell specimens of the patented invention to any extent, and may license others to do so; and neither he nor his licensees can be enjoined from a continuance in so doing.[173] Nor can any recovery of profits or damages be had against any such licensee at the suit of any co-tenant of any such licensor.[174] And no recovery of profits or damages can be had against one co-tenant who, without the consent of the others, has made, used or sold specimens of the patented thing.[175] It is said that the same rules apply as between two or more joint licensees.[176]

But where a patent belonging to tenants in common, has been infringed by a third party, the right of action for that infringement belongs in common to all the owners, and cannot be fully released by either of them alone.[177]

Either one of several co-tenants in a patent right may of course sell his right independently of any other;[178] but where joint trustees are appointed to hold the legal title to a patent, and to manage it according to their mutual judgment and discretion, a joint deed of all those trustees is necessary to convey that right to another.[179]

[173] Clum *v.* Brewer, 2 Curtis, 523, 1855; Aspinwall Mfg. Co. *v.* Gill, 32 F. R. 697, 1887; Grier *v.* Baynes, 49 F. R. 367, 1893; Lalance & Grosjean Mfg. Co. *v.* National Enameling Co., 108 F. R. 78, 1901.

[174] Dunham *v.* Railroad Co., 7 Bissell, 223, 1876.

[175] Vose *v.* Singer, 4 Allen (Mass.), 232, 1862; De Witt *v.* Mfg. Co., 5 Hun (N. Y.), 301, 1875; Whiting *v.* Graves, 3 Bann. & Ard. 225, 1878; Blackledge *v.* Weir & Craig Mfg. Co., 108 F. R. 71, 1901.

[176] Rudge-Whitworth *v.* Houk Mfg. Co., 221 F. R. 678, 1914.

[177] Lalance & Grosjean Mfg. Co. *v.* Haberman Mfg. Co., 93 F. R. 197, 1899; and 107 F. R. 487, 1901.

[178] May *v.* Chaffee, 2 Dillon, 388, 1871.

[179] Wiscott *v.* Agricultural Works, 11 F. R. 302, 1882.

An agreement by a trustee of a patent for the benefit of several beneficiaries of whom the trustee himself is one, to sell the patent cannot be specifically enforced even as to the trustee's own interest, where the object of the creation of the trust was to prevent less than all of the joint owners from conveying the same or granting licenses without the consent of all, and where the vendee had notice of the trust.[180]

§ 295. Partition of a patent right, held by tenancy in common, may of course be made by the common consent and mutual action of all the owners of that right; but no such partition can be made against the will of either owner. But equity has jurisdiction to remove a cloud from a title to a patent, where that cloud consists in an express or an implied assertion of adverse ownership or encumbrance.[181]

[180] M'Duffee *v.* Hestonville, M. & F. Pass. Ry Co., 162 F. R. 36, 1908.

[181] Dredging Co. *v.* Miller, 20 App. D. C. 253, 1902; Burpee *v.* Guggenheim, 226 F. R. 214, 1915.

CHAPTER XII

LICENSES

296. Licenses defined and described.
297. Express licenses to make, with implied leave to use, or implied leave to sell the things made.
298. Express licenses to use, with implied leave to make for use.
299. Express licenses to sell, with implied leave to the vendees to use and to sell the things they purchase.
300. Licenses to make and use, without implied leave to sell.
301. Licenses to make and sell, or to use and sell, with implied leave to the vendees to use and to sell the articles they buy.
302. Express licenses so restricted as not to convey implied rights.
302*a*. Implied licenses to repair or improve.
303. Written and oral licenses.
304. Recording and notice.
305. Licenses given by one of several owners in common, and licenses given to one of several joint users.
306. Construction of licenses.
307. Warranty of validity of patent, and eviction.
307*a*. Warranty of validity of license.
308. Clauses of forfeiture.
309. Effects of forfeiture.
310. Assignability of licenses.
311. Purely implied licenses.
312. Implied licenses from conduct, and first by acquiescence.
313. Implied license from conduct by estoppel.
313*a*. Implied license from employment of inventor.
314. Implied license from actual recovery of a full license fee.
314*a*. License restrictions on the use and resale of patented articles.
314*b*. The patent monopoly an aggregation of rights.
314*c*. Specific decisions considered.
314*d*. The same subject continued.
314*e*. The same subject continued.
314*f*. The same subject continued.
314*g*. The same subject continued.
314*h*. The same subject continued.
314*i*. The Clayton Act.
314*j*. The Clayton Act construed.

§ 296. ANY conveyance of a right under a patent, which does not amount to an assignment or to a grant, is a

license,[1] and may be granted at any time after the application for patent is filed.[2] It is a license, if it does not convey the entire and unqualified monopoly, or an undivided interest therein, throughout the particular territory to which it refers.[3] Consistently with this definition, the following have been held to constitute licenses only: an exclusive right to make and sell, but not to use: [4] an exclusive right to make and use, but not to sell:[5] an exclusive right to use and sell, but not to make: [6] an exclusive right to make, to use, and to sell to be used, for certain purposes, but for no other: [7] and the exclusive conveyance of some, but not all, of the claims of a patent.[8] "The right to manufacture, the right to sell, and the right to use, are each substantive rights, and may be granted or conferred separately by the patentee." [9] Any one or two of these rights may be expressly conveyed by a patentee,

[1] See Section 274; Waterman *v.* Mackenzie, 138 U. S. 255, 1891; Seibert Oil Cup Co. *v.* Lubricator Co., 34 F. R. 221, 1888; Hatfield *v.* Smith, 44 F. R. 355, 1890; Rice *v.* Boss, 46 F. R. 195, 1891; Standard Button-Fastener Co. *v.* Ellis, 159 Mass. 449, 1893; Ft. Wayne, Cincinnati & Louisville R. R. Co. *v.* Haberkorn, 1 Ind. App. 481, 1896; Kilburn *v.* Holmes, 121 F. R. 750, 1903; Paulus *v.* M. M'Buck Mfg. Co., 129 F. R. 594, 1904.

[2] St. Louis Street Flushing Mach. Co. *v.* Sanitary Street Flushing Mach. Co., 178 F. R. 923, 1910.

[3] Gayler *v.* Wilder, 10 Howard, 494, 1850; Sanford *v.* Messer, 1 Holmes, 149, 1872; Hill *v.* Whitcomb, 1 Holmes, 321, 1874.

[4] Hayward *v.* Andrews, 106 U. S. 673, 1882; Dorsey Rake Co. *v.* Mfg. Co., 12 Blatch. 203, 1874.

[5] Mitchell *v.* Hawley, 16 Wallace, 544, 1872; Rice *v.* Boss, 46 F. R. 195, 1891.

[6] Hamilton *v.* Kingsbury, 17 Blatch. 265, 1879; Brush Electric Co. *v.* California Electric Light Co., 52 F. R. 959, 1892.

[7] Gamewell Telegraph Co. *v.* Brooklyn, 14 F. R. 255, 1882; Jaros Underwear Co. *v.* Fleece Underwear Co., 60 F. R. 623, 1894; De Forest *v.* Collins Wireless Telephone Co., 174 F. R. 821, 1909.

[8] Pope Mfg. Co. *v.* Gormully Mfg. Co., 144 U. S. 249, 1892.

[9] Adams *v.* Burke, 17 Wallace, 456, 1873.

while the other is expressly retained by him. In the absence of express reservation, however, some licenses are extended by implication, so as to convey, not only what they expressly cover, but also some right which is necessary to the full enjoyment of the right expressly conveyed. This practice is not in conflict with the rule which prohibits the enlargement of an instrument in writing by parol evidence; because that rule is directed only against the admission of oral evidence of the language, used by the parties in a contract which was reduced to writing.[10] This practice relates to the legal effect of the language actually written, and is based on that maxim of the common law which prescribes, that any one granting a thing, impliedly grants that, without which, the thing expressly granted would be useless to the grantee.[11]

§ 297. An express license to make specimens of a patented thing, is without value, unless it implies a right to use, or a right to sell, the specimens made thereunder. It is not to be presumed that a right so nugatory as a bare right to make, was the only subject of a license for which a valuable consideration was paid. Whether the implied right, which accompanies such a license, is a right to use or a right to sell, can best be determined by ascertaining the circumstances which surrounded the giving of the particular license in question. If the licensee was engaged in a business which made it convenient for him to use the thing involved; then the right to use will be implied in preference to the right to sell, because it is the more natural implication in such a case. On the other hand, if the licensee had no occasion to use the thing in

[10] Greenleaf on Evidence, Section 277.

[11] Steam Stone Cutter Co. *v.* Shortsleeves, 16 Blatch. 382, 1879; Brush Electric Co. *v.* California Electric Light Co., 52 F. R. 960, 1892.

view, but was engaged in making and selling similar things, for the use of others, then a right to sell will be implied from a right to make.[12] Rights to both use and sell will not be implied from an express license to make, because only one of those rights is necessary to the beneficial enjoyment of such a license. An express license to make specimens of a particular thing, does not imply a license to use a particular patented machine for that purpose, even where the patent on that machine was owned by the licensor, at the time of the license, and even where that machine was then the best known means of making the thing licensed.[13]

§ 298. An express license to use a limited or unlimited number of specimens of a patented article, implies a right to make those specimens, and to employ others to make them, and will protect those others in making them for the use of the licensee.[14] If the license to use, covers a greater length of time than one specimen of the thing to be used will last; then there is an implied right in the licensee to repair or to rebuild that specimen, or to replace it by another specimen made or purchased for that purpose.[15]

§ 299. An express license to sell specimens of a patented thing, does not imply any right to make those specimens, if it can be presumed that they may be obtained by purchase; because no person requires any license to enable him to lawfully buy an article covered by any patent.

[12] Steam Cutter Co. *v.* Sheldon, 10 Blatch. 8, 1872.

[13] Troy Nail Factory *v.* Corning, 14 Howard, 193, 1852.

[14] Steam Stone Cutter Co. *v.* Shortsleeves, 16 Blatch. 381, 1879; Johnson Signal Co. *v.* Union Switch & Signal Co., 55 F. R. 487, 1893; Edison Electric Light Co. *v.* Peninsular L. P. & H. Co., 95 F. R. 676, 1899.

[15] Wilson *v.* Stolley, 4 McLean, 275, 1847; Bicknell *v.* Todd, 5 McLean, 236, 1851; Woodworth *v.* Curtis, 2 Woodbury & Minot, 524, 1847; Steam Cutter Co. *v.* Sheldon, 10 Blatch. 8, 1872.

But a license to sell does imply that a right to use and to sell again shall be conferred on the vendees of the licensee, for otherwise no person would buy except for exportation, and sales for exportation are seldom sufficiently practicable to raise a presumption that they alone were contemplated by the parties to a license to sell.

§ 300. A license to make and use does not authorize any sale of the thing so made, nor authorize any purchaser of that thing to use the same.[16] Nor does a sale, coupled with an express license to use, give any right to use after the license has been forfeited or has expired.[17] The purchaser of a patented thing gets no other right to use it than such right as the seller had an express or an implied right to convey.[18] And the purchaser of a thing which is useful only in producing a patented article,[19] or in being combined with other things to constitute a patented article,[20] or when used to perform a patented process,[21] gets thereby no right to use his purchased thing for such a purpose; for such a right would derogate from the exclusive rights of the owner of the patent on that article, combination, or process. But the purchaser of a patented apparatus, from the owner of the patent thereon, acquires whatever right that patent covers, to use that apparatus in accordance therewith, even where it is capable of a different use.[22] And a purchaser of an apparatus which

[16] Wilson *v.* Stolley, 3 McLean, 277, 1847.

[17] Wortendyke *v.* White, 2 Bann. & Ard. 25, 1875; Porter Needle Co. *v.* National Needle Co., 17 F. R. 536, 1883.

[18] Chambers *v.* Smith, 5 Fisher, 14, 1870; International Pavement Co. *v.* Richardson, 75 F. R. 594, 1896.

[19] Stevens *v.* Cady, 14 Howard, 528, 1852; Stevens *v.* Gladding, 17 Howard, 447, 1854; Elgin Wind Power Co. *v.* Nichols, 65 F. R. 220, 1894.

[20] Roosevelt *v.* Electric Co., 20 F. R. 724, 1884.

[21] United Nickel Co. *v.* Electrical Works, 25 F. R. 479, 1885.

[22] Edison Electric Light Co. *v.*

can be used only in connection with a device of a patent owned by the seller acquires an implied license to use the device not only in connection with the apparatus so purchased but also in connection with similar apparatus purchased from other makers.[23]

§ 301. A license to make and sell, implies a right in the purchaser to use and to sell again, the thing thus lawfully sold to him. When a specimen of a patented invention is sold with the authority of the owner of the patent which covers it, and without any restriction on the ownership or use of the thing conveyed; that specimen passes out of the exclusive right which is secured by the patent, and may be used as long, or sold as often, as though it had never been subject to a patent.[24] This principle, however, goes only to the extent of permitting the unrestricted use of the patented thing in the condition as purchased or acquired and does not permit the purchaser to use any of the parts in union with the parts of another machine and thus construct a new infringing device.[25] The same results also follow from a sheriff's sale of a patented article, where that sale was made in pursuance of an execution, issued against the owner of the patent right, and lawfully levied on that article, as the property of that owner.[26] Restrictions in respect of methods or purposes of use, and pre-

Peninsular L. P. & H. Co., 101 F. R. 831, 1900.

[23] Thomson-Houston Electric Co. *v.* Illinois Tel. Const. Co., 152 F. R. 631, 1907.

[24] Morgan Envelope Co. *v.* Albany Paper Co., 152 U. S. 432, 1894; Bloomer *v.* McQuewan, 14 Howard, 539, 1852; Chaffee *v.* Belting Co., 22 Howard, 217, 1859; Adams *v.* Burke, 17 Wallace, 453, 1873; Paper-Bag Cases, 105 U. S. 771, 1881; McKay *v.* Wooster, 2 Sawyer, 373, 1873; May *v.* Chaffee, 2 Dillon, 385, 1871; Detweiler *v.* Voege, 8 F. R. 600, 1881; Holiday *v.* Mattheson, 24 F. R. 185, 1885.

[25] National Cash Register Co. *v.* Grobet, 153 F. R. 905, 1907.

[26] Wilder *v.* Kent, 15 F. R. 217, 1883.

scriptions in respect of prices and conditions of leasing or reselling, may properly accompany any sale of a patented article;[27] but no such restriction or prescription is operative upon any subsequent purchaser of that article, who had no notice thereof, at the time of his purchase.[28]

§ 302. Express licenses which, if unrestricted, would convey implied rights, may be so restricted that they will not have that effect.[29] A license to make and sell, may be restricted to certain parts of the United States, for the making, and to certain parts for the selling; and may be so restricted as not to cover any making or selling, for export to any foreign country.[30] A license to make and use may likewise be restricted to limited territory for either or both of its branches;[31] and to a limited time as well as a limited territory.[32] And a license to use may be restricted in respect of materials operated on,[33] or in any other manner.

§ 302*a*. A purchaser may repair a patented machine which he has purchased, by replacing broken or worn-out unpatented parts, so long as the identity of the machine is not destroyed,[34] provided the machine itself is not an

[27] Heaton-Peninsular Button-Fastener Co. *v.* Eureka Specialty Co., 77 F. R. 288, 1896; Edison Phonograph Co. *v.* Kaufmann, 105 F. R. 960, 1901; Cortelyou *v.* Lowe, 111 F. R. 1005, 1901; Whitson *v.* Phonograph Co., 18 App. D. C. 573, 1901; Edison Phonograph Co. *v.* Pike, 116 F. R. 863, 1902; Victor Talking Mach. Co. *v.* The Fair, 123 F. R. 424, 1903. See Sections 314 *et seq.*

[28] Edison Electric Light Co. *v.* Goelet, 65 F. R. 614, 1894.

[29] Hamilton *v.* Kingsbury, 15 Blatch. 64, 1878; Hamilton *v.* Kingsbury, 17 Blatch. 264, 1879.

[30] Dorsey Rake Co. *v.* Mfg. Co., 12 Blatch. 204, 1874.

[31] Wicke *v.* Kleinknecht, 1 Bann. & Ard. 608, 1874.

[32] Mitchell *v.* Hawley, 16 Wallace, 544, 1872.

[33] Tubular Rivet & Stud Co. *v.* O'Brien, 93 F. R. 200, 1898.

[34] Young *v.* Foerster, 37 F. R. 203, 1889; Shickle, Harrison & Howard Iron Co. *v.* St. Louis Car-Coupler Co., 77 F. R. 739, 1896; Thomson-Houston Electric Co. *v.*

infringement.[35] Likewise another who furnishes the repair parts on the order of the purchaser is not liable for infringement in the absence of a license reservation to the patentee to supply such parts.[36] The right of him furnishing repair parts is measured by the right of the user to repair.[36a] And he may improve such a machine for his own peculiar use, by substituting for an unpatented part thereof, a corresponding part originally purchased, or not purchased, from the patentee.[37] But no unauthorized person can lawfully engage in the business of reconstructing patented machines for their owners, by omissions and substitutions of parts; where those machines do not require any repair, but are thus changed with a view to their improvement.[38] Nor can even an owner of a patented machine lawfully replace any part or combination thereof, which is patented to another person alone.[39] And no person acquiring the ownership of mutilated portions of a specimen of a patented thing, can lawfully reconstruct that specimen by adding the missing parts; nor can

H. W. Johns Mfg. Co., 78 F. R. 364, 1896; Alaska Packers' Association *v.* Pacific Steam Whaling Co., 93 F. R. 672, 1899; and 100 F. R. 462, 1900; Goodyear Shoe Machinery Co. *v.* Jackson, 112 F. R. 149, 1901; Morrin *v.* Robert White Eng. Works, 143 F. R. 519, 1905 (see also opinion of court below in 138 F. R. 68); Wagner Typewriter Co. *v.* F. S. Webster Co., 144 F. R. 405, 1906; F. F. Slocumb & Co. *v.* A. C. Layman Machine Co., 227 F. R. 94, 1915.

[35] Union Special Mach. Co. *v.* Maimin, 161 F. R. 748, 1908. See Sections 404–407.

[36] Morgan Gardner Electric Co. *v.* Buettner & Shelburne Mach. Co., 203 F. R. 490, 1913; F. F. Slocumb & Co. *v.* Layman Machine Co., 227 F. R. 94, 1915.

[36a] National Malleable Castings Co. *v.* American Steel Foundries, 182 F. R. 626, 1910.

[37] Thomson-Houston Electric Co. *v.* Kelsey Ry. Specialty Co., 75 F. R. 1010, 1896.

[38] National Phonograph Co. *v.* Fletcher, 117 F. R. 149, 1902.

[39] Morgan Envelope Co. *v.* Albany Paper Co., 152 U. S. 435, 1894.

he lawfully use or sell the entire articles when reconstructed.[40]

§ 303. Licenses may be written, or they may be oral.[41] The former have advantages over the latter; because they can be made exclusive, and can usually be proved with more ease and more certainty; and because the latter may sometimes be obnoxious to some State statute of frauds and be rendered non-enforceable, by being non-performable within one year from the dates of their origins.[42] These points constitute abundant reasons for embodying all such contracts in plain black and white documents, rather than committing them to the "slippery memory of man." And a written license, which purports to be exclusive, will operate as a non-exclusive license, if it was given by one who had authority to give the latter, but not the former kind of license.[43] A license is valid, if made before the patent is issued, as well as if made afterward;[44] and a contract for a license is enforceable as a license, if no formal license is ever given in pursuance of the contract.[45]

§ 304. No license is required to be recorded,[46] and no

[40] American Cotton Tie Co. *v.* Simmons, 106 U. S. 89, 1882; Davis Electrical Works *v.* Edison Electric Light Co., 60 F. R. 276, 1894.

[41] Jones *v.* Berger, 58 F. R. 1007, 1893; Union Switch & Signal Co. *v.* Johnson Signal Co., 61 F. R. 944, 1894; Sharpless *v.* Moseley & Stoddard Mfg. Co., 75 F. R. 595, 1896; Cook *v.* Sterling Electric Co., 150 F. R. 766, 1907; St. Louis Street Flushing Mach. Co. *v.* Sanitary Street Flushing Mach. Co., 178 F. R. 923, 1910.

[42] Buhl *v.* Stephens, 84 F. R. 922, 1898.

[43] Union Switch & Signal Co. *v.* Johnson Signal Co., 61 F. R. 943, 1894.

[44] Brush Electric Co. *v.* California Electric Light Co., 52 F. R. 963, 1892; St. Louis Street Flushing Machine Co. *v.* Sanitary Street Flushing Machine Co., 178 F. R. 923, 1910.

[45] American Paper Bag Co. *v.* Van Nortwick, 52 F. R. 752, 1892.

[46] Brooks *v.* Byam, 2 Story, 525, 1843; Consolidated Fruit Jar Co.

record of a license affects the rights of any person; for a license is good against the world,[47] whether it is recorded or not,[48] and a purchaser of a patent takes it subject to all outstanding licenses.[49] So also, if a license is embodied in two papers, one of which limits the scope of the other, an assignee of the broader document will take subject to the limitations of the narrower, even if he had no notice of its provisions, nor even of its existence. Nor will the fact that the broader document was recorded, and the narrower one unrecorded, alter or affect the operation of this rule.[50] It follows, that where two licenses conflict, the first must prevail, even though the taker of the second had no notice of the existence of the first; and it also follows that any license will prevail as against the claims of any subsequent assignee or grantee of the patent right involved.[51]

§ 305. A license from one of several owners in common of a patent right, is as good as if given by all those owners;[52] and a license given to one of several joint makers or users of a patented thing is as good as if given to all, if the licensor gives it with the understanding that the thing licensed to be done is to be done jointly, or is to be done by the express licensee on behalf of the other party.[53]

v. Whitney, 2 Bann. & Ard. 38, 1875; Buss *v.* Putney, 38 N. H. 44, 1859; Jones *v.* Berger, 58 F. R. 1007, 1893; Ft. Wayne, Cincinnati & Louisville R. R. Co. *v.* Haberkorn, 1 Ind. App. 481, 1896.

[47] Chambers *v.* Smith, 5 Fisher, 14, 1870.

[48] Farrington *v.* Gregory, 4 Fisher, 221, 1870.

[49] Pratt *v.* Wilcox Mfg. Co., 64 F. R. 592, 1893.

[50] Hamilton *v.* Kingsbury, 17 Blatch. 264 and 460, 1880.

[51] Continental Windmill Co. *v.* Empire Windmill Co., 8 Blatch. 295, 1871; New York Phonograph Co. *v.* Edison, 136 F. R. 600, 1905.

[52] Dunham *v.* Railroad Co., 7 Bissell, 224, 1876; Paulus *v.* M. M. Beck, 129 F. R. 594, 1904.

[53] Bigelow *v.* Louisville, 3 Fisher, 603, 1869.

§ 306. The construction of a license in writing depends upon the same general rules as the construction of other written contracts.[54] For example, it is to be construed in the light of the circumstances which surrounded its execution.[55] Accordingly, where the owner of several patents licenses a person to make, use or sell a particular class of things which, if made, used or sold without a license, would infringe all those patents, then that license confers a right under them all.[56] And this is the rule even where the licensor's title accrued to him, after the date of the license.[57] In the absence of language to the contrary in a license, the royalties provided for therein, are construed as being payable during the lives of the patents to which they respectively relate, and not any longer.[58] The grant of a "license under said letters" patent conveys the full right to make, use, and sell under the patent, if the license contains no qualifying provisions.[58a]

§ 307. No warranty of validity of the letters patent is implied in any license given thereunder; and unattended proof of invalidity is therefore no defence to any suit for promised royalties.[59] As long as a licensee continues to enjoy the benefit of the exclusive right, he must pay the

[54] Wetherill *v.* Zinc Co., 6 Fisher, 50, 1872.

[55] Burdell *v.* Denig, 92 U. S. 722, 1875.

[56] Dey *v.* Stellman, 1 Fisher, 487, 1859.

[57] Pratt *v.* Wilcox Mfg. Co., 64 F. R. 591, 1893.

[58] Sproull *v.* Pratt & Whitney Co., 101 F. R. 265, 1900; and 108 F. R. 963, 1901.

[58a] Buffalo Specialty Co. *v.* Indiana Rubber & I. Wire Co., 234 F. R. 334, 1916.

[59] Birdsall *v.* Perego, 5 Blatch. 251, 1865; Sargent *v.* Larned, 2 Curtis, 340, 1855; Marsh *v.* Dodge 4 Hun (N. Y.), 278, 1875; Bartlett *v.* Holbrook, 1 Gray (Mass.), 118, 1854; Marston *v.* Sweet, 66 N. Y. 207, 1876; Pope Mfg. Co. *v.* Owsley, 27 F. R. 105, 1886; Marsh *v.* Harris Mfg. Co., 63 Wis. 283, 1885; Moore *v.* National Boiler Co., 84 F. R. 347, 1897.

royalty which he promised to pay, and he cannot escape from so doing by offering to prove the patent to be void.[60] It has been held, however, that a licensee may purchase a patent which was pending in the Patent Office at the time of issuance of the patent under which the license was granted and that he may assert the patent so purchased against the licensor even though by so doing he proves the former invalid by reason of anticipation.[61] The licensee must pay the promised royalty, not only on the exact invention claimed in the patent, but also on whatever is near enough like that invention to infringe the patent.[62] Nor can a licensee renounce his license without the consent, acquiescence or fault of the licensor;[63] but a false representation by the licensor to the licensee, of the rate of the royalty paid by other licensees, is such a fault as will entitle the licensee to renounce his license.[64] A license implies that the licensee shall not be evicted from its enjoyment, and such an eviction is a defence to a suit for royalties accruing after it occurred.[65]

Such an eviction occurs whenever the patent is adjudged void in an interference suit prosecuted in equity in pursuance of Section 4618 of the Revised Statutes, or whenever the patent is repealed by the decree of a court in which an action is brought by the United States for that purpose,[66]

[60] Burr *v.* Duryee, 2 Fisher, 285, 1862; Deane *v.* Hodge, 35 Minn. 153, 1886; Godell *v.* Wells & French Co., 70 F. R. 319, 1895; Holmes, Booth & Haydens *v.* McGill, 108 F. R. 238, 1901.

[61] Victor Talking Machine Co. *v.* Am. Graphophone Co., 189 F. R. 359, 1911. See section 362*a*.

[62] St. Paul Plow Works *v.* Starling, 140 U. S. 195, 1891.

[63] St. Paul Plow Works *v.* Starling, 140 U. S. 195, 1891.

[64] Hat-Sweat Mfg. Co. *v.* Waring, 46 F. R. 106, 1891; Hat-Sweat Mfg. Co. *v.* Porter, 46 F. R. 757, 1891.

[65] White *v.* Lee, 14 F. R. 791, 1882.

[66] McKay *v.* Smith, 39 F. R. 557, 1889.

or whenever the patent is held to be void in a suit based on its infringement.[67]

Such eviction also occurs whenever the licensee is enjoined from acting under it at the suit of the owner of a senior patent;[68] and, by parity of reasoning, it occurs whenever a judgment or decree is obtained by the owner of a senior patent, against the licensee, for an infringement which consisted of acting under the license, but not when such a suit is merely proposed to be brought by the owner of a senior patent.[69]

While such an eviction might possibly be held to occur whenever the patent is defied by unlicensed persons, so extensively and so successfully as to deprive the licensee of the benefit of his share in the exclusive right which it was supposed to secure, a single successful defiance is not enough to constitute such an eviction.[70] Nor does such an eviction result from the patentee granting later licenses at lower rates.[71]

In the absence of an express warranty of validity of a patent, from a license given thereunder; the licensor, when sued by the licensee for damages on account of having violated the license, by granting a competing license or by not suing an infringer, may prove his patent to be void, as relevant to the amount of damages suffered by the licensee, by reason of the breach.[72]

§ 307*a*. An implied warranty of validity of the license itself, is appurtenant to every license given under a pat-

[67] Ross *v.* Fuller & Warren Co., 105 F. R. 510, 1900.

[68] Pacific Iron Works *v.* Newhall, 34 Connecticut, 67, 1867.

[69] American Electric Co. *v.* Consumers' Gas Co., 47 F. R. 43, 1891; Consumers' Gas Co. *v.* Electric Co., 50 F. R. 778, 1892.

[70] Pope Mfg. Co. *v.* Owsley, 27 F. R. 100, 1886.

[71] McKay *v.* Smith, 39 F. R. 557, 1889; National Rubber Co. *v.* Rubber Shoe Co., 41 F. R. 48, 1890.

[72] Jackson *v.* Allen, 120 Mass. 78, 1876.

ent; and therefore the licensor cannot repudiate the license, on the ground that he had no authority to execute it, at the time he did, even where that fact was known to the licensor at that time.[73] This implied warranty of validity of a license, will render the licensor liable to an injunction, if he presumes to employ the patented invention in any way covered by the license; and it will operate to confer upon the licensee, the benefit of any estate which the licensor may afterward acquire in the patent, so far as that benefit would have been appurtenant to the license, if that estate had belonged to the licensor, at the time he executed the license.

§ 308. A license not expressly limited in duration, continues till the patent expires,[74] or the license is surrendered in pursuance of its own provision,[75] or is terminated by a new agreement,[76] or is forfeited by the licensee.[77]

Forfeiture of a license does not follow from the single fact that the licensee has broken covenants which were made by him when accepting the license;[78] unless the parties expressly agreed that such a forfeiture should follow such a breach.[79] For example, in the absence of

[73] Seal *v.* Beach, 113 F. R. 831, 1901.

[74] Sproull *v.* Pratt & Whitney Co., 101 F. R. 265, 1900; and 108 F. R. 963, 1901.

[75] Stimpson Computing Scale Co. *v.* W. F. Stimpson Co., 104 F. R. 893, 1900.

[76] American Street Car Advertising Co. *v.* Jones, 122 F. R. 808, 1903.

[77] St. Paul Plow Works *v.* Starling, 140 U. S. 195, 1891.

[78] Chadeloid Chemical Co. *v.* Johnson, 203 F. R. 993, 1913.

[79] White *v.* Lee, 5 Bann. & Ard. 572, 1880; Consolidated Purifier Co. *v.* Wolf, 28 F. R. 814, 1886; Densmore *v.* Tanite Co., 32 F. R. 544, 1887; Seibert Oil Cup Co. *v.* Lubricator Co., 34 F. R. 221, 1888; Hammacher *v.* Wilson, 26 F. R. 241, 1886; Washburn & Moen Mfg. Co. *v.* Wire Fence Co., 42 F. R. 675, 1890; Brush Electric Co. *v.* California Electric Light Co., 52 F. R. 964, 1892; Platt *v.* Fire Extinguisher Mfg. Co., 59 F. R. 900, 1894.

such an agreement, a mere non-payment of a license fee does not entitle a party to a decree of annulment.[80] And even where such an agreement is made, it will not always be enforced by the courts, and will never be self-enforcing.[81] For example, non-payment of royalty on the very day it becomes due, will not work a forfeiture, if that non-payment arose from lack of certainty relative to the place of payment, and from lack of demand from the licensor.[82] Nor will forfeiture result from the fact that in a suit by the owner of the patent against a third person, the licensee appeared and filed briefs in aid of the defendant.[83] Nor will forfeiture of a license result from the fact that the licensee has infringed the patent by doing acts, with the invention, which were unauthorized by the license. The license will not protect him in such doings, but it will continue to protect him in doing the acts which it did authorize.[84] Indeed, forfeitures are not favored by the law; and courts are always prompt to seize upon any circumstance which indicates an agreement or an election to waive one;[85] and an injunction will issue to prevent a threatened wrongful declaration of forfeiture.[86]

[80] Wagner Typewriter Co. *v.* Watkins, 84 F. R. 62, 1897; Foster Hose Supporter Co. *v.* Taylor, 184 F. R. 71, 1911; Rowland *v.* Biesecker, 185 F. R. 515, 1911.

[81] Standard Dental Mfg. Co. *v.* National Tooth Co., 95 F. R. 294, 1899; Hanifen *v.* Lupton, 95 F. R. 470, 1899; Chadeloid Chemical Co. *v.* Johnson, 203 F. R. 993, 1913; Foster Hose Supporter Co. *v.* Taylor, 180 F. R. 994, 1910 (see appeal); *contra*, Foster Hose Supporter Co. *v.* Taylor, 184 F. R. 71, 1911.

[82] Dare *v.* Boylston, 6 F. R. 493, 1880.

[83] Comptograph Co. *v.* Burroughs Adding Machine Co. (containing discussion of question of forfeiture of licenses), 175 F. R. 792, 1909 (affirmed with opinion in 183 F. R. 321, 1910).

[84] Wood *v.* Wells, 6 Fisher, 383, 1873; Steam Cutter Co. *v.* Sheldon, 10 Blatch. 1, 1872.

[85] Insurance Co. *v.* Eggleston, 96 U. S. 572, 1877.

[86] Baker Mfg. Co. *v.* Washburn & Moen Mfg. Co., 18 F. R. 172,

A surrender of a license in pursuance of its own provision, restores the parties to their former relation, and enables the licensee to thereafter act in respect of the patent, with the rights and responsibilities of strangers to the licensor.[87] And a termination of a license by a new agreement will end or will modify the relation of the parties to the license, according to the provisions of the new agreement.

At any rate where the license does not contain a forfeiture clause the owner may sue his licensee for infringement only on a showing that the license has terminated by mutual consent or that it has been forfeited by decree of a court. It is not open to the owner of the patent to prove in an infringement suit in which such a license is involved, the fact that the licensee has committed such a breach as would entitle the owner to forfeiture if the question came before a court of equity in a direct proceeding brought for that purpose.[88]

§ 309. Where a license is really forfeited, and the licensee continues to work under it as though it were still in force, the licensor has an option to sue him as an infringer, or to sue him for the promised royalties.[89] If he selects the first of these remedies, the act of the owner of the patent is regarded as a repudiation of the license, and the license being at an end and the contractual relation having ceased, the infringer may interpose any defence

1883. See Dixie Cotton Picker Co. *v.* Bullock, 188 F. R. 921, 1911, wherein the court discusses various considerations bearing upon the question of right to forfeiture.

[87] Stimpson Computing Scale Co. *v.* W. F. Stimpson Co., 104 F. R. 893, 1900.

[88] American Graphophone Co. *v.* Victor Talking Machine Co., 188 F. R. 431, 1911.

[89] Woodworth *v.* Weed, 1 Blatch. 166, 1846; Cohn *v.* Rubber Co., 3 Bann. & Ard. 572, 1878; Union Mfg. Co. *v.* Lounsbury, 42 Barbour (N. Y.), 125, 1864; Starling *v.* Plow Works, 32 F. R. 290, 1887.

that he could have set up in the absence of a license.[90] An exception is where the licensee continues to hold forth to the public by marking the articles with the patented stamp that he is manufacturing under the patent.[91] And similarly where the license contained an agreement of the licensee not to contest the validity of the patent [92] the licensee is estopped for the life of the patent. And when such a covenant is made, the estoppel continues for the full term of the patent as expressed therein, even though the patent may in fact expire before that time by reason of the expiration of a foreign patent for the same invention.[93] If the licensor selects the second of the remedies mentioned, he must sue at law;[94] except where he sues an assignee of the licensee for royalties accruing before the assignment, in which case the action for their recovery must be brought in equity.[95] Wherever the licensor sues for the promised royalties, the defendant may introduce evidence of the prior art, to guide the court to the construction of the patent, and thus to aid in the ascertain-

[90] Woodworth *v.* Cook, 2 Blatch. 150, 1850; Burr *v.* Duryee, 2 Fisher, 283, 1862; Brown *v.* Lapham, 27 F. R. 77, 1886; Antisdel *v.* Chicago Hotel Cabinet Co., 89 F. R. 311, 1898; Tate *v.* Baltimore & Ohio Railroad, 229 F. R. 141, 1915.

[91] Regina Music Box Co. *v.* Newell, 131 F. R. 606, 1904.

[92] Dunham *v.* Bent, 72 F. R. 60, 1885; Philadelphia Creamery Supply Co. *v.* Davis & Rankin Bldg. & Mfg. Co., 77 F. R. 879, 1896; Consolidated Rubber Tire Co. *v.* Finlay Rubber Tire Co., 116 F. R. 638, 1902.

[93] United Shoe Mach. Co. *v.* Caunt, 154 F. R. 239, 1904; New York Phonograph Co. *v.* National Phonograph Co., 163 F. R. 534, 1908.

[94] Consolidated Purifier Co. *v.* Wolf, 28 F. R. 816, 1886; Crandall *v.* Plano Mfg. Co., 24 F. R. 738, 1885; Washburn & Moen Mfg. Co. *v.* Freeman Wire Co., 41 F.. R. 410, 1890; Washburn & Moen Mfg. Co. *v.* Barbed Wire Co., 42 F. R. 675, 1890.

[95] Goodyear Shoe Machinery Co. *v.* Dancel, 119 F. R. 692, 1902.

ment of the extent of those doings of the licensee, which are subject to the payment of royalties.[96]

Where a license to make and sell patented articles, conferred also a right to designate those articles by an arbitrary identifying name, a forfeiture of the license, will disentitle the licensee to use that name to designate competing articles.[97]

§ 310. No license is assignable by the licensee to another, unless it contains words which show that it was intended to be assignable.[98] The most suitable phrase with which to express such an intention, would include the word "assigns"; but in one case it was held that the words "legal representatives" would answer the purpose, because the license fairly indicated that the parties understood that phrase to include "assigns" as well as "executors or administrators."[99] Also extrinsic facts and circumstances and the conduct of the parties may give an assignable character to a license which on its face is not assignable.[100] And unassignable licenses may sometimes be invoked by persons who are not exactly identical with the licensees. A railroad company which was formed by the consolidation of prior railroad companies, may invoke the licenses which were given to either of its constituent corporations; because the consolidated company

[96] Andrews *v.* Landers, 72 F. R. 666, 1896.

[97] Adam *v.* Folger, 120 F. R. 264, 1903; Bowers *v* Lake Superior, etc., Co., 149 F. R. 983, 1906.

[98] Troy Factory *v.* Corning, 14 Howard, 193, 1852; Rubber Co. *v.* Goodyear, 9 Wallace, 788, 1869; Hapgood *v.* Hewitt, 119 U. S. 226, 1886; Baldwin *r.* Sibley, 1 Clifford, 150, 1858; Searls *v.* Bouton, 12 F. R. 143, 1882; Bull *v.* Pratt, 1 Connecticut, 342, 1815; Adams *r.* Howard, 22 F. R. 657, 1884; Waterman *v.* Shipman, 55 F. R. 986, 1893.

[99] Hamilton *v.* Kingsbury, 15 Blatch. 69, 1878.

[100] Bowers *v.* Lake Superior, etc., Co., 149 F. R. 983, 1906.

is a successor rather than an assignee of those companies.[101] So also, a license to a corporation, will protect a receiver who is authorized to manage its business during its embarrassments.[102] But a receiver who is appointed in supplementary proceedings, under the New York Code of Civil Procedure, to settle the business of an insolvent individual, does not acquire any right to an unassignable license which belonged to the insolvent person.[103]

Where a license is given to a partnership, composed of several persons, and where that partnership is dissolved, and its business is continued by one of the partners, that partner is entitled to that license;[104] but where such a dissolution ends the business of the partnership, the license lapses;[105] except that a receiver appointed to wind up the partnership affairs, may invoke the license to protect him in so doing.[106] But a license to one person gives no right to any partner of that person, or to any corporation organized by the licensee;[107] although of course such a licensee may employ such agents as he wishes to manufacture the patented article for him;[108] and if it authorizes the licensee to act only at a particular place, it will not protect any of his doings elsewhere.[109] And no license to a man and any partner he may take, will protect any assignee of that man when acting alone.[110] Nor does an

[101] Lightner *v.* Railroad Co., 1 Lowell, 338, 1869.

[102] Emigh *v.* Chamberlin, 2 Fisher, 192, 1861; Schmidt *v.* Central Foundry Co., 218 F. R. 466, 1914.

[103] Waterman *v.* Shipman, 55 F. R. 985, 1893.

[104] Belding *v.* Turner, 8 Blatch. 321, 1871.

[105] Haffcke *v.* Clark, 50 F. R. 531, 1892.

[106] Montrose *v.* Mabie, 30 F. R. 234, 1887.

[107] Eclipse Windmill Co. *v.* Windmill Co., 24 F. R. 650, 1885.

[108] Foster Hose Supporter Co. *v.* Thomas P. Taylor Co., 191 F. R. 1003, 1912.

[109] Rubber Co. *v.* Goodyear, 9 Wallace, 788, 1869.

[110] Gibbs *v.* Hoefner, 19 F. R. 324, 1884.

unassignable license pass to an executor or administrator of a deceased licensee.[111] The non-assignability of a license may be waived by the licensor; and will be so waived if he accepts the promised royalty from the assignee of the license; [112] or ratifies the transfer of the license, by otherwise treating the assignee as the licensee was entitled to be treated.[113]

A reservation in an assignment, reserving the right to the assignor to operate fully under the patent but restricting the right to him personally will, it is held, prevent the assignor from authorizing a third party to operate under the license when the assignor has no interest in the business otherwise than a reservation of a royalty.[113a] It is surmised that this ruling would be the same even in the absence of the restriction as to personal use.

Assignable licenses are assignable only in their entirety; unless they expressly or impliedly authorize their assignment in parts, and to a plurality of persons.[114] And the royalties payable to a licensor are assignable by him; and the assignee's rights to those royalties follow the license, when it is assigned to a person who has notice of those rights.[115] The purchaser of a license takes it subject to all the restrictions connected therewith, whether he has notice of those restrictions or not; [116] and subject to liability for the same rate of royalty for his doings,

[111] Oliver *v.* Chemical Works, 109 U. S. 81, 1883.

[112] Bloomer *v.* Gilpin, 4 Fisher, 55, 1859.

[113] Hammond *v.* Organ Co., 92 U. S. 724, 1875; Lane & Bodley Co. *v.* Locke, 150 U. S. 196, 1893.

[113a] Lockjoint Pipe Co. *v.* Melber, 234 F. R. 319, 1916.

[114] Brooks *v.* Byam, 2 Story, 545, 1843; Consolidated Fruit Jar Co. *v.* Whitney, 1 Bann. & Ard. 356, 1874; Adams *v.* Howard, 22 F. R. 656, 1884; Brush Electric Co. *v.* California Electric Light Co., 52 F. R. 964, 1892.

[115] Grier *v.* Baynes, 46 F. R. 524, 1891.

[116] Chambers *v.* Smith, 5 Fisher, 12, 1870.

that the licensee would have had to pay for similar acts; [117] but not subject to any royalty, or other money, due from the licensee to the licensor, at the time of the assignment of the license.[118]

§ 311. Purely implied licenses may arise from the conduct of patentees and grantees of patents, or from recoveries by them, of profits or damages for certain classes of infringements. Many of the rules which have thus far in this chapter, been stated and explained in connection with purely express licenses, and in connection with express licenses having implied incidents, are also applicable to licenses which are purely implied. Little or nothing remains to be said about the latter, except to state the classes of circumstances out of which they are found to spring.

§ 312. Implied licenses, from conduct of owners of patent rights, may arise out of any one of a considerable number of classes of facts; but, when analyzed, those facts will probably always be found to thus operate by virtue of the doctrines of acquiescence, or the doctrines of estoppel. For example, where a patentee joins a partnership, the business of which involves the employment of his patented invention, an implied license passes to the partnership, as part of the partnership property.[119] And where the owner of a patent right acquiesces in the doings of one who makes, uses, or sells specimens of the patented invention, and where that owner also accepts partial compensation for such doings; a license will be implied, unless the case also presents other facts which negative such an implication.[120] Payment of full compensation would be

[117] Paper Stock Co. *v.* Disinfecting Co., 147 Mass. 323, 1888.

[118] Goodyear *v.* Rubber Co., 3 Blatch. 449, 1856.

[119] Mueller *v.* Mueller, 95 F. R. 155, 1899.

[120] Blanchard *v.* Sprague, 1 Cliff. 297, 1859; Seibert Oil Cup Co. *v.* Lubricator Co., 34 F. R.

a still more convincing ground upon which to base an implied license; and such a license may be based on a clear case of acquiescence, even if no special payment is proved to have been received.[121] But acquiescence in unpaid-for use, does not always imply that no compensation is to be expected. Where the user knew of the patent, and the patentee knew of the use, and did not object thereto; it is more reasonable to imply an agreement for a *quantum meruit* or a royalty, than to imply that the patentee donated the use of his invention to the user, or to imply that the user unlawfully seized upon the invention of the patentee.[122] In the absence of an established royalty, a *quantum meruit* is ascertained by general and expert evidence, showing what a reasonable royalty would be.[123] In no case, however, can a license be implied from acquiescence, unless the licensor had knowledge of the thing acquiesced in; nor can acquiescence be predicated even of knowledge and omission to interfere with the doings of the infringer, if that omission is fairly accounted for on other grounds.

§ 313. If the owner of a patent right were to explain the patented invention to a person ignorant of the patent; and were to advise him to make, to use, or to sell a specimen of that invention, with intent to induce him to infringe the patent unknowingly; and if that person were thereby induced to incur expense in infringing or in preparing to infringe that patent; an implied license would result by estoppel, to the person thus misled. The same

221, 1888; Keyes *v.* Eureka Mining Co., 158 U. S. 150, 1895.

[121] Gill *v.* United States, 160 U. S. 437, 1896.

[122] United States *v.* Palmer, 128 U. S. 269, 1888; McKeever *v.* United States, 23 O. G. 1527, 1883; Drainage Construction Co. *v.* Chelsea, 41 F. R. 47, 1890.

[123] Deane *v.* Hodge, 35 Minn. 154, 1886.

result would follow, if the owner of a patent right were to conceal the existence of the patent from a person who, to his knowledge, was about to infringe it unknowingly; if that concealment were done with intent to allow that person to infringe; and if that person incurred expense in infringing or in preparing to infringe, which he would not have incurred if he had known of the patent. And where a patentee sees an infringing article sold without authority from him, but makes no objection to the sale; an implied license by estoppel results to the purchaser.[124]

So, also, where a person sells a patented machine to another without having any interest in or under the patent, he will be estopped from prosecuting his vendee for infringement on the basis of any after acquired title. Such estoppel, however, extends only to machines made or sold by permission or with the co-operation of the person acquiring the title. For instance, a partner who, after dissolution of the partnership, acquires a patent covering machines made by the partnership is not estopped from claiming infringement of the patent by machines made or sold by the other partner after the dissolution.[125] And where a person sells a patent which employs an invention which infringes a prior patent; the person selling is estopped from bringing an action against his grantee for that infringement; even though the earlier patent is acquired after the sale of the later patent.[126] And that estoppel operates as a license, not only as against the seller but also as against owners in common with him of the

[124] Societe Fabriques, etc., *v.* Franco-American Trading Co., 82 F. R. 439, 1897.

[125] Dull *v.* Reynolds Electric 1908.

[126] United Printing Machinery Co. *v.* Cross Paper Feeder Co., 220 F. R. 322, 1915.

prior patent.[127] And where an inventor before applying for a patent thereon, sells a specimen of his invention to a manufacturer who avowedly buys it to copy it, by making other specimens for sale, and where the seller gives the buyer no notice of intention to apply for a patent on that invention; the inventor is estopped from bringing an action on such a patent against anyone, for using or selling a specimen of the invention which was made by that purchaser.[128] And so is the patentee estopped when he has sold to the defendant the necessary parts to make the patented article, even as respects articles made by the defendant partly from parts procured from a stranger if such a course was necessary to enable the defendant to use up all of the parts supplied by the patentee.[129] But a license to use a patented device may not be implied from the fact that the patentee has sold to the alleged infringer an article which constitutes one element of the patented combination, where the article is capable of other uses, even though the article is usually sold by the patentee as a part of the complete patented device.[130]

§ 313*a*. Where a man is employed by another party, to work in a particular business of the employer; and where, at any time before the end of that employment, he conceives an invention which appears to be applicable to his employer's business; and where during that employment, he uses the property of the employer in reducing that invention to practice; and where he sees the employer thereupon proceed to make, use, or sell, specimens of that invention, and does not thereupon demand any present

[127] Curran *v.* Burdsall, 20 F. R. 835, 1883.

[128] Anderson *v.* Eiler, 50 F. R. 775, 1892.

[129] Auto Spring Repairer Co. *v.* Grinberg, 175 F. R. 799, 1910.

[130] Davis *v.* Hall Mammoth Incubator Co., 200 F. R. 958, 1912.

or prospective compensation therefor, on account of any present or prospective patent thereon; an implied license, or "shop right" results to the employer, under any patent that may be granted on that invention, in pursuance of any application of that employed man.[131] Such an implied license will cover all the specimens of the invention which the employer may make or use or sell during the life of any such patent; or it will be confined to some or all of those specimens which were made or used or sold with the inventor's knowledge, during the time of his employment, according to the particular equities of each case in which such a license is implied.[132] Where an employee contracts to devote his time to the "cheapening of the processes" used by his employer, and in the course of his employment invents a process relating to the business of his employer and machines for carrying out the process, and thereafter constructed six of the machines in the employer's plant at the latter's expense, a license to the employer is implied to use the machines and to replace them and also to practice the process, even though there was no provision in the contract of employment that would give such right.[133] And the benefit of such an implied license will pass to the assigns or the successors of the employer; according to the particular circumstances which may justify such passage in particular cases, respectively.[134]

[131] Gill *v.* United States, 160 U. S. 426, 1896; Blauvelt *v.* Interior Conduit & Insulation Co., 80 F. R. 906, 1897; Wilson *v.* American Circular Loom Co., 187 F. R. 840, 1911; Schmidt *v.* Central Foundry Co., 218 F. R. 466, 1914.

See American Stoker Co. *v.* Underfeed Stoker Co., 182 F. R. 642, 1910.

[132] Fuller & Johnson Mfg. Co. *v.* Bartlett, 68 Wis. 73, 1887; Brickill *v.* New York, 112 F. R. 70, 1901.

[133] Barber *v.* National Carbon Co., 129 F. R. 370, 1904.

[134] Lane & Bodley Co. *v.* Locke,

§ 314. An actual recovery of a full royalty for making, and selling to others to be used, operates as an implied license to any purchaser of the thing thus made and sold, to use it to the same extent that he could lawfully have done, if the maker had been licensed to make and sell it.[135] But where there is a recovery of mere nominal damages in an infringement suit for unlicensed making and selling a specimen of a patented thing, that recovery does not operate as an implied license authorizing the use of that specimen.[136] And where an action in equity, against an infringing user of a patented thing, is brought to recover the profits which he derived from that use; that action cannot be successfully resisted on the ground that the profits, which the infringing maker, or an infringing seller of that thing, derived from his infringement, have already been recovered from him; because each infringer is liable, in equity, for his own profits only;[137] and because the payment to the owner of a patent, of the profits which one infringer has reaped from infringement, cannot operate in equity, to relieve another infringer from liability to the owner of the patent for other profits which he derived, either from the same infringement or from a different

150 U. S. 193, 1893; Withington-Cooley Mfg. Co. *v.* Kinney, 68 F. R. 500, 1895.

[135] Spaulding *v.* Page, 1 Sawyer, 709, 1871; Gilbert & Barker Mfg. Co. *v.* Bussing, 12 Blatch. 426, 1885; Perrigo *v.* Spaulding, 13 Blatch. 391, 1876; Steam Stone Cutter Co. *v.* Mfg. Co., 17 Blatch. 31, 1879; Booth *v.* Seevers, 19 O. G. 1140, 1881; Stutz *v.* Armstrong, 25 F. R. 147, 1885; Fisher *v.* Amador Mine, 25 F. R. 201, 1885; Tuttle *v.* Matthews, 28 F. R. 98, 1886; American Bell Telephone Co. *v.* Albright, 32 F. R. 287, 1887.

[136] Birdsell *v.* Shaliol, 112 U. S. 445, 1884; New York Filter Co. *v.* Schwarzwalder, 58 F. R. 579, 1893; Philadelphia Trust Co. *v.* Edison Electric Light Co., 65 F. R. 554, 1895.

[137] Elizabeth *v.* Pavement Co., 97 U. S. 140, 1877; Tatham *v.* Lowber, 4 Blatch. 87, 1857; Covert *v.* Sargent, 38 F. R. 238, 1889.

infringement, connected or disconnected therewith. Therefore the existence of a decree for profits against a manufacturer for making and selling a patented article, does not constitute any defence to a suit for infringement brought against a user of the very same article.[138] But if a patentee makes and sells under his patent, a recovery of both damages and profits from another who infringes by making and selling is a bar to further suits for infringement by users of specific articles covered by the decree.[138a] And no action of a patentee, by way of suit, or by way of amicable collection of money for infringement against an infringing maker or seller of a patented artiele, can deprive any licensee of the patentee, who has the exclusive right to use the patented article in a given territory, of the right to collect money from the user in that territory, of the very infringing article which was involved in the suit or settlement between the patentee and the manufacturer or seller of that article. Recoveries based on unlicensed use of a patented process or thing, are necessarily confined to such use as occurred before the suit was brought, if the action be at law, or to such as occurred before the final decree, if the action is in equity; and it follows that no such recovery can operate to license anyone to continue such use, or to begin a new use of that thing or that process.[139]

§ 314*a*. Section 1 of the so-called Sherman Anti-Trust Act provides that "every contract, combination in the form of trust or otherwise, or conspiracy in restraint of trade or commerce, among the several States or with foreign nations, is hereby declared to be illegal"; and

[138] Tuttle *v.* Matthews, 28 F. R. 98, 1886.

[138a] Stebler *v.* Riverside Heights Orange Growers Ass'n, 214 F. R. 550, 1914; Sherman, Clay & Co. *v.* Searchlight Horn Co., 225 F. R. 497, 1915.

[139] Suffolk Co. *v.* Hayden, 3 Wallace, 315, 1865.

Section 2 of the same Act provides that "every person who shall monopolize, or attempt to monopolize any part of the trade or commerce, among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor." [140]

Since the fourth edition of this book the question has arisen as to what extent, if any, this statute circumscribes or limits in any way the monopoly which a patentee possesses by virtue of the ownership of a patent. Putting the question in another way it is as to what extent the owner of a patent may legitimately create restrictions on the resale or use in the hands of another of articles made under his patent either by himself or by one licensed to manufacture under his patent.

It has been many times said, as in National Phonograph Co. *v.* Schlagel,[141] that "it rests with the owner to say what part of (his) property he will reserve to himself and what part he will transfer to others and upon what terms he will make the transfer," or, as expressed by the Supreme Court in another way "the general rule is absolute freedom in the use or sale of rights under the patent laws of the United States. The very object of these laws is monopoly and the rule is with few exceptions that any conditions, which are not in their very nature illegal with regard to this kind of property, imposed by the patentee and agreed to by the licensee for the right to manufacture or use or sell the article, will be upheld by the courts. The fact that the conditions in the contracts keep up the monopoly of fixed prices does not render them illegal." [142]

[140] Act of July 2, 1890, Chapter 647, 26 Stat. 209.

[141] National Phonograph Co. *v.* Schlagel, 128 F. R. 733, 1904.

[142] Bement *v.* National Harrow Co., 186 U. S. 70, 1902.

§ 314*b*. These holdings and others similar to them obviously mean that in legal conception the owner of a patent is possessed of a certain aggregation of rights which are assembled in his statutory rights to exclude others from making, selling or using articles within the scope of his patent, and with those holdings as the premises the logical deduction is that he may grant to others the right to make under certain circumstances, the right to use under certain circumstances, or the right to sell under certain circumstances, retaining to himself or bestowing as he sees fit, the right to make, use, or sell all under other circumstances.

§ 314*c*. Prior to the decision of Bauer *v.* O'Donnell,[143] known as the "Sanatogen" case, there was practically no judicial dissent from the proposition stated in the foregoing section. In Bement *v.* National Harrow Co., which was the leading case in the Supreme Court where the Dick case was decided, the owner of the patent granted a license to a manufacturer to manufacture harrows under the patent. The suit against the manufacturer was in the form of one to recover damages for a violation of licenses and to restrain further violation of them. Mr. Justice PECKHAM said in his opinion: "but that statute (Sherman Anti-Trust Law) clearly does not refer to that kind of a restraint of interstate commerce which may arise from reasonable and logical conditions imposed upon the assignee or licensee of a patent by the owner thereof restricting the terms upon which the article may be used, and the price to be demanded therefor. Such a construction of the Act we have no doubt was never contemplated by its framers." He further said: "The owner of a patented article can, of course, charge such price as he may choose, and the owner of a patent may assign it

[143] Bauer *v.* O'Donnell, 229 U. S. 1, 1913.

or sell the right to manufacture and sell the article patented upon the condition that the assignee shall charge a certain amount for such article. The Bement case therefore stands squarely for the proposition that when there is a license to manufacture and sell under a patent, a provision in the license agreement that the articles made under the patent shall be sold at a fixed price, is not contrary to the Sherman Anti-Trust Law and this holding has not been overruled."

§ 314*d*. The next case directly involving the question under discussion that came before the Supreme Court was the Henry *v.* Dick case.[144] The essential facts involved in that case were that the owner of the patent involved, who was also a manufacturer of mimeographs, made under the patent, affixed to his machines a notice stating that the machine was sold "with the license restriction that it may be used only with the stencil paper, ink and other supplies" made by the manufacturer, and that the defendant, a dealer in inks, sold a can of ink to a purchaser of one of the mimeographs, both the dealer and the purchaser having actual knowledge of the license restriction and of the intention of the purchaser to use the ink on the patented mimeograph. It further appeared that the machine had been purchased for a cash consideration, but which yielded no profit to the manufacturer whose method it was to make its profits on the sale of the inks and supplies. Five only of the nine judges who sat upheld the restriction. As the suit was for infringement it is obvious that the court considered that the patentee by virtue of the license restriction had retained to himself some part of the monopolistic rights granted to him by the patent.

To the objection that the entire title in the patented

[144] Henry *v.* Dick Co., 224 U. S. 1, 1912.

article had passed by virtue of the sale and that therefore there was no patent right left in the patentee which the defendant could infringe, Justice LURTON said:

"The argument for the defendants ignores the distinction between the property right in the materials composing a patented machine, and the right to use for the purpose and in the manner pointed out by the patent. The latter may be and often is the greater element of value, and the buyer may desire it only to apply to some or all of the uses included in the invention. But the two things are separable rights. If sold unreservedly the right to the entire use of the invention passes, because that is the implied intent; but this right to use is nothing more nor less than an unrestricted license presumed from an unconditional sale. A license is not an assignment of any interest in the patent. It is a mere permission granted by the patentee. It may be a license to make, sell and use or it may be limited to any one of these separable rights. If it be a license to use, it operates only as a right to use without being liable as an infringer. If a licensee be sued he can escape liability to the patentee for the use of his invention by showing that the use is within his license. But if his use be one prohibited by the license, the latter is of no avail as a defence."

A situation where the possessor of a patented machine had, without the permission of the owner of the patent, manufactured it for himself and subsequently obtained permission from the patentee to use it in a particular manner, or for a particular purpose, may serve to bring out more strongly the distinction mentioned by the court. In such a case it would hardly be open to question that permission by the owner of the patent would carry to the possessor of the machine only the right to use it in the manner provided, although title to the physical machine

would at all times have belonged to the maker of the machine.

§ 314*e*. The question next came before the Supreme Court in the case of Standard Sanitary Mfg. Co. *v.* United States.[145] This case was a prosecution under the Sherman Anti-Trust Law. The sixteen corporate defendants were the manufacturers of about 85% of the enameled iron ware made in the United States. Originally the Standard Co. was the manufacturer of about 50% of such ware and was the owner of a certain process patent for enameling under which it operated. The remaining manufacturers were, however, compelled to use older and inferior processes of enameling with the result that they produced a large quantity of "seconds" or inferior ware, which, however, came into competition with the high grade ware made by the Standard Co. At least such was the contention of the defendants, who also contended that in forming the combination attacked by the Government, they produced a healthy condition in the trade, eliminating "seconds" and making possible free competition in equal grade ware.

The essence of the combination involved in the case so far as the Sherman Law was concerned, was a license agreement substantially as follows: Right was granted to the licensee to use the process of the patent, royalties of a fixed sum were established, preferential discounts from the regular selling prices were announced, a commission was established to have supervision of all the royalties and transactions between the parties to the agreements, covenants were entered into to adhere to and maintain the conditions, regulations and prices and preferential discounts established by the licensor, and provision was made for the return of eighty per cent of the royalties

[145] Standard Sanitary Mfg. Co. *v.* United States, 226 U. S. 20, 1912.

paid if the agreements should be complied with by all concerned. Each licensee agreed to sell no "seconds." There was also a jobbers' license agreement that required the purchaser to pay the price fixed and in short the plan sought to be put into execution was to control the prices of enamel iron ware from the manufacturer to the ultimate consumer by means of license restrictions.

Mr. Justice McKENNA who rendered the opinion, said: "In this statement certain things are prominent. Before the agreements the manufacturers of enameled ware were independent and competitive. By the agreements they were combined, subjected themselves to certain rules and regulations, among others not to sell their product to the jobbers except at a price fixed not by trade and competitive conditions but by the decision of the committee of six of their number, and zones of sales were created. And the jobbers were brought into the combination and made its subjection complete and its purpose successful. Unless they entered the combination they could obtain no enameled ware from any manufacturer who was in the combination, and the condition of entry was not to resell to plumbers except at the prices determined by the manufacturers. The trade was, therefore, practically controlled from producer to consumer, and the potency of the scheme was established by the co-operation of 85% of the manufacturers and their fidelity to it was secured not only by trade advantages but by what was practically a pecuniary penalty, not inaptly termed in the argument, 'cash bail.' The royalty for each furnace was $5.00, 80% of which was to be returned if the agreement was faithfully observed; it was to be 'forfeited as a penalty' if the agreement was violated. And for faithful observance of their engagements the jobbers, too, were entitled to rebates from their purchases. It is testified that 90% of the job-

bers in number and more than 90% in purchasing power joined the combination.

"The agreements clearly, therefore, transcended what was necessary to protect the use of the patent or the monopoly which the law conferred upon it. They passed to the purpose and accomplished a restraint of trade condemned by the Sherman law. It had, therefore, a purpose and accomplished a result not shown in the Bement case. There was a contention in that case that the contract of the National Harrow Company with Bement & Sons was part of a contract and combination with many other companies and constituted a violation of the Sherman law, but the fact was not established and the case was treated as one between the particular parties, the one granting and the other receiving a right to use a patented article with conditions suitable to protect such use and secure its benefits. And there is nothing in Henry *v.* A. B. Dick Co., 224 U. S. 1, which contravenes the views herein expressed."

§ 314*f*. In Bauer *v.* O'Donnell,[146] the sole licensee under the patent sold a food composition known as Sanatogen made under the patent, subject to the following license restriction:

"This size package of Sanatogen is licensed by us for sale and use at a price not less than one dollar ($1.00). Any sale in violation of this condition, or use when so sold, will constitute an infringement of our patent No. 601,995, under which Sanatogen is manufactured, and all persons so selling or using packages or contents will be liable to injunction and damages.

"A purchase is an acceptance of this condition. All rights revert to the undersigned in the event of violation. The Bauer Chemical Co."

[146] Bauer *v.* O'Donnell, 229 U. S. 1, 1913.

Certain jobbers purchased packages of the Sanatogen from the licensee and resold them to the defendant, a retail dealer. The defendant in turn sold them to consumers at less than one dollar a package, an act which was charged by the owner of the patent as being an infringement. The matter came before the Supreme Court on a certification from the Court of Appeals. The question certified was as follows: "Did the acts of the appellee (defendant) in retailing at less than the price fixed in said notice, original packages of 'Sanatogen' purchased of jobbers as aforesaid, constitute infringement of appellant's (plaintiff's) patent?"

Mr. Justice DAY, in his opinion, paraphrased the question as follows: "May a patentee by notice limit the price at which future retail sales of the patented articles may be made, such articles being in the hands of a retailer by purchase from a jobber who has paid to the agent of the patentee the full price asked for the article sold?" The decision, holding that when the owner of the patent had received from the jobber the full price for the packages he had deprived himself of all rights secured by his patent monopoly, was based on the consideration of Section 4884 of the Revised Statutes which grants to the patentee "the exclusive right to make, *use and vend* the invention or discovery." The Patent Statute was held to be similar in its purpose and meaning to the Copyright Statute (Section 4952 of the Revised Statutes) which, as the court said: "secures to an author, inventor, designer or proprietor of books, maps, charts or dramatic or musical compositions the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending them." The meaning of the word "vend" in the Patent Statute and "vending" in the Copyright Statute, was held to be identical, the court saying: "So far

as the use of the terms 'vend' and 'vending' is concerned, the protection intended to be secured is substantially identical. The sale of a patented article is not essentially different from the sale of a book. In each case to vend is to part with the thing for a consideration."

§ 314*g*. There is, however, one distinction between the statutes in the respect that the Patent Statute gives the inventor the exclusive right to "use," a fact which was strongly urged upon the court by the plaintiff, and the Henry *v.* Dick Co. case was cited in support of the contention. The court distinguished the case from the Henry *v.* Dick case and also from the case of Bobbs-Merrill *v.* Straus,[147] by saying with reference to the facts in those cases: "While the title was transferred, it was a qualified title, giving the right to use the machine only with certain specified supplies." In response to the contention that the facts in the Bauer *v.* O'Donnell case dealt with the *use* of the invention, because the notice stated that the package was licensed "for sale and use at a price not less than One Dollar ($1.00)," the court said: "The jobber from whom the appellee purchased had previously bought at a price which must be deemed to have been satisfactory, the packages of Sanatogen afterwards sold to the appellee. The patentee had no interest in the proceeds of the subsequent sales, no right of any royalty therein or to participation in the proceeds thereof. The packages were sold with as full and complete title as any article could have when sold in the open market, excepting only the attempt to limit the sale or use when sold for not less than one dollar. In other words, the title transferred was full and complete with an attempt to reserve the right to fix the price at which subsequent sales could be made. There is

[147] Bobbs-Merrill Co. *v.* Straus, 210 U. S. 339, 1908.

no showing of a qualified sale for less than value for limited use with other articles only, as was shown in the Dick case. There was no transfer of a limited right to use this invention, and to call the sale a license to use is a mere play upon words.

"The real question is whether in the exclusive right secured by statute to 'vend' a patented article there is included the right, by notice, to dictate the price at which subsequent sales of the article may be made. The patentee relies solely upon the notice quoted to control future prices in the resale by a purchaser of an article said to be of great utility and highly desirable for general use. The appellee and the jobbers from whom he purchased were neither the agents nor the licensees of the patentee. They had the title to, and the right to sell, the article purchased without accounting for the proceeds to the patentee and without making any further payment than had already been made in the purchase from the agent of the patentee. Upon such facts as are now presented we think the right to *vend* secured in the patent statute is not distinguishable from the right of *vending* given in the copyright act. In both instances it was the intention of Congress to secure an exclusive right to sell, and there is no grant of a privilege to keep up prices and prevent competition by notices restricting the price at which the article may be resold. The right to vend conferred by the patent law has been exercised, and the added restriction is beyond the protection and purpose of the act. This being so, the case is brought within that line of cases in which this court from the beginning has held that a patentee who has parted with a patented machine by passing title to a purchaser has placed the article beyond the limits of the monopoly secured by the patent act."

§ 314*h*. Next came the case of Victor Talking Machine

Co. *v.* Straus,[148] decided by the Court of Appeals for the second circuit in which it appeared that a manufacturer of talking machines affixed thereto a very elaborate notice of license restrictions which was construed by the court as a grant of "only the right to use the particular machine unaltered without parts not manufactured by the Victor Co., maker and owner of the patents, and only with records and needles made by the Victor Co., and to use it only so long as the notice, unaltered and unerased, remains on the machine." The term for which the right to use was granted was a fixed period, "for the term of the patent having the longest term to run." The court said: "The character of the use is not the same in all cases:

"1. To 'Victor distributors' there is given a right to use only for 'demonstrating.'

"As the sole result of demonstration is to induce the public to get the machines it may be assumed that these distributors are paid by the Victor Company.

"2. To regularly licensed 'Victor dealers' there is also given a right to use for 'demonstrating' purposes. Sometimes conveyance of such right to use is made directly by the Victor Company, to the licensed Victor dealer. Sometimes the conveyance is made to the 'dealer' by the 'demonstrator,' who by the terms of the notice is expressly authorized to convey such right to the dealer. These dealers, of course, do not use these machines for their personal enjoyment; their demonstrations are given to induce the public to apply for machines and they are paid by a commission on the amount paid by every person who may be induced by them to take one.

"3. To the public, *i. e.*, to individuals who wish to use the machines generally."

Every machine sold was paid for in a lump sum which

[148] Victor Talking Machine Co. *v.* Straus, 230 F. R. 449, 1916.

the notice described as a royalty, although it was not expected or understood that any further payments should be made. The notice stated that the manufacturer reserved title to the machine and could take it into his possession upon breach of any of the restrictions. It did not appear in the case, as it did in the Dick case, that the machines were sold at less than cost with the expectation upon the part of the manufacturer of making his profit out of the sale on supplies. The defendant was a purchaser of talking machines in the open market and the bill was brought to enjoin him from selling the talking machines at less than the price fixed by the notice. The bill was sustained on the ground that the plaintiff had never passed complete title to any of the talking machines, the court saying: "A study of these various documents leads to the conclusion that complainant has undertaken to avoid making such a sale of its machine, as would permanently pass it beyond any further control by itself. We think it has succeeded in so doing; this is not a sale outright, or a conditional or restricted sale or any sale at all.

"Under the authorities the owner of a patent who manufactures machines under such patent can give the right to use to whom he pleases upon what conditions he may choose to impose. Some of these conditions may involve pecuniary return, such as royalties, rentals for fixed periods, specified lump sum compensation for the whole period. We do not see why he may not give to one person a more restricted right to use than he does to another. The Dick case, 224 U. S. 1, established the proposition that a restriction to use only with other products of the patentee is legitimate. Of course the giving to any person of a 'right to use' things of this sort is an idle thing, unless the person is also supplied with the physical thing to be

used, to hold the same while he is enjoying the use and complying with its terms."

§ 314*i*. It may be noted that in the Straus case the court gave no consideration to the fact that it did not appear that the plaintiff sold its talking machines at less than cost or that it depended for its profits on the future sale of supplies.

Since the decision in the Dick case legislation has largely nullified its practical results so far as they favor those undertaking to impose use restrictions. If the effect of such a restriction is to "substantially lessen competition or tend to create a monopoly in any line of commerce," the plan comes within the prohibition of the so-called Clayton Law in effect October 15, 1914.[149] Section 3 of that law provides as follows:

"That it shall be unlawful for any person engaged in commerce, in the course of such commerce to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented, for use, consumption or resale within the United States, or any territory thereof . . . on the condition, agreement or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale or contract for sale or such condition, agreement or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce." Act of October 15, 1914, c. 323, Section 3, 38 Stat. 731.

§ 314*j*. The construction of this Act in one aspect came before the Court of Appeals, second circuit, in Motion

[149] Act of October 15, 1914, Chapter 323, Sec. 3, 38 Stat. 731.

Picture Patents Co. *v.* Universal Film Co.,[150] in which a license notice was affixed to a machine for projecting motion pictures, restricting the machine to use only with films, whether patented or unpatented, manufactured by the plaintiff. It appeared from the testimony in the case that the plaintiff had a monopoly under its patents on projecting machines with the result that it would have a consequent monopoly of the film business if the restriction were enforced. The court held that for that reason the license restriction came within the prohibition of the Clayton Law. The Clayton Law was not, however, the sole ground of the decision, the court holding that the case came within the doctrine of Bauer *v.* O'Donnell for the reason that the title to the machine had once passed by virtue of the sale. It may be noted that likewise in the Dick case did the title of the patented mimeograph pass by the sale, at least to as great an extent as the projecting machine in the Motion Picture Patents Co. case. The case was distinguished from the case of Victor Talking Machine Co. *v.* Straus for the same reason.

As this book goes to press, the decisions in both the Victor Talking Machine Co. case and the Motion Picture Patents Co. case are being reviewed by the Supreme Court. However, the law to date appears to be that the patentee may, if he chooses, reserve to himself title to the patented article, in which event he may impose such restrictions as he pleases.

Other cases following or based upon the Supreme Court decisions cited in the foregoing sections, are found in the note.[151]

[150] Motion Picture Patents Co. *v.* Universal Film Co., 235 F. R. 398, 1916.

[151] Automatic Pencil Sharpener Co. *v.* Goldsmith Bros., 190 F. R. 205, 1911; Winchester Repeating Arms Co. *v.* Buengar, 199 F. R. 786, 1912; Crown Cork & Seal Co.

v. Brooklyn Bottle Stopper Co., 200 F. R. 592, 1912; Waltham Watch Co. *v.* Keene, 202 F. R. 225, 1913; Robt. H. Ingersoll & Bro. *v.* McColl, 204 F. R. 147, 1913; Free Sewing Machine Co. *v.* Bry-Block Mercantile Co., 204 F. R. 632, 1913; Kellogg Toasted Cornflake Co. *v.* Buck, 208 F. R. 383, 1913; Ford Motor Co. *v.* International Automobile League, 209 F. R. 235, 1913; Rajah Auto Supply Co. *v.* Rex Ignition Mfg. Co., 209 F. R. 622, 1913; United States *v.* Kellogg Toasted Cornflake Co., 222 F. R. 725, 1915; Ford Motor Co. *v.* Union Motor Sales Co., 225 F. R. 373, 1915; American Graphophone Co. *v.* Boston Store, 225 F. R. 785, 1915 (in which case a price restriction was upheld on the ground that there was a specific agreement so requiring, between the patentee and the manufacturer); Eliot Machine Co. *v.* Center, 227 F. R. 124, 1915; Sheridan-Clayton Paper Co. *v.* U. S. Envelope Co., 232 F. R. 153, 1916.

CHAPTER XIII

INTERFERING PATENTS

315. Characteristics and causes of interfering patents.
316. Actions in equity between interfering patents.
317. The questions and issues in such actions.
318. The evidence in such actions.
319. Injunctions in such actions.
320. The proper decrees in such actions.

§ 315. PATENTS which contain one or more claims in common, are interfering patents.[1] But a generic claim, and a specific claim, the first of which secures a particular process or mechanism, with its indispensable characteristics, with or without its minor features, and the last of which secures the same process or mechanism, with but not without its minor features, are not co-extensive claims, and therefore do not interfere with each other.[2] All but one of several interfering patents are necessarily void, as to the interfering claim or claims; though all may be valid as to the other claims which they respectively contain.[3]

There are two causes which lead to the granting of interfering claims. Such claims may be granted because of inadvertence or erroneous judgment on the part of the Patent Office; and they may be granted because applications do not always happen to be made in the order of in-

[1] Nathan Mfg. Co. *v.* Craig, 49 F. R. 370, 1892; Dederick *v.* Fox, 56 F. R. 717, 1893; Simplex Railway Appliance Co. *v.* Wands, 115 F. R. 520, 1902.

[2] Stonemetz Mach. Co. *v.* Brown Mach. Co., 57 F. R. 605, 1893.

[3] Gold and Silver Ore Co. *v.* Disintegrating Ore Co., 6 Blatch. 311, 1869.

ventions. The first cause may operate when the Patent Office examiners overlook an anticipating patent, while examining an application in point of novelty; or when they form an erroneous opinion that an existing patented claim is substantially different from the claim under immediate inspection. The second cause may operate when one person who is not the first inventor of a particular thing, applies for and receives a patent thereon, before another person, who is the first inventor of that thing, files his application in the Patent Office. Under such circumstances. it is the duty of the Commissioner to declare an interference between the patent, and the unpatented application, and if, in that interference proceeding, the later applicant is adjudged to be the prior inventor, and if the application is otherwise unobjectionable, it becomes the duty of the Commissioner to grant him a patent.[4] The Commissioner has, however, no authority to recall the patent theretofore granted to the wrong party. That patent can be repealed by the courts alone.

§ 316. An action in equity is the prescribed proceeding by means of which the interfering claims of two or more issued patents may be adjudicated, in point of relative priority.[5] Such an action may be joined with an action for infringement,[6] where the complainant's patent was issued first. But where the defendant's patent was issued first, an action for infringement of the complainant's patent by the defendant, cannot be joined with such an interference action.[7]

In previous editions of this book it has been stated that

[4] Revised Statutes, Section 262, 1883; Swift *v.* Jenks, 29 F. R. 642, 1887; Holliday *v.* Pickhardt, 29 F. R. 853, 1887; Hubel *v.* Dick, 28 F. R. 139, 1886.

[5] Revised Statutes, Section 4915.

[6] Leach *v.* Chandler, 18 F. R. 4904.

[7] American Roll-Paper Co. *v.* Knopp, 44 F. R. 611, 1891.

where such a suit in equity is brought without joining an action for infringement therewith, a cross-bill, based on alleged infringement by the complainant of the defendant's patent, is not proper,[8] and that a cross-bill is improper, which seeks to institute an interference action, in response to an action for infringement alone.[9]

These decisions cited on these points probably still hold good in spite of the second paragraph of Equity Rule 30 promulgated November 4, 1912, wherein it is provided that the answer may, without cross-bill, set out any set-off or counterclaim which might be the subject of an independent suit in equity against the plaintiff.[9a]

The complainant in an interference suit may be the patentee or assignee of either of the interfering patents, or a grantee or licensee thereunder; for all these persons fall within the category mentioned in the statute; a category which includes every person interested in any one of the patents, or in the working of the invention claimed under any of them. The defendant may be any patentee, assignee, grantee or licensee who is interested in another of the interfering patents. And if the interfering patents were originally applied for by a single inventor and assigned to different parties, the latter may be plaintiffs and defendants in such a suit.[10] It is neither necessary that all the possible complainants should join in a suit, nor that all the possible defendants should be brought before the court. The statute provides that no decree entered in such a suit, shall affect either patent, except so far as the patent affected is owned by parties to the suit, or by persons deriving title under them after the ren-

[8] Stonemetz Mach. Co. *v.* Brown Mach. Co., 46 F. R. 851, 1891.

[9] New Departure Bell Co. *v.* Hardware Co., 62 F. R. 462, 1894.

[9a] See Section 591.

[10] Keystone Trading Co. *v.* Zapota Mfg. Co., 210 U. S. 456, 1913.

dition of such decree. The proper practice is to make all persons complainants who have a right, and who are willing, to be so made; and to make all persons defendants who are liable to be made so, and who are inhabitants of the district where the suit is brought, or who shall be found in that district.[11]

A bill cannot be filed in an interference suit until the complainant's patent is actually granted,[12] and until the defendant's patent is actually granted there is no occasion for such a bill. No cross-bill or counterclaim is either necessary or proper in a suit of this kind, because the statute provides that in such a suit the court may adjudge either of the patents to be void, which provision is held to refer to any grounds of invalidity which may be found to exist.[13] The defendant may therefore obtain all rightful affirmative relief without becoming himself a complainant in a cross-bill,[14] or setting out a counterclaim. And the defendant's right to such relief prevents the complainant from dismissing his bill without the defendant's consent.[15] Since, by the terms of the statute, the judgment binds only the parties to the suit and those deriving title from them subsequent to the rendition of the judgment, it is proper for the court to enjoin the defendant from transferring his patent pending the outcome of the suit.[16]

§ 317. The questions which may arise in an interference suit are the following: 1. The presence or absence

[11] 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470; *In re* Hohorst, 150 U. S. 661, 1893.

[12] Hoeltge *v.* Hoeller, 2 Bond, 338, 1870.

[13] Nikola Tesla Co. *v.* Marconi Wireless Telegraph Co., 227 F. R. 903, 1915.

[14] Lockwood *v.* Cleveland, 6 F. R. 721, 1884.

[15] Electrical Accumulator Co. *v.* Brush Electric Co., 44 F. R. 606, 1890.

[16] Keystone Trading Co. *v.* Zapota Mfg. Co., 210 F. R. 456, 1913.

of an interference between the patents.[17] 2. The question whether the subject of the interference was patentable at all or whether either of the patents is void on any ground.[18] 3. The question whether the first party to conceive the invention involved in the suit, was also the first to reduce it to practice, or to file an application for a patent thereon, as the case may be. 4. The question whether the first party to conceive the invention, if he neither reduced it to practice nor applied for a patent thereon, till after another party to the suit did one or the other of those things, was negligent of the invention, before that other party conceived the invention himself.

The first and second of these questions may depend on the construction of the patent; and that construction may depend on evidence of the prior art. Where that construction can be based on the words of the patents, with or without taking judicial notice of facts not stated therein, the first and second questions may be decided on demurrer,[19] but not otherwise.[20] The interfering claims of the two patents must be substantially identical, else there is no jurisdiction under Section 4918. The identity of the claims is the sole test of the question of the existence of an interference.[21] The second question involves lack of invention, want of novelty and any other defence which may constitute a defence to an ordinary patent suit.[22]

[17] Revised Statutes, Section 1918.

[18] Palmer Pneumatic Tire Co. *v.* Lozier, 90 F. R. 732, 1898; General Chemical Co. *v.* Blackmore, 156 F. R. 968, 1907; Dittgen *v.* Racine Paper Goods Co., 181 F. R. 394, 1910; Nikola Tesla Co. *v.* Marconi Wireless Telegraph Co., 227 F. R. 903, 1915.

[19] Morris *v.* Mfg. Co., 20 F. R. 121, 1884.

[20] Simplex Railway Appliance Co. *v.* Wands, 115 F. R. 517, 1902.

[21] Boston Pneumatic Power Co. *v.* Eureka Patents Co., 139 F. R. 29, 1905.

[22] Nikola Tesla Co. *v.* Marconi Wireless Telegraph Co., 227 F. R. 903, 1915.

The third and fourth of the questions defined in the first paragraph of this section are properly investigated and decided by means of the rules which are stated and explained under the head of interferences, in that chapter of this book which is devoted to applications for patents.[23] Those two questions relate to the same issue of fact. If the complainant's invention is the older, the defendant's interfering claim is void for want of novelty.[24] And the complainant's interfering claim is void for want of novelty, if the defendant's invention is found to antedate the other.[25]

§ 318. The evidence upon which interference suits are decided, may consist of documents and exhibits, proved and supplemented by depositions of witnesses. Such depositions may be taken in the same ways in which depositions may be taken in infringement cases.[26] And any deposition which was taken in an interference in the Patent Office, between the same inventions, is admissible, or not admissible as the case may be, in an interference suit, according to those rules of the law of evidence, which relate to the use in one case, of depositions which were taken in another.[27]

A properly authenticated copy of the decision of the Commissioner of Patents in such an interference, or of the Court of Appeals of the District of Columbia reviewing such a decision of the Commissioner, is admissible in evidence in an interference suit between patents on inventions which were involved in such an interference.

[23] Sections 140–141*c* of this book.

[24] Pacific Cable Ry. Co. *v.* Butte City Ry. Co., 52 F. R. 865, 1892.

[25] National Cash Register Co. *v.* Lamson Store-Service Co., 60 F. R. 603, 1894.

[26] Section 639 of this book.

[27] Section 640 of this book; Clow *v.* Baker, 36 F. R. 692, 1888.

If not reversed by that court; the decision of the Commissioner is *prima facie* evidence in favor of the patent last granted, because he would not have granted it if he had not decided it to be entitled to priority in point of date of invention.[28] And any decision of that court, is also *prima facie* evidence in favor of the patent last granted, for that patent would never have existed, if that court had decided the interference against the applicant therefor.

§ 319. Injunctions are not expressly authorized by that section of the statute, which provides for interference suits. But Justice NELSON decided in 1863, that a preliminary injunction can be granted in such a case, on the ground that "the power conferred upon the Circuit Court to entertain bills in equity, in controversies arising under the patent act, is a general equity power, and carries with it all the incidents belonging to that species of jurisdiction." [29] And that decision has been reaffirmed and repeated in recent times.[30]

§ 320. The hearing of an interference case may disclose that there is no interference between the patents before the court; or that there is such an interference. In the former event, the proper decree to enter is one dismissing the complainant's bill; and in the latter event, the proper decree is one adjudging the patent issued on the later of the inventions to be void, so far as it covers the interfering matter, and so far as the title of the parties to the suit extends.[31] Such a decree should be entered regardless of whether the patent to be voided is that of the defendant

[28] Pacific Cable Ry. Co. *v.* Butte City Ry. Co., 52 F. R. 865, 1892.

[29] Potter *v.* Dixon, 5 Blatch. 165, 1863.

[30] Palmer Pneumatic Tire Co. *v.* Lozier, 69 F. R. 348, 1895.

[31] Gilmore *v.* Golay, 3 Fisher, 522, 1869; Sturges *v.* Van Hagan, 6 Fisher, 572, 1873.

or that of the complainant. If it is the latter, a decree merely dismissing the complainant's bill will not answer the purpose; because such a decree does not necessarily involve such a conclusion.[32] It may mean only that there is no interference; or it may merely mean that the complainant has no proper title to the patent which he invokes.

[32] Tyler *v.* Hyde, 2 Blatch. 310, 1851.

CHAPTER XIV

REPEAL OF PATENTS.

321. Patents obtained by fraud, or granted by mistake.
322. Jurisdiction of equity to repeal patents so obtained or so granted.
323. Practice in such cases.

§ 321. PATENTS and reissues may sometimes be obtained by fraud; and sometimes be granted by mistake. The facts which constitute the fraud, or which make the granting a mistaken one, may generally be interposed as one of the defences to an infringement suit; but where those facts are such that no one of those defences can be based upon them, they cannot be interposed merely because they constitute a fraud,[1] or constitute a mistake.[2] Nor can any individual bring any action to repeal or otherwise set aside a patent, on any ground of fraud; or indeed on any ground whatever, except that of an interference.[3] Where frauds are ingenious enough to keep clear of all known defences to infringement suits, the wrongs which they cause are without a remedy, unless the United States courts will repeal a patent which United States officers have fraudulently been induced to grant, or to reissue. For when a patent has been signed and sealed in the Patent Office, it cannot be revoked or canceled by the President of the United States, or any other

[1] Railroad Co. *v.* Dubois, 12 Wallace, 64, 1870; Western Glass Co. *v.* Schmerz Wire-Glass Co., 185 F. R. 788, 1911.

[2] Doughty *v.* West, 6 Blatch. 433, 1869; Calculagraph Co. *v.* Wilson, 132 F. R. 20, 1904.

[3] Mowry *v.* Whitney, 14 Wallace, 439, 1871.

officer of the Government.[4] For the same reason, where a patent is granted by mistake, instead of being refused, as it ought; and where the ground of refusal does not constitute ground of defence to a suit for infringement; the wrongs which such a mistake will occasion must be remedied by a repeal of the patent, or they are remediless.

§ 322. Equity has jurisdiction to repeal letters patent for inventions where they were obtained by fraud, whenever the United States files a bill of complaint, stating the facts and praying that the letters patent may be annulled.[5] And the same jurisdiction exists, where such letters patent are issued by any such mistake as those for which courts of equity grant relief, except so far as the peculiar provisions of the patent statutes may limit the general rule; but this jurisdiction to repeal letters patent, which may be claimed to have been issued by mistake, does not extend to error of judgment in deciding any debatable question of difference of invention.[6]

§ 323. A bill to repeal a patent must be filed before the expiration of the patent,[7] and in some District Court of the United States,[8] which has jurisdiction of the owner of the patent sought to be repealed. The District Court for the district in which that owner is an inhabitant, is such a court; as also probably is the District Court for any district wherein that owner can be found.[9] In beginning and prosecuting an action in equity to repeal a patent, the United States acts through the United States District Attorney of the district in which the action is

[4] McCormick Mach. Co. *v.* Aultman, 169 U. S. 608, 1898.

[5] United States *v.* Bell Telephone Co., 128 U. S. 373, 1888.

[6] United States *v.* Bell Telephone Co., 167 U. S. 264, 1897.

[7] Bourne *v.* Goodyear, 9 Wallace, 811, 1869.

[8] Revised Statutes, Section 629, paragraph 9.

[9] 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470; *In re* Hohorst, 150 U. S. 661, 1893.

brought;[10] and he acts under the direction of the Attorney General of the United States;[11] who may be prompted by the Commissioner of Patents;[12] or by any private person. But no citizen has any power to compel the Attorney General, or the District Attorney, to begin such a suit, or to control its prosecution after it is begun.[13] The pendency of a bill to repeal a patent, will not affect the progress of an infringement suit based on that patent;[14] and no injunction will issue to restrain a patentee from bringing infringement suits, pending a bill in equity to repeal the patent upon which he proposes to bring them.[15]

[10] Attorney General *v.* Rumford Chemical Works, 2 Bann. & Ard. 308, 1876.

[11] United States *v.* Bell Telephone Co., 128 U. S. 350, 1888.

[12] McCormick Mach. Co. *v.* Aultman, 169 U. S. 612, 1898.

[13] New York & Baltimore Coffee Polishing Co. *v.* New York Coffee Polishing Co., 9 F. R. 580, 1881.

[14] American Bell Telephone Co. *v.* National Telephone Co., 27 F. R. 666, 1886.

[15] United States *v.* Colgate, 21 F. R. 318, 1884.

CHAPTER XV

QUI TAM ACTIONS

324. *Qui tam* actions, defined and described as they exist in the patent laws.
325. The wrongs which are the foundations of such actions.
326. The first two of those three classes of wrongs.
327. The third of those three classes of wrongs.
328. Wrongs of either class are completed when the articles are illegally marked, without any subsequent using or selling.
329. The amount of the recoverable penalty.
330. The parties in *qui tam* patent cases.
331. The forum for *qui tam* patent actions.
332. The form of the suit, and the requisites of a declaration, in such an action.
333. Injunctions to restrain the commission of wrongs of either of the first two classes.
334. Appeals in *qui tam* patent cases.

§ 324. THESE are certain actions at law, which derive their name from the Latin words *qui tam*, used at the beginning of the declaration in such an action, in times when all declarations were written in the Latin language. No such action was known to the common law of England; but several actions of the kind have long been prescribed by statute, in that country, and in this. *Qui tam* actions relevant to patents are authorized by Section 4901 of the Revised Statutes. That statute forbids certain classes of acts; and provides that whoever commits an act of either of those classes, shall be liable to a penalty of not less than one hundred dollars, with costs; and that any person may sue for that penalty, in any District Court of the United States within whose jurisdiction the offence

was committed; and that one-half of the penalty, when recovered, shall go to the plaintiff, and the other half to the United States.

§ 325. The forbidden acts are: 1. Unauthorized marking, upon any patented article, of the name, or any imitation of the name, of the patentee. 2. Unauthorized marking, upon any patented article, of 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. 3. Marking upon any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public.

§ 326. The first two of these three classes of acts are injurious to the public, and to the patentees. They are injurious to the public in that they are adapted to mislead persons into buying and using articles which were made and sold in violation of patents, and which therefore cannot be lawfully used even by innocent purchasers. The law provides that those who have a right to make and sell patented articles shall mark those articles with the word "patented";[1] and that other persons shall not so mark such articles.[2] When buying anything which is not so marked, a purchaser properly concludes that it is not patented, and that he may therefore use it without risk of a suit for infringement; and when buying anything that is so marked, the purchaser concludes, with equal propriety, that it was made and sold by the patentee or some one lawfully authorized by him, and that therefore it may be lawfully used to any extent desired. It is clear, that on these accounts, the first two of the forbidden acts are detrimental to public security, and therefore opposed

[1] Revised Statutes, Section 4900.

[2] Revised Statutes, Section 4901.

to public policy. The same acts are also injurious to patentees, and they will be considered in that aspect in a subsequent section. But the second of the forbidden acts is not committed by marking the word "patented" upon a case containing patented articles of such a character that they could themselves have been thus marked.[3]

§ 327. The last of the three forbidden classes of acts is injurious to the public, in that it is adapted to mislead persons into an opinion that they have no right to make and use, or make and sell, other specimens of the thing marked as being patented. When an unpatented thing is so marked, it is immaterial whether it is a patentable thing or not.[4] Whether a thing is patentable or not depends on considerations of which the public as a whole are necessarily ignorant. They may therefore be deceived by seeing the word "patented" upon an unpatentable unpatented article, as readily as by seeing the same word upon a patentable unpatented article. That word warns them not to copy that article. They are as reluctant to disregard that warning on a supposition that the article is not patentable, as they are on the hypothesis that it is not patented; and they are as effectually diverted from exercising their right to copy it in the one case as in the other.

Intent to deceive the public is a necessary element of the forbidden act now under consideration; and that intent must exist at the time of the marking;[5] and it does not exist when the person marking, is himself mistaken relevant to his right so to mark;[6] or where the word "patented"

[3] Smith *v.* Walton, 51 F. R. 17, 1892; 56 F. R. 499, 1893.

[4] Oliphant *v.* Salem Flouring Mills Co., 5 Sawyer, 128, 1878; Winne *v.* Snow, 19 F. R. 509, 1844.

[5] Hotchkiss *v.* Wooden Ware Co., 53 F. R. 1018, 1891; Loudon *v.* Everett H. Dunbar Corporation, 179 F. R. 506, 1910.

[6] Walker *v.* Hawxhurst, 5 Blatch. 494, 1867; Russell *v.* Newark Mach. Co., 55 F. R. 300, 1893.

is accompanied by other words or characters which indicate that the article was once the subject of a patent, but that the patent has expired at the time of the marking.[7] Inasmuch as all persons are presumed to intend the natural consequences of their acts, proof of an act which was adapted to deceive the public, is sufficient proof of the intent to deceive, unless the doer establishes his innocence of that intent. The burden of proof therefore lies upon the defendant, in this particular.[8] That burden can be carried by showing that the person marking, honestly believed that the thing marked was really patented by a particular patent; but it cannot be carried by showing that the person marking did not know whether the article marked was patented or not; and the question whether a particular thing marked "patented" is really patented by a particular patent, is a question of construction for the court.[9] Where the defendant is a corporation, the intent to deceive the public may be that of an officer or agent, who acted within the scope of his authority, in causing the marked article to be made and prepared for sale.[10] The forbidden act treated in this section, is not committed by marking upon a patented article the number and date of a patent which does not cover it, where it is also marked with the number and date of a patent which does cover it.[11]

§ 328. Proof that the article illegally marked "patented" was afterward sold, or was otherwise presented to the notice of the public, is not a necessary element in either of the acts which are forbidden by the statute; but proof that the intent to deceive the public existed when

[7] Wilson *v.* Mfg. Co., 12 F. R. 57, 1882.

[8] Brig Struggle *v.* United States, 9 Cranch, 74, 1815.

[9] Tompkins *v.* Butterfield, 25 F. R. 556, 1885.

[10] Tompkins *v.* Butterfield, 25 F. R. 559, 1885; Hotchkiss *v.* Wooden Ware Co., 53 F. R. 1018, 1891.

[11] Russell *v.* Newark Machine Co., 55 F. R. 300, 1893.

the marking was done is such an element. Accordingly, if a person illegally marks an article, his offence is complete, and is not condoned by a subsequent omission to profit by that offence; but where a person marks an article without any intent to deceive, and afterward uses the article so marked for purposes of deception, he does not violate the statute.[12] Where a person illegally marks an article in one judicial district of the United States, and offers it for sale in another, he violates the statute in the former district but not in the latter.[13]

§ 329. The penalty prescribed by the statute for either of the forbidden acts is "not less than one hundred dollars"; and that language must, in a penal statute like this, be strictly construed, and when so construed, it authorizes a penalty of precisely one hundred dollars and no more.[14] Judge THAYER once instructed a jury that where several unpatented articles are marked "patented" on the same day, and at the same time, so that the act of marking is practically continuous, but one offence is committed under the statute, and only a single penalty is recoverable for all the articles thus marked.[15]

§ 330. The plaintiff in a *qui tam* action for illegally marking a patented or unpatented article may be any "person," [16] whether he was injured by the doings of the defendant or not.[17] It was decided under a similar statute relevant to copyrights, that a plurality of persons could not join as plaintiffs in an action of the kind.[18] The lan-

[12] Nichols *v.* Newall, 1 Fisher, 647, 1853.

[13] Pentlarge *v.* Kirby, 19 F. R. 504, 1884.

[14] Stimpson *v.* Pond, 2 Curtis, 502, 1855.

[15] Hotchkiss *v.* Wooden Ware Co., 53 F. R. 1021, 1891; Loudon *v.* Everett H. Dunbar Corporation, 179 F. R. 506, 1910.

[16] Revised Statutes, Section 4901.

[17] Winne *v.* Snow, 19 F. R. 508, 1884.

[18] Ferrett *v.* Atwill, 1 Blatch. 153, 1846.

guage of that copyright statute was identical with that of the present patent statute in this particular; and the same reasoning which carried the court to its conclusion in the copyright case, will probably carry any court to the same conclusion in any *qui tam* action under the patent statute. The person who sues must be a natural and not an artificial person; and he must sue in his own name and not in that of the United States,[19] though it is not improper for him to state that he sues for the United States, as well as for himself.[20]

The defendant may be the particular natural person who did the marking complained of, or the particular corporation which caused it to be done, or which otherwise became responsible therefor.[21] The death of the defendant, if a natural person, will end a *qui tam* patent case, and will terminate the right of action on which it is based.[22]

§ 331. Jurisdiction in *qui tam* actions, unlike that in other kinds of patent suits, has always been conferred solely upon District Courts, and has never been conferred upon Circuit Courts of the United States, and is conferred for each case, upon the particular District Court within the district of which the forbidden act was committed.[23]

§ 332. The proper form of common-law action in *qui tam* cases is that of debt.[24] Inasmuch, however, as no particular form is prescribed by the Federal statute, the

[19] United States *v.* Morris, 2 Bond, 27, 1866.

[20] Winne *v.* Snow, 19 F. R. 508, 1884.

[21] Hotchkiss *v.* Wooden Ware Co., 53 F. R. 1020, 1891; Loudon *v.* Everett H. Dunbar Corporation, 179 F. R. 506, 1910.

[22] Schreiber *v.* Sharpless, 17 F. R. 589, 1883.

[23] Revised Statutes, Section 4901; Winne *v.* Snow, 19 F. R. 509, 1884; Pentlarge *v.* Kirby, 19 F. R. 505, 1884.

[24] Stimpson *v.* Pond, 2 Curtis, 505, 1855; Jacob *v.* United States, 1 Brockenbrough, 520, 1821.

code forms of complaints or petitions are to be used in code States.[25] The declaration, complaint, or petition, as the case may be, ought to state all the elements of the forbidden act upon which it is based;[26] and to charge that the act was contrary to the form of the statute in such cases made and provided.[27] It is not necessary to aver the uses to which the penalty, when recovered, is to be applied.[28] A declaration, complaint or petition in a *qui tam* patent case, is tested in point of sufficiency, by the rules applicable to civil actions in the State in which the District Court is established, when that sufficiency is drawn in question in that court.[29] And each "marking" complained of must be separately stated, as a separate cause of action, in order to recover on all the "markings" cumulatively.[30]

§ 333. The first two of the classes of acts forbidden by Section 4901 of the Revised Statutes are not only injurious to the public, in the manner already explained, but they are also injurious to the rightful patentees. Such acts enable infringers to increase the amount of their infringements, by inducing the public to believe that the articles they sell were lawfully made, and may be lawfully sold and used. So also, such an act may enable an infringer to palm off on the public an inferior article, the using of which will disappoint the purchaser, and thus operate to injure the reputation of the genuine thing. For these reasons, it has been held that a person who is guilty of an act of

[25] Revised Statutes, Sections 721, 914; Hoyt *v.* Computing Scale Co., 96 F. R. 251, 1899.

[26] Ferrett *v.* Atwill, 1 Blatch. 155, 1846.

[27] Sears *v.* United States, 1 Gallison, 259, 1812; Smith *v.* United States, 1 Gallison, 264, 1812; Kendrick *v.* United States, 1 Gallison, 273, 1812.

[28] Sears *v.* United States, 1 Gallison, 259, 1812.

[29] Fish *v.* Manning, 31 F. R. 340, 1887.

[30] Hoyt *v.* Computing Scale Co., 96 F. R. 251, 1899.

either of the first two classes, may be restrained by an injunction from any repetition of such an act.[31]

§ 334. A writ of error lies to the Circuit Court of Appeals for the circuit, from the final judgment of a District Court in a *qui tam* patent case; but no such writ of error lies from a Circuit Court of Appeals to the Supreme Court of the United States; though such a case may go to the latter tribunal upon a certificate from the former, or upon a certiorari from the Supreme Court.[32]

[31] Washburn & Moen Mfg. Co. v. Haish, 4 Bann. & Ard. 571, 1879.

[32] Judicial Code, Sections 128, 238 and 240.

CHAPTER XVI

INFRINGEMENT

335. Infringement of process patents, illustrated by the case of Tilghman *v.* Proctor.
336. Illustrated by the case of Mowry *v.* Whitney.
337. Illustrated by the case of Cochrane *v.* Deener.
338. Equivalents in processes and additions thereto.
339. Infringement of patents for machines or manufactures.
340. Comparative results.
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343. As illustrated by the Driven-Well cases.
344. As illustrated by Blanchard's patent for turning irregular forms.
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347. Addition.
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371. Substitution of ingredients, as illustrated by the Giant-Powder cases.
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375. Infringements of patents for designs.
376. Comparative utility as a criterion of infringement.
377. Knowledge of a patent by an infringer, not a necessary element in its infringement.

§ 335. A PATENT for a process is infringed by him, who, without ownership or license, uses substantially the process which the patent claims; whether or not he uses substantially the apparatus which the patent describes,[1] and whether he uses the materials prescribed by the patent, or uses equivalents therefor.[2] Infringement of a process patent may occur even where precise identity does not exist in respect of the process claimed by the patent, and that used by the infringer.[2a] In the leading case first cited, the apparatus used by the infringer was totally unlike that described by the patent; and the process used by the infringer differed from the patented process in several particulars. The claim of the patent was: "The manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure." The description of the process which was contained in the specification of the patent, stated that the water should be mixed with the fatty body in the proportion of two or three parts of fat to one of water; and that the mixture should be heated to about 612° Fahrenheit; and should be subjected to a pressure sufficient to prevent the heat from converting the water into steam.

[1] Tilghman *v.* Proctor, 102 U. S. 730, 1880.

[2] Schwarzwalder *v.* Filter Co., 66 F. R. 158, 1895. See Section 362.

[2a] See Section 338.

The infringer mixed from four to seven per cent of lime with the water and the fat; and heated the mixture to only about 310° Fahrenheit; and subjected it to a pressure correspondingly lower than what would have been necessary to prevent the conversion of the water into steam, if he had used the higher degree of heat. So also, he heated his mixture by means of superheated steam introduced into the vessel containing it, instead of applying heat to the outside of the vessel; and he maintained the intimacy of the mixture by continuously pumping the water from the bottom to the top of the mingled mass, instead of continuously forcing the mixture through a coil of tubes. Notwithstanding all these differences, the Supreme Court held the defendant's process to substantially include that of the patent, and therefore to be an infringement of the latter. This holding was not inconsistent with the opinion that the addition of the lime to the mixture, was a useful addition to the patented process, nor with the possibility that the defendant's method of maintaining the intimacy of the mixture, was superior to that of the patent, nor with the probability that the heating by the introduction of superheated steam, was more perfect than by conducting the heat into the mixture through the walls of the inclosing vessel, nor with the fact that the lower degree of heat and of pressure used by the defendant was more safe, and perhaps more economical, than the higher degree of each, which was suggested in the patent.

§ 336. Similar circumstances characterized the question of infringement in the case of Mowry *v.* Whitney.[3] The patent in that case covered a process, which consists in taking cast iron car-wheels from their moulds as soon as they become solid enough to retain their shape; and in immediately placing the wheels in a furnace or chamber,

[3] Mowry *v.* Whitney, 14 Wallace, 620, 1871.

previously heated to about the temperature of the wheels when taken from the moulds; and in thereupon reheating those wheels; and then in causing them to finally cool with a great degree of slowness.

The infringer's process consisted in taking the wheels red hot from the moulds; and in thereupon putting them in an unheated chamber, interlaying them with charcoal, and covering the whole with a perforated metal plate; and in then causing the charcoal to burn so as to reheat the wheels to a somewhat indefinitely high temperature; and in so adjusting the draft, as to make the charcoal burn out, and the wheels to consequently cool down, with a great degree of slowness. The Supreme Court found all of the steps of the complainant's process in the defendant's doings, though confessedly the reheating was done by different means, and the slow cooling regulated on different principles, from those which caused and controlled the corresponding parts of the complainant's process.

§ 337. The case of Cochrane *v.* Deener [4] involved the infringement of a patent for a process of winnowing impurities out of ground wheat, while the flour is being separated from the other parts of the meal by means of fine cloth sieves, commonly called "bolts." The patent described a suitable apparatus by means of which to practice this process. It consisted of a series of cylindrical sieves, covered with cloth of progressively finer meshes, and having within them a series of air pipes, so disposed that when the ground wheat was in the sieves, and the sieves were revolving, air blasts were blown from the ends of those pipes, into and among the particles of ground wheat. Those air blasts operated to blow the impurities through the opening in the top of the bolting chamber, at the same time that the revolutions of the sieves operated

[4] Cochrane *v.* Deener, 94 U. S. 787, 1876.

to separate the flour from the middlings. The result of the whole operation was to separate the ground wheat into three sorts of matter, and to place those three sorts in three different receptacles.

The defendant accomplished the same result, by winnowing the impurities out of the ground wheat, while the flour was being separated from the other parts of the meal by means of fine cloth sieves. But the defendant's sieves were flat, and the air blasts were blown through those sieves from below and reached the impurities through the cloth, instead of reaching them from the ends of pipes located on the same side of the cloth, as that occupied by the ground wheat. The Supreme Court, however, held that process to infringe the complainant's patent, notwithstanding these differences.

§ 338. No process patent is infringed where any one of the series of acts which constitute the process is omitted by the supposed infringer, unless some equivalent act is substituted for the one omitted.[5] Precisely what constitutes equivalency, as between acts, has never been decided or stated by the Supreme Court. Reason seems to indicate that one act is the equivalent of another when it works in substantially the same way to accomplish the same result. Accordingly, it has been held that tamping oil wells with benzine, is equivalent to tamping them with water in respect of the series of acts which constitute the process covered by the Roberts torpedo patent.[6] An addition to a patented process does not avert infringement,

[5] Royer *v.* Coupe, 146 U. S. 531, 1892; Dittmar *v.* Rix, 1 F. R. 342, 1880; Hammerschlag *v.* Garrett, 10 F. R. 479, 1882; Cotter *v.* Copper Co., 13 F. R. 234, 1882; Arnold *v.* Phelps, 20 F. R. 315, 1884; Brush Electric Co. *v.* Julien Electric Co., 41 F. R. 679, 1890; Brush Electric Co. *v.* Accumulator Co., 47 F. R. 49, 1891; Kennedy *v.* Solar Refining Co., 69 F. R. 718, 1895.

[6] Roberts *v.* Roter, 5 Fisher, 295, 1872.

even where the addition is an improvement.[7] Neither is infringement avoided by merely reversing the steps in the process, when the same result is accomplished in substantially the same way,[8] nor by the fact that the process is used by the infringer for the attainment of a different object,[9] nor by the mere fact that two or more steps in the process are not taken simultaneously, where simultaneous action is not necessary to the result or to invention.[10] But infringement of a process patent, is absent from a process which does not proceed with substantially the same mode of operation as that of the process described and claimed in the patent.[11]

A process patent is not infringed by the purchase in the open market of a product of the process made by an infringing user of the process.[11a]

§ 339. Machines and manufactures may well be treated together in respect of infringement, because no exact line can be drawn between them, and because the same rules

[7] Lalance & Grosjean Mfg. Co. *v.* Habermann Mfg. Co., 53 F. R. 380, 1892; Tuttle *v.* Matthews, 28 F. R. 98, 1886; New York Filter Co. *v.* Schwarzwalder, 58 F. R. 579, 1893; Edison Electric Light Co. *v.* Philadelphia Trust Co., 60 F. R. 398, 1894; Ford Morocco Co. *v.* Tannage Patent Co., 84 F. R. 644, 1898.

[8] Burdon Wire & Supply Co. *v.* Williams, 128 F. R. 927, 1904; Malignani *v.* Germania Electric Lamp Co., (citing numerous cases), 169 F. R. 299, 1909; General Electric Co. *v.* Hill-Wright Electric Co., 174 F. R. 996, 1909; Malignani *v.* Hill-Wright Electric Co., 177 F. R. 430, 1910; Chadcloid Chemical Co. *v.* F. W. Thurston Co., 220 F. R. 685, 1915.

[9] U. S. Mitis Co. *v.* Midvale Steel Co., 135 F. R. 103, 1904.

[10] Fullerton Walnut Growers' Ass'n *v.* Anderson-Barngrover Mfg. Co., 166 F. R. 443, 1908.

[11] Philadelphia Creamery Supply Co. *v.* Davis & Rankin Bldg. & Mfg. Co., 79 F. R. 357, 1897; Electric Smelting & Aluminum Co. *v.* Pittsburg Reduction Co., 111 F. R. 742, 1901.

[11a] American Graphophone Co. *v.* Gimbel Bros., 234 F. R. 361, 1916.

of infringement are applicable to both those classes of tangible things. A patent for a machine or manufacture is infringed by him who, without ownership or license, makes, or uses, or sells any specimen of the thing covered by any claim of that patent. Merely making without selling is an infringement.[12] It is not an infringement of a patent, to make, use, or sell any specimen of any invention described but not claimed therein;[13] because a patent covers only what it claims. But whoever infringes any one claim of a patent infringes the patent, whether or not it contains other claims which he does not infringe.[14]

Whether a particular thing made or used or sold by a particular person, infringes a particular claim of a particular patent, is always a question of fact. In some cases that question can readily be decided by the application of one rule of law, and sometimes by the application of another, and sometimes it can be decided only by the judicial sagacity of the tribunal before which the question is tried. Such relevant rules of law as are well established, will now be stated, and, as far as necessary, will be illustrated by describing the leading cases which embody them.

§ 340. The respective results of a machine or manufacture covered by the claim of a patent, and of a machine or manufacture alleged to infringe that claim, do not

[12] Carter Crume Co. *v.* Am. Sales Book Co., 124 F. R. 903, 1903.

[13] Howe *v.* Williams, 2 Cliff. 262, 1863; Waterbury Brass Co. *v.* Miller, 9 Blatch. 93, 1871; Toohey *v.* Harding, 4 Hughes, 253, 1880; Buffington's Iron Building Co. *v.* Eustis, 65 F. R. 807, 1895.

[14] Moody *v.* Fiske, 2 Mason, 115, 1820; Wyeth *v.* Stone, 1 Story, 273, 1840; Pitts *v.* Whitman, 2 Story, 609, 1843; Colt *v.* Arms Co., 1 Fisher, 108, 1851; Pitts *v.* Wemple, 2 Fisher, 10, 1855; Foss *v.* Herbert, 1 Bissell, 121, 1856; Morris *v.* Barrett, 1 Bond, 254, 1859; Singer *v.* Walmsley, 1 Fisher, 558, 1860; McComb *v.* Brodie, 1 Woods, 153, 1871; McComb *v.* Ernest, 1 Woods, 195, 1871.

furnish a criterion by which to decide the question of infringement.[15] Those results may be identical, while the things which produce them are substantially different. Any person may accomplish the result performed by a patented thing without infringing the patent, if he uses means substantially different from those of the patent.[16] To hold the contrary of this rule would be to retard, and not to promote the progress of the useful arts.[17] So also, on the other hand, the result of an alleged infringing machine or manufacture may be different from the result described in the patent without causing that machine or manufacture to escape the charge of infringement, even when that charge is based on unlicensed using. This rule results from the well-established point of law that it is an infringement of a patent to use any machine or manufacture claimed therein, though such use is for a purpose which is not mentioned in the patent.[18] But a machine, which can do a particular kind of work, is not an infringement of a patent on a different machine, which cannot do the same work.[19]

[15] Westinghouse *v.* Boyden 1865; McComb *v.* Brodie, 1 Power-Brake Co., 170 U. S. 562, 1898; Powell *v.* Leicester Mills Co., 103 F. R. 485, 1900; American Fur Refining Co. *v.* Cimiotti Unhairing Mach. Co., 123 F. R. 874, 1903.

[16] O'Reilly *v.* Morse, 15 Howard, 62, 1853; Steam Gauge & Lantern Co. *v.* Mfg. Co., 29 F. R. 447, 1886; Johnson Furnace Co. *v.* Western Furnace Co., 178 F. R. 819, 1910.

[17] Smith *v.* Downing, 1 Fisher, 84, 1850.

[18] Mabie *v.* Haskell, 2 Cliff. 511, Woods, 159, 1871; Zinn *v.* Weiss, 7 F. R. 916, 1881; Union Stone Co. *v.* Allen, 14 F. R. 353, 1882; Cincinnati Ice Machine Co. *v.* Brewing Co., 31 F. R. 472, 1887.

[19] Norton *v.* Jensen, 49 F. R. 875, 1892; Ford *v.* Bancroft, 98 F. R. 309, 1899; Miller *v.* Last Co., 105 F. R. 525, 1900; Branson *v.* Kutz, 105 F. R. 974, 1901; Davey Pegging Mach. Co. *v.* Prouty, 107 F. R. 510, 1901; General Electric Co. *v.* Brooklyn Heights R. Co., 118 F. R. 154, 1902.

§ 341. Mode of operation is a criterion of infringement on one side of that question, but not on the other. If the mode of operation of an alleged infringing thing is substantially different from that covered by the claim alleged to be infringed, it follows that the charge of infringement must be negatived;[20] but if the mode of operation is substantially the same, it does not follow that the charge of infringement must be affirmed.[21] In that case the question must be decided by some additional criterion. To establish an infringement of a claim, the facts must be subjected to several successive tests. If the case fails on either of those tests, no further inquiry need be made; but an infringement cannot be affirmed till all those tests have been applied and have been withstood. The first of these is that which relates to identity of mode of operation. It is therefore important to know wherein this requisite identity consists. A dogmatic statement on that point has probably never been ventured by any court. The nature of the question seems not to admit of an answer which shall be at once short and sufficient. The best way to investigate the subject is probably to reason by analogy from precedents; and accordingly several of the sections which immediately follow, are devoted to an analysis of cases, with a view to furnishing the investigator with data for such reasoning.

§ 342. The Cawood patent[22] covered a machine which combined the mode of operation of an anvil, with the mode

[20] Field *v.* De Comeau, 116 U. S. 187, 1886; Yale Lock Co. *v.* Sargent, 117 U. S. 378, 1886; Smith *v.* Downing, 1 Fisher, 83, 1850; Eames *v.* Cook, 2 Fisher, 149, 1860; Enterprise Co. *v.* Snow, 80 F. R. 537, 1897; Westinghouse Air-Brake Co. *v.* New York Air-Brake Co., 119 F. R. 884, 1902; American Steel & Wire Co. *v.* Denning Wire & Fence Co., 194 F. R. 117, 1912.

[21] Diamond Drill & Mach. Co. *v.* Kelly Bros., 120 F. R. 293, 1903.

[22] Cawood Patent, 94 U. S. 706, 1876.

of operation of a vise. A drawing of the machine is printed on page 492 of 1 Wallace. The railroad rail mended upon it, was supported by it as by an anvil; and at the same time was clasped by it as by a vise. The Supreme Court held that the "Michigan Southern" machine did not infringe the Cawood patent, because while that machine did clasp the rail as a vise, it did not support the rail as an anvil. The same tribunal also held that the Beebe and Smith machine did not infringe the Cawood patent, because its mode of operation was different. It both supported and clasped the rail; but it clasped it by holding it between two jaws, which jaws, when in position, rested in a V-shaped notch in the anvil. The exterior of the jaws were also V-shaped, in order to fit the notch, and they clasped the rail because of their gravity, and not in the manner of a vise. They also supported the rail, but in a manner peculiar to themselves, and not in the manner of an anvil.

§ 343. The driven-well patent, reissue No. 4372, covers an interesting invention. That invention is practiced by driving into the ground a long tube closed and pointed at its lower end, and having perforations through its sides just above that end; and by attaching a pump to its upper end; and by working that pump whenever water is desired. The mode of operation of that well is as follows: The working of the pump rarefies the air in the tube, and outside of the tube in the neighborhood of its lower end, and that rarefication causes the air above the ground to force the water in several millions of cubic feet of the surrounding earth, into and up the tube.

The alleged infringer in one case,[23] followed the patent in every particular except that instead of driving the tube into the earth, or into a hole previously made by driving

[23] Andrews *v.* Long, 12 F. R. 871, 1880.

down a rod smaller than the tube, he bored a hole into the earth with an auger larger than the tube which he placed in the hole after the auger was withdrawn. This apparently slight change caused the well to have a substantially different mode of operation from that covered by the patent. The pump, indeed, rarefied the air in the tube as before, but that rarefication did not extend into the ground around the outside of the tube, because the space outside of the lower end of the tube was in direct communication with external air, through the annular space which surrounded the tube throughout its entire length, and which was due to the fact that the tube was smaller than the hole in which it was placed. Because of this difference, Judge McCrary, with excellent discrimination, held that the well of the defendant did not infringe the driven-well reissue.

§ 344. Blanchard's patent for a machine for turning and cutting irregular forms consisted of a combination of a model, a guide, and a cutter-wheel. When the machine was in operation, the guide followed the irregularities of the model, as the model revolved; and the guide also caused the cutter to follow the same irregular curves, while the rough block was revolved under the cutting edges. Both model and block had a continuous lateral motion, as well as a continuous rotary motion, and therefore the guide and the cutter-wheel proceeded in corresponding spiral courses. In that way, the guide traversed all parts of the surface of the model, and the cutter-wheel traversed all portions of the rough block, and thus reduced the latter to conformity with the shape of the model. An infringer in one case [24] so combined the parts of the machine that the model and rough block both rotated by an intermittent motion, and moved laterally by a rectilinear recipro-

[24] Blanchard *v.* Reeves, 1 Fisher, 103, 1850.

cating motion. Justice GRIER held that this mode of operation was substantially unchanged from that of the patent.

§ 345. Hayden's patent for a machine for making brass kettles consisted of two general divisions. 1. An engine lathe with its mandrel to revolve the pulleys and the gearing, and having special devices for the special work in hand. 2. A burnishing or spinning tool and tool carriage, secured to the frame of the lathe, and having special devices to make it work harmoniously with the lathe in producing the kettles which the two divisions of the machine jointly operated to manufacture. These two divisions were operated by one moving thing, like a shaft, which might be connected with a water wheel, or with a steam engine, or with any other suitable motor.

The infringer in one case [25] operated the first division of the machine by one such motive power; but he operated the second division by another, namely, by the hand of a workman turning a crank. Judge WOODRUFF held that this was not such a change of mode of operation as amounted to enough to negative infringement.

§ 346. The Wells hat-body machine consisted of a revolving brush to separate and throw fibres of fur; a perforated vacuum cone to receive the fur on its exterior surface; and an intermediate tunnel, to guide the fur from the brush to the cone. The patent which was granted for that invention was three times surrendered and reissued. The second reissue was involved in a celebrated Supreme Court case.[26] That reissue described the machine which Wells invented, and it claimed the mode of operation, substantially as described, of forming "bats" (hat bodies) of fur fibres. The object of this claim was to cover

[25] Waterbury Brass Co. *v.* Miller, 9 Blatch. 94, 1871.

[26] Burr *v.* Duryee, 1 Wallace, 531, 1863.

the machine of Seth Boyden; a machine which had the same general mode of operation as that of Wells, but which was substantially different from the latter in one of its parts. This attempt to base a charge of infringement on sameness of "mode of operation" alone was occasioned by the fact that Justice CURTIS, in delivering the opinion of the Supreme Court in the case of Winans *v.* Denmead,[27] had used the phrase with great frequency. He used it exactly twenty times in that case; and the counsel for the Wells patent, when arguing the case of Burr *v.* Duryee, formulated seven doctrines which they stated were deducible from that score of instances. Among those doctrines the fourth was this: That copying a mode of operation is an infringement. But Justice GRIER, who was one of the majority of the court which decided Winans *v.* Denmead, was convinced that the latter decision was erroneous, or that it did not mean what it was generally understood to signify, for in Burr *v.* Duryee he delivered the unanimous opinion of the Supreme Court rejecting the complainant's contention. The case of Winans *v.* Denmead cannot therefore be fairly cited as an authority on this point, for if it is not consistent with Burr *v.* Duryee, it was overruled by the latter, and if it is consistent with the latter case, its expressions are likely at least to mislead the reader, as they misled the counsel for the Wells patent. Harmoniously with its decision in Burr *v.* Duryee, the Supreme Court has since had a positive tendency to disregard whatever is abstract and intangible in questions of infringement, and to base its conclusions upon the concrete features of the issues at bar.

§ 346*a*. The Pope electric railroad signal consisted of the combination of an electric battery; a peculiar arrangement of electric circuits; and two or more circuit closers,

[27] Winans *v.* Denmead, 15 Howard, 330, 1853.

operating two or more visual or audible signals, situated at intervals along the line of a railroad. That peculiar arrangement of electric circuits essentially consisted in attaching two line wires to the positive and negative poles of a battery, respectively; and in extending both of those wires any required distance in a direction substantially parallel to the line of the railroad; and insulating both from the earth and from each other; and in connecting one of them at intervals with insulated rails in one of the two lines of rails of the railroad track; and in connecting the other one of those wires at the same intervals with insulated rails in the other line of rails of the same track; and interposing an electromagnet at some point in each of these latter connections. An alleged infringer in one case [28] used an electric railroad signal differing from that of Pope mainly in the peculiar arrangement of the electric circuits. That difference consisted mainly in disconnecting the negative pole of the battery from its line wire, and in connecting that pole with the earth adjacent thereto, and in connecting the remote end of the disconnected line wire with the earth adjacent to that end. These changes of arrangement changed the mode of operation of the apparatus, in that they caused the electricity to traverse circuits of equal length when the series of circuit closers were successively operated, whereas Pope's arrangement caused the electricity to traverse circuits of widely variant lengths at such times. This change of mode of operation resulted in a uniformity of electrical resistance among all the circuits, and thus much increased the utility of the apparatus. The Supreme Court therefore held the alleged infringer's combination to be an independent invention, substantially different from that of Pope, and not an infringement of his patent.

[28] Electric Signal Co. *v.* Hall Signal Co., 114 U. S. 87, 1885.

§ 347. Addition to a patented machine or manufacture does not enable him who makes, uses, or sells the patented thing with the addition, to avoid a charge of infringement.[29] This is true even where the added device facilitates the working of one of the parts of the patented combination, and thus makes the latter perform its function with more excellence and greater speed;[30] or where the added part hinders the patented combination from having some of its minor merits.[31] And duplication in a machine or manufacture, of one of its parts or features, is but a form of addition thereto; and falls in the same category, in respect of not avoiding infringement of a patent on that machine or manufacture.[32] But if a patented combination differs from some older combination, only in the omission of one of the parts of the latter; and in a resulting difference of mode of operation, the restoration of the older structure by adding the part which the patented combination omitted, would not constitute an infringement of the latter.[33]

[29] Western Electric Co. *v.* La Rue, 139 U. S. 607, 1891; Carr *v.* Rice, 1 Fisher, 209, 1856; Roemer *v.* Simon, 20 F. R. 197, 1884; Royer *v.* Coupe, 29 F. R. 366, 1886; Filley *v.* Stove Co., 30 F. R. 434, 1887; Williames *v.* Barnard, 41 F. R. 358, 1890; Goshen Sweeper Co. *v.* Bissell Sweeper Co., 72 F. R. 67, 1895; Sprague Electric Railway & Motor Co. *v.* Union Ry. Co., 84 F. R. 641, 1898; Western Electric Co. *v.* Capital Tel. & Tel. Co., 86 F. R. 778, 1898; Newton *v.* McGuire, 97 F. R. 614, 1899; 1900 Washer Co. *v.* Cramer, 169 F. R. 629, 1909. See Section 376.

[30] Cochrane *v.* Deener, 94 U. S. 786, 1876; Brislin *v.* Carnegie Steel Co., 118 F. R. 597, 1902; Columbia Wire Co. *v.* Kokomo Steel & Wire Co., 143 F. R. 116, 1905.

[31] Sawyer Spindle Co. *v.* Morrison Co., 52 F. R. 593, 1892; Am. Laundry Mach. Mfg. Co. *v.* Adams Laundry Mach. Co., 161 F. R. 556, 1908.

[32] Goldie *v.* Diamond State Iron Co., 81 F. R. 176, 1897; General Compressed Air, etc., Co. *v.* American Air Cleaning Co., 177 F. R. 272, 1910.

[33] Shoemaker *v.* Merrow, 61

§ 348. Changing the relative positions of the parts of a machine or manufacture does not avert infringement, where the parts transposed perform the same respective functions after the change as before.[34] In the first of the cases just cited, the thing transposed was a beater shaft in a corn-sheller. Both in its original and in its new position, its function was to force the ears of corn into the throat of the sheller. In the second case, the thing transposed was the outlet vapor flue of a quicksilver furnace; and that flue operated in the same way to perform the same function in the infringing apparatus that it did in the patented furnace.

But changing the relative positions of the parts of a machine does avert infringement, where the changing of these positions so changes the functions of the parts, that the machine acquires a substantially different mode of operation, even though the result of the machine remains the same.[35] A suit for infringement cannot be sustained against him who makes, uses, or sells a substantially different combination, even though it includes exactly the same ingredients as those claimed in combination by the patent in suit.[36] The owner of a patent for a combination can-

F. R. 948, 1894; Am. Laundry Mach. Mfg. Co. *v.* Adams Laundry Mfg. Co., 161 F. R. 556, 1908.

[34] Adams *v.* Mfg. Co., 3 Bann. & Ard. 1, 1877; Knox *v.* Quicksilver Mining Co., 6 Sawyer, 438, 1878; Northwestern Horse Nail Co. *v.* Horse Nail Co., 28 F. R. 234, 1886; Consolidated Roller Mill Co. *v.* Coombs, 39 F. R. 33, 1889; Devlin *v.* Paynter, 64 F. R. 400, 1894; Huntington Dry Pulverizer Co. *v.* Whittaker Cement Co., 89 F. R. 328, 1898; Union Steam-Pump Co. *v.* Battle Creek Steam-Pump Co., 104 F. R. 342, 1900; Metallic Extraction Co. *v.* Brown, 104 F. R. 352, 1900; Brislin *v.* Carnegie Steel Co., 118 F. R. 591, 1902; Anchor Cap & Closure Corp. *v.* Pritchard, 232 F. R. 156, 1916.

[35] Brooks *v.* Fiske, 15 Howard, 221, 1853; Union Steam-Pump Co. *v.* Battle Creek Steam-Pump Co., 104 F. R. 343, 1900.

[36] Gill *v.* Wells, 22 Wallace, 14, 1874; Snow *v.* Railway Co., 121

not suppress a newer, better, and substantially different combination of the same ingredients.[37]

§ 349. Omission of one element or ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim,[38] whether or not the omitted ingredient was essential to the combination of the patent, and whether or not it was necessary to the operativeness of the device.[39] And it makes no difference that another element is made to do the work of itself and of the omitted element.[40] A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible

U. S. 629, 1886; Singer Mfg. Co. F. R. 68, 1905; Central Foundry *v.* Brill, 54 F. R. 384, 1892.

[37] Seymour *v.* Osborne, 11 Wallace, 555, 1870.

[38] Prouty *v.* Ruggles, 16 Peters, 341, 1842; Eames *v.* Godfrey, 1 Wallace, 78, 1863; Case *v.* Brown, 2 Wallace, 328, 1864; Dunbar *v.* Myers, 94 U. S. 187, 1876; Fuller *v.* Yentzer, 94 U. S. 297, 1876; Rowell *v.* Lindsay, 113 U. S. 102, 1884; Shepard *v.* Carrigan, 116 U. S. 597, 1885; Sharp *v.* Riessner, 119 U. S. 636, 1886; Derby *v.* Thompson, 146 U. S. 482, 1892; Weatherhead *v.* Coupe, 147 U. S. 335, 1893; Dobson *v.* Cubley, 149 U. S. 120, 1893; Wright *v.* Yuengling, 155 U. S. 52, 1894; Black Diamond Coal Co. *v.* Excelsior Coal Co., 156 U. S. 617, 1895; Levy *v.* Harris, 130 F. R. 711, 1904; Mallon *v.* Gregg & Co., 137 Co. *v.* Coughlin, 141 F. R. 91, 1905; Consolidated Engine Stop Co. *v.* Landers, Frary & Clarke, 160 F. R. 79, 1908; Portland Gold Mining Co. *v.* Hermann, 160 F. R. 91, 1908; Electric Protection Co. *v.* American Bank Protection Co., 184 F. R. 916, 1910; National Cash Register Co. *v.* Gratigny, 213 F. R. 463, 1914; Steiger *v.* Waite Grass Carpet Co., 213 F. R. 798, 1914; Cimiotti Unhairing Co. *v.* American Fur Refining Co., 198 U. S. 399, 1905; Proudfit Loose Leaf Co. *v.* Kalamazoo Loose Leaf Binder Co., 230 F. R. 120, 1915.

[39] Hall-Mammoth Incubator Co. *v.* Teabout, 215 F. R. 109, 1914.

[40] Underwood Typewriter Co. *v.* Royal Typewriter Co., 224 F. R. 477, 1915.

in any case of alleged infringement.[41] The patentee makes all the parts of a combination material, when he claims them in combination and not separately.[42] A patentee may, however, describe all the devices in his machine or manufacture, and instead of claiming all or any particular portion of them in combination, may claim so much of the described mechanism as produces a particular described result.[43] Such a claim is infringed by him who, without ownership or license, makes, uses, or sells any apparatus made up of enough of the described devices to produce the specified result, by the specified mode of operation.[44] The rule stated at the head of this section is perhaps the best known and most frequently applied of all the rules which pertain to infringement; but it has no application to anything which depends upon a particular form for patentability, and which, for convenience, may be made in several sections. A shoe last, for example, even if made in only two sections, may infringe a patent for a last of the same shape, but which is made in three sections instead of in two.[45] And infringement is not averted by uniting two elements of a machine or manufacture into one integral part, if the united part performs

[41] Vance *v.* Campbell, 1 Black, 430, 1861; Fay *v.* Cordesman, 109 U. S. 420, 1883; Sargent *v.* Lock Co., 114 U. S. 86, 1884; Shepard *v.* Carrigan, 116 U. S. 597, 1885; Yale Lock Co. *v.* Sargent, 117 U. S. 378, 1885; McClain *v.* Ortmayer, 141 U. S. 425, 1891; Hubbell *v.* United States, 179 U. S. 82, 1900.

[42] Water-Meter Co. *v.* Desper, 101 U. S. 332, 1879; Brown *v.* Davis, 116 U. S. 249, 1885; Williams *v.* Stolzenbach, 23 F. R. 41, 1885; Otley *v.* Watkins, 36 F. R. 324, 1888; Levy *v.* Harris, 124 F. R. 71, 1903; Electric Protection Co. *v.* American Bank Protection Co., 184 F. R. 916, 1910.

[43] Parsons *v.* Seelye, 100 F. R. 458, 1900.

[44] Silsby *v.* Foote, 14 Howard, 218, 1852.

[45] Mabie *v.* Haskell, 2 Cliff. 511, 1865; White *v.* Walbridge, 46 F. R. 526, 1891.

the same function in substantially the same way, as did the separate parts before the union; [46] nor by the separation of one integral part into two, the two parts doing substantially what was done by the single part.[47]

§ 350. No substitution of an equivalent, for any ingredient of a combination covered by any claim of a patent, can avert a charge of infringement of that claim,[48] whether or not the equivalent is mentioned in the patent.[49] But like substitution of something which is not an equivalent, will have that effect.[50] The doctrine of equivalents may be invoked by any patentee, whether he claimed

[46] Bundy Mfg. Co. *v.* Detroit Time-Register Co., 94 F. R. 538, 1899; Nathan *v.* Howard, 143 F. R. 889, 1906; Lidgerwood Mfg. Co. *v.* Lambert Hoisting Engine Co., 150 F. R. 364, 1906; Weber *v.* Automobile & Accessories Mfg. Co., 190 F. R. 189, 1911; Hall Mammoth Incubator Co. *v.* Teabout, 205 F. R. 906, 1913; Grupe Drier & Boiler Co. *v.* Geiger, Fiske & Koop, 215 F. R. 110, 1914; New York Scaffolding Co. *v.* Whitney, 224 F. R. 452, 1915.

But distinguished from Underwood Typewriter Co. *v.* Royal Typewriter Co., 224 F. R. 477, where after the omission a remaining element is made to do double work.

[47] Nathan *v.* Howard, 143 F. R. 889, 1906; Kelsey Heating Co. *v.* James Spear Stove, etc., Co., 155 F. R. 976, 1907; Western Tube Co. *v.* Rainer, 156 F. R. 49, 1907; Kings County Raisin, etc., Co. *v.* U. S. Consolidated, etc., Co., 182 F. R. 59, 1910; Hall Mammoth Incubator Co. *v.* Teabout, 205 F. R. 906, 1913; Proudfit Loose Leaf Co. *v.* Kalamazoo Loose Leaf Binder Co., 230 F. R. 120, 1915; Yancey *v.* Enright, 230 F. R. 641, 1916.

[48] O'Reilly *v.* Morse, 15 Howard, 62, 1853; Imhaeuser *v.* Buerk, 101 U. S. 655, 1879; Reed *v.* Chase, 25 F. R. 94, 1885; American Box Machine Co. *v.* Day, 32 F. R. 585, 1887; Ligowski Clay-Pigeon Co. *v.* Clay-Bird Co., 34 F. R. 331, 1888.

[49] Treibacher-Chemische Werke, etc., Co. *v.* Roessler & Hasslacher Chemical Co., 219 F. R. 210, 1914.

[50] Railway Co. *v.* Sayles, 97 U. S. 562, 1878; Brown *v.* Puget Sound Reduction Co., 110 F. R. 388, 1901.

equivalents in his claim,[51] or described any in his specification,[52] or omitted to do either or both of those things. The patentee, having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of these forms.[53] Combination patents would generally be valueless in the absence of a right to equivalents, for few combinations now exist, or can hereafter be made, which do not contain at least one element, an efficient substitute for which could readily be suggested by any person skilled in the particular art.[54] But where a patentee states in his specification that a particular part of his invention is to be constructed of a particular material, and states or implies that he does not contemplate any other material as being suitable for the purpose, it is not certain that any other material will be treated by a court as an equivalent of the one recommended in the patent;[55] though celluloid has been held an equivalent of metal, in one well-considered case which depended upon the point.[56]

§ 352. One thing, to be the equivalent of another,

[51] Dental Vulcanite Co. *v.* Davis, 102 U. S. 229, 1880; Hunt Bros. Fruit Packing Co. *v.* Cassidy, 53 F. R. 261, 1892; McCormick Mach. Co. *v.* Aultman, 69 F. R. 393, 1895.

[52] Union Metallic Cartridge Co. *v.* United States Cartridge Co., 2 Bann. & Ard. 594, 1877; Welsbach Light Co. *v.* Sunlight Lamp Co., 87 F. R. 224, 1898.

[53] Western Electric Co. *v.* La Rue, 139 U. S. 606, 1891.

[54] Thrall *v.* Poole, 89 F. R. 721, 1898.

[55] Aiken *v.* Bemis, 3 Woodbury & Minot, 348, 1847; Harris *v.* Allen, 15 F. R. 106, 1883; Schillinger *v.* Cranford, 37 O. G. 1349, 1885; Reece Button-Hole Mach. Co. *v.* Globe Button-Hole Mach. Co., 61 F. R. 965, 1894; Seabury *v.* Johnson, 76 F. R. 456, 1896.

[56] Thrall *v.* Poole, 89 F. R. 718, 1898.

must perform the same functions as that other.[57] If it performs the same function, the fact that it also performs another function is immaterial to any question of infringement.[58] Therefore, it sometimes happens that a junior device is an equivalent of a senior device in a sense that will constitute it an infringement of a patent for the latter; at the same time that the senior device is not an equivalent of the junior device in a sense that will cause the former to negative invention or novelty in the latter.[59] One thing may accordingly be an equivalent of another, though it does more than that other, but it cannot be such an equivalent if it does less.[60] But the test of function is only the first of several tests of equivalency. The fact that one thing performs the same function as another, though necessary, is not sufficient to make it an equivalent thereof.[61]

§ 353. Function must be performed in substantially the same way by an alleged equivalent, as by the thing

[57] Machine Co. *v.* Murphy, 97 U. S. 125, 1877; Rowell *v.* Lindsay, 113 U. S. 103, 1884; Roller Mill Patent, 156 U. S. 271, 1895; Railway Mfg. Co. *v.* Railroad Co., 30 F. R. 238, 1887; Seeley *v.* Brush Electric Co., 44 F. R. 420, 1890; Farmers' Mfg. Co. *v.* Spruks Mfg. Co., 119 F. R. 599, 1902.

[58] Foss *v.* Herbert, 2 Fisher, 31, 1856; Sarven *v.* Hall, 9 Blatch. 524, 1872; Wheeler *v.* Reaper Co., 10 Blatch. 195, 1872; Kendrick *v.* Emmons, 3 Bann. & Ard. 623, 1878; Norton *v.* California Can Co., 45 F. R. 638, 1891; Masseth *v.* Palm, 51 F. R. 825, 1892; Comptograph Co. *v.* Mechanical Accountant Co., 145 F. R. 331, 1906. See Section 376.

[59] *In re* Hebard, 1 McArthur's Patent Cases, 550, 1857; Loercher *v.* Crandall, 11 F. R. 857, 1881; Section 36 of this book; Curry *v.* Union Electric Welding Co., 230 F. R. 422, 1916.

[60] Bliss *v.* Haight, 3 Fisher, 626, 1869; Engle Sanitary & Cremation Co. *v.* City of Elwood, 73 F. R. 486, 1896.

[61] Eames *v.* Godfrey, 1 Wallace, 78, 1863; Westinghouse *v.* Boyden Power-Brake Co., 170 U. S. 569, 1898; Conover *v.* Roach, 4 Fisher, 12, 1857; Merriam *v.* Drake, 5 Fisher, 259, 1872.

of which it is alleged to be an equivalent, in order to constitute it such.[62] This substantial sameness of way is not necessarily an identity of merit,[63] nor a theoretical scientific sameness.[64] In a purely scientific sense, a screw always performs its function in a substantially different way from a lever, and in substantially the same way as a wedge. Screws and wedges are equally inclined planes, while a lever is an entirely different elementary power. But screws and levers can practically be substituted for each other in a larger number of machines than screws and wedges can be similarly substituted. When a lever and a screw can be interchanged and still perform the same function with a result that is beneficially the same, they are said to perform the same function in substantially the same way.[65] Levers and springs are also used interchangeably in the arts, and constitute another example of equivalency.[66]

But one thing may be an equivalent of another in one environment, and not such an equivalent in another

[62] Burr *v.* Duryee, 1 Wallace, 573, 1863; Werner *v.* King, 96 U. S. 230, 1877; Dryfoos *v.* Wiese, 124 U. S. 37, 1887; Fonerook *v.* Root, 127 U. S. 181, 1887; Sargent *v.* Burgess, 129 U. S. 19, 1889; Sickles *v.* Borden, 3 Blatch. 535, 1856; Peard *v.* Johnson, 23 F. R. 509, 1885; Tondner *v.* Chambers, 37 F. R. 337, 1889; Pacific Cable Railway Co. *v.* Butte City Ry. Co., 58 F. R. 420, 1893; Carter Mach. Co. *v.* Hanes, 70 F. R. 865, 1895; Engle Sanitary & Cremation Co. *v.* City of Elwood, 73 F. R. 486, 1896; Pittsburg Meter Co. *v.* Pittsburg Supply Co., 109 F. R. 644, 1901; Farmers' Mfg. Co. *v.* Spruks Mfg. Co., 119 F. R. 599, 1902.

[63] Brush *v.* Condit, 132 U. S. 49, 1889; Roosevelt *v.* Telegraph Co., 33 F. R. 510, 1887; Standard Folding Bed Co. *v.* Osgood, 58 F. R. 584, 1893; National Binding Machine Co. *v.* James D. M'Laurin Co., 186 F. R. 992, 1911.

[64] Gordon *v.* Warder, 150 U. S. 52, 1893.

[65] Turrell *v.* Spaeth, 3 Bann. & Ard. 458, 1878.

[66] Gould Coupler Co. *v.* Pratt, 70 F. R. 627, 1895.

situation.[67] Springs and weights are generally equivalents;[68] but where the environment is such that a spring will operate successfully while a weight will not so operate, there they are not equivalents.[69] While in most cases a mere handle is not an equivalent of a lever, it is such an equivalent where its connections are such that it performs the same function in substantially the same way.[70] But infringement is averted by using a hand, instead of a lever of a claimed combination, to work a rod.[71] However, in one case, the Supreme Court went to the length of deciding a confined column of water in a cylinder, worked by a pump and working a piston, to be an equivalent of a combination of a vibrating arm, toggle joint, and other mechanical devices, when used to transmit vibratory power.[72] This decision may seem, superficially, to be inconsistent with the much later declaration of the same court, that interchangeability or non-interchangeability, is an important test in determining the question of infringement.[73] That view has already been recognized by several lower courts,[74] and is likely to persist. But in-

[67] Cochrane *v.* Deener, 94 U. S. 789, 1876; Hubel *v.* Dick, 28 F. R. 136, 1886.

[68] Imhaeuser *v.* Buerk, 101 U. S. 656, 1879; American Roll Paper Co. *v.* Weston, 45 F. R. 692, 1891; Taws *v.* Laughlins, 70 F. R. 108, 1895.

[69] Cross *v.* Mackinnon, 11 F. R. 601, 1882.

[70] Corn-Planter Patent, 23 Wallace, 235, 1874; Steam Gauge & Lantern Co. *v.* Mfg. Co., 28 F. R. 619, 1886.

[71] Brown *v.* Davis, 116 U. S. 249, 1885.

[72] Blake *v.* Robertson, 94 U. S. 732, 1876.

[73] Miller *v.* Eagle Co., 151 U. S. 208, 1894.

[74] Campbell Printing-Press Co. *v.* Duplex Printing-Press Co., 86 F. R. 322, 1898; Pittsburg Meter Co. *v.* Pittsburg Supply Co., 109 F. R. 651, 1901; Crown Cork & Seal Co. *v.* Imperial Bottle Cap Co., 123 F. R. 669, 1903; American Pneumatic Tool Co. *v.* Philadelphia Pneumatic Tool Co., 123 F. R. 896, 1903.

terchangeability usually requires change of form, in order to fit the thing interchanged to its new environment. Therefore it appears that the non-interchangeability referred to by the Supreme Court in this connection, involves such radical unfitness for a proposed position and function, as cannot be removed by any change of form.[75] There was no such radical unfitness in the hydraulic apparatus involved in the case of Robertson *v.* Blake, for the position and function of the mechanical apparatus for which it was substituted; and therefore there is no inconsistency between that case, and the later cases which have been developing the doctrine of the test of interchangeability.

§ 354. Whether a device, in order to be an equivalent of another, must have been known at the time of the invention of the machine which contains the latter, is a question which was elaborately investigated and discussed in Sections 354 to 358 of the first two editions of this book; because it appeared to be not only important, but also unsettled. But the weight of reason was always much on the side of the negative of that question; and the weight of authority has now accumulated so preponderatingly upon the same side, that the question may now be held to be settled in the negative.[76] An apparent excep-

[75] Alaska Packers' Association *v.* Letson, 119 F. R. 611, 1902.

[76] O'Reilly *v.* Morse, 15 Howard, 123, 1853; Burr *v.* Duryee, 1 Wallace, 573, 1863; Mason *v.* Graham, 23 Wallace, 275, 1874; Cochrane *v.* Deener, 94 U. S. 780, 1876; Union Paper Bag Machine Co. *v.* Murphy, 97 U. S. 125, 1877; Clough *v.* Mfg. Co., 106 U. S. 178, 1882; Cantrell *v.* Wallick, 117 U. S. 695, 1885; Sickles *v.* Borden, 3 Blatch. 535, 1856; Cahoon *v.* Ring, 1 Cliff. 620, 1861; Roberts *v.* Harnden, 2 Cliff. 506, 1865; Graham *v.* Mason, 5 Fisher, 11, 1869; Harwood *v.* Mfg. Co., 3 Fisher, 530, 1869; Vogler *v.* Semple, 7 Bissell, 382, 1877; Potter *v.* Stewart, 18 Blatch. 563, 1881; Evory *v.* Burt, 15 F. R. 112, 1883; United Nickel Co. *v.*

tion has been made by one court which held a material which the patentee had tried unsuccessfully to use as an element of his combination but which was later successfully used by another cannot be an equivalent of the material actually described in the patent.[77] It is therefore safe to define an equivalent as a thing which performs the same function, and performs that function in substantially the same manner, as the thing of which it is alleged to be an equivalent.

§ 359. Primary inventions are entitled to a somewhat looser application of this definition of an equivalent than those inventions which are secondary.[78] But a patentee is not to be denied the benefit of the doctrine of equiv-

Pendleton, 15 F. R. 745, 1883; Murphy *v.* Trenton Rubber Co., 45 F. R. 570, 1891; Norton *v.* California Can Co., 45 F. R. 638, 1891; Jones Co. *v.* Munger Co., 49 F. R. 67, 1891; National Cash Register Co. *v.* American Cash Register Co., 53 F. R. 373, 1893; Merrow *v.* Shoemaker, 59 F. R. 128, 1893; Beach *v.* Box Mach. Co., 63 F. R. 606, 1894; Edison Electric Light Co. *v.* Boston Lamp Co., 62 F. R. 309, 1894; Stahl *v.* Williams, 64 F. R. 124, 1894; McCormick Harvesting Mach. Co. *v.* Aultman, 69 F. R. 386, 1895; Gould Coupler Co. *v.* Pratt, 70 F. R. 627, 1895; Read Holliday & Sons *v.* Schulze-Berge, 78 F. R. 496, 1896; Kinloch Tel. Co. *v.* Western Electric Co., 113 F. R. 652, 1902.

[77] Folger & Moriarty *v.* Dow Portable Electric Co., 128 F. R. 45, 1904.

[78] Miller *v.* Eagle Co., 151 U. S. 207, 1894; Westinghouse *v.* Boyden Power-Brake Co., 170 U. S. 562, 1898; Dederick *v.* Seigmund, 51 F. R. 235, 1892; Welsbach Light Co. *v.* Sunlight Lamp Co., 87 F. R. 224, 1898; National Cash Register Co. *v.* Leland, 94 F. R. 513, 1899; Bundy Mfg. Co. *v.* Detroit Time Register Co., 94 F. R. 540, 1899; McBride *v.* Kingman, 97 F. R. 219, 1899; William Mann Co. *v.* Hoffmann, 104 F. R. 254, 1900; Rich *v.* Baldwin Tuthill & Bolton, 133 F. R. 920, 1904; Brothers *v.* Lidgerwood Mfg. Co., 223 F. R. 359, 1915; Ciniotti Unhairing Co. *v.* American Fur Refining Co., 198 U. S. 399, 1905; Computing Scale Co. *v.* Automatic Scale Co., 204 U. S. 609, 1907.

alents to the extent necessary to protect his actual invention, although the invention may be a narrow one.[79] A fair statement of the rule is that "the range of equivalents covered by the patent corresponds with the character of the invention, and includes all forms which embody the substance of the invention, and by like mechanical co-operation effect substantially the same result."[80] Another very clear statement of the correct rule is found in the case of Mallon *v.* Gregg & Co.[81] Other substantially similar expressions of the rule are found in the reported cases.[82] In Cimiotti Unhairing Co. *v.* American Fur Refining Co.[83] the Supreme Court made the very confusing statement that "where the patent does not embody patentee is limited to the precise devices and combinations shown and claimed in his patent." If this and similar expressions mean literally what they say, it is suggested that the doctrine has little support either in logic or authority.

Other cases where expressions of the various doctrines are found are: St Louis Street, etc., Co. *v.* Am. Street, etc., Co., 156 F. R. 574, 1907; Hardison *v.* Brinkman, 156 F. R. 962, 1907; W. W. Sly Mfg. Co. *v.* Russell & Co. (containing discussion of rule in Sixth Circuit) 189 F. R. 61, 1911; Grand Rapids Show Case Co. *v.* Baker, 216 F. R. 341, 1914; Yancey *v.* Enright, 230 F. R. 641, 1916.

[79] Levy *v.* Harris, 124 F. R. 69, 1903.

[80] Dowagiac Mfg. Co. *v.* Brennan & Co., 127 F. R. 143, 1903.

[81] Mallon *v.* Gregg & Co., 137 F. R. 68, 1905.

[82] Sloan Filter Co. *v.* Portland Gold Mining Co., 139 F. R. 23, 1905; Columbia Wire Co. *v.* Kokomo Steel & Wire Co., 143 F. R. 116, 1905; Union Match Co. *v.* Diamond Match Co., 162 F. R. 148, 1908; Lewis Blind Stitch Machine Co. *v.* Premium Mfg. Co., 163 F. R. 950, 1908; Veneer Machinery Co. *v.* Grand Rapids Chair Co., 227 F. R. 419, 1915.

An apparently contrary doctrine is announced in some cases as, for instance: Cumming *v.* Baker & Hamilton, 144 F. R. 395, 1906, where the statement is made that in improvement patents "the

[83] Cimiotti Unhairing Co. *v.* American Fur Refining Co., 198 U. S. 399, 1905.

a primary invention, but only an improvement on the prior art, and if defendant's machines can be differentiated the charge of infringement is not sustained," a statement which was substantially repeated in Computing Scale Co. *v.* Automatic Scale Co.[84] The doubt, however, was cleared up in the case of Continental Paper Bag Company *v.* Eastern Paper Bag Company,[85] where it was said, referring to the Cimiotti case and the Computing Scale Co. case: "It is manifest, therefore, that it was not meant to decide that only pioneer patents are entitled to invoke the doctrine of equivalents, but that it was decided that the range of equivalents depends upon and varies with the degree of invention." The latter proposition is therefore finally definitely settled as the law to be applied in determining the range of equivalents to which an inventor is entitled. In view of the "Paper Bag Patent Case," therefore, those who claim a proper range of equivalents in a secondary or narrow patent should not be alarmed by the statement in the later case of Diamond Rubber Co. *v.* Consolidated Rubber Co.[86] that a patent that is a "step only in the march of improvement" is "limited therefore to its precise form and elements."

A primary invention is one which performs a function never performed by any earlier invention;[87] while a secondary invention is one which performs a function previously

[84] Computing Scale Co. *v.* Automatic Scale Co., 204 U. S. 609, 1907.

[85] Continental Paper Bag Company *v.* Eastern Paper Bag Company, 210 U. S. 405, 1908.

[86] Diamond Rubber Co. *v.* Consolidated Tire Co., 220 U. S. 428, 1911.

[87] Morley Machine Co. *v.* Lancaster, 129 U. S. 273, 1889; Celluloid Mfg. Co. *v.* Arlington Mfg. Co., 44 F. R. 86, 1890; Norton *v.* Jensen, 49 F. R. 862, 1892; National Cash Register Co. *v.* American Cash Register Co., 53 F. R. 372, 1892; Boston Lasting Mach. Co. *v.* Woodward, 53 F. R. 481, 1893.

performed by some earlier invention, but which performs that function in a substantially different way from any that preceded it.[88] The six leading Supreme Court cases, which have attended to the distinction now under treatment, attended thereto in the following terms.

In the first of these cases the court said: "If the patentee be the original inventor of the device or machine called the divider, he will have a right to treat as infringers all who make dividers operating on the same principle, and performing the same functions, by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original, and patentable as such. But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee 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 improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first." [89]

In the second of these cases the court said: "In such cases, if one inventor precedes all the rest, and strikes out something which includes and underlies all that they produce, he acquires a monopoly, and subjects them to tribute. But if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each is entitled only to the specific form of device which he produces, and every other

[88] Butz Thermo-Electric Co. *v.* Electric Co., 36 F. R. 192, 1888; Writing Mach. Co. *v.* Book Typewriter Co., 108 F. R. 629, 1901.

[89] McCormick *v.* Talcott, 20 Howard, 405, 1857; also Wesel *v.* United Mattress Mach. Co., 139 F. R. 11, 1905; Central Foundry Co. *v.* Coughlin, 141 F. R. 91, 1905.

inventor is entitled to his own specific form, so long as it differs from those of his competitors, and does not include theirs.[90]

In the third of these cases the court said: "Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result, are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine." And the court also said that secondary patents ought to receive a narrower construction than this.[91]

In the fourth of these cases, the Supreme Court concurred with the Circuit Court, and the Circuit Court of Appeals, in holding that the question of infringement depended upon the question whether the patents in suit were primary or were secondary. The Circuit Court had held them to be secondary, and had found non-infringement. The Circuit Court of Appeals had held one of the four patents in suit to be primary, and had found it to be infringed by the defendant's machine. The Supreme Court concurred with the Circuit Court on this issue of fact, and found non-infringement accordingly.[92]

In the fifth of these cases the court said: "It is well settled that a greater degree of liberality and a wider range of equivalents are permitted where the patent is of a pioneer character than where the invention is simply an improvement, may be the last and successful step,

[90] Railway Co. *v.* Sayles, 97 U. S. 556, 1878.

[91] Morley Machine Co. *v.* Lancaster, 129 U. S. 273, 1889.

[92] Kokomo Fence Mach. Co. *v.* Kitselman, 189 U. S. 8, 1903.

in the art theretofore partially developed by other inventors in the same field." [93]

The sixth of these cases was that of Continental Paper Bag Co. *v.* Eastern Paper Bag Co., and as shown in the first part of this section definitely settled the law to be that an inventor is entitled to a range of equivalents commensurate with the scope of his invention. Thus the old distinction between primary and secondary patents in respect to range of equivalents, if such distinction ever really existed, has been eradicated.

§ 362. The four leading cases and other cases on this subject,[94] teach general doctrines rather than precise rules; and those general doctrines may be concisely stated as follows:

There are two tests of equivalency. 1. Identity of function. 2. Substantial identity of way of performing that function.[95] Primary as well as secondary patents are infringed by no substitutions that do not fully respond to the first of these tests. The second of these tests is somewhat elastic, because it contains the word "substantial." That word is allowed to condone more and more important differences in the case of a primary patent, than in the case of a secondary one.[96] In the case of

[93] Cimiotto Unhairing Co. *v.* American Fur Refining Co., 198 U. S. 399, 1905.

[94] Pope Mfg. Co. *v.* Gormully Mfg. Co., 144 U. S. 242, 1892; Sessions *v.* Romadka, 145 U. S. 45, 1892; Knapp *v.* Morss, 150 U. S. 230, 1893; Miller *v.* Eagle Co., 151 U. S. 204, 1894.

[95] Steam Gauge & Lantern Co. *v.* Rogers, 29 F. R. 453, 1886; Clark *v.* Wilson, 30 F. R. 373, 1887; Butz Thermo-Electric Co. *v.* Electric Co., 36 F. R. 195, 1888; Harmon *v.* Struthers, 43 F. R. 443, 1890; National Typographic Co. *v.* New York Typograph Co., 46 F. R. 116, 1891; New Departure Bell Co. *v.* Bevin Mfg. Co., 64 F. R. 864, 1894; Read Machine Co. *v.* Jaburg, 221 F. R. 662, 1915.

[96] Miller *v.* Eagle Co., 151 U. S. 207, 1894; McCormick Harvesting Mach. Co. *v.* Aultman, 69 F. R. 393, 1895; Welsbach Light Co. *v.* Sunlight Lamp Co., 87 F. R. 224,

a patent narrowed in construction by an extensive state of the preceding art, the word "substantial" will give but little elasticity to the application of the doctrine.[97] If fewer inventions preceded the one at bar, the word will have somewhat more of carrying power.[98] When the invention at bar is strictly primary, and especially if it is extremely useful, then the word "substantial" will be made to cover differences alike numerous and important, and even highly creditable to the infringer who invented them.[99]

1898; Eldred *v.* Kessler, 106 F. R. 517, 1900; National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 710, 1901; Western Electric Co. *v.* Williams-Abbott Electric Co., 108 F. R. 955, 1901; Adams Co. *v.* Schreiber & Conchar Mfg. Co., 111 F. R. 186, 1901; Adam *v.* Folger, 120 F. R. 263, 1903; Carnegie Steel Co. *v.* Brislin, 124 F. R. 220, 1903.

[97] Duff *v.* Pump Co., 107 U. S. 639, 1882; Knapp *v.* Morss, 150 U. S. 230, 1893; Boyd *v.* Janesville Hay Tool Co., 158 U. S. 267, 1895; Dashiell *v.* Grosvenor, 162 U. S. 432, 1896; Dederick *v.* Seigmund, 51 F. R. 235, 1892; Standard Folding Bed Co. *v.* Osgood, 51 F. R. 678, 1892; Joslin *v.* Northern Pacific Ry. Co., 55 F. R. 68, 1893; Bundy Mfg. Co. *v.* Time Recorder Co., 64 F. R. 853, 1894; Schuyler Electric Co. *v.* Electric Supply Co., 66 F. R. 315, 1895.

[98] Reminder Lock Co. *v.* Adler, 71 F. R. 185, 1895; Boston & R. Electric St. Ry. Co. *v.* Bemis Car Box Co., 80 F. R 287, 1897; Penfield *v.* Chambers Bros. Co., 92 F. R. 649, 1899; Brammer *v.* Schroeder, 106 F. R. 920, 1901; Writing Mach. Co. *v.* Book-Typewriter Co., 108 F. R. 629, 1901; Dowagiac Mfg. Co. *v.* Minnesota Moline Plow Co., 118 F. R. 141, 1902; Lamson Consolidated Store Service Co. *v.* Hillman, 123 F. R. 423, 1903.

[99] The Telephone Cases, 126 U. S. 537, 1888; American Bell Telephone Co. *v.* Spencer, 8 F. R. 509, 1881; American Bell Telephone Co. *v.* Dolbear, 15 F. R. 488, 1883; Hubel *v.* Dick, 28 F. R. 136, 1886; Brush Electric Co. *v.* Ft. Wayne Electric Co., 40 F. R. 833, 1889; Rapid Store Service Ry. Co. *v.* Taylor, 43 F. R. 256, 1887; Harmon *v.* Struthers, 43 F. R. 443, 1890; Brush Electric Co. *v.* Electric Co., 43 F. R. 541, 1890; Brush Electric Co. *v.* Electric Imp. Co., 52 F. R. 977, 1892; National Cash Register Co. *v.*

The rule has also been laid down that even though an invention is not generic, if it is one of exceptional merit, it is entitled to a liberal construction and a fair range of equivalents.[100]

§ 362*a*. The broad statement is frequently made that the grant of a subsequent patent raises a legal presumption of patentable difference from an earlier invention.[101] And the doctrine finds apparent support in the Supreme Court case of Kokomo Fence Machine Co. *v.* Kitselman.[102] Such a general rule, however, ignores the distinction between improvements over prior structures and inventions of a different species.[103] As said in Electric Candy Machine Co. *v.* Morris:[104]

"But it is claimed that the Kochs patent raises a *prima facie* presumption that there is a patentable difference between defendant's machine and complainant's machine. But this presumption does not exclude the fact that the

American Cash Register Co., 53 F. R. 372, 1892; Mergenthaler Co. *v.* Press Pub. Co., 57 F. R. 505, 1893; Reece Button-Hole Mach. Co. *v.* Globe Button-Hole Mach. Co., 61 F. R. 964, 1894; Bowers *v.* Von Schmidt, 63 F. R. 580, 1894; Beach *v.* Box Mach. Co., 63 F. R. 606, 1894; Rogers Typograph Co. *v.* Mergenthaler Co., 64 F. R. 803, 1894; Bredin *v.* Solmson, 132 F. R. 161, 1904.

[100] Benbow-Brammer Mfg. Co. *v.* Straus, 166 F. R. 114, 1908; Hagan *v.* Swindell, 204 F. R. 442, 1913.

[101] Milwaukee Carving Co. *v.* Brunswick-Balke-Collender Co. (9th Circuit), 126 F. R. 171, 1903; Century Electric Co. *v.* Westinghouse Electric & Mfg. Co., 191 F. R. 350 (8th Circuit), 1911; General Electric Co. *v.* Allis-Chalmers Co., 197 F. R. 558 (N. J.), 1912; Gillette Safety Razor Co. *v.* Durham Duplex Razor Co., 197 F. R. 574, 1912; Crowe *v.* Oscar Barnett Foundry Co., 206 F. R. 164, 1913; Simplex Electric Heating Co. *v.* Leonard, 180 F. R. 763, 1910.

[102] Kokomo Fence Machine Co. *v.* Kitselman, 189 U. S. 8, 1903.

[103] Miller *v.* Eagle Mfg. Co., 151 U. S. 186, 1894.

See Section 184.

[104] Electric Candy Machine Co. *v.* Morris, 156 F. R. 972 (Mo.), 1905.

later patent may embody things which are the exclusive property of the complainant under a prior patent. In other words, it may be that Kochs' patent contains improvements which this complainant cannot use, but it does not follow that therefore Kochs' patent also absorbs improvements theretofore invented by and patented to complainant's assignors. If, therefore, as the court has found, defendant's machine infringed on certain essential features of complainant's machine, the mere fact that it is constructed in accordance with a subsequent patent issued to another party is no defense."

In the Kokomo case it will be noted that the court had before it two patents both of which were improvements on the prior art and it was said that "the presumption from the grant of the letters patent is that there was a substantial difference between the inventions." As there may be and in fact are, in the cases of a multitude of patents, improvements upon improvements as well as improvements of different species it must be admitted that the Kokomo case lends considerable judicial support to the doctrine, unless the court meant by the phrase "substantial difference" a difference in species. If, however, the court meant, as is said in substance in Autopiano Co. *v.* Amphion Piano Player Co.,[105] that the presumption arises only when one patent is not an improvement upon the other, the doctrine as thus modified would seem to be a reasonable application of the rule of presumption attaching to the issuance of a patent.

In view of the fact that the great bulk of patents issued are for improvements over the structures of prior patents the doctrine of the Autopiano case would seem to be sub-

[105] Audopiano Co. *v.* Amphion Piano Player Co., 186 F. R. 159 (Second Circuit), 1911.

stantiated by actual facts. Further, it seems to be sustained by the weight of authority.[106] Of course if subordination to the patent in suit is expressly recognized in the subsequent patent no such presumption could be raised in any jurisdiction.[107] One court has said that if the Commissioner of Patents has held that no interference exists between the two patents the presumption is overcome.[108] Here again the same consideration exists that the subsequent patent may be merely an improvement over the prior patent and if such be the case and the claims be confined to the actual invention, the Commissioner would not declare that an interference existed. Another court has held that when the prior patent is for a primary invention the presumption that the later patent is for an improvement on the former is at least as strong as the presumption of the rule that the later patent is not an infringement,[109] with the result apparently that in such a case there is no presumption at all. The arguments for and against the doctrine in question and the modifications of it are well set forth in the case of Herman *v.* Youngstown Car Mfg. Co.[110] where the Circuit Court of Appeals of the sixth circuit said:

"Defendant's device is manufactured under patent No. 765,406, issued July 19, 1904, to J. H. Wagenhorst, and the court below gave to this fact some force in reaching his conclusion that the device did not infringe. We think that the granting of the later patent and defendant's

[106] Ries *v.* Barth Mfg. Co., 136 F. R. 850 (7th Circuit), 1905; Cutler-Hammer Mfg. Co. *v.* Union Electric Mfg. Co., 147 F. R. 266 (Wisconsin), 1906.

[107] Columbia Wire Co. *v.* Kokomo Steel & Wire Co., 143 F. R. 116 (2nd Circuit), 1905.

[108] Century Electric Co. *v.* Westinghouse Electric & Mfg. Co., 191 F. R. 350, 1911.

[109] Century Electric Co. *v.* Westinghouse Electric & Mfg. Co., 191 F. R. 350, 1911.

[110] Herman *v.* Youngstown Car Mfg. Co., 191 F. R. 579, 1911.

conformity thereto are not of importance in this case, on the infringement issue. There are expressions in some reported cases implying that by the later patent the government has granted a right to make and use the article so patented, and that such grant is inconsistent with any construction of the earlier patent which would forbid the manufacture of the later structure. Such implication rests on a fundamental error. A patent is not the grant of a right to make or use or sell. It does not, directly or indirectly, imply any such right. It grants only the right to exclude others. The supposition that a right to make is created by the patent grant is obviously inconsistent with the established distinctions between generic and specific patents, and with the well-known fact that a very considerable portion of the patents granted are in a field covered by a former relatively generic or basic patent, are tributary to such earlier patent, and cannot be practiced unless by license thereunder.

"Another reason sometimes advanced for supposing that the structure of the second does not infringe the claim of the first patent is that the Patent Office has declared that a patentable difference exists. The premise is sound, but not the conclusion. In examining the second application, the Patent Office has no concern with the scope of the claim of the first, and does not and must not pay any attention thereto. It is concerned only with the early disclosure by the specification and drawings. Patentable difference does not of itself tend to negative infringement. It may just as well be based upon infringement, plus improvement; an improvement may lie in addition, simplification, or variance. This is well illustrated by this Wagenhorst patent. The drawings show, and the specifications describe, a structure generally similar to Herman's, but each one of the 10 claims is found to be confined to some

modification and supposed improvement added to the underlying combinations of the earlier art.

"As the necessary result of the fundamental principles, it seems that the existence of the later patent can have no tendency to disprove infringement, unless, for other reasons, we have first reached the conclusion that the earlier patent is, as to the later structure, specific, and not generic. If we have reached that conclusion, and the correlative conclusion that the earlier patent is entitled only to a narrow range of equivalents, and if we find that the claims of the later patent embody no improvement feature whatever, we will then find our conclusion fortified by the Patent Office declaration that the two structures are different species of the same genus; but before we can so interpret the Patent Office action, we must have given to the earlier patent a construction which will of itself probably determine the question of infringement, and it is difficult to see how in deciding the underlying question material aid can be had from such Patent Office declaration.

"We find no authoritative decisions which go beyond the limits we have indicated. Corning *v.* Burden, 15 How. 252, 270, 14 L. Ed. 683, seems to be the basis of the later rulings. Its language is general. The report does not show the two patents fully enough to indicate any inconsistency with the ideas we have formulated; and the opinion antedates the Patent Office practice in force while all now existing patents were issued. Blanchard *v.* Putnam, 8 Wall. 420, 19 L. Ed. tends to limit, if not overrule, Corning v. Burden. The remark of Mr. Justice JACKSON in Miller *v.* Eagle Co., 151 U. S. 186, 208, 14 Sup. Ct. 310, 38 L. Ed. 121, refers to patentable difference, not to non-infringement, and the case to which he refers (Duff *v.* Sterling, 107 U. S. 636, 2 Sup. Ct. 487, 27 L. Ed. 517) did

not involve the evidential force of the junior patent. In Boyd *v.* Janesville, etc., Co., 158 U. S. 260, 15 Sup. Ct. 837, 39 L. Ed. 973, the court reaches the conclusion that the Boyd patent is specific, and then, in referring to defendant's patent, considers the structural differences which put the two patents in two specific classes. The sentence quoted with apparent approval from Pavement Co. *v.* City of Elizabeth, 4 Fish. 189, Fed. Cas. No. 312, was appropriate to that case, but, if applied generally, would overlook the distinction between patentable difference and non-infringement. The opinions of the Supreme Court in Kokomo, etc., Co. *v.* Kitselman, 189 U. S. 8, 23, 23 Sup. Ct. 521, 47 L. Ed. 689, and of this court in Ney *v.* Ney Mfg. Co., 69 Fed. 405, 407, 408, 16 C. C. A. 293, show situations like that in Boyd *v.* Janesville Co., and do not lend support to the idea that the junior patent tends to prove anything more than patentable difference."

The broad doctrine is rejected in the cases cited in the note,[111] but the exception noted in the Herman *v.* Youngstown Car Mfg. Co. case seems to be recognized, and that case may be considered to state the law on the question.

§ 363. A change of form does not avoid an infringement of a patent, unless the form shown in the patent is necessary to the functions which the patent ascribes to the invention; [112] or unless that form is the distinguishing characteristic of the invention; [113] or is essential to its patent-

[111] Murray *v.* Detroit Wire Spring Co., 206 F. R. 465 (6th Circuit), 1913; J. F. Rowley Co. *v.* Columbus Pharmical Co., 220 F. R. 127, 1915; Munising Paper Co. *v.* American Sulphite Pulp Co., 228 F. R. 700, 1915; Curry *v.* Union Electric Welding Co., 230 F. R. 422, 1916.

[112] Long *v.* Pope Mfg. Co., 75 F. R. 839, 1896; Columbia Wire Co. *v.* Kokomo Steel & Wire Co., 143 F. R. 116, 1905.

[113] National Hollow Brake-Beam Co. *v.* Interchangeable Brake-Beam Co., 106 F. R. 711, 1901; Ide *v.* Trorlicht, Duncker & Renard Carpet Co., 115 F. R.

ability;[114] or unless the patentee specifies a particular form as the means by which the effect of the invention is produced;[115] or otherwise confines himself to a particular form of what he describes.[116] Even where a change of form somewhat modifies the construction, the action or the utility of a patented thing, non-infringement will seldom result from such a change.[117] The best way to show the scope and meaning of these rules is to collect and explain some of the instances in which changes of form have been held to be immaterial to questions of infringement.

§ 365. Ives *v.* Hamilton[118] was a case wherein the patent

149, 1902; Dowagiac Mfg. Co. *v.* Superior Drill Co., 115 F. R. 904, 1902; Benbow-Brammer Mfg. Co. *v.* Simpson Mfg. Co., 132 F. R. 614, 1904; O. H. Jewell Filter Co. *v.* Jackson, 140 F. R. 340, 1905; J. L. Owens Co. *v.* Twin City Separator Co., 168 F. R. 259, 1909; Wayne Mfg. Co. *v.* Benbow-Brammer Mfg. Co., 168 F. R. 271, 1909; Wm. B. Scaife & Sons Co. *v.* Falls City Woolen Mills, 209 F. R. 210, 1913; Zittlosen Mfg. Co. *v.* Boss, 219 F. R. 887, 1914.

[114] Adam *v.* Folger, 120 F. R. 263, 1903; Glauber *v.* H. Mueller Mfg. Co., 169 F. R. 110, 1909; M. Solmson *v.* Bredin, 136 F. R. 187, 1905; Cazier *v.* Mackie-Lovejoy Co., 138 F. R. 654, 1905; B. F. Avery & Sons *v.* J. I. Case Plow Works, 148 F. R. 214, 1906; Detroit Copper Mining Co. *v.* Mine & Smelter Supply Co., 215 F. R. 100, 1914.

[115] O'Reilly *v.* Morse, 15 Howard, 123, 1853; Ewart Mfg. Co. *v.* Iron Co., 31 F. R. 150, 1887; Pacific Cable Ry. Co. *v.* Butte City Ry. Co., 55 F. R. 763, 1893.

[116] Pope Mfg. Co. *v.* Mfg. Co., 34 F. R. 890, 1888; Union Steam Pump Co. *v.* Battle Creek Steam Pump Co., 104 F. R. 342, 1900.

[117] Risdon Iron & Locomotive Works *v.* Trent, 92 F. R. 389, 1899; McSherry Mfg. Co. *v.* Dowagiac Mfg. Co., 101 F. R. 721, 1900; Dowagiac Mfg. Co. *v.* Brennan & Co., 127 F. R. 143, 1903; Diamond Match Co. *v.* Ruby Match Co., 127 F. R. 341, 1904; Hutter *v.* DeQ. Bottle Stopper Co., 128 F. R. 283, 1904; Lourie Implement Co. *v.* Lenhart, 130 F. R. 122, 1904; Letson *v.* Alaska Packers' Assoc'n, 130 F. R. 129, 1904.

[118] Ives *v.* Hamilton, 92 U. S. 431, 1875.

covered a combination of a saw-mill saw, with a pair of curved guides at the upper end of the saw; and a lever, connecting rod or pitman, straight guides, pivoted cross-head, and slides or blocks, and crank-pin, or their equivalents, at the opposite end; whereby the toothed edge of the saw was caused to move unequally forward and backward at its two ends while sawing. The result was a rocking or vibratory motion in the saw, instead of a straight reciprocating motion theretofore characteristic of saw-mill saws. The defendant substituted for the curved guides of the patent, similar guides made crooked by a broken line. But the Supreme Court held this change of form not to avoid infringement, saying that a curve is often treated even in mathematical science as constituting a succession of very short straight lines, or as one broken line constantly changing its direction.

§ 366. Morey *v.* Lockwood,[119] was a case in which the bill was based on the patent for the Davidson syringe; an invention which furnishes a good illustration of one of the rules which relate to infringement, as well as of one of those which relate to novelty. In it the bulk was placed in an axial line with two flexible tubes, and received fluid at one of its ends, from one of those tubes, and discharged the same, from its other end, into and through the other of those tubes. The Supreme Court held the patent to have been infringed by the Richardson syringe, in which the bulb was placed above the axial line of the two flexible tubes, and received the fluid from one of those tubes near the point where it discharged the same into the other.

§ 367. The American Diamond Rock Boring Co. *v.* The Sullivan Machine Co.,[120] was a case involving a patent

[119] Morey *v.* Lockwood, 8 Wallace, 230, 1868.

[120] American Diamond Rock Boring Co. *v.* Sullivan Machine Co., 14 Blatch. 119, 1877.

for a rock-boring implement, consisting of a hollow metal boring head armed with diamonds, and which, when moved with a combined rotary and forward motion, bored an annular hole into rock, leaving a central core to be subsequently broken by a wedge and then readily removed. The defendant used a rock-boring tool, consisting of a hollow metal boring head, but having its bottom partly plugged so as to leave two holes elsewhere than in the centre of the head, and having a convex surface armed with diamonds. This tool bored a simple hole into rock without leaving any core to be afterward removed. The change of form involved a modification of the action, and perhaps a modification of the utility of the invention, but it was held not to avoid infringement of a claim which did not mention the annular form of the implement.

§ 368. Elizabeth *v.* Pavement Co.[121] was a case based on the Nicholson pavement patent. That pavement consisted primarily of rows of parallel-sided wood blocks, set endwise, on a continuous foundation, the rows being separated by parallel-sided strips of board, set edgewise between them, and resting on the same foundation, and about half as wide as the blocks were long. The defendant made a pavement differing from the Nicholson in nothing, except that the sides of the strips were not parallel with each other, the strips being thicker at the top than at the bottom edge, and except that the upper angles of the strips were let into corresponding notches cut in the sides of the blocks. The Supreme Court held that though this change in the form of the blocks and of the strips might constitute an improvement in point of utility, it did not operate to avoid infringement.

§ 368*a*. Structures which are designed merely for the purpose of evading the spirit of the invention but which

[121] Elizabeth *v.* Pavement Co., 97 U. S. 137, 1877.

contain all the elements of the claims, are infringements of the patent. For example, infringement may not be evaded by adding to the structure of the patent an easily discarded part which may or may not be used by the purchaser, although if used the structure would not be within the scope of the patent.[122] Likewise the charge of infringement is not averted by a showing that the structure may be and occasionally is used in good faith in a manner that would not infringe if it would infringe when used in the normal, easiest and most effective way.[123]

§ 369. Patents for compositions of matter give rise to questions of infringement somewhat peculiar to themselves. Infringement depends, in such cases, upon sameness or equivalence of ingredients, and upon substantial sameness of the proportions of those ingredients. Omission of one or more of the ingredients of a patented composition of matter avoids infringement, as truly as omission of one of its parts avoids infringement of a patent for a combination of mechanical devices.[124] Addition to a patented composition of matter, of an ingredient which the patent purposely avoided, and which when added substantially changes the character of the composition, also avoids infringement.[125] But an addition which results in no substantial change of character, and which was

[122] Weed Chain Tire Grip Co. *v.* Cleveland Chain & Mfg. Co., 196 F. R. 213, 1910; Parsons Non-Skid Co. *v.* Atlas Chain Co., 198 F. R. 399, 1912; Parsons Non-Skid Co. *v.* Asch, 196 F. R. 215, 1912.

See Wright Co. *v.* Herring-Curtis Co., 211 F. R. 654, 1914.

[123] Marconi Wireless Telegraph Co. *v.* DeForest Telephone & Telegraph Co., 225 F. R. 65, 1914; Parsons Non-Skid Co. *v.* Atlas Chain Co., 198 F. R. 399, 1912.

[124] Otley *v.* Watkins, 36 F. R. 324, 1888; Lane *v.* Levi, 104 O. G. 1898, 1903.

[125] Byam *v.* Eddy, 5 Blatch. 521, 1853.

made merely for the purpose of an attempt to evade the patent, will not have that effect.[126]

The ascertainment of the character of a composition of matter, is a work for chemists; and that work consists in the application of proper tests to each particular case. The same mysterious forces through whose action and reaction a compound was produced, must be availed of to disintegrate and disrupt that compound, in order to ascertain its ingredients, and the mode of their mixture or their union. All the tests of identity specified in a patent, on a composition of matter, and all proper tests of identity, whether thus specified or not, may be invoked by a defendant in support of his contention of non-infringement. But a patentee is confined to proper tests of identity, and cannot impose an improper test upon any defendant, by stating it in his patent, as being legitimate.[127]

§ 370. Substitution of one equivalent for another, in a patented composition of matter, is generally as ineffectual to avoid infringement as is like substitution in a machine. An equivalent for one ingredient of a patented composition of matter is anything which in that composition performs the same function as that ingredient.[128] Chemical equivalency is not necessary to legal equivalency between substances, in respect of a non-chemical use of those substances.[129] The term "equivalent" means "equally good" when it refers to the ingredients of compositions of matter.[129a] Nor will the fact that two substances are classified by chemists in the same group necessarily

[126] Rich *v.* Lippincott, 2 Fisher, 6, 1853.

[127] Matheson *v.* Campbell, 78 F. R. 910, 1897.

[128] Woodworth *v.* Morrison, 1 Holmes, 131, 1872.

[129] Welsbach Light Co. *v.* Sunlight Lamp Co., 87 F. R. 221, 1898; Treibacher-Chemische Werke Gesellschaft, etc., *v.* Roessler & Hasslacher Chemical Co., 219 F. R. 210, 1914.

[129a] Tyler *v.* Boston, 7 Wallace, 330, 1868.

make them legal equivalents.[130] Where the composition of matter involved, is a compound of metals, an equivalent of either of those, is another metal having similar properties, and producing substantially the same effect in that composition.[131] And a substitute is not less an equivalent, because it is derived from a different source than that for which it is a substitute, or because the patentee had no knowledge of it when he received his patent.[132]

§ 370*a*. Where a patent states that each member of a group of substances can be used to compose the matter which is the subject of the patent, and where some of those members cannot be thus used, the patentee cannot invoke the doctrine of equivalents to enable him to monopolize all of them which are afterward found to be suitable for the purpose. If such a patent has only a generic claim, purporting to cover the matter of the patent as made from any of the prescribed starting materials, that patent is void.[133] But if such a patent has a specific claim, limited to the matter of the patent as made from one starting material which is suitable for the purpose, that claim may be valid, though a generic claim in the same patent is not.[134]

§ 371. A substituted ingredient may perform the required function better than the patented ingredient, and may perform that function in a somewhat different manner, and still be an equivalent for the latter.[135] In

[130] General Electric Co. *v.* Laco-Philips Co., 233 F. R. 96, 1916.

[131] Matthews *v.* Skates, 1 Fisher, 609, 1860.

[132] Standard Paint Co. *v.* Bird, 65 F. R. 511, 1894.

[133] Matheson *v.* Campbell, 78 F. R. 921, 1897.

[134] Consolidated Electric Light Co. *v.* McKeesport Light Co., 159 U. S. 465, 1895.

[135] Atlantic Giant Powder Co. *v.* Mowbray, 2 Bann. & Ard. 447, 1876.

the case cited the patent covered a compound of nitro-glycerine and absorbent matter, of which infusorial earth was stated to be the preferred variety. The absorbent matter, when mixed with three times its weight in nitro-glycerine, absorbed the whole, and still retained the form of a powder. This compound made dynamite. The defendant's compound consisted of nitro-glycerine and mica scales mixed in nearly equal proportions, the mica scales not absorbing the nitro-glycerine, but merely holding it in suspension upon their surfaces. This compound was called mica powder. Its use at the Hoosac Tunnel demonstrated its superiority over dynamite, in point of efficiency, economy, and safety; and there is evidently a difference between a powder which absorbs a liquid as in minute capillary tubes, and one which does not absorb, but which carries a liquid upon the surfaces of its particles. But notwithstanding these differences, Judge SHEPLEY, in an accomplished opinion, held the mica powder to infringe the dynamite patent. So also, in a later case on the same patent,[136] the same judge held a certain gunpowder to be an equivalent of the infusorial earth, because it performed every function of the latter substance, though it also performed the additional function, at the time of the explosion of the compound, of co-operating with the nitro-glycerine in rending the rock, instead of remaining, like infusorial earth, an inert substance. The doctrine which results from this case is that one ingredient is an equivalent of another in the composition of matter, if it performs the same function, even though it also performs another function, which that other is wholly incompetent to accomplish.

§ 372. When a patent expressly states that the composi-

[136] *Atlantic Giant Powder Co. v. Goodyear*, 3 Bann. & Ard. 161, 1877.

tion of matter which it covers, does not include a specified ingredient of similar compositions, the substitution of that ingredient for one of those covered by the patent, is enough to avoid infringement, even though the two ingredients perform that same function in that composition of matter. But this does not amount to saying that the two things are not equivalents. It merely amounts to the doctrine that a patentee may disclaim a particular equivalent if he chooses.[137] And where a particular equivalent is disclaimed, that disclaimer is binding even if it was unnecessary.[138]

§ 373. Changes of the proportions of the ingredients of a composition of matter will not avoid infringement of a patent for such a composition, where those changes do not affect its essential character in any way more important than to increase its bulk more than they increase its cost.[139]

But changes in proportion, which change the operative character of a composition of matter, together with changes in its mode of manufacture, may sometimes amount to enough to avert any charge of infringement of a patent on the original composition.[140]

§ 375. A design patent is infringed by any design which, to general observers interested in the subject, or to purchasers of things of similar design, has the same appearance as that of the design covered by the patent, [141]

[137] Byam *v.* Farr, 1 Curtis, 260, 1852.

[138] Cartridge Co. *v.* Cartridge Co., 112 U. S. 624, 1884.

[139] Eastman *v.* Hinckel, 5 Bann. & Ard. 1, 1879.

[140] Atlantic Dynamite Co. *v.* Climax Powder Mfg. Co., 72 F. R. 935, 1895.

[141] Gorham *v.* White, 14 Wallace, 528, 1871; Perry *v.* Starrett, 3 Bann. & Ard. 425, 1878; Dryfoos *v.* Friedman, 18 F. R. 824, 1884; Tomkinson *v.* Mfg. Co., 23 F. R. 895, 1884; Redway *v.* Ohio Stove Co., 38 F. R. 584, 1889; Sutro Bros. Braid Co. *v.* Schloss, 44 F. R. 357, 1890; Macbeth *v.*

and to this end the two articles may be compared as they appear when in use;[141a] but a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent, from the prior art.[142] For design patents cover appearances only, and not uses.[143] Appearances of designs are to be judged by synthetic observation, rather than by analytic inspection. The fact that an analysis of two forms of design discloses differences between them, is insufficient to show lack of that substantial identity of appearance, which constitutes infringement. The test is not whether an ordinary purchaser might be deceived into buying one article for another, but it is the sameness of æsthetic effect on the eye.[144] Such a question of identity is to be decided on the basis of the opinions of average observers, and not upon the basis of the opinions of experts.[145] It matters not to what articles the patentee applies his design or in what channels of trade it goes, or to what material he applies it. If the defendant uses the design,

Gillinder, 54 F. R. 172, 1891; Smith *v.* Stewart, 55 F. R. 483, 1893; Graff, Washbourne & Dunn *v.* Webster, 195 F. R. 522, 1912; Macbeth-Evans Glass Co. *v.* Rosenbaum Co., 199 F. R. 154, 1912; Bush & Lane Piano Co. *v.* Becker Bros., 209 F. R. 233, 1913; Mygatt *v.* Schaffer, 218 F. R. 827, 1914; Ashley *v.* Weeks-Numan Co., 220 F. R. 899, 1915; Grelle *v.* City of Eugene, 221 F. R. 68, 1915.

[141a] Bolte & Weyer Co. *v.* Knight Light Co., 180 F. R. 412, 1910.

[142] New York Belting Co. *v.* New Jersey Rubber Co., 53 F. R. 815, 1893; Byram *v.* Friedberger, 87 F. R. 559, 1897; Bevin Bros. Mfg. Co. *v.* Starr Bros. Bell Co., 114 F. R. 362, 1902; Kruttschnitt *v.* Simmons, 118 F. R. 851, 1902.

[143] Royal Metal Mfg. Co. *v.* Art Metal Works, 121 F. R. 128, 1903.

[144] Bolte & Weyer Co. *v.* Knight Light Co., 180 F. R. 412, 1910.

[145] Bolte & Weyer Co. *v.* Knight Light Co., 180 F. R. 412, 1910.

at least in a non-analogous manner, he is liable for infringement.[146]

§ 376. The comparative utility of the plaintiff's and the defendant's process, machine, manufacture, or composition of matter, is not alone a criterion of infringement.[147] No man is permitted to evade a patent by simply constructing the patented thing so imperfectly that its utility is diminished.[148] On the other hand, a defendant's machine may be better than that covered by the patent in suit and may be an improvement upon it; if that superiority resulted from some addition to the latter, it will have no tendency to avoid infringement,[149] and it matters not that the addition or improvement is patentable or patented.[150] On the other hand, the superiority of the defendant's machine may be due to the fact that he has discovered an entirely different mode of construction and operation in which event it does not infringe.[151]

[146] Dominick & Haff *v.* R. Wallace & Sons Mfg. Co., 209 F. R. 223, 1913.

[147] Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 848, 1901.

[148] Chicago Fruit House Co. *v.* Busch, 2 Bissell, 472, 1871; Roberts *v.* Harnden, 2 Cliff. 506, 1865; Whitely *v.* Fadner, 73 F. R. 486, 1895.

[149] Pitts *v.* Wemple, 1 Bissell, 87, 1855; Carter *v.* Baker, 1 Sawyer, 512, 1871; American Delinter Co. *v.* American Machinery & Const. Co., 128 F. R. 709, 1904; Eck *v.* Kutz, 132 F. R. 758, 1904; Voightmann *v.* Weis & Ridge Cornice Co., 133 F. R. 298, 1904; Ries *v.* Barth Mfg. Co., 136 F. R. 850, 1905; General Electric Co. *v.* Morgan-Gardner Electric Co., 159 F. R. 951, 1907; International Time Recording Co. *v.* W. H. Bundy Recording Co., 159 F. R. 464, 1908; Standard Paint Co. *v.* Bird, 175 F. R. 346, 1910; Stockland *v.* Russell Grader Mfg. Co., 222 F. R. 906, 1915; Yancey *v.* Enright, 230 F. R. 641, 1916.

See Section 347.

[150] Benjamin Electric Mfg. Co. *v.* Dale Co., 158 F. R. 617, 1907.

See Section 362*a*.

[151] Duncan *v.* Cincinnati Butchers' Supply Co., 171 F. R. 656, 1909.

In other words, the defendant's machine may be of a different species and of course cannot infringe a patent of a different species than itself although it might infringe the genus patent of which both are species.

But comparative utility is relevant to questions of infringement, when its consideration is coupled with the consideration of comparative character.[152] An invention, which was never useful enough to be used in any productive business, cannot be dragged across the road which leads toward success, and thus be made to prevent the progress of a useful art along that road.[153] An invention which succeeds, is not to be suppressed by means of a patent on an invention which failed, and can never succeed.[154]

§ 377. To constitute an infringement of a patent, it is not necessary that the infringer should have known of the existence of the patent at the time he infringed it; [155] or, knowing of its existence, it is not necessary that he should have known his doings to constitute an infringement.[156] And infringement is not averted by the fact that the infringer contrived his own process, machine, manufacture, or composition of matter, as the case may be, without any knowledge of the patent infringed thereby.[157]

[152] Goodyear Shoe Mach. Co. *v.* Spaulding, 101 F. R. 994, 1900.

[153] General Electric Co. *v.* Winsted Gas Co., 110 F. R. 963, 1901; Severy Process Co. *v.* Harper & Bros., 113 F. R. 584, 1902.

[154] Westinghouse Air-Brake Co. *v.* New York Air-Brake Co., 112 F. R. 428, 1901.

[155] Parker *v.* Haworth, 4 McLean, 373, 1848; Matthews *v.* Skates, 1 Fisher, 608, 1860; National Car Brake Shoe Co. *v.* Mfg. Co., 19 F. R. 520, 1884; Royer *v.* Coupe, 29 F. R. 361, 1886; Bate Refrigerating Co. *v.* Gillett, 31 F. R. 815, 1887.

[156] Parker *v.* Hulme, 1 Fisher, 54, 1849; Norton *v.* Automatic Can Co., 57 F. R. 933, 1893.

[157] United States *v.* Berdan Fire Arms Co., 156 U. S. 566, 1895.

CHAPTER XVII

COURTS, PARTIES AND CAUSES

378. Introductory explanation.
379. Jurisdiction of United States courts of first resort in patent cases.
380. Non-jurisdiction of State courts in patent cases.
388. Jurisdiction of State courts over controversies growing out of contracts relevant to patents.
389. Jurisdiction of individual United States courts of first resort in patent cases.
390. Qualification of the rule of the last section.
391. Jurisdiction of the Court of Claims.
392. Absence of jurisdiction of the Court of Claims over causes of action based on unauthorized making, using, or selling by the United States Government of specimens of a patented process or thing.
393. Presence of jurisdiction of United States Circuit Courts over actions brought against agents of the United States Government, and based on unauthorized making, using, or selling, by those agents, on behalf of the Government, of specimens of a patented process or thing.
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395. Who may be plaintiff or complainant in an action based on an assigned accrued right of action for infringement.
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402. Minors and married women as defendants.
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404. Employers as defendants.
405. Persons as defendants who have caused others to infringe.
406. Joint infringers as defendants.
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411. The same subject continued.
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417. Causes of action based on a plurality of patents or on both terms of an extended patent, or on a patent and a trade-mark.

§ 378. THE foregoing part of this text-book treats of the rights of inventors and patentees, and of their assignees, grantees, licensees, and legal representatives; and also treats of the wrongs which are committed when those rights are infringed. The remaining part explains the remedies which may be invoked, sometimes to prevent, and sometimes to repair such wrongs of infringement. The present chapter is devoted to the courts which may originally administer those remedies; and to the parties who may invoke them, and against whom they may be invoked; and to the causes of action which justify patent litigation between those parties in those courts.

§ 379. The Circuit Courts of the United States, before they were abolished, had original jurisdiction, regardless of the amount involved, of all suits at law or in equity, arising under the patent laws of the United States.[1] By the Judiciary Act of March 3, 1911, 36 Statutes 1100, known as the Judicial Code, this jurisdiction was vested

[1] Revised Statutes, Section 629; Miller-Magee Co. *v.* Carpenter, 34 F. R. 434, 1888.

in the District Courts.[1a] The same jurisdiction belongs to the District Courts of the Territories of the United States,[2] and to the Supreme Court of the District of Columbia.[3]

This jurisdiction is independent of all State statutes; and therefore a corporation of any State may begin and prosecute an action arising under the patent laws, in any proper Federal court, without complying with any State statute which may require foreign corporations to file copies of their respective charters in some State custody, before beginning any suit in any court of that State.[4]

Not every suit arises under the patent laws, which relates to letters patent for inventions; for some suits relate to letters patent for inventions, though they arise out of contracts between private parties. An action at law which seeks a judgment for damages, or an action in equity which seeks a decree for an injunction and a money recovery, on account of an alleged infringement of a patent, is an action arising under the patent laws of the United States.[5]

An action on a judgment obtained in a patent case is not, however, a suit arising under the patent laws, even though it is brought against directors of an insolvent corporation to make them liable for a judgment obtained in an infringement suit against the corporation.[6]

§ 380. Whether State courts have any jurisdiction of actions for infringements of patents was a question which,

[1a] Judicial Code, Sections 289 to 296.

[2] Revised Statutes, Section 1910, and Section 1911, as amended June 29, 1876, 19 Statutes at Large, Ch. 154, p. 62.

[3] Sections 760 and 764 of the Revised Statutes relating to the District of Columbia; Cochrane *v.* Deener, 94 U. S. 782, 1876.

[4] Columbia Wire Co. *v.* Freeman Wire Co., 71 F. R. 302, 1895.

[5] Victor Talking Mach. Co. *v.* The Fair, 123 F. R. 424, 1903.

[6] H. C. Cook Co. *v.* Beecher, 217 U. S. 497, 1910.

under the Revised Statutes of 1874, was clearly answerable in the negative.[7] But in 1875 Congress enacted a statute which provided: "That the Circuit Courts of the United States shall have original cognizance, concurrent with the courts of the several States, of all suits of a civil nature at common law or in equity, where the matter in dispute exceeds, exclusive of costs, the sum or value of five hundred dollars, and arising under the Constitution or laws of the United States."[8] This statute of 1875 appeared to assume that, in the absence of congressional prohibition, the State courts would inherently have concurrent jurisdiction with the Federal courts of all suits of a civil nature, at common law or in equity, arising under the Constitution or laws of the United States; and it seemed to remove the prohibition contained in the Revised Statutes. Accordingly, in the first and second editions of this book, Sections 381 to 387 were devoted to the great question whether, in the absence of congressional prohibition, State courts would have jurisdiction of civil actions arising under the Constitution or laws of the United States. In those sections it was shown that ALEXANDER HAMILTON and Justice WASHINGTON held the affirmative of that question, while Justice STORY, Chancellor KENT, and Justice FIELD held the negative; and that the Supreme Court had never decided the question; but that the strongest relevant reasons supported the negative opinion. But, independent of that great question, the Supreme Court has now decided that the statute of 1875, as amended in 1887 and 1888, does not affect the jurisdiction, granted by earlier statutes, of any court of the United States over specified cases arising under the Constitution and laws of the United States; and therefore the later

[7] Revised Statutes, Section 711.

[8] 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470.

statute does not apply to any case arising under the patent laws of the United States.[9] Thus it is now established that State courts have no jurisdiction of such cases. And it accordingly has been so said by several Federal judges,[10] and by several State courts.[11]

§ 388. Actions brought to enforce contracts between private parties, relevant to patent rights, are not actions arising under the patent laws of the United States; and therefore are not cognizable as such in the United States courts.[12] And actions to set aside such contracts fall in the same category.[13] This doctrine, however, was severely strained in the Supreme Court decision in the case of New Marshall Engine Co. *v.* Marshall Engine Co.,[13a] a case in which the bill was brought in a State court on a contract to assign a certain patent and "all improvements thereon and renewals of the same." The patent specifically designated was assigned in compliance with the contract and

[9] *In re* Hohorst, 150 U. S. 661, 1893.

[10] White *v.* Rankin, 144 U. S. 636, 1892; *In re* Keasbey & Mattison Co., 160 U. S. 230, 1895; Pratt *v.* Paris Gas Light & Coke Co., 168 U. S. 259, 1897; Myers *v.* Cunningham, 44 F. R. 347, 1890; Elgin Wind Power & Pump Co. *v.* Nichols, 65 F. R. 217, 1895; Hupfeld *v.* Automaton Piano Co., 66 F. R. 789, 1895.

[11] Continental Store Service Co. *v.* Clark, 100 N. Y. 370, 1886; Waterman *v.* Shipman, 130 N. Y. 308, 1891; Havana Press Drill Co. *v.* Ashurst, 148 Ill. 137, 1893.

[12] Brown *v.* Shannon, 20 Howard, 56, 1857; Albright *v.* Teas, 106 U. S. 613, 1882; Dale Tile Mfg. Co. *v.* Hyatt, 125 U. S. 46, 1888; Marsh *v.* Nichols, 140 U. S. 344, 1891; Pratt *v.* Paris Gas Light & Coke Co., 168 U. S. 260, 1897; Standard Sewing Mach. Co. *v.* Leslie, 118 F. R. 557, 1902; Victor Talking Mach. Co. *v.* The Fair, 123 F. R. 424, 1903; New Marshall Co. *v.* Marshall Engine Co., 223 U. S. 473, 1912; Briggs *v.* United Shoe Co., 239 U. S. 48, 1915.

[13] Wilson *v.* Sandford, 10 Howard, 101, 1850; Wade *v.* Lawder, 165 U. S. 624, 1897; Standard Dental Mfg. Co. *v.* National Tooth Co., 95 F. R. 291, 1899.

[13a] New Marshall Engine Co. *v.* Marshall Engine Company, 223 U. S. 473, 1912.

thereafter the inventor invented what was alleged in the bill to be an improvement on the patent assigned. In addition the bill prayed that the defendants should be enjoined from manufacturing or selling machines covered by the improvement patent. The defendant moved to dismiss the bill because "it presents questions involving an inquiry as to the construction and scope of the patents therein mentioned, of which questions the Federal Courts have exclusive jurisdiction." Justice LAMAR who delivered the opinion said in part as follows:

"The complainant did not by its bill in the State Court raise any question as to the validity or construction of the patent, nor did it make any claim for damages for infringement. . . . The Patent 725,349 was an improvement thereon (on the original patent) as on the face of the application and letters patent it appeared to be, then the complainant was entitled to a decree requiring Marshall to make conveyance which could be properly recorded for the protection of the true owner.

"It is, however, urged that the State Court was ousted of the jurisdiction to enter a decree for specific performance because the bill went further and prayed that the defendants and each of them should be enjoined from manufacturing and selling machines covered by Patent 725,349. It is claimed that this was, in effect, an application and decree for injunction against infringement and could only be granted by a Federal Court.

"But the allegations of the complainant's bill did not involve any construction of the meaning or effect of Patent 725,349 nor does it charge that the manufacture or sale of engines by the defendants would be an infringement of the patent or of any right of the complainant if in fact, patent 725,349 belonged to the New Marshall Engine Co. The injunction was asked for only as an in-

cident of a finding that the title was vested in the complainant."

But a majority of the Supreme Court has gone further than any of the rules above stated, and in spite of a vigorous dissent from the minority, has held another doctrine which is as follows: Where a complainant files a bill, in which he states a patent right, and states its use by the defendant; and, in a charging part, recites the particulars of an alleged license claimed by the defendant to be a justification of that use, and avers that there is no such license in existence, and prays for an injunction and an account of infringer's profits; and where the defendant files an answer, admitting the patent right, and admitting the use, and defending only on the ground of the alleged license; then the action is not one arising under the patent laws of the United States.[14] But there is no warrant for pressing that conclusion any further than it necessarily goes; no warrant for applying its doctrine to any case which lacks any of the elements upon which it was based. And neither the Supreme Court nor the other Federal tribunals have shown a disposition so to do.[15]

Where a complainant files a bill in which he states a patent right, and states its use by the defendant, and says nothing about any contract or license, and prays for an injunction and an account of infringer's profits; and where the defendant thereupon files an answer in which he does not traverse any part of the bill, but pleads, by way of confession and avoidance, that he has a license which covers his use of the patent, it will not do to apply the rule in Hartell *v.* Tilghman. If that rule were applied to such a case, it would result in a dismissal of the bill for

[14] Hartell *v.* Tilghman, 99 U. S. 547, 1878.

[15] Atherton Mach. Co. *v.* Atwood-Morrison Co., 102 F. R. 955, 1900; Leslie Co. *v.* William Mann Co., 157 F. R. 236, 1907.

want of jurisdiction. Then if the complainant should file a new bill in a State court, precisely like the other, and if the defendant should thereupon file an answer saying nothing about any license, but denying the validity of the patent, that suit would also have to be dismissed, because it would present no controversy except one touching the validity of a patent for an invention. Any infringer of a patent could thus defeat every suit based on his infringement, by simply making one defence in one court and another defence in another court, no matter how fictitious both of those defences might be. A consequence so unjust could not be tolerated; and the law is now settled that where a plaintiff decides to sue a defendant as a naked infringer, the Federal courts have jurisdiction, and that such jurisdiction cannot be ousted by any answer which the defendant may interpose.[16]

§ 389. Actions for infringement of patents, being transitory in their nature, could formerly be brought in any district in which the defendant was an inhabitant or should be found.[17] But a statute of March 3, 1897, re-enacted by Act of March 3, 1911, c. 231, § 48 (36 Stat. 1100), restricts such suits to the district of which the defendant is an inhabitant, or to any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement, and have a regular and

[16] White *v.* Rankin, 144 U. S. 628, 1892; Excelsior Wooden Pipe Co. *v.* Pacific Bridge Co., 185 U. S. 282, 1902; Elgin Wind Power & Pump Co. *v.* Nichols, 65 F. R. 217, 1895; Everett *v.* Haulenbeek, 68 F. R. 911, 1895; Young Reversible Lock-Nut Co. *v.* Young Lock-Nut Co., 72 F. R. 62, 1896; Pacific Contracting Co. *v.* Union Paving Co., 80 F. R. 737, 1897; Atherton Mach. Co. *v.* Atwood-Morrison Co., 102 F. R. 949, 1900; Clancy *v.* Troy Belting & Supply Co., 157 F. R. 554, 1907; The Fair *v.* Kohler Die Co., 228 U. S. 22, 1913.

[17] 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470.

established place of business.[18] These restrictions on jurisdiction are, however, merely a personal privilege and are waived by a general appearance.[19] Further, the statute applies not only to defendants who are inhabitants of some district within the United States but also to non-resident aliens, who may be served by substituted service on their agents in the United States whether the alien is a person, partnership, or corporation.[20] In addition aliens may be sued in any district in which they are found.[21]

The general appearance, however, is limited in its application by the scope of the action in which the general appearance is filed, and such an appearance does not warrant the court in allowing an amendment which sets up a new, different or distinct cause of action from that set up in the original bill; as for instance a cause of action on which the defendant could not originally have been sued in the jurisdiction where the suit was commenced.[22]

Section 740 of the Revised Statutes, providing that where there are two or more defendants residing in different Federal districts of the same State, the suit may be brought in either district and jurisdiction of all defendants obtained by the issuance and service of duplicate subpœnas, does not apply to suits for infringement of patents, and where there are two or more joint defendants living in different districts of the same State, each

[18] 29 Statutes at Large, Ch. 395, p. 695; Bowers *v.* Atlantic G. & P. Co., 104 F. R. 889, 1900.

[19] U. S. Consolidated, etc., Co. *v.* Phœnix, etc., Raisin Co., 124 F. R. 234, 1903; United States Expansion Bolt Co. *v.* H. G. Kroucke Hardware Co., 216 F. R. 186, 1914.

[20] Smith *v.* Farbenfabriken of Elberfeld Co., 203 F. R. 476, 1913.

[21] United Shoe Mach. Co. *v.* Duplessis, etc., Co., 133 F. R. 930, 1904.

[22] Western Wheeled Scraper Co. *v.* Gahagan, 152 F. R. 648, 1907. (Note: while the principle of law stated is undeniably correct, query as to its application to the facts in the particular case.)

defendant must be within the scope of the provisions of the Act of March 3, 1897, above noted.[23]

Where the jurisdiction is not based on habitation, the existence of a regular and established place of business in the district, at the time the suit is begun, is necessary to the jurisdiction; though the infringement in the district may have ceased at that time.[24] Where a manufacturing corporation makes infringing articles in the State where it is organized and exists, and sends those articles to another State to be there sold by another corporation as its agent, and where those articles are thus sold; the place of business of the selling corporation is a regular and established place of business of the manufacturing corporation.[25] But a space occupied by an exhibitor, in an exposition, for the purpose of showing articles to the public, is not a regular and established place of business, within the meaning of the statute.[26]

Where a manufacturing corporation maintains an agency for the preliminary negotiation of sales of infringing articles, it has a regular and established place of business; but if that preliminary negotiation is not followed by any sale or subsequent use of an infringing article, in the district where that agency is maintained, the District Court for that district has no jurisdiction of that corporation, on account of that agency.[27] But if that preliminary

[23] Cheatham Electric Switching Device Co. *v.* Transit Development Co., 191 F. R. 727, 1911.

[24] Feder *v.* A. B. Fiedler & Sons, 116 F. R. 378, 1902; Underwood Typewriter Co. *v.* Fox Typewriter Co., 158 F. R. 476, 1907.

[25] Thomson-Houston Electric Co. *v.* Bullock Electric Co., 101 F. R. 588, 1900; Smith *v.* Farbenfabriken of Elberfeld Co., 203 F. R. 476, 1913.

[26] L. E. Waterman Co. *v.* Parker Pen Co., 100 F. R. 544, 1900.

[27] Westinghouse Electric & Mfg. Co. *v.* Stanley Electric Mfg. Co., 116 F. R. 641, 1902; United Autographic Register Co. *v.* Egry

negotiation is followed by a sale of an infringing article outside of that district, for subsequent use inside of that district, the District Court for that district has jurisdiction of that manufacturing corporation, on the ground that it not only has a regular and established place of business in the district, but also is chargeable with contributing to the infringing use of the article in the district, after having sold it for that purpose, though the sale was consummated outside of the district.[28]

In W. S. Tyler Co. against Ludlow-Saylor Wire Co.,[28a] the Supreme Court held that where a manufacturing company of another State than that where the suit is brought employs a representative in the State of suit, paying him a small salary, commissions on sales and travelling expenses, the duty of the representative being merely to solicit orders and forward them when received, to the home office for execution, does not have a regular and established place of business in the district of suit. The court said: "Guerin received and forwarded and his principal accepted orders for goods which were thereafter manufactured and shipped by express to the purchaser in New York City. This sale was consummated at St. Louis and did not constitute an infringement of appellant's patent within the district where suit was brought." The determining elements in the case are considered to be that the "agent" was also employed by another corpora-

Register Co., 219 F. R. 637, 1915; Tyler Co. *v.* Ludlow-Saylor Wire Co., 236 U. S. 723, 1915; United States Envelope Co. *v.* Transo Paper Co., 229 F. R. 576, 1916.

[28] Westinghouse Electric & Mfg. Co. *v.* Stanley Electric Mfg. Co., 121 F. R. 101, 1903. See Chadeloid Chemical Co. *v.* Chicago Wood Finishing Co., 180 F. R. 770, 1910, where the phrase in question is given a liberal interpretation; Edison *v.* Allis-Chalmers Co., 191 F. R. 837, 1911.

[28a] W. S. Tyler Co. *v.* Ludlow-Saylor Wire Co., 236 U. S. 723, 1915.

tion than the defendant to solicit orders to be executed at the home office of the latter, and that he shared his office expenses with the other corporation.[28b]

The provision of the Act of March 3, 1897, c. 395 (29 Stat. 695), that where the suit is brought in a district where the defendant has a "regular and established place of business" service of process "may be made by service upon the agent or agents engaged in conducting such business" is permissive only, and where the defendant is a corporation service may be made on the corporation itself if it be found within the district of suit.[29]

Where a defendant intends to deny habitation, or the existence of a regular and established place of business, in the district in which a suit has been begun, the proper practice is a special appearance for the purpose, and a motion to set aside whatever service of process may have been made, upon any person as assumed representative of the defendant.[30] Where a defendant intends to deny any infringement within the district in which a suit has been begun; that denial may be made by motion to dismiss, unless such infringement is asserted in the bill. And where such infringement is asserted in the bill, that denial may be made by special matter in the answer.[30a] If made by special matter in the answer, then the issue of fact must be settled by evidence. If that denial is made in an answer, it may be presented to the court by a motion to dismiss the bill for want of jurisdiction, after the complainant has taken his evidence in chief, and has

[28b] United States Envelope Co. *v.* Transo Paper Co., 229 F. R. 576, 1916.

[29] National Electric Signalling Co. *v.* Telefunken Wireless Telegraph Co., 194 F. R. 893, 1912.

[30] Interior Construction Co. *v.* Gibney, 160 U. S. 219, 1895; L. E. Waterman Co. *v.* Parker Pen Co., 100 F. R. 544, 1900; United States Seeded Raisin Co. *v.* Phœnix Seeding Co., 124 F. R. 234, 1903.

[30a] Equity Rule 29.

omitted or failed to prove infringement as having occurred in the district where the suit is pending.[31] For purposes of jurisdiction of a non-resident the infringement must be actual and not merely threatened.[32] A voluntary general appearance by the defendant does not relieve the plaintiff from proving the jurisdictional facts if the allegations concerning them are denied.[33]

§ 390. Where a district contains more than one division, every action for infringement of a patent, which is brought in that district on the ground of the habitation of the defendant therein, must be brought in the division where he resides; and where there are two or more defendants residing in different divisions of a district, such an action, if brought against them in that district, on the ground of their habitation therein, must be brought in one of those divisions.

§ 391. The Court of Claims is the tribunal which has jurisdiction of all actions brought by owners of patent rights against the government of the United States, for compensation for the use by the Government of patents and patent rights owned by individuals.[34] Such suits are subject to a six-year statute of limitations and in the absence of an established royalty the claimant is entitled to recover what a reasonable royalty for an express license would have been.[35] But it is held that no implied contract arises where the patentee is an officer of the United States Government making the patent invention in the course of his official duty at the expense of the Govern-

[31] Streat *v.* American Rubber Co., 115 F. R. 634, 1902.

[32] Gray *v.* Grinberg, 147 F. R. 732, 1906.

[33] Gray *v.* Grinberg, 159 F. R. 138, 1908.

[34] United States *v.* Burns, 12 Wallace, 246, 1870; United States *v.* Palmer, 128 U. S. 269, 1888; Act June 25, 1910, 36 Stat. 851.

[35] United States *v.* Berdan Fire Arms Co., 156 U. S. 569, 1895.

ment and for the public service.[36] It has been held that this protection, at least as far as a suit for an injunction is concerned, extends to an owner of a hotel who has purchased infringing mail chutes and established them in his hotel and hence are by the general Act of Congress, under the care and custody of the United States.[37] Presumably this holding applies only to the particular chutes already supplied to the Government and an injunction might issue against supplying more,[38] at least in the absence of the statute passed in 1910 permitting certain suits against the Federal Government to be brought in the Court of Claims.[39]

§ 392. What remedy a patentee has when the Government makes or uses specimens of the patented invention without his consent is a question which was long debated. The United States cannot be sued except where it has consented thereto by a statute. This question was, however, set at rest by the passage of the Act of June 25, 1910, 36 Statutes, 851, whereby the Court of Claims was given jurisdiction of suits by owners of patents and licensees for the recovery of reasonable compensation for the use by the Government of the patent owned or licensed.[40]

§ 393. Prior to the Act mentioned in the preceding section there was much debate as to the personal liability of an officer of the United States Government who was chargeable with an unauthorized use of a patented inven-

[36] Solomons *v.* United States, 22 Court of Claims, 342, 1887; Davis *v.* United States, 23 Court of Claims, 334, 1888.

[37] Cutler *v.* Maryland Hotel Co., 168 F. R. 931, 1909.

[38] International Curtis Marine Turbine Co. *v.* William Cramp & Sons Ship & Engine Co., 211 F. R. 124, 1914.

[39] Act June 25, 1910, c. 423 (36 Stat. 851).

See Section 157.

[40] See Schillinger *v.* United States, 155 U. S. 169, 1894, decided before the Act of June 25, 1910.

tion for the benefit of the Government. This question is considered more fully in Section 157 of this book. In brief, however, it may be stated that it is no longer the law that an action will lie against agents of the Government under such circumstances.[41]

§ 394. The plaintiff or complainant in an action based on an infringement of a patent may be the patentee, or the sole assignee of that patent; or any grantee under a patent may sue alone, for any infringement committed within his territory.[42] And the owner of an equitable title to the patent may sue in equity if the defendant is the patentee or his assignee.[43] And the plaintiff or complainant may be a partnership, as well as a person or a corporation; and may sue in the partnership name, though that name is an artificial one, quite unlike the names of the partners.[44]

It is not necessary for the plaintiff, in an action at law, to own any present interest in the patent at the time he brings his action. It is enough if he was the patentee, assignee, or grantee of the rights infringed, at the time the infringement sued upon was committed.[45] But this rule does not generally apply to actions in equity, for such actions are generally dependent upon an injunction, and no injunction can be granted to restrain future infringements of a patent, on the suit of a person who has no interest in the patent threatened to be infringed.[46] Though

[41] Crozier *v.* Krupp, 224 U. S. 290, 1912.

[42] Revised Statutes, Section 4919; Wilson *v.* Rousseau, 4 Howard, 646, 1846; Stein *v.* Goddard, 1 McAlister, 82, 1856; Seibert Oil Cup Co. *v.* Beggs, 32 F. R. 790, 1887.

[43] Prest-O-Lite Co. *v.* Avery Portable Lighting Co., 164 F. R. 60, 1908.

[44] Fruit Cleaning Co. *v.* Fresno Home Packing Co., 94 F. R. 847, 1899.

[45] Moore *v.* Marsh, 7 Wallace, 515, 1868.

[46] Waterman *v.* Mackenzie, 138 U. S. 255, 1891.

where a complainant owns a patent infringed, when he files his bill for an injunction and a money recovery, jurisdiction will not lapse when he assigns the future of his patent.[47]

§ 395. Actions at law brought by assignees or grantees, for infringements committed prior to the time they obtained title, must, according to the common law, be brought in the name of the person who held the legal title to the patent right when and where it was infringed by the defendant. This rule was not abrogated by the statute which permits suits to be brought by assignees; because the assignees which are contemplated by that statute, are assignees of patents and not assignees of rights of action under patents.[48] No cause of action for damages against an infringer lies in favor of an assignee of a mere claim for damages for infringement. Such an assignee is not a "party interested, either as patentee, assignee or grantee."[49] Nor may such an assignee, or at any rate one who has merely the right to share in moneys collected from infringement, be a party to a suit in equity for an injunction,[50] unless as owner of the patent who was granted an exclusive license but who has reserved an interest in damages to be recovered from infringers and also has the right to cancel the license under certain conditions. The latter right is held to entitle him to bring such a suit, even if the former would not be sufficient.[51]

An action in equity, if maintainable at all in such a case, may be brought in the name of the assignee; and such an

[47] New York Belting Co. *v.* New Jersey Rubber Co., 47 F. R. 505, 1891.

[48] Moore *v.* Marsh, 7 Wallace, 515, 1868; Armstrong, Whitworth & Co. *v.* Norton, 15 App. D. C. 232, 1899.

[49] Webb *v.* Goldsmith, 127 F. R. 572, 1904; Revised Statutes, Section 4919.

[50] Kaiser *v.* General Phonograph Supply Co., 171 F. R. 432, 1909.

[51] Kaiser *v.* General Phonograph Supply Co., 171 F. R. 432, 1909.

action will be maintainable where the suit is based on infringements and threatened infringements, committed after the complainant obtained title, as well as upon infringements committed before that event.[52] An action in equity will also be maintainable in such a case, if the assignor of the right of action was a corporation, and has been dissolved or has expired;[53] or if for any reason it is impossible for the assignee of the right of action to sue in the name of the assignor.[54]

Where the assignor is dead at the time the assignee desires to bring an action at law, and where no legal representative of the assignor exists, or is likely to exist unless the appointment of one is obtained for the special purpose of using his name as nominal plaintiff in the assignee's suit, it would seem no great stretch of equity jurisdiction to allow the assignee to file a bill in his own name, and thus avoid the useless and expensive circuity of compelling him first to secure the appointment of an administrator, and then to bring an action at law in the name of the latter. No principle adverse to such a proceeding was perceived by Chief Justice MARSHALL, when, in a similar case of expensive circuity at law, the more direct and less expensive methods of equity were invoked before him.[55]

§ 396. Where a patentee, assignee, or grantee, who was entitled to sue for an infringement of a patent, died before beginning an action thereon, such an action may be

[52] Dibble *v.* Augur, 7 Blatch. 86, 1869; Henry *v.* Stove Co., 2 Bann. & Ard. 224, 1876; Gordon *v.* Anthony, 16 Blatch. 234, 1879; Merriam *v.* Smith, 11 F. R. 589, 1882; Shaw *v.* Lead Co., 11 F. R. 715, 1882; Consolidated Oil Well Packer Co. *v.* Eaton, 12 F. R. 870, 1882.

[53] Lenox *v.* Roberts, 2 Wheaton, 373, 1817.

[54] Hayward *v.* Andrews, 106 U. S. 675, 1882.

[55] Riddle *v.* Mandeville, 5 Cranch, 329, 1809.

brought by his executor or administrator,[56] upon his fulfilling the conditions and giving the guarantees of fidelity and solvency required by the law of the State wherein the court is established in which the action is proposed to be brought.[57] But it is not certain that, when beginning a patent action in a Federal court in a State other than that of his appointment, an executor or administrator must conform to the conditions, or give the guarantees, prescribed by the local laws.[58] Whether the various State laws, relevant to foreign executors or administrators suing in State courts, are binding in such cases as these, is a point upon which there appears to be a conflict of authority. The cases last cited appear to support the negative of the question, while those cited just before seem to sustain the affirmative view. It is possible that a distinction may be drawn on this point between actions based on patents and actions arising out of local law and brought into Federal courts on grounds of diverse citizenship. If that distinction is found to be important, it may lead to a decision that executors and administrators may begin and prosecute patent cases in Federal courts in States other than that of their appointment, without any regard to the probate or other analogous laws of those States. If it is held otherwise, then the laws of the States relevant to the conditions upon which foreign executors or administrators are permitted to sue in their courts, will require the attention of the practitioner in such cases. In some States those conditions amount to local probate,

[56] May *v.* County of Logan, 30 F. R. 253, 1887.

[57] Rubber Co. *v.* Goodyear, 9 Wallace, 791, 1869; Wilkins *v.* Ellett, 108 U. S. 256, 1882; Picquet *v.* Swan, 3 Mason, 472, 1824.

[58] Hodge *v.* Railroad Cos., 4 Fisher, 162, 1870; Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co., 1 Bann. & Ard. 177, 1874.

and in others they amount to no more than the giving of a bond for costs. But whether onerous or easy, and whether necessary or unnecessary to be regarded in patent cases, an omission to regard them cannot be availed of by a defendant, unless availed of in his pleadings.[59]

§ 397. Where an executor or administrator of a deceased patentee, or assignee or grantee of a patent right, assigns that right to another, or assigns to another a right of action for its infringement, that other can sue thereon in any State, without any proceedings in the nature of local probate, provided he can sue in his own name.[60] Whether he can sue in his own name will depend upon whether he is entitled to an injunction; or if not entitled to an injunction, it will depend upon whether equity can take jurisdiction on some other ground; or if not entitled to sue in equity at all, it will depend upon whether the laws of the particular State authorize assignees of rights of action to bring actions at law in their own respective names.[61]

§ 398. Patentees and other persons entitled to bring actions for infringements of patents may appoint attorneys in fact to bring those actions in the names of the appointers; but not in the names of the attorneys in fact.[62]

§ 399. Owners in common of patent rights must sue jointly for their infringement, or the defendant may plead in abatement or demur,[63] or in suit in equity, move to dismiss. This rule applies where a patentee has assigned an

[59] Rubber Co. *v.* Goodyear, 9 Wallace, 791, 1869.

[60] Harper *v.* Butler, 2 Peters, 238, 1829; Treeothick *v.* Austin, 4 Mason, 36, 1825; Leake *v.* Gilchrist, 2 Devereaux (N. C.), 73, 1829; Peterson *v.* Chemical Bank, 32 N. Y. 21, 1865; Riddick *v.* Moore, 65 N. C. 382, 1871; May *v.* County of Logan, 30 F. R. 253, 1887.

[61] May *v.* County of Logan, 30 F. R. 253, 1887.

[62] Goldsmith *v.* Collar Co., 18 Blatch. 82, 1880.

[63] Van Orden *v.* Nashville, 67 F. R. 332, 1895; Postal Tel. Cable Co. *v.* Netter, 102 F. R. 691, 1900.

undivided part of his patent,[64] and also to cases where the owner of the patent has granted an undivided interest therein, in that part of the territory of the United States wherein the infringement sued upon was committed. In the first of these cases the action must be brought by the patentee and assignee jointly; and in the other case it must be jointly brought by the owner of the patent and his grantee. Indeed, the rule necessarily applies to every case where a plurality of persons own the undivided interest in a patent right, whether in the whole, or only in a part of the territory of the United States. And it has been held in one case, that the owner of a patent right in a part of the territory of the United States, may join with the owner of the same patent right in another part of that territory, in suing for infringement of the patent in the territory of the latter, on the ground that all the owners of territorial rights under the patent are interested in having it sustained.[65] But there is no occasion for a person who has only an interest in the proceeds of a patent, without having any title in the patent itself, to join in a suit for its infringement.[66]

§ 400. Licensees under patents cannot bring actions for their infringement.[67] Where a person has received an exclusive license to use or to sell a patented invention within

[64] Moore *v.* Marsh, 7 Wallace, 515, 1868; Waterman *v.* Mackenzie, 138 U. S. 255, 1891; Dick *v.* Struthers, 25 F. R. 104, 1885.

[65] Otis Mfg. Co. *v.* Crane Mfg. Co., 27 F. R. 558, 1886.

[66] Bogart *v.* Hinds, 25 F. R. 485, 1885.

[67] Gayler *v.* Wilder, 10 Howard, 477, 1850; Paper-Bag Cases, 105 U. S. 766, 1881; Blanchard *v.* Eldridge, 1 Wallace, Jr., 337, 1849; Potter *v.* Holland, 4 Blatch. 206, 1858; Sanford *v.* Messer, 1 Holmes, 149, 1872; Nelson *v.* McMann, 4 Bann. & Ard. 203, 1879; Gamewell Telegraph Co. *v.* Brooklyn, 14 F. R. 255, 1882; Ingalls *v.* Tice, 14 F. R. 297, 1882; Wilson *v.* Chickering, 14 F. R. 917, 1883; De Forest *v.* Collins Wireless Telephone Co., 174 F. R. 821, 1909.

a specified territory, all actions at law against persons who, without right, have done anything covered by the license, must be brought in the name of the owner of the patent right, but generally for the use of the licensee;[68] and all actions in equity must be brought by the owner of the patent right and the exclusive licensees suing together as joint complainants;[69] even where the license is oral,[70] or is an incident of a partnership.[71]

But the holder of a license less than exclusive must not join in an action in equity for an infringement of the patent under which he is licensed,[72] even where the infringement consisted in making and selling one form of the patented invention, which the licensee was exclusively licensed to make and sell.[73] And an exclusive licensee who has assigned his license, must not join in an action in equity for an infringement of the patent, even against a defendant who infringed before the license was assigned; for such a person is not entitled to pray for an injunction, and therefore is not entitled to invoke a court of equity to decree a money recovery for past infringement.

Actions at law brought in the name of the owner of a patent right, but actually begun by an exclusive licensee, may be maintained by the latter, even against the will

[68] Littlefield *v.* Perry, 21 Wallace, 223, 1874; Goodyear *v.* McBurney, 3 Blatch. 32, 1853; New York Filtration Co. *v.* City of Sullivan, 111 F. R. 181, 1901.

[69] Waterman *v.* Mackenzie, 138 U. S. 255, 1891; Hammond *v.* Hunt, 4 Bann. & Ard. 113, 1879; Huber *v.* Sanitary Depot, 34 F. R. 752, 1888; Bredin *v.* Solmson, 145 F. R. 944, 1906. See Havens *v.* W. R. Ostrander & Co., 190 F. R. 199, 1911.

[70] Sharpless *v.* Moseley & Stoddard Mfg. Co., 75 F. R. 595, 1896.

[71] Chisholm *v.* Johnson, 106 F. R. 213, 1901.

[72] Blair *v.* Lippincott Glass Co., 52 F. R. 226, 1892; American Graphaphone Co. *v.* Walcutt, 87 F. R. 557, 1898.

[73] Pope Mfg. Co. *v.* Clark, 46 F. R. 792, 1891.

of the nominal plaintiff.[74] And where an exclusive licensee brings an action in equity in the name of himself and the owner of the patent right, that action may be maintained without the co-operation and even against the objection of the latter.[75] The fact that the owner has been enjoined in another circuit from maintaining suits for infringement on the patent in suit does not relieve the owner from such liability to be joined as plaintiff.[76]

Where the owner of a patent is himself an infringer of a licensee's exclusive right to use or to sell the invention covered thereby, no action at law can remedy the wrong. The licensee cannot bring such an action in his own name in that case, any more than in another; and he cannot sue in the name of the wrongdoer, for he would thus make the latter both plaintiff and defendant. Such a state of facts constitutes such an impediment to an action at law as authorizes the licensee to sue the owner of a patent or one who purchased the patent with knowledge of the license in a court of equity.[77] And a stranger to the title who joined in the infringement, may be joined with the owner as a defendant.[78]

[74] Goodyear *v.* Bishop, 4 Blatch. 438. 1860.

[75] Brush-Swan Electric Light Co. *v.* Electric Co., 48 F. R. 224, 1891; Brush Electric Co. *v.* Electric Co. of San José, 49 F. R. 73, 1892; Brush Electric Co. *v.* California Electric Co., 52 F. R. 945, 1892; Excelsior Wooden-Pipe Co. *v.* Allen, 104 F. R. 553, 1900; Chisholm *v.* Johnson, 106 F. R. 212, 1901; Excelsior Wooden-Pipe Co. *v.* City of Seattle, 117 F. R. 140, 1902; Hurd *v.* James Goold Co., 203 F. R. 998, 1913.

[76] Hurd *v.* James Goold Co., 203 F. R. 998, 1913.

[77] Littlefield *v.* Perry, 21 Wall. 223, 1874; Root *v.* Railway Co., 105 U. S. 216, 1881; Rapp *v.* Kelling, 41 F. R. 792, 1890; Adriance *v.* McCormick Mach. Co., 55 F. R. 290, 1893; 56 F. R. 918, 1893; Smith *v.* Ridgely, 103 F. R. 876, 1900; New York Phonograph Co. *v.* National Phonograph Co., 144 F. R. 404, 1906.

[78] Waterman *v.* Shipman, 55 F. R. 986, 1893.

Where an exclusive licensee, who pays royalties in proportion to the extent of his use or his sales of the patented invention, allows infringers to use or to sell that invention without interference from him, the owner of the patent right may sue those infringers in his own name and for his own use.[79]

§ 401. The defendant in an action for an infringement of a patent may be a natural person, or a partnership. A private corporation may also be held liable as defendant in such an action.[80] And a receiver, appointed by a State court for an infringing corporation, may be sued for its infringement or for his own infringement as receiver, without the consent of the State court which appointed him.[81] And so with trustees in bankruptcy and assignees for the benefit of creditors.[82] Among public corporations, the liability of a city for infringing a patent has been affirmed,[83] and that of a county has sometimes been affirmed and sometimes denied.[84] It follows of course that an individual cannot escape liability for infringement by showing that the infringing articles were supplied under contract to a city even though the infringing articles were

[79] Still *v.* Reading, 20 O. G. 1026, 1881.

[80] York & Maryland Line Railroad Co. *v.* Winans, 17 Howard, 30, 1854.

[81] Hupfeld *v.* Automaton Piano Co., 66 F. R. 789, 1895; Union Switch & Signal Co. *v.* Philadelphia & Reading Railroad Co., 69 F. R. 833, 1895.

[82] United Wireless Telegraph Co. *v.* National Electric Signalling Co., 198 F. R. 385, 1912; American Graphophone Co. *v.* Pickard, 201 F. R. 546, 1912.

[83] Bliss *v.* Brooklyn, 4 Fisher, 596, 1871; Asbestine Mfg. Co. *v.* Hepp, 39 F. R. 326, 1889; City of Akron *v.* Bone, 221 F. R. 944, 1915.

[84] Jacobs *v.* Hamilton County, 4 Fisher, 81, 1862; May *v.* County of Mercer, 30 F. R. 246, 1887; May *v.* County of Juneau, 30 F. R. 241, 1887; May *v.* County of Logan, 30 F. R. 260, 1887; May *v.* County of Ralls, 31 F. R. 473, 1887.

specified in the call for bids.[85] If any distinction exists between a city and a county, it is founded on the fact that cities are created and exist mainly for the special use of the people who compose them; while counties are subdivisions of States, made for the purposes of political organization, and civil and judicial administration.[86] The same reasons, if valid, would indicate that organized villages are generally liable for infringements, while ordinary townships are not. The general rule on the subject would then appear to be that cities and villages are liable for infringements of patents, unless the charters or statutes which created or which regulate them, otherwise require or provide, while counties and townships are not so liable unless they are made so by the legislative power which called them into being.[87] School districts probably fall in the same category as townships in respect to this sort of liability.[88] No State can be sued for any infringement of a patent without its statutory consent.[89] And it has been held that a State officer is not responsible for any infringement of a patent which occurs in any State work conducted by him, where he did not direct the infringement to be committed, and did not know the fact of infringement till after it was done.[90]

§ 402. Natural persons cannot escape liability for their infringements of patents on the ground that they are

[85] Consolidated Contract Co. *v.* Hassan Paving Co., 227 F. R. 436, 1915.

[86] Ward *v.* County of Hartford, 12 Connecticut, 406, 1838; Commissioners of Hamilton County *v.* Mighels, 7 Ohio State, 118, 1857.

[87] May *v.* County of Buchanan, 29 F. R. 473, 1886; May *v.* County of Cass, 30 F. R. 762, 1887.

[88] Wilson *v.* School District, 32 New Hampshire, 118, 1855.

[89] Eleventh Amendment to the Constitution of the United States; Hans *v.* Louisiana, 134 U. S. 17, 1890.

[90] Standard Fireproofing Co. *v.* Toole, 122 F. R. 652, 1903.

minors or married women.[91] A minor is not less liable to an action because the act of infringement was done at the command of his father;[92] but if a married woman commits an infringement in the presence of her husband, she is not liable to an action therefor, unless it can be shown that she did it without his influence or consent.[93] In the absence of such evidence, the husband is alone liable for the torts of the wife which are committed in his presence;[94] or under his direction;[95] and for the infringements which are committed jointly by both.[96]

§ 403. An agent or salesman who sells or leases specimens of a patented thing, is liable as an infringer for so doing.[97] The foreman of a factory is liable for infringements done under his supervision.[98] And any employed person who has derived a distinct and independent benefit from infringing a patent under the direction of his employer, is himself liable to an action based on that infringement.[99] But a mechanic who, when working for wages, makes or uses a patented thing, or uses a patented process, at the command of his employer, is not liable to an action at law, on that account,[100] though he may doubtless be restrained by an injunction from continuing such making

[91] Cooley on Torts, Chapter IV.

[92] Humphreys *v.* Douglass, 10 Vermont, 71, 1838; Scott *v.* Watson, 46 Maine, 362, 1859.

[93] Bishop's Law of Married Women, Volume 2, Section 258.

[94] Bishop's Law of Married Women, Volume 1, Section 43.

[95] American Bell Telephone Co. *v.* Cushman, 57 F. R. 844, 1893.

[96] Green *v.* Austin, 22 O. G. 683, 1882.

[97] Potter *v.* Crowell, 3 Fisher, 112, 1866; Maltby *v.* Bobo, 14 Blatch. 53, 1876; Steiger *v.* Heidelberger, 4 F. R. 455, 1880; Cramer *v.* Fry, 68 F. R. 207, 1895; Graham *v.* Earl, 82 F. R. 743, 1897.

[98] Cahoone Mfg. Co. *v.* Harness Co., 45 F. R. 584, 1891.

[99] Palmer *v.* Landphere, 99 F. R. 568, 1900; and 118 F. R. 52, 1902.

[100] Delano *v.* Scott, Gilpin, 498, 1834; United Nickel Co. *v.* Worthington, 13 F. R. 392, 1882; Young *v.* Foerster, 37 F. R. 203, 1889; Graham *v.* Earl, 82 F. R. 742, 1897.

or using;[101] provided his employer is also subject to be thus restrained.[102] A decree for an account of profits would not be proper in such a case, because a mechanic cannot be said to make any profits from such an infringement. Nor would a decree for damages be any more proper in an action in equity, than would a judgment for damages in an action at law.

While it cannot be so stated as a matter of law, it has been remarked that the class of persons described in the foregoing paragraph, when sued for infringement by their former employers, are not entitled to be indulged in presumptions of fact to which they are not entitled by rule of law.[103]

§ 404. Whoever directs or requests another to infringe a patent, is himself liable to an action for the resulting infringement, on the principle that what one does by another he does by himself.[104] So, also, if an infringement is committed by A. B. for the benefit of C. D., but without the knowledge or authority of the latter, the latter will still be liable as an infringer, if he approves the tort after its commission.[105] An infringement which is committed by an employee in the regular course of his employer's business will also render the latter liable to an action, even if the employer forbade the acts which constituted the infringement,[106] or even if the em-

[101] Goodyear *v.* Mullee, 5 Blatch. 437, 1867; Regent Mfg. Co. *v.* Penn. Electrical & Mfg. Co., 121 F. R. 80, 1902.

[102] Boston Lasting-Mach. Co. *v.* Woodward, 82 F. R. 98, 1897.

[103] Brunswick Refrigerating Co. *v.* Wolf, Sayer & Heller, 222 F. R. 916, 1915; Spirella Co. *v.* Unbone Corset Co., 180 F. R. 470, 1910.

[104] Green *v.* Gardner, 22 O. G. 683, 1882; Chisholm *v.* Johnson, 106 F. R. 207, 1901.

[105] See Judson *v.* Cook, 11 Barbour (N. Y.), 642, 1852; Allred *v.* Bray, 41 Missouri, 484, 1867.

[106] See Philadelphia & Reading Railroad Co. *v.* Derby, 14 Howard, 468, 1852.

ployer did not know that such was the character of those acts.[107]

§ 405. It is a general principle of law, that whoever does an act which naturally causes another to commit a tort, is himself liable to an action therefor.[108] For example, if A. B. unlawfully makes a specimen of a patented thing, and sells it to C. D., a man whose business it is to use things of that class, there is no injustice in holding the former responsible, not only for his own illegal making and selling, but also for the illegal using committed by the latter, for that making and selling naturally resulted in that using. On the other hand, if E. F., a merchant, gives G. H., a manufacturer, an order for a quantity of articles which may be made either with or without a particular patented process or machine, and if G. H. makes those articles with that machine or process, it is clear that E. F. is not liable for that unlawful making.[109] But where the articles can be made only by infringing a patent, any merchant who causes them to be made for him is liable to an injunction restraining him from a continuation of his conduct.[110] And a person who makes plans for infringing machinery, or other subject of a patent, and obtains bids for its manufacture, and receives compensation for work in its erection, is liable as infringer of the patent on the structure thus produced.[111]

§ 406. Where several persons co-operate in any infringe-

[107] Wooster *v.* Marks, 17 Blatch. 368, 1879; McKnight *v.* McNiece, 64 F. R. 116, 1894.

[108] Guille *v.* Swan, 19 Johnson (N. Y.), 381, 1822; Brooks *v.* Ashburn, 9 Georgia, 297, 1851; Lewis *v.* Johns, 34 California, 629, 1868; Smith *v.* Felt, 50 Barbour (N. Y.), 612, 1868.

[109] Keplinger *v.* De Young, 10 Wheaton, 358, 1825; Brown *v.* District of Columbia, 3 Mackey, 502, 1884.

[110] Welsbach Light Co. *v.* Freeman, 100 F. R. 298, 1900.

[111] Risdon Iron & Locomotive Works *v.* Trent, 92 F. R. 390, 1899.

ment, all those persons are liable therefor as contributors thereto.[112] In that, as in all cases of torts for which several persons are liable, all may be sued jointly, or any of them may be sued alone.[113] But where a patentee sues one of several joint infringers collusively, for the purpose of getting a mutual advantage over another joint infringer, the court, on learning the facts, will dismiss the case.[114]

So, also, an action may be brought against several joint defendants, and sustained against such of them as the evidence shows to be liable, even though not sustained against all.[115] Separate acts of infringement of the individual defendants cannot, however, form the basis of recovery in such suit.[116] Where an action at law is sustained against several joint infringers, the judgment will be entered against all, regardless of whether the benefits of the infringement were confined to part of them, or extended to the whole; [117] though only one payment can be enforced; [118] and a decree for profits, in an action in equity, will be entered only against those of the defendants who are proved to have actually realized profits from the infringement.[119]

§ 407. Contributory infringement is intentional aid or co-operation in transactions, which collectively constitute complete infringement. For example: where a

[112] Chisholm *v.* Johnson, 106 F. R. 209, 1901.

[113] Jennings *v.* Dolan, 29 F. R. 862, 1887; Bray *v.* Denning, 56 F. R. 1019, 1893; Columbia Wire Co. *v.* Freeman Wire Co., 71 F. R. 306, 1895; Bowers Dredging Co. *v.* New York Dredging Co., 77 F. R. 983, 1896.

[114] Ring Refrigerator Co. *v.* St. Louis Ice Mfg. Co., 67 F. R. 535, 1895.

[115] Reutgen *v.* Kanowrs, 1 Washington, 172, 1804.

[116] Edison *v.* Allis-Chalmers Co., 191 F. R. 837, 1911; *contra*, Stebler *v.* Riverside Ass'n, 214 F. R. 550, 1914.

[117] Cooley on Torts, p. 136.

[118] Jennings *v.* Dolan, 29 F. R. 862, 1887.

[119] Elizabeth *v.* Pavement Co., 97 U. S. 140, 1877; Featherstone *v.* Cycle Co., 53 F. R. 110, 1892.

person furnishes one part of a patented combination, intending that it shall be assembled with the other parts thereof, and that the complete combination shall be used or sold; that person is liable to an action, as infringer of the patent on the complete combination.[120] The part furnished must, however, be an element of the combination.[121] It has been held that where the part is sent to a foreign country there to be incorporated in the remainder of the combination which had been made in the United States, the sender is not guilty of contributory infringement.[122] Where a person furnishes a machine which is useful only for the purpose of making a patented article, intending that it shall be thus used, that person is himself liable for any infringement which is afterward committed, in the manufacture of that article with that machine.[123] So also, a person is chargeable with contributory infringement of a patent on a machine, where he

[120] Wallace *v.* Holmes, 9 Blatch. 73, 1871; Schneider *v.* Pountney, 21 F. R. 403, 1884; Travers *v.* Beyer, 26 F. R. 450, 1886; Stearns *v.* Phillips, 43 F. R. 795, 1890; Thomson-Houston Electric Co. *v.* Kelsey Electric Railway Specialty Co., 72 F. R. 1016, 1896; and 75 F. R. 1005, 1896; American Graphophone Co. *v.* Amet, 74 F. R. 791, 1896; Thomson-Houston Co. *v.* Ohio Brass Co., 80 F. R. 721, 1897; Red Jacket Mfg. Co. *v.* Davis, 82 F. R. 432, 1897; American Graphophone Co. *v.* Leeds, 87 F. R. 874, 1898; Wilkins Shoe-Button Fastener Co. *v.* Webb, 89 F. R. 996, 1898; Canda *v.* Michigan Malleable Iron Co., 124 F. R. 486, 1903; Standard Computing Scale Co. *v.* Computing Scale Co., 126 F. R. 639, 1903; Heekin Co. *v.* Baker, 138 F. R. 63, 1905; Rumford Chemical Works *v.* Hygiene Chemical Co., 159 F. R. 436, 1908; General Electric Co. *v.* Sutter, 186 F. R. 637, 1911; New York Scaffolding Co. *v.* Whitney, 224 F. R. 452, 1915; Safety Car Heating, etc., Co. *v.* Gould Coupler Co., 229 F. R. 429, 1916.

[121] National Malleable Castings Co. *v.* T. H. Symington Co., 230 F. R. 821, 1916.

[122] Bullock Electric, etc., Co. *v.* Westinghouse, etc., Co., 129 F. R. 105, 1904.

[123] American Graphophone Co. *v.* Hawthorne, 92 F. R. 516, 1899.

furnishes articles for that machine to operate upon, intending that the machine shall be used by operating on those articles.[124] Furthermore, where a person furnishes a machine, composition of matter or other article, which is particularly adapted to be used in performing a patented process, and which the person furnishing the same, intends shall be thus used, that person is liable as a contributory infringer, for any infringement which afterward occurs in accordance with his intention.[125] But where the machine or other property thus furnished, is useful for some other purpose than to be a part of a patented combination, or to make a patented article, or to be operated upon by a patented machine, or to be used in performing a patented process, and where he who furnishes the property, does not intend or know, when furnishing the same, that it is to be thus used, he incurs no liability to an action for infringement.[126] But if he knew or intended that the property furnished by him was to be used in either of the infringing ways, he cannot defeat an action for infringement, by showing that the furnished property could have been used in some non-infringing

[124] Heaton-Peninsular Button-Fastener Co. *v.* Eureka Specialty Co., 77 F. R. 288, 1896; Tubular Rivet & Stud Co. *v.* O'Brien, 93 F. R. 200, 1898.

[125] Rumford Chemical Works *v.* Hecker, 2 Bann. & Ard. 363, 1876; Willis *v.* McCullen, 29 F. R. 641, 1886; Alabastine Co. *v.* Payne, 27 F. R. 560, 1886; Celluloid Mfg. Co. *v.* Zylonite Co., 30 F. R. 437, 1887; Boyd *v.* Cherry, 50 F. R. 282, 1883; New York Filter Co. *v.* Jackson, 91 F. R. 425, 1898; German-American Filter Co. *v.* Loew Filter Co., 103 F. R. 303, 1900; John R. Williams Co. *v.* Miller, DuBrul & Peters Co., 107 F. R. 290, 1901; Loew Filter Co. *v.* German-American Filter Co., 107 F. R. 949, 1901.

[126] Maynard *v.* Pawling, 5 Bann. & Ard. 551, 1880; Millner *v.* Schofield, 4 Hughes, 261, 1881; Snyder *v.* Bunnell, 29 F. R. 47, 1886; Geis *v.* Kimber, 36 F. R. 109, 1888; Edison Electric Light Co. *v.* Peninsular Light, Power & Heat Co., 95 F. R. 673, 1899.

way.[127] In the absence of specific proof of knowledge or intent, the fact that the property furnished could be used with an article or machine which in itself could not be an infringement and that there are many such articles or machines in use is sufficient to absolve one who supplies such property from the charge of infringement.[128] Also if the invention consists merely of a new arrangement of old parts, one who sells the old parts is not chargeable with infringement unless they were sold with the knowledge that they were intended to be used in making up the combination.[129]

The rules regulating the rights of substitution or "re-supply" of an element of a patented combination when the element is of such a nature that it must be renewed or replaced from time to time and is something upon which the remaining elements operate, has received thorough consideration by the Supreme Court in the case of Leeds & Catlin *v.* Victor Talking Machine Co.[129a] In the opinion, Mr. Justice McKenna said that the rule of Wilson *v.* Simpson,[129b] permitted "the re-supply of the effective ultimate tool of the invention which is liable to be often worn out or to become inoperative for its intended effect, which the inventor contemplated would have to be frequently replaced anew, during the time that the machine as a whole might last." The parts which the defendant claimed to be entitled to supply in the Leeds & Catlin case were ordinary unpatented disc phonograph records,

[127] Saxe *v.* Hammond, 1 Holmes, 456, 1875; Bowker *v.* Dows, 3 Bann. & Ard. 518, 1878; Imperial Chemical Mfg. Co. *v.* Stein, 69 F. R. 617, 1895.

[128] Sheridan-Clayton Paper Co. *v.* United States Envelope Co., 232 F. R. 153, 1916.

[129] Johnson *v.* Foos Mfg. Co., 141 F. R. 73, 1905.

[129a] Leeds & Catlin *v.* Victor Talking Machine Co., 213 U. S. 325, 1909.

[129b] Wilson *v.* Simpson, 9 How. 109, 1849.

which, however, constitute an element of the patented machine as a whole. In respect to these the court said: "But there is no pretense in the case at bar of mending broken or worn-out records or of repairing or replacing the 'operative ultimate tool of the invention' which has deteriorated by use. The sales of petitioner as found by the courts below and as established by the evidence, were not to furnish new records identical with those originally offered by the Victor Co., but, to use the language of Judge LACOMBE in the Circuit Court, 'more frequently to increase the repertoire of tunes than as substituted for certain worn-out records.'

"The right of substitution or 're-supply' of an element depends upon the same test. The license granted to a purchaser of a patented invention is to preserve its fitness for use so far as it may be affected by wear or breakage. Beyond this there is no license." The true test seems to be whether or not the element supplied is consumed in the ordinary use of the machine.[129c]

Persons who contribute money for the purpose of supporting others in infringing a patent, are also liable as infringers.[130] Where an infringer makes a voluntary assignment for the benefit of creditors, and the assignee continues the infringement, both may be sued jointly for the infringement committed before, and also that committed after the assignment.[131] And a corporation and its receiver may be joined as defendants, for infringements begun by the company and continued by the receiver.[132]

Where the owner of a patent on something which in-

[129c] Williams *v.* Barnes, 234 F. R. 339, 1916.

[130] Bate Refrigerating Co. *v.* Gillett, 30 F. R. 684, 1887.

[131] Gordon *v.* Harvester Works, 23 F. R. 147, 1885.

[132] Union Switch & Signal Co. *v.* Philadelphia & Reading Railroad Co., 69 F. R. 834, 1895.

fringes an older patent, licenses another to use his device, and furnishes to his licensee, plans and drawings for making his device, and requiring, to that end, the making of the device of the prior patent, without procuring or intending to procure the consent of its owner, that licensor is a joint infringer with his licensee of the prior patent.[133] Where one man owns and others operate an infringing machine, all are jointly liable to an action therefor.[134] And where one who has contracted to erect a building, lets a portion of the work to a subcontractor, and in the prosecution of their respective parts, each of them infringes a patent of another, both of them are liable as joint infringers.[135]

Where one of several joint infringers is sued for their infringement, the other one or ones may be admitted as joint defendant or defendants to help defend the suit.[136] The bill, however, in such cases should declare only on the joint infringement and not on individual infringements of the respective defendants, for in the latter case it will be demurrable for multifariousness.[137]

And while the maker, the seller and the user of a patented machine, manufacture, or other article, are not joint infringers of the patent thereon,[138] the maker will be bound by an injunction obtained in the suit against the dealer which the former has openly and avowedly supported even though he was not a party to the record.[139]

[133] Toppan *v.* Tiffany Car Co., 39 F. R. 420, 1889.

[134] Woodworth *v.* Edwards, 3 Woodbury & Minot, 121, 1847.

[135] Jackson *v.* Nagle, 47 F. R. 703, 1891.

[136] Curran *v.* Car Co., 32 F. R. 835, 1887; Standard Oil Co. *v.* Southern Pacific Co., 54 F. R. 521, 1893; Ring Refrigerator Co. *v.* St. Louis Ice Mfg. Co., 67 F. R. 540, 1895.

[137] Jewell *v.* City of Philadelphia, 186 F. R. 639, 1911.

[138] Consolidated Car Heating Co. *v.* American Electric Heating Corp., 82 F. R. 998, 1897.

[139] Eagle Mfg. Co. *v.* Miller, 41

The maker may, however, be admitted by the court to defend as a party to the record a suit against the seller, or a suit against the user, and the seller may be admitted in the same way to defend the user, when the user is sued for using the article sold to him.[140] And it follows that if pending the suit the plaintiff does anything that would terminate it, as, for instance, purchases all the business and good-will of the defendant's business, the manufacturer who has already intervened may dismiss the suit or else assume the defence, in which latter event the suit would be tried on its merits notwithstanding the absence of the original defendant.[141]

Although the maker has openly and avowedly taken care of the defence of the suit he may not on application of the plaintiff be made a party to the record, whether or not he could originally have been sued in the district of suit.[142] But where pending suit a defendant corporation transfers all its assets and good-will to another corporation the transferee may be brought into the suit by supplemental bill and subjected to the injunction order and accounting,[143] at least if the latter had openly and avowedly defended the original suit.[144] Such a trans-

F. R. 351, 1890; Dicks Press Guard Mfg. Co. *v.* Bowen, 229 F. R. 193, 1916.

See Section 696.

[140] Consolidated Rubber Tire Co. *v.* Finley Rubber Tire Co., 119 F. R. 705, 1902; United States Expansion Bolt Co. *v.* H. G. Kroucke Hardware Co., 216 F. R. 186, 1914.

[141] Irving-Pitt Mfg. Co. *v.* Twinlock Co., 220 F. R. 325, 1914.

[142] Bidwell *v.* Toledo Consolidated, etc., Ry., 72 F. R. 10, 1896; Parsons Non-Skid Co. *v.* E. J. Willis, 176 F. R. 176, 1909; but see Dicks Press Guard Mfg. Co. *v.* Bowen, 229 F. R. 193, 1916, and Western Tel. Mfg. Co. *v.* American Electric Telephone Co., 137 F. R. 603, 1905.

[143] Young *v.* Herman, 232 F. R. 361, 1916; Western Tel. Mfg. Co. *v.* Am. Electric Co., 141 F. R. 998, 1905.

See Section 625.

[144] Western Telephone Mfg.

feree is not, however, bound by the findings of law or fact on which a decree fixing profits against the transferor was based, as the respective liabilities are separable and relate only to the respective periods of ownership.[145]

§ 408. A partnership is liable to an action for an infringement committed in the regular course of the partnership business, by one or more of the partners, or under his or their orders; and also for any infringement committed outside of that regular course of business, if it was previously authorized or afterward adopted as the act of the partnership by all the partners. But no partnership is liable for any infringement committed outside of the regular course of the partnership business, unless it was so authorized or adopted.[146] A person who is employed as manager of a partnership, and in that capacity infringes a patent, is a joint infringer with the partners.[147]

Likewise is the case with a joint-stock association. Each member may be held as an infringer for acts of infringement committed by the association.[148]

§ 409. Private corporations are responsible for infringement, committed, authorized, or ratified by them, under substantially the same rules as those which govern the similar responsibility of natural persons. It was formerly supposed that corporations could not be held liable for torts, because torts are never authorized by corporate charters, and are therefore *ultra vires*. But this idea was soon found to produce gross injustice in its practical operation; and was therefore abandoned by the courts.[149]

Co. *v.* American Electric Telephone Co., 137 F. R. 603, 1905.

[145] Young *v.* Herman, 232 F. R. 361, 1916.

[146] See Story on Partnership, Sections 166 and 168.

[147] Featherstone *v.* Cycle Co., 53 F. R. 110, 1892; Trent *v.* Risdon Iron & Locomotive Works, 102 F. R. 635, 1900.

[148] National Casket Co. *v.* Stolts, 135 F. R. 534, 1905.

[149] Baltimore & Potomac Railroad Co. *v.* Fifth Baptist Church,

The law is, that every private corporation is liable for all the torts which were authorized by that corporation, and for all torts done in pursuance of any authority to act on its behalf, on the subject to which the torts relate, and for all torts ratified by the corporation after they are committed.[150] And in deciding upon this liability, the courts consider corporate officers, agents, and servants as possessing a large discretion, and they accordingly hold the corporation liable for all their acts within the most extensive range of the corporate powers.[151] The agent of a corporation in committing an infringement may be another corporation; and the relation of agency exists and binds the principal, where the agent infringes a patent in authorized pursuance of the business which the principal was chartered to transact.[152] And a corporation organized for the purpose of conducting a particular business, alleged to infringe a particular patent, may be sued on that patent, without waiting for the infringement to begin.[153] Unless their charters otherwise provide, public corporations which are liable at all for infringements of patents, are doubtless liable under the same circumstances and to the same extent as private corporations are.[154]

§ 410. Under what circumstances and to what extent an officer, director, or stockholder of a corporation is personally liable for infringements committed by it, is a compound question, the analysis of which is complicated. There are three kinds of liability for infringements of patents. These are, liability to an injunction; liability

108 U. S. 330, 1882; Salt Lake City *v.* Hollister, 118 U. S. 256, 1886.

[150] May *v.* County of Mercer, 30 F. R. 248, 1887.

[151] See Cooley on Torts, p. 119.

[152] York & Maryland Line Railroad Co. *v.* Winans, 17 Howard, 38, 1854.

[153] National Mechanical Directory Co. *v.* Polk, 121 F. R. 746, 1903.

[154] May *v.* County of Mercer, 30 F. R. 248, 1887.

to a recovery of infringer's profits; and liability to a recovery of patentee's damages.

The liability to an injunction can be enforced against every person connected with a corporation, without making any person a defendant to the action in equity which seeks to enforce that liability; because a decree for an injunction against a corporation, can properly be made to equally restrain all the officers, directors and stockholders of that corporation from doing whatever the decree forbids the corporation to do.[155] And the injunction will extend to them even though they enter the employ of another who was not a party to the suit.[156] Therefore, a patentee can have no motive to sue such officer, director or stockholder, for an injunction; except to impose on him the burden of the expenses and costs of patent litigation. That motive is not one which is apt to move a court of equity into action, and therefore many such courts have dismissed such representatives of corporations from suits, which sought to make them defendants to prayers for injunctions.[157]

[155] Howard *v.* St. Paul Plow-Works, 35 F. R. 747, 1888; Boston Woven Hose Co. *v.* Star Rubber Co., 40 F. R. 167, 1889; Mergenthaler Linotype Co. *v.* Ridder, 65 F. R. 853, 1895; Donaldson *v.* Roksament Stone Co., 176 F. R. 386, 1910.

[156] Campbell *v.* Magnet Light Co., 175 F. R. 117, 1909; but see E. W. Bliss Co. *v.* Atlantic Handle Co., 212 F. R. 190, 1913.

[157] Howard *v.* St. Paul Plow-Works, 35 F. R. 744, 1888; Boston Woven Hose Co. *v.* Starr Rubber Co., 40 F. R. 167, 1889; Mergenthaler Linotype Co. *v.* Ridder, 65 F. R. 854, 1895; Consolidated Brake-Shoe Co. *v.* Chicago, P. & St. L. Ry. Co., 69 F. R. 412, 1895; Bowers *v.* Atlantic Gulf & Pacific Co., 104 F. R. 888, 1900; Loomis-Manning Filter Co. *v.* Manhattan Filter Co., 117 F. R. 325, 1902; Farmers' Mfg. Co. *v.* Spruks Mfg. Co., 119 F. R. 594, 1902; Greene *v.* Buckley, 120 F. R. 955, 1902; Hutter *v.* DeQ. Bottle Stopper Co., 128 F. R. 283, 1904 (collates authorities); Glucose Sugar Refining Co. *v.* St. Louis Syrup Co., 135 F. R. 540, 1905; Cazier *v.*

This doctrine, however, does not go to the extent of protecting an individual who is using the corporation merely as a shield to protect him in his infringement, and in such cases he may be sued without joining the corporation.[158] On the same principle an officer of a corporation may not resign his office pending a suit against the corporation for infringement and then continue the manufacture of the article in controversy, as he is bound by the decree and is punishable for violation of the injunction.[159] Likewise in the case of one who with knowledge that others have been enjoined, takes over their business and continues it to their profit, whether he was actually employed by them or not.[160]

It has even been held that a corporation which owns the majority of the stock of a subsidiary corporation and utilizes the latter as one of its manufacturing departments is directly liable to an owner of a patent where the patent has been infringed by the subsidiary corporation in the course of the business of the main corporation.[161]

No person is liable to a recovery of infringer's profits, except such profits as were made by himself; though the profits made by a joint infringer with him, may have been

Mackie-Lovejoy Mfg. Co., 138 F. R. 654, 1905.

Contra, in cases in which the officer is personally active in carrying on the infringement: Simplex Electric Heating Co. *v.* Leonard, 147 F. R. 744, 1906; Whiting Safety Catch Co. *v.* Western Wheeled Scraper Co., 148 F. R. 396, 1905; Weston Electrical Inst. Co. *v.* Empire Electrical Inst. Co. (discussing authorities), 166 F. R. 867, 1909.

[158] Calculagraph Co. *v.* Wilson, 132 F. R. 20, 1904; Crown Cork & Seal Co. *v.* Brooklyn Bottle Stopper Co., 190 F. R. 323, 1911.

[159] Janney *v.* Pancoast, etc., Co., 124 F. R. 972, 1903.

[160] Diamond Drill & Mach. Co. *v.* Kelley Bros., 132 F. R. 978, 1904.

See Sections 108, 109.

[161] Westinghouse Electric & Mfg. Co. *v.* Allis-Chalmers Co., 176 F. R. 362, 1910.

much larger than any made by him.[162] Where a person has no connection with a corporation, except as an officer, director or stockholder, he makes no profit from any infringement committed by that corporation; except such as he may receive in dividends or in salary. As long as a corporation is solvent enough to pay over to a patentee, all the profits which it made from its infringement of the patent of that patentee, there is no good reason for a court of equity to go further in search of money for that purpose. There is, therefore, no good reason for such a court taking jurisdiction of any officer, director, or stockholder of the corporation, with a view of tracing into his hands, the money needed to satisfy the patentee's claim for infringer's profits. It follows that an officer, director, or stockholder in a corporation is not liable to a recovery of infringer's profits, on account of any infringement committed by the corporation; except where the corporation is so insolvent as to be unable to itself respond to an execution for the amount of those profits.[162a] And even in that exceptional case, no person is liable to a recovery of infringer's profits, out of money received by him, as a fair compensation for services rendered to the corporation. But in the exceptional case, dividends can be reached in the hands of stockholders, and subjected to the payment of the infringer's profits; because a court of equity will pursue the money of a corporation into whosesoever possession it may be transferred, when that pursuit is neces-

[162] Elizabeth *v.* Pavement Co., 97 U. S. 140, 1877.

[162a] Boston Woven Hose Co. *v.* Star Rubber Co., 40 F. R. 167, 1889; Mergenthaler Linotype Co. *v.* Ridder, 65 F. R. 854, 1895; Western Electric Co. *v.* Home Telephone Co., 85 F. R. 661, 1898; Bowers *v.* Atlantic, Gulf & Pacific Co., 104 F. R. 888, 1900; Loomis-Manning Filter Co. *v.* Manhattan Filter Co., 117 F. R. 325, 1902; Greene *v.* Buckley, 120 F. R. 955, 1902; Panzl *v.* Battle Island Paper, etc., Co., 132 F. R. 607, 1904.

sary to reach means for paying the corporate obligations.[163]

§ 410*a*. The liability to a recovery of patentee's damages, depends upon different reasons from those which negative or condition the liability to a recovery of infringer's profits; where those damages or those profits are sought to be recovered from an officer, director, or stockholder of an infringing corporation. Judge JOHN LOWELL, in 1882, held that an action at law cannot be maintained against the officers, directors, or shareholders of a corporation which infringes a patent, even where such persons personally conducted the business which constituted the infringement.[164] But that decision was expressly overruled, in respect of the liability of directors, in 1899, by Judge FRANCIS C. LOWELL, when writing the opinion of the majority of the Circuit Court of Appeals for the first circuit.[165] Still, one of the three judges who heard that case, dissented from the decision of the majority; and the case did not deal with the liability of officers or stockholders. The compound question of the liability of officers, directors, and stockholders in such cases is important. Upon it may sometimes depend the just reward of a meritorious inventor, and the just retribution of a willful infringer. A full explanation of the subject, is therefore presented, in the next five sections of this book.

§ 411. Wrongs are divisible, in one aspect, into two classes: wrongs of commission and wrongs of omission. Where an officer, director, or stockholder of a corporation

[163] Mumma *v.* Potomac Co., 8 Peters, 286, 1834; Curran *v.* Arkansas, 15 Howard, 311, 1853; Railroad Co. *v.* Howard, 7 Wallace, 409, 1868; Weston Electrical Inst. Co. *v.* Empire Electrical Inst. Co., 166 F. R. 867, 1909.

[164] United Nickel Co. *v.* Worthington, 13 F. R. 393, 1882.

[165] National Cash Register Co. *v.* Leland, 94 F. R. 514, 1899.

is engaged in managing its business, and as a part of that business manages and directs the infringement of a patent, that person is chargeable with a wrong of commission. Where such a person has power to prevent his corporation from infringing a patent, and omits to exercise that power, and where the corporation therefore infringes that patent, then that person is chargeable with a wrong of omission. Where a person is an officer, director, or stockholder of a corporation, but has no personal power to cause it to infringe a particular patent, nor to restrain it from so doing, that person is chargeable with no wrong of either sort.

§ 412. Stockholders seldom have any power, merely as stockholders, to control the action of their corporation in such a matter of detail as the infringement of a particular patent. Unless it can be shown that the stockholder whom it is sought to hold liable in a particular case, did possess power of that kind, it is clear that the common law will not compel him to respond in damages for any infringement with which he was not personally connected. If the law were otherwise, a man could lawfully be made to suffer for wrongs which he did not commit, and could not prevent, and from which he received no advantage. Indeed, it is the general rule of the common law that mere stockholders in a corporation are not liable for its debts,[166] and if not liable for its debts, they surely ought not to be liable for its torts.

§ 413. The officers of a corporation are the persons who are charged with the superintendence and control of its transactions. It is doubtless their duty to refrain from directing infringements to be committed; and also to prevent the agents and servants of their corporations from committing infringements of patents when prosecuting the corporate business. If such an officer directs and causes

[166] Shaw *v.* Boylan, 16 Indiana, 386, 1861.

a specific thing to be done, which turns out to constitute an infringement, it is doubtless difficult to see why he should be permitted to shift all the responsibility for the tort upon the intangible corporation, that is to say, upon the innocent stockholders as a body.

If an agent or a servant of a corporation commits an infringement in the course of the corporate business, the officers whose function it is to control that agent or that servant are chargeable with a wrong of omission. They are guilty of *non-feasance* in the performance of their official duties. If their omission to prevent the infringement is the result of gross inattention on their part, they are liable to the corporation for any loss it may incur on account of the infringement; but it is otherwise if the omission resulted from an error of judgment.[167] Whether such an officer is liable at common law to the owners of the patent infringed, seems to depend upon other considerations.

If an officer, in pursuance of his general authority, directs a servant of a corporation to make a machine for a particular purpose, which machine may be made so as to infringe a patent, or may be made so as not to have that effect, it seems that the officer is bound to see that it is not made so as to infringe, and that if the servant makes it in that way, the officer is liable to the patentee.[168] But if a servant of a corporation, without any special orders to do so, makes or uses or sells a thing which turns out to be an infringement of a patent, it seems that no superior officer is personally liable therefor at common law.[169] It appears reasonable that officers of corporations should

[167] Spering's Appeal, 71 Pennsylvania State, 11, 1872.

[168] See Hewett *v.* Swift, 3 Allen (Mass.), 425, 1862.

[169] See Bath *v.* Caton, 37 Michigan, 202, 1877.

be bound to see that whatever they cause to be done is done lawfully; but it would perhaps not be ordinarily right to make them personally responsible to strangers for acts spontaneously committed by their subordinates.

§ 414. Directors of corporations, unlike other officers, act only in a collective capacity. Where an entire board of directors unanimously order a particular thing to be done which will constitute an infringement of a patent, and where that thing is accordingly done by the corporation's agents or servants, there seems to be no reason why those directors should not be held personally liable to an action for that infringement. If the corporation is alone liable in such a case, then crafty and dishonest men may often manage to divide the spoils of infringement, and leave nothing but an insolvent or dormant corporation to be sued by the patentee. It would evidently be a reproach to our laws if such a scheme could be made to work. Whoever attempts to defend the legal safety of such a mode of reaping the harvest of another, should have his attention called to the following sentence, written by Justice CAMPBELL, and approved by the Supreme Court, and worthy to be quoted in every law-book, and remembered by every man: "It is certainly true that the law will strip a corporation or individual of every disguise, and enforce a responsibility according to the very right, in despite of their artifices." [170]

Where the action of a board of directors in ordering an infringement, results from the votes of a majority only, the relations of the minority voters to the resulting infringement must be different from that of the others. The members of the minority ought not, in such a case, to be held liable for the action of the board, or for its results,

[170] York & Maryland Line Railroad Co. *v.* Winans, 17 Howard, 40, 1854.

unless they afterward adopt it by ratification. Where an infringement is ordered by a quorum of a board of directors, in the absence of the residue, the residue will be free from common-law liability for the wrong, unless they afterward ratify it, or unless they are chargeable with such gross non-attendance upon the meetings of the board as justly causes them to be held responsible for whatever is done by their colleagues in their absence. The mere fact of being a director in a corporation is not sufficient to render a person liable at common law for any tort committed by that corporation or its managers or agents.[171]

§ 415. But there is a statutory liability in such cases as those which we are considering. Most of the States have statutes which provide that, under various circumstances therein specified, the officers, directors, or stockholders of a corporation shall be personally liable for its debts or liabilities. Section 721 of the Revised Statutes of the United States provides that: "The laws of the several States, except where the Constitution, treaties, or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law, in cases where they apply." Under this section of the Revised Statutes, these laws of the States will probably have the same effect in a patent suit in a United States court, that they would have in any action of trespass on the case in a State court.[172] Such of the

[171] Arthur *v.* Griswold, 55 New York, 406, 1874.

[172] McCluny *v.* Silliman, 3 Peters, 270, 1830; McNeil *v.* Holbrook, 12 Peters, 84, 1838; Vance *v.* Campbell, 1 Black, 427, 1861; Hausknecht *v.* Claypool, 1 Black, 431, 1861; Wright *v.* Bales, 2 Black, 535, 1862; Leffingwell *v.* Warren, 2 Black, 599, 1862; Hanger *v.* Abbott, 6 Wallace, 537, 1867; Campbell *v.* Haverhill, 155 U. S. 614, 1895; Parker *v.* Hall, 2 Fisher, 62, 1857; Parker *v.* Hawk, 2 Fisher, 58, 1857; Rich *v.* Ricketts, 7 Blatch. 230, 1870; Hayden

State statutes referred to as make stockholders, officers, or directors responsible for the "liabilities" of their corporations are clearly broad enough to cover liabilities arising out of infringement of patents. Indeed Justice STORY decided that such liabilities were covered by the word "debts" in such a statute.[173] In most of the States the statutory, individual liability of officers, directors, and stockholders of corporations is more limited than it was in Massachusetts when Justice STORY made that decision. It is outside the scope of this text-book to set forth the details of the State statutes which bear upon the point. It will frequently happen that the controlling legislative edicts, which relate to the matter, will be found in the special charters of particular corporations, rather than in the general statutes of the several States. The general principle which runs through all such laws seems to be that where a corporation is so managed that it cannot be made to respond to lawful claims based on its contracts or torts, those officers or directors who caused that inability, or those officers, directors, or stockholders who profited thereby, shall be made to respond in its place.

§ 416. A consolidated corporation is liable to actions in equity for infringements committed before the consolidation, by each of its constituents, if the property and franchises which the consolidated corporation acquired from that constituent were of sufficient value, over and above all paramount claims, to equal the profits or damages sought to be recovered in such actions.[174] This proposition results from the fact that equity regards

v. Oriental Mills, 15 F. R. 605, 1883.

[173] Carver *v.* Mfg. Co., 2 Story, 448, 1843.

[174] Sayles *v.* The Lake Shore & Michigan Southern Railway Co., Manuscript, 1878.

the property of a corporation as held in trust for the payment of its debts, and recognizes the right of creditors to pursue that property into whosesoever possession it may be transferred, unless it has passed into the hands of a *bona fide* purchaser.[175]

The liability of consolidated corporations to actions at law, for infringements committed by their constituent corporations, before the consolidation, is a matter which does not rest on common-law principles, so much as upon the statutes of the States wherein those consolidated corporations came into being, or upon the private Acts which authorized the consolidations, or upon the charters of the constituent or of the consolidated companies. Whenever occasion arises to hold a consolidated corporation liable to an action at law for such a cause, a proper authority for so doing can probably always be found in one or another of these sources.

§ 417. A plurality of patents may be sued upon in one action, where the inventions covered by those patents are embodied in one infringing process, machine, manufacture, or composition of matter; [176] but not otherwise.[177]

[175] Mumma *v.* Potomac Co., 8 Peters, 286, 1834; Curran *v.* Arkansas, 15 Howard, 311, 1853; Railroad Co. *v.* Howard, 7 Wallace, 409, 1868.

[176] Seymour *v.* Osborne, 11 Wallace, 516, 1870; Bates *v.* Coe, 98 U. S. 48, 1878; Nourse *v.* Allen, 3 Fisher, 63, 1859; Gillespie *v.* Cummings, 3 Sawyer, 259, 1874; Horman Patent Mfg. Co. *v.* Railroad Co., 15 Blatch. 444, 1879; Gamewell Fire-Alarm Telegraph Co. *v.* Chillicothe, 7 F. R. 351, 1881;

[177] Nellis *v.* McLanahan, 6 Fisher, 286, 1873; Hayes *v.* Dayton, 8 F. R. 702, 1880; Barney *v.* Peck, 16 F. R. 413, 1883; Hayes *v.* Bickelhoupt, 23 F. R. 184, 1885; Huber *v.* Sanitary Depot, 34 F. R. 752, 1888; Union Switch & Signal Co. *v.* Philadelphia & Reading Railroad Co., 68 F. R. 913, 1895; Louden Mach. Co. *v.* Montgomery Ward & Co., 96 F. R. 232, 1899; Russell *v.* Winchester Arms Co., 97 F. R. 634, 1899.

The devices of the various patents sued upon may even be distinct, but if by using them all in a single structure they contribute to a common purpose they may be joined in one bill.[178]

This principle goes to the extent of permitting a patent for a machine to be joined with a patent for the product of the machine, when the alleged infringement consists of the product.[179]

An apparent exception to the general rule prohibiting the joining in one suit of causes of action on a plurality of unrelated patents exists when the defendant has taken a license under a number of patents and has expressly agreed not to infringe any of them, in which event, instead of bringing a number of separate actions at law, a single suit may be brought in equity to enforce the provisions of the agreement as to all the patents.[180]

But any action based on alleged infringement, in one process or thing, of a plurality of patents, may be sustained by evidence that one of those patents was so infringed, though the others were not; [181] and an action brought for

Nellis *v.* Mfg. Co., 13 F. R. 451, 1882; Lilliendahl *v.* Detweller, 18 F. R. 177, 1883; Consolidated Electric Light Co. *v.* Electric Light Co., 20 F. R. 502, 1884; Griffith *v.* Segar, 29 F. R. 707, 1887; Diamond Match Co. *v.* Ohio Match Co., 80 F. R. 117, 1897; Wilkins Shoe-Button Fastener Co. *v.* Webb, 89 F. R. 992, 1898; Continental Gin Co. *v.* F. H. Lummus Sons' Co., 110 F. R. 390, 1901; Edison Phonograph Co. *v.* Victor Talking Mach. Co., 120 F. R. 305, 1903; Electric Goods Mfg. Co. *v.* Benjamin Electric Mfg. Co., 169 F. R. 832, 1909; Robinson *v.* Chicago Rys. Co., 174 F. R. 40, 1909; Luten *v.* Dover Construction Co., 189 F. R. 405, 1911.

[178] Rose Mfg. Co. *v.* E. A. Whitehouse Mfg. Co., 193 F. R. 69, 1911.

[179] Adrian Wire Fence Co. *v.* Jackson Fence Co., 190 F. R. 195, 1911.

[180] Reece Folding Machine Co. *v.* Earl & Wilson, 205 F. R. 539, 1913.

[181] Matthews *v.* Mfg. Co., 18 Blatch. 86, 1880; Green *v.* City of

alleged unlawful making, using, and selling may be sustained by evidence of either of those three sorts of infringement.[182] So also, an action may be based on infringement committed during the first term, and on infringement committed during an extended term, of any patent, and may be sustained on proof of either or both of those infringements. And several actions may be based on several infringements of the same patent, committed at different times by the same infringer.[183] It has also been held that one action will lie for an infringement of a patent and an infringement of a trade-mark, where the trade-mark and the patent were both infringed together,[184] and also that a bill will lie for both infringement of patent and unfair competition by the infringement, and furthermore that the Federal court has jurisdiction of the cause of action for unfair competition even though the parties are citizens of the same State, if the acts of infringement constitute the acts of unfair competition.[185]

A bill by the equitable owner of a patent against the holder of the legal title, to compel a transfer of the patent and for infringement of the same patent is not multifarious.[186]

Lyon, 81 F. R. 387, 1897; Chisholm *v.* Johnson, 106 F. R. 211, 1901.

[182] Locomotive Truck Co. *v.* Railway Co., 10 Blatch. 293, 1872.

[183] Roemer *v.* Neumann, 23 F. R. 447, 1885.

[184] Jaros Underwear Co. *v.* Fleece Underwear Co., 60 F. R. 622, 1894.

[185] T. B. Woods Sons' Co. *v.* Valley Iron Works, 166 F. R. 770, 1909; Onondaga Indian Wigwam Co. *v.* Ka-noo-no Indian Mfg. Co., 182 F. R. 832, 1910.

[186] Prest-O-Lite Co. *v.* Avery Portable Lighting Co., 164 F. R. 60, 1908.

CHAPTER XVIII

ACTIONS AT LAW

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§ 421. One section of the Revised Statutes provides that "Damages for the infringement of any patent may be recovered by action on the case."[1] Another section pro-

[1] Revised Statutes, Section 4919.

vides that "The practice, pleadings, and forms and modes of proceeding in civil causes, other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the courts of record of the State, within which such circuit or district courts are held, any rule of court to the contrary notwithstanding."[2] Both these apparently inconsistent provisions are contained in the same enactment. They must therefore be construed together; and effect must be given to both. This result is reached by following Section 4919 as far as it necessarily goes, and by conforming in other respects to Section 914.[3] With this view, it has been held that the complaints and petitions which are prescribed for civil actions by the codes of sundry of the States, may be used in bringing actions on the case for infringements of patents in Federal courts sitting in those States, respectively;[4] and indeed, in one case, it has been held that the forms of pleading and procedure in such an action in a Federal court should be the same as those employed in civil actions in the State courts of the State in which that Federal court is located.[5] But in a later case, it has been decided, that the pleadings in an action at law, for infringement of a patent, should conform to the common law, even in a code State;[6] and inasmuch as many of the States still employ common-law actions and pleadings in their own courts, it is necessary for pleaders to accurately know the proper characteristics

[2] Revised Statutes, Section 914.

[3] Cottier *v.* Stimson, 18 F. R. 690, 1883.

[4] May *v.* County of Mercer, 30 F. R. 250, 1887.

[5] Celluloid Mfg. Co. *v.* Zylonite Co., 34 F. R. 744, 1888.

[6] Myers *v.* Cunningham, 44 F. R. 349, 1890.

of a declaration, in an action of trespass on the case, for the infringement of a patent.

§ 421*a*. An action at law lies for damages against one who fraudulently procures a patent for an invention which in fact was made by another.[7]

§ 422. The proper parts of such a declaration are the following: 1. The title of the court. 2. The title of the term. 3. The venue. 4. The commencement. 5. The statement of the right of action. 6. The conclusion.

The true title of the United States District Court established in Connecticut is "District Court of the United States for the District of Connecticut," and the title of the district court which is established in any other district is the same, except as to the name of the district.[8]

The proper term of the court in which to entitle the declaration, is the term at which the appearance of the defendant is due.[9] It is unnecessary to entitle a declaration in the name of the case in which it is filed; though it is convenient to indorse that name on the back of the declaration, for the purpose of enabling the document to be readily found in a file.

The venue should be laid in the district, and division if any, where the action is commenced, regardless of the district or districts wherein the infringement was committed.[10]

The commencement contains a statement of the names of the parties to the action, and of the capacity in which they respectively sue or are sued, if it is other than a natural personal capacity. Though it is probably unnecessary, it is undoubtedly prudent to state the nation of which

[7] Le Brocque *v.* Childs, 158 F. R. 412, 1908.

[8] Judicial Code, Section 1.

[9] 1 Chitty on Pleading, 15th American Edition, p. 263.

[10] McKenna *v.* Fisk, 1 Howard, 248, 1843.

the parties are respectively citizens, and if that nation is the United States, to allege also the particular State of which the parties are citizens respectively. Where either party is a corporation, that fact must be stated, and the name of the State or other sovereignty wherein it was created and exists should also be alleged. The commencement properly closes with a brief recital that the form of action is that of trespass on the case.

§ 423. The statement of the right of action should contain the name and residence and citizenship of the inventor, upon whose application the patent, on which the action is based, was granted.

§ 424. The novelty and the utility of the invention must be put in issue by proper averments in the declaration;[11] which averments include not only the general statement that the invention was new and useful, but also those details of the elements of novelty which are defined by the statute,[12] and which consist in actual newness in this country, and technical novelty throughout the world. But it is not necessary to state the particular time at which the invention was made, so that it appears to have been made before the application for the patent was filed.[13]

§ 425. The statement of the right of action must also aver that the invention was not in public use or on sale in this country for more than two years before the inven-

[11] Coop *v.* Development Institute, 47 F. R. 900, 1891; Overman Wheel Co. *v.* Elliott Cycle Co., 49 F. R. 859, 1892; Goebel *v.* Supply Co., 55 F. R. 827, 1893; Ross *v.* Ft. Wayne, 58 F. R. 407, 1893.

[12] Revised Statutes, Section 4886, as amended March 3, 1897, Chapter 391, Section 1, 29 Stat. 692; Diamond Match Co. *v.* Ohio Match Co., 80 F. R. 117, 1897; Rubber-Tire Wheel Co. *v.* Davie, 100 F. R. 85, 1900; Elliott & Hatch Book-Typewriter Co. *v.* Fisher Typewriter Co., 109 F. R. 330, 1901.

[13] Wilder *v.* McCormick, 2 Blatch. 31, 1846.

tor's application for the patent.[14] And where a declaration is based on a patent which was applied for after 1897, the statement of the right of action must likewise aver that the invention was not patented or described in any printed publication, more than two years prior to the application for that patent.[15]

§ 426. If the patentee is neither a party to the action, nor the inventor of the thing or process covered by the patent, it is natural and proper to separately state his name in order to fully and surely identify the patent. It is well also to state his residence and his citizenship, though there is no requirement of law on either of these points.

§ 427. It is not necessary to state in a declaration the particulars of the application for the letters patent, nor the particulars of the proceedings of the Patent Office in considering that application;[16] nor to make any statement about any application, except that the letters patent were granted upon the application of the inventor named in the declaration.[17]

§ 428. The declaration may indicate the letters patent in the language of the grant, and make profert thereof; and if that is done, it is not necessary to set out the speci-

[14] Revised Statutes, Section 4886; Gandy *v.* Belting Co., 143 U. S. 592, 1892; Gray *v.* James, 1 Peters' Circuit Court Reports, 482, 1817; Blessing *v.* Copper Works, 34 F. R. 754, 1888; Nathan Mfg. Co. *v.* Craig, 47 F. R. 522, 1891; Consolidated Brake-Shoe Co. *v.* Detroit Spring Co., 47 F. R. 895, 1890, Hayes-Young, etc., Co. *v.* St. Louis Transit Co., 137 F. R. 80, 1905.

[15] Revised Statutes, Section 4886, as amended March 3, 1897; 29 Statutes at Large, p. 692, Ch. 391, Section 1; Rubber-Tire Wheel Co. *v.* Davie, 100 F. R. 85, 1900.

[16] Cutting *v.* Myers, 4 Washington, 221, 1818.

[17] Wilder *v.* McCormick, 2 Blatch. 31, 1846; Luten *v.* Dover Construction Co., 189 F. R. 405, 1911.

fication either verbatim or substantially;[18] for the profert imports the patent, by implication into the declaration.[19]

Where a declaration is based on a patent which was granted before April 11, 1902, the declaration must state that the letters patent were issued in the name of the United States of America, under the seal of the Patent Office, and were signed by the Secretary of the Interior, or an Assistant Secretary of the Interior, as the case may be, and countersigned by the Commissioner of Patents, and that they were delivered to the patentee.[20] And where a declaration is based on a patent granted after April 11, 1902, the declaration must state that the letters patent were issued in the name of the United States of America, under the seal of the Patent Office, and were signed by the Commissioner of Patents.[21]

Inasmuch as patents are granted for various spaces of time, it is necessary to state the particular term for which the letters patent in suit were issued. It is necessary also to plead the legal effect of the patent, by saying that it did grant to the patentee, his heirs or assigns, the exclusive right to make, use and vend the invention covered thereby, throughout the United States and the Territories thereof.[22]

§ 429. Where the patent upon which the action is based is a reissue, the original letters patent should be set forth precisely as though no surrender and reissue had occurred; and in addition thereto, it is proper to state the particular kind of defect which made the original a proper subject of a reissue; and to state also that such defect arose from

[18] Cutting *v.* Myers, 4 Washington, 223, 1818.

[19] Graham *v.* Earl, 82 F. R. 737, 1897; Dyer *v.* Cryder, 153 F. R. 767, 1907.

[20] Revised Statutes, Section 1883; 25 Statutes at Large, Ch. 15, p. 40; Cutting *v.* Myers, 4 Washington, 222, 1818.

[21] 32 Statutes at Large, Part I, page 95, Ch. 417.

[22] Revised Statutes, Section 4884.

inadvertence, accident, or mistake, as the case may be, and without any fraudulent or deceptive intention; and to state that the original patent was surrendered, and who surrendered it; and to state that the Commissioner of Patents caused a new patent to be issued for the same invention; and to state finally the name of the person to whom such new patent was granted. These particulars lie at the foundation of the right of the grantee of a reissue patent to receive such a grant; and although the reissue is *prima facie* evidence that the truth on all these points is favorable to the validity of the patent, it is none the less proper to put those facts in issue by proper pleading. And it is hardly prudent to venture a case on a more indefinite form of pleading; though a more indefinite form of pleading has once been held sufficient in such a case.[23]

§ 430. Where a disclaimer has been filed, that fact ought to be stated in the declaration, and its legal effect ought to be indicated, because disclaimers constitute amendments of original patents, and operate to vary their scope.[24] In such a case also, the declaration ought to state that the disclaimer was filed without unreasonable delay, because that fact is necessary to the right of a patentee to maintain a suit on a patent which required a disclaimer.[25]

§ 431. Where the patent in suit has been extended by a special Act of Congress, and where the suit is partly or wholly based on such extension, the declaration must state the legal effect of the Act of extension, and it must specially show the particular space of time covered thereby.

§ 432. Where the plaintiff is an assignee or grantee of

[23] Spaeth *v.* Barney, 22 F. R. 828, 1885.

[24] Revised Statutes, Section 4917.

[25] Revised Statutes, Section 4922.

the patentee, it is safer to set forth all the mesne assignments or grants down to him, than merely to state that the exclusive right which was infringed by the defendant, came to the plaintiff by assignment or by grant. And a declaration must not only state how and when the plaintiff became the owner of the patent right, but must also allege ownership during the time of the infringement upon which the declaration is based. Title papers should be set forth by their legal effect, and not be copied bodily in the declaration.

§ 433. No profert need be made in any declaration, of any assignment or grant of any interest under letters patent. But where the title papers of a plaintiff include letters testamentary or letters of administration, he must make profert of those documents. If profert is made of any document of which it is not necessary, it will be treated as surplusage, and will not entitle the defendant to oyer.

§ 433*a*. The declaration must state, either that no person ever made or sold the patented article under the authority of the patent; or that such of the patented articles as were thus made or sold, had the word "patented," together with the day and year the patent was granted, fixed thereon, or when, from the character of the article, this could not be done, then to the package wherein one or more of them was enclosed; or otherwise that the defendant was duly notified that his doings were an infringement of the patent, and continued, after such notice, to infringe.[26]

§ 434. The statement of infringement should allege that the defendant, without any license, did make, or that he did use, or that he did sell, the subject of whatever claim or claims of the patent the plaintiff intends to prosecute

[26] Dunlap *v.* Schofield, 152 U. S. 244, 1894.

at the trial; and that the infringement occurred within the territory covered by the plaintiff's title to the patent, and within the time during which the plaintiff held the title within that territory, and contrary to the statutes of the United States, in such cases made and provided.

While an allegation of either making, using, or selling will be sufficient in a declaration to show a cause of action, no allegation of any one of these kinds of infringement will support evidence of either of the others. A declaration ought therefore to allege as many of them as the plaintiff has any expectation of being able to prove.

§ 435. The time of the infringement is properly stated, by alleging that it occurred on a specified day, and on divers other days between that day and some later specified date; and no plaintiff will be permitted to prove infringement outside of the space of time which he specified in his declaration.[27] It is, however, held that it is not necessary for plaintiff to plead the six-year statutory period within which infringement must be shown to have taken place in order to justify a recovery [27a] since although the statute does not create a true statute of limitations but on the contrary creates a condition of the right of recovery, nevertheless the fact that no infringements have taken place within the statutory period is a matter of defence. Furthermore, the defendant need not specially plead the restriction but may avail himself of it if it appears in the plaintiff's case that no infringements have taken place within that period, or the defendant may prove the facts on his own behalf.[28] This rule, of course, applies equally well to appeals in equity when an account-

[27] Eastman *v.* Bodfish, 1 Story, 530, 1841; LePage Co. *v.* Russia Cement Co., 51 F. R. 949, 1892.

[27a] Act March 3, 1897, Chap. 391, 29 Statutes, 694.

[28] Peters *v.* Hanger, 134 F. R. 586, 1904.

ing of damages and profits is sought.[29] Repeated infringements may be sued for in one action; [30] but all of the infringements complained of in one declaration must have been committed after the plaintiff obtained the title to the patent, and before the beginning of the action. Where the plaintiff is an assignee, and where he not only has rights of action against the defendant, for infringements committed after the date of his assignment, but also has purchased rights of action against the same party, for infringements committed before such purchase, he must, if he sues at law, bring a separate action for the latter causes, and must bring that action in the name of the person who owned the patent at the time they accrued.

§ 436. The damages incurred by the plaintiff on account of a defendant's infringement must be stated specially, because no particular damage necessarily arises from infringements of patents, and therefore none is implied by the law.[31] The special damages to be alleged in any particular case depend upon the circumstances of that case: depend upon the particular criterion of damages upon which the plaintiff relies. The various measures of damages in patent cases are stated and explained in the nineteenth chapter of this book. One or more of them will be found to be applicable to every case which is likely to arise. From among them, the pleader may select those which he expects to be able to prove to be pertinent, and may then draw his special statement of damages accordingly. Such a special statement is required by the substantial principles of pleading, as well as by its technical rules. Without it, the defendant would not be apprised of all the issues of the case. He would not know, till the

[29] See Section 579.

[30] Wilder *v.* McCormick, 2 Blatch. 32, 1846.

[31] 1 Chitty on Pleading, 396.

day of trial, whether the plaintiff would prove an established royalty, or would prove loss or reduction of his sales, or would prove reduction of his prices, as the criterion of his damages. The defendant would therefore have to go to court provided with witnesses on all these points, or would have to trust his sagacity, and guess which of these points he would be called upon to meet. It was to prevent such inconveniences that written pleadings were originally designed; and for the same purpose, among others, they are still retained in actions in courts.

§ 437. The conclusion of a proper declaration in a patent case alleges that, by force of the statutes of the United States, a right of action has accrued to the plaintiff to recover the actual damages which the declaration specifies, and such additional amount, not exceeding in the whole three times the amount of such actual damages, as the court may see fit to adjudge and order, besides costs. The conclusion ends with the ancient allegation of bringing suit.

§ 438. A declaration, though not drawn in due form, is sufficient for practical purposes, if it contains all that is essential to enable the plaintiff to give evidence of his right, and of its violation by the defendant, and affords to the defendant the opportunity of interposing every defence allowed to him by law.[32] Courts do not encourage merely technical objections to pleadings, and even on special demurrer, will seek to sustain those which, though not technically accurate, are substantially sufficient for the real purposes of pleading.

§ 439. Dilatory pleas in patent actions are not materially different in their nature and operation from corresponding pleas in other common-law cases. It is therefore unnecessary to treat those preliminary defences in this

[32] Wilder *v.* McCormick, 2 Blatch. 37, 1846.

book. Recourse may be had to the standard works on common-law pleading for whatever information the patent pleader may require upon the subject.

§ 440. The defences which are pleadable in bar to an action, are very numerous in the patent law, and most of them are peculiar to this branch of jurisprudence. Where the facts appear to warrant so doing, a defendant may plead: 1. That the matter covered by the letters patent was not a statutory subject of a patent: or 2. That it was not an invention: or 3. That it was not novel at the time of its alleged invention: or 4. That it was not useful at that time: or 5. That the inventor actually abandoned the invention: or 6. That he constructively abandoned it, by not applying for a patent on it, during the time allowed by the statutes for such an application to be made: or 7. That the invention claimed in the original patent is substantially different from any indicated, suggested, or described in the original application therefor: or 8. That the patentee surreptitiously or unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting the same: or 9. That the invention was made by another jointly with the sole applicant: or 10. That it was made by one only of two or more joint applicants: or 11. That for the purpose of deceiving the public, the description and specification filed in the Patent Office was made to cover less than the whole truth relevant to the invention, or was made to cover more than was necessary to produce the desired effect: or 12. That the description of the invention in the specification is not 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: or 13. That the claims of

the patent are not distinct: or 14. That the patentee unreasonably delayed to enter a needed disclaimer: or 15. That the original patent was surrendered and reissued in the absence of every statutory foundation thereof: or 16. That the claims of the reissue patent in suit are broader than those of the original, and that the reissue was not applied for till a long time had elapsed after the original was granted: or 17. That the reissue patent in suit covers a different invention from any which the original patent shows was intended to be secured thereby: or 18. That the invention claimed in the original patent, is substantially identical with an invention claimed in a prior patent granted on the application of the same inventor: or 19. That the patent was repealed: or 20. That the patent legally expired before the alleged infringement began, or before it ended: or 21. That the patentee made or sold specimens of the invention covered by his patent, without marking them "patented," and without notifying the defendant of his infringement: or 22. That the plaintiff has no title to the patent, or no such title as can enable him to maintain the action: or 23. That the defendant has a license, which authorized part or all of the doings which constitute the alleged infringement: or 24. That the defendant has a release, discharging him from liability on account of part or all of the alleged infringement: or 25. That the defendant is not guilty of any infringement of the patent upon which he is sued: or 26. That the plaintiff is estopped from enforcing any right of action against the defendant: or 27. That the cause of action sued upon, is partly or wholly barred by some statute of limitation: or 28. That the Commissioner of Patents has exceeded his legal authority in granting or reissuing the patent.[33]

§ 441. The first fourteen and the twenty-eighth of these

[33] See Section 148.

defences assail the validity of original patents; and either of them, if successfully maintained, will defeat any such patent, and therefore defeat any action based thereon. All of the fifteen are also applicable to actions based upon reissue patents, for though a defective or insufficient specification, or a defective or insufficient claim, or an excessive claim, can be cured by surrender and reissue,[34] those faults are sometimes retained and sometimes introduced in reissues.

The fifteenth, sixteenth, and seventeenth of these defences assail reissues as reissues. To what extent those defences, if successful, will affect the patent, or the action, are points which are explained in the chapter on reissues.[35]

The eighteenth defence assails the validity of original patents, and it may be applicable to all the claims of such a patent, or it may be applicable to only some of them. And a patent will not be invalidated throughout, by the fact that one or more of its claims, less than all of them, must be invalidated on this ground, any more than where such invalidity arises out of any other reason.

The nineteenth defence, when true, will certainly be a full one to any action based on alleged infringements which were committed after the repeal of the patent. Whether it will be a defence to any infringement committed before that time, will depend upon whether the patent is repealed *ab initio*, or only *in futuro*.

The twentieth defence will be available against any patent which was applied for before 1898, where the defendant can prove that the invention was patented with the knowledge and consent of the inventor in some foreign country before it was patented in the United States,

[34] Revised Statutes, Section 1916.

[35] Sections 221 and 249 of this book.

and that such foreign patent expired before the United States patent purported to terminate. This defence, if successful, will not affect the validity of the patent. It will merely limit its duration to less than seventeen years.[36]

The twenty-first defence, if successful, will bar the action, but it will not affect the patent. Any oral or written notice of infringement, if given to the defendant without stopping his infringement, will oust the defence as to subsequent infringements.[37]

All defences from the twenty-first to the twenty-seventh are without relevancy to the validity of the patent. Either of them may be partly or wholly successful, according to the circumstances of each action, regardless of the success or want of success which may attend the other twenty-one.

§ 442. Such of these defences as can be established from the face of the declaration, or of the letters patent upon which the suit is based, or can be based upon a fact of which the court will take judicial notice, may be made by demurrer; but if so made and overruled, such a defence cannot afterward be made in a plea, without leave of the court.[38]

The ancient rules of common-law pleading would require a special plea for either of the twenty-eight defences which are enumerated in Section 440, save only the defence of non-infringement, and sometimes that of want of title.[39] But a loose and unscientific relaxation of that part of those rules crept at one time into practical pleadings, both in England and America. The abuse was re-

[36] Section 163 of this book.

[37] New York Pharmical Association *v.* Tilden, 14 F. R. 740, 1882; Allen *v.* Deacon, 21 F. R. 122, 1884.

[38] Brickill *v.* Hartford, 57 F. R. 218, 1893.

[39] Stephen on Pleading, 160.

formed in England in the fourth year of William the Fourth;[40] but in the United States it has continued, except so far as it has been limited or enlarged by legislation in particular States. But there was never any principle which guided this departure from the ancient law, and therefore no foundation for any science of the subject. Where an authoritative precedent can be found for a particular relaxation, that particular relaxation must be regarded. In the absence of such a precedent, the safe and proper course is to conform to the ancient common-law rules, unless the pleader is willing to risk his defence upon the theory that State statutes relevant to pleadings are binding on Federal courts when trying patent actions of trespass on the case.

§ 443. The patent statute provides that five of the twenty-eight defences may be made under the general issue, accompanied with a certain statutory notice of special matter.[41] Those are the defences which, in Section 440 of this book, are numbered three, five, six, eight, and eleven, respectively. Either of these five defences may also be made under a special plea, instead of under the general issue accompanied by notice, if the defendant so determines.[42] But if any defendant uses both these forms of pleading for any one defence, the court will, on motion, call upon him to select the one which he prefers, and to abandon the other.[43]

§ 444. Notices of special matter must be in writing, and must be served on the plaintiff or his attorney at

[40] Stephen on Pleading, 158.

[41] Revised Statutes, Section 4920, as amended in 29 Statutes at Large, p. 692, Ch. 391, Section 2.

[42] Evans *v.* Eaton, 3 Wheaton, 454, 1818; Grant *v.* Raymond, 6 Peters, 218, 1832; Day *v.* Car-Spring Co., 3 Blatch. 181, 1854; Henry *v.* United States, 22 Court of Claims, 78, 1887.

[43] Read *v.* Miller, 2 Bissell, 16, 1867.

least thirty days before the trial of the case.[44] No such notice requires any order of court as a prerequisite thereto; and depositions taken before the service of such a notice are as admissible under it as if taken afterward.[45] It is not the purpose of the statute to oblige the defendant to give notice of anticipating matter before taking depositions. Its only purpose is to give the plaintiff thirty days before the trial, in which to secure evidence to contradict the testimony of the defendant's witnesses, in case the latter is untrue. Notices of special matter are not required to be filed in court; and if filed they are not examinable by demurrers. Their sufficiency is decided at the time of trial, by admitting or excluding evidence offered thereunder.[46]

Notices of want of novelty must state the names of the prior patentees, and the dates of their patents, where prior patents are relied upon; and where prior knowledge or use is relied upon, such a notice must state the names and residences of the persons alleged to have had the prior knowledge of the thing patented, and where and by whom it was used.[47] Where prior printed publications are relied upon as negativing the novelty of the patented invention, the statute does not say how such publications are to be identified in such notices. But the Supreme Court has decided that they must be pointed out with sufficient definiteness to relieve the plaintiff from making an unnecessarily laborious search therefor.[48] In the Supreme Court case just cited, a notice was held to be insufficient, which stated that the patented thing was described in a

[44] Revised Statutes, Section 4920, as amended 29 Stat. 692.

[45] Teese *v.* Huntingdon, 23 Howard, 2, 1859.

[46] Henry *v.* United States, 22 Court of Claims, 79, 1887.

[47] Revised Statutes, Section 4920, as amended 29 Stat. 692.

[48] Silsby *v.* Foote, 14 Howard, 218, 1852; also, Corrugated Metal Co. *v.* Pattison, 197 F. R. 577, 1912.

certain book therein mentioned, but did not state in what part of that book it was so described. Notices of prior knowledge or use are sufficiently specific, when they specify the city in which that knowledge or use existed or occurred, and give the names of persons who had that knowledge, or who engaged in that use, and state in what city those persons reside.[49] That is to say: the word "where" and the word "residence," as those words are used in the statute, refer to cities, villages, or towns, as the case may be, and do not refer to particular houses, factories, or farms. In short, the answer must locate the time and place of such use with such directness and certainty as will enable complainant to go upon the ground and determine what acts are relied upon by the defendant to constitute prior use.[50]

The names of witnesses as such, need not be mentioned in a notice, yet it is often necessary to use as witnesses, persons who are named in the notice as having been engaged in the prior use to be proved, or as having known of the anticipating process or thing. Accordingly where a notice alleges that A. B. used an anticipating machine in a certain city, and that C. D. had knowledge of that prior use, those facts may both be proved by E. F. without mentioning his name in the notice.[51] But if A. B. is the only available person by whom to prove his prior use, or if his testimony on that point is to be taken together with that of others, his name must still be mentioned in the notice: mentioned not as a witness to be called to prove a fact, but as the person who transacted that fact.

Notices need not state the particular time when an

[49] Wise *v.* Allis, 9 Wallace, 737, 1869.

[50] Corrugated Metal Co. *v.* Pattison, 197 F. R. 577, 1912.

[51] Planing-Machine Co. *v.* Keith, 101 U. S. 492, 1879; Many *v.* Jagger, 1 Blatch. 376, 1848.

anticipating printed publication was published, nor when an anticipating process or thing was known or used;[52] but they must state the dates of all alleged anticipating patents.[53] If a notice does unnecessarily state a particular time, that statement will be regarded as harmless surplusage, and a variance therefrom in the evidence will not render the latter inadmissible.[54]

§ 445. Where any defence to a patent action can be based upon a fact of which the court will take judicial notice without evidence, that defence may be made under the general issue without any special pleading.[55]

§ 446. The first and second defences are those which come within the rule of the last section relevant to judicial notice. The first defence is applicable mainly or only when a "principle" has been patented, as for example by the eighth claim of Morse,[56] or by the anæsthesia patent of Morton and Jackson.[57] The applicability of judicial notice to that defence is perhaps invariable.

But there appears to be no warrant for saying that the second defence need not be pleaded, where a patent is assailed for want of invention, on account of prior facts which must be proved by evidence, in order to be acted upon by courts.[58] Justice requires that the plaintiff be notified beforehand of such a defence, as truly as of the defence of want of novelty; for it may equally be based on facts outside of the patent, and outside of the knowledge of the inventor and of the plaintiff.

[52] Phillips *v.* Page, 24 Howard, 164, 1860.

[53] Revised Statutes, Section 4920.

[54] Phillips *v.* Page, 24 Howard, 164, 1860.

[55] May *v.* Juneau County, 137 U. S. 408, 1890.

[56] O'Reilly *v.* Morse, 15 Howard, 112, 1853.

[57] Morton *v.* Infirmary, 5 Blatch. 116, 1862.

[58] Brickill *v.* Hartford, 57 F. R. 217, 1893; Britton *v.* White Mfg. Co., 61 F. R. 95, 1894.

§ 447. The third defence may be based upon a special plea, instead of on the general issue accompanied by notice; and when that practice is adopted, that plea is the only notice which the plaintiff can claim.[59] It has been held that special pleas, when used instead of notices, must be filed at least thirty days before the term of trial, or the plaintiff will be entitled to a continuance.[60] This holding was so reasonable that it can be supported on the ground that every court has power to make reasonable rules to regulate the time of filing pleas.[61] A special plea which has been stricken out by order of court, cannot operate as a notice, and thus furnish the foundation of a defence which requires a notice in the absence of a special plea.[62] And a plea or notice of want of novelty must state that the anticipating fact occurred before the invention claimed by the patent was made; for it is not enough to state that the anticipating fact occurred before the date of the patent.[63]

§ 448. The fourth defence is not among those which can be made under the general issue accompanied by notice. There is probably no case in which it has been successfully made at law, without being set up in a special plea. In the absence of such precedents, it would be unsafe for a pleader to attempt such an innovation on the rules of the common law.

§ 449. The fifth and sixth defences always require evidence outside of the patent, and outside of the doctrines of judicial notice. They may be made under the general issue accompanied by the statutory notice,[64] or under a

[59] Evans *v.* Eaton, 3 Wheaton, 504, 1818.

[60] Phillips *v.* Comstock, 4 McLean, 525, 1849.

[61] Packet Co. *v.* Sickles, 19 Wallace, 611, 1873.

[62] Foote *v.* Silsby, 1 Blatch. 445, 1849.

[63] Brickill *v.* Hartford, 57 F. R. 219, 1893.

[64] Revised Statutes, Section 4920, as amended 29 Stat. 692.

special plea, but there is no reason to suppose that they can lawfully be made under the general issue alone.

§ 450. The seventh defence is not based on any express statute. Its foundation is the general spirit of the patent laws; and it has been expounded in a number of cases, beginning in the case of Railway Co. *v.* Sayles.[65] Evidence to support it must always be drawn from outside of the patent, and must be regularly introduced into the case. This defence is therefore to be made by a special plea, when it is made at all.

§ 451. The eighth defence may be made either by the general issue accompanied by notice,[66] or by special plea. It applies to cases where another than the patentee preceded him in the first conception of the patented thing, but did not precede him in adapting it to actual use. If that other stopped with that conception, the validity of the patent is not affected thereby, but if he used reasonable diligence in adapting and perfecting the invention so conceived, no subsequent inventor can have a valid patent, surreptitiously or unjustly obtained by him for the same invention. Such a patent is surreptitiously obtained, where the patentee appropriates the idea from the first conceiver, and, exceeding him in speed, reduces the invention to proper form, and secures the patent, while the first conceiver is diligently laboring to adapt the invention to use. Such a patent is unjustly obtained, if it is issued to a subsequent inventor, when the first con-

[65] Railway Co. *v.* Sayles, 97 U. S. 563, 1878; Consolidated Electric Light Co. *v.* McKeesport Light Co., 40 F. R. 26, 1889; Beach *v.* Box Machine Co., 63 F. R. 604, 1894; Michigan Central Railroad Co. *v.* Car-Heating Co., 67 F. R. 126, 1895; Bowers *v.* San Francisco Bridge Co., 69 F. R. 644, 1895; Erie Rubber Co. *v.* American Dunlop Tire Co., 70 F. R. 62, 1895; Hulett *v.* Long, 15 App. D. C. 291, 1899.

[66] Revised Statutes, Section 4920, as amended 29 Stat. 692.

ceiver is using due diligence to reduce his invention to practice.[67] Where this defence is pleaded, all its elements must be incorporated in the plea. The allegation of unjust or surreptitious obtaining of the patent, must be accompanied by an allegation that the first conceiver was at the time using reasonable diligence in adapting and perfecting the invention.[68]

§ 452. The ninth and tenth defences are based on the fact that patents can lawfully be granted to no one but the inventors of the things covered thereby, or to those who represent them as assigns or legal representatives.[69] Neither of those defences can ever receive any support from the face of the patent, or from any fact of which any court can take judicial notice. Both depend upon evidence *aliunde*, and either must be interposed in a special plea, for the statute does not include either among those defences which may be made under the general issue accompanied by notice.[70]

§ 453. The eleventh defence may be set up under the general issue accompanied by notice,[71] or in a special plea; and in either way, this defence must be stated with particularity.[72] Even where a patent does contain too much or too little, this defence does not apply, unless the fault was intended, and was intended to deceive the public.[73] But those intentions will be inplied from proof of the

[67] Yates *v.* Huson, 8 App. D. C. 93, 1896.

[68] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868.

[69] Sections 50 and 51 of this book.

[70] Butler *v.* Bainbridge, 29 F. R. 143, 1886.

[71] Revised Statutes, Section 4920, as amended 29 Stat. 692.

[72] American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 70 F. R. 992, 1895.

[73] Hotchkiss *v.* Oliver, 5 Denio (N. Y.), 314, 1848; Celluloid Mfg. Co. *v.* Russell, 37 F. R. 679, 1889; Burke Electric Co. *v.* Independent Pneumatic Tool Co., 232 F. R. 145, 1916.

fact that the inventor knew the true importance of what he wrongly omitted from his specification, or wrongly inserted therein.[74]

§ 454. The twelfth defence is somewhat similar to the first member of the eleventh; but unlike that, it cannot be based on the general issue accompanied by notice; and it does not require the element of intention to deceive. It is based upon that provision of the statute which makes a full clear, concise, and exact description of the invention a prerequisite to the jurisdiction of the Commissioner to grant a patent.[75] If a patent falls below the statutory requirement in that respect, that patent is void.[76] Whether a given patent does so fall is a question of evidence and not of construction.[77] Therefore this defence cannot be made by demurrer.[78] This defence must be interposed in a special plea; for neither the statute nor any precedent contemplates its being based on the general issue, either with or without notice; and still less does any rule of law provide for its being made on the trial of an action without being pleaded at all.

§ 455. The thirteenth defence is based on the statute which requires that, before any inventor shall receive a patent for his invention, he shall particularly point out, and distinctly claim, the part, improvement or combination which he claims as his invention.[79] It is a defence of decided merit, aimed by the policy of the law at nebulous

[74] Electric Boot & Shoe Finishing Co. *v.* Little, 75 F. R. 276, 1896.

[75] Revised Statutes, Section 4888.

[76] O'Reilly *v.* Morse, 15 Howard, 62, 1853; Pacific Cable Ry. Co. *v.* Butte City Ry. Co., 58 F. R. 422, 1893; National Chemical & Fertilizer Co. *v.* Swift & Co., 100 F. R. 451, 1900.

[77] Loom Co. *v.* Higgins, 105 U. S. 580, 1881.

[78] Chase *v.* Fillebrown, 58 F. R. 376, 1893.

[79] Revised Statutes, Section 4888.

claims. The courts have not heretofore gone so far in upholding this defence as the statute would justify. Probably the strongest judicial language heretofore used on the subject is that of the Supreme Court in the case of Carlton *v.* Bokee.[80] In that case Justice BRADLEY, in delivering the opinion, said that: "Where a specification, by ambiguity and a needless multiplication of nebulous claims, is calculated to deceive and mislead the public, the patent is void." This defence may be made by demurrer;[81] because the question of the validity of a patent, as against it, is a question of construction of the document, to decide which, a judge will seldom require aid from other evidence than the letters patent themselves. But a special plea is probably the best means of interposing this defence; though there is less meritorious necessity for special pleading to support it, than there is to support any other defence which assails the validity of a patent.

§ 456. The fourteenth defence is based upon the statute which provides that where a new invention and an old one are both claimed in a patent, the patentee may sustain an action on the former, but not unless he disclaims the latter without unreasonable delay.[82] That the old invention was old, and that the delay to disclaim it was unreasonable, are matters of fact depending upon evidence. There is therefore no reason to suppose that this defence can be made in any action at law, without a special plea to give it entrance.

§ 457. The fifteenth defence goes to the jurisdiction of the Commissioner to reissue the patent in suit. In the

[80] Carlton *v.* Bokee, 17 Wallace, 472, 1873.

[81] Brickill *v.* Hartford, 49 F. R. 373, 1892.

[82] Revised Statutes, Section 4922.

chapter on reissues the defence is discussed with some fulness.[83] Whatever doubt may exist relevant to its scope, it is clear that the questions which are involved in its applicability to a particular case, are mainly questions of fact, depending upon evidence *in pais*, and that a special plea is therefore the proper means of bringing it to the attention of the court.

§ 458. The sixteenth defence originated in the year 1882,[84] and though not based on the letter of any statute, it has been many times enforced. The first element in its foundation is a point of comparative construction of the original and the reissue patent. But inasmuch as a plaintiff, suing on a reissue, need not introduce the original in evidence, even that element depends upon proof by the defendant of the contents of the original. The second element is a variable quantity, for the particular length of time between the date of an original and the application for a reissue patent, which will be fatal to a broadened reissue, depends upon the circumstances of each case, and those circumstances can be made known to the court through evidence alone. These considerations point to the propriety of disregarding this defence, in an action at law, unless it is set up in a special plea, and the plaintiff thus notified of what he must meet on the trial.

§ 459. The seventeenth defence depends upon proof of the original patent, and requires at least that amount of evidence to support it. In cases where the question of sameness or difference of invention is a complicated one, courts may require the benefit of evidence on that subject to aid them in deciding the point. In order to give both sides an opportunity to produce such evidence, a special

[83] Section 221 of this book.

[84] Miller *v.* Brass Co., 104 U. S. 350, 1882.

plea seems necessary; but it has been decided that a general denial of the declaration is enough.[85]

§ 460. The eighteenth defence can be made by a demurrer in a case which is based on the prior patent, as well as on its alleged double;[86] but in other cases it requires a special plea, because it is a defence in confession and avoidance of the declaration.

§ 461. The nineteenth defence will of course require evidence of the record of the court which repealed the patent. But as that record cannot be contradicted by any evidence, and as no repeal could have been had without the knowledge of the plaintiff or his privies, there seems to be no meritorious reason why a special plea should be insisted upon to sustain this defence. But in the absence of a precedent, that will be the safest pleading for the defendant to file.

§ 462. The twentieth defence demands a special plea, where it is based on the expiration of a foreign patent on the same invention as that of the patent in suit; because the evidence to prove the existence and the expiration of the foreign patent, must come from outside the patent in suit, and must generally be supported by expert testimony that the foreign patent produced is really one for the same invention as the patent in suit. Indeed, the defence may fail even then, for it cannot stand against proof that the foreign patent was surreptitiously taken out by another than the United States patentee, and without his knowledge or consent. It would be unjust to allow a plaintiff to be surprised on the trial of an action at law, with proof of a foreign patent for his invention granted to another, after his invention was made, but before the date of his patent. Such a piece of evidence,

[85] Oregon Imp. Co. *v.* Excelsior Coal Co., 132 U. S. 215, 1889.

[86] Russell *v.* Kern, 64 F. R. 581, 1894.

if unexplained, might limit the duration of the United States patent, and thus perhaps defeat the suit. It is clear, therefore, that no such issue ought to be sprung upon a plaintiff when before the court. A special plea is requisite to give him notice of a fact apparently so unfavorable.

§ 463. The twenty-first defence can be made under the general issue, for it must be negatived in the declaration.[87]

§ 464. The twenty-second defence can be made under the general issue, where the defendant merely proposes to argue that the plaintiff's evidence does not make out any title, or makes out no such title as enables him to sue in an action at law. But where the defendant attacks the plaintiff's title on the basis of a paramount assignment to another, he ought to plead the defence specially, for otherwise the plaintiff might be surprised on the trial with evidence which, with a little time for preparation, he could perhaps explain away, or perhaps overthrow.

§ 465. The twenty-third and twenty-fourth defences both required to be pleaded specially according to the pleading rules of the ancient common law.[88] But under the relaxation which obtained in England, in the eighteenth century, they could, in ordinary cases, have been proved under the general issue.[89] That relaxation does not, however, deserve to be extended by any process of reasoning by analogy; and it is possible that the courts will hold that it does not apply to patent litigation in the United States.

§ 466. The twenty-fifth defence is one to which the plea of the general issue is, and always was, appropriate, for it is a defence which consists simply in a denial of the

[87] Dunlap *v.* Schofield, 152 U. S. 244, 1894.

[88] Stephen on Pleading, 158.

[89] 1 Chitty on Pleading, 491.

alleged infringement.[90] And even where a proper defence of non-infringement involves evidence of the state of the art, the general issue is a sufficient plea under which to make such a defence, because no notice to the plaintiff is necessary to render such evidence admissible.[91]

§ 467. The twenty-sixth defence is as proper in an action at law as it is in an action in equity.[92] Estoppels in patent cases are like those in other cases, in that they are divisible into three classes: Estoppels by matter of record; by matter of deed; and by matter *in pais*. The principles of estoppel constitute a systematic department of the law, to the delineation and development of which a number of text-writers have devoted careful and thorough consideration. No extensive discussion of the subject is therefore to be expected in this book. Something has already been written about estoppel *in pais*, in connection with the subject of implied licenses.[93] And it may be mentioned here, that a defendant is not estopped from denying the validity of a patent, by the fact that he formerly thought and represented it to be valid,[94] or the fact that he once made an application himself, for a patent on the same invention.[95] And something more may be added in this place, about estoppels by matter of record, and by matter of deed, for the patent precedents contain a few cases in which those doctrines have been applied to

[90] Stephen on Pleading, 160.

[91] Dunbar *v.* Myers, 94 U. S. 198, 1876; Eachus *v.* Broomall, 115 U. S. 434, 1885; Grier *v.* Wilt, 120 U. S. 429, 1886; Jones *v.* Cyphers, 126 F. R. 753, 1903; Morton *v.* Llewellyn, 164 F. R. 693, 1908; Stevens *v.* Rodgers Boiler & Burner Co., 186 F. R. 631, 1911.

[92] Dickerson *v.* Colgrove, 100 U. S. 584, 1879; City of Concord *v.* Norton, 16 F. R. 477; 1883.

[93] Section 313 of this book.

[94] De La Vergne Machine Co. *v.* Featherstone, 49 F. R. 919, 1892.

[95] Page *v.* Buckley, 67 F. R. 142, 1895.

controversies touching letters patent for inventions. But the investigator will often need to resort to the standard text-books on estoppel, when seeking for the law applicable to such matters, as they may hereafter arise in patent litigation; for the instances in which the doctrines of estoppel have heretofore been applied to patent cases are comparatively few. Those doctrines may, however, be deduced from other kinds of causes, and then applied in patent litigation with all their inherent forces.[96]

§ 468. Estoppel by matter of record arises out of the doctrine of *res judicata;* and indeed that sort of estoppel generally and properly passes under the name of that doctrine. It is a requirement of public policy and of private peace, that each particular litigation shall duly come to an end, and that when once ended, it shall not be revived. The law therefore properly requires that things adjudicated shall not again be drawn in question between the same parties, or between any persons whose connection with the adjudication is such that it ought to bind them all.[97] But a person cannot invoke an adjudication, on the ground that he contributed money to or otherwise assisted in the litigation which produced it, unless that fact was known, at the time it occurred, to the party against whom the adjudication is sought to be invoked.[98]

[96] Duboise *v.* Railroad Co., 5 Fisher, 208, 1871.

[97] Hubbell *v.* United States, 171 U. S. 209, 1898; Bradley Mfg. Co. *v.* Eagle Mfg. Co., 57 F. R. 985, 1893; Westinghouse Electric & Mfg. Co. *v.* Stanley Electric Mfg. Co., 117 F. R. 309, 1902.

[98] Cramer *v.* Singer Mfg. Co., 93 F. R. 636, 1899; Lane *v.* Welds, 99 F. R. 287, 1899; Hanks Dental Ass'n *v.* International Tooth Crown Co., 122 F. R. 74, 1903; Penfield *v.* Potts & Co., 126 F. R. 475, 1903; Sacks *v.* Kufferle, 127 F. R. 569, 1904; Westinghouse Electric & Mfg. Co. *v.* Jefferson, etc., Co., 128 F. R. 751, 1904; Jefferson Electric, etc., Co. *v.* Westinghouse Electric, etc., Co., 139 F. R. 385, 1905; Foote *v.* Par-

This rule is based on the doctrine of mutuality of estoppel. Nor can a user invoke the doctrine when sued for infringement, even though the article has been held to be an infringement in a suit by the same complainant against the manufacturer who supplied the article to the user.[99] What circumstances will cause a third party assisting in a defence to be bound by a decree cannot be definitely stated. It has been held that mere payment of costs does not cause a manufacturer to be bound by a decree against a dealer where it does not appear that the attorney for the defendant was not under the exclusive control of the dealer.[100]

Interlocutory decrees furnish no foundation for a plea of *res judicata*.[101] And it is only in respect of questions actually litigated and decided in a prior case, that the judgment is conclusive in another action.[102]

A final decree is pleadable, in a subsequent action, notwithstanding the defendant may have new defences to interpose: defences, which he did not deem it necessary to make to the former suit, or did not learn of in time to set them up in the former litigation.[103] And final decrees or judgments are not only binding on the parties to the

sons Non-Skid Co., 196 F. R. 951, 1912.

[99] Eldred *v.* Breitwieser, 132 F. R. 251, 1904.

[100] General Electric Co. *v.* Morgan-Gardner Electro Co., 168 F. R. 52, 1908.

[101] Rumford Chemical Works *v.* Hecker, 2 Bann. & Ard. 359, 1876; Roemer *v.* Neumann, 26 F. R. 332, 1886; Morss *v.* Knapp, 37 F. R. 353, 1889; Harmon *v.* Struthers, 48 F. R. 260, 1891; Brush Electric Co. *v.* Western Electric Co., 76 F. R. 764, 1896; Stromberg Motor Devices Co. *v.* Zenith Carburetor Co., 220 F. R. 154, 1915.

[102] Bruise *v.* Peck, 54 F. R. 822, 1893; Mack *v.* Levy, 60 F. R. 751, 1894; Norton *v.* Jansen, 81 F. R. 505, 1897.

[103] Duboise *v.* Railroad Co., 5 Fisher, 210, 1871; Gloucester Isinglass Co. *v.* LePage, 30 F. R. 371, 1887; Bradley Mfg. Co. *v.* Eagle Mfg. Co., 57 F. R. 989, 1893; Mack *v.* Levy, 60 F. R. 752, 1894.

actions from which they resulted, but they are also conclusive against or for all persons who purchase interests in the subject-matter of litigation after such decrees or judgments are entered;[104] or even before such entry, if after the beginning of the action which resulted in those judgments or decrees;[105] and also against or for persons who openly assumed the control and expense of the former litigation, even though not parties thereto.[106] So, also, judgments by default, decrees *pro confesso*, and consent decrees are pleadable as *res judicata*, if they are final in their nature, with the same effect as are judgments or decrees which were rendered after long-contested litigations.[107] But final consent decrees are not pleadable against those who merely assume defence of the suit without becoming parties on the record, where the decree was entered without the consent of such parties.[108]

But in order to be binding on either party to a new action, a former judgment or decree must be binding on

[104] Consolidated Fruit Jar Co. *v.* Whitney, 2 Bann. & Ard. 33, 1875; Pennington *v.* Hunt, 20 F. R. 195, 1884; Norton *v.* San Jose Fruit-Packing Co., 79 F. R. 793, 1897; Newton Mfg. Co. *v.* Wilgus, 90 F. R. 484, 1898.

[105] Carroll *v.* Goldschmidt, 83 F. R. 509, 1897.

[106] United States Felting Co. *v.* Asbestos Felting Co., 4 F. R. 816, 1880; American Bell Telephone Co. *v.* National Telephone Co., 27 F. R. 665, 1886; Eagle Mfg. Co. *v.* Miller, 41 F. R. 357, 1890; Eagle Mfg. Co. *v.* Bradley Mfg. Co., 50 F. R. 193, 1891; Bradley Mfg. Co. *v.* Eagle Mfg. Co., 57 F. R. 985, 1893; National Folding-Box Co. *v.* Dayton Paper Novelty Co., 95 F. R. 991, 1899; D'Arcy *v.* Staples & Hanford Co., 161 F. R. 732, 1908; Gilchrist Co. *v.* Erie Specialty Co., 231 F. R. 659, 1916.

[107] Bradford *v.* Bradford, 5 Connecticut, 131, 1823; Davis *v.* Murphy, 2 Rich. (S. C.) 560, 1846; United States Packing Co. *v.* Tripp, 31 F. R. 350, 1887; Carroll *v.* Goldschmidt, 83 F. R. 509, 1897.

[108] Stromberg Motor Devices Co. *v.* Zenith Carburetor Co., 220 F. R. 154, 1914.

both.[109] No former adjudication is pleadable in favor of either party to a suit, unless it would have been pleadable against him, if it had been rendered the other way.[110] But a decree may be pleadable against a complainant, only on a single point in a subsequent case, though it would have been pleadable against the defendant on all the points in that case, if it had been rendered the other way; because to be rendered the other way, all those points would have to be decided for the complainant, whereas only one of those points might have to be decided against the complainant, in order to necessitate a decree for the defendant.[111] On the other hand, a decree may be pleadable for the complainant, only on the subject of the validity of his patent, and not upon the question of its infringement by the defendant.[112]

§ 469. Estoppel by matter of deed may also arise in patent affairs.[113] Where, for example, the alleged infringer has by contract admitted the validity of the patent and agreed not to infringe in the future,[114] or where an assignor or grantor of a patent right, afterward infringes the right which he conveyed, he is estopped by his conveyance from denying the plaintiff's title,[115] or the validity of the patent, when sued for its infringement,[116] even where the

[105] Mack *v.* Levy, 60 F. R. 752, 1894.

[110] Ingersoll *v.* Jewett, 16 Blatch. 378, 1879; Dale *v.* Rosevelt, 1 Paige (N. Y.), 35, 1828; Paynes *v.* Coles, 1 Munford (Va.), 394, 1810; Greene *v.* City of Lynn, 55 F. R. 522, 1893.

[111] Steam Gauge & Lantern Co. *v.* Meyrose, 27 F. R. 213, 1886.

[112] Bradley Mfg. Co. *v.* Eagle Mfg. Co., 57 F. R. 988, 1893.

[113] On the question of such an estoppel in favor of purchasers from trustees in bankruptcy, receivers and the like, see Section 290 of this book.

[114] American Specialty Stamping Co. *v.* New England Enamelling Co., 178 F. R. 106, 1910.

[115] Woodward *v.* Lasting Mach. Co., 60 F. R. 284, 1894.

[116] Consolidated Middlings Purifier Co. *v.* Guilder, 9 F. R.

invalidity is due to an unlawful reissue obtained after the assignment,[117] and even though the assignee at the time of the assignment knew of the defects which rendered the patent invalid,[118] and even though the assignor had been induced to part with his title on fraudulent representation by the assignee.[119] This is likewise true of strangers who are co-operating with him in the infringement;[120] and also of a corporation which is merely an incorporation of the assignor;[121] or an incorporation of the assignor, and strangers in collusion with him even though some of the minor stockholders are innocent;[122] and also of one who, although he had no interest in the title to the patent nevertheless receives for his own benefit a portion

156, 1881; Adee *v.* Thomas, 41 F. R. 345, 1890; Corbin Lock Co. *v.* Yale & Towne Mfg. Co., 58 F. R. 565, 1893; Martin & Hill Cash Carrier Co. *v.* Martin, 67 F. R. 787, 1895; National Conduit Co. *v.* Connecticut Pipe Mfg. Co., 73 F. R. 491, 1896; Daniel *v.* Miller, 81 F. R. 1000, 1897; Griffith *v.* Shaw, 89 F. R. 313, 1898; Smith *v.* Ridgely, 103 F. R. 875, 1900; Force *v.* Sawyer-Boss Mfg. Co., 111 F. R. 902, 1901; Consolidated Rubber Tire Co. *v.* Finley Rubber Tire Co., 116 F. R. 629, 1902; Continental Wire Fence Co. *v.* Pendergast, 126 F. R. 381, 1903; Automatic Switch Co. *v.* Monitor Mfg. Co. (discussing question and collating authorities in various circuits), 180 F. R. 983, 1910.

[117] Burdsall *v.* Curran, 31 F. R. 919, 1887.

[118] Peele Co. *v.* Raskin, 194 F. R. 440, 1912.

[119] Vacuum Engineering Co. *v.* Dunn, 209 F. R. 219, 1913.

[120] Continental Wire Fence Co. *v.* Pendergast, 126 F. R. 381, 1903; Frank *v.* Bernard, 131 F. R. 269, 1904; Climax Lock & Ventilator Co. *v.* Ajax Hardware Mfg. Co., 192 F. R. 126, 1911; Mellor *v.* Carroll, 141 F. R. 992, 1905.

[121] Siemens Halske Electric Co. *v.* Duncan Electric Mfg. Co., 142 F. R. 157, 1905; Matthews Gravity Co. *v.* Lister, 154 F. R. 490, 1906; Automatic Switch Co. *v.* Monitor Mfg. Co., 180 F. R. 983, 1910; Onondago Indian Wigwam Co. *v.* Ka-Noo-No Indian Mfg. Co., 182 F. R. 832, 1910.

[122] Mellor *v.* Carroll, 141 F. R. 992, 1905.

of the proceeds of the sale of the patent.[123] But the estoppel does not extend to a stranger merely because the patentee or a previous owner is in the employ of the former,[124] unless the employment was for the purpose of designing a device which would avoid infringement—in which event if infringement is found the estoppel applies;[125] nor to a corporation which took over the business in good faith without special reference to the patent.[126]

Where a stranger is charged with the estoppel it must be a case of actual co-operation between him and the assignor, since, if he makes the infringing article merely on the order of the assignor he is not estopped, at least as to more than the particular machine which he made.[127] Nor does the estoppel extend to a corporation which employs the assignor to make for it articles under an improvement patent of the assignor even though the corporation knew of the assignment of the original patent and even though the corporation is utilizing the improvement patent under royalties.[128] But such an assignor or grantor is not estopped, by his conveyance, from showing how narrowly the patent must be construed,[129] except

[123] Johnson Furnace & Eng. Co. *v.* Western Furnace Co., 178 F. R. 819, 1910.

[124] Babcock & Wilcox Co. *v.* Toledo Boiler Works Co., 170 F. R. 81, 1909.

[125] Mergenthaler Linotype Co. *v.* International Typesetting Machine Co., 229 F. R. 168, 1914.

[126] Macey Co. *v.* Globe-Wernicke Co., 180 F. R. 401, 1910.

[127] Roessing-Ernst Co. *v.* Coal & Coke By-Products Co., 208 F. R. 990, 1913.

[128] Trussed Concrete Steel Co. *v.* Corrugated Bar Co., 214 F. R. 393, 1913.

[129] Babcock *v.* Clarkson, 63 F. R. 607, 1894; Western Telephone Construction Co. *v.* Stromberg, 66 F. R. 551, 1895; Martin Cash Carrier Co. *v.* Martin, 67 F. R. 787, 1895; Missouri Lamp & Mfg. Co. *v.* Stempel, 75 F. R. 583, 1896; Noonan *v.* Chester Park Athletic Club Co., 99 F. R. 90, 1900; Alvin Mfg. Co. *v.* Scharling, 100 F. R. 87, 1900; Smith *v.* Ridgely, 103 F. R. 875,

to the extent to which he may have made representations as to the scope of the patent as an inducement to the sale.[130] He may not, however, introduce evidence ostensibly for that purpose, but which in fact tends to show that the patent is invalid.[130] The assignor is not, however, estopped from testifying in derogation of the patent in a suit by the assignee against a third party.[131]

§ 470. The defence of estoppel requires a special plea to introduce it into a litigation. Thus, for example, if a former judgment or decree is not pleaded as an estoppel by a defendant, he refers the merits of the controversy anew to the court. The former adjudication may be used as an argument, but it cannot be relied upon as a bar, unless it is set up in a special plea.[132]

§ 471. The twenty-seventh defence may be made by demurrer,[133] but if not so interposed it must always be

1900; Hurwood Mfg. Co. *v.* Wood, 138 F. R. 835, 1905; National Recording Safe Co. *v.* International Safe Co., 158 F. R. 824, 1908; Johns-Pratt Co. *v.* Sachs Co., 175 F. R. 70, 1909; Leather Grille & Drapery Co. *v.* Christopherson, 182 F. R. 817, 1910; Rollman Mfg. Co. *v.* Universal Hardware Works, 207 F. R. 97, 1913; Standard Plunger Elevator Co. *v.* Stokes, 212 F. R. 941, 1914; Crown Cork & Seal Co. *v.* Carper-Automatic, etc., Co., 229 F. R. 748, 1915; Automatic Switch Co. *v.* Monitor Mfg. Co. (collating authorities on the point in various circuits), 180 F. R. 983, 1910; *contra*, Siemens Halske Electric Co. *v.* Duncan Electric Mfg. Co., 142 F. R. 157, 1905.

[130] Cross Paper Feeder Co. *v.* United Printing Machine Co., 220 F. R. 313, 1915; Automatic Switch Co. *v.* Monitor Mfg. Co. (discussing doctrine of estoppel in this connection), 180 F. R. 983, 1910; United Printing Machine Co. *v.* Cross Paper Feeder Co., 227 F. R. 600, 1915.

[131] DeLaval Separator Co. *v.* Vermont Farm Mach. Co., 135 F. R. 772, 1904. But see Siemens Halske Co. *v.* Duncan, 142 F. R. 157, 1905.

[132] 1 Chitty on Pleading, 509.

[133] Brickill *v.* Hartford, 49 F. R. 373, 1882.

Contra, Peters *v.* Hangar, 134 F. R. 586, 1904.

specially pleaded by the defendant, or it will be disregarded by the court.[134] No defendant can avail himself of any statute of limitation, upon the general issue.[135]

§ 472. A national statute of limitation for patent suits, has been in existence and in force since the beginning of 1898. That statute provides that there shall be no money recovery in any such suit, for any infringement committed more than six years before the beginning of such an action.[136]

§ 476. State statutes of limitation can never apply to any right of action under a patent, if that particular right is subject to the running of a national statute of limitations.[137] This point of law follows from the fact that the States have no right to control the operation of the patent laws;[138] and from the fact that Congress never adopted State laws for the government of Federal courts in any case where the constitution, treaties or statutes of the United States specially attend to the subject.[139]

§ 477. State statutes of limitation, on actions based on torts unaccompanied by force, apply to such actions for infringements of patents, as are not subject to any national statute of limitation.[140]

§ 477*a*. The twenty-eighth defence may be raised by

[134] 1 Chitty on Pleading, 498.

[135] Neale *v.* Walker, 1 Cranch's Circuit Court Reports, 57, 1802.

Contra, Peters *v.* Hangar, 134 F. R. 586, 1904.

[136] 29 Statutes at Large, p. 694, Ch. 391, Section 6.

[137] Sayles *v.* Oregon Central Railroad Co., 4 Bann. & Ard. 429, 1879; Hayden *v.* Oriental Mills, 22 F. R. 103, 1884; May *v.* County of Logan, 30 F. R. 256, 1887.

[138] M'Culloch *v.* Maryland, 4 Wheaton, 436, 1819.

[139] Revised Statutes, Section 721; Section 34 of the Judiciary Act of 1789; 1 Statutes at Large, Ch. 20, p. 92.

[140] Campbell *v.* Haverhill, 155 U. S. 613, 1895.

answer, unless the illegality appears on the face of the patent.[141]

§ 478. Replications and subsequent pleadings are seldom required in patent cases, because, most of the pleas applicable to such cases are pleas in bar by way of traverse, and not by way of confession and avoidance.[142] The principal exceptions are the plea of a license, the plea of a release, and the plea of a statute of limitation. If the plaintiff purposes to deny the existence of a license or release, as the case may be, his replication should be by way of traverse to the plea, and should conclude to the country, and thus tender issue. So, also, if the plaintiff can show that the license or release covered only a part of the infringement covered by the declaration, the general replication by way of traverse will be sufficient.[143] If the plaintiff cannot deny the existence of a full paper, but purposes to show that it was obtained by duress or by fraud, or that it has been effectually revoked, his replication will state the facts by way of confession and avoidance of the plea, and will conclude with a verification. It will then be the duty of the defendant to file a rejoinder to the replication. If he can deny the duress, or the fraud, or the revocation, as the case may be, his rejoinder will be by way of traverse, and will conclude by tendering issue. If, however, he cannot deny the truth of the replication, but can avoid its effect by showing that the plaintiff freely ratified the license or release after the alleged duress terminated, or the alleged fraud became known to him, or that he annulled the revocation after making it, then the defendant's rejoinder will be by way of confession and avoidance, and will conclude with a

[141] Weston Electrical Inst. Co. *v.* Empire Electrical Inst. Co., 136 F. R. 599, 1905.

[142] Brickill *v.* Hartford, 57 F. R. 219, 1893.

[143] 1 Chitty on Pleading, 596.

verification, and will render necessary a sur-rejoinder from the plaintiff, denying the truth of the rejoinder, and putting himself upon the country.

§ 481. A similiter must be filed or added by or on behalf of the other party, whenever either the plaintiff or defendant properly tenders issue. As the party to whom issue is well tendered, has no option but to accept it, the similiter may be added for him. It is a mere matter of form, but it is a form which should always be attended to in common-law pleading. Its omission has sometimes constituted a fatal defect.[144]

§ 482. A demurrer may be interposed by either party in an action at law, to any pleading of his opponent, except another demurrer.[145] When a demurrer is interposed, the court will examine all the pleadings in the case, and will generally decide against the party who first filed a substantially defective one.[146] The principal exception to this rule is, that where the declaration is the pleading demurred to, the demurrer will not be sustained if it is too large; that is, if it is pointed at an entire declaration, some independent part of which is good in law.[147] This exception does not apply to demurrers to pleas,[148] or replications,[149] or rejoinders,[150] for it is in the nature of those pleadings to be entire, and if bad in part, to be bad for the whole.

§ 483. Demurrable declarations occur in patent cases when the patent appears to be void on its face, or by reason of some fact within judicial notice; or when the plaintiff's pleader omits some of the allegations which are necessary

[144] Earle *v.* Hall, 22 Pickering (Mass.), 102, 1839.

[145] 1 Chitty on Pleading, 661, 666.

[146] 1 Chitty on Pleading, 668.

[147] 1 Chitty on Pleading, 665.

[148] 1 Chitty on Pleading, 546.

[149] 1 Chitty on Pleading, 644.

[150] 1 Chitty on Pleading, 651.

parts of such a pleading; or when he makes those allegations in improper form; or where he makes the statement of infringement cover a space of time, part or all of which is remote enough to be barred by the statute of limitation. It will rarely occur that the whole of an infringement declared upon can plausibly be claimed to be thus barred; but it may not be unknown for declarations to allege that the infringement sued on began at a point of time more than six years before the beginning of the action, and was continued till after that limit was passed. If, in such a case, the defendant would interpose the statute of limitation to that part of the infringement which occurred more than six years before the bringing of the suit, he may do so by a special demurrer aimed at the questionable part of the right of action. If, in such a case, he demurs generally to the whole declaration, his demurrer will be overruled, because it will appear on the argument that an independent, divisible part of the right of action sued upon is unbarred by the statute.[151]

§ 484. Demurrable pleas occur in patent cases whenever the facts stated therein constitute no defence to the action; or when they are in improper form; or when the statute of limitation is pleaded to the whole of a right of action, only a part of which is old enough to be barred thereby; for a plea which is bad in part, is bad altogether.[152]

§ 486. A joinder in demurrer is the proper response to such a pleading in a patent action, as well as any other. If a plaintiff attempts to demur to a demurrer, or refuses to join issue of law upon it, he thereby discontinues his action; and if a defendant does so he discontinues his defence.[153] But the actual filing in writing of a joinder in

[151] 1 Chitty on Pleading, 665.
[152] 1 Chitty on Pleading, 546.
[153] Gould's Pleadings, Ch. IX, Section 33; 1 Chitty on Pleading, 169.

demurrer is generally waived, and demurrers are generally brought on for argument without that formality.

When a demurrer to an entire declaration is sustained, on a ground which cannot be cured by amendment, the plaintiff may file an exception, and take the case to the Circuit Court of Appeals for a review of the decision upon the demurrer; and he must do so, or abandon his action. But where a demurrer to a declaration is overruled, the defendant may either file an exception and take the case to the Circuit Court of Appeals for review, or may obtain leave of court to file a plea to the declaration. If he takes the latter course, he cannot set up in that plea any defence which was set up in the overruled demurrer. And if his other defences fail on the trial, and he afterward takes the case to the Circuit Court of Appeals, he cannot get a review of the decision of the District Court overruling his demurrer to the declaration. For this reason, it is not wise to trust any vital defence to the carriage of a demurrer, except where the defendant has no other vital defence, or except where he is certain that his demurrer will not be overruled.

Where a demurrer to a plea is sustained, on a ground which cannot be cured by amendment, the defendant may file an exception, and take the case to the Circuit Court of Appeals for a review of the decision upon the demurrer; or he may go to trial upon any other plea which he may have filed, and which has not been demurred to, or has repelled a demurrer. If he takes the latter course, and is beaten on the trial, and afterward takes the case to the Circuit Court of Appeals, he ought, in that tribunal, to get a review of the decision of the District Court sustaining the demurrer to his plea; for he could not prevent the filing of that demurrer, and without such a review can get no appeal from the decision of the District Court sustain-

ing it. But where a demurrer to a plea is overruled, the plaintiff must stand by that demurrer, and take the case to the Circuit Court of Appeals upon that issue alone, or if he goes to trial without doing so, he will thereby waive his demurrer; and if he is unsuccessful on the trial, and thereafter takes the case to the Circuit Court of Appeals, he cannot secure in that court a review of the decision of the court below, overruling his demurrer to the plea.

§ 487. The trial of an action at law for infringement of a patent may be by a jury, or by a judge, or by a referee. The first of these sorts of trial is the only proper one, except in cases where both parties agree to substitute one of the others. Cases of the kind may be tried by the judge, where the parties file with the clerk a stipulation in writing waiving a jury;[154] and trial by a referee appointed by the court, with the consent of both parties, is a mode of trial fully warranted by law.[155]

§ 488. Trial by jury must, in the absence of contrary consent by the parties, be by a jury of twelve men. Unanimity is necessary to a verdict of a jury in a Federal court, even in California or Nevada; though the statutes of those States provide that in their courts, a legal verdict may be found when three-fourths of the members of a jury agree. The laws of those States on that point are not covered by Section 721 of the Revised Statutes, and so made rules of decision in Federal courts; because the Federal Constitution otherwise provides. That provision is found in its seventh amendment, and in the following language: "In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved." It is true that unanimity was not necessary to the verdicts of juries in England till

[154] Revised Statutes, Section 649.

[155] Heckers *v.* Fowler, 2 Wallace, 123, 1864.

after the reign of Edward the First,[156] and that it was never required in Scotland.[157] But the kind of "trial by jury," known in England and in the United States when the seventh amendment was proposed by Congress,[158] and when it was ratified by three-fourths of the States,[159] is doubtless the kind of trial guaranteed by that amendment.[160] Therefore, no law providing for any other kind of trial by jury can be enforced in a United States court.

§ 489. The practice in actions at law in the Federal courts is not uniform throughout the United States. There are no general rules governing the District Courts when sitting as law courts. When thus sitting, each District Court is governed, in matters of practice, by the laws of the State in which it is established, so far as those laws are applicable; [161] and on points where no law exists, it is governed by rules or customs of its own making or observance. No Act of Congress is necessary to enable a United States court to make and enforce its own rules of practice. It is only necessary that such rules be not repugnant to the laws of the United States.[162]

§ 490. The rules of evidence which are used in the trial of patent causes are the ordinary rules of the common law, as modified by the statutes of the particular States in which such trials occur,[163] and as adapted to the circum-

[156] Bracton, Liber IV, Ch. 19; Fleta, Liber IV, Ch. 9; Britton, Liber II, Ch. 21.

[157] Barrington on the Statutes, Ch. 29, p. 20; 17 & 18 Victoria, Ch. 59; 22 & 23 Victoria, Ch. 7; 31 & 32 Victoria, Ch. 100, Section 48.

[158] September 25, 1789.

[159] November 3, 1791.

[160] Thompson *v.* Utah, 170 U. S. 349, 1898.

[161] Revised Statutes, Section 914.

[162] Heckers *v.* Fowler, 2 Wallace, 123, 1864.

[163] Vance *v.* Campbell, 1 Black, 427, 1861; Hausknecht *v.* Claypool, 1 Black, 431, 1861; Wright *v.* Bales, 2 Black, 535, 1862.

stances of patent litigation by the decisions of the United States courts.

§ 491. Evidence to support his declaration must of course be introduced by a plaintiff in a patent suit before the defendant can be called upon to prove any defence. Where the complainant or the defendant is a corporation, and that fact is not admitted in the defendant's plea, it must be proved by the plaintiff; and it may be proved by a certified copy of its charter or articles of incorporation. Aside from that preliminary matter, the first item of the plaintiff's evidence consists of the letters patent sued upon, or of a written or printed copy of the same, authenticated by the seal and certified by the Commissioner or the Acting Commissioner of the Patent Office.[164] Either the letters patent, or such a copy thereof, is *prima facie* evidence of the validity of the letters patent, unless it appears on its face not to be such a form of document as the statute prescribes.[165] This presumption is strengthened by the circumstance that the alleged anticipating patent was considered by the Patent Office in connection with the application for the patent in suit.[166] And the presumption is weakened by the circumstance that closely

[164] Revised Statutes, Section 892.

[165] Hunt Bros. Fruit Packing Co. *v.* Cassidy, 53 F. R. 259, 1892; Singer Mfg. Co. *v.* Brill, 54 F. R. 383, 1892; Holloway *v.* Dow, 54 F. R. 514, 1893; Harper & Reynolds Co. *v.* Wilgus, 56 F. R. 588, 1893; Chase *v.* Fillebrown, 58 F. R. 376, 1893; Schwarzwaelder *v.* Detroit, 77 F. R. 889, 1896; J. J. Warren Co. *v.* Rosenblatt, 80 F. R. 540, 1897; Wilkins Shoe-Button Fastener Co. *v.* Webb, 89 F. R. 996, 1898; Consolidated R'y Co. *v.* Adams & Westlake Co., 161 F. R. 343, 1908; San Francisco Cornice Co. *v.* Beyrle, 195 F. R. 516, 1912; Consolidated Contract Co. *v.* Hassan Paving Co., 227 F. R. 436, 1915.

[166] Hale & Kilburn Mfg. Co. *v.* Oneonta, etc., R'y Co., 129 F. R. 598, 1904; Beckwith *v.* Malleable Iron Range Co., 174 F. R. 1001, 1910; New Jersey Wire Cloth Co. *v.* Buffalo Expanded Metal Co., 131 F. R. 265, 1904.

similar prior references were not interposed or considered by the Office in the prosecution of the application.[167] But the printed memorandum, which is usually made at the head of the specification of a patent, and which states the date of the filing of the application for that patent, is not even *prima facie* evidence of that date.[168] That point, if it is material in a particular case, must be proved by a certified copy of the application itself. The letters patent themselves are also conclusive as against collateral attack in an infringement suit that all formal requisites to issuance have been complied with, except such as may appear on the face of the patent.[169]

§ 492. Reissue letters patent are also *prima facie* evidence of their own validity, on all of the three points which are involved in that question. They are so in respect of the fifteenth defence; because the fact that the Commissioner assumed jurisdiction, by treating the original letters patent as a proper subject for a reissue, is at least *prima facie* evidence that he had jurisdiction.[170] They are so in respect of the sixteenth defence; because the presumption is that the Commissioner knew the law, and, knowing it, would not grant a broadened reissue after a long lapse of time from the date of the original.[171] They are so in respect of the seventeenth defence; because the presumption is that the Commissioner would not violate the law, by granting a reissue for a different invention from any which

[167] American Soda Fountain Co. *v.* Sample, 130 F. R. 145, 1904; Westinghouse Electric & Mfg. Co. *v.* Toledo, P. C. & L. R'y Co., 172 F. R. 371, 1909; Elliott & Co. *v.* Youngstown Car Mfg. Co., 181 F. R. 345, 1910.

[168] International Terra Cotta Co. *v.* Maurer, 44 F. R. 620, 1890; See Section 129 of this book.

[169] Wayne Mfg. Co. *v.* Coffield Motor Washer Co., 227 F. R. 987, 1915.

[170] Brooks *v.* Bicknell, 3 McLean, 258, 1843.

[171] Clark *v.* Wooster, 119 U. S. 326, 1886.

the original letters patent shows was intended to have been claimed therein.

§ 494. It is an undoubted presumption of law that letters patent, which appear on their face to be in full force, are so in fact. Such a document is therefore *prima facie* evidence that it neither has been repealed by a decree of court, nor has expired because of the expiration of some foreign patent for the same invention. It follows that neither the nineteenth nor twentieth defence needs to be anticipated by a plaintiff when introducing his *prima facie* evidence.

§ 495. After introducing the letters patent in evidence, unless the plaintiff is himself the patentee, his next step is to prove his title to the right, upon the infringement of which the action is based. Where the letters patent were originally granted to an assignee of the inventor, they are *prima facie* evidence of title in that assignee.[172] But where the plaintiff obtained his title after the letters patent were granted, he must prove himself to have been the assignee of the patent, or at least a grantee under it as to the territory wherein the alleged infringement occurred, when that infringement occurred. He may do either of these, by properly introducing in evidence the original assignments or grants which constitute his chain of title.

Where such a document was acknowledged before a notary public, or other magistrate specified in the statute, the certificate of that acknowledgment is *prima facie* evidence of the execution of the document.[173] In the absence of such an acknowledgment, it is necessary to prove

[172] Whitcomb *v.* Coal Co., 47 391, Section 5, p. 693; De Laval F. R. 655, 1891; Elliott-Fisher Co. *v.* Underwood Typewriter Co., 176 F. R. 372, 1909.

[173] 29 Statutes at Large, Ch. Separator Co. *v.* Vermont Farm-Mach. Co., 109 F. R. 813, 1901; Lanyon Zinc Co. *v.* Brown, 115 F. R. 154, 1902.

such a paper according to the rules of the common law. When proceeding under those rules, to prove a paper which appears to have been subscribed by a witness, as well as by the grantor or assignor, the first step is to produce that witness, and take his testimony to the fact and the genuineness of his signature; or if he cannot be produced, the first step consists in proving, if possible, what has become of him, and if that is impossible, in proving that fact.[173a] When this step has been taken, and also where there is no subscribing witness to the document to be proved, it can be proved by testimony of the genuineness of the signature of him who executed it, as assignor or grantor, as the case may be. Where an original assignment or grant, which is essential to the plaintiff's title, cannot be produced, its character may be proved according to the rules of the law of evidence relevant to such cases.

Whether a certified copy of the Patent Office record of an assignment or grant of a patent is admissible evidence of the original document or of the Patent Office record thereof, is a question which was long ago decided in the affirmative,[174] and afterward was decided in the negative,[175] and then in the affirmative again,[176] and finally again in the negative.[177] Assuming the negative decisions to be

[173a] This is the old common-law rule. In most jurisdictions it will be found to have been abrogated either by statute or judicial decision. See Wigmore on Evidence. Sections 1290 *et seq.*

[174] Brooks *v.* Jenkins, 3 McLean, 436, 1844; Parker *v.* Haworth, 4 McLean, 370, 1848; Lee *v.* Blandy, 2 Fisher, 91, 1860; Dederick *v.* Whitman Agricultural Co., 26 F. R. 763, 1886; National Folding Box & Paper Co. *v.* American Paper Pail & Box Co., 55 F. R. 488, 1893.

[175] Paine *v.* Trask, 56 F. R. 233, 1893; Mayor of New York *v.* American Cable Ry. Co., 60 F. R. 1016, 1894.

[176] Standard Elevator Co. *v.* Crane Elevator Co., 76 F. R. 792, 1896.

[177] National Cash Register Co. *v.* Navy Cash Register Co., 99

right, it seems that the inadmissibility of such a certified copy is waived by an omission to make a proper objection when such a copy is offered in evidence.[178]

§ 496. It is not necessary for any plaintiff to prove in his *prima facie* evidence that the defendant has no license or release with which to defend.[179] But it is required of him to prove that he never made nor sold any specimen of the invention without marking it "patented," together with the day and year the patent was granted; or that the defendant was duly notified that his doings constituted an infringement of the patent, and, after such notice, continued to infringe.[180]

The requirements of the statute providing for marking must be strictly complied with and where a patented device is part of a complete structure the marking must be on the patented device itself, or, where such a method of marking cannot be followed, on a package, or label.[181]

§ 497. Proof of the making, selling, or using, by the defendant, before the beginning of the suit, of a specimen or specimens of a process or thing which the plaintiff claims is covered by his patent, constitutes the next step to be taken in proving a *prima facie* case. This point is often covered by a stipulation of the parties. In the absence of such a stipulation the point of proof may be one

F. R. 89, 1900; American Graphophone Co. *v.* Leeds & Catlin Co., 140 F. R. 981, 1905; Eastern Dynamite Co. *v.* Keystone Powder Mfg. Co., 164 F. R. 47, 1908; Johnston *v.* Southern Well Works Co., 208 F. R. 145, 1913.

[178] International Tooth-Crown Co. *v.* Bennett, 72 F. R. 170, 1896; A. B. Dick Co. *v.* Henry, 75 F. R. 388, 1896.

[179] Fischer *v.* Hayes, 6 F. R. 79, 1881.

[180] Dunlap *v.* Schofield, 152 U. S. 244, 1894; Traver *v.* Brown, 62 F. R. 933, 1894; Matthews & Willard Mfg. Co. *v.* National Brass & Iron Works, 71 F. R. 518, 1895; Campbell *v.* City of New York, 81 F. R. 184, 1897.

[181] Lichtenstein *v.* Phipps, 168 F. R. 61, 1909.

of difficulty, for courts of law have no power to order inspections of a defendant's works; [182] though the defendant may be called as a witness, and compelled to describe what he has done; [183] and a discovery of the defendant's doings may be obtained by a bill in equity filed in aid of an action at law.[184] Where a defendant cannot be relied upon to testify fairly and fully, the plaintiff must secure other evidence; for it is necessary to a verdict in an action at law for an infringement of a patent, that both the nature and extent of that infringement be shown to the jury by satisfactory proof. Evidence of the nature of a defendant's doings is the first element of evidence of infringement; and evidence of their extent is an indispensable part of the necessary evidence of damages.[185]

§ 498. Evidence of infringement is completed with evidence of the defendant's doings, if what he did was obviously and unquestionably identical with what is covered by the patent in suit,[186] or if he is estopped from denying identity between those doings and that patent.[187] And even where differences are apparent, the complainant, if he chooses, may rest when he has introduced evidence or a stipulation stating the character of the acts done by the defendant. In that case the court will interpret the words of the patent in the sense in which they are ordi-

[182] Parker *v.* Bigler, 1 Fisher, 287, 1857.

[183] Roberts *v.* Walley, 14 F. R. 169, 1882; Delamater *v.* Reinhardt, 43 F. R. 76, 1890.

[184] Colgate *v.* Compagnie Francaise, 23 F. R. 85, 1885.

[185] National Car-Brake Shoe Co. *v.* Mfg. Co., 19 F. R. 519, 1884.

[186] Jennings *v.* Kibbe, 10 F. R. 669, 1882; Barrett *v.* Hall, 1 Mason, 471, 1818; Hayes *v.* Bickelhoupt, 23 F. R. 184, 1885; Freese *v.* Swartchild, 35 F. R. 141, 1888; Sugar Mfg. Co. *v.* Yaryan Mfg. Co., 43 F. R. 148, 1890; Hardwick *v.* Masland, 71 F. R. 889, 1895; McDowell *v.* Kurtz, 77 F. R. 207, 1896.

[187] Time Telegraph Co. *v.* Himmer, 19 F. R. 322, 1884.

narily employed, and, with the knowledge of the invention thus acquired, will determine whether the acts done by the defendant amount to infringement.[188] But judges do not always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, and are not always able to accurately weigh similarities and differences in mechanics, chemistry, electricity, or other physics, without receiving special information thereon. Therefore it is always proper and generally necessary to introduce expert testimony to show that the differences are all immaterial, and to show that the defendant's doings actually did constitute an infringement of the plaintiff's patent.[189]

Experts in patent cases are mainly experts in mechanics, chemistry, or electricity; and a man who has extensive theoretical and practical knowledge of either of those sciences, is a mechanical, chemical, or electrical expert, as the case may be; and a man may be an expert in any other science, who possesses the same qualifications in it. The opinions of such experts are admissible upon the points of fact to which they are relevant; but in order to have much weight, they must be accompanied by statements of good reasons upon which they are based.[190] The expert may testify as to experiments that he has made to test the theory of the patent and the claim of infringement, although a number of judges have commented on the weakness of such testimony when the experiments were conducted under such conditions that the opposing

[188] American Linoleum Co. *v.* Nairn Linoleum Co., 44 F. R. 756, 1890.

[189] Overweight Elevator Co. *v.* Improved Order of Red Men, 94 F. R. 161, 1899.

[190] United States Annunciator Co. *v.* Sanderson, 3 Blatch. 184, 1854; Livingston *v.* Jones, 1 Fisher, 521, 1859; Conover *v.* Rapp, 4 Fisher, 57, 1859; Norton *v.* Jensen, 49 F. R. 864, 1892; Briggs *v.* Central Ice Co., 54 F. R. 379, 1892.

party was not allowed to observe them.[191] An expert may properly write out in advance, the testimony he intends to give; but he cannot properly adopt and insert in his deposition, or read in open court as his testimony, any exposition of the subject which was written by another man.[192] Communications between expert witnesses and the parties or the counsel who employ them, are not privileged,[193] and therefore it is proper on cross-examination to ascertain and record the origin and the development of the opinions which such witnesses state in their depositions or oral testimony.

In deciding between contradictory expert testimony, juries should consider the respective reasons, ability, knowledge, and fairness of the experts.[194] To judge according to their number or their fame would be unsafe. The wealthier litigants are generally those who employ the more numerous and the more expensive expert witnesses; but it is not always the wealthier litigant who is right in a controversy, nor always the more famous expert who is right in his opinion. The carefully digested

[191] Rynear Co. *v.* Evans, 83 F. R. 696, 1897; Plunger Elevator Co. *v.* Standard Plunger Elevator Co., 165 F. R. 906, 1908; Bethlehem Steel Co. *v.* Niles-Bement-Pond Co., 166 F. R. 880, 1909; Bemis *v.* Charles A. Stevens & Bros., 177 F. R. 717, 1910; Chadeloid Chemical Co. *v.* Wilson Remover Co., 220 F. R. 681, 1915.

[192] Emerson Co. *v.* Nimocks, 88 F. R. 282, 1898.

[193] Lalance & Grosjean Mfg. Co. *v.* Haberman Mfg. Co., 87 F. R. 564, 1898.

[194] Johnson *v.* Root, 1 Fisher, 351, 1858; Many *v.* Sizer, 1 Fisher, 17, 1849; Hudson *v.* Draper, 4 Fisher, 256, 1870; Page *v.* Ferry, 1 Fisher, 298, 1857; Carter *v.* Baker, 1 Sawyer, 512, 1871; Spaulding *v.* Tucker, Deady, 649, 1869; Cahoon *v.* Ring, 1 Cliff. 592, 1861; Cox *v.* Griggs, 1 Bissell, 362, 1861; Conover *v.* Roach, 4 Fisher, 12, 1857; Whipple *v.* Mfg. Co., 4 Fisher, 29, 1858; Conover *v.* Rapp, 4 Fisher, 57, 1859; Waterbury Brass Co. *v.* New York Brass Co., 3 Fisher, 43, 1858; Bierce *v.* Stocking, 11 Gray (Mass.), 174, 1858.

views of a young and studious scientist, may be more nearly true than the more hastily formed opinion of a more distinguished man. And testimony based on experience is more weighty than testimony based on the theoretical consideration.[195]

§ 499. No expert can know whether a particular thing, done or made by a defendant, is the same as anything covered by a particular patent, until he ascertains what that patent covers. But the latter question is one of construction for the court, and not a question of evidence, to be sworn to by an expert, and decided by the jury.[195a] In the regular course of proceedings in trials at law, as well as in hearings in equity, the construction of the patent is not announced by the judge till after the evidence is taken. This practice makes it proper to put hypothetical questions to expert witnesses. The hypothesis in such a question is one which embodies that construction of the patent upon which the examining counsel thinks it both safe and sufficient to rely. If, when charging the jury, the judge gives a different construction from that embodied in the hypothetical question, then the answer to that question will be seen to be immaterial, and the jury will do right to disregard it. Examining counsel ought therefore to be very certain that his hypothetical construction is the true one; or otherwise, to put as many hypothetical questions as there are probable favorable constructions. Doing the latter, he may have a favorable answer upon which to argue to the jury, if he secures from the judge a construction which corresponds with either of his hypothetical questions. A statement of a witness that a particular thing does or does not infringe a particular patent, is inadmissible in evidence, because that statement in-

[195] Young *v.* Wolfe, 120 F. R. 958, 1903.

[195a] See Section 500.

cludes a construction of the patent, and construction of patents is the duty of courts, and not of experts.[196]

§ 500. Though not permitted to testify to the construction of a patent,[197] experts are sometimes called upon to testify to facts which positively control that construction.[198] Where the state of the art is the subject of inconsistent evidence, and where the construction of the patent depends on what is the fact in that regard, the judge will not charge the jury that the patent means thus and so, but will tell them that if they find the state of the art to be so and so, then the patent is entitled to such and such a construction.[199] In cases of this kind it may occur that the jury, in deciding upon the state of the art, must receive information from experts relevant to the mechanical nature of prior things,[200] as well as information from other sources relevant to the prior existence of those things. Generally speaking all questions of similarities or of differences between things, are questions for the jury in an action at law,[201] and are therefore proper to be testified about by experts.[202] Where a patent covers such of the things described, as perform a particular function, it is the business of the jury to decide, and therefore proper for an expert to testify, which those things are.[203] And in general all issues of fact including the issues of abandonment, invention and infringement are for the jury to de-

[196] Marsh *v.* Stove Co., 51 F. R. 203, 1892; Holmes *v.* Truman, 67 F. R. 545, 1895.

See Section 189.

[197] Waterbury Brass Co. *v.* New York Brass Co., 3 Fisher, 54, 1858.

[198] Marsh *v.* Stove Co., 51 F. R. 203, 1892.

[199] Burdell *v.* Denig, 92 U. S. 722, 1875.

[200] McKay & Copeland Mach. Co. *v.* Claflin, 58 F. R. 354, 1893.

[201] Tyler *v.* Boston, 7 Wallace, 327, 1868.

[202] Myers *v.* Sternheim, 97 F. R. 625, 1899.

[203] Silsby *v.* Foote, 14 Howard, 218, 1852.

cide and their findings on these issues will not be disturbed unless against the weight of evidence.[204]

An exception to this rule is where the defendants' device is made under a patent and the court is able from mere comparison to comprehend what are the inventions described in each patent involved in the action. In such case the question of infringement is solely one of law for the court to determine.[205]

Though not permitted to testify directly on any question of infringement, experts are permitted to testify on points of fact which control the answers to such questions. For example, where a question of infringement depends on comparative mode of operation, an expert may testify that the modes of operation of two machines are substantially the same, or are substantially different, as the case may be. And where a question of infringement depends on whether a particular part of one machine, is an equivalent of a particular part of another machine, an expert may testify whether they perform the same function, and if so whether they perform that function in substantially the same way.

§ 501. Where an expert, in his direct examination, expounds the whole, or a part, of the prior art, his cross-examination may extend to the same sources of knowledge or domains of experience. But where an expert is giving testimony in chief, upon points of fact relevant to infringement, and confines that testimony to the similarities and differences between the plaintiff's patent and the defendant's doings, he cannot be cross-examined on the prior art; except by inquiring whether he took the prior art into consideration, when forming his opinion on the

[204] Trustees of Masonic Fund *v.* Fountain Electrical, etc., Corporation, 218 F. R. 642, 1914.

[205] Singer Mfg. Co. *v.* Cramer, 192 U. S. 265, 1904.

significance of the differences between the plaintiff's patent and the defendant's doings. That exceptional question is proper, because the answer will show whether the expert treated the plaintiff's patent as a primary patent, or treated it as a secondary patent, when he was weighing the differences between it and the defendant's doings; and because the validity of his estimate of those differences, may depend on whether he was right or was wrong in treating it as he did, in that respect.

The cross-examination of experts, cannot extend to inquiries into the characteristics of things not relevant to the case, put to them for the purpose of testing their knowledge or their fairness; because if the answers appeared to be undeniably correct, they would be wholly immaterial, and if thought to be erroneous they could be shown to be so, only by the testimony of others, who might themselves be the mistaken ones. To allow such a question, would thus operate to introduce an immaterial issue of fact into a case, and to draw the attention of the jury away from the issues of the pleadings.[206]

[206] Odiorne *v.* Winkley, 2 Gallison, 51, 1814.

On the subject of the proper scope of examination of experts, Equity Rule 7 of the Southern District of New York is of interest. It is as follows:

"In cases where under Supreme Court Rule 48 the direct testimony of experts in patent causes is taken by affidavit, the witnesses shall not give their opinion as to the meaning of any patent claim or specification, but their testimony shall be strictly confined to an explanation of the operation of relevant arts, processes, machines, manufactures or compositions of matter, and of the meaning of terms of art or science and of diagrams or formulæ.

"If the affidavit or deposition of any expert witness contain matter forbidden by this Rule, or irrelevant or immaterial matter, it shall not be answered by the opposite party, nor shall it be the basis of any cross-examination at the hearing, and the Court at any stage of the cause may strike from any such affidavit or deposition all such matter."

§ 502. The last part of a plaintiff's *prima facie* evidence, consists in proof of the amount of his damages, sometimes supplemented by evidence tending to show that a judgment ought to be entered for an amount greater than the actual damages sustained by him.[207] The matter is mentioned in this connection for the sake of symmetry; but it is so large that it constitutes the subject of a separate chapter of this book. To that chapter, recourse may be had for detailed information upon the subject.

§ 503. Except where a defendant exercises his right to demur to the evidence, or to move the court to direct the jury to return a verdict for him, at the close of the plaintiff's evidence in chief; the next part of a trial is the introduction of evidence by the defendant to sustain his defences. The possible defences in patent cases are twenty-eight in number. In prior sections in this chapter, they are consecutively numbered for purposes of easy reference, and are treated in respect of the pleadings which they respectively require, and the results which they respectively produce in patent actions at law. It is now convenient to set forth, in the same order, the leading points of the law of evidence applicable to each.

§ 504. The first defence will sometimes require evidence to show that the terms of art or science which are used in the patent, have such a meaning that the court is bound to construe the patent to be one for a principle, or for something other than a patentable process, or a machine, manufacture, composition of matter, or design. But where a patent plainly claims only the peculiar function of a described machine, the first defence can be maintained without any evidence outside of the patent.

§ 505. The second defence may sometimes be supported

[207] Revised Statutes, Section 4919.

by facts of which the court will take judicial notice.[208] But evidence to show the state of the art, is often required to show want of invention. A patent granted for an implement of agriculture, consisting of a hoe-handle with a hoe on one end and a rake on the other, would be void for want of invention, even if both new and useful.[209] The court would take judicial notice of the prior existence of handles having hoes attached thereto, and of other like handles having rakes fastened to one end; and on the basis of that judicial notice, would pronounce such a patent to be invalid. In fact the court will take judicial notice of all practices existing generally in an art although it may be necessary for the individual judge to determine the facts from consultation with standard literature dealing with the subject involved.[210]

A patent for a particular alleged combination in a complicated machine, may also be open to the same sort of objection; while the facts upon which it rests in the particular case, may be unknown to people generally, and unknown to judges who hear patent causes; though well understood by some experts and some mechanics. In such a case, it is necessary to introduce evidence of those facts in order to show want of invention. Such evidence may consist of proof of the prior existence of the parts of the alleged combination, and proof of the fact that their union in the machine, constitutes not a real combination, but an aggregation only.

So also, where want of invention results from some

[208] Brown *v.* Piper, 91 U. S. 37, 1875; Slawson *v.* Railroad Co., 107 U. S. 649, 1882; Phillips *v.* Detroit, 111 U. S. 606, 1883; Specialty Mfg. Co. *v.* Fenton Mfg. Co., 174 U. S. 497, 1899.

[209] Reckendorfer *v.* Faber, 92 U. S. 347, 1875; also Roberts *v.* Bennett, 136 F. R. 193, 1905.

[210] Werk *v.* Parker, 231 F. R. 121, 1916.

other reason than aggregation, the prior art must generally be proved in order to support the second defence; and that proof will generally consist of one or more prior patents or printed publications. The method of introducing them in evidence, is explained in the next two sections where substantial identity between the invention of the patent in suit and the invention disclosed in a prior patent or printed publication, is pre-supposed. But where a prior patent or printed publication is set up to negative invention, rather than to negative novelty, identity may be absent. In such a case, the question is whether the difference or differences between the subject claimed in the patent in suit and the prior art, amount to invention; and it is generally necessary for a defendant to introduce expert testimony on that point,[211] for a question of invention is a question of fact.[212] That testimony may state the character and the results of experiments made with the processes or articles involved in the comparison, or it may be based on knowledge otherwise acquired by the expert who testifies.

For the purpose of determining the meaning of terms where the evidence has left the question in doubt, it has been held that the court may resort to dictionaries, publications, books of science, etc.[213] It is surmised that the decision so holding is not so construed to permit the court to depart from the rules governing the doctrine of judicial notice.

§ 506. The third defence, and the facts which support it, are explained at large in the third chapter of this book.

[211] Waterman *v.* Shipman, 55 F. R. 987, 1893.

[212] Kisinger-Ison Co. *v.* Bradford Belting Co., 97 F. R. 508, 1899; Willis *v.* Miller, 121 F. R. 985, 1903.

See Section 23.

[213] Panzl *v.* Battle Island Paper, etc., Co., 132 F. R. 607, 1904.

In this connection, it is only necessary to explain the kinds of evidence by which those facts may be proved, and to state the special rules which govern the weight of such evidence.

Where novelty is duly sought to be negatived by prior United States patents, duly certified copies of those patents are admissible;[214] and it is a general practice among patent lawyers to waive the certificate, where a printed copy from the Patent Office is presented by opposing counsel. This practice has been approved and such copies held competent evidence not only of the patent itself but of the date when the application was filed, when no objection has been interposed on the ground of incompetency.[215] The certified copies of letters patent, which are admissible in evidence, include not only such individual copies as are furnished to private persons on payment of the proper fees; but also the certified bound volumes of copies which are gratuitously distributed by the Commissioner of Patents to all the State and Territorial capitols, and to all the United States District Court clerks' offices, except those which are located at the capitals of the States and Territories.[216]

Where prior foreign patents are duly pleaded to negative novelty, they may be proved *prima facie*, by duly certified copies of those copies thereof, which are kept in the United States Patent Office.[217] If plenary proof of foreign letters patent is required, it can be made by producing a copy thereof, duly certified by that officer of the foreign government which issued the patent, who corresponds to the

[214] Revised Statutes, Section 892.

[215] Drawson *v.* Hartje Paper Co., 131 F. R. 734, 1904.

See Section 129.

[216] Revised Statutes, Section 490.

[217] Revised Statutes, Section 893.

Commissioner of Patents in the United States.[218] Where an error creeps into a certified copy of any letters patent, it may be corrected by another and more carefully compared certified copy from the same office.[219] Letters patent, to be admissible, must agree in name and date with the statements in the pleadings, in proof of which they are offered.[220]

§ 507. Prior printed publications must be proved by the introduction of a specimen of the printed thing, which is relied upon, and by satisfactory evidence that it was published before the date of the patent in suit. Parol testimony of the contents of such printed matter is generally inadmissible.[221] The testimony of a person, that the printed thing produced was published before the date of the invention in suit, if believed by the jury, would be sufficient evidence on that point. What evidence short of that in convincing force, would answer the purpose in hand, has not been judicially settled. Printed publications are not generally evidence of the truth of the statements which they contain.[222] But where a book or public periodical appears to have been published in a specified year, or on a specified day, and where it contains matter which furnishes collateral evidence of the genuineness of the date, and where it is free from the suspicion of having been changed after it was put forth, it will be received in evidence, without direct testimony that it was published when it purports to have been.[223] But a certificate of the Commissioner of Patents, that a particular book was

[218] Schoerken *v.* Swift & Courtney & Beecher Co., 7 F. R. 469, 1881.

[219] Brooks *v.* Jenkins, 3 McLean, 432, 1844.

[220] Bellas *v.* Hays, 5 Sergeant & Rawle (Penn.), 427, 1819.

[221] McMahon *v.* Tyng, 14 Allen (Mass.), 167, 1867.

[222] Seymour *v.* McCormick, 19 Howard, 106, 1856.

[223] Britton *v.* White Mfg. Co., 61 F. R. 95, 1894.

in the library of the Patent Office as early as a particular date, is not evidence of that fact.[224]

§ 508. Prior knowledge or use of a thing patented, may be proved by the testimony of the person or persons who had such prior knowledge, or who know of such prior use. Such testimony includes three points: the existence, the character, and the date of the thing previously known or used. Where a witness relies wholly on his memory for all three of these points, his testimony, though admissible, is not strong. It is generally impossible to remember with certainty the particular construction of a thing of which no specimen is known to remain in existence; and most memories are nearly unreliable on questions of dates. It is therefore desirable to fortify testimony of prior knowledge or use by producing the anticipating thing, or a specimen thereof, and by connecting the history of that thing with events about which there is no room for doubt. Where the anticipating thing cannot be produced, the testimony which supports its prior existence, may still prevail, if the construction of the article was so simple, and so well understood, as to be unlikely to be forgotten, and especially if a number of credible witnesses agree in regard to its character and its date.[225]

§ 509. Parol evidence of an anticipating thing, is likely to be met by other parol evidence, tending to show that such a thing never existed at the place alleged; or that it was substantially different from the patented invention sought to be anticipated; or that it did not exist at the alleged place till after the date of the patented invention. Testimony of the first sort is negative in its character, and therefore not so weighty as the affirmative evidence which it contradicts.[226] But it does not need to be so weighty,

[224] Travers *v.* Cordage Co., 64 F. R. 773, 1894.

[225] See Section 76.

[226] Union Sugar Refinery *v.*

in order to overthrow the latter; for a mere proponderance of evidence will not sustain the defence of want of novelty. That defence, in order to prevail, must be proved beyond a reasonable doubt.[227] Testimony of an anticipating thing may also be met by evidence that the witness purchased a license under the patent; but such answering evidence is generally entitled to very little weight,[228] because the witness may not have understood that the facts of which he knew, constituted a legal defence to the patent, or he may have preferred to pay for a license, rather than to undergo the annoyance and incur the expense which are generally incident to actions for infringement.

§ 510. When anticipating matter is undeniably proved to have existed before the date of the patent in suit, want of novelty is *prima facie* proved; [229] because the printed memorandum of the date of the application for the patent, which is put at the head of the specification, is not evidence of that date.[230] But the plaintiff may meet the defendant's evidence of anticipating matter by proof that he, or his assignor, made the invention at a still earlier date. He may sometimes do this by means of a certified copy of the specification and drawings of his original application; but not by parol evidence relevant to the time when the petition, specification, or drawing was filed.[231] If his application was not early enough for the purpose, the plaintiff may prove the real date of his invention by proving the date of either of those facts, which, in the chapter on novelty, were shown to constitute the birth of an

Matthiessen, 2 Fisher, 600, 1865. F. R. 773, 1894.

[227] Section 76 of this book.

[228] Evans *v.* Eaton, 3 Wheaton, 454, 1818.

[229] Havemeyer *v.* Randall, 21 F. R. 404, 1884.

[230] International Terra Cotta Co. *v.* Maurer, 44 F. R. 619, 1890.

See Section 506.

[231] Wayne *v.* Winter, 6 McLean, 344, 1855.

invention thereafter patented.[232] If that fact was a tangible thing, its establishment requires the production and proof of that thing, or requires proof of its loss or destruction, and the best obtainable evidence of what its character was.[233] But declarations of the patentee relating to his invention, accompanied by descriptions thereof, and made before the application was filed, are competent evidence for the purpose in question on the principle of *res gestæ*.[234]

After the plaintiff has introduced evidence that he, or his assignor, made the invention at a still earlier date than that proved for the anticipating matter; the defendant cannot introduce evidence to carry the date of the anticipating matter back of the new date thus proved by the plaintiff; but the defendant may introduce evidence to disprove, if he can, the plaintiff's new date of invention.[235]

§ 511. The fourth defence requires evidence that the patented invention will not perform any function which is ascribed to it in the letters patent,[236] or proof that its function is not a useful one, within the meaning of the law on that subject.[237]

The first of these sorts of proof may consist of testimony of a person who is skillful in the art to which the invention pertains, and who has endeavored, in good faith, to make the patented thing work, and has been unable to do so. In plain cases, it may also consist of the testi-

[232] Section 70; Consolidated Ry., etc., Co. *v.* Adams & Westlake Co., 161 F. R. 343, 1908.

[233] Richardson *v.* Hicks, 1 McArthur's Patent Cases, 336, 1854.

[234] Bullock Electric Mfg. Co. *v.* Crocker-Wheeler Co., 141 F. R. 101, 1905.

[235] St. Paul Plow Works *v.* Starling, 140 U. S. 198, 1891.

[236] Rowe *v.* Blanchard, 18 Wisconsin, 462, 1864.

[237] Sections 82 to 84 of this book.

mony of such a person, who has not actually experimented with a specimen of the patented thing, but who is able to show theoretically, that it is impossible for such a specimen to operate.[238] And in all cases the evidence must show a total incapacity in the invention to do anything claimed for it, because neither imperfect operation, nor a total failure to perform part of the claimed functions, will sustain a defence of want of utility.[239] And either practical or theoretical evidence of want of utility in the sense now under consideration, may be overthrown by the testimony of a person who has succeeded in causing the patented process or thing to produce a result ascribed to it in the patent.

The second of these sorts of proof may consist of evidence that the function of the patented thing is one which people generally profess to condemn as dangerous or immoral. Conventional and not absolute ethics is the criterion of judgment on this point.

§ 512. The fifth defence may be supported by any competent evidence which shows that the inventor relinquished all expectation to secure a patent, and formed an expectation that the invention would always be free to the public.[240] Such evidence may be either direct or circumstantial, but a mere preponderance of evidence cannot sustain this defence of actual abandonment, because it is one of those which, in order to prevail, must be proved beyond a reasonable doubt.[241]

§ 513. The sixth defence requires proof that the inventor

[238] Campbell Printing-Press Co. *v.* Duplex Printing-Press Co., 86 F. R. 330, 1898; Crown Cork & Seal Co. *v.* Aluininum Stopper Co., 108 F. R. 849, 1901.

[239] Seymour *v.* Marsh, 6 Fisher, 115, 1872.

[240] Babcock *v.* Degener, 1 McArthur's Patent Cases, 616, 1859.

[241] McCormick *v.* Seymour, 2 Blatch. 256, 1851.

omitted to apply for the patent, during the time allowed by the statutes for such an application to be made, in his particular case.[242] That proof, to be effective, must establish the fact beyond a reasonable doubt.[243]

§ 514. The seventh defence requires the introduction of the original application papers, or certified copies thereof; and in all except very plain cases it requires the testimony of experts to explain the outward embodiment of the terms contained in the original letters patent, and in the original application respectively.[244]

§ 515. The eighth defence calls for evidence that another than the patentee conceived the invention before he did; and that the other used reasonable diligence in adapting and perfecting the same; and that the patentee knew of that prior conception, and obtained the patent surreptitiously; or, if he did not know of the prior conception, that he obtained the patent unjustly, by applying for it when the prior conceivor was not chargeable with laches in reducing the invention to practice, or in preparing and filing an application for a patent thereon.[245]

§ 516. The ninth defence requires proof that another than the patentee was joint inventor with him of the thing covered by the patent. Testimony on this point must be strong in order to prevail, because the tendency of courts and juries is to assign such evidence to the category of mechanical assistance in construction, or to that of suggested substitution of equivalents.[246]

[242] Andrews *v.* Hovey, 123 U. S. 267, 124 U. S. 694, 1887.

[243] Hanifen *v.* Godshalk, 78 F. R. 816, 1896.

[244] Bischoff *v.* Wethered, 9 Wallace, 812, 1869.

[245] Revised Statutes, Section 4920, as amended, 29 Statute, 692; Yates *v.* Huson, 8 App. D. C. 93, 1896.

[246] Agawam Co. *v.* Jordan, 7 Wallace, 587, 1868; Pitts *v.* Hall, 2 Blatch. 229, 1851; Locke *v.* Lane Co., 35 F. R. 293, 1888; Hall Signal Co. *v.* Union Switch & Signal Co., 115 F. R. 643, 1901.

§ 517. The tenth defence is more likely to be successful in the proof than the ninth; because it may not only be based on the counterpart of the circumstances which underlie the latter, but also on other circumstances, where those do not exist. It has sometimes happened that an inventor, having sold an undivided half interest in his invention, has joined with his vendee in applying as joint inventor for a patent therefor. Such errors have been known to result from ignorance of the law; and such an error has been said to have occurred in one case on account of a desire to give an important patent the benefit of the name of a more distinguished scientist than him who was the real producer of the subject of the claim. But in any case, it is certain that very clear and unequivocal evidence is necessary to support this defence.[247]

§ 518. The eleventh defence calls for proof that the letters patent contain less than the whole truth relevant to the invention, or that it contains more than is necessary to produce the desired result, and that the fault arose from intention to deceive the public. But positive and direct evidence is not required on the latter point. It is sufficiently shown by proof of any circumstances which satisfy the jury that such intention existed.[248] The intent, however, is the gist of this defence and even though the patent may appear to be deceptive in fact, the defence is not sustained unless the intent is shown. The *prima facie* showing of intent may be rebutted by any competent evidence that tends to disprove it, as for in-

[247] Gottfried *v.* Brewing Co., 5 Bann. & Ard. 4, 1879; Butler *v.* Bainbridge, 29 F. R. 142, 1886; Consolidated Apparatus Co. *v.* Woerle, 29 F. R. 449, 1887; Schlicht & Field Co. *v.* Sewing Machine Co., 36 F. R. 585, 1888; Welsbach Light Co. *v.* Cosmopolitan Gaslight Co., 100 F. R. 650, 1900.

[248] Gray *v.* James, 1 Peters' Circuit Court Reports, 394, 1817; Dyson *v.* Danforth, 4 Fisher, 133, 1865.

stance public disclosures by the inventor at the time of issuance of the patent of the matters that on the face of the patent might appear to have been withheld.[249]

§ 519. The twelfth defence can be supported by no evidence except that of persons skilled in the art to which the invention pertains, or with which it is most nearly connected. A patent for a chemical composition or process cannot be overthrown, on the ground of an insufficient description, by the testimony of a mechanical expert; nor can a patent for an improvement of a loom be overthrown on that ground, by the testimony of a machinist skilled only in printing-presses. If a description is sufficiently full, clear, concise, and exact to be effectually understood by any person skilled in that kind of machinery, or other subject of a patent, it is sufficiently so to meet this defence.[250]

§ 520. The thirteenth defence may sometimes succeed without any evidence outside of the letters patent themselves. It will, however, always be prudent to fortify the defence by the testimony of an expert who can show that the outward embodiment of the terms of the claim, is uncertain in character or in extent.

§ 521. The fourteenth defence requires several items of evidence for its support. It requires proof that one or more of the claims of the patent are void for want of embodying a subject-matter of a patent,[251] or for want of invention, or for want of novelty; [252] and that the patentee has long known the facts which make it invalid in that behalf. No disclaimer is ever necessary, in the absence of all of the first three of these circumstances; and no

[249] Malignani *v.* Jasper Marsh, etc., Co., 180 F. R. 442, 1910.

[250] Loom Co. *v.* Higgins, 105 U. S. 580, 1881.

[251] O'Reilly *v.* Morse, 15 Howard, 121, 1853.

[252] Revised Statutes, Section 4922.

delay to file one is unreasonable in the absence of the fourth. Indeed, proof of a necessity for a disclaimer, and of long-existing knowledge of the facts out of which that necessity arose, will not always sustain this defence; because delay to file a disclaimer is not unreasonable, so long as there is any reasonable doubt whether the known facts constitute a necessity for such a document.[253]

§ 522. The fifteenth defence can seldom be supported by evidence that the original patent was neither inoperative nor invalid by reason of a defective or insufficient specification; because inoperativeness, from one of these causes, exists whenever the patent does not secure and cover all the inventions which it indicated, suggested, or described, and which might lawfully have been claimed in it; [254] and because, when not granted on account of such inoperativeness, reissues are generally granted on account of invalidity which arose by reason of a defective or insufficient specification, or by reason of a too extensive claim.[255] This defence therefore generally requires to be sustained by evidence showing that, whatever inoperativeness or invalidity on account of defective or insufficient specification, or on account of too extensive claims, is to be found in the original patent, the error arose otherwise than by inadvertence, accident, or mistake. The absence of all three of these mishaps from the history of the preparation of any original specification, may be proved by evidence which shows that the statements or claims alleged to have been omitted in one or another of these ways, were in fact omitted with deliberation or with care, or were omitted because they had to be, in order to secure

[253] Silsby *v.* Foote, 20 Howard, 290, 1857; Matthews *v.* Flower, 25 F. R. 834, 1885.

[254] Wilson *v.* Coon, 18 Blatch. 532, 1880.

[255] Revised Statutes, Section 4916.

the original patent,[256] or were disclaimed in order to secure an extension thereof.[257] Evidence to show either of the last two of these circumstances, if it exists at all, may generally be found among the correspondence on file in the Patent Office, and may be introduced in the form of certified copies of the letters which contain it.[258]

§ 523. The sixteenth defence can be supported by the introduction of the original patent, if when it is compared with the reissue, the latter appears to claim something which the original did not, and appears to have been applied for a long time after the original was granted. How long this space of time must be, in order to sustain this defence, depends largely upon the particular circumstances of particular cases. Different spaces of time which have been held to be sufficient for the purpose, are collated in the chapter on reissues,[259] and the burden is on the plaintiff to excuse delay for more than two years.[260]

§ 524. The seventeenth defence always requires to be supported by the introduction of the original patent,[261] and generally requires expert testimony showing that the outward embodiment of something claimed in the reissue, is substantially different from anything described in the original patent and apparently intended to be claimed therein. The judge will not reject such expert testimony, unless the case is so clear that he would have decided the question on a demurrer, if it had been presented to him by that pleading.

[256] James *v.* Campbell, 104 U. S. 356, 1881; Yale Lock Co. *v.* Berkshire Bank, 135 U. S. 379, 1890; Dobson *v.* Lees, 137 U. S. 265, 1890.

[257] Leggett *v.* Avery, 101 U. S. 256, 1879.

[258] Revised Statutes, Section 892.

[259] See Section 227.

[260] Wollensak *v.* Reiher, 115 U. S. 101, 1884; Hoskin *v.* Fisher, 125 U. S. 222, 1887.

[261] Seymour *v.* Osborne, 11 Wallace, 516, 1870.

§ 525. The eighteenth defence requires the introduction in evidence of the prior patent, granted on the application of the same inventor; but it will seldom require expert testimony, because, in order to prevail at all, this defence requires the claim of the prior patent to be so clearly co-extensive with the claim of the patent in suit, that its co-extensiveness is apparent upon the faces of the two patents. But expert testimony may be necessary to show such substantial identity of claims, where one or both of the claims may be formulated in phraseology, which cannot be understood without expert explanation.

§ 526. The nineteenth defence would require to be supported by the introduction of an officially attested copy of the record of the court repealing the patent,[262] or if that record is proved to have been destroyed by fire,[263] or rendered illegible by wear or time,[264] and not restored by the court to which it pertains,[265] it may be proved by a witness who examined and copied it when it was still unharmed.[266] But parol evidence will not be admitted of a record of which only a part is lost. The part which still exists, must be produced or proved by an officially attested copy.[267]

§ 527. The twentieth defence calls for the introduction in evidence, of a properly certified copy of the foreign patent which is relied upon to curtail the term of the patent in suit; and if the parties offer no testimony to aid the court in determining whether the foreign patent, so proved, is for the same invention as the United States patent upon

[262] Revised Statutes, Section 905.

[263] United States *v.* Delespine's Heirs, 12 Peters, 654, 1838.

[264] Little *v.* Downing, 37 New Hampshire, 355, 1858.

[265] Revised Statutes, Sections 899 and 900.

[266] 1 Wharton on Evidence, 135.

[267] Nims *v.* Johnson, 7 California, 110, 1857.

which the action is based, then the court will determine that point from an inspection of the two documents.[268] But if expert evidence on that subject is offered, it will doubtless be received.[269] And a foreign patent is evidence of its own duration; and will be held not to have been extended, in the absence of evidence that it has been.[270]

§ 528. The twenty-first defence is supported by proof that the plaintiff has made or sold one or more specimens of the patented article without marking it "patented," together with the day and year whereon the patent was granted.[271] When such evidence is introduced, the burden is shifted to the plaintiff, if an accounting is prayed, to show that before suit was brought the defendant was duly notified that he was infringing the patent, and that he continued to infringe after such notice.[272] A voluntary statement made to the infringer by a third person, that his doings infringe a patent, is not such a notice of infringement as is contemplated by the statute;[273] but such a notice does reside in the beginning of a suit for infringement.[274]

The twenty-first defence does not apply to any patent for a process; because processes are not made or sold. They are only used, and the statute on this subject is expressly confined to cases of making or to cases of selling without marking "patented."[275]

[268] De Florez *v.* Reynolds, 17 Blatch. 439, 1880.

[269] Bischoff *v.* Wethered, 9 Wallace, 812, 1869.

[270] Edison Electric Light Co. *v.* Electric Supply Co., 60 F. R. 404, 1890; Bonsack Mach. Co. *v.* Smith, 70 F. R. 383, 1895.

[271] Revised Statutes, Section 4900.

[272] Goodyear *v.* Allyn, 6 Blatch. 36, 1868.

[273] Pairpoint Mfg. Co. *v.* Eldridge Co., 71 F. R. 309, 1896.

[274] United States Mitis Co. *v.* Carnegie Steel Co., 89 F. R. 206, 1898.

[275] United States Mitis Co. *v.* Carnegie Steel Co., 89 F. R. 206, 1898.

§ 529. The twenty-second defence may sometimes be sustained by means of pointing out faults in the plaintiff's proof of title. Where that proof is apparently complete, it can be attacked by the introduction of assignments or grants in writing, which intervene between some of the links of the plaintiff's chain of title in such a way as to destroy or impair its continuity. The numerous points of law relevant to title are explained in the eleventh chapter of this book. It is enough to say, in this connecton, that no title will be recognized in a court of law, unless it is evidenced by instruments in writing.[276]

§ 530. The twenty-third defence may be sustained by evidence of a written or a parol license, or of an express or an implied license. And a license may be a defence to an infringement suit, even where the license fee is in arrears.[277] Licenses form the subject of the twelfth chapter of this book, and to that chapter recourse may be had for further information in regard to the proper evidence to support this defence.

§ 531. The twenty-fourth defence may be sustained by proof of a total or partial release, given after the infringement was committed and before the action was commenced, or it may be sustained *pro tanto* by a partial release given even after the action was begun.[278] A paper cannot be a release, if executed before the infringement to which it refers was committed, because no man can relinquish what he does not possess.

Whether a lease, given only to a joint infringer with the defendant, can be invoked by the defendant himself, is a question to which no categorical answer can at present

[276] Revised Statutes, Section 4898, as amended 29 Stat. 692.

[277] Keyes *v.* Mining Co., 158 U. S. 150, 1895.

[278] Burdell *v.* Denig, 92 U. S. 721, 1875.

be given. It depends upon the question whether contribution can be enforced between infringers, and that point has never been settled by the courts. Nothing more useful can therefore be said in this connection, than to state the principles upon which the two questions seem to depend.

The doctrine that there can be no contribution between tort-feasors, does not generally apply to cases where the wrongdoers suppose their doings to be lawful.[279] This is generally true of infringers of patents. When they infringe, they are perhaps ignorant of the patents which they violate; or if they know of the patents, they are apt to give themselves the benefit of every suggested ground for doubt, and thus suppose that their doings do not constitute any infringement. Therefore, it seems to be generally true, that where one of several joint infringers is sued alone, and suffers and pays a judgment for the joint infringement, he may compel his co-infringers to contribute their due portion of that payment, by means of an action to enforce its refunding. That being so, it will follow that a release to one joint infringer will operate to release all his co-infringers from the claim of the patentee. Where contribution can be enforced between tort-feasors, a full release to one must release all; for if it did not do so, it would not fully release that one. The releasee would not be fully protected by his release, unless his co-infringers would also be protected by it; because otherwise the releasee would still be liable to an action for contribution, brought against him by a joint tort-feasor who had been compelled to respond in damages for the joint infringement. The true rule, therefore, appears to be that a plain release given to either of several joint infringers may be successfully invoked in a court of law, not only by

[279] Bailey *v.* Bussing, 28 Connecticut, 461, 1859.

the nominal releasee, but also by any or all of his co-infringers.

A release given to an infringer, by one of several owners in common of a patent right, is not a defence to an action of the other owners against the infringer;[280] and those other owners will be permitted to prosecute their rights, by making the releasing co-owner a co-plaintiff against his will, if that is necessary in a particular jurisdiction. In a suit thus prosecuted, the release will be a defence to the damages due to the releasing co-owner, but not to those due to the others.

§ 532. The twenty-fifth defence may be successful without any evidence, because the burden of proof is upon a plaintiff to show an infringement,[281] and because a plaintiff may fail to sustain that burden. Accordingly, in one leading law case, the defendant was the prevailing party on the circuit, and in the Supreme Court, though the plow which he made was nearly identical with that covered by the plaintiff's patent, and though the defendant introduced no evidence on the subject of infringement, nor indeed on any other.[282] So, also, in a leading case in equity, the defendant, though beaten on the circuit, successfully interposed the defence of non-infringement in the Supreme Court, without any evidence on that side of the issue, and against the contrary testimony of several experts.[283] Several cases have also been successfully defended in Circuit Courts, on the ground of non-infringement, without any expert testimony on that side

[280] Lalance & Grosjean Mfg. Co. *v.* Haberman Mfg. Co., 93 F. R. 198, 1899.

[281] Brooks *v.* Jenkins, 3 McLean, 453, 1844; Royer *v.* Mfg. Co., 20 F. R. 853, 1884; Dowagiac Mfg. Co. *v.* Brennan, 118 F. R. 146, 1902.

[282] Prouty *v.* Ruggles, 16 Peters, 336, 1842.

[283] Railway Co. *v.* Sayles, 97 U. S. 554, 1878.

of that issue,[283a] and against regular expert depositions asserting and arguing the proposition of infringement.[284]

But where a thing made or used or sold by the defendant is proved or is stipulated, and where a competent expert testifies that it is substantially the same as that which appears to be covered by the patent in suit, it is generally advisable, and sometimes necessary, for the defendant to introduce evidence tending to show non-infringement, if he means to rely upon that defence.[285] Evidence of this sort may consist of the testimony of experts who are acquainted with the letters patent in suit, and with the doings of the defendant, and are of opinion that those doings are substantially different from everything which appears to be secured by the letters patent, and can give an intelligent reason for that opinion. But such testimony must describe the defendant's doings, to enable the court to judge the correctness of its comparisons.[286] This testimony, like other testimony of experts on questions of infringement, is necessarily based on hypothetical constructions of the patents in suit, and is therefore to be disregarded, if the judge finds those hypothetical constructions to be substantially erroneous.

When a plaintiff has made a *prima facie* case of infringement of a process patent the defendant may find himself in the seeming predicament of being obliged to disclose his secret process in order to offset the plaintiff's showing. The practical necessity for this of course will depend upon the strength of plaintiff's showing, but in any event the defendant will not be compelled to disclose his secret

[283a] See Section 189.

[284] Enterprise Co. *v.* Snow, 72 F. R. 263, 1896; 80 F. R. 537, 1897; Beale *v.* Spate, 74 F. R. 869, 1896.

[285] Bennet *v.* Fowler, 8 Wallace, 447, 1869.

[286] Goldie *v.* Iron Co., 64 F. R. 240, 1894.

process, as he may show by affirmative proof that some one or more steps of the patented process has not been followed by him.[287]

Whether the fact that the defendant conformed his doings to a junior patent, is admissible as tending to show non-infringement of the patent in suit, is a question which the Supreme Court once decided in the affirmative,[288] and afterward in the negative,[289] but finally in the affirmative.[290] The lower courts have uniformly followed the last of these decisions, ever since it was rendered in 1895; so that now the law of the point appears to be established and confirmed.[291]

§ 533. The twenty-sixth defence requires to be proved as pleaded. Where it depends upon estoppel *in pais*, it may be proved by parol, or by the production of documents, according as the ground of the estoppel consists of things done, or words spoken, or consists of words which were committed to writing. Where the defence depends upon estoppel by deed, the document must be produced or otherwise proved according to the rules of evidence applicable to such cases; and where it depends upon estoppel by record, or *res judicata*, the record must be proved in accordance with the laws governing such evidence.

[287] Philadelphia Rubber Works Co. *v.* United States Rubber Reclaiming Works, 225 F. R. 789, 1915 (affirmed 229 F. R. 150, 1915).

[288] Corning *v.* Burden, 15 Howard, 252, 1853.

[289] Blanchard *v.* Putnam, 8 Wallace, 420, 1869.

[290] Boyd *v.* Janesville Hay Tool Co., 158 U. S. 261, 1895.

[291] Ransome *v.* Hyatt, 69 F. R. 149, 1895; New Departure Bell Co. *v.* Hardware Specialty Co., 69 F. R. 156, 1895; Ney *v.* Ney Mfg. Co., 69 F. R. 407, 1895; Illinois Steel Co. *v.* Kilmer Mfg. Co., 70 F. R. 1015, 1895; Wolff *v.* Du Pont, 122 F. R. 959, 1903.

For a more complete discussion of this question and of the distinctions involved, see Section 362*a*.

But if the record, when proved, stops short of showing that the point in question was decided in the former case, that fact may be proved by extrinsic evidence.[292]

§ 534. The twenty-seventh defence seldom requires any evidence to sustain it, because the Federal courts take judicial notice of the statutes of limitation; [293] and because the plaintiff's pleadings and proofs, when taken together, will generally show when the infringement sued upon was committed. But if the plaintiff's presentation of the case leaves the latter point uncertain to such an extent as to affect the question of the operation of a statute of limitation, the burden is then cast upon the defendant to prove that part or all of the infringement is old enough to be barred by the statute which he pleaded.[294]

§ 534*a*. The twenty-eighth defence would generally require the production of the record of the patent application, together with proof of whatever acts of the commissioner are relied upon as being illegal.

§ 535. Testimony in actions at law for infringements of patents may always be taken orally in open court. It may also be taken by depositions in writing, where the witness lives more than one hundred miles from the place of trial, or when he is bound on a voyage at sea, or is about to go out of the United States and out of the judicial district in which the case is to be tried, or to a greater distance than one hundred miles from the place of trial, before the time of trial, or when he is ancient and infirm. The sorts of magistrates before whom such a deposition may be taken are judges of any United States court; judges

[292] Southern Pacific Co. *v.* Earl, *v.* Wilson, 9 Wallace, 121, 1869.

See Sections 435 and 579.

[293] Pennington *v.* Gibson, 16 Howard, 79, 1853; Cheever *v.* Wilson, 9 Wallace, 121, 1869.

[294] Russell *v.* Barney, 6 McLean, 577, 1855.

of any supreme, superior, or county court, or court of common pleas in any of the United States; commissioners of United States circuit courts; clerks of United States circuit or district courts; mayors or chief magistrates of cities; and notaries public. If any such magistrate is counsel or attorney for either party, or interested in the event of the cause, he is disqualified from acting. Before such a deposition is taken, reasonable notice thereof must be given in writing by the party intending to take it, or his attorney of record, to the opposite party, or his attorney of record, as either may be nearest, and that notice must state the name of the witness, and the time and place of taking the deposition.[295]

The formalities to be observed in taking and transmitting such depositions are prescribed in Sections 864 and 865 of the Revised Statutes; and they must be strictly complied with, in order to make such depositions admissible as against proper objections. Indeed, no such deposition is admissible in any event, unless it appears to the satisfaction of the court that the witness is dead, or gone out of the United States, or to a greater distance than one hundred miles from the place where the court is sitting, or that, by reason of age, sickness, bodily infirmity, or imprisonment, he is unable to travel and appear at court.[296] Where the witness testified in his deposition to the then existence of the fact which authorized its taking, that fact is presumed to exist at the time the deposition is offered in evidence, and in the absence of contrary proof, the deposition itself will satisfy the court that it is entitled to be admitted.[297] Depositions may also be taken

[295] Revised Statutes, Section 863.

[296] Revised Statutes, Section 865.

[297] Whitford *v.* Clark County, 119 U. S. 524, 1886.

in actions at law for infringements of patents, in the modes prescribed by the laws of the respective States,[298] in any instance in which such a deposition can be taken under Sections 864 and 865 of the Revised Statutes of the United States.[299]

Where a deposition is being taken from a witness who cannot testify in the English language; the magistrate who takes it, may translate the questions into the language of the witness, and propound them to him therein, and may translate the answers into English and record them in that language.[300]

Most objections to depositions, in order to be efficacious, must be made before the depositions are received in evidence; for when introduced with the acquiescence of the opposite party, they cannot afterward be excluded on the ground that they were not taken in accordance with the rules prescribed therefor.[301] But where evidence is pertinent to either of several possible defences, one or more of which were pleaded, and one or more of which were not pleaded by the defendant; the fact that the evidence was not objected to when taken or admitted, does not make it admissible in support of any defence which was not pleaded.[302]

§ 536. The judge may direct the jury to return a verdict for the defendant, where it is entirely clear that the plain-

[298] 27 Statutes at Large, Ch. 14, p. 7.

[299] National Cash Register Co. *v.* Læland, 77 F. R. 242, 1896; Despeaux *v.* Pennsylvania Railroad Co., 81 F. R. 897, 1897; National Cash Register Co. *v.* Leland, 94 F. R. 505, 1899.

[300] Meyer *v.* Rothe, 13 App. D. C. 103, 1898.

[301] Evans *v.* Hettich, 7 Wheaton, 453, 1822; Howard *v.* Stillwell & Bierce Mfg. Co., 139 U. S. 199, 1891; Bibb *v.* Allen, 149 U. S. 481, 1893; Meyer *v.* Rothe, 13 App. D. C. 99, 1898.

[302] Zane *v.* Soffe, 5 Bann. & Ard. 284, 1880.

tiff cannot recover, but not otherwise.[303] Such a direction may therefore be given, where want of novelty or want of invention is clearly shown by a prior patent,[304] but not where that question is doubtful.[305] And such a direction may be given where the question of infringement depends entirely upon the construction of the patent; and where that construction does not depend upon any doubtful question of the prior art.[306]

But where the question of infringement depends upon the construction of the patent, and that construction depends upon a doubtful question in the prior art, the latter question should be left to the jury; and the dependent question of infringement should also be left to the jury to decide.[307] A motion that the judge direct the jury to return a verdict for the defendant needs not to specify the reason on which it is based; but that reason will naturally be stated in the argument which is made to support the motion.[308]

§ 537. Instructions to juries set forth the construction of patents[309] and embody all the law that is applicable to the material facts in evidence, but need embody no other.[310] In ascertaining that law, the judges resort to the statutes of the United States, and to the decisions of the United States Supreme Court; and where further

[303] Klein *v.* Russell, 19 Wall. 463, 1873; Keyes *v.* Grant, 118 U. S. 25, 1886; Connors *v.* Ormsby, 148 F. R. 13, 1906.

[304] Market St. Ry. Co. *v.* Rowley, 155 U. S. 625, 1895.

[305] San Francisco Bridge Co. *v.* Keating, 68 F. R. 353, 1895.

[306] DeLoriea *v.* Whitney, 63 F. R. 611, 1894; Cramer *v.* Fry, 68 F. R. 201, 1895; Jackson *v.* Western Fireproofing Co., 112 F. R. 361, 1901.

[307] Royer *v.* Belting Co., 135 U. S. 325, 1890.

[308] May *v.* Juneau County, 137 U. S. 410, 1890.

[309] Holmes *v.* Truman, 67 F. R. 545, 1895.

[310] Haines *v.* McLaughlin, 135 U. S. 598, 1890.

information is required, they examine or call to mind the decisions of the Circuit Courts of Appeals, and of the Circuit and District Courts of the United States.

But judges are not bound to conform their instructions to any statement of law contained in any opinion of any court, unless that statement was applicable to the case in which it was made.[311] The Supreme Court has sometimes decided cases, contrary to its own previous *obiter dicta;* and the circuit court decisions contain many remarks which cannot be harmonized with the decisions of the supreme tribunal, nor be incorporated into any systematic science. The statements of the best text-writers are more likely to be followed by the Federal courts than are the *dicta* of the judges of those courts; because the best legal authors fill their minds with the subjects which they treat, and hold those subjects in solution there when writing their books; while the *dicta* of judges are separately written down, without adequate comparison with adjudicated precedents, or full harmonization with established principles.

Instructions to juries may express the opinions of the judges upon the questions of fact to be decided,[312] but an instruction should not enforce those opinions upon the jury for its guidance,[313] and should not include the reading of a charge which has been given to a jury in another case.[314] While the judge is bound not to tell the jury how to decide any issue of fact, the judge will tell them what issues of fact they are to decide, and those are the issues

[311] Day *v.* Rubber Co., 20 Howard, 216, 1857; Day *v.* Stellman, 1 Fisher, 487, 1859.

[312] Haines *v.* McLaughlin, 135 U. S. 593, 1890; Coupe *v.* Royer, 155 U. S. 579, 1895; International Tooth Crown Co. *v.* Hanks Dental Ass'n, 111 F. R. 919, 1901.

[313] Turrill *v.* Railroad Co., 1 Wallace, 491, 1863.

[314] Arey *v.* DeLorica, 55 F. R. 323, 1893.

in the pleadings, and not some other issue which the judge may think is the one upon which the merits of the case really depend.[315]

In the State courts of most of the States, counsel have a right to require all instructions to be given in writing; but the judges of the Federal courts are not controlled by State regulations in the manner of charging juries, and therefore instructions in patent cases may be given in writing, or may be given orally, at the option of the court.[316]

§ 538. The verdict in a patent action will be for the plaintiff, if every defence except non-infringement fails, and if that fails as to any one claim of the letters patent.[317] So also, the plaintiff is entitled to a verdict, where every defence fails except the sixteenth, seventeenth, and eighteenth, and where those defences lack application to one or more of the claims shown to have been violated.[318] So also, if the twenty-second, twenty-third, or twenty-fourth defence is the only successful one, and if that is successful only as to part of the alleged infringement, the plaintiff will be entitled to a verdict as to the residue; and the same thing may be true of the twenty-sixth or of the twenty-seventh defence.

§ 539. A new trial may be obtained by the defeated party, if the jury disregarded the instructions of the judge;[319] or failed to correctly apply them to the issues of the case;[320] but not where the only error complained of

[315] Grant *v.* Raymond, 6 Peters, 244, 1832.

[316] Lincoln *v.* Power, 151 U. S. 442, 1894.

[317] Waterbury Brass Co. *v.* New York Brass Co., 3 Fisher, 43, 1858.

[318] Gage *v.* Herring, 107 U. S. 640, 1882; Gould *v.* Spicer, 15 F. R. 344, 1882; Cote *v.* Moffitt, 15 F. R. 345, 1883.

[319] Tucker *v.* Spalding, 13 Wallace, 453, 1881.

[320] Johnson *v.* Root, 2 Cliff. 108, 1862.

is an alleged wrong decision of such an issue, unless it was decidedly against the weight of evidence.[321]

Excessive assessment of damages, even where it is undeniably so, does not always entitle the defendant to a new trial. Such an error may be cured by the plaintiff remitting such a sum as the judge thinks constitutes the excess, in all cases where he thinks that the error of the jury arose from inadvertence; but where the circumstances of the case clearly indicate that the error arose from prejudice, or from reckless disregard of duty on the part of the jury, a new trial will be granted.[322] But an excessive verdict can be corrected by the Circuit Court of Appeals, unless the trial judge made some error which entitles the defeated party to a new trial.[323]

Errors made by judge may also entitle a party to a new trial, but no such error will have that effect unless it was excepted to at the time it was committed; nor where it consisted in erroneous admission of evidence, which the subsequent course of the trial rendered nugatory.[324] So, also, where the error of the judge consisted in erroneous instructions relevant to damages, the plaintiff may avoid a new trial by consenting that the verdict be reduced to nominal damages and costs.[325]

[321] Alden *v.* Dewey, 1 Story, 336, 1840; Stimpson *v.* Railroads, 1 Wallace, Jr., 164, 1847; Allen *v.* Blunt, 2 Woodbury & Minot, 121, 1846; Aiken *v.* Bemis, 3 Woodbury & Minot, 348, 1847; Wilson *v.* Janes, 3 Blatch. 227, 1854; Bray *v.* Hartshorn, 1 Cliff. 538, 1860; Roberts *v.* Schuyler, 12 Blatch. 448, 1875; Heide *v.* Panonlias (differentiating between functions of judge and jury in action at law), 188 F. R. 914, 1911.

[322] Stafford *v.* Hair-Cloth Co., 2 Cliff. 83, 1862; Johnson *v.* Root, 2 Cliff. 108, 1862; Russell *v.* Place, 9 Blatch. 175, 1871.

[323] Hogg *v.* Emerson, 11 Howard, 607, 1850.

[324] Allen *v.* Blunt, 2 Woodbury & Minot, 121, 1846.

[325] Cowing *v.* Rumsey, 8 Blatch. 36, 1870.

Newly discovered evidence may also furnish a good ground for granting a new trial; but not where that evidence might, with due diligence, have been obtained before the former trial,[326] nor where it is merely cumulative.[327] But evidence is not merely cumulative, where it refers to facts not before agitated, though it may refer to defences which, in the former trial, were based on other facts.[328] A party moving for a new trial upon the ground of alleged newly discovered evidence, must succeed or fail on the strength or weakness of the case as it is disclosed in his affidavits, and in the answering affidavits of the other party; for the moving party is not permitted to rebut the latter; nor will he be entitled to a new trial, if the opposing affidavits make out a strong case against him.[329] When a new trial is granted on the ground of newly discovered evidence, the terms usually are that the costs of the former trial must first be paid by the appellant.[330]

§ 540. Trials by a judge without a jury require to be so managed that the issues of law and the issues of fact are kept entirely distinct; for his decisions on the former are reviewable by the Circuit Court of Appeals, while his finding of fact has the same operation as the verdict of a jury.[331] If the finding of the judge be a general one, it is conclusive on all issues of fact, and is also conclusive on all questions of law, except those which arise upon the pleadings, and those which the bill of exceptions specifi-

[326] Washburn *v.* Gould, 3 Story, 122, 1844; Moneyweight Scale Co. *v.* Toledo Computing Scale Co., 199 F. R. 905, 1912.

[327] Ames *v.* Howard, 1 Sumner, 482, 1833.

[328] Aiken *v.* Bemis, 3 Woodbury & Minot, 358, 1847.

[329] Ames *v.* Howard, 1 Sumner, 491, 1833.

[330] Aiken *v.* Bemis, 3 Woodbury & Minot, 358, 1847.

[331] Revised Statutes, Section 649; St. Paul Plow Works *v.* Starling, 140 U. S. 197, 1891.

cally presents as having been ruled upon and excepted to in the progress of the trial.[332] If the finding of the judge be a special one, it will still be conclusive on the facts found; but the sufficiency of those facts to support the judgment will be open to review in the Circuit Court of Appeals.[333] Where the judge simply finds for the defendant, and enters a judgment accordingly, that judgment can be taken to the Circuit Court of Appeals for review only in the regular common-law method of a bill of exceptions and a writ of error, and only on pure questions of law.[334] Where the judge finds as a fact that the patent is void for want of novelty, or that the defendant has not infringed it, and thereupon enters a judgment for the latter, it is undeniable that the fact so found is sufficient to support that judgment. In arriving at his opinion, the judge may have misunderstood or misapplied the tests of novelty, or of infringement, but still his finding is conclusive; because on an appeal from a judgment at law the Circuit Court of Appeals is authorized to examine nothing but the sufficiency of the facts found.[335]

But if the judge finds that A. B. invented, made and used a certain described thing in the United States, prior to the invention of the patentee, or that the defendant made or used or sold only a certain described thing during the life of the patent, and therefore renders a judgment for the defendant, that judgment will be reversed by the Circuit Court of Appeals on a writ of error, if that court is of opinion that the thing invented, made and used by A. B. did not negative the novelty of the patent, or is of opinion that the thing made, used or sold by the defendant

[332] Insurance Co. *v.* Sea, 21 Wallace, 160, 1874.

[333] Revised Statutes, Section 700.

[334] Revised Statutes, Sections 649 and 700.

[335] Jennisons *v.* Leonard, 21 Wallace, 307, 1874.

did really infringe the patent in suit.[336] These illustrations of the practice in trials by a judge without the aid of a jury, show that where special findings of facts are adopted as the method of laying a foundation for a review of the case by the Circuit Court of Appeals, the finding ought to relate to the fundamental facts of the case, and not merely to the conclusions of fact which are deducible therefrom.

§ 541. Trial by referee may be instituted by an entry of the clerk of the court, made at the request of the parties, simply indicating that the case is to be referred to the person or persons named as referee; or it may be ordained by a stipulation in writing, signed by the parties or their attorneys, and filed in the case. When that is done, a rule may be issued, or an order of court may be entered, referring the case to the referee indicated by the parties, and directing him to hear and determine all the issues thereof. It thereupon becomes the duty of the referee to hear the parties, and then to decide the controversy and make a report to the court. The report may be special, setting forth the details of the evidence upon which it is based, or it may be general, giving only the conclusions to which that evidence carried the mind of the referee. To that report, either party may except in writing, and upon the hearing of those exceptions, the court may adopt or reject the report and enter judgment accordingly, or it may recommit the report to the referee with further directions.[337]

Such is substantially the outline of the trial by referee, which is delineated in the decision just cited. Inasmuch as that form of trial is not provided for by any United

[336] French *v.* Edwards, 21 Wallace, 147, 1874; Insurance Co. *v.* Sea, 21 Wallace, 160, 1874.

[337] Heckers *v.* Fowler, 2 Wallace, 132, 1864.

States statute, its details are regulated by the laws of the particular State in which such a trial is had.[338] Recourse must therefore be had to those laws for sundry points of information relevant to the methods of taking testimony before referees; the time when referees' reports must be made; the weight attached to such reports on issues of fact; and the proper practice by means of which to secure the judgment of the court upon reviewable points.

§ 542. Judgments follow verdicts of juries, findings of judges, or reports of referees; unless those verdicts are set aside, those findings reconsidered and modified, or those reports rejected or recommitted. It is not the practice of the United States District Courts to require a rule for a judgment to be entered in any case. Judgments are entered by the clerk of the court under a special or general authority from the judge, and where so entered are binding as the act of the court.[339] The circumstances which justify courts in entering judgments in patent cases, for any sum above the amount of the verdict, finding, or report, but not exceeding three times the amount thereof, are explained in the chapter on damages. That the court has the same power in this particular, in cases where the damages are ascertained by the finding of the judge, or by the report of a referee, that it has in cases where they are ascertained by the verdict of a jury, is a point which has not been judicially decided, but is one which can hardly be doubted.

§ 543. Costs are recoverable by all plaintiffs who secure judgments for infringements of patents;[340] even for

[338] Revised Statutes, Sections 721 and 914.

[339] Heckers *v.* Fowler, 2 Wallace, 132, 1864.

[340] Revised Statutes, Section 4919; Merchant *v.* Lewis, 1 Bond, 172, 1857.

nominal damages only;[341] except where it appears on the trial that one or more of the claims of the letters patent are void for lack of being the subject of a patent, or for want of invention, or for want of novelty, and it does not appear that the proper disclaimer was filed in the Patent Office before the commencement of the action;[342] and except where only a small part of the infringement alleged by the plaintiff is found by the verdict;[343] and except where the defendant offered before the suit was begun, to submit to the patent and to pay a definite sum as damages for his infringement, and which sum was as large as the plaintiff's recovery;[344] and except where part of the patents or part of the claims sued upon, are not recovered upon.[345] In the last mentioned case, the plaintiff may sometimes recover costs on account of his successful patent or patents, or his successful claim or claims,[346] and sometimes not.[347]

[341] Williames *v.* McNeely, 77 F. R. 895, 1896.

[342] Revised Statutes, Sections 973, 4917, and 4922; Metallic Extraction Co. *v.* Brown, 110 F. R. 665, 1901; General Electric Co. *v.* Crouse-Hinds Electric Co., 147 F. R. 718, 1906; Novelty Glass Mfg. Co. *v.* Brookfield, 172 F. R. 221, 1909.

[343] Marks' Chair Co. *v.* Wilson, 43 F. R. 304, 1890.

[344] Lowell Mfg. Co. *v.* Whittall, 71 F. R. 515, 1895.

[345] Adams *v.* Howard, 19 F. R. 319, 1884; Albany Steam Trap Co. *v.* Felthousen, 20 F. R. 640, 1884; Mann's Car Co. *v.* Monarch Car Co., 34 F. R. 130, 1888; Ligowski Clay-Pigeon Co. *v.* Clay-Bird Co., 34 F. R. 328, 1888; National Machine Co. *v.* Brown, 36 F. R. 322, 1888; Schmid *v.* Mfg. Co., 37 F. R. 348, 1889; Thomson-Houston Electric Co. *v.* Elmira Ry. Co., 71 F. R. 886, 1895; American Saddle Co. *v.* Sager Gear Co., 122 F. R. 645, 1903; Suddard *v.* Am. Motor Co., 103 F. R. 852, 1908.

[346] Green *v.* Lynn, 81 F. R. 388, 1897; J. L. Owens Co. *v.* Twin City Separator Co., 168 F. R. 259, 1909; Roth *v.* Harris, 168 F. R. 279, 1909.

[347] Brill *v.* Delaware County Electric Ry. Co., 109 F. R. 901, 1901; Ide *v.* Trorlicht, Duncker & Renard Carpet Co., 115 F. R. 150, 1902.

There is no United States statute which provides that defendants shall recover costs in any patent case. The common law of England allowed no costs to either party in any action at law; [348] and the statutes of Gloucester,[349] which supplied that defect as to plaintiffs, did not supply it as to defendants. The statute of 23 Henry VIII, Chapter 15, enacted, however, that where, in actions on the case, the plaintiff is nonsuited after the appearance of the defendant; or where the verdict happens to pass, by lawful trial, against the plaintiff, the defendant shall have judgment to recover his costs against the plaintiff, and shall have such process and execution for the recovery of the same, as the plaintiff might have had against the defendant, in case the judgment had been given for the plaintiff. This statute of Henry VIII, having been enacted before the founding of the English colonies in America, and being suited to the condition of society in the United States, is in force in the United States courts to the same extent that it would be if it were one of the rules of the common law.[350]

§ 544. All the items of costs which are taxable in a United States court are specified in the United States statutes,[351] or in some rules of that court authorized by such a statute.[352] The province of a taxing officer is therefore limited to comparing suggested items with the particulars of those statutes and rules, and to taxing those,

[348] Day *v.* Woodworth, 13 Howard, 372, 1851.

[349] 6 Edward I, Chapter I, 1278.

[350] Hathaway *v.* Roach, 2 Woodbury & Minot, 69, 1846; Bunker *v.* Stevens, 26 F. R. 249, 1885.

[351] Revised Statutes, Sections 823, 983; The Baltimore, 8 Wallace, 392, 1869; Lyell *v.* Miller, 6 McLean, 422, 1855; Wooster *v.* Handy, 23 F. R. 60, 1885; Kelly *v.* Springfield Ry. Co., 83 F. R. 183, 1897.

[352] Tesla Electric Co. *v.* Scott, 101 F. R. 524, 1900.

and only those, which he finds enumerated therein.[353] And no expenses, other than taxable costs, can be lawfully inserted in any cost bill.[354] On most points, the statutes relevant to fees are so clear that they require no explanation; but in some particulars they needed and have received judicial construction. Several such cases may be conveniently explained in a few of the sections which immediately follow.

§ 545. One attorney's docket fee is taxable in each case against the defeated party.[355] There is no warrant for taxing the unsuccessful party with a separate docket fee for each of his adversary's attorneys, nor with a separate docket fee for each term during which a case has been pending in court, nor for taxing any docket fee in favor of any attorney of the defeated party. Neither is there any warrant for taxing an attorney's deposition fee in favor of any attorney of the beaten party, or in favor of more than one attorney of the party which prevails in the action.[356] And taxable attorney's fees are taxed in favor of clients to help them pay their attorneys, and not in favor of attorneys as extra compensation.[357]

§ 546. The fees of the clerk of the court are in general taxable against the defeated party; but several of the items to which he is entitled are not so taxable, but are to be paid by the party for which he rendered the services to which they refer. Among those items, are copies of the record ordered by a party for his own use.[358] As

[353] Dedekam *v.* Vose, 3 Blatch. 153, 1853.

[354] Parks *v.* Booth, 102 U. S. 106, 1880.

[355] Dedekam *v.* Vose, 3 Blatch. 153, 1853; Troy Iron & Nail Factory *v.* Corning, 7 Blatch. 17, 1869; Parker *v.* Bigler, 1 Fisher, 285, 1857.

[356] Revised Statutes, Section 824.

[357] Celluloid Mfg. Co. *v.* Chandler, 27 F. R. 9, 1886.

[358] Caldwell *v.* Jackson, 7 Cranch, 277, 1812.

the greater must include the less, this rule must apply also to copies of pleadings, depositions or other papers which form parts of the records of cases.[359] The extent to which clerks may make records, and charge defeated parties therefor, depends upon the rules of each court in actions at law; but in actions in equity, that matter is regulated by Section 750 of the Revised Statutes.

§ 547. The fees of a commissioner or other magistrate, who takes a deposition in a case, are strictly limited to twenty cents for each hundred words in the deposition.[360] Those fees are generally taxable against the defeated party,[361] but if the deposition is not offered in evidence at the trial, those fees cannot be so taxed.[362] And reasoning by analogy from the taxation of attorneys' deposition fees, it should follow that magistrates' fees are not taxable on depositions which are offered in evidence, but are not admitted.[363]

§ 548. Witness fees are generally taxable against the defeated party, whether the testimony was given orally in court or by deposition before a magistrate.[364] But they are not so taxable when the testimony is taken by deposition and the deposition is not offered,[365] or if offered, is not admitted in evidence.[366] Nor will a defeated party be taxed with the fees of more than three witnesses to one fact, unless the prevailing party satisfies the court by affidavit, that the additional witnesses were really necessary to adequately support his contention on that point.[367]

[359] Tesla Electric Co. *v.* Scott, 101 F. R. 525, 1900.

[360] Tesla Electric Co. *v.* Scott, 101 F. R. 525, 1900.

[361] Fry *v.* Yeaton, 1 Cranch's Circuit Court Reports, 550, 1809.

[362] Hathaway *v.* Roach, 2 Woodbury & Minot, 75, 1846.

[363] Revised Statutes, Section 824.

[364] Revised Statutes, Section 848.

[365] Hathaway *v.* Roach, 2 Woodbury & Minot, 63, 1846.

[366] Section 547 of this book.

[367] Bussard *v.* Catalino, 2

Whether any defeated party is taxable with the fees of any witness who testified on request and without a subpœna, is an unsettled question, upon which there are two decisions in the affirmative,[368] and three decisions in the negative.[369] If it is necessary, in order to make witness fees taxable, that the witness should be served with a subpœna, it is not necessary that he should be so served by any officer. Service by a private person is sufficient.[370]

Witness fees are taxable in favor of a defendant, though his witnesses are not examined, because the action is not prosecuted; and where witnesses attend more than once at the same term, because of a stipulated postponement of the trial, their fees are to be taxed as for continuous attendance during the interim, and not as for repeated journeys from their homes.[371] Witnesses from a distance are entitled to fees for Sunday, where they are detained over that day.[372]

§ 549. The taxation of costs may properly be made at the time the judgment is entered, and that is the course which best secures the rights of the parties. But a blank may be left in the judgment for that purpose, and may be filled by a taxation made *nunc pro tunc*, after the judgment has been affirmed by the Circuit Court of Appeals.[373] Where the former practice is followed, the legality of the taxation may probably be reviewed by the Circuit Court of Appeals, if the case is taken to that forum by the de-

Cranch's Circuit Court Reports, 421, 1823.

[368] Cummings *v.* Plaster Co., 6 Blatch. 510, 1869; Dennis *v.* Eddy, 12 Blatch. 196, 1874.

[369] Dreskill *v.* Parish, 5 McLean, 213, 1851; Woodruff *v.* Barney, 2 Fisher, 244, 1862; Spalding *v.* Tucker, 4 Fisher, 637, 1871.

[370] Power *v.* Semmes, 1 Cranch's Circuit Court Reports, 247, 1805.

[371] Hathaway *v.* Roach, 2 Woodbury & Minot, 63, 1846.

[372] Schott *v.* Benson, 1 Blatch. 564, 1850.

[373] Sizer *v.* Many, 16 Howard, 98, 1853.

fendant, to secure a reversal of a judgment against him for substantial damages as well as costs, and if the court affirms or modifies the judgment as to the damages.[374] But where only nominal damages and costs are adjudged against a defendant, he cannot take the case to the Circuit Court of Appeals for the purpose of securing a reversal of the judgment or a diminution of the costs.[375] Where a judgment for costs is entered against a plaintiff on the basis of a verdict for the defendant, the plaintiff may go to the Circuit Court of Appeals on a writ of error. If he secures a reversal of the judgment for errors on the trial, there will be no occasion for the court to consider the correctness of the taxation of costs. If, on the other hand, the court finds no error upon which to ground a reversal, it will seek for no error in the taxation.[376]

The clerks of the District Courts are the primary taxing officers of those tribunals; but they perform that duty under the general or particular direction of the judges. And such directions may properly be given by a judge when entering a judgment in a case.[377]

The taxation of costs is ordinarily made by the clerk on his own motion, or at the request of the prevailing party, and without notice to the defeated party. If the latter is dissatisfied with the result, the court will hear his motion for a retaxation. If such a motion is accompanied with an explanation showing colorable ground for a claim of error in the taxation, the court will order the clerk to retax the costs, upon the mover giving the opposite party due notice

[374] Parks *v.* Booth, 102 U. S. 106, 1880.

[375] Elastic Fabrics Co. *v.* Smith, 100 U. S. 110, 1879; Paper-Bag Cases, 105 U. S. 772, 1881.

[376] Canter *v.* Insurance Companies, 3 Peters, 318, 1830; Robbins *v.* Illinois Watch Co., 81 F. R. 959, 1897.

[377] Eastman Co. *v.* Getz, 84 F. R. 462, 1898.

of the time and place thereof, and paying the costs occasioned thereby.[378] Then, if either party is dissatisfied with the result of the retaxation, he may appeal to the court; but as a foundation for the hearing of such an appeal, he must secure from the clerk an itemized bill of the charges to which he objects;[379] and as a foundation for success on that hearing, must show that part or all of those items are unwarranted by the statute, or are untaxable because they refer to evidence which was immaterial to the case, and improperly taken therein.[380] All of these proceedings must take place at the term in which the judgment is entered;[381] except in a case where a blank for costs is left in a judgment, pending a writ of error.

§ 550. A writ of error properly taken out from the office of the clerk of any Circuit Court of Appeals,[382] will carry any action at law for an infringement of a patent from any court subordinate thereto, to that court, regardless of the amount of damages in controversy;[383] and whether the case was tried by a jury, by a referee, or by a judge alone.[384] But no writ of error can carry any question of fact to a Circuit Court of Appeals.[385]

The sole function of such a writ is to secure from such tribunal a review of the questions of law involved in a case, or, where the finding below was made by a judge, and was

[378] Collins *v.* Hathaway, Olcott's Reports, 182, 1845.

[379] Dedekam *v.* Vose, 3 Blatch. 153, 1853.

[380] Ecaubert *v.* Appleton, 67 F. R. 926, 1895.

[381] Blagrove *v.* Ringgold, 2 Cranch's Circuit Court Reports, 407, 1823.

[382] West *v.* Barnes, 2 Dallas, 401, 1791.

[383] Revised Statutes, Section 699; 26 Statutes at Large, p. 826, Ch. 517, Section 6.

[384] York & Cumberland Railroad Co. *v.* Myers, 18 Howard, 246, 1855; Heckers *v.* Fowler, 2 Wallace, 123, 1864.

[385] Heckers *v.* Fowler, 2 Wallace, 123, 1864.

special, to secure a review of the question whether the facts so found are sufficient to support the judgment based thereon.[386]

Any action at law for infringement of a patent which has been pending, and has been decided in the Supreme Court of the District of Columbia, may be taken by a writ of error to the Court of Appeals of the District of Columbia,[387] and the decree of the latter court is final, no review being allowed in the Supreme Court,[388] except by certiorari.[388a]

Where a new trial is had in a District Court, or in the Supreme Court of the District of Columbia, in pursuance of a writ of error, and where the case is again taken to an appellate court by another writ of error, that upper court is bound by its own prior decision on all the points decided therein.[389]

Actions at law for infringements of patents cannot be taken by a writ of error, from any Circuit Court of Appeals, to the Supreme Court of the United States.

Any Circuit Court of Appeals may certify to the Supreme Court any pure question of law, upon which it desires the instruction of that court for its proper decision.[390] And the Supreme Court may send a certiorari to any Circuit Court of Appeals, requiring any case for infringement of a patent to be sent to the Supreme Court for its review and determination.[391]

§ 551. Bills of exception, allowed and signed, or sealed by the judge, constitute the only mode by which the ques-

[386] Revised Statutes, Section 700; Singer Mfg. Co. *v.* Cramer, 192 U. S. 265, 1904.

[387] 27 Statutes at Large, Ch. 74, Section 7, p. 435.

[388] Judicial Code, Section 250.

[388a] Judicial Code, Section 251.

[389] Standard Sewing Mach. Co. *v.* Leslie, 118 F. R. 559, 1902.

[390] Graver *v.* Faurot, 162 U. S. 435, 1896; Cross *v.* Evans, 167 U. S. 60, 1897; Judicial Code, Section 239.

[391] Judicial Code, Section 240.

tions of law that arise on the trial of a case, can be prepared for transmission to an appellate court in pursuance of a writ of error.[392] But a paper which is incorporated in the record, and which has all the substantial characteristics of a bill of exceptions, will be treated as such, even though it is not so entitled.[393] Such a document should state no more of the case than is necessary to present the questions which are reviewable in the appellate court, and which the plaintiff in error seeks to have reviewed there.[394] If those questions relate only to the pleadings, the pleadings only should be inserted in the bill of exceptions. Where those questions relate only to the competency of a witness, the bill of exceptions need only show that the witness was offered, and was accepted or rejected, as the case may be, and that such admission or rejection was duly excepted to, and, in case of a rejection of a witness to want of novelty, that due notice of the fact, to be proved by him, was served on the opposite party;[395] and where particular answers of a competent witness were excluded by the court below, the bill of exceptions must contain those answers, and must show that they were material to the issues; and where particular questions were excluded, and therefore not answered, the bill of exceptions must show what facts the party offered to prove by means of those questions, and that such facts were material to the case.[396] And where a particular question was objected to, but was admitted and was answered, the bill of exceptions must show what the answer was, in order to

[392] Insurance Co. *v.* Lanier, 95 U. S. 171, 1877.

[393] Herbert *v.* Butler, 97 U. S. 319, 1877.

[394] Hauskuecht *v.* Claypool, 1 Black, 431, 1861.

[395] Philadelphia & Trenton Railroad Co. *v.* Stimpson, 14 Peters, 448, 1840; Blanchard *v.* Putnam, 8 Wallace, 420, 1869.

[396] Railroad Co. *v.* Smith, 21 Wallace, 255, 1874.

enable the appellate court to pass upon the propriety of the evidence.[397]

§ 552. Where the questions which are sought to be brought before the Court of Appeals, relate only to the instructions which the court below gave, or refused to give to the jury, the bill of exceptions should set forth the issues of the pleadings, and the substance of the charge or refusal to charge, as the case may be, together with whatever part of the evidence is necessary to enable the Court of Appeals to decide upon the propriety, or impropriety, of the action of the court below.

The issues of the pleadings should be stated in the bill of exceptions, for otherwise the appellate tribunal cannot know whether the charge or refusal to charge, which was excepted to, was material to the case; and because the Court of Appeals will not sit to try moot issues of law, nor to establish legal propositions in cases wherein those propositions are not involved.[398]

The substance of the charge, rather than the charge *in extenso*, should be stated in the bill, because the Court of Appeals cannot afford to be occupied in listening to minute criticisms and observations upon expressions incidentally introduced into a charge for purposes of argument or illustration, and which, if they were the direct point in judgment, might need qualification, but which do not show, that the relevant law was not justly expounded to the jury.[399] But the whole substance of the charge should be stated where nothing but charged matter is excepted to; because if part is omitted, the Court of Appeals cannot know that the omitted portion did not cure the faults

[397] Lovell *v.* Davis, 101 U. S. 542, 1879.

[398] Jones *v.* Buckell, 104 U. S. 554, 1881.

[399] Evans *v.* Eaton, 7 Wharton, 356, 1822.

of the parts inserted.[400] So also, where the matter which is excepted to is a refusal to charge; not only the refused instruction, but also the whole substance of the given charge, should be inserted in the bill of exceptions; for otherwise the Court of Appeals cannot be informed whether the refused instruction was not substantially contained in the charge which was actually given; and because judges are never bound to instruct juries in the form requested, provided they substantially embody the whole of the relevant law in the charges which they give.[401]

Where nothing but charged matter is excepted to, the bill of exceptions should not contain any part of the evidence; because the only question before the Court of Appeals in such a case is the correctness of the charge.[402] But where a refusal to charge is excepted to, the bill must contain the evidence to which the refused instruction relates, or must contain a statement of facts pertinent to that point, and a statement that evidence was introduced tending to prove those facts; because no court is bound to give any charge which does not relate to the evidence, no matter how sound the proposed instruction may be, as a proposition of law.

§ 553. Specific exceptions must be made to instructions, in order to entitle the objector to a review of those instructions in the Court of Appeals. Where a requested instruction is refused, and the refusal is excepted to, that refusal will be sustained by the Court of Appeals, if the requested instruction was unsound in any particular.[403] Counsel ought therefore to carefully separate their propositions of

[400] Meyers *v.* Sternheim, 97 F. R. 625, 1899.

[401] Indianapolis & St. Louis Railroad Co. *v.* Horst, 93 U. S. 295, 1876.

[402] Pennock *v.* Dialogue, 2 Peters, 1, 1829.

[403] Indianapolis & St. Louis Railroad Co. *v.* Horst, 93 U. S. 295, 1876.

law from each other, when framing their requests for instructions, lest one erroneous proposition deprive them of the benefit of several sound ones.

§ 554. Exceptions to charges, or to refusals to charge, must be made and noted while the jury is at the bar.[404] But bills of exception may be drawn up, and signed or sealed by the judge at any time before the expiration of the term, unless the judge enforces some rule of his court which prescribes a shorter time for the preparation and presentation of such documents for his approval. And, if not otherwise too late, such bills may be prepared and signed after a writ of error has been sued out from the Court of Appeals, to transfer the case to that tribunal.[405]

[404] Phelps *v.* Mayer, 15 Howard, 160, 1853.

[405] Hunnicutt *v.* Peyton, 102 U. S. 353, 1880.

CHAPTER XIX

DAMAGES

555. The generic measure of damages.
556. Established royalties as specific measures of damages.
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558. Tests applied to royalties on behalf of plaintiffs.
559. Money paid for infringement already committed, is no measure of damages in another case.
560. Royalties reserved on sales of patents.
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565. Evidence of damages.
566. Indirect consequential damages.
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567. Exemplary damages.
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570. Counsel fees and other expenses.
571. Interest on damages.
571*a*. Damages in design cases.

§ 555. THE pecuniary injury which a plaintiff incurs by reason of a defendant's infringement of his patent, is the generic measure of the damages which that plaintiff is entitled to recover on account of that infringement.[1] Such an injury is often called the plaintiff's loss,[2] and

[1] Coupe *v.* Royer, 155 U. S. 582, 1895; Goodyear *v.* Bishop, 2 Fisher, 158, 1861; Graham *v.* Mfg. Co., 24 F. R. 643, 1881; Brickill *v.* Baltimore, 60 F. R. 98, 1894.

[2] Suffolk Co. *v.* Hayden, 3 Wallace, 315, 1865; Cowing *v.* Rum-

sometimes it is strictly that, but often it is a loss only in the sense that it is a failure to acquire a just and deserved gain.[3] Whether the injury caused to a plaintiff by an infringement was a loss in one or the other of these senses, its magnitude must always be ascertained, in order to ascertain the amount of the damages which he is entitled to recover. The amount of the profits which the defendant derived from his infringement, has no direct relevancy to the question of the plaintiff's damages. In the first place the defendant's profits as such are not recoverable in an action at law;[4] and in the second place they cannot be used as a measure of damages, because they are sometimes much larger than the plaintiff's pecuniary injury;[5] and where they are smaller, that fact is no defence to the plaintiff's right to recover full damages for the pecuniary injury which the infringement caused him to incur.[6] But where a patentee has elected to recover the infringer's profits, instead of his own damages, in an action in equity, he cannot recover, for the same infringement, his damages in an action at law.[7]

To ascertain the extent of the pecuniary injury which a particular infringement caused a particular plaintiff, it is necessary to ascertain the difference between his pecuniary condition after that infringement, and what that condition would have been if that infringement had

sey, 8 Blatch. 36, 1870; McComb *v.* Brodie, 1 Woods, 161, 1871; La Baw *v.* Hawkins, 2 Bann. & Ard. 563, 1877.

[3] Hobbie *v.* Smith, 27 F. R. 662, 1886.

[4] Brown *v.* Lanyon, 148 F. R. 838, 1906.

[5] Seymour *v.* McCormick, 16 Howard, 480, 1853; New York *v.* Ransom, 23 Howard, 487, 1859; Packet Co. *v.* Sickles, 19 Wallace, 611, 1873; Beach *v.* Hatch, 153 F. R. 763, 1907.

[6] Emerson *v.* Simm, 6 Fisher, 281, 1873; Dental Vulcanite Co. *v.* Van Antwerp, 2 Bann. & Ard. 255, 1876.

[7] Child *v.* Iron Works, 19 F. R. 258, 1884.

not occurred.[8] If he availed himself of his patent, by granting licenses to others to do the things which the defendant did without a license, then that difference consists in his not having received the royalty which such a license would have brought him.[9] If he so availed himself, by keeping his patent right a close monopoly and granting licenses to no one, then that difference consists of the money he would have realized from such a close monopoly if the defendant had not infringed; but which that infringement prevented him from receiving.[10] Therefore there are several methods of assessing damages for infringements of patents. The primary method consists in using the plaintiff's established royalty as the measure of those damages,[11] and the second consists in ascertaining those damages by ascertaining what the defendant's interference with the plaintiff's close monopoly prevented the latter from deriving therefrom;[12] and the third consists in proving what would have been a reasonable royalty.[13] It is convenient to consider these three criteria of damages separately, and in the order in which they have been stated.

§ 556. Royalties, as measures of damages, are sometimes objected to by plain-

[8] Yale Lock Co. *v.* Sargent, 117 U. S. 552, 1885.

[9] Seymour *v.* McCormick, 16 Howard, 480, 1853; New York *v.* Ransom, 23 Howard, 487, 1859; Philip *v.* Nock, 17 Wallace, 462, 1873; Clark *v.* Wooster, 119 U. S. 326, 1886; Tilghman *v.* Proctor, 125 U. S. 143, 1887; Graham *v.* Mfg. Co., 24 F. R. 643, 1881; Timken *v.* Olin, 41 F. R. 171, 1890.

[10] Philip *v.* Nock, 17 Wallace, 462, 1873; Yale Lock Co. *v.* Sargent, 117 U. S. 552, 1885; McComb *v.* Brodie, 1 Woods, 153, 1871; Covert *v.* Sargent, 38 F. R. 238, 1889.

[11] Brickill *v.* Baltimore, 60 F. R. 98, 1894.

[12] Zane *v.* Peck, 13 F. R. 475, 1882.

[13] Dowagiac Mfg. Co. *v.* Minnesota Plough Co., 235 U. S. 641, 1915.

tiffs. When invoked by a plaintiff, a royalty is liable to one class of tests, applied on behalf of the defendant; and when invoked by a defendant to limit the plaintiff's recovery, it is liable to another class of tests, applied on behalf of the plaintiff.

§ 557. A defendant may successfully object to a given royalty, as a measure of the plaintiff's damages, unless it was uniform, and was actually paid or secured before the defendant's infringement was committed, by a sufficient number of persons to show that people who have occasion to purchase a license under the patent, can afford to pay that royalty.[14] The sale of a single license is not sufficient to establish a royalty,[15] because one purchaser may give a larger sum for a license than he or any other can afford to pay; whereas such a business error is not likely to be made by a considerable number of persons when buying licenses under the same patent. The unanimous opinion of twelve average men is thought to be the most reliable criterion of guilt or innocence; but no reasonable person would hold that view, of the opinion of any one of the twelve. In like manner, the unanimous acquiescence of a considerable number of men in a particular royalty, is evidence of its substantial justice, while the acquiescence of one only of the same men would have no convincing force.

The amount of the royalty relied upon must have been actually paid or secured by the licensees in order to make it a measure of damages against other infringers. Were the rule otherwise, there would be no safeguard against

[14] Rude *v.* Westcott, 130 U. S. 152, 1889; Adams *v.* Stamping Co., 28 F. R. 366, 1886; Hunt Bros. Fruit Packing Co. *v.* Cassidy, 53 F. R. 262, 1892; Houston Ry. Co. *v.* Stern, 74 F. R. 636, 1896.

[15] Judson *v.* Bradford, 3 Bann. & Ard. 549, 1878; Vulcanite Paving Co. *v.* Pavement Co., 36 F. R. 378, 1888.

collusion between patentees and licensees for the purpose of imposing on infringers and other third parties. It follows that the mere production of a quantity of licenses, purporting to have been granted at a certain rate, cannot establish a royalty at that rate. Somebody must make oath that the ostensible price of the licenses was their true price, before they can have that effect. The oath and not the license being the best evidence of the royalty, the royalty may be proved by the oath without the production of the license, even where the license is in writing.[16]

A royalty, in order to be binding on a defendant who was a stranger to the licenses which established it, must be a uniform royalty.[17] This rule does not imply that a patentee may not change the rate of his royalty as often as he can get a sufficient number of licensees to acquiesce in such a change;[18] but it does exclude from consideration all such licenses as were given at variant rates, for no better reason than variant ability on the part of the licensees to negotiate for a license or to resist a suit for infringement.[19]

So, also, a particular royalty may be successfully objected to by a defendant, if it was not established till after the infringement sued upon was committed.[20] And

[16] Wooster *v.* Simonson, 20 F. R. 316, 1884; Timken *v.* Olin, 41 F. R. 170, 1890.

[17] Westcott *v.* Rude, 19 F. R. 833, 1884; Diamond Stone Sawing Machine Co. *v.* Brown, 155 F. R. 753, 1907.

[18] Asmus *v.* Freeman, 34 F. R. 902, 1888; Fox *v.* Knickerbocker Engraving Co., 158 F. R. 422, 1908; Consolidated Rubber Tire Co. *v.* Diamond Rubber Co., 232 F. R. 475, 1916.

[19] Black *v.* Munson, 14 Blatch. 268, 1877; United Nickel Co. *v.* Railroad Co., 36 F. R. 190, 1888.

Contra, American Sulphite Pulp Co. *v.* De Grasse Paper Co., 193 F. R. 653, 1912, holding that the lowest royalty will form the basis of damages; also Consolidated Rubber Tire Co. *v.* Diamond Rubber Co., 232 F. R. 475, 1916.

[20] Emigh *v.* Railroad Co., 6

it is probable that a defendant may avoid the application of a particular royalty by showing that a different rate was established in the particular city, county or State wherein he unlawfully availed himself of the patentee's invention.

§ 558. A plaintiff may successfully object to a particular royalty as a measure of his damages, where that royalty was established, and was intended to be established, within a particular territory only, or where it was changed or abandoned before the infringement in suit was committed. These two points rest upon obvious reasons. A patentee may wish to hold a close monopoly on his invention in Maine, while willing to grant licenses in Florida; or he may rightfully demand a much larger royalty in Minnesota than that which he is willing to accept in Texas or in Oregon. In such a case, it is clear that his Oregon royalty is not to be forced upon him for infringement committed in Minnesota; and that his business in Maine is not to be ruined by infringers who have nothing worse to fear at the end of the suit than the payment of a royalty like that established in Florida.

So, also, it has often happened, and may happen again, that an inventor is forced by poverty, or other misfortune, to accept inadequate royalities during the earlier years of his exclusive right. In such a case, it is clear that he ought to be permitted to increase the rate whenever he can get licensees to consent thereto, or to abandon his royalty altogether and hold a close monopoly on his invention, as far as he can do so consistently with licenses outstanding.

§ 559. Money paid for infringement already committed does not establish nor tend to establish a royalty.[21] A

F. R. 284, 1881; Diamond Stone Sawing Machine Co. *v.* Brown, 166 F. R. 306, 1908.

[21] Rude *v.* Westcott, 130 U. S. 152, 1889; Cornely *v.* Marckwald, 131 U. S. 159, 1889; Black

price paid to compromise a pending action, or an existing right of action, may sometimes be larger and sometimes be smaller than a proper royalty would be. It may be larger where the infringer is a person who is disinclined to litigation, or where he has some reason to fear a judgment for triple damages, or where the compromise releases him not only from damages, but also from all rights of action for infringer's profits. It may be smaller where the infringer is presumably insolvent, or where the amount involved is too small to justify the expense incident to its collection by an action at law.

§ 560. A royalty which is reserved as the whole or a part of the purchase price of a patent, is not a proper one to measure damages as against an infringer.[22] It may be too large, or it may be too small for that purpose. It will be too large when the patent is of such a nature that the buyer can afford to pay more for a close monopoly, than for a license to complete with other licensees.[23] It will be too small, where it is for the interest of the owners of the patent to subdivide the right to practice the invention. In the latter class of cases, the buyer, in order to get paid for introducing the invention and retailing the licenses, must sell them at a higher rate than that which he pays to the patentee.

v. Munson, 14 Blatch. 268, 1877; Greenleaf *v.* Mfg. Co., 17 Blatch. 253, 1879; Matthews *v.* Spangenberg, 14 F. R. 350, 1882; National Car Brake Shoe Co. *v.* Mfg. Co., 19 F. R. 517, 1884; Westcott *v.* Rude, 19 F. R. 832, 1884; Gottfried *v.* Brewing Co., 22 F. R. 433, 1884; Cornely *v.* Marckwald, 32 F. R. 292, 1885; United Nickel Co. *v.* Railroad Co., 36 F. R. 190, 1888; Keyes *v.* Refining Co., 43 F. R. 478, 1890; Ewart Mfg. Co. *v.* Baldwin Cycle-Chain Co., 91 F. R. 265, 1898; Diamond Stone Sewing Machine Co. *v.* Brown, 166 F. R. 306, 1908.

[22] La Baw *v.* Hawkins, 2 Bann. & Ard. 564, 1877.

[23] Colgate *v.* Mfg. Co., 28 F. R. 147, 1886.

§ 561. A royalty provided for in licenses to make and use, is no measure of damages for an infringement which consisted of making and selling the patented thing; nor is a royalty which was established by licenses to make and sell specimens of the invention covered by a patent, any criterion of the injury which may have been inflicted on the pecuniary interests of the owner by unlawfully making and using such specimens.[24] These rules rest upon undeniable reasons. The value of some patents resides almost entirely in the exclusive right to make and sell, while that of others consists almost wholly in the exclusive right to make and use the inventions which they respectively cover.

§ 562. In measuring damages with a royalty, due regard must be had to proportion. Where an infringement was smaller in extent or shorter in duration than the corresponding doings which were authorized by the licenses which established the royalty, it is but just that the damages should be assessed at a correspondingly smaller sum, unless there are special facts in the case which render the particular extent of the infringement immaterial to the plaintiff.[25] In like manner, damages will amount to a sum correspondingly larger than the royalty which constitutes their criterion, when the infringement in suit was larger or was longer than the doings authorized by the licenses which established the royalty.

So, also, where only part of the inventions covered by a particular patent are unlawfully appropriated by an infringer, he is liable for only an equitable proportion of the

[24] Colgate *v.* Mfg. Co., 28 F. R. 147, 1886.

[25] Birdsall *v.* Coolidge, 93 U. S. 70, 1876; Judson *v.* Bradford, 3 Bann. & Ard. 549, 1878; Wooster *v.* Simonson, 16 F. R. 680, 1883; Westcott *v.* Rude, 19 F. R. 834, 1884; Bates *v.* Railroad Co., 32 F. R. 628, 1887.

royalty which has been established for all of those inventions jointly;[26] and where a royalty has been established for the joint employment of all of the inventions covered by several patents, damages for the infringement of part of those patents may be equitably assessed by dividing that royalty into portions proportionate to the value of the several inventions covered by those patents.[27] But the plaintiff must furnish data in his evidence, upon which to make this division.[28]

§ 563. Where no established royalty is applicable as a measure of the damages caused by a particular infringement, those damages may be ascertained by the second method; that is, by finding what the plaintiff would have derived from his monopoly if the defendant had not interfered, but which he failed to realize because of that interference with his rights.

Where the owner of a patent is able to supply the whole demand for the article it covers, and where the whole demand would go to him in the absence of infringement; the losses inflicted upon him by an infringer, may consist in reducing his sales, or in reducing his prices, or in both those injurious ways. His sales may be reduced by the omission of the infringer to buy from him, while procuring infringing articles elsewhere or otherwise. His sales may also be reduced by competing sales made by the infringer to others, who in the absence of that competition, would have purchased from the patentee. The sum of the profits which the patentee would have derived from the sales which the infringer's course prevented the patentee from making, and the sum of the reduction in prices which the

[26] Willimantic Thread Co. *v.* Clark Thread Co., 27 F. R. 865, 1886; Asmus *v.* Freeman, 34 F. R. 903, 1888.

[27] Porter Needle Co. *v.* Needle Co., 22 F. R. 829, 1885.

[28] Hunt Bros. Fruit Packing Co. *v.* Cassidy, 53 F. R. 262, 1892.

infringer's course compelled the patentee to make on the sales which he did effect, or either of those elements in the absence of the other, make up the amount of the damages which the patentee is entitled to recover from the infringer, where there is no established royalty applicable to their measurement.[29] Where only part of the profits which plaintiff would have made, would be attributable to the invention, the total profits must be apportioned between those due to the invention and those due to other causes.[30]

Proof of the element of lost sales, includes evidence to show what profits the patentee would have derived from the sales which the infringer's course prevented him from making;[31] and evidence to show that he could have supplied the articles which the infringer procured elsewhere,[32] and the articles which the infringer's competition prevented him from selling to others;[33] and evidence to show that the infringer would have purchased from him, rather than do without such articles;[34] and evidence to show that

[29] Yale Lock Co. *v.* Sargent, 117 U. S. 552, 1885; Boesch *v.* Graff, 133 U. S. 705, 1891; Seabury *v.* Am Ende, 152 U. S. 569, 1894; Fitch *v.* Bragg, 16 F. R. 247, 1883; Hobbie *v.* Smith, 27 F. R. 662, 1886; Creamer *v.* Bowers, 35 F. R. 207, 1888; Am Ende *v.* Seabury, 43 F. R. 673, 1890; Force *v.* Sawyer-Boss Mfg. Co., 143 F. R. 894, 1906; McSherry Mfg. Co. *v.* Dowagiac Mfg. Co., 160 F. R. 948, 1908.

[30] Stockham *v.* Duncan, 226 F. R. 740, 1915.

[31] Cornely *v.* Marckwald, 131 U. S. 161, 1889; Bemir Box Car Co. *v.* J. G. Brill Co., 200 F. R. 749, 1912.

[32] Rose *v.* Hirsh, 94 F. R. 178, 1899.

[33] Crosby Valve Co. *v.* Safety Valve Co., 141 U. S. 452, 1891; Regina Music Box Co. *v.* Otto, 114 F. R. 505, 1902.

[34] Rose *v.* Hirsh, 94 F. R. 178, 1899; Underwood Typewriter Co. *v.* E. C. Stearns & Co., 227 F. R. 74, 1915; *contra*, Transit Development Co. *v.* Cheatham Electric Switching Device Co., 194 F. R. 963, 1912; where it is held that it is presumed that the purchasers would have bought from an authorized source if they had not bought from the defendant.

the persons who purchased infringing articles from the infringer, would have bought them from the patentee, if they could not otherwise have procured them.[35]

The first three of the five elements of evidence specified in the last paragraph must be direct and strong. The last two of those elements, though not necessarily direct, must at least be legitimate circumstantial evidence.[36] But where the defendant's infringement was wanton, that evidence needs not to be so strong, as where it was unintentional or was the result of error of information or of judgment.[37]

Proof of the element of reduced prices includes evidence to show that it was the defendant's infringement that caused, or helped to cause, the reduction of prices which the patentee was compelled to make,[38] and evidence of the extent of the reduction so caused;[39] but it does not include evidence that the patentee would have been asked to supply the particular demand which was supplied by the defendant, if the defendant had not supplied it.

Where damages cannot be assessed on the basis of a royalty, nor on that of lost sales, nor on that of hurtful competition, only nominal damages can be recovered for the infringement of a patent.[40]

[35] Dobson *v.* Dornan, 118 U. S. 18, 1885; Goodyear *v.* Bishop, 2 Fisher, 161, 1861; Magic Ruffle Co. *v.* Douglas, 2 Fisher, 340, 1863; Sargent *v.* Mfg. Co., 17 Blatch. 247, 1879; Hall *v.* Stern, 20 F. R. 788, 1884; Roemer *v.* Simon, 31 F. R. 41, 1887; Bell *v.* Stamping Co., 32 F. R. 551, 1887; Tatum *v.* Gregory, 51 F. R. 447, 1892.

[36] Covert *v.* Sargent, 38 F. R. 237, 1889; Kinner *v.* Shepard, 107 F. R. 952, 1901.

[37] Rose *v.* Hirsh, 94 F. R. 178, 1899; Regina Music Box Co. *v.* Otto, 114 F. R. 506, 1902.

[38] Ingersoll *v.* Musgrove, 3 Bann. & Ard. 304, 1878; Holmes *v.* Truman, 67 F. R. 545, 1895.

[39] Cornely *v.* Marckwald, 131 U. S. 161, 1889; Boesch *v.* Graff, 133 U. S. 703, 1890.

[40] City of Seattle *v.* McNamara, 81 F. R. 863, 1897.

§ 564. Damages for infringement by making, without unlawfully selling or using, specimens of a patented thing will be nominal only,[41] unless there is an established royalty for such making,[42] or unless the amount of a reasonable royalty can be shown or unless some definite damage can be proved on some basis not yet discoverable in the statutes or in the precedents.

§ 565. The evidence of damages must be reasonably definite,[43] in order to justify a jury in finding a verdict for more than a nominal amount. Conjecture will not perform the office of proof, nor can imagination take the place of calculation in this behalf.[44] But this rule is not to be used to defeat the ends of justice. It may happen that a plaintiff can prove the measure of his damages with precision, while unable to prove the real extent of the defendant's infringement. In such a case, the defendant can usually remove the uncertainty, because he is likely to know or be able to ascertain what and how much he has done. If, by omitting to supply the information, a defendant could avert a verdict for proper damages, he could easily defeat a meritorious cause. But the law will not allow itself to be thus circumvented. On the contrary, it is the rule that where a plaintiff introduces evidence to show that the damages were large, and to show the amount of those damages as accurately as the nature of the case permits him to do, and where the defendant offers no evidence upon the subject, it becomes the function of the jury to estimate those damages as best they can, on the basis

[41] Whittemore *v.* Cutter, 1 Gallison, 483, 1813; Carter *v.* Baker, 4 Fisher, 419, 1871

[42] Ketchum Harvester Co. *v.* Johnson Harvester Co., 8 F. R. 586, 1881.

[43] Creamer *v.* Bowers, 35 F. R. 208, 1888; Williames *v.* McNeely, 77 F. R. 894, 1896.

[44] New York *v.* Ransom, 23 Howard, 487, 1859.

of the plaintiff's evidence.[45] In making such an estimate, a jury ought to resolve every point of uncertainty against the defendant, for he had it in his power to give them accurate data upon which to compute.[46] When the patent on which suit is brought covers an improvement on an existing device, it is incumbent on the plaintiff to show how much of his loss was due to the improvement.[47] And so if he has deliberately and persistently infringed the patent.[48]

§ 566. Remote consequential damages cannot be embodied in a verdict for an infringement of a patent.[49] The instances in which such damages have been claimed are but few, but they are likely to become more numerous hereafter. It is therefore proper to mention such injuries as will probably be held to fall within such a category.

Pecuniary injury may result to a patentee from a particular infringement, in that it caused him to incur competition and consequent loss, in business outside of the patent infringed; or in that it so unexpectedly reduced the business of the patentee as to make it necessary for him to sell unpatented property at less than its real value, or to borrow money at more than a proper rate of interest, in order to meet his pecuniary engagements; or in that it encouraged other persons to infringe, from whom, by reason of insolvency or other obstacle, no recovery can be obtained; or in that such infringement caused the patentee so much trouble and anxiety that he incurred loss from inability to attend to other business. But pecuniary

[45] Stephens *v.* Felt, 2 Blatch. 38, 1846.

[46] National Car-Brake Shoe Co. *v.* Mfg. Co., 19 F. R. 520, 1884.

[47] Baker *v.* Crane Co., 138 F. R. 60, 1905.

[48] Consolidated Rubber Co. *v.* Diamond Rubber Co., 232 F. R. 475, 1916.

[49] Carter *v.* Baker, 4 Fisher, 421, 1871.

injury of either of these kinds would be such an indirect consequential matter as not to furnish any part of a proper basis for recoverable damages.

§ 566*a*. If the plaintiff has not availed himself of his patent rights by granting licenses, or his license fees are not of such uniformity as to enable him to prove his damage by proof of established royalties and in the absence of proof of lost sale or injury by competition, the only recourse of the plaintiff is to prove what would have been a reasonable royalty for the defendant to pay.[30] The problem of determining what constitutes a reasonable royalty offers many difficulties and it can at the best be no more than an estimate. In Consolidated Rubber Tire Co. *v.* Diamond Rubber Co.[31] the court in determining the amount of a reasonable royalty based its decision on established royalties which the plaintiff had secured during a period prior to that with which the accounting was concerned, as it appeared that there were no elements that could properly have operated to reduce that royalty. The principle was also anounced that in determining the amount of a reasonable royalty, room must be left for the usual profit in the business of the defendant together with the cost of production. The court said: "Whether the resulting price will be greater than what the market can bear only experience can test, which means that what the market will bear determines the license value or royalties." The essential circumstances upon which a reasonable royalty was fixed were that the plaintiffs had prior to the period of the accounting established a royalty of ten to twenty cents; that later the plaintiffs, having

[30] Dowagiac Mfg. Co. *v.* Minnesota Plow Co., 235 U. S. 641, 1915; United States Frumentum Co. *v.* Lauhoff, 216 F. R. 610, 1914.

[31] Consolidated Rubber Tire Co. *v.* Diamond Rubber Co., 226 F. R. 455, 1915.

begun to manufacture the component parts of that patent, abandoned the license agreement, charging instead a flat rate for the rubber stock which was one of the elements of the patented combination, a practice which they continued until the Circuit Court of Appeals of the Sixth Circuit in 1902 declared their patent void. In 1911, however, the patent was finally declared valid. The question at issue concerned the period from 1902 to 1911, during which the plaintiffs naturally had great difficulty in obtaining any return on their patent at all. The contracts by which they charged the flat rate specifically agreed that the price should include the rent of a brazing or welding machine and the royalty for the patent in suit together with a design patent. The "rent and royalty" so fixed was originally twenty cents, but competition cut this down first to ten cents and subsequently to five cents. In order to determine the amount of the reasonable royalty, the court went about it by "disentangling from this joint sum (rent and royalty) the amount of the reasonable royalty." The process of disentanglement is detailed in the report of the case. Another point that was announced in the case was that the amount of the defendants' profits could not be taken as an element in determining a reasonable royalty.

How an owner of a patent who had never granted licenses or manufactured under his patent, in short who had a mere unworked "paper patent," would prove the amount of a reasonable royalty under his patent, is left for future decisions to determine. Unlike the method of proving damages by showing the amount of sales lost to the plaintiff, the "reasonable royalty" doctrine is independent of that element, for it is immaterial whether or not a plaintiff has ever derived any profit from his patent at all, except in so far as profits derived from the patent

may be proper evidence upon which to affix the amount of a reasonable royalty. As the court in the Consolidated Rubber Tire Co. case said: "In estimating loss of sales, it is, of course, necessary to show that the patentee would have made the sales. Not so with licenses. Every wheel made up with Diamond rubber was a wheel upon which the plaintiffs lost a license whether they would have manufactured it or not. In contributing to that eventual infringement which occurred when the rubber was so used, they contributed to a tort, the damages from which are to be estimated by a loss of the royalties, which could have been got for that wheel. Whether the defendants could have secured better terms is beside the point. What they did was to deprive the plaintiffs of a corresponding amount of royalties on wheels, and the licenses for wheels are established."

§ 567. Exemplary damages cannot lawfully be given by a jury for any infringement of a patent.[52] The meaning of this rule is that juries are to base verdicts on plaintiff's injuries, and not on defendant's ill-deserts. Their function is to award compensation to the injured, not punishment to the injurer. The power to inflict punitive damages is committed by the statute to the judge. He may exercise that power by entering a judgment for any sum above the amount of the verdict, not exceeding three times that amount, together with costs,[53] or by declining to increase the damages beyond the amount found by the verdict; and in either case his judgment will not be overruled by the Circuit Court of Appeals, unless the evidence

[52] Wilbur *v.* Beecher, 2 Blatch. 143, 1850; Hall *v.* Wiles, 2 Blatch. 200, 1851; Parker *v.* Hulme, 1 Fisher, 56, 1849; Haselden *v.* Ogden, 3 Fisher, 378, 1868; Russell *v.* Place, 5 Fisher, 134, 1871.

[53] Revised Statutes, Section 4919; Seymour *v.* McCormick, 16 Howard, 489, 1853.

clearly demands it.[54] The costs are to be added to the increased verdict, and the judgment cannot be entered for a sum three times greater than the aggregate of the verdict and the costs; and if, for any reason, no costs are awarded to the plaintiff, that fact neither ousts the power of the court to enter a judgment for a sum larger than the verdict, nor constitutes a reason for exercising that power where no other reason exists.[55] But that power will be exercised where the defendant's infringement was deliberate and intentional, even though it may have been committed under an erroneous opinion of the plaintiff's rights;[56] or where the defendant acted in bad faith, or has been stubbornly litigious, or has caused unnecessary trouble and expense to the plaintiff;[57] but not merely because the defendant's defence was so extensive as to require great expenditure to overcome it.[58]

§ 568. Increased damages may properly be awarded by a court, where it is necessary to award them in order to prevent a defendant infringer from profiting from his own wrong, whether that wrong was intentional or was unwitting. The power conferred by the statute is general. It is not confined to awarding punitive damages, but is to be exercised "according to the circumstances of the case."[59] Among the circumstances of patent cases is the fact that

[54] Topliff *v.* Topliff, 145 U. S. 174, 1892; Kuhn *v.* Lock-Stub Check Co., 165 F. R. 445, 1908.

[55] Guyon *v.* Serrell, 1 Blatch. 246, 1847.

[56] Russell *v.* Place, 9 Blatch. 175, 1871; Peek *v.* Frame, 9 Blatch. 194, 1871.

[57] Day *v.* Woodworth, 13 Howard, 372, 1851; Teese *v.* Huntingdon, 23 Howard, 2, 1859; Weston Electrical Inst. Co. *v.* Empire Electrical Inst. Co., 155 F. R. 301, 1907; Consolidated Rubber Tire Co. *v.* Diamond Rubber Tire Co., 226 F. R. 455, 1915.

[58] Welling *v.* La Bau, 35 F. R. 303, 1888; Brown Bag Filling Machine Co. *v.* Drohn, 175 F. R. 576, 1910.

[59] Revised Statutes, Section 4919.

the profits, which defendants derive from their infringements, *are often larger than the actual damages which* those infringements cause plaintiffs to sustain. If, in such a case, the defendant is forced to pay no more than the actual damages, it is clear that he will have derived advantage from his own wrong. It would be an imperfect system of law that would thus put a premium upon its own violation. Exemplary or increased damages are not forfeitures, and liability to be compelled to pay such damages, does not give an infringer any right to withhold his testimony, as tending to criminate himself.[60]

It has been held in the seventh circuit that when the defendant has not only infringed but has also copied the plaintiff's structure so closely that he is chargeable with unfair competition, damages for the unfair competition may be recovered in the infringement suit regardless of the citizenship of the parties. The reason given is that the unfair competition is an aggravation of the infringement.[61]

§ 569. A verdict for actual damages cannot be averted by evidence that the defendant was ignorant of the existence of the patent at the time he infringed.[62] All infringers have constructive notice of all patents, because all letters patent are recorded in the Patent Office. There is no more injustice involved in the rule that infringers are bound to take notice of patents, than there is in the rule that buyers of land are bound to take notice of the real estate records, or in the rule that all citizens are bound to take notice of the laws of their country. The amount of pecuniary injury which an infringement causes a patentee,

[60] Masseth *v.* Johnston, 59 F. R. 613, 1894.

[61] Ludwigs *v.* Payson Mfg. Co., 206 F. R. 60, 1913.

[62] Emerson *v.* Simm, 6 Fisher, 281, 1873; Timken *v.* Olin, 41 F. R. 170, 1890.

is not affected by the fact that the infringer did not know of the existence of the patent which he infringed. The fact, however, that the infringer has deliberately and persistently infringed the patent after its validity has been established is sufficient to cause all doubts or question of fact to be resolved against him.[63]

§ 570. Neither counsel fees nor any other expenses incident to litigation, can be included in a verdict for actual damages in a patent case.[64] There is no more reason for allowing a successful plaintiff to recover such items, than there is for giving a similar recovery to a successful defendant. Certain expended fees may be recovered as costs by either; but no expenditures or costs can be recovered as damages.

§ 571. Interest should be allowed on royalties, from the time those royalities ought to have been paid, in all cases where a royalty is the measure of the plaintiff's damages.[65] In such a case the damages are liquidated at such time as the royalty would have been due, if the defendant had elected to purchase instead of to infringe the right to use the invention in suit. No interest is due on damages measured otherwise than by a royalty, because such damages are unliquidated until they are ascertained by an action,[66]

[63] Consolidated Rubber Tire Co. *v.* Diamond Rubber Co., 232 F. R. 475, 1916.

[64] Day *v.* Woodworth, 13 Howard, 373, 1851; Teese *v.* Huntingdon, 23 Howard, 8, 1859; Philip *v.* Nock, 17 Wallace, 462, 1873; Whittemore *v.* Cutter, 1 Gallison, 429, 1813; Stimpson *v.* The Railroads, 1 Wallace, Jr., 164, 1847; Holbrook *v.* Small, 3 Bann. & Ard. 626, 1878.

[65] McCormick *v.* Seymour, 3 Blatch. 222, 1854; Goodyear *v.* Bishop, 2 Fisher, 162, 1861: Locomotive Safety Truck Co. *v.* Pennsylvania Railroad Co., 2 F. R. 682, 1880; McNeely *v.* Williames, 96 F. R. 982, 1899; Munising Paper Co. *v.* American Sulphite Pulp Co., 228 F. R. 700, 1915; *contra*, Diamond Stone Sawing Machine Co. *v.* Brown, 155 F. R. 753, 1907.

[66] Gilpin *v.* Consequa, 3 Washington, 194, 1813.

except where the method of measurement is as definite and conclusive as it is in the case of a royalty.[67]

§ 571*a*. Damages for infringement of a design patent are fixed by a special statute, at the minimum amount of two hundred and fifty dollars, and at a maximum amount enough larger than that, to equal the total profit made by the infringer upon the infringing article or articles made or sold by him.[68] The statute does not state whether the two hundred and fifty dollars is recoverable from an infringer for each of his infringements, or is recoverable only once for all of his infringements of each claim infringed, or is recoverable only once for all of his infringements of each patent infringed, or is recoverable only once for all of his doings of a particular kind, even where those doings infringed more than one patent of the plaintiff. No court has put the first of these constructions on the statute; but each of the others has apparently been approved by at least one judicial tribunal.[69]

In order to recover under this statute, the plaintiff must show that the defendant knew of the plaintiff's design, and knew of the plaintiff's patent, or at least knew of facts which put him upon his inquiry for that patent;[70] and that he knew that the design was applied to the infringing article, without the license of the owner of the patent.[71] The last point of knowledge will be presumed against the maker; but as against a dealer whose infringement consisted in selling, or exposing for sale, articles manufactured

[67] Creamer *v.* Bowers, 35 F. R. 207, 1888.

[68] 24 Statutes at Large, Ch. 105, p. 387.

[69] Lowell Mfg. Co. *v.* Whittall, 71 F. R. 515, 1895; Hogg *v.* Gimbel, 94 F. R. 518, 1899; Gimbel *v.* Hogg, 97 F. R. 791, 1899; Frank *v.* Geiger, 121 F. R. 126, 1903.

[70] Smith *v.* Stewart, 55 F. R. 484, 1893; Lichtenstein *v.* Strauss, 166 F. R. 319, 1908.

[71] Anderson *v.* Pittsburgh Lumber Co., 47 F. R. 68, 1891.

by another, it must be proved.[72] The profits recoverable are measured by the extent to which the infringement has contributed to the entire profits on the article to which the design is applied ;[72a] and the statute is constitutional, although it provides for recoveries which are in the nature of penalties, and provides that those recoveries may be obtained upon a bill in equity for an injunction, as well as by an action at law.[73] Where the complainant in a bill in equity, waives any recovery of more than two hundred and fifty dollars, a decree will be entered for that amount, without an inquiry into the particular extent of the defendant's infringement.[74] But where there is no such waiver, the case will be referred to a master to ascertain whether and how much the defendant's profits exceeded two hundred and fifty dollars.[75]

[72] Anderson *v.* Saint, 46 F. R. 765, 1891; Gimbel *v.* Hogg, 97 F. R. 791, 1899.

[72a] Bush & Lane Piano Co. *v.* Becker Bros., 234 F. R. 79, 1916.

[73] Untermeyer *v.* Freund, 58 F. R. 211, 1893.

[74] Pirkl *v.* Smith, 42 F. R. 410, 1890.

[75] Ripley *v.* Elson Glass Co., 49 F. R. 927, 1892.

CHAPTER XX

ACTIONS IN EQUITY

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§ 572. JURISDICTION in equity, in patent litigation, is conferred upon the same courts that are authorized to exercise jurisdiction at law in that branch of jurisprudence.[1] The two kinds of jurisdiction are kept as distinct in those courts as if they were conferred upon different tribunals. Equitable relief cannot be had in any action at law; and legal relief cannot be had in any action in equity, except as incidental to some equitable relief granted, or at least rightfully prayed for, therein. The only function of actions at law in patent cases is to give damages for past infringements of patents. The principal function of actions in equity in such cases is to restrain future infringements of patents by means of the writ of injunction.[2] In every case where an injunction is proper, a court of equity, in order to avoid a multiplicity of actions, will take an account of the profits which the defendant derived from infringing the complainant's patent, and will compel the defendant to pay that amount to the complainant. And equity has jurisdiction, independent of any injunction or right to an injunction, to grant this relief relevant to profits, in all patent cases wherein some impediment prevents a resort to remedies purely legal, or wherein special circumstances render the remedy obtainable by an action at law difficult, inadequate, or incomplete.[3]

[1] Judicial Code, Section 24; Section 379 of this book.

[2] Allington & Curtis Mfg. Co. *v.* Booth, 78 F. R. 879, 1897; Truman *v.* Holmes, 87 F. R. 744, 1898.

[3] Root *v.* Railway Co., 105 U. S. 189, 1881.

§ 573. Wherever equity has jurisdiction to decree an account of the defendant's profits, it also has jurisdiction to assess the damages which the complainant sustained on account of the defendant's infringement.[4] Having ascertained the amount of both, if the profits are found to exceed the damages, the court will enter a decree for their recovery, and will do nothing further about the damages.[5] Where the accounting shows no such profits, but does show such damages, the court will enter a decree for the amount of the latter.[6] Where the accounting shows both profits and damages, and shows the latter to equal or exceed the former, a decree will be entered for the amount of the damages,[7] or for any sum not exceeding three times that amount.[8]

In assessing damages, equity follows the law,[9] and is guided by the rules and principles which are set forth in Chapter XIX of this book. But where damages are measured by a royalty, only the earned portion of the royalty should be assessed; for if the royalty assessed is one which covers the future life of the patent, its recovery would authorize a continuance of the defendant's doings, and thus defeat an injunction, and perhaps oust the jurisdiction of equity, and so eventuate in a reversal of the decree by an appellate court.[10]

[4] Revised Statutes, Section 4921.

[5] Emigh *v.* Railroad Co., 6 F. R. 283, 1881.

[6] Marsh *v.* Seymour, 97 U. S. 348, 1877.

[7] Star Salt Caster Co. *v.* Crossman, 4 Bann. & Ard. 566, 1879; Child *v.* Iron Works, 19 F. R. 259, 1884; Simpson *v.* Davis, 22 F. R. 444, 1884.

[8] Revised Statutes, Section 4919; Covert *v.* Sargent, 42 F. R. 298, 1890; Beach *v.* Hatch, 153 F. R. 763, 1907.

[9] Bancroft *v.* Acton, 7 Blatch. 506, 1870; Locomotive Safety Truck Co. *v.* Pennsylvania Railroad Co., 2 F. R. 682, 1880.

[10] Bragg *v.* City of Stockton, 27 F. R. 509, 1886; but see Campbell Printing Press Co. *v.* Man-

§ 573*a*. It has been held that, when a *prima facie* case of infringement has been made out on a motion for a preliminary injunction, the court has power to impound in the custody of the marshal or of a receiver such infringing articles as may be in the possession of the defendant, but that the court cannot order them destroyed before interlocutory decree.[11]

§ 574. The complainant in an action in equity for an infringement of a patent, may be the holder of the complete title to that patent in the territory where the infringement occurred. Where the legal title resides in one person and the equitable title in another, both should generally join in such an action.[12] But the holder of the legal title may be dispensed with as co-complainant, where the circumstances of the case are such that a decree against the equitable owner would clearly be pleadable against the holder of the legal title; [13] and the holder of an equitable title may be dispensed with, where his interest is confined to a share of the proceeds of the patent,[14] or where he has given to the holder of the legal title a written power to bring and prosecute the suit alone.[15]

Where an equitable owner brings an action in equity in the name of the holder of the legal title alone, the defendant may, by means of a motion to the court, compel the equitable owner to become a co-complainant in his own name, if that action is necessary to the protection of the rights of the defendant.[16] But where a defendant

hattan Ry. Co., 49 F. R. 930, 1892.

[11] Underwood Typewriter Co. *v.* Elliott-Fisher Co., 156 F. R. 588, 1907; see Section 644, *post; In re* Steiner, 195 F. R. 299, 1912.

[12] Stimpson *v.* Rogers, 4 Blatch. 336, 1859.

[13] Littlefield *v.* Perry, 21 Wallace, 222, 1874.

[14] Rude *v.* Westcott, 130 U. S. 152, 1899.

[15] Union Trust Co. *v.* Walker Electric Co., 122 F. R. 815, 1903.

[16] Patterson *v.* Stapler, 7 F. R. 210, 1881.

moves to make a stranger to a suit co-complainant therein, on the ground that he has an equitable interest in the matter involved, the motion will be overruled, if the person, so sought to be brought in, files in the case a disclaimer of all interest in the subject of the litigation.[17]

No grounds for a suit in equity to enjoin the use by a defendant of complainant's invention lies in favor of an applicant whose patent has not issued, even though the defendant has fraudulently secured a patent to himself for the same invention.[18]

§ 575. The defendant in an action in equity for an infringement of a patent, may generally be any person or private corporation connected with that infringement. Questions relevant to the liability of public corporations to such actions, and relevant to the respective liability of joint infringers when sued in equity, and indeed relevant to numerous points in the subject of parties, are explained and answered in the chapter on courts, parties, and causes: the seventeenth chapter in this book.

§ 576. Anciently an original bill in equity consisted of nine parts. 1. The Title of the Court. 2. The Introduction. 3. The Stating Part. 4. The Charging Part. 5. The Confederacy Part. 6. The Jurisdiction Part. 7. The Interrogatories. 8. The Prayer for Relief. 9. The Prayer for Process. By Equity Rule 25 of the Equity Rules in effect February 1, 1913, it is provided as follows:

"Hereafter it shall be sufficient that a bill in equity shall contain, in addition to the usual caption:

"First, the full name, when known, of each plaintiff and defendant, and the citizenship and residence of each

[17] Graham *v.* Mfg. Co., 11 F. R. 148, 1880.

[18] Standard Scale & Foundry Co. *v.* McDonald, 127 F. R. 709, 1904.

party. If any party be under any disability that fact shall be stated.

"Second, a short and plain statement of the grounds upon which the court's jurisdiction depends.

"Third, a short and simple statement of the ultimate facts upon which the plaintiff asks relief, omitting any mere statement of evidence.

"Fourth, if there are persons other than those named as defendants, who appear to be proper parties, the bill should state why they are not made parties—as that they are not within the jurisdiction of the court, or cannot be made parties without ousting the jurisdiction.

"Fifth, a statement of and prayer for any special relief pending the suit on final hearing, which may be stated and sought in alternative forms. If special relief pending the suit be desired the bill should be verified by the oath of the plaintiff, or someone having knowledge of the facts upon which such relief is asked."

Therefore by the specific provisions of the rule, the only parts of the ancient bill which now remain are the title of the court, the introduction, the stating part, and the prayer for relief. The subject of specific interrogatories and the procedure for obtaining discovery by means of them has been preserved in the Federal Equity procedure, however, but by means of a separate proceeding.[19] In fact prior to February 1, 1913, the plaintiff might omit the confederacy part, the charging part and the jurisdiction part which usually stated that the acts complained of were contrary to equity and that the plaintiff was without any remedy at law.[20]

§ 577. The title of the court, at the beginning of a bill, should be in the same form as at the beginning of a declara-

[19] Sections 590e and 590f.

[20] Former Equity Rule 21.

tion.[21] It is technically unscientific to entitle a bill in the name of the case, because until the bill is filed there is no such case pending. But such a title is convenient, in order to show at a glance who are the parties; and convenience may properly outweigh technical nicety. It is therefore exceptional to see a bill that is not entitled in the name of the case.

§ 578. The introductory part contains a formal address to the judges of the court in which the bill is to be filed, together with the names, residences, and the citizenship of the parties.[22]

§ 579. The stating part of a bill in equity, though differing in form from the statement of the cause of action in a declaration at law, agrees with the latter in substance, except in the following particulars: It must state that the complainant fears and has reason to fear, future infringement by the defendant.[23] It need not state past infringement, where it states a specific reason for fearing future infringement.[24] It may state infringements which were committed before the complainant obtained his title, provided that title, when obtained, covered the right of action for those infringements. Where the bill prays for a preliminary injunction, its stating part must set forth one or more of the grounds for that relief, which are explained in the chapter on injunctions.[25] Where profits are sought to be recovered, it must plainly aver that prof-

[21] Section 422 of this book; Equity Rule 25.

[22] Equity Rule 25.

[23] Edison Phonograph Co. *v.* Hawthorne & Sheble Mfg. Co., 108 F. R. 630, 1901; Weston Electrical Inst. Co. *v.* Vallee Bros. Electrical Co., 145 F. R. 534, 1906.

[24] Canton Steel Roofing Co. *v.* Kanneberg, 51 F. R. 599, 1892.

[25] Parker *v.* Brant, 1 Fisher, 58, 1850; American Bell Telephone Co. *v.* Southern Telephone Co., 34 F. R. 803, 1888; Peters *v.* Chicago Biscuit Co., 142 F. R. 779, 1905; Equity Rule 25.

its were realized by the defendant on account of the stated infringement,[26] and that the infringements complained of, or some of them took place within six years before the filing of the bill.[27] Where either damages or profits or both are sought to be recovered the bill must show proper marking under Section 4900 of the Revised Statutes or proper notice to the defendant, otherwise no recovery can be had except for infringements after suit commenced.[28] The filing of the bill is notice.[29] The bill should also allege infringements in all places where they have taken place, since if infringements merely in the district of suit are alleged, the plaintiff will be confined to them in his proof of damages and profits.[30] It need not aver that any damage was incurred by the complainant, if the action is brought for an injunction only, or for an injunction and an account of the defendant's profits. Where a former decree is invoked against the defendant, it must be stated in the bill, according to the rule of equity pleading in that behalf.[31] But it must not state any consent decree which has been made against any stranger to the suit.[32]

A bill in equity as in the case of a declaration at law must show compliance with Section 4886 of the Revised Statutes, that is, it must show the requirement as to the two years' use, that the invention had not been previously

[26] Wirt *v.* Hicks, 46 F. R. 71, 1891.

[27] See Section 435.

Contra, Fichel *v.* Barthel, 173 F. R. 489, 1909.

See Section 435.

[28] Westinghouse Electric & Mfg. Co. *v.* Condit Electric & Mfg. Co., 159 F. R. 154, 1908; Crier *v.* Innes, 170 F. R. 324, 1909.

[29] Maimen *v.* Union Special Mach. Co., 165 F. R. 440, 1908.

[30] Gray *v.* Grimberg, 159 F. R. 138, 1908.

[31] Bradley Mfg. Co. *v.* Eagle Mfg. Co., 57 F. R. 985, 1893.

[32] Western Electric Co. *v.* Williams-Abbott Electric Co., 83 F. R. 842, 1897; Haarmann *v.* Lueders, 109 F. R. 327, 1901.

patented or described in a printed publication, that the patentee is the original inventor, and also of course title in the complainant.[33] Furthermore, it must allege that the patent was issued in the name of the United States and under the seal of the Patent Office and that it was signed by the Commissioner of Patents.[34] It need not, however, negative abandonment as that is a defence.[35] It must appear that the patent was properly executed by the authorized officers of the government, although profert of the patent obviates the necessity of such an allegation and indeed of an allegation as to anything appearing on the face of the patent.[36]

The foregoing paragraph states the rules in force at any rate prior to the Equity Rules promulgated November 4, 1912. Since that time several judges have held that under Rule 25, providing that the bill shall contain "a short and simple statement of the ultimate facts upon which the plaintiff asks relief, omitting any mere statement of evidence," it is sufficient merely to allege the issuance of the patent and the chain of title.[37]

The purport of the patent is properly embodied in a bill of complaint, by making profert therein, of the patent on which the bill is based.[38] But the particular claims

[33] American Graphophone Co. *v.* National Phonograph Co., 127 F. R. 349, 1904; Moss *v.* M'Conway-Torley Co., 144 F. R. 128, 1906.

[34] Eastwood *v.* Cutler-Hammer Mfg. Co., 148 F. R. 718, 1906.

[35] Fichtel *v.* Barthel, 173 F. R. 489, 1909.

[36] Fichtel *v.* Barthel, 173 F. R. 489, 1909.

[37] Zenith Carburetor Co. *v.* Stromberg Motor Devices Co., 205 F. R. 158, 1913; General Bakelite Co. *v.* Nikolas, 207 F. R. 111, 1913.

Contra Maxwell Steel Vault Co. *v.* National Casket Co., 205 F. R. 515, 1913.

[38] International Terra Cotta Lumber Co. *v.* Maurer, 44 F. R. 618, 1890; Heaton-Peninsular Button-Fastener Co. *v.* Schlochtmeyer, 69 F. R. 592, 1895; Chin-

of the patent which the complainant intends to prosecute in the case, must be specified by their numbers in the stating part of the bill of complaint.[39]

If, however, the bill charges infringement of "the claims" of the patent in suit, it will be construed to charge infringement of all the claims, and the complainant cannot be required to amend the bill specifying the claims with respect to which infringement is claimed.[40] Neither will he be required to amend by stating the parts of defendant's structure that are alleged to infringe.[41]

If the bill is brought by an owner of a patent for the benefit of a licensee it should so state as, if the bill apparently proceeds for the interest of the owner alone, no damages can be recovered on behalf of the licensee.[41a]

Where a plurality of defendants are sued for infringing a patent, the bill ought to state that the infringement was joint,[42] though it has also been held that the point may properly be left to implification.[43]

nock *v.* Paterson, P. & S. Tel. Co., 110 F. R. 199, 1901; Fowler *v.* City of New York, 121 F. R. 748, 1903.

[39] Russell *v.* Winchester Repeating Arms Co., 97 F. R. 634, 1899; Eastwood *v.* Cutler-Hammer Mfg. Co., 148 F. R. 718, 1906.

Contra, Foundation Co. *v.* O'Rourke Eng. Const. Co., 171 F. R. 425, 1909, holding that a bill of particulars may be ordered; also for rule in second circuit, see General Electric Co. *v.* Am. Brass & Copper Co. (holding that the claims relied upon may be specified outside of the bill), 209 F. R. 237, 1911.

[40] Morton Trust Co. *v.* Am. Car & Foundry Co., 129 F. R. 916, 1904; but see Marconi Wireless Telegraph Co. *v.* New England Navigation Co., 191 F. R. 194, 1911.

[41] Morton Trust Co. *v.* Am. Car & Foundry Co., 129 F. R. 916, 1904.

[41a] Brookfield *v.* Novelty Glass Mfg. Co., 170 F. R. 960, 1909; National Metal Weather Strip Co. *v.* Bredin, 186 F. R. 490, 1911.

[42] Diamond Match Co. *v.* Ohio Match Co., 80 F. R. 118, 1897.

[43] Indurated Fibre Co. *v.* Grace, 52 F. R. 127, 1892.

§ 580. The prayer for relief should be both special and general.[44] The special part should ask for a preliminary injunction, and for a permanent injunction, and for an account of the defendant's profits, and for an assessment of the complainant's damages, and for an increase of those damages, and for costs. The prayer for general relief should be in the ordinary form of prayers of that kind.

§ 581. Although the interrogating part of the bill has been abolished by the Supreme Court,[44a] since the fourth edition of this book, and its purpose effected by the practice of filing specific interrogatories separately from the bill, the general principles of interrogatories have not been affected and therefore the discussion of the subject as found in the fourth edition is substantially repeated, the consideration of the present practice being left for later sections of this edition.[44b]

The interrogating part of the bill was designed and adapted to secure from the defendant such admissions or statements as would obviate the necessity for evidence to support those allegations of the bill which related to his doings.[45] The character, but not the extent of those doings, could properly be the subject of an interrogating part of a bill in equity in a patent case.[46] If infringement was denied the defendant could not be compelled to state in answer to interrogatories how many of the infringing articles he has made.[47]

Where an interrogating part contained more than one interrogatory, the interrogatories were required to be

[44] Equity Rule 25.

[44a] Equity Rules 25 and 58.

[44b] See Sections 590*c* and 590*d*.

[45] Coop *v.* Physical Institute, 47 F. R. 899, 1891; 48 F. R. 239, 1891.

[46] Keller *v.* Strauss, 88 F. R. 517, 1898.

[47] Lovell Mfg. Co. *v.* Automatic Wringer Co., 124 F. R. 971, 1903.

divided from each other, and consecutively numbered, and a note required to be put at the foot of the bill specifying which of those numbered interrogatories each defendant was required to answer.[48] Where the complainant in his bill waived the oath which otherwise the defendant was entitled to make to his answer, or if he required such an oath to be made only to the answer of certain specified interrogatories; the answer of the defendant, though it was in fact under oath, was not evidence in his favor on any point not covered by such specified interrogatories, unless the case was heard on bill and answer only.[49]

§ 582. The prayer for process formerly had to contain the names of all the defendants who were mentioned in the introductory part of the bill,[50] and if any of them were known to be minors, or otherwise under guardianship, that fact had to be stated in the prayer for process.[51] No mention of these requirements is made in the rules of 1913.

§ 583. The bill must be signed by one or more solicitors of record.[52] The former requirement was for the signature of "counsel."[52a]

§ 584. An oath of the truth of the bill must be appended to such a document, if it prays for a preliminary injunction.[53] Such an oath is to be made by the complainant or someone having knowledge of the facts upon which the application for the injunction is based.[54] Where the complainant is a corporation, the bill may be verified by an officer of the corporation who knows it to be true; or if no such officer possesses that knowledge, it may be

[48] Former Equity Rules 41 and 42.

[49] Former Equity Rule 41.

[50] Goebel *v.* Supply Co., 55 F. R. 827, 1893.

[51] Former Equity Rule 23.

[52] Equity Rule 24.

[52a] Former Equity Rule 24.

[53] Equity Rule 25.

[54] Equity Rule 25.

sworn to by any agent or attorney who does.[55] Where there is a plurality of complainants, the bill may be sufficiently verified by the oath of one of them, and be signed by him without any other signature, except the counter-signature of lawyer who represents all the complainants.[56]

If the bill prays for a preliminary injunction, and if its affiant can swear only on information and belief to the defendant's doings, and to their character as infringements, the application should be fortified by affidavits of persons who know what the defendant has done, and by affidavits of experts who can intelligently testify to the character of those doings, as compared with what appears to be covered by the complainant's patent. Where the complainant can positively swear to part of the allegations of his bill, and can swear to the residue only on information and belief, the bill should state the first class of facts positively, and the second class on information and belief alone; and the oath should clearly discriminate between the two classes in that behalf. It is not sufficient for the oath to state that the material averments of the bill are true;[57] nor to state that those allegations are true which render an injunction necessary and proper;[58] because such a form of oath leaves it uncertain which allegations the affiant had in mind. But positive oaths ought to be based on positive knowledge. It is much to be feared that many persons make affidavits to bills and other papers, without much reflection upon the statements they contain, or upon the wrong of falsehood, or upon the pains and penalties of perjury. The better lawyers will guard the

[55] Bank of Orleans *v.* Skinner, 9 Paige (N. Y.), 305, 1841.

[56] Cimiotti Unhairing Co. *v.* American Fur Refining Co., 120 F. R. 674, 1903.

[57] Sauvinet *v.* Poupono, 14 Louisiana, 87, 1839.

[58] Hebert *v.* Joly, 5 Louisiana, 50, 1832.

conscience of a client at this point, while the inferior ones are sometimes more apt to mislead than to protect it. Affidavits to bills, and indeed all other affidavits to be used in any civil cause, in any circuit or district court of the United States, may be taken before a commissioner of the District Court for the district; [59] or before any notary public of either of the States or Territories, or of the District of Columbia.[60]

§ 585. A bill to perpetuate testimony tending to show a particular patent to be void, may be filed and prosecuted in any United States District Court;[61] but a bill brought into court to establish non-infringement of a particular patent by the complainant will not be entertained.[62] Nor will a court of equity restrain an action, brought, or to be brought, in another court, for infringement of a patent.[63] Neither can a bill be partly based on a patent, and partly on unfair competition before the patent was in existence.[64] But a bill may properly pray that the defendant be restrained from infringing a patent and also from applying the designating name of the patented article to a spurious imitation thereof, while the patent is in force.[65]

§ 585*a*. Several bills of complaint have been filed, and other proceedings instituted in courts of equity, since 1885,

[59] Revised Statutes, Section 945.

[60] 19 Statutes at Large, Ch. 304, p. 206.

[61] Revised Statutes, Section 866; New York & Baltimore Coffee Polishing Co. *v.* New York Coffee Polishing Co., 9 F. R. 578, 1881; 11 F. R. 813, 1882.

[62] Celluloid Mfg. Co. *v.* Vulcanite Co., 13 Blatch. 375, 1876; Strait *v.* Harrow Co., 51 F. R. 819, 1892.

[63] Kelley *v.* Ypsilanti Dress-Stay Mfg. Co., 44 F. R. 19, 1890: Germain *v.* Wilgus, 67 F. R. 601. 1895; American School Furniture Co. *v.* Sauder Co., 106 F. R. 732, 1901.

[64] Ball & Socket Fastener *v.* Cohn, 90 F. R. 664, 1898.

[65] Adam *v.* Folger, 120 F. R. 264, 1903.

to restrain patentees from publishing statements favorable to their patents, and unfavorable to alleged infringers thereof, or to restrain alleged infringers of patents from publishing statements unfavorable to those patents, and favorable to such alleged infringers. In each of those cases, the court was practically asked to abridge the freedom of speech and of the press. The first two applications of the kind were made to Judge COXE early in 1886; but both of them were denied by him.[66] The next application was denied by Justice BRADLEY and Judge MCKENNAN, in October of the same year.[67] The fourth application met the same fate at the hands of Judges COLT and CARPENTER in the following November.[68] Two more such applications were denied in December, 1890, by Judges WOODS and JENKINS respectively.[69] On the contrary, one such application was granted by Judge BLODGETT in 1888;[70] and one other was ordered to be granted in 1903, by Judges WALLACE and LACOMBE.[71] Other cases where the question has been decided are found in the note.[72]

A distinction exists between the six cases in which the applications were denied, and the two cases in which they were granted. That distinction consists in the fact that in the two cases, the judges were convinced that the statements sought to be restrained, were not believed to be

[66] Chase *v.* Tuttle, 27 F. R. 110, 1886; Tuttle *v.* Matthews, 28 F. R. 98, 1886.

[67] Kidd *v.* Horry, 28 F. R. 773, 1886.

[68] Baltimore Car-Wheel Co. *v.* Bemis, 29 F. R. 95, 1886.

[69] Fougeres *v.* Murbarger, 44 F. R. 292, 1890; International Tooth-Crown Co. *v.* Carmichael, 44 F. R. 350, 1890.

[70] Emack *v.* Kane, 34 F. R. 46, 1888.

[71] Adriance, Platt & Co. *v.* National Harrow Co., 121 F. R. 827, 1903.

[72] Dittgen *v.* Racine Paper Goods Co., 164 F. R. 84, 1905; Dittgen *v.* Racine Paper Goods Co., 164 F. R. 85, 1908.

true by those who had made them. But Justice BRADLEY explained, in the case decided by him and Judge McKENNAN, that a court of equity has no jurisdiction to prevent persons from printing and publishing, and that the jurisdiction of the court is not affected by the opinion the judge may entertain on the question whether the printing and publishing sought to be restrained, was done in sincerity or was done in malice. For some reason, this explanation of Justice BRADLEY, was not met by any statement or argument in the decision of Judge BLODGETT, or in that of Judges WALLACE and LACOMBE.

This question of the jurisdiction of a court of equity to abridge the freedom of speech and of the press, was decided in the negative by the Supreme Court of the United States,[73] on a day about midway between the two decisions of Judge COXE in the same direction. That Supreme Court decision was not attended to in any of the published opinions which support the affirmative conclusion; but it was cited by Judge WOODS in his negative decision, and was held by Judge JENKINS to settle the question in the negative.[74]

§ 586. Amendments to bills may be made as a matter of course, and without costs, at any time before the defendant has responded thereto, but if such amendment be filed after any copy has issued from the clerk's office the plaintiff must at his own cost furnish to the solicitor of record of each defendant a copy of the bill as amended.[75] After an answer is put in, the complainant may obtain an order from the court or judge to amend his bill upon payment of costs, or without payment of costs, as the

[73] Francis *v.* Flinn, 118 U. S. 385, 1886.

[74] Fougeres *v.* Murbarger, 44 F. R. 292, 1890; International Tooth-Crown Co. *v.* Carmichael, 41 F. R. 350, 1890.

[75] Equity Rule 28.

judge may in his discretion direct.[76] In fact it is provided that the court may at any time, in furtherance of justice upon such terms as may be just, permit any process, proceeding, pleading or record to be amended.[77] Amendments applied for at or after the hearing of a case, are not regulated by the Equity Rules, but are allowed or refused, according to the sound discretion of the court.[78] But that discretion is governed by precedents, and those precedents indicate that amendments, at or after the hearing, will be allowed only where the bill is found to be defective in proper parties, or in its prayer for relief, or in the omission or misstatement of some fact or circumstance connected with the substance of the case, but not forming the substance itself, or where it is necessary for the complainant to take issue with new matter in the answer.[79] Where a litigation has been conducted precisely as it would have been if the proper amendment had been made before any pleading to the bill was filed, the court will allow that amendment to be filed even after the hearing, and thus make the pleadings conform to what the course of the litigation assumed them to be.[80]

§ 587. A bill needs amendment when the defendant's demurrer, plea, or answer, or under the present Equity Rules his answer or motion to dismiss points out a material fault therein, or when the complainant otherwise discovers a material error or omission which may be cured, or when the defendant's answer contains statements to

[76] Equity Rules 19 and 28.

[77] Equity Rule 19.

[78] Neale *v.* Neals, 9 Wallace, 9, 1869.

[79] Shields *v.* Barrow, 17 Howard, 144, 1854; Daniel *v.* United Shoe Mach. Co., 120 F. R. 839, 1903.

[80] The Tremolo Patent, 23 Wallace, 527, 1874; Vattier *v.* Hinde, 7 Peters, 273, 1833; Duponti *v.* Mussy, 4 Washington, 128, 1821; New York Sugar Co. *v.* Sugar Co., 20 F. R. 505, 1884; New Departure Bell Co. *v.* Bevin Mfg. Co., 64 F. R. 866, 1894.

which it is necessary to plead by way of confession and avoidance.[81] No reply by way of confession and avoidance could be made in a replication in equity,[82] under the practice prevailing prior to the present Equity Rules, and replications of all kinds have been abolished by the present rules. Where the plea or answer set up new matter, to which the complainant wished to reply by way of traverse, the general replication was the proper pleading to file for that purpose.[83] Replications have, however, as stated been wholly abolished and now the only pleadings are the bill and answer.[83a]

§ 588. Defences could formerly be made to a bill in equity for infringement of a patent, by a demurrer, or by a plea, or by an answer; or by a demurrer to part and a plea to another part, and an answer to the residue;[84] or by a demurrer to part, and a plea to the residue; or by a demurrer to a part, and an answer to the residue; or by a plea to a part, and an answer to the residue.[85] They can now be made only by answer and motion to dismiss.[85a]

It may be here noted that courts have always been loath to decide questions of validity[86] and infringe-

[81] Wilson *v.* Stolley, 4 McLean, 275, 1847.

[82] Former Equity Rule 45.

[83] Former Equity Rule 66.

[83a] Equity Rules 29 and 31.

[84] Former Equity Rule 32.

[85] Story's Equity Pleading, Section 437.

[85a] Equity Rule 29.

[86] Jackes-Evans Mfg. Co. *v.* Hemp & Co., 140 F. R. 254, 1905; Gaines *v.* Alabama Consol. Coal & Iron Co., 173 F. R. 303, 1909; Lange *v.* McGuin, 177 F. R. 219, 1910; Matteawan Mfg. Co. *v.* Emmons Bros. Co., 185 F. R. 814, 1911; Sanitary Metal Tile Co. *v.* New York Metal Ceiling Co., 188 F. R. 441, 1910; Gilbert Mfg. Co. *v.* Post & Lester Co., 189 F. R. 81, 1911; Luten *v.* Dover Construction Co., 189 F. R. 405, 1911; Burrowes *v.* Carrom-Archarena Co., 190 F. R. 204, 1911; Rose Mfg. Co. *v.* Whitehouse Mfg. Co., 193 F. R. 69, 1911; Card *v.* Standard Coal & Coke Co., 202 F. R. 351, 1912; Acme Steel Goods Co. *v.* Am. Metal Fasteners Co., 206 F. R.

ment [87] on demurrer, and that it is seldom that a defendant has succeeded on those issues by such method of procedure. The number of cases to the contrary is negligible. The demurrer, or its equivalent, the motion to dismiss, is not helped by the fact that the patent has been held void in other jurisdictions in suits against other parties.[88]

The nature and operation of demurrers and answers in equity practice, are so well understood by the profession, that little need be said about them in this book, or about their equivalents as provided by the present Equity Rules. But defences by plea may bear a longer review, because even before those rules they had largely gone out of use in the Federal courts and their principles been partly forgotten by the members of the bar, since even the former Equity Rules authorized nearly every defence to be made in an answer, that formerly required a plea for its interposition.[89] But those rules did not authorize any defendant to make a particular defence in a plea, and if unsuccessful there, to make it over again in an answer.[90] Such a plan, if allowed, would have enabled a defendant whose plea was overruled as stating no defence at law, to argue that question again on the final hearing; and it would have enabled a defendant, whose plea was proved to be false in fact, to contest that issue again on new testimony taken in pursuance of an answer. Though pleas in bar were not necessary in equity cases in the Federal courts, except under rare circumstances, they were some-

478, 1913; Krell Auto Grand Piano Co. *v.* Story & Clark Co., 207 F. R. 946, 1913; International Mausoleum Co. *v.* Sievert, 213 F. R. 225, 1914.

[87] Neidich *v.* Edwards (citing authorities), 169 F. R. 424, 1909.

[88] Voightmann *v.* Seely, 176 F. R. 371, 1909.

[89] Former Equity Rule 39.

[90] Hubbell *v.* De Land, 14 F. R. 475, 1882.

times made useful in saving time, labor, costs, and expense. It is, on these accounts, expedient to remind the reader of the general nature and operation of those pleadings, before explaining their special application under the former Equity Rules to actions in equity for infringements of patents.

§ 589. A plea in equity is a sworn [91] pleading, which alleges that some one fact, not stated in the bill, is true; or that some one statement of fact in the bill, is not true; or that some one fact, which the bill states is not a fact, is a fact nevertheless. A plea of the first kind sets up new matter by way of confession and avoidance, and is properly named an affirmative plea.[92] This is the only sort of plea in equity which was recognized in the time of Chancellor BACON.[93] A plea of the second kind traverses some one statement of fact in the bill, and is therefore properly called a negative plea.[94] This sort of plea was established by Chancellor THURLOW, and thereafter became a fully recognized part of equity pleading in England and in the United States.[95] A plea of the third kind states some fact to be true which the bill seeks to impeach.[96] It is similar to an affirmative plea in respect that it sets up matter outside of that upon which the bill is based; and it is similar to a negative plea, in that it contradicts some one statement of fact in the bill. It may therefore be properly named a composite plea. Where the single point of fact stated or denied in a plea, depends for its truth or error upon the comparative construction of two documents, the plea is

[91] Former Equity Rule 31.

[92] Daniell's Chancery Practice, Vol. 1, Chap. XV, Section 1.

[93] Beame's General Orders of the High Court of Chancery, 26.

[94] Daniell's Chancery Practice, Vol. 1, Ch. XV, Section 1.

[95] Story's Equity Pleading, Section 668.

[96] Daniell's Chancery Practice, Vol. 1, Ch. XV, Section 1.

bad and must be overruled; because such a question of construction is a question of law.[97]

But by Rule 29 of the Equity Rules, effective February 1, 1913, demurrers and pleas are abolished. The rule further provides that: "Every defence in point of law arising upon the face of the bill, whether for misjoinder, non-joinder, or insufficiency of fact to constitute a valid cause of action in equity, which might heretofore have been made by demurrer or plea, shall be made by motion to dismiss or in the answer; and every such point of law going to the whole or a material part of the cause or causes of action stated in the bill may be called up and disposed of before final hearing at the discretion of the court. Every defence heretofore presentable by plea in bar or abatement shall be made in the answer and may be separately heard and disposed of before the trial of the principal case in the discretion of the court. If the defendant move to dismiss the bill or any part thereof, the motion may be set down for hearing by either party upon five days' notice, and, if it be denied, answer shall be filed within five days thereafter or a decree *pro confesso* entered."

The effect of this rule is to leave the answer as the means of defence against all matters which might formerly have been presented by demurrer, plea or answer, or any or all of them. In addition, if the defence is on a point of law arising upon the face of the bill, the defendant has the option of making a motion to dismiss the bill without having first interposed it in his answer. If the defence is as to a point of law arising on the face of the bill the point may be called up and disposed of before final hearing at the discretion of the court. If the defence consists of matter formerly presentable by plea in bar or abatement it

[97] Lowery v. Aluminum Co., 56 F. R. 495, 1893.

may be separately heard and disposed of before the trial of the principal case in the discretion of the court.

As a matter of pleading it has therefore become unnecessary to determine how the twenty-eight defences enumerated or any of them, may be interposed except as between a motion to dismiss and an answer. It is important, however, to know just which of them might formerly have been presented by plea in bar or abatement in order that the parties may know whether or not a particular defence may be separately heard before the trial of the principal case and thus dispense with the labor and expense of preparing for the trial of all of the issues. The discussion of the various methods by which each of the twenty-eight defences could be interposed as found in the fourth edition of this book is therefore retained in this edition.

§ 590. The general rule of equity pleading requires that when a defendant files a plea to a bill in equity, the complainant should satisfy himself whether it states a good defence to the bill, or to that part of the bill to which it refers, and should ascertain whether it is true in point of fact. If he is sure that he can prove it to be false, he should take issue upon it,[98] by filing a replication.[99] If he has any ground for fear that the plea is true in fact, and any ground for hope that it is bad in law, his true course is to set the plea down for argument; [100] which setting down is equivalent to a demurrer to the plea.[101] If, on the argument, the plea is held to state no fact which constitutes a defence to the bill, or to any part thereof, it will be overruled, and the defendant will be permitted to file an answer

[98] Former Equity Rule 33.

[99] Daniell's Chancery Practice, Vol. 1, Ch. XV, Section V.

[100] Former Equity Rule 33.

[101] Davison's Ex'rs *v.* Johnson, 16 New Jersey Equity, 113, 1863; Korn *v.* Wiebusch, 33 F. R. 51, 1887; Burrell *v.* Hackley, 35 F. R. 834, 1888; Cook *v.* Sterling Electric Co., 118 F. R. 47, 1902.

setting up whatever other defences he can.[102] But if the plea is held on the argument to state a good defence to the bill, or to that part of the bill to which it applies, it will be allowed, and thereupon the complainant may ask leave to amend his bill; [103] or if he cannot truly amend it so as to make it avoid the plea, he must file a replication.[104] Thereupon, if the plea is proved to be true, the fact thus established will avail the defendant, as far as, in law and equity, it ought to avail him; [105] and if the plea is proved to be false, the defendant must file an answer to the bill.[106] Only one defence can be made to a bill in a plea, unless the court, in order to avoid a special inconvenience, gives a special permission to a defendant to make a plurality of defences in that method of pleading.[107] With that exception, after any plea has been overruled, the defendant, if he has other defences to interpose, must interpose them in an answer.[108] This outline of the principles of pleas in equity should be kept in mind by the reader while perusing sundry of the sections which follow, for, though the name has been abolished, the practice has been retained in its essence, it merely being changed sufficiently to relieve

[102] Former Equity Rule 34; Societe Anonyme *v.* General Electric Co., 97 F. R. 606, 1899.

[103] Edison Electric Light Co. *v.* Equitable Life Co., 55 F. R. 481, 1893.

[104] Story's Equity Pleading, Section 697; Daniell's Chancery Practice, Vol. 1, Ch. XV, Section V.

[105] Pearce *v.* Rice, 142 U. S. 42, 1891; Horn *v.* Detroit Co., 150 U. S. 610, 1893; Green *v.* Bogue, 158 U. S. 500, 1895: Elgin Wind Power Co. *v.* Nichols, 65 F. R. 218, 1894; American Graphophone Co. *v.* Edison Phonograph Works, 72 O. G. 1350, 1895.

[106] Dalzell *v.* Dueber Mfg. Co., 149 U. S. 326, 1893; Westervelt *v.* Library Bureau, 118 F. R. 824, 1902.

[107] Story's Equity Pleading, Section 657; Wheeler *v.* McCormick, 8 Blatch. 267, 1871; Noyes *v.* Willard, 1 Woods, 187, 1871; Giant Powder Co. *v.* Nitro Powder Co., 19 F. R. 510, 1884.

[108] Former Equity Rule 34.

defendants of the useless expense and trouble to which they were formerly often subjected.

§ 590*a*. With the radical changes in the system of equity pleading introduced by the Equity Rules promulgated in 1912, whereby among other things it was required that the complaint should consist merely of a short and simple statement of the ultimate facts upon which the plaintiff asks relief, omitting any mere statement of evidence,[109] and that the answer should in short and simple terms set out the defences, omitting any mere statement of evidence and specifically admitting or denying or explaining the facts set up in the bill,[110] came the necessity for the means of compelling an opponent to amplify and make more definite his pleading, which means are known in most code jurisdictions by the term "bill of particulars." The rule relating to this procedure provides that a further and better statement of the nature of the claim or defence, or further and better particulars of any matter stated in any pleading may in any case be ordered upon such terms as to costs and otherwise as may be just.[111] While the expression "bill of particulars" is not found in the rule, it is obvious that what is meant by the rule and intended to be provided for is the bill of particulars which is an adjunct of common law and codes pleading, such as equity pleadings, in so far as their method of stating facts is concerned, have actually become.

A typical illustration of the procedure referred to is found in the New York Code of Civil Procedure (Section 481) requiring that the complaint shall consist of a "plain and concise statement of the facts constituting each cause of action without unnecessary repetition" and in Section 531 of the same code which allows the court to "direct a

[109] Equity Rule 25.
[110] Equity Rule 30.
[111] Equity Rule 20.

bill of particulars" of the claim of either party to be delivered to the adverse party. Substantially similar provisions exist in most of the other code States. It is beyond the scope of this work to enter into any detailed discussion of the functions of a bill of particulars, but it should be noted that the procedure can only be used as a means of informing the party instigating it of the precise nature and character of the cause of action or defence of the opposite party. The bill of particulars is nothing more or less than an amplification of general allegations set up in the pleading which of themselves do not clearly apprise the opposite party of the nature of the claim or defence and thereby create such a situation as would cause surprise at the trial. Such being the function of the bill of particulars, the fact that the party demanding the bill was personally familiar with the facts in respect to which the amplification is asked, cannot avail him, since it is not ignorance of facts which entitles a party to a bill of particulars, but ignorance of the nature of the claim or defence of his opponent. For further consideration of the foregoing principles, reference is made to the various works on pleading and practice and to the decisions dealing with the subject which may be found in the reports of all the code States.

§ 590*b*. The question has already, at this writing, been presented as to whether or not a plaintiff should be compelled to fix the date of his invention. It has been held in the Eastern District of Pennsylvania,[112] that such a requirement would not be made, the court remarking that it "would be an innovation in pleading and a dangerous one." It is not readily apparent where the danger lies in compelling a party to amplify his pleading in a patent cause to the extent of stating when his invention

[112] Todd *v.* Whitaker, 217 F. R. 319, 1914.

was made or at any rate what date he expects to establish as the date of his invention. This appears to be the view of the Judges of the District Court for the Southern District of New York, where the announced practice is to oblige each party to inform the other of the respective dates of invention which they intend to prove. That is, the plaintiff is compelled to inform the defendant of the date of invention of the patent in suit, and the defendant is obliged to inform the plaintiff of the date of invention of any inventions by which he expects to anticipate the plaintiff's invention.[113] In carrying out the interchange of dates it may be noted that in the practice in the Southern District of New York the interchange is required to be simultaneous.

A bill of particulars of the answer will not be required stating in whose presence an alleged prior use or invention occurred, but a defendant will be required to give a description of the thing or things invented or used or the ingredients of a composition or manufacture or of a process involved or practiced in its production.[113] The latter requirement is presumably subject to the condition that a defendant may refuse to disclose his process if the process is secret. Also it would seem that these requirements would apply to the defendant's process only when it or a similar process is set up as an anticipation, as, if the purpose of the inquiry is to ascertain the nature of the infringing article the result desired should properly be effected by means of interrogatories as will appear in the discussion of that procedure.

Another respect in which a bill of particulars has been allowed in the Southern District of New York is that requiring the defendant to name the patents and publica-

[113] A. B. Dick Co. *v.* Underwood Typewriter Co., 235 F. R. 300, 1916.

tions that would be offered in evidence at the trial of the cause to support the contention of anticipation, and of those so offered, on which of them the defendant will rely at the trial in support of the contention of anticipation.[113] This requirement, however, is subject to a very important modification. As Judge LEARNED HAND says in Grand Rapids Show Case Co. *v.* Strauss:[114] "It is impossible under the statute to prevent the defendant from pleading as many patents in anticipation as he desires, but it is obviously preposterous to suppose that the invention has actually been patented by anything like the number of patents impleaded. I recognize that the question of anticipation is bound up in the question of interpretation and that the defendant must have some latitude until he knows what view the court will take of the plaintiff's invention; but a good excuse should not pardon a bad practice. With every latitude the number of patents which can serve as anticipations must be very limited. It is proper, therefore, for the plaintiff in a case such as this to call on the defendant to declare in advance which patents he seriously contends to be anticipations and the court will so direct the defendant." Judge HAND, however, realizes that a defendant cannot be compelled, by imposing the usual penalty, to file such a bill of particulars, and therefore states as follows: "If this order carries no sanction, however, it will not be effective and the only sanction can be in costs. If at the conclusion of the case the judge who tries it is satisfied that the defendants could, without any reasonable danger to themselves, have cut down the patents on which they rely for anticipation below the number given to the plaintiff in response

[113] A. B. Dick Co. *v.* Underwood Typewriter Co., 235 F. R. 300, 1916.

[114] Grand Rapids Show Case Co. *v.* Strauss, 229 F. R. 199, 1915.

to the order of the court, the court will, however, deprive the defendant of costs or award costs against defendants notwithstanding their success."

A contrary view is taken in the Northern District of Ohio where it is held that such a bill of particulars may be absolutely required.[115] It does not appear, however, in the decision of that district, what can be done in case the defendant sets forth in his bill of particulars all the patents and publications which he has named in his answer. Under ordinary circumstances a failure to file a bill of particulars as ordered debars the party who should file it from giving evidence on the subject-matter of the bill, but it is obvious that such a penalty could not be imposed under the circumstances now being considered.

In theory there appears to be a fundamental objection to requiring a defendant to specify in advance what patents he intends to rely upon at the trial. That objection is that it is distorting the principles and function of a bill of particulars. When a defendant sets up a certain number of patents as anticipatory of the patent in suit with the allegations required by the Revised Statutes, he has set forth in that respect a pleading which is perfectly clear on its face. Whether or not he ever expects to be able to prove the allegations of his pleading is an entirely different question from the question of the fulness of his allegations. The requirement of a bill of particulars in such a case amounts to nothing more or less than compelling the defendant to cut down his pleading and is in effect compelling him to state whether or not he really means what he says. However, all attorneys conversant with the way in which answers are prepared in patent causes will recognize that if the foregoing statements are correct, theory seriously conflicts with practice and a requirement

[115] Coulston *v.* H. Franke Steel Range Co., 221 F. R. 669, 1915.

of the nature of that in the Grand Rapids Show Co. case cannot but help reduce the issues in almost every patent cause to their proper proportions.

Another requirement that has been imposed in the Southern District of New York is that of obliging the defendant to set forth patents and publications that will be offered in evidence at the trial of the cause to illustrate the prior state of the art.[113] The propriety of this requirement, however, either in theory or in practice, is less clear than the propriety of the requirement of stating what patents and publications are to be used as anticipations. When used as anticipations patents and publications are the things themselves, that is, the documents or ultimate facts which are to be proved and as such the designation of those which will be used as a defense might properly come within the scope or to at least effect the object of a bill of particulars. But when patents and publications are used to show the prior state of the art they are evidence and nothing more, and there appears to be no justification in equity for compelling an opponent to disclose the evidence which he will use to establish his claim or defence. The state of the art is the fact to be proved, and it would seem to be properly within the theoretical scope of a bill of particulars to require the state of that art as it will be shown to be set forth, although the practical difficulties of doing so are too obvious to require comment. The prior state of the art is evidenced by the sum total of human knowledge of that art, and what that knowledge is, is the fact to be proved. That knowledge may be evidenced by patents, periodicals, treatises, dictionaries, books, practices of a particular trade or community of people, or in brief, by showing any circumstances that would in-

[113] A. B. Dick Co. *v.* Underwood Typewriter Co., 235 F. R. 300, 1916.

dicate a knowledge existing at the time involved in issue. To require the defendant to produce his evidence to prove the state of the prior art even though he is required to produce only patents and publications, is therefore imposing upon him a requirement that is wholly outside the purpose and functions of the bill of particulars.

The names of those having prior knowledge or having made prior use of an invention in suit should obviously be required on the same terms and conditions as a statement of anticipating patents and publications, but the names of the witnesses to the prior knowledge or use should not, of course, be required.

In the Northern District of Ohio a bill of particulars will be required of the defendant setting forth in what respects each of the patents pleaded in the answer discloses any of the elements or combinations of elements described in the letters patent in suit, and also in what respect they negative the novelty and invention of the device shown and described in complainant's letters patent.[115] The bill of particulars, however, will not be granted compelling a plaintiff to point out in what particular part of an infringing machine each element of the patent in suit is embodied, at any rate in ordinary cases, although a plaintiff probably would be required to advise the defendant what parts of the defendant's machine infringed.[116] The case holding the foregoing proposition contains an instance of the confusion sometimes existing between the functions of a bill of particulars and those of interrogatories.

§ 590*c*. Prior to the year 1913 when the present equity rules went into effect, a most important part of nearly every bill in equity consisted of the specific interrogatories

[115] Coulston *v.* H. Franke Steel Range Co., 221 F. R. 669, 1915.

[116] Gennert *v.* Burke & James, Inc., 231 F. R. 998, 1916.

which were in fact nothing more or less than an amplification of the charging part of the bill. While the charging part of the bill has been eliminated from equity practice by Equity Rule No. 25, the specific interrogatory has been retained, with the additional features, however, that the defendant may now have the benefit of interrogatories to sustain his defence, as the plaintiff formerly could have the benefit of them to sustain his bill, and with the further feature that interrogatories have been taken out of the pleadings and made a separate and distinct procedure.

It should be added that there is one further change of a more or less important character whereby it is provided that if any party to the cause is a public or private corporation any opposite party may apply for an order allowing him to file interrogatories to be answered by any officer of the corporation, and that an order may be made for the examination of such officer as may appear to be proper upon such interrogatories as the court or judge shall think fit. It has not yet been decided, nor so far as the reports show, has the question been raised whether or not under the present rule interrogatories may be addressed directly to a corporation party to be answered by the corporation as such, without the application for such an order as is mentioned in the foregoing paragraph. In principle and according to the equity practice prior to the present rules, there is no objection to such a method of procedure and it is not seen how the present rules have changed the liability of a party corporation to answer interrogatories.

Under the former practice every bill which was not a pure bill for discovery, combined the functions both of a bill for discovery and a bill for substantive relief. The bill for discovery could be and frequently was filed against a corporation as is likewise the case with the com-

bined bill for discovery and substantive relief. The incidents of the pure bill for discovery were, however, carried into the bill for combined discovery and substantive relief, and as discovery could be enforced only against a party to the action in the case of the pure bill for discovery, so it could be enforced only against a party to the action in the case of the combined bill for discovery and substantive relief. This made it necessary, whenever discovery was desired from an officer of a corporation defendant, to join the officer as a party to the suit. It would seem, therefore, that the provision of Rule 58 above noted could have no other purpose than to dispense with this cumbersome and unnecessary requirement of equity procedure in cases where discovery only as distinguished from substantive relief is desired from an officer of a defendant corporation.

One other feature should be noted. The rule permits a party to file interrogatories for the discovery by the opposite party of *facts and documents only, material to the support or defence of the cause.* Under the former practice interrogatories contained in the bill, as also charges of evidence, were directed solely to the elicitation of facts which would support the cause of action set forth. It would seem, therefore, that the rule in no way changes this practice with the exception that the defendant may now file interrogatories for the discovery of facts and documents material to his defence as the plaintiff formerly could in support of his bill. In other words, the interrogatories are directed to the discovery of such facts and documents as will sustain the claims of the party filing the interrogatories and are not intended to enable the party to ascertain what facts or documents the opposite party would produce to sustain the latter's claim. The latter result in so far as it consists of apprising a party of the

nature of the claim or defence of the opposite party is obtained by the procedure for the bill of particulars. Beyond these limitations, however, neither the bill of particulars nor the specific interrogatories as the case may be, can go.

A detailed discussion of the principles stated in the foregoing paragraph is of course not within the general scope of a work of this character, and therefore reference is made for a further consideration of them to the standard works on equity practice. The application of the rule, only in so far as it has to do with patent causes, is considered here.

§ 590*d*. The general purpose of the present procedure involving specific interrogatories purports to be stated in Bronk *v.* Charles H. Scott Co.[117] An examination of that case shows that a plaintiff was compelled to state in answer to interrogatories whether or not his charge of infringement was based on any other or different acts of the defendant than the manufacture or sale of certain articles described and exhibited in the answer. This is obviously compelling the plaintiff to disclose his own case and has been very properly criticised for that reason by the District Court for the Eastern District of Tennessee [118] wherein Judge SANFORD made a comprehensive statement of the purpose and scope of interrogatories under the present rules as follows:

"Prior to the adoption of this Rule 58 it was well settled that a complainant was entitled to a discovery of such facts and documents only as would aid in the maintenance of his own title or cause of action and not to matters that relate exclusively to the defendant's title or ground of defence and that interrogatories which went beyond this

[117] Bronk *v.* Charles H. Scott Co., 211 F. R. 338, 1914.

[118] J. H. Day Co. *v.* Mountain City Mill, 225 F. R. 622, 1915.

and sought a disclosure of the defendant's title or claim having no relation to the complainant's title or cause of action were inquisitorial and unwarranted. . . .

"After careful consideration I think it is clear that the 58th equity rule was intended merely to change the procedure in reference to obtaining discovery and to extend this right as well to defendant as to complainant, and was not established to change the long established rule in reference to the subject-matter of such a discovery, or to extend such right in favor of either party beyond the matters relating to his own ground of action or defence and enable him to obtain discovery in reference to matters relating solely to the ground of action or defence of the other party. In other words, under this rule the plaintiff's right of disclosure extends only to facts resting upon the knowledge of the defendant or documents in his possession material to the support of the plaintiff's case; and the defendant's correlative right of discovery only to facts and matters material to his defence."

Judge SANFORD also criticised the case of P. M. Co. *v.* Ajax Rail Anchor Co.,[119] on the same ground. The interrogatories in the P. M. Co. case required the plaintiff to describe the element in defendant's device which the plaintiff considered to be a particular element mentioned in the patent in suit, and also to state whether a certain phrase found in the claims referred to a certain element of the structure, but the court said that the matter called for was purely evidentiary and based its decision on that ground. According to the J. H. Day Co. case and to the general principles covering specific interrogatories, another ground would have been that the interrogatories required the plaintiff to disclose his case. For the same reason the court refused to allow interrogatories requiring

[119] P. M. Co. *v.* Ajax Rail Anchor Co., 216 F. R. 634. 1914.

the plaintiff to state whether he had manufactured devices under his patent, or whether he had any interest in any other patents, or whether he considered defendant's device to infringe such other patents, or whether he contemplated bringing other patent suits, and whether or not he had knowledge of one of certain letters pleaded in the answer. These latter interrogatories are subject to the same criticism as those first mentioned in connection with the P. M. Co. case. An interrogatory which inquired upon which of the five claims of the patent complainant relied, although probably more proper for a motion for a bill of particulars, was, if the technical objection be disregarded, properly allowed.[120]

In Luten *v.* Camp,[121] the interpretation given to the opinion in the P. M. Co. case was that it is not proper to inquire into mere evidence of facts tending to prove the nature of the case, or *facts tending to prove the facts* upon which it is based, not that it is not proper to inquire into the facts upon which the case is based. If by the latter clause of the sentence the court means that it is proper only to inquire into ultimate facts which set forth the cause of action, the statement adds much confusion to the questions of practice involved in the employment of interrogatories, for a pleading must, of course, in order to set forth a cause of action or defence, set forth all the ultimate facts which are to be proved. In the Luten against Camp case the plaintiff alleged infringement of his patents by the defendants, some of whom contracted with the others to erect an alleged infringing structure, and the complainant further alleged that the contractor delivered plans and specifications to the defendants for whom the bridge

[120] See Window Glass Machine Co. *v.* Brookville Glass & Tile Co., 229 F. R. 833, 1916.

[121] Luten *v.* Camp, 221 F. R. 424, 1915.

was to be built with the intent and purpose that the plans and specifications should be used as the basis for the contract. The court, therefore, very properly overruled objections filed by the defendant to interrogatories which inquired relative to the connection of the defendants with the blueprints and contracts. Interrogatories inquiring of the defendants as to the precise showing of the blueprints, however, were held improper, the court stating that the plaintiff was entitled to have an order made for their production and inspection, but as the blueprints themselves were the best evidence of their contents the defendants could not be required in advance of the trial to furnish copies, nor could they be questioned as to their contents unless the originals being in their possession were produced or were shown to have been destroyed or lost or beyond the power of the plaintiff to produce.

Inasmuch as Rule 58 of the Equity Rules specifically allows a party discovery of documents by means of interrogatories, and on the assumption that the principles of discovery through specific interrogatories have not been altered by the change in practice, it is not clear as a rule of practice why a party is not entitled to compel his opponents to produce originals or copies of any documents within the latter's control and relevant to the party's claim or defense as the case may be.

Another form of interrogatory held objectionable in the Luten case was that which called for a comparison between certain sets of blueprints inquired about and a set of blueprints attached to the interrogatories. The objection found by the court was that it was a matter to be established by expert testimony or by inspection of the documents at the trial and because the opinion of the defendants was merely evidentiary in character and not a fact in support of the plaintiff's cause. Also interrogatories in-

quiring as to the contents of documents which it was within the power of the proponent of the interrogatories to produce were held objectionable. "Equity Rule 58" said the court, in Window Glass Co. *v.* Brookville Glass & Tile Co.,[122] "was not intended to be used to impose unreasonable burdens on parties or to require of parties opinions either as to the reading of contracts or as to the functions of particular parts of the machinery."

The same thing has been substantially said in other cases cited in the notes to this section. The court making the foregoing statement further added that interrogatories were intended to aid a party in making out his case where the ascertainment of facts in support of the defences of the cause was difficult, referring to a line of cases holding to the doctrine that discovery will not be permitted if the facts can be otherwise procured, and stating that in reference to an interrogatory asking the defendant to disclose the nature of his alleged infringing structure that the plaintiff could easily procure the right to inspection according to the ancient method. Interrogatories inquiring of the plaintiff when or where a particular part of the plaintiff's apparatus was first used by the plaintiffs were criticised by the court as a part of that well-known practice of attempting to ascertain the opponent's case, anciently and now characterized as a "fishing expedition."

F. Speidel Co. against N. Barstow Co.[123] states that Equity Rule 58 merely adopts the English rule of Order XXXI "Discovery and Inspection" of the rules of the Supreme Court of 1883 and, referring to the "Yearly Practice for 1912 by Mackenzie & Chitty, Vol. I, 370"

[122] Window Glass Machine Co. *v.* Brookville Glass & Tile Co., 229 F. R. 833, 1916.

[123] F. Speidel Co. *v.* N. Barstow Co., 232 F. R. 617, 1916.

says that the provision for interrogatories was not intended to give any right to discovery that did not exist before or take away any previously existing right to production on any ground of privilege. And the court further says that it seems that the purpose of the practice was to enable a party to establish his case rather than to seek information as to the evidence or witnesses of the other party. Accordingly the court held objectionable an inquiry as to what were the steps of a process practiced by a prior corporation user and when and where such process was practiced and by what persons, together with their names and addresses. While this interrogatory was properly denied, it would seem to be well within the scope of a bill of particulars for a defendant who sets up a corporate prior user to be compelled to state the particular person or persons who actually practiced the use and the places where it was practiced. Of course the information did not tend to establish the plaintiff's case, but as the name of the actual individual user was merely a particularization of the allegation of the answer, it would seem to be proper that the information should be supplied to the plaintiff in some form or other, preferably by a bill of particulars, unless the court were willing to disregard the technicality as in the case of Gennert against Burke.[124]

Another point was raised in the F. Speidel Co. case in connection with the interrogatory inquiring as to whether or not the defendant had practiced the process of the patent in suit. It appears to be a principle of equity that discovery will not be allowed in suits in which a penalty may be inflicted on the offender, and consequently the court held that inasmuch as a defendant may be held liable in a patent infringement suit for treble damages a patent infringement suit was within the scope of that rule

[124] Gennert *v.* Burke & James, Inc., 231 F. R. 998, 1916.

of equity, and that therefore such an interrogatory was objectionable.

§ 591. The twenty-eight defences which may be made to actions at law for infringements of patents,[125] may all be made to actions in equity based on such causes; and the latter actions are also liable to two other defences, to which actions at law are not subject. These are non-jurisdiction of equity, and laches. It is convenient first to explain the facts which may support each of these two defences, and then state the various methods in which each may be interposed, and afterward to review the twenty-eight defences in their order, and to explain wherein any of them differ in their operation in equity, from their operation at law, and to state what forms of pleading are suitable to each, under the varying circumstances of patent litigation.

§ 591*a*. It is no defense to a bill for infringement that the plaintiffs have entered into a combination or conspiracy among themselves or with third parties to violate the so-called Sherman Anti-Trust Act (Act July 2, 1890, c. 647, 26 Stat. 209).[126]

§ 591*b*. Under Rule 30 of the Equity Rules promulgated November 4, 1912, the defendant may set forth any counterclaim arising out of the transaction which is the subject-matter of the suit, and may without cross-bill, set out any set-off or counterclaim against the plaintiff which might be the subject of an independent suit in equity against him.[127] This rule has been construed to cover

[125] Section 440 of this book.

[126] Independent Baking Powder Co. *v.* Boorman, 130 F. R. 726, 1904; Motion Picture Patents Co. *v.* Laemmle, 178 F. R. 104, 1909; Motion Picture Patents Co. *v.* Ullman, 186 F. R. 174, 1911; U. S. Fire Escape, etc., Co. *v.* Joseph Halstead Co., 195 F. R. 295, 1912; Fraser *v.* Duffey (citing authorities), 196 F. R. 900, 1912.

[127] Carnegie Steel Co. *v.* Colorado Fuel & Iron Co., 165 F. R. 195, 1908; American Sulphite

only a counterclaim proper arising out of the transaction which is the subject-matter of the suit in spite of the words "which might be the subject of an independent suit." [128] A cause of action by the defendant for infringement by the plaintiff of patents relating to the same subject-matter as that of the patent in suit has been held proper matter for a counterclaim under the rule; [129] but not when the patents alleged by the defendant to have been infringed do not relate to the same subject-matter.[130] (For other cases construing the rule see note.[131]) A counterclaim for unfair competition involving the respective rights of the parties under the patents involved in an infringement suit has also been held to be proper.[132]

If the counterclaim sets forth matter which is cognizable by a Federal court by reason of the subject-matter, as, for example, infringement of a patent, it is proper even though the court might not have been able to acquire original jurisdiction had the defendant brought an independent suit. The plaintiff is deemed to have waived

Pulp Co. *v.* Crown-Columbia Pulp & Paper Co., 169 F. R. 140, 1909; W. W. Sly Mfg. Co. *v.* Central Iron Works, 201 F. R. 683, 1912.

[128] Terry Steam Turbine Co. *v.* B. F. Sturtevant Co., 204 F. R. 103, 1913; Williams Patent Crusher, etc., Co. *v.* Kinsey Mfg. Co., 205 F. R. 375, 1913.

Contra, Electric Boat Co. *v.* Lake Torpedo Boat Co. (reviewing authorities), 215 F. R. 377, 1914.

[129] Marconi Wireless Telegraph Co. *v.* National Electric Signal Co., 206 F. R. 295, 1913; but see Christensen *v.* Westinghouse Traction Brake Co., 235 F. R. 898, 1916.

[130] Adamson *v.* Shaler, 208 F. R. 566, 1913; Klander-Weldon Dyeing Machine Co. *v.* Giles, 212 F. R. 452, 1914.

[131] Salt's Textile Mfg. Co. *v.* Tingne Mfg. Co., 208 F. R. 156, 1913; Vacuum Cleaner Co. *v.* American Rotary Valve Co., 208 F. R. 419, 1913; Christensen *v.* WestinghouseTraction Brake Co., 235 F. R. 898, 1916.

[132] United States Expansion Bolt Co. *v.* H. G. Kroucke Hardware Co., 216 F. R. 186, 1914.

the question of jurisdiction of the person in such a case. But if the Federal court would have jurisdiction of the counterclaim only by reason of diversity of citizenship, as, for example, in the case of unfair competition, there is no jurisdiction unless the requisite diversity exists.[132a]

§ 592. Non-jurisdiction in equity is a defence which will succeed in any infringement case, unless an injunction is granted, or at least rightfully prayed for in that case, or unless some impediment prevents a resort to remedies purely legal, or unless the circumstances of the case render the remedy obtainable by an action at law, difficult, inadequate, or incomplete.[133] Equity jurisdiction is therefore absent where the patent expired before the bill is filed.[134] But a bill for infringement of both an expired and unexpired patent states grounds for equitable relief which alleges that the defendant has combined the devices of both patents in a single machine, so conjoined that it is practically impossible to apportion the damages and profits between the two patents.[135] And it has even been held that, where a number of patents are sued on in separate suits between the same parties, the patents pertaining to the same subject-matter, equity has jurisdiction of all if they could be tried on the same record even though some of them have nearly expired.[136] Where the complainant has no ownership in the patent at the

[132a] U. S. Expansion Bolt Co. *v.* Kroucke Hardware Co., 234 F. R. 868, 1916; Colman *v.* Am. Warp Drawing Machine Co., 235 F. R. 531, 1915.

[133] Root *v.* Railway Co., 105 U. S. 189, 1881.

[134] Root *v.* Railway Co., 105 U. S. 189, 1881; Farrel *v.* United Verde Copper Co., 121 F. R. 551, 1903, T. W. & C. B. Sheridan Co. *v.* Robert O. Law Co., 172 F. R. 223, 1909.

[135] Huntington Dry Pulverizer Co. *v.* Virginia-Carolina Chemical Co., 130 F. R. 558, 1904.

[136] Thomson-Houston Electric Co. *v.* Electrose Mfg. Co., 155 F. R. 543, 1907.

time when the bill was filed, equitable jurisdiction is also absent.[137] Equitable title to a patent arising out of an executory contract to assign the patent to the plaintiff is not sufficient to confer jurisdiction.[138] But where a bill is filed before the expiration of the patent upon which it is based, and where it truly states a proper case for an injunction, and contains a proper prayer for that relief, equity has jurisdiction, and should retain it to the end of the suit; even if, on account of the expiration of the patent before a hearing is had,[139] or on account of the sale of the patent by the complainant before a hearing is obtained,[140] or on account of public policy,[141] or on account of the complainant's delay to move,[141a] no injunction is ever granted in the case.

[137] Waterman *v.* Mackenzie, 138 U. S. 257, 1891.

[138] Milwaukee Carving Co. *v.* Brunswicke-Balke Co., 126 F. R. 171, 1903.

[139] Clark *v.* Wooster, 119 U. S. 325, 1886; Beedle *v.* Bennett, 122 U. S. 75, 1886; Gottfried *v.* Brewing Co., 13 F. R. 479, 1882; Gottfried *v.* Moerlein, 14 F. R. 170, 1882; Forehand *v.* Porter, 15 F. R. 256, 1883; Reay *v.* Raynor, 19 F. R. 309, 1884; Adams *v.* Howard, 19 F. R. 317, 1884; Dick *v.* Struthers, 25 F. R. 103, 1885; Adams *v.* Iron Co., 26 F. R. 324, 1886; Kirk *v.* DuBois, 28 F. R. 460, 1886; Brooks *v.* Miller, 28 F. R. 615, 1886; Kittle *v.* De Graff, 30 F. R. 689, 1887; Kittle *v.* Rogers, 33 F. R. 49, 1887; Hohorst *v.* Howard, 37 F. R. 97, 1888; Singer Mfg. Co. *v.* Wilson Mach. Co., 38 F. R. 587, 1888; Ross *v.* City of Ft. Wayne, 63 F. R. 466, 1894; Bradner Hanger Co. *v.* Waterbury Button Co., 106 F. R. 735, 1901; United States Mitis Co. *v.* Detroit Steel & Spring Co., 122 F. R. 865, 1903; Huntington Dry Pulverizer Co. *v.* Virginia-Carolina Chemical Co., 130 F. R. 558, 1904; Schmeiser Mfg. Co. *v.* Lilly, 189 F. R. 631, 1911.

Contra, Miller *v.* Schwarner, 130 F. R. 561, 1904.

[140] New York Belting Co. *v.* New Jersey Car-Spring Co., 47 F. R. 505, 1891; 48 F. R. 559, 1891.

[141] Bragg Mfg. Co. *v.* Hartford, 56 F. R. 293, 1893.

[141a] Waite *v.* Chair Co., 45 F. R. 259, 1891.

But where a bill untruly states a proper case for an injunction, and contains a prayer for that relief, the jurisdiction of equity will lapse and the bill be dismissed, whenever it is shown to have been untrue in respect of those of its statements upon which the prayer for an injunction is based.[142] And where a bill states no proper case for an injunction, but contains a prayer for such a writ, the jurisdiction of equity will not attach at all, and the bill be dismissed whenever its character is brought to the attention of the court.[143] And where a bill is filed so shortly before the expiration of the patent upon which it is based, that no motion for an injunction can be regularly notified to the defendant and heard by the court till after that expiration, the bill will be dismissed whenever the court learns that no injunction can be lawfully granted.[144] And where a bill states no ground for a preliminary injunction, and is filed so shortly before the expiration of the patent that no permanent injunction can possibly be obtained in the case, the bill will also be dismissed.[145] And if no injunction is granted, and if the court does dismiss the bill for want of equity, in the absence of a right to an injunction at the time of the hearing, such dismissal will not be reversed on an appeal.[146]

[142] Dowell *v.* Mitchell, 105 U. S. 430, 1881.

[143] Campbell *v.* Ward, 12 F. R. 150, 1882; Creamer *v.* Bowers, 30 F. R. 185, 1887.

[144] Clark *v.* Wooster, 119 U. S. 324, 1886; Burdell *v.* Comstock, 15 F. R. 395, 1883; Davis *v.* Smith, 19 F. R. 823, 1884; Mershon *v.* Furnace Co., 24 F. R. 741, 1885; American Cable Ry. Co. *v.* Chicago City Ry. Co., 41 F. R. 522, 1890; Bragg Mfg. Co. *v.* Hartford, 56 F. R. 293, 1893; Overweight Elevator Co. *v.* Standard Elevator Co., 96 F. R. 231, 1899; Diamond Stone-Sawing Machine Co. *v.* Sens, 159 F. R. 497, 1908.

See Tompkins *v.* International Paper Co., 183 F. R. 773, 1910.

[145] McDonald *v.* Miller, 84 F. R. 344, 1898; Heap *v.* Borchers, 108 F. R. 237, 1901.

[146] Keyes *v.* Mining Co., 158

But the Court of Appeals for the second circuit holds that a bill filed the day before the expiration of the patent, which states that the plaintiff has never used his patent, and has never derived any financial benefit from it, states a cause of action in equity for the reason that on the facts the plaintiff would be unable to prove any damages at law.[146]

§ 593. The case of Root *v.* Railway Co. does not precisely state what exceptional facts will give equity jurisdiction, independent of any injunction or prayer for injunction. What the court said on that subject, was said in the following language: "Grounds of equitable relief may arise, other than by way of injunction, as where the title of the complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent a resort to remedies purely legal; and such an equity may arise out of, and inhere in, the nature of the account itself, springing from special and peculiar circumstances which disable the patentee from a recovery at law altogether, or render his remedy in a legal tribunal difficult, inadequate, and incomplete; and as such cases cannot be defined more exactly, each must rest upon its own peculiar circumstances, as furnishing a clear and satisfactory ground of exception from the general rule." But in a later case, that court explained that grounds of equitable relief do not arise "where the title of the complainant is equitable merely," unless that fact constitutes an impediment to a resort to remedies purely legal, or constitutes a circumstance which renders the remedy obtainable by an action at law difficult, inadequate, or incomplete.[147] And Judge COLT has decided that such an

U. S. 152, 1895; Russell *v.* Kern, al Paper Co., 183 F. R. 773, 69 F. R. 94, 1895.

[146a] Tompkins *v.* International- 1910.

[147] Hayward *v.* Andrews, 106 U. S. 672, 1882.

equity does not "arise out of, and inhere in, the nature of the account itself" merely because the account is intricate.[148]

§ 594. Want of jurisdiction in equity may be set up by a defendant by motion to dismiss or in an answer. But it cannot be interposed without any pleading to sustain it;[149] except where the bill shows that it was filed after the patent expired. In that case, non-jurisdiction may be invoked by a motion at any stage of the case in the Circuit Court.[150] There was, under the practice prior to the Equity Rules of 1913, an advantage in making this defence by demurrer instead of by answer, or by motion after an answer; for in the first case the bill could be dismissed with costs,[151] while in either of the others no costs could be recovered, even if the defence was successful.[152] This advantage does not now exist.

§ 595. Prior adjudication in an action at law is not necessary to give jurisdiction to equity in cases of infringements of patents, nor is such an adjudication necessary to call equity into activity in that behalf.[153] A district court may, in its discretion, order a trial at law in such a case,[154] or order a trial by jury at its own bar,[155] in order to inform the conscience of the chancellor; but no such

[148] Lord *v.* Machine Co., 24 F. R. 803, 1885; Adams *v.* Iron Co., 26 F. R. 325, 1886.

[149] Reynes *v.* Dumont, 130 U. S. 395, 1889; Tyler *v.* Savage, 143 U. S. 96, 1892; Dederick *v.* Fox, 56 F. R. 717, 1893.

[150] Spring *v.* Sewing Machine Co., 13 F. R. 446, 1882.

[151] International Wireless Tel. Co. *v.* Fessenden, 131 F. R. 493, 1904.

[152] Dawes *v.* Taylor, 14 Reporter, 180, 1882.

[153] McCoy *v.* Nelson, 121 U. S. 487, 1887; Wyckoff *v.* Wagner Typewriter Co., 88 F. R. 516, 1898.

[154] Wise *v.* Railway Co., 33 F. R. 277, 1888.

[155] 18 Statutes at Large, Part 3, Ch. 77, Section 2, p. 316.

trial can be demanded by either or both of the parties as an absolute right, for courts of equity are not only really, but also technically, competent to decide questions of facts.[156]

§ 596. Laches is a defence which is peculiar to courts of equity. "The cases are many in which this defence has been invoked and considered. It is true, that by reason of their differences of fact, no one case becomes an exact precedent for another, yet a uniform principle pervades them all. They proceed on the assumption that the party to whom laches is imputed, has knowledge of his rights, and an ample opportunity to establish them in the proper forum; that by reason of his delay, the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned; and that because of the change in condition or relations during this period of delay, it would be an injustice to the latter to permit the former to now assert them."[157] "The length of time during which the party neglects the assertion of his rights, which must pass in order to show laches, varies with the peculiar circumstances of each case, and is not, like the matter of limitations, subject to an arbitrary rule. It is an equitable defence, controlled by equitable considerations, and the lapse of time must be so great, and the relations of the defendant to the rights such, that it would be inequitable to permit the plaintiff to assert them now."[158] In pursuance of these principles, courts of equity sometimes dismiss bills for infringements of patents, because they were not filed with diligence,[159] or not prosecuted with dili-

[156] Cochrane *v.* Deener, 94 U. S. 780, 1876.

[157] Galliher *v.* Cadwell, 145 U. S. 372, 1892.

[158] Halstead *v.* Grinnan, 152 U. S. 416, 1894.

See Section 186*a*.

[159] Lane & Bodley Co. *v.* Locke, 150 U. S. 200, 1893; New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 24 F. R. 604, 1885; Edison Electric Light Co. *v.*

gence after they were filed; [160] and whether the complainant or his assignor is the party who is chargeable with laches.[161] But delay to sue is not always laches, because it may have been harmless to the defendant; [162] or it may have resulted from the fact that the complainant did not know of the infringement till long after it began; [163] or from the fact that he was litigating a test case under his patent against another infringer during the time of the delay; [164] or it may have occurred after the infringer was warned to infringe no more, and while the patentee was preparing for action.[165] The second of these circumstances excuses delay, because vigilance does not imply omniscience; and the third excuses delay, because abstinence

Equitable Life Co., 55 F. R. 479, 1893; Fosdick *v.* Lowell Machine Shop, 58 F. R. 817, 1893; Starrett *v.* Arms & Tool Co., 96 F. R. 244, 1899; Covert *v.* Travers Bros. Co., 96 F. R. 568, 1899; Meyrowitz Mfg. Co. *v.* Eccleston, 98 F. R. 438, 1899; Westinghouse Air-Brake Co. *v.* New York Air-Brake Co., 111 F. R. 741, 1901; Safety Car H. & L. Co. *v.* Consolidated Car Heating Co., 160 F. R. 476, 1908; L. H. Gilmer Co. *v.* Geisel, 168 F. R. 313, 1909; Brown & Scharpe Mfg. Co. *v.* Coates Clipper Mfg. Co., 195 F. R. 84, 1912.

[160] Johnston *v.* Mining Co., 148 U. S. 370, 1892.

[161] Kittle *v.* Hall, 29 F. R. 511, 1887; Woodmanse & Hewitt Co. *v.* Williams, 68 F. R. 492, 1895; Richardson *v.* Osborne & Co., 82 F. R. 96, 1897; and 93 F. R. 828, 1899.

[162] American Street-Car Advertising Co. *v.* Jones, 122 F. R. 810, 1903.

[163] Imperial Chemical Mfg. Co. *v.* Stein, 77 F. R. 612, 1896.

[164] Van Hook *v.* Pendleton, 1 Blatch. 193, 1846; Green *v.* French, 4 Bann. & Ard. 171, 1879; Green *v.* Barney, 19 F. R. 421, 1884; American Bell Telephone Co. *v.* Southern Telephone Co., 34 F. R. 802, 1888; Edison Electric Light Co. *v.* Mt. Morris Electric Light Co., 57 F. R. 644, 1893; Norton *v.* Automatic Can Co., 57 F. R. 932, 1893; Taylor *v.* Sawyer Spindle Co., 75 F. R. 304, 1896; Timolat *v.* Franklin Boiler Works Co., 122 F. R. 69, 1903; United States Mitis Co. *v.* Detroit Steel & Spring Co., 122 F. R. 866, 1903.

[165] Seibert Oil Cup Co. *v.* Lubricator Co., 34 F. R. 34, 1888.

from vexatious litigation is worthy to be praised rather than punished by a court of equity; and the fourth excuses delay because it is neglect, and not patience, that constitutes laches. In fact it may be stated that time alone is not a test of laches. There must be something that practically amounts to an equitable estoppel against the plaintiff, for instance, the investment by the defendant of capital in the infringing business with the knowledge of the plaintiff accompanied by inaction on the part of the latter.[166]

§ 597. The defence of laches could formerly be made in a demurrer,[167] or in a plea,[168] or in an answer, or in an argument on the hearing without any pleading to support it.[169] Of course now this defence can be made only by answer or motion to dismiss accordingly as the situation permits.

To guard against a motion to dismiss based on laches, in a case where long delay intervened between the infringement and the filing of the bill, the bill ought to state the existing excuses for that delay;[170] and to guard against such a defence being started on the hearing, the evidence ought to show whatever excuse the complainant can interpose. This is absolutely essential in a bill for infringement

[166] Valvona-Marchiony Co. *v.* Marchiony, 207 F. R. 380, 1913; General Electric Co. *v.* Yost Electric & Mfg. Co., 208 F. R. 719, 1913; Hausen *v.* Slicks, 216 F. R. 164, 1914; Drum *v.* Tuiner, 219 F. R. 188, 1914.

[167] Maxwell *v.* Kennedy, 8 Howard, 222, 1850.

Contra, Marconi Wireless Telegraph Co. *v.* New England Navigation Co., 191 F. R. 194, 1911.

[168] Edison Electric Light Co. *v.* Equitable Life Co., 55 F. R. 479, 1893.

[169] Sullivan *v.* Railroad Co., 94 U. S. 811, 1876; Woodmanse & Hewitt Mfg. Co. *v.* Williams, 68 F. R. 494, 1895; Westinghouse Air-Brake Co. *v.* New York Air-Brake Co., 111 F. R. 741, 1901.

[170] Edison Electric Light Co. *v.* Equitable Life Co., 55 F. R. 481, 1893.

of a broadened reissue where it appears that a delay of more than two years intervened between the issuance of the original patent and the application for the reissue.[171]

§ 598. The first of the twenty-seven defences which are known both to actions at law and actions in equity for infringements of patents, can be made in a motion to dismiss, where the letters patent appear on their face to have been granted for something other than a process, machine, manufacture, composition of matter, or design.[172] And indeed any defence, which can be based upon the face of the patent, can be made by motion to dismiss.[173]

§ 599. The second defence may be made on the hearing, without any pleading or evidence, in all cases where the court will take judicial notice of the fact which shows want of invention;[174] and a motion to dismiss will also be sustained in the same circumstances.[175] But a court will not take judicial notice of a fact, merely because it is

[171] American Thermos Bottle Co. *v.* Semple, 222 F. R. 942, 1915.

[172] Risdon Locomotive Works *v.* Medart, 158 U. S. 84, 1895.

[173] Richards *v.* Chase Elevator Co., 158 U. S. 301, 1895; Equity Rule 29.

[174] Brown *v.* Piper, 91 U. S. 41, 1875; Terhune *v.* Phillips, 99 U. S. 592, 1878; Slawson *v.* Railroad Co., 107 U. S. 649, 1882; Ligowski Clay-Pigeon Co. *v.* Clay-Bird Co., 34 F. R. 332, 1888; Hunt Bros. Fruit Packing Co. *v.* Cassidy, 53 F. R. 260, 1892; Schreiber *v.* Grim, 65 F. R. 221, 1895; Cary Mfg. Co. *v.* De Haven, 88 F. R. 700, 1898.

[175] Risdon Locomotive Works *v.* Medart, 158 U. S. 84, 1895; Dick *v.* Supply Co., 25 F. R. 105, 1885; New York Belting Co. *v.* Rubber Co., 30 F. R. 785, 1887; West *v.* Rae, 33 F. R. 45, 1887; Root *v.* Sontag, 47 F. R. 309, 1891; United States Credit System Co. *v.* Indemnity Co., 51 F. R. 751, 1892; United States Credit System Co. *v.* Credit Co., 53 F. R. 818, 1893; Wall *v.* Leck, 61 F. R. 291, 1894; Covert *v.* Travers Bros. Co., 70 F. R. 788, 1895; Lamson Consolidated Service Co. *v.* Siegel-Cooper Co., 106 F. R. 734, 1901; Baker *v.* F. A. Duncombe Mfg. Co., 146 F. R. 744, 1906, citing numerous cases.

stated in a prior patent:[176] nor of any fact which is not generally known,[177] even though known to the judge;[178] nor of any fact, the reality or the significance of which is subject to doubt.[179] And a motion to dismiss for want of invention will be denied except in a clear case.[180] Where the state of the prior art must be proved by evidence, in order to show that the advance covered by the patent did not amount to invention; it is necessary to set up the defence of want of invention in an answer.[181] But the answer need not state the particular part of the prior art, upon which the defence of want of invention is based.[181a]

[176] Bottle Seal Co. *v.* De La Vergne Co., 47 F. R. 61, 1891; Parsons *v.* Seelye, 100 F. R. 454, 1900.

[177] Eclipse Mfg. Co. *v.* Adkins, 36 F. R. 554, 1888; Lyons *v.* Drucker, 106 F. R. 416, 1901.

[178] New York Belting Co. *v.* New Jersey Rubber Co., 137 U. S. 449, 1890; Am. Sulphite Pulp Co. *v.* DeGrasse Paper Co., 157 F. R. 660, 1907.

[179] Blessing *v.* Copper Works, 34 F. R. 753, 1888; Lalance & Grosjean Mfg. Co. *v.* Mosheim, 48 F. R. 452, 1891; Hanlon *v.* Primrose, 56 F. R. 600, 1893; Davock *v.* Chicago & Northwestern R. R. Co., 69 F. R. 468, 1895; American Fibre-Chamois Co. *v.* Buckskin-Fibre Co., 72 F. R. 512, 1896.

[180] Standard Oil Co. *v.* Southern Pacific Co., 42 F. R. 295, 1890; Krick *v.* Jansen, 52 F. R. 823, 1892; Drainage Construction Co. *v.* Engelwood Sewer Co., 67 F. R. 141, 1894; Beer *v.* Walbridge, 100 F. R. 465, 1900; Electric Vehicle Co. *v.* Winton Motor-Carriage Co., 104 F. R. 814, 1900; Neidich *v.* Fosbenner, 108 F. R. 266, 1901; Chinnock *v.* Paterson P. & S. Tel. Co., 112 F. R. 531, 1902; Drake Castle Pressed Steel Lug Co. *v.* Brownell, 123 F. R. 90, 1903; Merrimack Mattress Mfg. Co. *v.* Schlesinger, 124 F. R. 237, 1903; Southern Plow Co. *v.* Atlantic Agricultural Works (in which the authorities are reviewed), 165 F. R. 214, 1908.

[181] Bottle Seal Co. *v.* De La Vergne Co., 47 F. R. 61, 1891; Brickill *v.* Hartford, 57 F. R. 217, 1893; Drainage Construction Co. *v.* Englewood Sewer Co., 67 F. R. 141, 1894.

[181a] Dunbar *v.* Myers, 94 U. S. 198, 1876; Western Electric Co. *v.* North Electric Co., 135 F. R. 79, 1905 (but see Conderman *v.* Clements, 147 F. R. 915, 1906).

A motion to dismiss will not be sustained, in such a case, on the basis of what the patent may set forth as the state of the prior art; unless the patentee is some way estopped from showing the patent to be otherwise than accurate in its statements on that subject.[182] A plea was never applicable to such a case, because defendants could seldom swear to the state of the art, and even where they could they could not plead resulting want of invention, because that depends upon the construction of the patent, which is to be made by the court in the light of the state of the art. When interposing this defence, it is not necessary to state what facts are intended to be proved in its support; because those facts refer only to the state of the art, and not to novelty.[183] The function of an answer, in respect of this defence, is to notify the complainant that the evidence of the state of the art, which is to be taken by the defendant, will be invoked at the hearing to show want of invention, and not merely to narrow the patent and thus show non-infringement. It has been held that where absence of invention clearly appears on the face of the patent itself, the court may even though the question is not raised by the pleadings, *sua sponte*, declare the patent invalid and dismiss the bill.[184]

§ 600. The third defence could never be set up in a plea, because the statute expressly provides that it shall be set up in an answer.[185] Nor can it be based on such a notice

[182] Indurated Fibre Co. *v.* Grace, 52 F. R. 128, 1892.

[183] Vance *v.* Campbell, 1 Black, 430, 1861; Hunt Bros. Fruit Packing Co. *v.* Cassidy, 53 F. R. 260, 1892; Dayton Crupper Co. *v.* Ruhl, 55 F. R. 651, 1893.

[184] Wills *v.* Scranton Cold Storage & Warehouse Co., 153 F. R. 181, 1907.

[185] Carnrick *v.* McKesson, 8 F. R. 807, 1881; Arrott *v.* Standard Sanitary Mfg. Co., 113 F. R. 389, 1902; Western Electric Co. *v.* North Electric Co., 135 F. R. 79, 1905; Duntley Mfg. Co. *v.* Keller Mfg. Co., 173 F. R. 318, 1909.

as will effect the purpose in an action at law.[186] It has always required an answer for its embodiment; [187] and that answer must state the same things which a statutory notice of want of novelty in an action at law is required to contain.[188]

It has been held on the circuit, that evidence of want of novelty, taken without being properly pleaded in the answer, is not made admissible by being set up in a subsequent amendment of that pleading.[189] In another case it was held to rest in the discretion of the court to admit the evidence so taken, and subsequently pleaded, or to reject that evidence, but permit the defendant to take it anew under the amended answer.[190] These holdings are hardly consistent with each other, and neither of them seems consistent with an earlier Supreme Court decision on a similar point.[191] In that case it was held that evidence of want of novelty is admissible in an action at law, where it was taken without being properly set up in any notice, but where a proper notice was subsequently given, and given thirty days before the trial.

Where the answer states that the patent sued on is void for want of novelty, evidence to support that statement will be admitted at the hearing, though not specified in the answer, unless the complainant objects to that evidence for want of the statutory notice.[192]

[186] Doughty *v.* West, 2 Fisher, 555, 1865.

[187] Seymour *v.* Osborne, 11 Wallace, 516, 1870; Roemer *v.* Simon, 95 U. S. 214, 1877; Vacuum Cleaner Co. *v.* Dunn, 189 F. R. 634, 1911.

[188] Agawam Co. *v.* Jordan, 7 Wallace, 583, 1868; Bates *v.* Coe, 98 U. S. 31, 1878; Planing-Machine Co. *v.* Keith, 101 U. S. 493, 1879.

[189] Roberts *v.* Buck, 1 Holmes, 224, 1873.

[190] Allis *v.* Buckstaff, 13 F. R. 879, 1882.

[191] Teese *v.* Huntingdon, 23 Howard, 2, 1859.

[192] Roemer *v.* Simon, 95 U. S. 220, 1877; Brown *v.* Hall, 9

§ 601. The fourth defence is not rightly the subject-matter of a plea, for though a defendant may make an oath that he believes the patented thing to be without utility, he can hardly swear that it is certainly so.[193]

Blatch. 405, 1869; Barker *v.* Stowe, 15 Blatch. 49, 1878; U. S. Consolidated Seeded Raisin Co. *v.* Selma Fruit Co., 195 F. R. 264, 1912.

[193] Rubber Co. *v.* Goodyear, 9 Wallace, 793, 1869; Ames & Frost Co. *v.* Woven Wire Mach. Co., 59 F. R. 705, 1893.

EDITOR'S NOTE: The statement that only matter of which the defendant had personal knowledge could be presented by plea in bar or abatement is made in substance by the learned author at several places in this book (Sections 605, 607, 610, 614, 616, 618, 621); and as the question is not free from doubt the original text has been substantially preserved in this edition wherever the statement occurs.

It is true that by Equity Rule 31 of the Equity Rules in force prior to February 1, 1913, it was required that every plea to a bill in equity should be verified by affidavit of the defendant to the effect that the plea was true in fact. This requirement, however, broadly speaking, was a peculiarity of the practice prevailing in the United States, being required in the English Chancery practice only in those cases in which, where issue was joined on the plea, evidence upon oath would be required to sustain it at the hearing. The conclusion, however, apparently reached by the author that only such matter as was within the personal knowledge of the defendant could be presented by plea does not appear to be sustained by authority. That proposition was of course correct as a practical proposition if the facts stated in the plea were averred of the defendant's own knowledge, but there was nothing to prevent a defendant from interposing by plea a defence based on facts not within his personal knowledge but which he could swear to on information and belief. Indeed the propriety of a plea in a particular case appears to be determinable on other and different grounds than as stated in the text. Generally it may be said that its office is to "present some distinct fact, which of itself creates a bar to the suit or to the part to which the plea applies, and thus to avoid the necessity of making the discovery asked for and the expense of going into the evidence at large." (Folly *v.* Kittson, 120 U. S. 303, 314, and other cases cited

§ 602. The fifth and sixth defences, even before the present Equity Rules were proper only for an answer, because they both rest on evidence of abandonment outside of the bill, and therefore cannot be interposed by a demurrer, [194] or motion to dismiss. Being two of the five defences provided for by Section 4920 of the Revised Statutes, neither of them are proper subject-matter of a plea.[195] And an answer must show what fact or facts constitute the abandonment which is invoked therein.[196]

in Street's Federal Equity Practice, Sections 827 and 828.) Accordingly it is held that it is not the province of a plea to interpose defences that go to the merits and relate in nowise to matters in abatement or in bar, as such defences should be raised by answer. For this reason a plea of non-infringement in a suit for infringement of a patent has been considered a bad plea to be entertained only under special circumstances. (1 Street's Federal Equity Practice, Section 836.)

If, however, the statement of the author was correct when made, it apparently has had no application since the present Equity Rules went into effect on February 1, 1913; for by these Equity Rules pleas as such were abolished and it was provided that every defence heretofore presentable by plea in bar or abatement should be made in the answer and might be separately heard and disposed of before the trial of the principal case in the discretion of the Court (Equity Rule 29); and as there is no provision in the Equity Rules requiring an oath to the answer, the reasoning advanced by the author in the statement under discussion would no longer have any force. Whether or not the abolishment of the requirement of an oath to matter presentable by plea has increased the number of defences which may be so treated after the manner of pleas must in view of the absence of authorities be left for the courts to decide. For further consideration of the subject the reader is referred to the treatment of it contained in Street's Federal Equity Practice.

[194] United States Electric Lighting Co. *v.* Consolidated Electric Light Co., 33 F. R. 869, 1888.

[195] Carnrick *v.* McKesson, 8 F. R. 807, 1881.

[196] Western Electric Co. *v.* Sperry Electric Co., 58 F. R. 192, 1893; Warren Featherbone Co. *v.*

§ 603. The seventh defence is not proper matter for a plea because it involves the construction of the claims of the letters patent in suit. Letters patent are not void merely because they describe something not shown in the original application therefor. It is only when they claim something not indicated or described in the specification or drawings of the original application, that they are obnoxious to the seventh defence. The question what letters patent claim, is a question of law for the court, and is therefore in its nature not one which can properly be raised by a plea in an action in equity. Nor can this defence be raised by a demurrer, or motion to dismiss, because, in order to decide upon its validity, the court must not only construe the claims of the patent, but must also compare the claims so construed with the original application, and that application must be introduced for the purpose, as a matter of evidence. This defence therefore now and at all times was properly set up only in the answer, except where the complainant took the initiative upon the subject. In that case the complainant must maintain the validity of his patent against this defence, even where it is not specifically interposed.[197]

§ 604. The eighth defence is not proper matter for a plea, because it is one of the five which the statute requires to be set up in an answer.[198]

§ 605. Either the ninth or the tenth defence may be treated as pleas where the defendant knows the fact of joint or of sole invention upon which they respectively stand. Each of these defences rests upon a single matter

Warner Bros. Co., 92 F. R. 991, 1899.

[197] Michigan Central Railroad Co. *v.* Car Heating Co., 67 F. R. 121, 1895.

[198] Revised Statutes, Section 4920; Carnrick *v.* McKesson, 8 F. R. 807, 1881; Ecaubert *v.* Appleton, 47 F. R. 893, 1891.

of fact, which, if decided against the complainant, is fatal to his patent. It was formerly unwise to make either of these defences in a plea, because the complainant had no alternative but to file a replication, and because, by doing so, he might foreclose other defences, and because there was always a possibility that the court would, on the evidence, decide that the invention was joint, or was several, according as it may be necessary to do in order to sustain the patent.[199] It is assumed that these difficulties do not now exist.

§ 606. The eleventh defence stands in the same category, in respect of equity pleading, with the third, fifth, sixth, and eighth, and the answer must state the details of the facts upon which the eleventh defence is based.[200]

§ 607. The twelfth defence cannot be made by a motion to dismiss;[201] and it cannot be treated as a plea because, though the defendant might be able to make oath that he is a person skilled in the art to which the invention covered by the patent appertains, and that the description contained in that patent is not full, clear, concise, and exact enough to enable him to make and use the same, he could not make oath that the same thing is true of other persons skilled in that art.[201a]

§ 608. Nor can the thirteenth defence be treated as a plea, because it depends on the construction of the claims of the letters patent, and not upon any matter of fact to be sworn to in a plea or proved in a deposition. But this defence can be made by a motion to dismiss, where profert

[199] Pitts *v.* Hall, 2 Blatch. 229, 1851; Blandy *v.* Griffith, 3 Fisher, 616, 1869.

See Note 193 of this Chapter.

[200] American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 70 F. R. 992, 1895.

[201] Dade *v.* Boorum & Pease Co., 121 F. R. 135, 1903.

[201a] See Note 193 of this Chapter.

has been made of the letters patent, or they have otherwise been made a part of the bill.[202] An answer was formerly a proper pleading in which to interpose this defence, and of course it is so now.

§ 609. The fourteenth defence also, was generally required to be set up in an answer.[203] A plea was not ordinarily suitable for the purpose, because this defence depends primarily upon the necessity for a disclaimer, and because that necessity depends upon the claim being obnoxious to one or more of the first three defences, and because the third defence always, and the first and second generally, are not appropriate for pleas.

§ 610. The fifteenth defence is not proper subject-matter of a plea because it primarily depends, either upon the original patent not being inoperative or invalid by reason of a defective or insufficient specification, or upon its not being invalid in part, for want of novelty.[204] Where it primarily depends upon the first of these matters, it depends either upon the construction of the original letters patent, or upon proof that any person skilled in the art to which the invention belongs, could from the original specification make and use the same; and where it depends upon the second of these matters, it depends upon proof that everything claimed in the original letters patent was novel. None of these matters can properly be put into a plea. Statements of the true construction of a patent cannot be, because they are statements of law. Statements that any person skilled in the art can make and use a particular invention, from a particular specification, are hardly proper in pleas, because a defendant ought

[202] Brickill *v.* Hartford, 49 F. R. 373, 1892.

[203] Burden *v.* Corning, 2 Fisher, 498, 1864.

[204] Revised Statutes, Section 4916.

seldom to attempt to swear what other persons can or cannot do. And statements that everything claimed in the patent of another was novel with him, are not proper for a plea, becaus a defendant can never know that none of those things were previously known or used.[204a] Nor can this defence be raised by a motion to dismiss, unless the original letters patent are incorporated in the bill for infringement of its reissue; and not even then can it be so raised, unless the question is solely one of construction of the original letters patent.

§ 611. The sixteenth defence depends partly on the comparative construction of the original and the reissue letters patent, and partly upon evidence that the delay in applying for the reissue was unreasonable. Where both the original and the reissue are proffered or incorporated in the bill; this defence may be made by motion to dismiss, because the court then has every necessary means of making the comparative construction,[205] and because long delay will be held to be unreasonable, unless it is excused in the bill. Where the bill omits to set out the original patent, this defence must be treated as ordinary matter for an answer, for such mixed questions of law and fact are wholly unsuitable to a plea.[206]

§ 612. The seventeenth defence depends upon the comparative construction of the original and the reissue letters patent. It may be made on motion to dismiss, where both those documents are proffered or otherwise incorporated in the bill. If the original letters patent are not so incorporated, this defence may be made regularly in

[204a] See Note 193 of this Chapter.

[205] Powder Co. *v.* Powder Works, 98 U. S. 126, 1878; Wollensak *v.* Reiher, 115 U. S. 96, 1884; International Terra Cotta Lumber Co. *v.* Maurer, 44 F. R. 619, 1890.

[206] Maxwell *v.* Kennedy, 8 Howard, 222, 1850.

the answer; but is never proper matter for a plea, because the question involved is one of construction of documents, and not a question of fact to be sworn to by a defendant, or to be decided upon the replication of the complainant and the evidence of experts.

§ 613. The eighteenth defence may be made by a motion to dismiss where the bill is based on the prior patent, as well as on its alleged double.[207] But a plea would not be suitable to this defence, unless the disputed claim or claims in the subsequent patent can be plainly seen to be identical with a claim or claims in the prior patent; for if construction must be resorted to in order to determine identity, or want of identity, between the claims of the two patents, the question is one of law, and therefore improper to be raised by a plea in equity.

§ 614. The nineteenth defence is suitable for a plea, if the defendant has personal knowledge of the record which he pleads, and therefore is able to make the required oath that there is in fact such a record.[207a]

§ 615. The twentieth defence can be made by a motion to dismiss, where the bill shows the patent had expired when the doings which constitute the alleged infringement were committed. But that will seldom be the fact, for the expiration relied upon in such cases is nearly always due to the expiration of some foreign patent for the same invention, and not to anything which appears on the face of the United States patent in suit. Where the defence depends upon the expiration of a foreign patent which is not mentioned in the bill, it cannot be taken advantage of by motion to dismiss. Nor is it proper matter for a plea; because it depends not only upon the existence of a foreign patent, but also upon that patent being for the

[207] Russell *v.* Kern, 64 F. R. 581, 1894.

[207a] See Note 193 of this Chapter.

same invention as the patent in suit; and because this last question, except where the two patents are plainly identical, is one of construction for the court;[208] and because defences which depend upon the comparative construction of different documents are not proper matter for a plea.[209]

§ 616. The twenty-first defence is proper subject-matter for a plea, if the defendant knows that the complainant made or sold specimens of the patented thing during the life of the patent without marking them "patented," and if the defendant was not duly notified of his infringement, or, if notified, immediately discontinued to infringe.[210] This defence can also be made without any special statement relevant thereto in the answer, because the complainant must negative it in his bill and in his evidence in chief, or suffer the operation of the defence, whether the defendant has set it up in any pleading or not.[211] But this defence is not a defence to a prayer for an injunction,[212] though it is to a prayer for damages,[213] and to a prayer for profits.[214] Though this defence need not be pleaded, it is waived, unless it is presented to the court on the hearing of the case; and it cannot be successfully presented for the first time, in the appellate court to which the case may be taken.[215]

[208] De Florez *v.* Reynolds, 17 Blatch. 436, 1880.

[209] Lowry *v.* Aluminum Co., 56 F. R. 495, 1893.

[210] Revised Statutes, Section 4900.

See Note 193 of this Chapter.

[211] Dunlap *v.* Schofield, 152 U. S. 244, 1894.

See Sections 433*a* and 496.

[212] See Section 636.

[213] Goodyear *v.* Allyn, 6 Blatch. 33, 1868; Morton Trust Co. *v.* Am. Car & Foundry Co., 161 F. R. 546, 1908.

See Section 636.

[214] Lowell Mfg. Co. *v.* Hogg, 70 F. R. 787, 1895; Michigan Stove Co. *v.* Fuller-Warren Co., 81 F. R. 379, 1896; General Electric Co. *v.* Star Brass Works, 109 F. R. 950, 1901; Westinghouse Air-Brake Co. *v.* New York Air-Brake Co., 111 F. R. 741, 1901.

[215] Tuttle *v.* Claflin, 76 F. R. 227, 1896.

§ 617. The twenty-second defence may be made by motion to dismiss, where the bill sets forth copies of the complainant's title papers, either in the stating part or as exhibits attached to the bill and thus made parts thereof, or where the bill pleads those papers according to their legal effect, and in such a way that the title appears on the face of the bill to be defective. Where the bill shows a good *prima facie* title, but where the defendant knows that one of the papers which compose its chain was executed after the assignor had assigned his right to another, and that the prior assignment was recorded in the Patent Office within three months after its date; or knows that such assignor assigned his right to another for a valuable consideration more than three months after the making of the assignment set up in the bill, and before the latter was recorded in the Patent Office, and without the junior assignee having notice of the senior unrecorded assignment, the defendant may successfully take advantage of those facts by answer as though they were set up in a plea under the former Equity Rules.[215a] The action of a complainant will be defeated by evidence of either of these two sorts of faults in his title.[216] No defect of title due to an outstanding unrecorded document can be made available as a defence without being pleaded.[217]

§ 618. The twenty-third defence is properly the subject-matter for a plea if the defendant is sure of the fact of the license. This defence when stated as a plea must state the character of the license specifically.[218]

§ 619. The twenty-fourth defence should be treated in

[215a] See Note 193 of this Chapter.

[216] Revised Statutes, Section 4898.

[217] California Electric Works *v.* Fink, 47 F. R. 583, 1891.

[218] Jones *v.* Berger, 58 F. R. 1007, 1893.

See Note 193 of this Chapter.

respect of pleading, in the same way as the twenty-third, and that whether the release pleaded was executed before or after the filing of the bill.

§ 620. The twenty-fifth defence may be interposed by a motion to dismiss, where the bill sets forth the claims alleged to be infringed, and sets forth also the particular character of the defendant's doings.[219] But such a motion will be dismissed, except where non-infringement is obvious from the bill of complaint, without any reference to the prior art. Where such a motion to disniss is denied, and the defendant wishes to make the defence of non-infringement in an answer, and to support that defence by evidence, he may do so within five days after the motion is denied.[220]

The rules of equity pleading which were developed in England would justify the interposition of the defence of non-infringement as in a plea; but the precedents in the United States courts do not accord with those rules on that subject.[221] Those precedents indicate that pleas will not be permitted in such cases. It would be an economical practice to so prepare bills that this defence could be made by motion to dismiss, but this is usually very difficult of accomplishment.

§ 621. The twenty-sixth defence may be made as in a plea, and it ought to be made so in every case where the defendant is certain that he can prove the facts which he is advised amount to a basis for an estoppel. Where that defence consists of *res judicata*, the former record can be introduced in evidence without being specially pleaded in

[219] Collins Chemical Co. *v.* Capitol City Mfg. Co., 42 F. R. 64, 1890; Gerard *v.* Safe & Lock Co., 48 F. R. 380, 1891.

[220] Equity Rule 29.

[221] Western Electric Co. *v.* North Electric Co., 135 F. R. 79, 1905; Am. Sulphite Pulp Co. *v.* Bayless Pulp & Paper Co., 163 F. R. 843, 1908.

the answer.[222] If the former record is of an action at law, it may be examined for the purpose of determining just what facts were found by the verdict of the jury.[223] If the bill asks for damages and profits the defendant may set up a former action at law between the same parties and a judgment for the plaintiff which will be a bar to any recovery in the equity suit of profits or damages accruing subsequent to the commencement of the action at law.[224]

§ 622. The twenty-seventh defence may be interposed by a motion to dismiss where the bill clearly states the time when the infringement was committed or the space of time during which it was carried on.[225] Statutes of limitations have the same effect upon actions in equity in the Federal courts, that they have upon corresponding actions at law.[226] Where the bill simply states that the infringement occurred during the life of the patent, and where any part of that life is remote enough in point of time, to be barred by either the national or any applicable State statute of limitations, then the applicable statute must be set up in order to avail the defendant.

§ 622*a*. The twenty-eighth defence may be interposed by motion to dismiss or by answer accordingly as the defect appears in the bill or extrinsically.

§ 623. Prior to the Equity Rules in effect February 1, 1913, a general replication was required to be filed by the plaintiff in order to put in issue those points wherein the answer disagreed with the bill but no special replication

[222] Bradley Mfg. Co. *v.* Eagle Mfg. Co., 58 F. R. 721, 1893.

[223] Cheatham Electric Switching Co. *v.* Transit Development Co., 209 F. R. 229, 1913.

[224] Panoulias *v.* National Equipment Co., 198 F. R. 493, 1912.

[225] Brickill *v.* Hartford, 49 F. R. 374, 1892.

[226] Elmendorf *v.* Taylor, 10 Wheaton, 168, 1825; Miller *v.* McIntyre, 6 Peters, 66, 1832; Bank of United States *v.* Daniel, 12 Peters, 56, 1838.

was permitted.[227] They also provided that whenever the answer of the defendant should not be excepted to or should be adjudged or deemed sufficient, the plaintiff should file a general replication and no further pleading was required by either side.[228] Both general and special replications have, however, been abolished [229] and it is provided that unless the answer assert a set-off or counter-claim no reply shall be required without special order of the court or judge, but the cause shall be deemed at issue upon the filing of the answer and any new or affirmative matter shall be deemed to be denied by the plaintiff.[230]

§ 624. Before tracing further the common course of an action in equity for infringement of a patent, it is expedient to make a short excursion into the field of those subordinate bills which are sometimes required to be filed before decrees for infringements can properly be entered. Four kinds of such bills are known: 1. Supplemental bills. 2. Bills in the nature of supplemental bills. 3. Bills of revivor. 4. Bills in the nature of bills of revivor.

§ 625. A supplemental bill is required where the original bill was filed by a person as executor or administrator, or as assignee in bankruptcy or insolvency, whenever any other person succeeds to the title of the complainant to act in that representative capacity.[231] Such a bill is also necessary, in order to subject the estate of the defendant to a decree, where he is adjudged bankrupt or insolvent after the bill against him is filed.[232] His assignee in bankruptcy or insolvency is the proper person to be made the defendant to such a bill.[233] He will come before the court

[227] Former Equity Rule 45.

[228] Equity Rule 66.

[229] Equity Rules of 1913.

[230] Equity Rule 31.

[231] Story's Equity Pleading, Section 340.

[232] Mitford & Tyler's Equity Pleading, 166.

[233] Sedgwick *v.* Cleveland, 7 Paige (N. Y.), 290, 1838.

in the same plight as that of the bankrupt, and will be bound by all the prior proceedings in the case.[234] A supplemental bill is also a proper one to be filed against a stranger to the original bill, where he has conspired with the original defendant to infringe the patent in suit, after the original defendant was enjoined from doing so himself,[235] or where without the element of conspiracy he has purchased the defendant's infringing business pending the suit. In such case the purchaser is brought within the equitable doctrine that one taking the *res pendente lite* is bound by the judgment of the court as to that *res*.[236] And such a bill is proper, where a patent is extended after the filing of the original bill, if the defendant continues to infringe the patent after the extension is granted.[237]

The same reasons which support the latter rule will also support a supplemental bill based on a new patent covering some feature of those doings of the defendant which also infringe the patent originally sued upon; and will also support such a bill where the defendant so changes the character of his doings *pendente lite*, as to make them infringe some other patent of the complainant, as a part of the same acts that constitute infringements upon the patent upon which the original bill was based. But a good title, acquired after the filing of an original bill, cannot be brought into a case by a supplemental bill, to take the place of the bad title stated in the original bill.[238]

A supplemental bill which merely alleges that since the original bill was filed the defendant has modified his

[234] Mitford & Tyler's Equity Pleading, 166.

[235] Parkhurst *v.* Kinsman, 2 Blatch. 72, 1848; Western Tel. Mfg. Co. *v.* Am. Electric Tel. Co., 137 F. R. 603, 1905.

[236] Western Tel. Mfg. Co. *v.* Am. Electric Co., 141 F. R. 998, 1905.
See Section 407, *supra*.

[237] Reedy *v.* Scott, 23 Wallace, 352, 1874.

[238] Emerson *v.* Hubbard, 34 F. R. 327, 1888.

structure but in such manner that it still infringes, is demurrable. If the new acts infringe, the new acts may be proved upon the accounting and full relief obtained under the averments of the original bill.[239] Another court holds that it is permissible to bring such a bill, but the plaintiff need not do so, leaving the new infringement to be dealt with in an independent suit for the reason that each infringement raises a separate cause of action.[240] A supplemental bill is not allowed for the purpose of permitting the plaintiff to bring in officers of a defendant corporation to charge them with individual liability after an accounting has been had.[241]

§ 626. A bill in the nature of a supplemental bill is called for where the original bill was filed by a person in his own right, whenever that right passes to another person by voluntary assignment, or passes from the complainant to his assignee in bankruptcy or insolvency.[242] This rule applies not only to cases where the entire right of a sole complainant is thus transferred *pendente lite*, but also to cases where the right of one of several complainants is so transferred, and to cases where a part only of the right of a sole complainant is made the subject of a voluntary assignment after the filing of the original bill.[243] And a bill

[239] Westinghouse Air-Brake Co. *v.* Christensen Eng. Co., 126 F. R. 764, 1904.

Contra, Chicago Grain Door Co. *v.* Chicago, B. & Q. R. Co., 137 F. R. 101, 1905; T. B. Woods Sons *v.* Valley Iron Works, 198 F. R. 869, 1912.

[240] T. B. Woods' Sons Co. *v.* Valley Iron Works, 198 F. R. 869, 1912.

[241] H. C. Cook Co. *v.* Little River Mfg. Co., 156 F. R. 676, 1907.

[242] Story's Equity Pleading, Section 349; Ross *v.* Ft. Wayne, 63 F. R. 470, 1894; Ecaubert *v.* Appleton, 67 F. R. 924, 1895; Goss Printing Co. *v.* Scott, 134 F. R. 880, 1905; Leadam *v.* Ringgold, 140 F. R. 611, 1905.

[243] Story's Equity Pleading, Section 346.

in the nature of a supplemental bill, even if filed after the expiration of the patent, may be maintained in equity, if the original bill was filed before the expiration of the patent, and could have been thus maintained.[244]

§ 627. A bill of revivor is the proper means of reviving and continuing an action in equity for infringement of a patent, which has abated by reason of the death of one or more of the parties thereto.[245] It is to be brought by or against the executor or administrator of the deceased party, and not by or against his heirs.[246] When such a bill is filed, if the facts warrant him in so doing, the defendant may file an answer if required by the court under the Equity Rules denying that the person who filed the bill was entitled to do so,[247] or interposing some statute of limitation applicable to bills of revivor.[248] There is no Federal statute of that kind, but the relevant statutes of the several States are applicable to bills of revivor in Federal courts.[249] Those State statutes are of many species. In some, the limitation begins to run from the death of the deceased complainant; and in others, from the time his death is suggested in the case; and in others, from the time when a *scire facias* to revive is served on the person entitled to revive. The length of the limitation also varies in the different States. Perhaps the shortest time is six months, and the longest eighteen.

Where a bill of revivor is filed by the proper person within the proper time, the action will stand revived with-

[244] Ross *v.* Ft. Wayne, 63 F. R. 466, 1894; George W. Jackson, Inc., *v.* Friestedt, etc., Bar Co., 159 F. R. 496, 1908.

[245] Kirk *v.* Du Bois, 28 F. R. 460, 1886; Head *v.* Porter, 70 F. R. 498, 1895.

[246] Story's Equity Pleading, Section 354*a*.

[247] Equity Rules 29 and 45.

[248] Story's Equity Pleading, Section 331.

[249] Revised Statutes, Section 721; Campbell *v.* Haverhill, 155 U. S. 610, 1895.

out any pleading being filed by the defendant.[250] But where a defendant dies without filing a sufficient answer to the original bill and the amendments thereto, the bill of revivor which is occasioned by his deatl. ought to pray that the person against whom it seeks to revive the suit be compelled to answer the original bill and its amendments, or so much thereof as remains unanswered.[251] After an action in equity has been duly revived, it proceeds in the new form, unaffected by the change of name; and all the testimony theretofore taken may be thereafter used, precisely as if no abatement and revivor had occurred.[252]

§ 628. A bill in the nature of a bill of revivor is required where the complainant in the original bill assigned the right of action and the patent upon which it was based, and then died before the assignee took his place in the action, by means of a bill in the nature of a supplemental bill. A bill of the latter scrt will not answer the purpose, unless it is filed before the death of the original complainant; because that death will cause an abatement of tlie suit, and because only bills of revivor, or bills in tlie nature of bills of revivor, can revive abated actions in equity.[253] Bills of revivor can be filed only by privies in law, such as executors and administrators; and not by privies in estate, such as devisees and assignees.[254] For the latter class of persons, bills in the nature of bills of revivor are available; and by means of such a bill, an assignee who did not file a bill in the nature of a supplemental bill before the death of the original complainant,

[250] Equity Rule 56.

[251] Story's Equity Pleading, Section 375; Mitford & Tyler's Equity Pleading, 174.

[252] Vattier *v.* Hinde, 7 Peters, 265, 1833.

[253] Equity Rule 45.

[254] Story's Equity Pleading, Section 379.

may draw to himself the benefit of the original action, in whatever stage it may have been at the date of the abatement.[255] Such a bill is also the proper means of reviving an action which has abated at the death of the administrator or executor who was prosecuting it in his representative capacity, if the person entitled to revive represents the original testator or intestate, and not the deceased executor or administrator.[256]

§ 629. A bill of revivor and supplement is merely a compound of a supplemental bill, and of a bill of revivor.[257] It is therefore proper to be filed when either of the facts which justify a supplemental bill and either of the facts which require a bill of revivor, occur in one action. So also, any two or more of the four sorts of bills mentioned in the four last sections, may be united in one bill, whenever either of the facts which require either of those bills, occurs in the same action with any of the facts which require any of the others.

§ 630. Leave of court is a prerequisite to the filing of supplemental bills, or bills in the nature of supplemental bills; and it is to be obtained upon proper cause shown, and due notice to the opposite party.[258] And likewise is the case with bills of revivor.[259]

§ 631. Pleadings may or may not be required to be filed to a bill of revivor, or to a bill in the nature of a bill of revivor.[260] But defendants are always required to plead to supplemental bills, and to bills in the nature of supplemental bills.[261] Where a bill of either of those

[255] Slack *v.* Walcott, 3 Mason, 511, 1825.

[256] Story's Equity Pleading, Section 382.

[257] Mitford & Tyler's Equity Pleading, 177.

[258] Equity Rule 34.

[259] Equity Rule 45.

[260] Equity Rule 45.

[261] Equity Rule 32.

kinds shows on its face that the person who filed it was not a proper person to do so, the objection may be made by a motion to dismiss,[262] and formerly when that fault existed, but did not appear on the face of the bill, the defence grounded upon it was, under the rules in force prior to February 1, 1913, appropriate for a plea.[263] Presumably under Equity Rule 29 the defence could now be set down for special hearing. Other defences can be made to supplemental bills, or to bills in the nature of supplemental bills, in the same forms and in the same circumstances in which corresponding defences can be made to original bills for infringement.[264]

§ 632. The hearing of an action in equity for infringement of a patent, may take place before one of the judges of the court sitting alone, or before several judges sitting together, or before a judge and a jury,[265] or before a master in chancery.[266] Judges constitute the best tribunals for the purpose; but as either of the other methods of trial may be resorted to at the will of the court, it is expedient to outline the law relevant to all three.

§ 633. An interlocutory hearing by a judge, in a patent action in equity, is one which occurs after the evidence relevant to the validity of the patent and its infringement by the defendant, has been taken, and before the case is referred to a master to take and state an account of profits and damages. The final hearing, which occurs after the master has taken that account and filed his report, generally involves nothing but the correctness of that report,

[262] Story's Equity Pleading, Section 612.

[263] Story's Equity Pleading, Section 827.

[264] Story's Equity Pleading, Sections 611 and 826.

[265] 18 Statutes at Large, Part 3, Ch. 77, Section 2, p. 316.

[266] Parker *v.* Hatfield, 4 McLean, 61, 1845.

and it therefore may appropriately be treated in the chapter on profits. So also, the preliminary hearing, which occurs when a preliminary injunction is applied for, may properly be discussed in the chapter on injunctions. The interlocutory hearing is generally the pivotal point of a litigation. Where it results in the success of the defendant and consequent dismissal of the bill, it becomes a final hearing.

A complainant cannot discontinue his action in equity for infringement of a patent, when it is called for a hearing; without showing some better reason for wishing so to do, than an intention to begin a new suit for the same cause of action, and a hope of proving a stronger case in the new suit, than he did prove in the one before the court.[267]

Questions of the patentability of inventions and the construction of patents concern the public, and therefore courts will examine all the questions involved in the patent cases brought on for hearing before them, and will not refrain from so doing at the suggestion of either party or of both.[268]

§ 634. Questions of law, in equity patent cases, are to be decided according to the relevant rules of law and equity in force in the United States courts. The sources of those rules are the statutes of the United States, and the decisions of the United States Supreme Court and Court of Appeals, and Circuit Courts, the District Courts, and those decisions of the chancellors of England which were made before the adoption of the Constitution of the United States. Later decisions of English courts sometimes indicate what the law is, but no such decision is of any binding authority in any United States court. Where such

[267] American Steel & Wire Co. v. Mayer & Englund Co., 121 F. R. 127, 1902.

[268] Millard v. Chase, 108 F. R. 401, 1901.

a decision is strictly relevant to a question at bar, and is supported by good reasoning, it may be followed by a United States judge; but if it refers to a substantially different state of statute law from that to which United States patent cases are subject, or if it was fallaciously reasoned out by the judge who delivered it, such a decision may properly be disregarded in the Federal courts. The decisions of State courts fall in the same category in this respect with the modern English decisions, except in cases where the United States statutes direct the Federal courts to follow the laws of the several States. In those cases, the State laws are binding on the Federal judges, not because the States have any authority to prescribe rules to Federal courts, but because the national legislature has adopted those particular State laws, instead of framing and enacting corresponding regulations of its own.

Where a question arises to which no direct answer can be found in the recognized sources of the law, it becomes the duty of the judge to deduce a proper answer, by means of just reasoning, from the general principles of law, of equity, and of justice. He may find assistance in that work by consulting the *obiter dicta* of courts and the commentaries of text-writers; but no *obiter dictum* and no text-book is of any binding authority. The points of law actually decided by the United States Supreme Court are generally binding on all other United States courts, regardless of the reasons which support them.[269] There is an exception to this rule, where the Supreme Court has decided the same question both ways. In such a case, the

[269] American Middlings Purifier Co. *v.* Christian, 3 Bann. & Ard. 44, 1877; Goodyear Dental Vulcanite Co. *v.* Davis, 3 Bann. & Ard. 116, 1877; Green *v.* City of Lynn, 55 F. R. 518, 1893; Westinghouse Air-Brake Co. *v.* Christensen Engineering Co., 103 F. R. 493, 1900.

last decision governs, if it expressly overruled the first.[270] If it simply ignored the first, it may have resulted from the first decision not being called to the attention of the justices who rendered the second. In such a case it is probably the duty of a District Court to follow the more reasonable of the two decisions, regardless of seniority. The points of law actually decided by the Circuit Court of Appeals of any circuit are binding upon all the District Courts in that circuit;[271] but not on any court in any other circuit.[272] And the points of law actually decided by any judge, holding any United States District Court, are followed by every other judge holding any United States District Court, unless they have been reversed by a Circuit Court of Appeals, or by the Supreme Court, or are contrary to other decisions of equal or superior dignity, or appear to be erroneous.[273] The points of law spoken of in this section include the construction given to letters patent, where the evidence of the prior art and other facts relevant to that construction remain unchanged, as well as the rules of law in general.[274] But where a Circuit

[270] Tilghman *v.* Proctor, 125 U. S. 149, 1887.

[271] Edison Electric Light Co. *v.* Bloomingdale, 65 F. R. 214, 1894; Thomson-Houston Electric Co. *v.* Mahar, 112 F. R. 534, 1898.

[272] American Street Car Advertising Co. *v.* Jones, 122 F. R. 807, 1903.

[273] Cary *v.* Lovell Mfg. Co., 31 F. R. 345, 1887; Rubber Trimming Co. *v.* Rubber Comb Co., 35 F. R. 500, 1888; Kidd *v.* Ransom, 35 F. R. 588, 1888; Eastern Paper Bag Co. *v.* Nixon, 35 F. R. 752, 1888; Consolidated Roller Mill Co. *v.* Barnard & Leas Mfg. Co., 43 F. R. 532, 1890; Zinsser *v.* Krueger, 45 F. R. 574, 1891; Enterprise Mfg. Co. *v.* Deisler, 46 F. R. 854, 1891; Campbell Mfg. Co. *v.* Manhattan Ry. Co., 49 F. R. 935, 1892; Macbeth *v.* Gillinder, 54 F. R. 170, 1889; Office Specialty Co. *v.* Winternight Mfg. Co., 67 F. R. 928, 1895; Maitland *v.* Graham, 96 F. R. 247, 1899.

[274] National Box & Paper Co. *v.* American Paper Box Co., 48 F. R. 913, 1892; Sessions *v.* Gould, 60 F. R. 755, 1894.

Court of Appeals, or circuit justice, or circuit judge, or any judge holding a District or Circuit Court has decided the point both ways, the last of those decisions is the one which is to be regarded, if it expressly reversed the first.[275] If it simply ignored the first, the two decisions will respectively weigh according to the weight of the reasons which respectively support them.

Adjudicated cases are binding precedents in the law only where the questions of law involved in those cases were actually submitted for decision therein; and such a submission is not involved in raising those questions in the pleadings, nor in controverting them in the evidence, if one party or the other abandons those questions at the hearing.[276]

§ 635. Questions of fact depend upon the evidence in the particular cases in which they arise, except so far as they depend upon matters of which courts take judicial notice. Questions of fact in patent cases often require for their solution a severely logical process of reasoning from the testimony in the record. It sometimes occurs that the evidence in a number of cases, pending in a number of District Courts, is substantially the same. Where one such case has been carefully argued and deliberately decided in a District Court, all the other District Courts are apt to follow that decision;[277] except where a different decision is required by a different state of evidence.[278] In fact in the second circuit the rule has been laid down

[275] Brown Mfg. Co. *v.* Mast, 53 F. R. 582, 1892.

[276] Celluloid Mfg. Co. *v.* Tower, 26 F. R. 452, 1885.

[277] Hammerschlag Mfg. Co. *v.* Bancroft, 32 F. R. 585, 1887; Hammerschlag Mfg. Co. *v.* Spalding, 35 F. R. 67, 1888; Pratt *v.* Wright, 65 F. R. 99, 1890; Cutler-Hammer Co. *v.* Hammer, 121 F. R. 222, 1903.

[278] Barnes Sprinkler Co. *v.* Walworth Mfg. Co., 51 F. R. 89, 1892; Gates Iron Works *v.* Kimbell & Cobb Stone Co., 79 F. R. 78, 1897.

in a *per curiam* opinion that the importance of securing uniformity of decision is so great "that a decision of a court of co-ordinate jurisdiction should be followed in every case where the questions presented can fairly be regarded as doubtful."[279] The rule in the sixth circuit is expressed in equally vigorous terms.[280]

Still it is the duty of every court to decide cases right; and to that end every judge is bound to decide his cases according to his own convictions, rather than according to the convictions of any other judge of any co-ordinate tribunal; and it is only in cases of doubt in the mind of the judge, that comity comes into operation and suggests a uniformity of ruling,[281] a proposition which is all the more true when the doubt is in the minds of the appellate court.[282]

A serious practical question often arises when a Court of Appeals of one circuit has held a patent invalid and afterwards a Court of Appeals in another circuit holds the patent valid. In such cases it has been held in the second circuit that the decree in the suit holding the patent valid should except from its operation articles acquired from defendants to suits in circuits where the patent was held invalid.[283] It has been held, however, that such a decree

[279] Gormley & Jeffrey Tire Co. *v.* United States Agency, 177 F. R. 691, 1910; Calculagraph Co. *v.* Automatic Time Stamp Co., 187 F. R. 276, 1911; Warren Bros. *v.* City of New York, 187 F. R. 831, 1911; Doelger *v.* German-American Filter Co., 204 F. R. 274, 1913; National Electric Signalling Co. *v.* Telefunksen Wireless Telegraph Co., 221 F. R. 629, 1915.

[280] Cincinnati Butchers' Supply Co. *v.* Walker Bin Co., 230 F. R. 453, 1916.

[281] Mast, Foos & Co. *v.* Stover Mfg. Co., 177 U. S. 488, 1900.

[282] Eldred *v.* Kirkland, 130 F. R. 342, 1904.

[283] Consolidated Rubber Tire Co. *v.* Diamond Rubber Co., 162 F. R. 892, 1908.

should not be so construed as to permit such articles to be used or sold in the second circuit.[284]

The relations between the different Circuit Courts of Appeals, in respect of following the decisions of each other, on questions of fact in patent cases, are the same as the corresponding relations between the different District Courts of the United States.[285]

Where a question of fact in a patent case, has been decided by a Circuit Court of Appeals, that decision is binding in all cases in the District Courts of the same circuit, wherein the evidence is substantially the same,[286] and will be followed by the Circuit Court of Appeals in a later suit on the same patent in which substantially the same evidence is presented even though the claim of invalidity was not urged on the prior appeal.[287] And where a question of fact in a patent case, has been decided by the Supreme Court, that decision is conclusive in all other patent cases, so far as the evidence is substantially identical with that before the Supreme Court.[288] But the evidence must be taken in the subsequent cases, and cannot be imported from the record of the Supreme Court or of the Court of Appeals; though it is not necessary or proper to introduce evidence to prove what evidence was before the

[284] Hurd *v.* Seim, 189 F. R. 591, 1911.

[285] Hanifen *v.* Price, 102 F. R. 509, 1900; Dowagiac Mfg. Co. *v.* Brennan & Co., 127 F. R. 143, 1903; Westinghouse Elec. & Mfg. Co. *v.* Stanley Inst. Co., 133 F. R. 167, 1904.

[286] Bowers Dredging Co. *v.* New York Dredging Co., 80 F. R. 119, 1897.

[287] Crier *v.* Inners, 170 F. R. 324, 1909.

[288] American Middlings Purifier Co. *v.* Christian, 3 Bann. & Ard. 44, 1877; American Bell Telephone Co. *v.* Southern Telephone Co., 34 F. R. 796, 1888; Birmingham Cement Mfg. Co. *v.* Gates Iron Works, 78 F. R. 351, 1896; Westinghouse Air-Brake Co. *v.* Christensen Engineering Co., 113 F. R. 595, 1901.

higher court, or to prove what decision was rendered on that evidence; those two points being left to the examination of the reports and records of the higher tribunal.[289]

The points stated in the last three paragraphs relate to prior cases which were litigated in earnest between opposing parties; and those points do not apply to any case which was collusively conducted, or which ceased to be an adversary action before the hearing which resulted in the decision of the case.[290]

§ 636. The evidence which a complainant is required to produce to support his bill in an action in equity, is the same as that which a plaintiff in an action at law is required to introduce in support of his declaration; except that in an action in equity the complainant must introduce evidence to excuse his delay in filing his bill, where a long delay to file it occurred after the infringement took place; and except that evidence of danger of infringement, may take the place of evidence of actual infringement; [291] and except that a court of equity may take notice of its own records in other cases, when ascertaining the state of the prior art; [292] and except that till after the interlocutory hearing, the complainant need introduce no evidence relevant to profits or to damages, or even showing notice of infringement by "marking patented" or otherwise.[293]

[289] Green *v.* City of Lynn, 55 F. R. 519, 1893.

[290] Western Electric Co. *v.* Anthracite Telephone Co., 100 F. R. 301, 1900, and 113 F. R. 834, 1902.

[291] National Meter Co. *v.* Thomson Meter Co., 106 F. R. 531, 1900. The evidence to establish infringement must be convincing; Marcus *v.* Sutton, 124 F. R. 74, 1903.

In the absence of further showing evidence of a single act of infringement is sufficient to show danger of further infringement. Luten *v.* Dover Construction Co., 189 F. R. 405, 1911.

[292] Cushman Paper Box Mach. Co. *v.* Goddard, 95 F. R. 666, 1899.

[293] Underwood Typewriter Co. *v.* Elliott-Fisher Co., 171 F. R.

When the complainant has some evidence tending to show the character of the defendant's doings, and that those doings infringe the complainant's patent, a court of equity has power to order the defendant to allow the complainant, or some expert or other person representing him, to inspect the defendant's doings for fuller accuracy of knowledge.[294] But this power will not be exercised, where a bill is filed upon a conjecture of infringement with the hope of obtaining evidence to that effect afterward.[295] Mere suspicion of infringement is not sufficient to justify the issuance of an order for inspection.[296] All averments of a bill not specifically denied except allegations of amount of damage are deemed admitted.[297]

§ 637. The evidence which is required to support either of the twenty-eight defences which are common to actions at law and actions in equity, is the same in both those forms of proceeding. Of the two defences which are peculiar to equity, that of non-jurisdiction is one which seldom or never requires any evidence to support it; and laches is, *prima facie*, supported by the fact of the long lapse of time which is deducible from the complainant's proofs, where such a defence has any foundation at all. Where the complainant introduces evidence to excuse the delay, it may be necessary for the defendant to negative that evidence by other proof, or to prove facts which show the complainant's excuse to be invalid or insufficient.

§ 638. The testimony in patent causes as in other ac-

116, 1909; but see Byerley *v.* Philip Carey Co., 225 F. R. 77, 1915.

[294] Diamond Match Co. *v.* Oshkosh Match Works, 63 F. R. 984, 1894; Wilson *v.* Keeley, 43 O. G. 511, 1888; Rowell *v.* Wm. Koehl Co., 194 F. R. 446, 1912.

[295] Dobson *v.* Graham, 49 F. R. 17, 1889; Stokes Bros. Mfg. Co. *v.* Heller, 56 F. R. 298, 1893.

[296] Eibel Process Co. *v.* Remington-Martin Co., 197 F. R. 760, 1912.

[297] Lovell *v.* Johnson, 82 F. R. 206, 1897; Equity Rule 30.

tions in equity is taken orally in open court, with certain exceptions.[298] The court passes upon the admissibility of all evidence as in an action at law. When evidence is offered and excluded and the party against whom the ruling is made excepts thereto at the time, it is provided that the court shall take and report so much thereof or make such a statement respecting it as will clearly show the character of the evidence, the form in which it was offered, the objection made, the ruling and the exception. If the appellate court shall be of opinion that the evidence should have been admitted it may not reverse the decree unless it be clearly of opinion that material prejudice will result from an affirmance, in which event it must direct that further steps be taken as justice may require.[299]

In special instances, however, the court may upon application of either party when allowed by statute or for good and exceptional cause for departing from the rule stated in the foregoing paragraph, permit the deposition of named witnesses to be used before the court or upon a reference to a master to be taken before an examiner or other named officer upon terms specified in the order.[300]

"In a case involving the validity or scope of a patent or trade-mark, the district court may, upon petition, order that the testimony in chief of expert witnesses, whose testimony is directed to matters of opinion, be set forth in affidavits, and filed as follows: Those of the plaintiff within forty days after the cause is at issue; those of the defendant within twenty days after plaintiff's time has expired; and rebutting affidavits within fifteen days after the expiration of the time for filing original affidavits. Should the opposite party desire the production of any affiant for cross-examination, the court or judge shall, on motion, direct that said cross-examination and any

[298] Equity Rule 46. [299] Equity Rule 46. [300] Equity Rule 47.

re-examination take place before the court upon the trial, and unless the affiant is produced and submits to cross-examination in compliance with such direction, his affidavit shall not be used as evidence in the cause."[301]

§ 640. Depositions taken in any other case may be used in any action in equity, if each party therein was a party to the action in which they were taken, or is in privity with a party to that action, and if the court grants a motion to use them.[302] But where either party in the new action was not a party to the former one, and is not in privity with any party thereto, no deposition taken in the former suit can be used in the new one; for no deposition can be read against a party, who could not read it in his favor if it were favorable to him.[303]

§ 641. Documentary evidence is generally introduced before the examiner, within the same time that the oral testimony is required to be taken; and that is the necessary course where documents require to be proved by oral testimony. Each party ought to introduce his documentary evidence, when taking his own testimony; and if he introduces such evidence when the testimony of the other party is being taken, it will be treated as if it was introduced afterward, when the introducer was taking his own testimony, if such subsequent taking of testimony was proper.[304]

Stipulations are extensively made in patent cases on undebatable points of fact, and when made they are binding upon the parties, unless they are canceled or

[301] Equity Rule 48.

[302] Clow *v.* Baker, 36 F. R. 692, 1888.

[303] Dale *v.* Rosevelt, 1 Paige (N. Y.), 35, 1828; Paynes *v.* Coles, 1 Munford (Va.), 394, 1810; Barker *v.* Shoots, 18 F. R. 652, 1884.

[304] Cimiotti Unhairing Co. *v.* American Fur Refining Co., 120 F. R. 673, 1903.

amended by agreement of the parties or an order of the court.[305] But courts will allow a party to withdraw from an inadvertently made stipulation, when it is found to be out of conformity to the truth, and when such a withdrawal is not unjust to the opposite party to the action.[306]

Documents which prove themselves, may be introduced on the hearing without having been put in evidence before the examiner.[307] And documents which require to be proved, may be introduced on or even after the hearing, with the consent of the court.[308] Where a document thought by a party to be material to his case, is known to be in the possession of the opposite party, its production in court may be compelled by a subpœna *duces tecum*.[309]

§ 642. A jury of not less than five and not more than twelve persons may be empanelled by any United States District Court, when sitting in equity for the trial of a patent cause, for the purpose of submitting to them such questions of fact in the case as the court shall deem it expedient to submit; and the verdict of such a jury is treated 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.[310] Therefore such a verdict is only advisory, and never conclusive upon the court. If the judge disagrees in opinion with the jury relevant to the questions of fact covered by the verdict,

[305] General Electric Co. *v.* Wagner Electric Mfg. Co., 123 F. R. 103, 1903.

[306] Carnegie Steel Co. *v.* Cambria Iron Works, 185 U. S. 444, 1902.

[307] Knapp *v.* Shaw, 15 F. R. 115, 1883.

[308] Mast, Foos & Co. *v.* Windmill & Pump Co., 68 F. R. 224, 1895.

[309] Edison Electric Light Co. *v.* United States Electric Lighting Co., 45 F. R. 55, 1891.

[310] 18 Statutes at Large, Part 3, Ch. 77, Section 2, p. 316; Gray *v.* Halkyard, 28 F. R. 854, 1886.

he may enter a decree contrary thereto.[311] But the regular course of proceeding in such a case is to enter a decree in accordance with the verdict, unless the party against whom it was found moves the court for a new trial. A new trial in such a case is granted or refused according as the judge thinks the verdict was right or was wrong; and without special regard to any errors, or freedom from errors, which characterized the admission or rejection of evidence on the trial, or the instructions which were given or those which were refused by the judge.

Where a new trial is refused, and a decree is entered in accordance with the verdict, if the defeated party would take the case to the Circuit Court of Appeals for review, he must do so on appeal from the decree, and not upon a writ of error as from a judgment entered upon a verdict in an action at law. In a properly prepared case, the Circuit Court of Appeals will decide whether, on the whole, the decree was right or was wrong; but it will not pass upon the correctness or incorrectness of the rulings of the judge at the jury trial. Therefore, the evidence taken at the jury trial should be preserved, if there is any intention to take the case to the Circuit Court of Appeals, but no bill of exceptions in the case is necessary or is proper.[312]

§ 643. A master in chancery may be directed by a District Court, with the consent of the parties, to hear and decide any or all the questions in a patent case, and to report his decision to the court.[313] But such a report is advisory only, and no decree will be entered upon it, if either party can convince the judge that it was wrong. Ex-

[311] Silsby *v.* Foote, 1 Blatch. 545, and 20 Howard, 290, 1857.

[312] Watt *v.* Starke, 101 U. S. 247, 1879.

[313] Parker *v.* Hatfield, 4 McLean, 61, 1845; National Cash-Register Co. *v.* Navy Cash-Register Co., 99 F. R. 565, 1900; Western Union Telegraph Co. *v.* American Bell Telephone Co., 105 F. R. 686, 1900.

But see Equity Rule 59.

ceptions to the master's report are the proper means of appeal from his conclusion. If, on such exceptions, the judge concludes that the master was wrong in any respect, he may send the case back to him, with directions to make a new report, and with prescriptions of new criteria by which to make it;[314] or he may proceed to try the questions himself, if that course appears to be more convenient. The rules of practice which regulate the taking of evidence by masters in chancery, and regulate the hearings before them, and the filing of exceptions to their reports, are the same, when they are directed to ascertain the truth relevant to such questions as novelty or infringement, that they are in the more common cases wherein they are directed to take and state accounts of profits and damages.

§ 644. An interlocutory decree, in an equity patent case, is a decree which adjudges that the patent sued upon is valid; and that the defendant has infringed it; and usually that a master in chancery be directed to take and report an account of the profits which the defendant realized from that infringement, and of the damages which the complainant sustained by reason thereof; and sometimes that the defendant be permanently enjoined from further infringement.[315] The decree for an accounting is not, however, a matter of course and may be refused when it appears that the defendant has made only a small number of infringing articles and has discontinued infringement before suit brought, and no substantial recovery could be had.[316] The accounting may also be

[314] Cawood Patent, 94 U. S. 708, 1876.

[315] Dudley E. Jones Co. *v.* Munger Mfg. Co., 50 F. R. 785, 1892; Richmond *v.* Atwood, 52 F. R. 21, 1892; Brush Electric Co. *v.* Western Electric Co., 76 F. R. 761, 1896.

[316] Perkins Electric Switch Mfg. Co. *v.* Yost Electric Co., 189 F. R. 625, 1910.

denied by reason of laches on the part of the plaintiff in bringing suit although the laches shown be not sufficient for a defence to the application for injunctive relief.[317] If the bill prays for an account of damages and profits and actual notice to the defendant is relied upon instead of constructive notice by "marking patented," the decree will grant an accounting only as to infringements committed subsequently to the receipt of the notice, if it is not shown that infringements committed after receipt of notice were substantial in amount.[318] It may be questioned as to whether or not it is proper to decree an accounting in any event if it is not made to appear that there are at least some infringements of which an account could be rendered.[319]

Where only part of the claims in suit are found valid and infringed, such a decree is confined to that part;[320] and such a decree is not entered in a case where the infringement is below the dignity of the court, but bills in such cases are dismissed without costs.[321] Judicial destruction of infringing articles, is a feature of the patent laws of England, but is not justified by any existing law of the United States; though that severe measure has been approved in two *obiter dicta*,[322] and unsuccessfully invoked in two adjudicated cases.[323]

[317] A. R. Mosler & Co. *v.* Luric, 209 F. R. 364, 1913; Marconi Wireless Telegraph Co. *v.* National Electric Signalling Co., 213 F. R. 815, 1914; Vacuum Cleaner Co. *v.* Innovation Electric Co., 234 F. R. 942, 1916.

[318] American Caramel Co. *v.* White, 234 F. R. 328, 1915.

[319] But see Section 636 of this book.

[320] Shute *v.* Morley Co., 64 F. R. 368, 1894.

[321] Wickwire *v.* Wire Fabric Co., 41 F. R. 36, 1889.

[322] Birdsell *v.* Shaliol, 112 U. S. 487, 1884; Underwood Typewriter Co. *v.* Elliot-Fisher Co., 156 F. R. 588, 1907.

See Section 573*a*.

[323] American Bell Telephone Co. *v.* Kitsell, 35 F. R. 521, 1888;

When the District Court finds certain of the claims infringed, the defendant is entitled to a finding on the remaining claims, in order that he may be relieved from the payment of costs.[324] An interlocutory decree which as to damages and profits in form follows the language of Section 4921 of the Revised Statutes is not improper.[325]

§ 644*a*. An appeal from an interlocutory decree may in certain cases be taken to the Circuit Court of Appeals, for the circuit in which that decree was rendered, at any time within thirty days from the entry of the decree.[326]

The grounds upon which an appeal from an interlocutory decree could be taken have been changed from time to time by Federal legislation.[327] Prior to January 1, 1912, such an appeal could be taken only from an interlocutory decree which granted or continued an injunction.[328] By the act of March 3, 1911, c. 231,[329] however, the jurisdiction of the Circuit Court of Appeals to review interlocutory decrees has been extended to those refusing or dissolving or refusing to dissolve an injunction, thereby giving a plaintiff who has been refused an injunction on

American Caramel Co. *v.* Thomas Mills & Bro., 162 F. R. 147, 1907.

[324] National Malleable Co. *v.* Symington Co., 234 F. R. 343, 1916.

[325] Pedersen *v.* Dundon, 220 F. R. 309, 1915.

[326] Judicial Code, Section 128; National Automatic Mach. Co. *v.* Automatic Weighing Mach. Co., 105 F. R. 670, 1901; Western Electric Co. *v.* Williams-Abbott Electric Co., 108 F. R. 953, 1901; Thomson-Houston Electric Co. *v.* Nassau Electric Railroad Co., 112 F. R. 676, 1901.

[327] For a review of the various statutes and authorities see Ward Baking Co. *v.* Weber Bros., 230 F. R. 142, 1916.

[328] See cases cited under note 326 and *Ex Parte* National Enamelling Co., 201 U. S. 156, 1906.

[329] Judicial Code, Section 129 (Act March 3, 1911, c. 231, 36 Stat. 1134), in effect January 1, 1912.

any or all of his claims sued upon, a right of review.[330] It is held that this statute permits an appeal by a defendant from an order refusing to dissolve an injunction although the application for the order of dissolution is merely a rehearing of the application for the injunction.[331] Such an appeal will secure a review of that part of the decree which refers to an injunction;[332] and to that end, the Circuit Court of Appeals will decide the questions of validity and infringement, and whatever other questions underlie the question of the justice of an injunction.[333] If the decision on either of these two fundamental questions is adverse to the complainant, it will result in a direction to the court below, to dismiss the bill of complaint from that tribunal.[334] On such an appeal, however, the findings of the court below on questions of fact have great weight and unless obviously erroneous they will be permitted to stand.[335]

No appeal can be taken by a defendant from an interlocutory decree which directs an accounting of profits and damages, but does not order an injunction. And where an interlocutory decree directs an accounting of profits and damages, and orders an injunction on only part of the claims in suit, and where the defendant there-

[330] Ward Baking Co. *v.* Weber Bros. (reviewing statutes and authorities), 230 F. R. 142, 1916.

[331] American Grain Separator Co. *v.* Twin City Separator Co., 202 F. R. 202, 1912.

[332] Metallic Extraction Co. *v.* Brown, 104 F. R. 354, 1900.

[333] Richmond *v.* Atwood, 52 F. R. 28, 1892; Consolidated Cable Co. *v.* Pacific Ry. Co., 58 F. R. 226, 1893; Columbus Watch Co. *v.* Robbins, 64 F. R. 397, 1894; Kilmer Mfg. Co. *v.* Griswold, 67 F. R. 1017, 1895.

[334] Smith *v.* Vulcan Iron Works, 165 U. S. 525, 1897; Millard *v.* Chase, 108 F. R. 404, 1901; Sheffield Car Co. *v.* D'Arcy, 194 F. R. 686, 1912; *Ex Parte* National Enamelling Co., 201 U. S. 156, 1906.

[335] DeLavel Separator Co., *v.* Iowa Dairy Separator Co., 194 F. R. 423, 1912.

upon appeals, the court will not consider that part of the decree which was favorable to him.[336] Nor will any part of the decree relating to an accounting be considered.[337]

§ 645. Equity Rule 69 reads as follows:

"Every petition for rehearing shall contain the special matter or cause on which such rehearing is applied for, shall be signed by counsel, and the facts therein stated, if not apparent on the record, shall be verified by the oath of the party or by some other person. No rehearing shall be granted after the term at which the final decree of the court shall have been entered and recorded, if an appeal lies to the Circuit Court of Appeals or the Supreme Court. But if no appeal lies, the petition may be admitted at any time before the end of the next term of the court, in the discretion of the court.[338]

§ 646. A rehearing for matter apparent on the face of the record may be applied for by a petition signed by counsel, and stating the ground upon which the rehearing is prayed.[339] That ground must be sufficient to convince the judge that the decree was perhaps erroneous.[340] In order to do that, it is necessary to point out some particular misapprehension of the law, or some particular mistake in respect of the evidence, into which the judge was unfortunate enough to fall.[341] Such a misappprehension may be established by showing that since the case sought to be reheard was decided, the appellate court has settled or

[336] Eagle Lock Co. *v.* Corbin Lock Co., 64 F. R. 789, 1894.

[337] Lederer *v.* Garage Equipment Co., 235 F. R. 527, 1916.

[338] Equity Rule 69.

[339] Equity Rule 69.

[340] American Diamond Rock Boring Co. *v.* Sheldon, 18 Blatch. 50, 1880.

[341] Everest *v.* Oil Co., 22 F. R. 252, 1884; Railway Mfg. Co. *v.* Railroad Co., 26 F. R. 411, 1886; Coupe *v.* Weatherhead, 37 F. R. 16, 1888; Detwiller *v.* Bosler, 58 F. R. 250, 1893; Beach *v.* Hobbs, 82 F. R. 928, 1897.

clarified the law so as to give it a different character from that which it was then understood to have;[342] but such a mistake cannot be established by showing that the judge omitted, in his opinion, to review all the evidence in the case.[343] It is useless to ask for a rehearing of this kind on the general ground that the decision is thought by counsel to be wrong.[344] But a rehearing may be spontaneously ordered by the court, when the judge begins to doubt his decision.[345]

§ 647. A rehearing on account of newly discovered evidence must be applied for as soon as possible after its discovery,[346] by a petition verified by the oath of the applicant or of some other person,[347] and stating the nature of the alleged newly discovered evidence, and that it was not known to the petitioner till after the decree was rendered;[348] and also what diligence was exercised in searching therefor prior to that time,[349] and praying for leave to file a supplemental bill in the nature of a bill of review, and for a rehearing of the cause at the time when the issues raised by that bill shall be ready for hearing.[350] The function of such a bill is to furnish a foundation in the pleadings for evidence on both sides of the new issues of fact to determine which the rehearing is granted.

[342] Wooster *v.* Handy, 21 F. R. 51, 1884; Spill *v.* Celluloid Mfg. Co., 21 F. R. 640, 1884; Campbell *v.* New York, 35 F. R. 504, 1888.

[343] Timken *v.* Olin, 37 F. R. 207, 1888.

[344] Tufts *v.* Tufts, 3 Woodbury & Minot, 429, 1847; Gage *v.* Kellogg, 26 F. R. 243, 1886.

[345] Brown Mfg. Co. *v.* Deere, 51 F. R. 229, 1892.

[346] Blandy *v.* Griffith, 6 Fisher, 435, 1873; Pittsburgh Reduction Co. *v.* Cowles Aluminum Co., 121 F. R. 557, 1903.

[347] Equity Rule 69.

[348] Foote *v.* Stein, 35 F. R. 205, 1888.

[349] Allis *v.* Stowell, 5 Bann. & Ard. 459, 1880; New York Filter Co. *v.* Filter Co., 62 F. R. 582, 1894.

[350] Dexter *v.* Arnold, 5 Mason, 310, 1829; Daniell's Chancery Practice, 1537.

When such a petition is filed, it must be supported by affidavits of the witnesses who are expected to testify to the newly discovered facts which are sought to be brought into the case,[351] and also by affidavits showing that those facts were not discovered by the petitioner till after the former hearing,[352] and could not, with reasonable diligence, have been discovered sooner than they were.[353] Such a petition may be answered by counter affidavits tending to show that part or all of the statements in the petitioner's affidavits are untrue.[354] To grant the prayer of the petition, the court must be satisfied that the applicant's affidavits are probably true,[355] and clearly material,[356] and that the facts they set forth were not known to the petitioner at the time of the former hearing, and could not with reasonable diligence have been discovered prior to that event;[357] except that the last of these four points is not required to be shown, where it is shown that the other party knew, at the time of the decree, of the facts which are sought to be brought into the case on a rehearing.[358]

Where a rehearing is granted to permit the defendant

[351] Reeves *v.* Keystone Bridge Co., 2 Bann. & Ard. 259, 1876.

[352] Reeves *v.* Keystone Bridge Co., 2 Bann. & Ard. 256, 1876.

[353] India Rubber Comb Co. *v.* Phelps, 4 Fisher, 317, 1870; Hitchcock *v.* Tremaine, 9 Blatch. 551, 1872; Barker *v.* Stowe, 4 Bann. & Ard. 405, 1878; Willimantic Linen Co. *v.* Clark Thread Co., 24 F. R. 799, 1885; Bennett *v.* Schooley, 77 F. R. 352, 1896.

[354] Blandy *v.* Griffith, 6 Fisher, 435, 1873.

[355] Munson *v.* New York, 11 F. R. 72, 1882; New York Sugar Co. *v.* Sugar Co., 35 F. R. 217, 1888.

[356] Reeves *v.* Keystone Bridge Co., 2 Bann. & Ard. 259, 1876.

[357] Prevost *v.* Gratz, 1 Peters' Circuit Court Reports, 364, 1816; Baker *v.* Whiting, 1 Story, 234, 1810; Reeves *v.* Keystone Bridge Co., 2 Bann. & Ard. 258, 1876; Page *v.* Telegraph Co., 18 Blatch. 122, 1880.

[358] Jonathan Mills Mfg. Co. *v.* Whitehurst, 60 F. R. 81, 1894.

to introduce newly discovered evidence, after an accounting has been carried forward in pursuance of an interlocutory decree; the order will properly provide that the defendant shall pay to the complainant all the costs which shall have been incurred by the latter, in connection with that accounting.[359]

Rehearings will not be granted to enable parties to search for further evidence;[360] nor to strengthen their expert testimony;[361] nor to amend their pleadings so as to make certain evidence admissible, which was taken before the former hearing, and was disregarded thereon, because not supported by any pleading;[362] nor to produce cumulative evidence on questions of fact which were in issue at the former hearing;[363] nor to correct errors of management committed by the petitioner's counsel.[364] And no appeal lies from a decision of a District Court granting or refusing any rehearing.[365]

Where a rehearing on account of newly discovered evidence, is wanted by either party, after an interlocutory decree against him has been affirmed by the Circuit Court of Appeals, the petition for that rehearing must be addressed to the appellate tribunal. If that court denies the petition, that denial is final. If it thinks the petition

[359] Pittsburgh Reduction Co. *v.* Cowles Aluminum Co., 121 F. R. 557, 1903.

[360] Munson *v.* New York, 11 F. R. 72, 1882.

[361] Hitchcock *v.* Tremaine, 5 Fisher, 538, 1872.

[362] American Saddle Co. *v.* Hogg, 6 Fisher, 67, 1872.

[363] Blandy *v.* Griffith, 6 Fisher, 435, 1873; Pfanschmidt *v.* Mercantile Co., 32 F. R. 667, 1887.

[364] Ruggles *v.* Eddy, 11 Blatch. 524, 1874; Colgate *v.* Telegraph Co., 19 F. R. 828, 1884; Pittsburg Reduction Co. *v.* Aluminum Co., 64 F. R. 128, 1894; Lowell Mfg. Co. *v.* Hogg, 70 F. R. 787, 1895; Hanifen *v.* E. H. Godshalk Co., 78 F. R. 816, 1896.

See Judicial Code.

[365] Roemer *v.* Bernheim, 132 U. S. 106, 1889.

should be granted, the Circuit Court of Appeals grants permission to the petitioner to apply to the court below for the desired rehearing; and that court will then pass upon such an application on its merits.[366] Where a rehearing on account of newly discovered evidence, is wanted by either party, after an interlocutory decree against him has been appealed to the Circuit Court of Appeals, but has not been heard in that tribunal, the petition for that rehearing must be addressed to the court below, and must ask that court to request the Circuit Court of Appeals to return the record to the lower tribunal for further proceedings therein.[367]

§ 648. A supplemental bill in the nature of a bill of review should state the newly discovered facts upon which it is based, and should pray that the cause may be heard with respect to the new matter, at the same time that it is reheard upon the original bill, and that the party who files the subordinate bill may have such relief as the nature of his case requires. The proceedings upon a bill of this description are the same as those upon original bills in general.[368] No order for a rehearing, made after an interlocutory decree, and while an account of profits and damages is being taken by a master in chancery, will stop the taking of that account; unless the court enters a special order directing the master to suspend proceedings therein.[369] And where a rehearing results in a reversal of an interlocutory decree, which has been entered in favor

[366] *In re* Gamewell Fire-Alarm Tel. Co., 73 F. R. 908, 1896; Municipal Signal Co. *v.* Gamewell Fire-Alarm Tel. Co., 77 F. R. 452, 1896; Bliss *v.* Read, 106 F. R. 318, 1901.

[367] Roemer *v.* Simon, 91 U. S. 149, 1875; Cimiotti Unhairing Co. *v.* American Unhairing Mach. Co., 99 F. R. 1003, 1900; Nutter *v.* Mossberg, 118 F. R. 168. 1902.

[368] Daniell's Chancery Practice. 1537.

[369] Daniell's Chancery Practice, 1467.

of a complainant, and results also in a dismissal of the complainant's bill; that dismissal will be without prejudice to the use, in any subsequent accounting, of the evidence which may have been taken by the master.[370] And the decree ordering that dismissal will give costs to the complainant for the litigation prior to the granting of the rehearing; and will give costs to the defendant for the litigation which occurred after that event.[371]

§ 649. A final decree will be entered in favor of the defendant, where a demurrer to the whole bill is sustained or, since the Equity Rules in effect Feb. 1, 1913, a motion to dismiss is granted, on a point which is not cured by amendment; or where a plea to the whole bill or its present equivalent, special matter in the answer, is found to be true; or where either of the numerous defences which were formerly appropriate only for an answer, and which apply to the whole bill, are established at an interlocutory hearing.[372]

Where more than one of those defences is strongly supported in the record, it is proper for the court to confine the decision to any one of them that is judicially found to be sound. Where the defence of non-infringement is thus found, it is proper[373] and generally preferable[374] to select that defence as the one upon which to base the decision for the defendant. The reason for this preference, is the consideration that the question of the validity of a patent ought not to be adjudicated in the affirmative, in a case where the defendant, by reason of non-infringement thereof,

[370] Campbell *v.* New York, 35 F. R. 501, 1888.

[371] Hake *v.* Brown, 44 F. R. 283, 1890.

[372] Richmond *v.* Atwood, 52 F. R. 21, 1892.

[373] McMichael & Wildman Mfg. Co. *v.* Ruth, 123 F. R. 890, 1903.

[374] Wilcox & Gibbs Sewing Mach. Co. *v.* Sherborne, 123 F. R. 877, 1903.

has no adequate motive to hunt up and lay before the court, all the facts which relate to that question. But where a record does contain evidence enough to establish the invalidity of a patent, it is both proper and expedient to base a decision for the defendant on that ground, even where the defence of non-infringement is also established by the record; because the public has a right to be judicially told that a void patent is void, whenever that conclusion is established by evidence presented in a litigated case, in one of the courts which have received jurisdiction to adjudicate all questions of validity of patents.

Final decrees will be entered in favor of complainants, when their bills have successfully run the gauntlet of motions to dismiss, answers, interlocutory hearings, petitions for rehearings, supplemental bills in the nature of bills of review, accountings before a master, exceptions to the master's report, and final hearings, through which original bills in patent cases may regularly be caused to pass. The last three parts of this series of proceedings are explained in the chapter on profits, and the others have already been outlined in this.

Where an action in equity for alleged infringement of a patent, is settled after evidence is taken therein, and before a hearing thereof; that settlement cannot include an effective stipulation that the evidence shall be withdrawn from the files of the court.[375] Parties who litigate such controversies in United States courts, must litigate them in public, and are not permitted to use those tribunals for secret proceedings, or to conceal or suppress any of the records of their litigations.

Where several cases on one patent are litigated on one set of depositions and other evidence, only one bill of costs is taxed; and where that bill is taxed against the complain-

[375] Sloan Filter Co. v. El Paso Reduction Co., 117 F. R. 504, 1902.

ant, a decree is made in favor of each defendant for an equal share of the amount.[376]

Assuming that a final decree has already been entered for the complainant or the defendant, and that the costs have been adjusted and taxed according to law,[377] it is now convenient to delineate the further proceedings to which the defeated party may resort. These are of two kinds: bills of review, and appeals.

§ 650. A bill of review is the proper means of securing a reconsideration of a final decree, after the expiration of the term at which it was entered.[378] Such bills are of two sorts: those filed to correct errors apparent on the face of the pleadings or decree;[379] and those filed to introduce evidence of facts which occurred or were discovered after the decree was entered.[380]

§ 651. A bill of review to correct errors apparent on the pleadings or decree, may be filed without leave of court,[381] but no such bill will be considered or acted upon by the court, unless it is filed within the same time after the entry of the decree, as that provided for by statute relevant to appeals;[382] which latter time is at present six months.[383] Nor will such a bill be entertained, if the decree which it was filed to correct, was entered by the lower court, after

[376] Taber *v.* Meriden Britannia Co., 106 F. R. 85, 1901.

[377] Sections 543 to 549 of this book; Wooster *v.* Handy, 23 F. R. 49, 1885; Spill *v.* Mfg. Co., 28 F. R. 870, 1886; Hill *v.* Smith, 32 F. R. 753, 1887; Ryan *v.* Gould, 32 F. R. 754, 1887; New York Belting Co. *v.* Rubber Co., 32 F. R. 755, 1887.

[378] Story's Equity Pleading, Section 403.

[379] Whiting *v.* The Bank of the United States, 13 Peters, 14, 1839.

[380] Story's Equity Pleading, Section 404.

[381] Ross *v.* Prentiss, 4 McLean, 106, 1846; Story's Equity Pleading, Section 405.

[382] Thomas *v.* Harvie's Heirs, 10 Wheaton, 149, 1825; McDonald *v.* Whitney, 39 F. R. 467, 1889.

[383] 26 Statutes at Large, p. 826, Ch. 517, Section 11.

an appeal to a higher court, and in pursuance of directions contained in the mandate of the latter tribunal.[384] In considering a bill of review of this sort, the court will confine its examination to the pleadings and decree in the original action; for no bill lies to correct any errors of fact which were made in examining or weighing the evidence upon which the decree was based.[385]

§ 652. A bill of review, filed to introduce evidence of new facts or of newly discovered facts, cannot be filed without leave of court.[386] Where the case sought to be reviewed has been appealed to the Circuit Court of Appeals, and decided there, the application must be presented to that tribunal.[387] If that court decides that the leave ought to be granted, it will authorize the court below to receive and adjudicate the bill of review; and thereafter the case will proceed in the lower tribunal, much as it would have done if no appeal had been taken. After the bill of review has been litigated and a new decree entered, an appeal will lie to the Circuit Court of Appeals on the whole case. The mode of application for leave to file such a bill, is by a petition stating the original proceedings and the new facts or newly discovered facts, on the strength of which reversal of the decree is prayed.[388] The petition must be supported by affidavits stating the exact nature of those facts, in order that the court may judge of their materiality and sufficiency, and showing that they occurred after the final decree was entered, or if

[384] Southard *v.* Russell, 16 Howard, 570, 1853.

[385] Whiting *v.* Bank of the United States, 13 Peters, 14, 1839; Story's Equity Pleading, Section 407.

[386] Ross *v.* Prentiss, 4 McLean, 106, 1846.

[387] *In re* Potts, 166 U. S. 263, 1897; Kissinger-Ison Co. *v.* Bradford Belting Co., 123 F. R. 92, 1903.

[388] Massie's Heirs *v.* Graham's Adm'rs, 3 McLean, 43, 1842.

they occurred before that time, that they were not discovered, and could not with reasonable diligence have been discovered till afterward.[389] Petitions of this sort may be filed even more than six months after the entry of the decree, provided they are filed within a reasonable time after the discovery is made, upon which they are based.[390]

Leave to file such a bill will be granted, in a proper case, whether those facts relate to issues in the original action, or relate to defences which were not in issue therein; [391] but it will not be granted where the facts stated in the petition are not adapted, or are not sufficient, to have altered the decree if they had been before the court on the hearing; [392] nor where those facts could, with reasonable diligence, have been discovered before the decree was entered; [393] nor to enable the petitioner to introduce evidence to impeach the character of the witnesses upon whose testimony the decree was based; nor to introduce cumulative testimony on a point litigated and decided at the hearing; but newly discovered corroborating evidence in writing, may furnish a foundation for such leave.[394]

After a bill of review to introduce new facts, or newly discovered facts, has been duly filed, the opposite party may answer thereto, and thus put the party who filed

[389] Story's Equity Pleading, Sections 412, 413, and 414.

[390] United States *v.* Samperyac, Hemstead's Circuit Court Reports, 131, 1831.

[391] Dexter *v.* Arnold, 5 Mason, 313, 1829; United States *v.* Samperyac, Hemstead's Circuit Court Reports, 131, 1831; Story's Equity Pleading, Sections 415 and 416.

[392] Dexter *v.* Arnold, 5 Mason, 313, 1829.

[393] Rubber Co. *v.* Goodyear, 9 Wallace, 806, 1869; Boston & Revere Electric Street-Railway Co. *v.* Bemis Car-Box Co., 98 F. R. 121, 1899; Kissinger-Ison Co. *v.* Bradford Belting Co., 123 F. R. 92, 1903.

[394] Southard *v.* Russell, 16 Howard, 569, 1853.

it, to the proof of its allegations.[395] A motion to dismiss a bill of this sort is not appropriate, because its sufficiency in point of law must be passed upon before it can be filed.

§ 653. A bill in the nature of a bill of review, differs from a bill of review only in respect of the legal character of the complainant. The latter bill can be filed by either of the parties to the decree which is sought to be reviewed, or by their respective privies in representation, such as heirs, executors, or administrators; but the former is required to be filed, where privies in estate, such as devisees or assignees of an original party, seek to secure the reversal or modification of a final decree after the expiration of the term at which it was entered.[396] Neither of these sorts of bills is to be confounded with a supplemental bill in the nature of a bill of review. That is still another variety, and its character and operation have already been outlined.[397]

§ 654. An appeal to the Supreme Court of the United States, can be taken by a complainant whose action for an infringement of a patent, has been dismissed by a District Court, on the ground of want of jurisdiction.[398] Where a motion to dismiss an action on that ground has been denied by a District Court, and where a decree has afterward been made against the defendant for infringement, the defendant has a right to have the question of jurisdiction reviewed on an appeal, and also has a right to have reviewed, all the questions which were decided against him in the decree for infringement. It has been held that in such a case the proper practice is to appeal

[395] Dexter *v.* Arnold, 5 Mason, 309, 1829.

[396] Story's Equity Pleading, Section 409.

[397] Sections 647 and 648 of this book.

[398] Judicial Code, Section 238; L. E. Waterman Co. *v.* Parker Pen Co., 107 F. R. 141 1901.

the whole case to the Circuit Court of Appeals, and then that tribunal will certify the question of jurisdiction to the Supreme Court, and will wait for the answer to that question, before hearing the appeal from the decree of infringement.[399]

More recent authorities, however, hold that when the lower court has in addition to the question of jurisdiction decided issues of general law, the Circuit Court of Appeals has power to decide all questions including that of jurisdiction, if the assignments of error are addressed both to the questions of general law and that of jurisdiction.[400]

An appeal may be taken to the Supreme Court from a decree of the Court of Appeals of the District of Columbia wherein is drawn in question the validity of any act of the Commissioner done under the authority of any statute or rule of the Patent Office—*e. g.*—where the Court of Appeals has passed upon the act of the officials of the Patent Office in compelling a division of an application under Patent Office Rule 41. The rule having the force of a statute, whatever action is taken under it is taken or purports to be taken under the "authority of the United States."[401] The case of Frasch *v.* Moore,[402] however, seems to hold generally that no appeal lies to the Supreme Court from a decree of the Court of Appeals of the District of Columbia which passes on a decision of the Commissioner requiring division of an application, since such a decree is not final within the meaning of Section 8 of the Act of Feb. 9, 1893, c. 74, 27 Stat. 436.

[399] Sun Printing & Publishing Ass'n *v.* Edwards, 121 F. R. 826, 1903.

[400] Smith *v.* Farbenfabriken of Elberfeld Co., 203 F. R. 476, 1913.

[401] Act of February 3, 1893, Section 8; Steinmetz *v.* Allen, 192 U. S. 543, 1904.

[402] Frasch *v.* Moore, 211 U. S. 1, 1908. See Judic. Code, Sec. 250.

An appeal to a Circuit Court of Appeals is demandable from the final decree of any United States District Court, in any case arising under the patent laws, provided it is taken within six months after the entry of the decree; [403] unless the decree involves only a question of jurisdiction; or is only for costs.[404] But in order to operate as a supersedeas, and thus stay execution, an appeal must be taken within sixty days after the rendition of the decree; and indeed an execution may be issued, if an appeal is not taken within ten days after such rendition.[405] But in the latter case, a supersedeas afterward obtained will prevent further proceedings under the execution, though it will not interfere with what has already been done.[406] The time within which appeals may be taken, may properly be held to begin, either when the case is finally decided, or when the formal decree is signed by the judge, and filed with the clerk of the court.[407] When an appeal operates as a supersedeas, it so operates only as against the money recovery provided for in the decree, and not as against that part of the decree which directs the payment of the master's fees,[408] nor as against that part which directs an injunction to issue; [409] but the judge who enters a decree granting an injunction, has discretionary power to suspend, modify or restore the same pending an appeal.[410]

A decision of a United States District Court, not to dismiss a bill for infringement of a patent, upon the motion

[403] 26 Statutes at Large, p. 826, Ch. 517, Sections 6 and 11; Judicial Code, Section 128.

[404] DuBois *v.* Kirk, 158 U. S. 67, 1895.

[405] Revised Statutes, Sections 1012 and 1007.

[406] Board of Commissioners *v.* Gorman, 19 Wallace, 663, 1873.

[407] Silsby *v.* Foote, 20 Howard, 290, 1857.

[408] Myers *v.* Dunbar, 1 Bann. & Ard. 565, 1874.

[409] Whitney *v.* Mowry, 3 Fisher, 175, 1867.

[410] Equity Rule 74.

of a nominal complainant, against the opposition of those equitably entitled to sue in the name of the nominal complainant, is immediately appealable to the Circuit Court of Appeals.[411] But a decree which sustains part of the claims upon which a bill is based, while dismissing another part of those claims from court, is not appealable by the complainant as from a final decree; for though it is final in respect of the latter, it is only interlocutory in respect of the former, and the right of the complainant to appeal from its final part, is suspended until after an accounting is had on the sustained claim, and a completely final decree is made to dispose of the entire case.[412]

An interlocutory decree awarding merely an accounting and granting no injunction for the reason that the patent has expired is not appealable to the Circuit Court of Appeals. The court announcing this holding states that "it is idle to say that this is an appeal from an order denying an injunction, in view of the fact that it is conceded on all hands that the patent has expired." [413]

The prosecution of an appeal includes the procurement, from the clerk of the District Court, of a transcript of the record of the case in that court, or of such parts of that record as the parties agree to be sufficient to enable the Circuit Court of Appeals to decide the questions involved in the appeal. Such an agreement must be made as a formal stipulation, and be filed in the office of the clerk of the District Court; and when it is thus made and

[411] Brush Electric Co. *v.* Electric Co. of San Jose, 51 F. R. 557, 1892.

[412] Western Electric Co. *v.* Williams-Abbott Electric Co., 108 F. R. 953, 1901; Library Bureau *v.* Yawman & Erbe Mfg. Co., 147 F. R. 245, 1906; *Ex Parte* National Enamelling Co., 201 U. S. 156, 1906.

Contra, Chicago Wooden Ware Co. *v.* Miller Ladder Co., 133 F. R. 541, 1904.

[413] American Sulphite Pulp Co. *v.* Carthage Sulphite Pulp Co., 224 F. R. 501, 1915.

filed, the clerk will prepare a transcript of the specified parts of the record and will certify it accordingly.[414]

An appeal to the Court of Appeals of the District of Columbia, is demandable from the final decree of the Supreme Court of the District of Columbia, in any case arising under the patent laws.[415] And the law stated in this section, in respect of appeals from a United States District Court to a United States Circuit Court of Appeals, is also applicable to appeals from the Supreme Court of the District of Columbia to the Court of Appeals of the District of Columbia; except in a few particulars of difference, due to differences between the statutes which gave to those appellate courts, their respective beings and jurisdictions.[416]

§ 655. On the hearing of an appeal in any Circuit Court of Appeals, the decree may generally be attacked by the appellant, upon any ground upon which it was resisted in the court below; and may be supported by the appellee upon any ground in the record, whether the court below based its decree upon that ground or some other.[417] But the decree cannot be assailed on the ground that the court below refused to set aside a decree *pro confesso*,[418] or refused to allow the appellant to retract an admission which he had made in his pleadings;[419] or granted or refused a rehearing;[420] or rendered any other decision

[414] Lamb Knit Goods Co. *v.* Lamb Glove & Mitten Co., 120 F. R. 273, 1902. See Equity Rules 75, 76, and 77.

[415] 31 Statutes, Ch. 854, sec. 226, p. 1225.

[416] 26 Statutes at Large, p. 826, Ch. 517; 27 Statutes at Large, p. 434, Ch. 74; 31 Statutes at Large, p. 660, Ch. 803.

[417] Electric Gas Lighting Co. *v.* Fuller, 59 F. R. 1003, 1894.

[418] Dean *v.* Mason, 20 Howard, 198, 1857.

[419] Jones *v.* Morehead, 1 Wallace, 155, 1863.

[420] Roemer *v.* Bernheim, 132 U. S. 106, 1889; Boesch *v.* Graff, 133 U. S. 699, 1890.

which belonged to the judicial discretion of the court to make. Nor can a decree be attacked in the Circuit Court of Appeals, on account of any error made by a master in chancery in taking an account of profits or damages, unless that error was brought before the court below for correction, by means of a proper exception to the master's report;[421] not even then, where the alleged error is one of quantity or computation, and is not obvious.[422] In fact when the court below has concurred with the master on his findings of fact the findings will not be disturbed by the appellate court except for strong reasons.[423] Where a decree is reversed and remanded for further proceedings, and a second decree is entered by the court below after those proceedings are taken, and an appeal is taken from the second decree, that decree cannot be assailed on account of any errors that occurred prior to the former decree.[424] And the decision of the Circuit Court of Appeals on the first appeal is not reviewable on the second appeal to that tribunal.[425] No decree can be attacked by the appellee, on the appellant's appeal. Where either party to a decree intends to ask the Circuit Court of Appeals to direct it to be altered, he must appeal to that tribunal, whether the other party appeals or not.[426] Where both parties appeal, both appeals are heard together in the Circuit Court of Appeals, and the complainant in the court below is entitled to open and to close the argu-

[421] Kinsman *v.* Parkhurst, 18 Howard, 289, 1855.

[422] Warren *v.* Keep, 155 U. S. 267, 1894.

[423] Emerson & Morris Co. *v.* Simpson Bros. Corporation, 214 F. R. 572, 1914.

[424] Himely *v.* Rose, 5 Cranch, 313, 1809; The Santa Maria, 10 Wheaton, 431, 1825; American Insurance Co. *v.* Canter, 1 Peters, 511, 1828; Corning *v.* Troy Iron & Nail Factory, 15 Howard, 451, 1853.

[425] Standard Sewing Mach. Co. *v.* Leslie, 118 F. R. 559, 1902.

[426] Corning *v.* Troy Iron & Nail Factory, 15 Howard, 451, 1853.

ment. A decree may also be attacked by an appellant on several grounds upon which it may not have been resisted in the court below. Non-jurisdiction of equity falls in this category,[427] where the patent expired before the bill was filed; and so does want of invention, when that want results from facts of which the court will take judicial notice.[428]

Where a defendant interposed several defences in the court below, and where that court held one of them to be good, and therefore dismissed the bill; and where the Circuit Court of Appeals on an appeal, finds the latter defence to be bad, it will thereupon decide whether either of the others are good,[429] and if it finds either of them to be so, it will affirm the decree.[430] Or the Circuit Court of Appeals may find a defence to be good, which the court below did not so find, and may thereupon omit to decide upon the defence which the court below found to be good.[431] And a decree for a complainant may also be sustained on a different ground from that upon which it was based in the court below.[432] For these reasons, assignments of error must be aimed at the decree of the court, and not at the reasons which were stated by the judge for making that decree.[433]

§ 656. After the Circuit Court of Appeals has heard an appeal, it may affirm the decree, or may reverse it, or may modify it, or may remand the case to the court below for

[427] Hipp *v.* Babin, 19 Howard, 271, 1856.

[428] Brown *v.* Piper, 91 U. S. 41, 1875.

[429] Crown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 F. R. 848, 1901.

[430] Corning *v.* Troy Iron & Nail Factory, 15 Howard, 451, 1853.

[431] Patent Clothing Co. *v.* Glover, 141 U. S. 560, 1891.

[432] Woodward *v.* Boston Lasting Mach. Co., 63 F. R. 609, 1894.

[433] Clark *v.* Deere & Mansur Co., 80 F. R. 534, 1897; Evans *v.* Suess Glass Co., 83 F. R. 706, 1897.

further proceedings.[434] Such further proceedings may involve the taking of further testimony before the master on the question of damages and profits, and in such a case the defendant may introduce evidence to show that the witnesses on the former hearing made mistakes as to the number of infringements.[435] Where the Court of Appeals affirms the decree, with respect of the merits, it will affirm it also in respect of the costs; [436] except where the absence of a needed disclaimer necessitates that costs shall not be recovered though the decree is otherwise affirmed.[437] Where it reverses the decree, it generally does so at the appellee's costs, so that the court below will have nothing to do but to tax those costs, and enter a decree therefor; and from such a decree there is no appeal.[438] If, however, the appellate court does not pass on the question of costs in the court below, the court below in entering a decree on the mandate will not ordinarily change its prior decree as to costs, at least in a case where the plaintiff has obtained a decree for damages which was reversed by the appellate court on the ground that plaintiff has failed to make a proper separation of damages and where nevertheless the plaintiff did suffer damage.[439] When the appellate court modifies the decree, it may do so in either of several respects. For example, it may change

[434] Revised Statutes, Section 701.

[435] Westinghouse Electric Mfg. Co. *v.* Wagner Electric Mfg. Co., 218 F. R. 646, 1914.

[436] Du Bois *v.* Kirk, 158 U. S. 58, 1895; Sproull *v.* Pratt & Whitney Co., 108 F. R. 965, 1901.

[437] Revised Statutes, Section 4922; O'Reilly *v.* Morse, 15 Howard, 121, 1853; Novelty Glass Mfg. Co. *v.* Brookfield, 172 F. R. 221, 1909.

Contra, Kahn *v.* Starrels, 136 F. R. 597, 1905; Johnson *v.* Foos Mfg. Co., 141 F. R. 73, 1905.

[438] Elastic Fabrics Co. *v.* Smith, 100 U. S. 111, 1879.

[439] Westinghouse Air-Brake Co. *v.* New York Air-Brake Co., 140 F. R. 144, 1905.

the amount of the decree, instead of remanding the case to the court below for a recomputation.[440] Where it remands a case for further proceedings, those proceedings are guided by the court below, as if it had originally rendered the decision, which was made by the appellate tribunal.[441] Where both parties appeal from the decree, and the decree is affirmed, no costs incurred in the Circuit Courts of Appeals, are allowed to either party.[442]

§ 657. A certificate of division of opinion is a means of taking a question of law to the Circuit Court of Appeals, where that question arises in a case heard by two judges in the court below, and where those judges disagree about its proper solution.[443] No question of infringement or other question of fact can be taken to the Circuit Court of Appeals in this method; [444] and such a certificate must state the precise points of law which are involved, or the case will be remanded without an answer.[445]

§ 657*a*. No appeal may be taken, to the Supreme Court from a final decree of the Court of Appeals of the District of Columbia, which merely adjudges the validity or invalidity of a patent although the decree may in a proper case be reviewed by certiorari or certified questions.[446] And no appeal lies from any Circuit Court of Appeals to the Supreme Court in any patent case,[447] ex-

[440] Parks *v.* Booth, 102 U. S. 106, 1880; Tuttle *v.* Claflin, 76 F. R. 237, 1896; Wales *v.* Waterbury Mfg. Co., 101 F. R. 130, 1900.

[441] *In re* Chicago Sugar-Refining Co., 87 F. R. 750, 1898.

[442] Edison Electric Light Co. *v.* Electric Supply Co., 66 F. R. 312, 1895.

[443] 26 Statutes at Large, p. 826, Ch. 517, Section 11.

[444] California Paving Co. *v.* Molitor, 113 U. S. 616, 1884.

[445] Wilson *v.* Barnum, 8 Howard, 258, 1850.

[446] Judicial Code, Sections 250, 251.

[447] Judicial Code, Section 128, as amended by Act of January 28, 1915.

cept actions brought by the United States to repeal patents.[448]

Any Circuit Court of Appeals may certify to the Supreme Court any pure question of law upon which it desires the instruction of that court for its proper decision.[449] Where a Circuit Court of Appeals sends such a certificate to the Supreme Court, that certificate must clearly and distinctly state whatever question of law is involved therein, and must show that the Circuit Court of Appeals desires to receive instruction from the Supreme Court how to decide that question.[450]

The Supreme Court may send a writ of certiorari, to any Circuit Court of Appeals, requiring any action in equity for infringement of a patent to be sent from the latter tribunal to the Supreme Court, for its review and determination, with the same power and authority as if the case had been carried by an appeal to the Supreme Court.[451] This power may be exercised before or after any decision of the Circuit Court of Appeals, and irrespective of any such decision, and at any time during the pendency of the case in that tribunal.[452] But this power is exercised by the Supreme Court, only in cases of great importance; or in cases of conflict between two or more Circuit Courts of Appeals, or between such a court and a State court; or in cases which affect some interest of this nation.[453] And it is only when the lower courts are distinctly wrong that they will be reversed on questions of fact.[454]

[448] United States *v.* Bell Telephone Co., 159 U. S. 548, 1895.

[449] Graver *v.* Faurot, 162 U. S. 435, 1896; Cross *v.* Evans, 167 U. S. 60, 1897; Judicial Code, Section 239.

[450] Columbus Watch Co. *v.* Robbins, 148 U. S. 267, 1893; Supreme Court Rule 37.

[451] Judicial Code, Section 240.

[452] The Three Friends, 166 U. S. 1, 1897.

[453] Forsyth *v.* Hammond, 166 U. S. 514, 1897.

[454] Draper *v.* Am. Loom Co., 169

§ 657*b*. When, in a suit on several patents the complainant succeeds on some and is defeated as to others, costs are in the discretion of the court and are awarded according to the circumstances of the particular case. Likewise when the bill charges infringement by a number of devices and only one is proven to infringe.[455] When an injunction is denied only because the patent has expired *pendente lite* the plaintiff is also entitled to costs.[456]

F. R. 298, 1909; Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

[455] Perkins Electric Switch Mfg. Co. *v.* Yost Electric Mfg. Co., 189 F. R. 625, 1911.

[456] American Caramel Co. *v.* White, 234 F. R. 328, 1916.

CHAPTER XXI

INJUNCTIONS

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709. Improper defences to motions for attachments.
710. Penalties for violations of injunctions.

§ 658. JURISDICTION to grant injunctions to prevent the violation of patent rights, is conferred by statute upon the same courts that are vested with common-law jurisdiction in patent cases.[1] The statute provides that the jurisdiction shall be exercised according to the course and principles of courts of equity, and upon such terms as the court may deem reasonable. This twofold provision indicates the sources from which the existing rules ap-

[1] Revised Statutes, Section 4921.

plicable to such cases were drawn. They were drawn from the ordinary course and principles of courts of equity, and from a reasonable contemplation of the peculiar circumstances which attend patent rights and patent litigation. Some of those rules relate only to preliminary injunctions, and others relate to permanent injunctions alone; and the residue are equally applicable to both. It is the plan of this chapter to explain those three classes of rules, and to show how all of them combined make up a system which may guide the judicial discretion in nearly every variety of circumstances.

§ 658*a*. Whether or not an injunction that merely enjoins the defendant, for instance, from "making, using or selling devices embodying the constructions set forth, and claimed in the patent in suit" was ever sufficient in form, it probably ceased to be so on October 15, 1914, when the so-called Clayton law went into effect.[2] By Section 19 of that Act it is provided that:

"That every order of injunction or restraining order shall set forth the reasons for the issuance of the same, shall be specific in terms, and shall describe in reasonable detail, and not by reference to the bill of complaint or other document, the act or acts sought to be restrained, and shall be binding only upon the parties to the suit, their officers, agents, servants, employees and attorneys, or those in active concert or participating with them, and who shall, by personal service, or otherwise, have received actual notice of the same."

§ 659. A preliminary injunction is one which is granted after the filing of the bill, and before the case is ready to be decided in respect of its prayer for a permanent injunction,

[2] Federal Anti-Trust Act in effect October 15, 1914, Chap. 323, Section 19, 38 Statutes, page 730. See Lion Tractor Co. *v.* Bull Tractor Co., 231 F. R. 156, 1916.

or in respect of its prayer for profits or for damages. Where a preliminary injunction is granted, it is usually applied for before the filing of the answer; but it is often issued after that stage of the case; and sometimes even after the complainant has introduced all his *prima facie* evidence,[3] and even after all the evidence has been taken, and an interlocutory hearing has been had upon the record of that evidence.[4]

Such an injunction may be dissolved at any time; and a motion to dissolve it may be made whenever an apparent cause for its dissolution becomes known to the party enjoined. If not sooner terminated by dissolution, or by a certain statutory limitation hereafter explained, such an injunction continues till the interlocutory decree; and then it is dissolved or is made permanent, according to the equities of the case as they appear at that time.

§ 660. As the practice was prior to the promulgation of the Equity Rules now in force, it was required that a bill of complaint, in order to lay the foundation for a preliminary injunction, should state the prior adjudication or acquiescence upon which the presumption of validity of the patent is based.[5] It is surmised, however, that since the promulgation of the present Equity Rules whereby a bill of complaint becomes merely a statement of ultimate facts to be proved and charges of evidence are eliminated therefrom, that it would not only not be required that a bill of complaint set forth such adjudication or acquiescence but that such allegations in a bill of complaint would be improper and should appear only in the

[3] Union Paper-Bag Machine Co. *v.* Newell, 11 Blatch. 550, 1874.

[4] Cimiotti Unhairing Co. *v.* American Fur Refining Co., 117 F. R. 623, 1902.

[5] Parker *v.* Brant, 1 Fisher, 59, 1850; Wirt *v.* Hicks, 46 F. R. 71, 1891.

affidavits accompanying the motion. Such allegations are merely statements of evidence and pertinent only on a motion for preliminary injunction and even then only in so far as they indicate probable eventual success on the part of the plaintiff. They are not ultimate facts which form the basis of the plaintiff's case. While it is true that Equity Rule 25 requires that the bill shall include "a statement of" any special relief pending the suit, it is surmised that this would require a statement only of the ultimate facts which would entitle the plaintiff to relief *pendente lite*, as, for example, a statement of facts which would show that the plaintiff would be liable to irremediable injury if relief were not granted pending the suit. The bill must contain a specific prayer for an injunction pending the suit,[6] and must conform to those requisites of bills in equity which are set forth in the 20th chapter of this book.

§ 661. Due notice of a motion for a preliminary injunction must be served on the party sought to be enjoined from infringing a patent, before that motion will be heard by the court. This rule formerly had a sufficient foundation in a statute of 1793, which provided that no writ of injunction should be granted in any case without reasonable previous notice to the adverse party, or his attorney, of the time and place of moving for the same.[7] Portions of the section which contained that provision are embraced in the Revised Statutes,[8] but that provision was omitted from those statutes, and was thereby repealed.[9] But, by the Federal "Anti-Trust" Act of 1914, known as the Clayton Act,[9a] the requirement was re-

[6] Equity Rule 25.

[7] 1 Statutes at Large, Ch. 22, Section 5, p. 334.

[8] Revised Statutes, Sections 716 and 720.

[9] Revised Statutes, Section 5596.

[9a] Act of Oct. 15, 1914, Chap. 323, Section 17, 38 Stat. 730.

stored not only as to preliminary injunctions but as to restraining orders, unless it appear that immediate and irreparable damage will ensue if the restraining order is not granted immediately.

The Revised Statutes provide that the Supreme Court shall have power to prescribe from time to time, and in any manner not inconsistent with any law of the United States, the modes of proceeding to obtain relief in suits in equity in the Circuit and District Courts.[10] In pursuance of this authority, the Supreme Court has prescribed an elaborate code of rules of practice for the courts of equity of the United States. Rule 73 of that series provides that preliminary injunctions shall be grantable only upon due notice to the other party. And there is a similar provision as to restraining orders unless immediate and irreparable loss or damage would ensue before the matter could be heard on notice.[11] Formerly notice was required only in the case of "special" injunctions.[12] The requirements of the statute are therefore substantially the same as those of the Equity Rules.

§ 662. A motion for a preliminary injunction is heard on *ex parte* affidavits.[13] The complainant's affidavits in chief must show all the facts which are necessary to *prima facie* entitle him to such an injunction.[14] The defendant's affidavits must state all the facts upon which he bases his defence to the motion, and if those statements are by way of traverse, no further affidavits are admitted on the hearing; but if they are by way of confession and avoidance, the complainant is permitted to read affidavits in

[10] Revised Statutes, Section 917; Orr *v.* Littlefield, 1 Woodbury & Minot, 19, 1845.

[11] Equity Rule 73.

[12] Former Equity Rule 55.

[13] Grover & Baker Sewing Machine Co. *v.* Williams, 2 Fisher, 133, 1860.

[14] Union Paper-Bag Machine Co. *v.* Binney, 5 Fisher, 167, 1871.

reply, but to that reply no rejoinder from the defendant is ever allowed.[15]

The complainant's bill, if sworn to, may be used as an affidavit;[16] and so also may the defendant's answer, if it is on file when the motion for a preliminary injunction is heard.[17] But answers are commonly and properly drawn in such general terms, that they are of minor importance as defences to such motions, even where they are well concerted as pleadings. For example, where the answer says, on the question of infringement, that the defendant never made, used or sold any specimen of the patented thing and where the affidavits of the complainant contain a description of what the defendant has done, and contain proper expert testimony showing that those doings constitute infringement of the patent, the general denial of the answer will go for naught, on the hearing of a preliminary injunction.[18] The statements of the complainant's affidavits in chief are taken on the hearing to be true, so far as they are uncontradicted by the affidavits of the defendant;[19] and the affidavits of the defendant are taken to be true, so far as they are consistent with the complainant's affidavits in chief, and are not contradicted by his affidavits in reply.[20]

All affidavits to be used to support, or to oppose, a motion for a preliminary injunction ought to be served on the opposite counsel a reasonable time before the motion is argued. Where that is not done, the court may reject the affidavits, or, at its discretion, may allow them

[15] Day *v.* Car-Spring Co., 3 Blatch. 154, 1854; Rogers *v.* Abbot, 4 Washington, 514, 1825.

[16] Young *v.* Lippman, 9 Blatch. 277, 1872.

[17] Parker *v.* Brant, 1 Fisher, 58, 1850.

[18] Ely *v.* Mfg. Co., 4 Fisher, 64, 1860.

[19] Wells *v.* Gill, 6 Fisher, 89, 1872.

[20] Cooper *v.* Mattheys, 3 Penn. Law Journal Reports, 40, 1842.

to be read, giving the opposite party the option to proceed with the hearing, or to take time to examine the affidavits, and where they admit of reply, to take other affidavits for that purpose.[21]

§ 663. Where, on the hearing of a motion for a preliminary injunction, the complainant's moving papers are found to lack a necessary point which is presumably capable of being supplied, the court may suspend the motion to enable the complainant to supply it.[22] And the complainant may withdraw his motion at any time before it would otherwise be decided; even where the defendant objects to that withdrawal, and the complainant does not permanently relinquish his contention.[23]

If, when the recently repealed equity rules were in force, a demurrer was on file in the case when a motion for a preliminary injunction came on to be heard, the demurrer was first heard and disposed of, even though that proceeding necessitated a postponement of the hearing of the motion. But if the demurrer was overruled, the defendant in order to secure leave to contest the motion further was required to file an affidavit that the demurrer was not filed for the purpose of delay, and was required to give security to pay the complainant the amount of any money decree to which the delay consequent upon the demurrer might afterward be found to entitle him.[24] The equity rules enforced February 1, 1913, do not appear to have wrought any changes which will call for any different practice in the case of a motion to dismiss than as formerly existed in the case of a demurrer.

[21] Sterrick *v.* Pugsley, 1 Central Law Journal, 106, 1874.

[22] Hodge *v.* Railroad Co., 6 Blatch. 85, 1868.

[23] Sprague Electric Motor Co. *v.* Steel Motor Co., 105 F. R. 959, 1898.

[24] Woodworth *v.* Edwards, 3 Woodbury & Minot, 131, 1847.

§ 664. A temporary restraining order may be made by the court, where there appears to be danger of irreparable injury from delay, whenever notice is given of a motion for a preliminary injunction; and formerly such an order could be granted with or without security, in the discretion of the court, or judge.[25] Since the Clayton Act[26] went into effect, however, security must be required as a condition of granting either a restraining order or a temporary injunction. Where defendant denies infringement since the beginning of the suit, and states that he has abandoned infringement and will not further infringe, danger of irreparable injury is not shown.[27]

§ 665. In deciding whether a complainant at bar has made out a *prima facie* case for a preliminary injunction to restrain infringement of a patent, the judge is guided by the presence or absence of two presumptions and one certainty. Those presumptions relate to the validity of the patent and to the defendant's infringement thereof, and that certainty relates to the complainant's title thereto. If that certainty or either of those presumptions is absent in a given case, no preliminary injunction will be granted except in unusual circumstances;[28] but such a writ will be granted where they are all present, unless the defendant interposes some good defence to the motion, or unless the court takes a bond from the defendant, instead of subjecting him to an injunction. A preliminary injunction will not be granted when defendant is responsible, and a substantial doubt of infringement exists, or where the complainant's right is doubtful.[29]

[25] Revised Statutes, Section 718.

[26] Act October 15, 1914, Chap. 323, Sec. 18, 38 Statutes 730.

[27] Silver & Co. *v.* Eustis Mfg. Co., 130 F. R. 348.

[28] McMaster *v.* Daugherty Mfg. Co., 219 F. R. 219, 1914; Standard Typewriter Co. *v.* Standard F. T. S. Co., 181 F. R. 500.

[29] Hallock *v.* Babcock, 124 F. R. 226, 1903.

A special presumption that the patent is valid, lies at the foundation of a patentee's right to a preliminary injunction.[30] That presumption does not arise out of the unattended letters patent,[31] but will always exist where the patent has been suitably adjudicated in a Federal court, and there held to be valid; [32] or where the validity of the patent has been suitably acquiesced in by the public; [33] or where the defendant at bar has allowed a decree *pro confesso* to be taken against him; [34] or where the defendant does not deny the validity of the patent; [35]

[30] Edward Barr Co. *v.* Sprinkler Co., 32 F. R. 80, 1887.

[31] Foster *v.* Crossin, 23 F. R. 401, 1885; Dickerson *v.* Machine Co., 35 F. R. 145, 1888; Standard Elevator Co. *v.* Crane Elevator Co., 56 F. R. 719, 1893; Smith *v.* Meriden Britannia Co., 92 F. R. 1003, 1899; Planters' Compress Co. *v.* Moore & Sons' Co., 106 F. R. 500, 1901; Brunswick-Balke-Collender Co. *v.* Kochler & Hinrichs, 115 F. R. 649, 1902; but see Palmer *v.* Wilcox Mfg. Co., 141 F. R. 378, 1905, where, however, the prior art appears not to have been shown.

[32] Orr *v.* Littlefield, 1 Woodbury & Minot, 13, 1845; Edison Electric Light Co. *v.* Beacon Electrical Co., 54 F. R. 679, 1893; Thomson-Houston Electric Co. *v.* Ohio Brass Co., 78 F. R. 141, 1896; Societe Anonyme *v.* Allen, 84 F. R. 823, 1897; Adam *v.* Folger, 120 F. R. 261, 1903; Leeds & Catlin *v.* Victor Talking Machine Co., 213 U. S. 301, 1909.

Contra, where a weak defense was made in the prior suit, the defendant having little interest in the outcome, and the issue of validity was not seriously contested. Silver & Co. *v.* Eustis Mfg. Co., 130 F. R. 348, 1904; Diamond Match Co. *v.* Union Match Co., 129 F. R. 602, 1904.

[33] Goodyear *v.* Railroad Co., 1 Fisher, 626, 1853; American Middlings Purifier Co. *v.* Christian, 3 Bann. & Ard. 48, 1877; White *v.* Surdam, 41 F. R. 791, 1890; White *v.* Hunter, 47 F. R. 819, 1891; Sessions *v.* Gould, 49 F. R. 856, 1892; Palmer *v.* Mills, 57 F. R. 222, 1893; Corser *v.* Overall Co., 59 F. R. 781, 1893; Silver & Co. *v.* Eustis Mfg. Co., 130 F. R. 348, 1904; Crescent Specialty Co. *v.* National Fireworks Distributing Co. (stating the rule in the sixth circuit), 219 F. R. 130, 1915.

[34] Schneider *v.* Bassett, 13 F. R. 351, 1882.

[35] Sickles *v.* Mitchell, 3 Blatch. 548, 1857; New York Grape

or where he is estopped from doing so;[36] and that presumption will sometimes exist where the patent has successfully undergone an interference or other contested proceeding in the Patent Office.[37]

§ 666. An adjudication in another case, in order to furnish a suitable foundation for a right to a preliminary injunction, must have resulted in favor of the patent in a regular hearing in equity, or on the trial of an action at law.[38] Of these, the former raises the stronger presumption,[39] but most of the considerations which apply to it, apply also to the latter. An interlocutory decree in another case is as good a foundation for a right to an injunction as a final decree would be;[40] because an interlocutory decree settles all pending questions of validity, and a final decree merely reiterates its conclusions on that point. An adjudication of a prior suit based on the first term of a patent, may be made the foundation of a right to a preliminary injunction to restrain infringement of an extended term of the same patent.[41] But no adjudication of a suit based on an original patent, can be invoked as a basis for a preliminary injunction to restrain infringement of any new claim contained in a reissue thereof.[42] Though an injunction in favor of one claim of a patent is a basis for

Sugar Co. *v.* American Grape Sugar Co., 10 F. R. 835, 1882.

[36] Time Telegraph Co. *v.* Himmer, 19 F. R. 322, 1884.

[37] Pentlarge *v.* Beeston, 14 Blatch. 354, 1877; Smith *v.* Halkyard, 16 F. R. 414, 1883; Consolidated Apparatus Co. *v.* Brewing Co., 28 F. R. 428, 1886; Minneapolis Harvester Works *v.* Machine Co., 28 F. R. 565, 1886; Dickerson *v.* Machine Co., 35 F. R. 147, 1888.

[38] Doughty *v.* West, 2 Fisher, 559, 1865.

[39] Goodyear *v.* Mullee, 3 Fisher, 420, 1868; Panoulias *v.* Hawley, 178 F. R. 101, 1910.

[40] Potter *v.* Fuller, 2 Fisher, 251, 1862.

[41] Clum *v.* Brewer, 2 Curtis, 507, 1855; Tilghman *v.* Mitchell, 4 Fisher, 615, 1871.

[42] Poppenhusen *v.* Falke, 2 Fisher, 181, 1861.

a preliminary injunction on another claim, specifying the same invention in narrower terms.[43]

Where the prior adjudication was that of the Supreme Court or of a Circuit Court of Appeals, it is conclusive of the questions it covered; [44] and where the prior adjudication was that of a Circuit or District Court, it will be followed, unless it is inconsistent with some other decision of equal or higher rank; [45] and a verdict of a jury, which is supplemented by a refusal to grant a new trial, and by the entry of a judgment thereon, has the same weight as an adjudication in equity.[46] But a prior adjudication of a court of some foreign nation or dominion, is not controlling, though it is entitled to fair consideration as embodying the opinion of a judicial tribunal.[47] And where the prior adjudication was based upon an estoppel,[48] or upon some other ground than recognized validity of the patent,[49] or upon consent,[50] it does not constitute any ground for a preliminary injunction against another defendant.

It is the established practice in the second circuit to refuse a preliminary injunction in the absence of proof of prior adjudication or public acquiescence when there

[43] Sawyer Spindle Co. *v.* Taylor, 56 F. R. 110, 1893.

[44] American Bell Telephone Co. *v.* McKeesport Tel. Co., 57 F. R. 661, 1893; Edison Electric Light Co. *v.* Philadelphia Trust Co., 60 F. R. 397, 1894; Interurban Ry. & Terminal Co. *v.* Westinghouse Electric & Mfg. Co., 186 F. R. 166, 1911.

[45] Pullman Palace Car Co. *v.* Wagner Palace Car Co., 44 F. R. 765, 1891; Wilgus *v.* Van Sickle, 99 F. R. 443, 1900.

[46] Woodard *v.* Gas-Stove Co., 68 F. R. 717, 1895.

[47] Carter *v.* Wollschlaeger, 53 F. R. 575, 1892.

[48] Ney Mfg. Co. *v.* Drill Co., 56 F. R. 153, 1893.

[49] Empire State Nail Co. *v.* Button Co., 61 F. R. 650, 1894.

[50] New York Button Works *v.* Crescent Button Co., 185 F. R. 820, 1910.

See Section 672.

is any fair question as to invention, anticipation, construction, infringement,[51] or title.[52] But the fact that no prior adjudication or public acquiescence is shown is not ground for refusing the injunction where there is no substantial question as to validity.[53] The rules governing the granting of preliminary injunctions in the sixth circuit are set forth in the case of City of Grand Rapids *v.* Warren Bros. Co.[54]

§ 667. Public acquiescence sufficient to create a presumption of validity, and therefore sufficient to furnish a foundation for a right to a preliminary injunction, may arise out of either of two classes of facts. It may arise where the patentees made and sold specimens of the patented article for many years, during which no other person assumed to make any such specimens; [55] or it may arise where the patentee long licensed others to make, use, or sell such specimens, while nobody assumed to do either without such a license from him; and the acquiescence is quite as positive in this case as in the other.[56] But acquiescence in exclusive use of a thing which contains several patented inventions, does not raise a special presumption

[51] Newhall *v.* McCabe Hanger Mfg. Co., 125 F. R. 919, 1903; Standard Plunger Elevator Co. *v.* Stokes, 196 F. R. 47, 1912.

[52] Armat Moving Picture Co. *v.* Edison Mfg. Co., 125 F. R. 939, 1903; Alphons Custodie, etc., Co. *v.* Heinicke, 135 F. R. 552, 1904.

[53] Hall Signal Co. *v.* General Ry. Signal Co., 153 F. R. 907, 1907; Lambert Snyder Vibrator Co. *v.* Marvel Vibrator Co., 138 F. R. 82, 1905; Boyce *v.* Stewart-Warner Speedometer Corporation, 220 F. R. 118, 1914.

[54] City of Grand Rapids *v.* Warren Bros. Co., 196 F. R. 892, 1912.

[55] Sargent *v.* Seagrave, 2 Curtis, 557, 1855; Covert *v.* Curtis, 25 F. R. 43, 1885; National Typographic Co. *v.* New York Typograph Co., 46 F. R. 116, 1891; Blount *v.* Societe, 53 F. R. 102, 1892; Crescent Specialty Co. *v.* National Fireworks Distributing Co., 219 F. R. 130, 1915.

[56] Thomson Electric Welding Co. *v.* Two Rivers Mfg. Co., 63 F. R. 121, 1894.

of validity in favor of any particular one of the patents involved; [57] and when acquiescence stops for good reasons, the special presumption of validity which rested upon it comes also to an end; [58] and mere manufacture and sale of a patented article does not constitute acquiescence in the patent which claims it.[59]

§ 668. The length of time necessary to make exclusive possession, of the first sort, available on a motion for a preliminary injunction, depends upon the nature of the invention, and on the extent to which a good invention of the sort would naturally be used if it were free to the public; and upon the popularity of that particular invention with that part of the public likely to want an article of that kind.[60] Where nobody but the patentee had any use for the article during the time of the alleged acquiescence, or where its merits were prized so low that nobody else cared to adopt it; no lapse of time has any tendency to raise a presumption that the patent is valid.[61] Acquiescence in claims which nobody cared to dispute when the acquiescence occurred, has no tendency to show that those claims are valid.[62]

But where all persons, other than the owner of the patent, refrain from making, using, or selling specimens of the patented article merely because it is patented, and notwithstanding it would otherwise be for their interest to adopt it, their acquiescence shows their conviction that

[57] Upton *v.* Wayland, 36 F. R. 691, 1888; Geo. Ertel Co. *v.* Stahl, 65 F. R. 521, 1895; Welsbach Light Co. *v.* Benedict & Burnham Mfg. Co., 82 F. R. 748, 1897.

[58] Wollensak *v.* Sargent, 33 F. R. 843, 1888.

[59] Geo. Ertel Co. *v.* Stahl, 65 F. R. 521, 1895.

[60] Doughty *v.* West, 2 Fisher, 559, 1865.

[61] Raymond *v.* Woven Hose Co., 39 F. R. 366, 1889; Consolidated Fastener Co. *v.* American Fastener Co., 94 F. R. 523, 1899.

[62] Geo. Ertel Co. *v.* Stahl, 65 F. R. 521, 1895.

the patent is valid;[63] a conviction presumably based on inquiry, because persons are not likely to acquiesce in adverse rights without any investigation of their soundness.[64] In a case of the latter sort, any acquiescence which is shown by lapse of time to be general and to be genuine, will be sufficient to sustain a preliminary injunction.[65] Two years have been found to be ample in a case where the patentee made and sold 105,000 specimens of his patented apple-paring machine during that time,[66] and in another case, eight years, in which the patentee made and sold 150 specimens of his patented machine for cutting leather for shoe soles, were held to be sufficient.[67]

§ 669. The length of time necessary to make exclusive possession, of the second sort, available on a motion for a preliminary injunction will depend largely upon whether the licenses granted, were granted in consideration of the payment of substantial royalties, or for such an insignificant price as indicates that they were issued for the sole purpose of raising a presumption of public acquiescence. In the former case, it is safe to assume that sales of licenses will be quite as rapidly efficacious in the desired direction as sales of specimens of the patented invention;[68] while in the latter case, a long and genuine payment of royalties will be necessary to give the licenses any importance in respect of preliminary injunctions against third parties.

[63] National Typographic Co. *v.* New York Typograph Co., 46 F. R. 116, 1891; Keasbey & Mattison Co. *v.* Philip Carey Mfg. Co., 110 F. R. 747, 1901.

[64] Grover & Baker Sewing Mach. Co. *v.* Williams, 2 Fisher, 134, 1860.

[65] Orr *v.* Littlefield, 1 Woodbury & Minot, 17, 1845.

[66] Sargent *v.* Seagrave, 2 Curtis, 557, 1855.

[67] Foster *v.* Moore, 1 Curtis, 279, 1852.

[68] Grover & Baker Sewing Mach. Co. *v.* Williams, 2 Fisher, 138, 1860.

§ 670. Public acquiescence is strengthened rather than weakened, as a foundation to a right to a preliminary injunction, by the fact that some persons for a while refused to join in it, but on receiving further information, submitted to the exclusive right claimed by the patentee. Such a submission is generally the most persuasive degree of acquiescence,[69] and is certainly so where the submission was costly to him who submitted.[70] Nor is universal acquiescence necessary to be shown as existing at the time of the motion; for if it were necessary and were shown, it would prove that the defendant himself is not infringing the patent, and thus negative that part of the foundation of the case.[71]

But a preliminary injunction will not be granted on any basis of acquiescence, where the defendant has been long in possession and use of the invention, adverse to the claim of the complainant, and under a claim and color of right.[72] In fact it may be stated as a general proposition that, although validity and infringement be proven, the court will consider the relative benefits to the parties, and when the injury likely to be inflicted on the defendant is pronouncedly greater than the benefits to be derived by the plaintiff by the issuance of the injunction, the injunction will be denied.[73] No acquiescence in an original patent can be made the basis of a right to a preliminary injunction to restrain infringement of any claim in a reissue of that patent, unless that claim was also contained

[69] Sargent *v.* Seagrave, 2 Curtis, 556, 1855; Carter *v.* Wollschlaeger, 53 F. R. 576, 1892.

[70] Corbin Lock Co. *v.* Yale & Towne Mfg. Co., 58 F. R. 565, 1893.

[71] McComb *v.* Ernest, 1 Woods, 206, 1871; McDowell *v.* Kurtz, 77 F. R. 208, 1896.

[72] Isaacs *v.* Cooper, 4 Washington, 259, 1821.

[73] Kryptok Co. *v.* Stead Lens Co., 190 F. R. 767, 1911; City of Grand Rapids *v.* Warren Bros. Co., 196 F. R. 892, 1912.

in the original.[74] But where some applicable acquiescence is proved, it would be strengthened, as a foundation for a preliminary injunction, by the fact that it has been tried as such a foundation in another case, by basing a preliminary injunction upon it.[75]

§ 671. A decree *pro confesso* entered in a case, raises a sufficient presumption of the validity of the patent to support a right to a preliminary injunction in that case;[76] but there is no ground for giving such a decree such an operation in any case against another defendant.[77]

§ 672. A consent decree is one which is entered by the consent of both parties, when the defendant is not in default, and before the judge has decided the case on its merits. A consent decree in a patent case can never be a proper foundation for a right to a preliminary injunction against third persons; unless it appears from the nature of the patented thing, or from convincing evidence, that the defendant consented to the decree because his defence had become hopeless, and not because it had become inexpedient regardless of its strength. This can seldom or never be shown, because the motive of the consenting defendant can seldom or never be known. Consent decrees are therefore useless on motions for preliminary injunctions, against anyone other than the consenting defendant, or someone in privity with him.[78]

[74] Grover & Baker Sewing Mach. Co. *v.* Williams, 2 Fisher, 144, 1860.

[75] Blount *v.* Societe, 53 F. R. 102, 1893; Carter *v.* Wollschlaeger, 53 F. R. 575, 1892; Carter-Crume Co. *v.* Ashley, 68 F. R. 379, 1895.

[76] Schneider *v.* Bassett, 13 F. R. 351, 1882.

[77] Everett *v.* Thatcher, 3 Bann. & Ard. 437, 1878; American Electrical Novelty Co. *v.* Newgold, 99 F. R. 567, 1900.

[78] Spring *v.* Domestic Sewing Machine Co., 4 Bann. & Ard. 427, 1879; Hayes *v.* Leton, 5 F. R. 521, 1881; De Ver Warner *v.* Bassett, 7 F. R. 468, 1881; Keyes *v.* Refining Co., 31 F. R. 561, 1887; Wollensak *v.* Sargent, 33 F. R.

§ 673. Where a defendant admits or does not deny in his pleadings, the validity of the patent upon which a preliminary injunction is sought against him, there seems to be no reason why such an admission or lack of denial should not raise a sufficient presumption of that validity to furnish a foundation to a right to a preliminary injunction in that case.[79] As between the parties to a motion, the court may properly assume every statement of fact to be true which is made by the complainant, and expressly or tacitly admitted by the defendant. And where the validity of a patent is disputed on no ground, except one which is susceptible of an immediate and correct decision, such a decision may be made on a motion for a preliminary injunction, and may result in the granting of the injunction, if the decision is favorable to the patent.[80]

§ 674. An interference decision of the Patent Office raises a sufficient presumption of validity to furnish a foundation for a preliminary injunction, where the defendant is the person, or the legal representative or assignee of the person who was defeated in the interference, and where he denies the validity of the patent on no other ground than that the decision of the Patent Office on the question of priority in the interference was wrong.[81] But such an interference decision cannot be invoked against

843, 1888; Tibbe Mfg. Co. *v.* Heineken, 37 F. R. 686, 1889; Bowers Dredging Co. *v.* New York Dredging Co., 77 F. R. 984, 1896; Western Electric Co. *v.* Williams-Abbott Electric Co., 83 F. R. 842, 1897; Earll *v.* Rochester S. & E. R. Co., 157 F. R. 241, 1907.

See Section 666.

[79] New York Grape Sugar Co. *v.* American Grape Sugar Co., 10 F. R. 835, 1882; Lane *v.* Levi, 104 O. G. 1899, 1903.

[80] Foster *v.* Crossin, 23 F. R. 400, 1885.

[81] Pentlarge *v.* Beeston, 14 Blatch. 354, 1877; Holliday *v.* Pickhardt, 12 F. R. 147, 1882; Perfection Cooler Co. *v.* Rose Mfg. Co., 175 F. R. 120, 1909.

third parties, because it does not rise to the dignity and force of an adjudication of a court,[82] unless the question of priority as between the two patents at issue in the interference is the only question at issue in the suit.[83] However, a decision of the Court of Appeals of the District of Columbia on an appeal from a decision of the Commissioner of Patents in an interference establishes a primary case of validity on a motion for a preliminary injunction even as against third parties.[84] But an interference decision cannot be invoked as against any defence not involved in it, because it has no relevancy to any such defence.[85] And where the defeated party in the interference, contended in the Patent Office that the patent should not issue to the other party, because the invention was in public use or on sale in this country, more than two years before that party filed his application, the decision of the Patent Office to the contrary, does not raise a sufficient presumption of validity to furnish a foundation for a preliminary injunction against anyone.[86]

§ 675. The complainant's title to the patent upon which a preliminary injunction is asked must be clear, or the injunction will be refused.[87] The best evidence of that title is found in the patent, if the complainant is the pat-

[82] Edward Barr Co. *v.* Sprinkler Co., 32 F. R. 80, 1887; Western Electric Co. *v.* Williams-Abbott Electric Co., 83 F. R. 842, 1897; Wilson *v.* Consolidated Store Service Co., 88 F. R. 288, 1898; Westinghouse Elec., etc., Co. *v.* Roberts, 125 F. R. 6, 1903; Hildreth *v.* Curtis & Son Co., 157 F. R. 394, 1907.

[83] Laas *v.* Scott, 145 F. R. 195, 1906; Automatic Racking Mach. Co. *v.* White Racker Co., 145 F. R. 643, 1906.

[84] Scott *v.* Laas, 150 F. R. 764, 1907.

[85] Greenwood *v.* Bracher, 1 F. R. 856, 1880.

[86] Empire State Nail Co. *v.* American Button Co., 61 F. R. 650, 1894.

[87] Mowry *v.* Railroad Co., 5 Fisher, 587, 1872.

entee; but if he is an assignee or grantee of the patentee, he must produce and prove the original assignments or grants which constitute his title, or otherwise prove his ownership.[88] Where the complainant's title papers require judicial construction, in order to determine their legal effect, it is the duty of the court to give them that construction upon a motion for a preliminary injunction, rather than to postpone the question to a final hearing, unless it is made to appear that evidence *aliunde* is necessary to their proper interpretation.[89]

§ 676. Infringement or danger of infringement by the defendant must be clearly proved by a complainant, in order to entitle him to a preliminary injunction.[90] Danger of infringement can be proved by evidence that the defendant has advertised infringing articles for sale;[91] and also by evidence that he has in his possession, articles the use of which would infringe the patent on which the suit is based. The first of these items of evidence is conclusive; but the second can be counteracted by proof that there is no intention and no prospect of using or selling the articles in this country, at any time during the life of the patent.

[88] Section 495 of this book.

[89] Clum *v.* Brewer, 2 Curtis, 507, 1855; Dodge *v.* Card, 2 Fisher, 116, 1860.

[90] Pullman *v.* Railroad Co., 5 F. R. 72, 1880; California Electrical Works *v.* Kenzel, 48 F. R. 377, 1891; Standard Elevator Co. *v.* Crane Elevator Co., 56 F. R. 719, 1893; Brush Electric Co. *v.* Storage Battery Co., 64 F. R. 776, 1894; Gec. Ertel Co. *v.* Stahl, 65 F. R. 518, 1895; Western Telephone Construction Co. *v.* Stromberg, 66 F. R. 551, 1895; Bowers Dredging Co. *v.* New York Dredging Co., 80 F. R. 120, 1897; Hatch Storage Battery Co. *v.* Electric Storage Battery Co., 100 F. R. 976, 1900; Chester Forging Co. *v.* Tindal-Morris Co., 165 F. R. 899, 1908.

[91] California Electrical Works *v.* Henzel, 48 F. R. 377, 1891; New York Belting Co. *v.* Gutta Percha Mfg. Co., 56 F. R. 264, 1892; Sessions *v.* Gould, 49 F. R. 856, 1892; Thomson-Houston Electric Co. *v.* Ohio Brass Co., 78 F. R. 139, 1896.

And danger of infringement is not proved by evidence that the defendant made, used or sold specimens of the subject of the patent, before the patent was granted.[92] A single sale made under circumstances which indicate a readiness to make other similar sales upon application is sufficient to make out a *prima facie* case of intent which will justify the issuance of an injunction.[93]

It must also appear that irreparable injury to the complainant will result from infringement if it be continued during the pendency of the suit, and the fact that the defendant is a mere user tends strongly to negative such a possibility.[94]

Proof of infringement cannot be made by affidavits which merely state that conclusion of fact. The complainant must prove the specific character of the defendant's doings.[95] Upon that evidence the court will examine and decide the question of infringement in the light of whatever expert testimony the case may contain,[96] and in the light of whatever construction of the patent it finds on examination to be just;[97] and that construction will generally be guided and governed by the construction which was given to the patent in the adjudicated case upon which the special presumption of validity is based,[98] and where the facts are substantially the same in the two cases, the former decision will be followed.[99] But where

[92] Brill *v.* St. Louis Car Co., 80 F. R. 910, 1897.

[93] Hutter *v.* DeQ. Bottle Stopper Co., 128 F. R. 283, 1904.

[94] Jefferson Electric Light, etc., Co. *v.* Westinghouse Electric, etc., Co., 134 F. R. 392, 1905.

[95] Kirby Bung Mfg. Co. *v.* White, 1 McCrary, 160, 1880.

[96] Blanchard *v.* Reeves, 1 Fisher, 105, 1850.

[97] Many *v.* Sizer, 1 Fisher, 33, 1849; Clum *v.* Brewer, 2 Curtis, 507, 1855; Coburn *v.* Clark, 15 F. R. 807, 1883.

[98] Mallory Mfg. Co. *v.* Hickok, 20 F. R. 116, 1884; Carter-Crume Co. *v.* Ashley, 68 F. R. 379, 1895.

[99] S. S. White Dental Mfg.

the question of infringement depends on a new and enlarged construction of the patent, a preliminary injunction will be denied.[100] And if the court is unable to arrive at a conclusion without the aid of further evidence, it will decline to grant the injunction till that evidence is supplied; [101] though it may require the defendant to give bonds and to keep an account of his doings which are alleged to infringe; [102] and the court will not grant a preliminary injunction where the question whether the defendant's doings constitute an infringement of the complainant's patent is a doubtful question.[103]

In order to entitle the complainant to a preliminary injunction, it is not necessary for him to prove that the defendant's infringement has not ceased before the motion is heard.[104] Indeed, no injunction can usually be averted

Co. *v.* Johnson, 56 F. R. 263, 1893.

[100] Thomson-Houston Electric Co. *v.* Exeter Ry. Co., 110 F. R. 987, 1901.

[101] United States Annunciator Co. *v.* Sanderson, 3 Blatch. 186, 1854; Howe *v.* Morton, 1 Fisher, 600, 1860; Boyd *v.* McAlpin, 3 McLean, 430, 1844; Carey *v.* Miller, 34 F. R. 392, 1888; Menasha Wood Split Pulley Co. *v.* Dodge, 85 F. R. 976, 1897.

[102] Macbeth *v.* Lippencott Glass Co., 54 F. R. 167, 1893.

[103] Jenkins *v.* Ruberg, 39 F. R. 611, 1889; Russell *v.* Hyde, 39 F. R. 614, 1889; Boston Electric Co. *v.* Holtzer, 41 F. R. 390, 1890; Judson L. Thomson Mfg. Co. *v.* Hatheway, 41 F. R. 520, 1890; Celluloid Mfg. Co. *v.* Eastman Dry Plate Co., 42 F. R. 159, 1890; Hammond Buckle Co. *v.* Goodyear Rubber Co., 49 F. R. 274, 1892; Williams *v.* McNeely, 56 F. R. 265, 1893; Brush Electric Co. *v.* Storage Battery Co., 64 F. R. 775, 1894; New York Air-Brake Co. *v.* Westinghouse Air-Brake Co., 69 F. R. 715, 1895; Bowers Dredging Co. *v.* New York Dredging Co., 77 F. R. 984, 1896; American Pneumatic Tool Co. *v.* Bigelow Co., 77 F. R. 991, 1897; National Folding-Box & Paper Co. *v.* Brown & Bailey Co., 98 F. R. 437, 1899; American Sulphite Pulp Co. *v.* Burgess Sulphite Fibre Co., 103 F. R. 981, 1900; Westinghouse Electric & Mfg. Co. *v.* American Transformer Co., 121 F. R. 560, 1903.

[104] Jenkins *v.* Greenwald, 2

by affirmative evidence that the defendant has ceased to infringe, even though coupled with a promise that he will infringe no more.[105] Where the doings of the defendant consisted in selling an article alleged to infringe the complainant's patent, it is immaterial to the motion for a preliminary injunction, whether the sale was made to some stranger, or was made to some agent of the complainant, who bought for the particular purpose of getting evidence of infringement.[106]

Where an infringing act was done before the bill was filed, and a preliminary injunction was granted on account thereof; successive preliminary injunctions may be obtained on successive motions therefor, to suppress successive subsequent acts which also infringe, though those subsequent acts differed from what was done before the bill was filed. But where no act was done or was threatened before the bill was filed, which appears to the court to be an infringement of the patent on which the bill was based, no injunction will be granted on that bill, to suppress any doings begun after the beginning of the suit.[107]

§ 677. The defences which a defendant may make to a motion for a preliminary injunction may be by way of traverse, or by way of confession and avoidance. A defence of the former sort consists in denying, and attempting to disprove, one or more of the facts which constitute

Fisher, 37, 1857; Potter *v.* Crowell, 3 Fisher, 112, 1866; Goodyear *v.* Berry, 3 Fisher, 439, 1868.

[105] Rumford Chemical Works *v.* Vice, 14 Blatch. 179, 1877; Celluloid Mfg. Co. *v.* Mfg. Co., 34 F. R. 324, 1888; Gilmore *v.* Anderson, 38 F. R. 847, 1889; White *v.* Walbridge, 46 F. R. 526, 1891; New York Filter Mfg. Co. *v.* Chemical Bldg. Co., 93 F. R. 827, 1899.

But see Section 701.

[106] Chicago Pneumatic Tool Co. *v.* Philadelphia Pneumatic Tool Co., 118 F. R. 852, 1902.

[107] Westinghouse Air-Brake Co. *v.* Christensen Engineering Co., 121 F. R. 558, 1903.

the complainant's *prima facie* case. A denial alone is useless, even where it is embodied in an answer.[108] Where the denial is supported by affidavits which contradict those of the complainant, the judge will refuse the injunction if he believes the defendant's affidavits to be the true ones, or if he is unable to decide which set of deponents tell the truth.[109] No remedy invoked in patent cases is so summary in operation, or so dangerous to justice as a preliminary injunction, and the courts will not apply that remedy to cases where the complainant's *prima facie* evidence of a right thereto, is overthrown or seriously damaged by the evidence of the defendant.[110]

§ 678. Defences by way of confession and avoidance to motions for preliminary injunctions, may confess and avoid the adjudication or acquiescence upon which the plaintiff bases the presumption of the validity of his patent; or may interpose any one of several facts entirely outside of the complainant's *prima facie* case.

§ 679. The effect of an adjudication may be averted by evidence of some good defence to the patent, together with evidence showing that defence not to have been interposed in the prior adjudicated case.[111] Several of

[108] Clum *v.* Brewer, 2 Curtis, 507, 1855.

[109] Cooper *v.* Mattheys, 3 Penn. Law Journal Reports, 40, 1842.

[110] Welsbach Light Co. *v.* Cosmopolitan Gaslight Co., 100 F. R. 650, 1900.

[111] Parker *v.* Brant, 1 Fisher, 58, 1850; Union Paper-Bag Machine Co. *v.* Binney, 5 Fisher, 168, 1871; American Nicolson Pavement Co. *v.* Elizabeth, 4 Fisher, 189, 1870; Bailey Wringing Machine Co. *v.* Adams, 3 Bann. & Ard. 97, 1877; Goodyear *v.* Allyn, 6 Blatch. 35, 1868; Robinson *v.* Randolph, 4 Bann. & Ard. 163, 1879; Page *v.* Telegraph Co., 18 Blatch. 125, 1880; Ladd *v.* Cameron, 25 F. R. 37, 1885; Fraim *v.* Iron Co., 27 F. R. 457, 1886; National Machine Co. *v.* Hedden, 29 F. R. 149, 1886; Glaenzer *v.* Wiederer, 33 F. R. 583, 1887; Holmes Protective Co. *v.* Alarm Co., 31 F. R. 562, 1887; Travers *v.* Spreader Co., 35 F. R. 133, 1888; Stuart *v.* Thorman, 37 F. R. 90, 1888;

the lower courts and Circuit Courts of Appeals have held that such a new defence must be established beyond a reasonable doubt;[112] and a new defence, which cannot endure the application of what was decided in the adjudicated case, must fail to avert a preliminary injunction.[113] But the effect of a prior adjudication may sometimes be averted by showing that it is inconsistent with a former decision of the court wherein the adjudged case is invoked,[114] or by showing that the adjudged case has been again taken under advisement in pursuance of a motion for a rehearing,[115] or has gone no further than a verdict of a jury which is still pending on a motion for a new trial,[116] or has been taken to a higher court for review,[117] or that a prior use not pleaded on the prior adjudication would have caused a contrary decision.[118]

Jacobson *v.* Alpi, 46 F. R. 767, 1891; Carter *v.* Fry, 54 F. R. 883, 1892; Bowers *v.* San Francisco Bridge Co., 69 F. R. 644, 1895; Societe Anonyme *v.* Allen, 84 F. R. 823, 1897; American Sulphite Co. *v.* Burgess Sulphite Fibre Co., 103 F. R. 981, 1900; Brunswick-Balke-Collender Co. *v.* Koehler & Hinrichs, 115 F. R. 648, 1902.

[112] Accumulator Co. *v.* Storage Co., 53 F. R. 800, 1893; Edison Electric Light Co. *v.* Beacon Electric Co., 54 F. R. 679, 1893; Edison Electric Light Co. *v.* Electric Mfg. Co., 57 F. R. 616, 1893; Electric Mfg. Co. *v.* Edison Electric Light Co., 61 F. R. 834, 1894; Philadelphia Trust Co. *v.* Edison Electric Light Co., 65 F. R. 553, 1895; Allington & Curtis Mfg. Co. *v.* Lynch, 71 F. R. 409, 1896; Tannage Patent Co. *v.* Adams, 77 F. R. 192, 1896; Campbell Printing-Press Co. *v.* Prieth, 77 F. R. 977, 1897; Bowers *v.* Pacific Coast Co., 81 F. R. 569, 1897.

[113] Sawyer Spindle Co. *v.* Taylor, 56 F. R. 110, 1892; Westinghouse Electric & Mfg. Co. *v.* Royal Weaving Co., 115 F. R. 735, 1902.

[114] Pullman Palace Car Co. *v.* Wagner Palace Car Co., 44 F. R. 765, 1891.

[115] American Graphophone Co. *v.* Leeds, 77 F. R. 193, 1896.

[116] Day *v.* Hartshorn, 3 Fisher, 34, 1855.

[117] Bowers Dredging Co. *v.* New York Dredging Co., 77 F. R. 984, 1896.

[118] Gamewell Fire Alarm Tele-

But courts will not always disregard adjudications which are thus suspended. They are a good foundation for preliminary injunctions, unless the defendant can convince the judge that they were wrong.[119] The effect of a prior adjudication can sometimes be averted by showing that there has been an adjudication against the validity of the patent,[120] but not where it appears that the lost cause was decided on a part only of the material evidence;[121] nor can such an effect be averted by showing that the validity of the patent is in question in some other case, which still awaits adjudication.[122] Where the patent sued upon is a reissue of the one adjudicated, a substantial doubt of the validity of the reissue as a reissue, must be solved against a motion for a preliminary injunction.[123]

§ 680. The effect of acquiescence, as a foundation for a preliminary injunction, may be averted by evidence that it was not general, or was not genuine: by proof that while some acquiesced in the patent, many others did not; or by proof that those who did acquiesce, did so collusively and not because they believed the patent to be invulnerable. And the effect of acquiescence may also be averted by evidence or arguments which clearly show that the patent is really invalid.[124]

graph Co. *v.* Hackensack Improvement Commission, 199 F. R. 182, 1912.

[119] Forbush *v.* Bradford, 1 Fisher, 317, 1858; Day *v.* Hartshorn, 3 Fisher, 32, 1855; Morris *v.* Mfg. Co., 3 Fisher, 70, 1866; Wells *v.* Gill, 6 Fisher, 89, 1872.

[120] Keyes *v.* Refining Co., 31 F. R. 560, 1887.

[121] United States Stamping Co. *v.* King, 4 Bann. & Ard. 469, 1879.

[122] Atlantic Giant Powder Co. *v.* Goodyear, 3 Bann. & Ard. 161, 1877; Allington & Curtis Mfg. Co. *v.* Lynch, 71 F. R. 411, 1896.

[123] Poppenhusen *v.* Falke, 2 Fisher, 181, 1861.

[124] Bradley & Hubbard Mfg. Co. *v.* The Charles Parker Co., 17 F. R. 240, 1883; Hat-Sweat Mfg. Co. *v.* Sewing Machine Co., 32 F. R. 403, 1887.

§ 681. The fact that the patent in suit will soon expire, is sometimes a reason for granting an injunction rather than a reason for refusing that remedy;[125] and sometimes a reason for refusing, rather than granting such a writ.[126] The fact that the patent sued upon has been repealed, or that it has expired by its own limitation, or because of the expiration of some foreign patent for the same invention, is of course a good defence to a motion for a preliminary injunction; as also is any fact which overthrows the title of the complainant; or any fact which shows the conduct of the complainant or his privies to be unjustifiable in the eye of equity.[127] And an injunction will be denied when the patent in suit expired before the decision of the motion, though it had not expired when the motion for the injunction was made.[128]

§ 682. A license is a good defence to a motion for a preliminary injunction; but where a license is disputed, it must be established by a preponderance of proof.[129] Where the question of license depends upon the construction of documents, the court will construe them on a motion for a preliminary injunction, unless it is made to appear that evidence exists, which is proper and necessary to be produced in order to enable the judge to arrive at the intention of the parties to an ambiguous instrument.[130] Where the license set up has been forfeited for non-payment of

[125] American Bell Telephone Co. *v.* Brown Tel. Co., 58 F. R. 409, 1893; Carter-Crume Co. *v.* Ashley, 68 F. R. 379, 1895; Woodard *v.* Gas Stove Co., 68 F. R. 717, 1895.

[126] Vermilya *v.* Erie Railroad Co., 89 F. R. 96, 1898.

[127] Western Union Telegraph Co. *v.* Telegraph Co., 25 F. R. 30, 1885.

[128] Huntington Dry Pulverizer Co. *v.* Virginia-Carolina Chemical Co., 121 F. R. 136, 1902.

[129] Armat Moving Picture Co. *v.* Edison Mfg. Co., 121 F. R. 559, 1902.

[130] Hodge *v.* Railroad Co., 6 Blatch. 165, 1868.

the royalty, a preliminary injunction will be granted, in an otherwise proper case, unless the defendant pays that royalty within some reasonable time to be fixed by the court;[131] and where it has been forfeited by a forbidden use of the patented thing, a preliminary injunction may be granted as to that use, but not as to the kind of use authorized by the license.[132] The principle of these precedents appears to be that a preliminary injunction will not be used to enforce a forfeiture, when the doings which caused the forfeiture can be otherwise compensated. So, also, a preliminary injunction will be refused where the defendant had a license which he forfeited by omission to pay the royalty, if that omission was necessitated by bad faith on the part of the complainant.[133]

§ 683. Estoppel is also a good defence to a motion for a preliminary injunction, and will prevail against a motion for that relief, upon the same facts that would make it prevail in an action at law.[134]

§ 684. Laches is a good defence to a motion for a preliminary injunction;[135] and delay works laches, unless it is excused by some fact which renders it reasonable.[136] The delay which, if unexcused, works laches in respect of an application for a preliminary injunction, is that

[131] Woodworth *v.* Weed, 1 Blatch. 165, 1846; Goodyear *v.* Rubber Co., 3 Blatch. 455, 1856.

[132] Wilson *v.* Sherman, 1 Blatch. 536, 1850.

[133] Crowell *v.* Parmeter, 3 Bann. & Ard. 480, 1878; Washburn & Moen Mfg. Co. *v.* Barbed Wire Fence Co., 22 F. R. 712, 1884; Washburn & Moen Mfg. Co. *v.* Scutt Co., 22 F. R. 710, 1884.

[134] Sections 467 to 469 of this book.

[135] Hockholzer *v.* Eager, 2 Sawyer, 363, 1873; Keyes *v.* Refining Co., 31 F. R. 560, 1887; Brush Electric Co. *v.* Storage Battery Co., 64 F. R. 777, 1894; Empire Cream Separator Co. *v.* Sears, Roebuck & Co., 157 F. R. 238, 1907.

[136] Wortendyke *v.* White, 2 Bann. & Ard. 26, 1875; Green *v.* French, 4 Bann. & Ard. 169, 1879; Collignon *v.* Hayes, 8 F. R. 912, 1881.

which occurs after the infringement sued upon was committed,[137] and not any delay which occurred before that time. Delay after the infringement may occur before the suit is brought, or it may occur after that event, and before any motion is made for a preliminary injunction.

Three months' delay of the first kind, for which there was no particular excuse, and which caused no injury to the defendant, has been held not to constitute laches; [138] and in another case the delay of one year was likewise condoned.[139] In another case, eighteen months', [140] and in another two years', [141] and in another three years', [142] and in another five years', [143] and in another six years', [144] delay after the known beginning of infringement, and before the beginning of a suit, was held to constitute such laches as must defeat a motion for a preliminary injunction; and in still another case a delay of two years by the then owners of the patent, was held to preclude their assignees from obtaining a preliminary injunction.[145] Two years' delay to sue was excused in one case on the ground that the complainant was much occupied with other business during the time, and that he repeatedly notified the defendant to cease his infringing; [146] and in another case a delay of twenty-eight months was excused on the ground that during most of that time the infringe-

[137] American Middlings Purifier Co. *v.* Christian, 3 Bann. & Ard. 50, 1877.

[138] Union Paper-Bag Machine Co. *v.* Binney, 5 Fisher, 167, 1871.

[139] Loring *v.* Booth, 52 F. R. 151, 1892.

[140] Hockholzer *v.* Eager, 2 Sawyer, 363, 1873.

[141] Sperry *v.* Ribbans, 3 Bann. & Ard. 261, 1878.

[142] Pope Mfg. Co. *v.* Johnson, 40 F. R. 584, 1889.

[143] Blakey *v.* Kurtz, 78 F. R. 368, 1897.

[144] Thomson-Houston Elec. Co. *v.* Wagner Elec. Co., 130 F. R. 902, 1904.

[145] Spring *v.* Machine Co., 4 Bann. & Ard. 428, 1879.

[146] Collignon *v.* Hayes, 8 F. R. 912, 1881.

ment was so small as to be harmless, and was likely to continue so;[147] but in another case four years' delay was held to be too long to be excused on that ground.[148] The pendency of a test case under a patent is also a good excuse for delay in bringing actions against other infringers, when those other infringers interpose the defence of laches to a motion for a preliminary injunction.[149]

Two months' unexcused delay after a suit is begun, before a motion for a preliminary injunction is made, is fatal to such a motion, where the delay seriously misleads the defendant;[150] and delay after a suit is begun will constitute such laches as will defeat an application for a preliminary injunction, if that delay continues till the defendant has closed his evidence for the interlocutory hearing of the case;[151] and still more strongly, when it continues till the case is about to be argued on the interlocutory hearing.[152]

§ 685. Where the complainant has made out a *prima facie* case for a preliminary injunction, and where the defendant has not overthrown that case, the court is generally bound to grant such an injunction,[153] upon all or upon

[147] Accumulator Co. *v.* Edison Illuminating Co., 63 F. R. 979, 1894.

[148] Brush Electric Co. *v.* Storage Battery Co., 64 F. R. 777, 1894.

[149] Van Hook *v.* Pendleton, 1 Blatch. 187, 1846; Rumford Chemical Works *v.* Vice, 14 Blatch. 181, 1877; Green *v.* French, 4 Bann. & Ard. 169, 1879; Colgate *v.* Gold & Stock Telegraph Co., 4 Bann. & Ard. 425, 1879; Edison Electric Light Co. *v.* Sawyer-Man Electric Co., 53 F. R. 597, 1892; Edison Electric Light Co. *v.* Mt. Morris Electric Light Co., 58 F. R. 572, 1893; New York Filter Mfg. Co. *v.* Loomis-Manning Filter Co., 91 F. R. 421, 1898.

[150] Ney Mfg. Co. *v.* Drill Co., 56 F. R. 154, 1893.

[151] Wooster *v.* Machine Co., 4 Bann. & Ard. 319, 1879.

[152] Andrews *v.* Spear, 3 Bann. & Ard. 80, 1877.

[153] Gibson *v.* Van Dresar, 1 Blatch. 535, 1850; Sickles *v.* Mitchell, 3 Blatch. 548, 1857; Sickles *v.* Tileston, 4 Blatch. 109,

part of the claims of the patent, according to the merits of the case.[154] The effect of the injunction upon others than the parties to the suit, cannot commonly be considered on such a motion; and while the judges fully appreciate the harsh and arbitrary character of a preliminary injunction in a patent case, they also know the innumerable obstacles which beset a recovery of damages or profits, and that there is generally no adequate remedy for infringement *pendente lite*, other than a preliminary injunction.[155]

But preliminary injunctions are not always made immediately operative. Where an equitable reason for so doing is presented to the court, such an injunction may sometimes be made to take effect a few days,[156] or even a few months[157] in the future; and sometimes at graduated future intervals upon distinct parts of the defendant's doings.[158]

So also, under some circumstances, the court can give the defendant the option to submit to such an injunction, or to give a bond to secure any decree for profits or damages which may ultimately be awarded against him; but

1857; Potter *v.* Fuller, 2 Fisher, 251, 1862; Conover *v.* Mers, 3 Fisher, 386, 1868; Ely *v.* Mfg. Co., 4 Fisher, 64, 1860; Rumford Chemical Works *v.* Vice, 14 Blatch. 181, 1877; American Middlings Purifier Co. *v.* Christian, 3 Banr. & Ard. 54, 1857; Green *v.* French, 4 Bann. & Ard. 169, 1879; New York Filter Mfg. Co. *v.* Niagara Falls Water Works Co., 77 F. R. 900, 1896; Allington & Curtis Mfg. Co. *v.* Booth, 78 F. R. 878, 1897; Pacific Steam Whaling Co. *v.* Alaska Packers' Ass'n, 100 F. R. 462, 1900.

[154] Colt *v.* Young, 2 Blatch. 471, 1852; Potter *v.* Holland, 1 Fisher, 382, 1858.

[155] Carter *v.* Wollschlaeger, 53 F. R. 576, 1892.

[156] Fuller *v.* Gilmore, 121 F. R. 129, 1902.

[157] American Sulphite Pulp Co. *v.* Burgess Sulphite Fibre Co., 103 F. R. 982, 1900.

[158] Westinghouse Air-Brake Co. *v.* Great Northern Ry. Co., 86 F. R. 132, 1898.

a bond can be required only in a case where an injunction must issue if the bond is not given.[159] The circumstances under which it is proper to give the defendant that option include the following:

§ 686. Bonds may be taken, instead of preliminary injunctions being imposed, if the complainant habitually avails himself of his exclusive right by receiving royalties for licenses, rather than by making and selling, or making and using the patented article himself, while permitting no other to do so;[160] but this course of business of the complainant is not otherwise a defence to a motion for a preliminary injunction.[161] And where the complainant is able and willing to supply the market for that article, the fact that the defendant is willing to take a license, and able to pay for one, does not entitle him to the option of giving bonds, if the complainant declines to give him a license.[162] The measure of the amount of the bond is the approximate amount of profits which the defendant will make from the time when the order is made to the termination of the cause.[163]

§ 687. So, also, a defendant may sometimes be entitled to the option of giving bonds instead of being enjoined,

[159] Forbush *v.* Bradford, 1 Fisher, 317, 1858; American Middlings Purifier Co. *v.* Atlantic Milling Co., 3 Bann. & Ard. 173, 1877.

[160] Howe *v.* Morton, 1 Fisher, 601, 1860; Hodge *v.* Railroad Co., 6 Blatch. 166, 1868; Dorsey Harvester Rake Co. *v.* Marsh, 6 Fisher, 387, 1873; Colgate *v.* Gold & Stock Telegraph Co., 16 Blatch. 503, 1879; Kirby Bung Mfg. Co. *v.* White, 1 McCrary, 155, 1880; New York Grape Sugar Co. *v.* American Grape Sugar Co., 10 F. R. 837, 1882; McMillan *v.* Conrad, 16 F. R. 128, 1883; Eastern Paper Bag Co. *v.* Nixon, 35 F. R. 752, 1888; Palmer *v.* Mills, 57 F. R. 222, 1893.

[161] Kennedy *v.* Penn. Iron & Coal Co., 67 F. R. 340, 1895.

[162] Baldwin *v.* Bernard, 5 Fisher, 447, 1872; Westinghouse Air-Brake Co. *v.* Carpenter, 32 F. R. 545, 1887.

[163] Karfiol *v.* Rothner, 151 F. R. 779, 1907.

where his infringing machinery contains costly parts which are not covered by the complainant's patent; [164] but he is not thus entitled in all such cases.[165] And a defendant may be entitled to that option where the infringing article was purchased in good faith, having been constructed in conformity to a junior patent;[166] or where it was so constructed by the defendant himself; or where the defendant is only a seller,[167] or only a user,[168] of specimens of the patented article, a suit being pending against the manufacturer from whom he received those specimens; or where the prior adjudication, upon which the right to a preliminary injunction is based, has been appealed to a higher court, and is still pending there; [169] or where new evidence is to be taken for the interlocutory hearing; [170] or where the patent in suit will soon expire; [171] or where the injunction, if granted, would be very damaging to the interests of the defendant, and not particularly beneficial to the legitimate rights of the complainant; [172] or where public

[164] Howe *v.* Morton, 1 Fisher, 587, 1860; Stainthorp *v.* Humiston, 2 Fisher, 311, 1862; Eagle Mfg. Co. *v.* Plow Co., 36 F. R. 907, 1888.

[165] Edison Electric Light Co. *v.* Sawyer-Man Electric Co., 53 F. R. 597, 1892.

[166] United States Annunciator Co. *v.* Sanderson, 3 Blatch. 184, 1854.

[167] Irwin *v.* McRoberts, 4 Bann. & Ard. 414, 1879.

[168] Westinghouse Air-Brake Co. *v.* Burton Stock-Car Co., 77 F. R. 301, 1896.

[169] Wells *v.* Gill, 6 Fisher, 93, 1872.

[170] Norton *v.* Automatic Can Co., 61 F. R. 296, 1894

[171] National Cash-Register Co. *v.* Navy Cash-Register Co., 99 F. R. 565, 1900.

[172] Morris *v.* Mfg. Co., 3 Fisher, 68, 1866; Morris *v.* Shelbourne, 4 Fisher, 377, 1871; Dorsey Harvester Rake Co. *v.* Marsh, 6 Fisher, 387, 1873; Kirby Bung Mfg. Co. *v.* White, 1 McCrary, 155, 1880; Hoe *v.* Boston Daily Advertiser, 14 F. R. 914, 1883; Consolidated Roller Mill Co. *v.* Richmond Mill Works, 40 F. R. 474, 1889; Edison Electric Light Co. *v.* Mt. Morris Electric Light Co., 58 F. R. 575, 1893; Duplex

policy forbids a discontinuance of the defendant's use of the patented invention; [173] or where the complainant does not himself employ the invention; [174] or where, for any reason, a preliminary injunction would operate unjustly.[175] It is no part of the legitimate office of a preliminary injunction to force the defendant to compromise a disputed claim,[176] not to compel him to give the complainant a contract to purchase specimens of the patented thing.[177]

But in the absence of every special reason for giving the defendant the option of giving bonds, instead of submitting to an injunction, that option cannot be demanded by him,[178] nor ought it to be granted by the court.[179] Where the defendant is entitled to the option of giving bonds or being enjoined, and chooses the former alternative, but is unable to furnish the bonds promptly, an injunction may issue against him, coupled with an order for its dissolution whenever the proper bonds are approved and filed.[180]

Printing-Press Co. *v.* Campbell Printing-Press Co., 69 F. R. 256, 1895; Huntington Dry-Pulverizer Co. *v.* Alpha Portland Cement Co., 91 F. R. 534, 1899; Aquarama Co. *v.* Old Mill Co., 124 F. R. 233, 1903.

[173] Guidet *v.* Palmer, 10 Blatch. 220, 1872.

[174] Hoe *v.* Knap, 27 F. R. 212, 1886.

[175] Union Paper Bag Machine Co. *v.* Binney, 5 Fisher, 169, 1871; National Cable Ry. Co. *v.* Sioux City Cable Ry. Co., 42 F. R. 685, 1890.

[176] Morris *v.* Mfg. Co., 3 Fisher, 70, 1866.

[177] American Nicolson Pavement Co. *v.* Elizabeth, 4 Fisher, 197, 1870.

[178] Consolidated Fruit-Jar Co. *v.* Whitney, 1 Bann. & Ard. 361, 1874.

[179] Gibson *v.* Van Dresar, 1 Blatch. 532, 1850; Tracy *v.* Torrey, 2 Blatch. 275, 1851; Tilghman *v.* Mitchell, 4 Fisher, 615, 1871; McWilliams Mfg. Co. *v.* Blundell, 11 F. R. 419, 1882.

[180] Brooks *v.* Bicknell, 3 McLean, 250, 1843; Foster *v.* Moore, 1 Curtis, 279, 1852; Howe *v.* Morton, 1 Fisher, 586, 1860; Stainthorp *v.* Humiston, 2 Fisher, 311, 1862; Goodyear *v.* Hills,

§ 688. Formerly it was entirely in the discretion of the court as to whether or not a bond should be required of the plaintiff as a condition to the issuance of a preliminary injunction.[181] Such bonds were conditioned on the ultimate success of the plaintiff in sustaining his claim, and might be required in cases where the injunction if granted would cause serious injury to the defendant.[182] By Section 18 of the Clayton Act[182a] it was provided that "no restraining order or interlocutory order of injunction shall issue except upon the giving of security by the applicant in such sum as the court or judge may deem proper conditioned upon the payment of such costs or damages as may be incurred or suffered by any party who may be found to have been wrongfully enjoined or restrained thereby."

§ 689. A preliminary injunction cannot be averted on the sole ground that an action at law for the damages to be caused by the infringement would be a plain, adequate and complete remedy therefor.[183] It many cases that would not be true, and the court cannot determine on affidavits whether it would be true in a particular case or not. A motion for a preliminary injunction is not to be defeated on a possibility that the complainant might be able to obtain damages for the wrong which he seeks to prevent.[184]

3 Fisher, 134, 1866; Sykes *v.* Manhattan Co., 6 Blatch. 496, 1869; Gilbert & Barker Mfg. Co. *v.* Bussing, 12 Blatch. 426, 1875.

[181] Tobey Furniture Co. *v.* Colby, 35 F. R. 594, 1888; Brush Electric Co. *v.* Accumulator Co., 50 F. R. 833, 1892; Accumulator Co. *v.* Storage Co., 53 F. R. 800, 1893; Columbia Wire Co. *v.* Freeman Wire Co., 71 F. R. 302, 1895.

[182] Orr *v.* Littlefield, 1 Woodbury & Minot, 20, 1845; Brammer *v.* Jones, 3 Fisher, 340, 1867; Shelly *v.* Brannan, 4 Fisher, 198, 1870; Consolidated Fruit-Jar Co. *v.* Whitney, 1 Bann. & Ard. 361, 1874.

[182a] Act of October 15, 1914, Chap. 323, 38 Stat. 730.

[183] General Electric Co. *v.* Wise, 119 F. R. 924, 1903.

[184] Allington & Curtis Mfg. Co. *v.* Booth, 78 F. R. 879, 1897.

But even where it is plain that the damages recoverable in an action at law would be as beneficial to the complainant as an injunction would be, that fact does not oust the right of the complainant to the latter relief. The case is analogous to actions in equity for the specific performance of contracts to sell real property. The bills in such cases seldom show, and never are required to show, that an action at law for damages would not be a plain, adequate, and complete remedy for the failure to perform. "Ordinarily a vendor, in the recovery of pecuniary damages, has an adequate remedy at law, but he has a choice of remedies. He may resort either to a court of law or a court of equity."[185] Bills for preliminary injunctions in patent cases are never obnoxious to Section 267 of the Judicial Code, because the word "case" in that section is to be interpreted specifically and not generically. "Suits in equity shall not be sustained in either of the courts of the United States in any case where a plain, adequate and complete remedy may be had at law."[186] This statute regards an action in equity to restrain infringement of a patent, as a case for an injunction, and not merely as a patent case. It therefore opposes no obstacle to the jurisdiction of equity in such a case.

§ 690. Where the defendant withdraws his opposition to a motion for a preliminary injunction before the motion is decided, the injunction may be granted by consent; but the court will decline to render a decision.[187] That is to say: a consent decree will be entered as a consent decree, and not as one based on a conclusion of the judicial mind. If this rule were otherwise, parties between whom

[185] Crary *v.* Smith, 2 Comstock (N. Y.), 62, 1848.

[186] Revised Statutes, Section 723, re-enacted in Judicial Code, Section 267.

[187] American Middlings Purifier Co. *v.* Vail, 15 Blatch. 315, 1878.

there continued to be no real contest, night manage to secure decisions from courts which would operate to their mutual advantage, and to the serious disadvantage of strangers to the litigation.

§ 691. The discretion of the court was said in some of the earlier cases to be the criterion of judgment when deciding motions for preliminary injunctions in patent cases. The doctrine was a necessity in the beginning of the evolution of the patent laws, because the judges could then find but few precedents to guide or to warn. At present the fact is otherwise. Approved precedents can now be found on nearly every point that can arise.[187a]

§ 692. A motion to dissolve a preliminary injunction may be made at any time,[188] upon reasonable notice to the complainant's solicitor;[189] and it will be promptly granted where the judge becomes convinced that the granting of the injunction was erroneous in point of law,[190] or where the defendant positively proves any fact which would have been fatal to the motion for the preliminary injunction, if presented at the time that motion was heard, and shows that the evidence could not with reasonable diligence have been presented at that hearing.[191] So, also, a dis-

[187a] See Section 696*a*; Irving-Pitt Mfg. Co. *v.* Twinlock Co., 220 F. R. 325, 1914.

[188] Minturn *v.* Seymour, 4 Johnson's Chancery (N. Y.), 173, 1819; Cammack *v.* Johnson, 2 New Jersey Equity, 163, 1839; Jones *v.* Bank, 5 How. (Miss.) 43, 1840; Timolat *v.* Philadelphia Pneumatic Tool Co., 123 F. R. 899, 1903.

[189] Wilkins *v.* Jordan, 3 Washington, 226, 1813; Caldwell *v.* Waters, 4 Cranch's Circuit Court Reports, 577, 1835.

[190] Steam Gauge & Lantern Co. *v.* Miller, 11 F. R. 719, 1882.

[191] Woodworth *v.* Rogers, 3 Woodbury & Minot, 135, 1847; Hussey *v.* Whiteley, 2 Fisher, 125, 1860; Young *v.* Lippman, 5 Fisher, 230, 1872; Carey *v.* Spring Bed Co., 26 F. R. 38, 1886; Huntington *v.* Heel Plate Co., 33 F. R. 838, 1888; Electrical Accumulator Co. *v.* Julien Electric Co., 47 F. R. 892, 1891.

solution of a preliminary injunction may be based on a fact which arose after the injunction was granted: for example, on the fact that the complainant, after that event, assigned all his interest in the future duration of the patent to another; [192] or on the fact that he omitted to prosecute his case toward an interlocutory hearing with the speed which the rules of court require; [193] or on the fact that the complainant advertised the injunction falsely for effect upon strangers to the suit; [194] or on the fact that the prior adjudication, upon which the injunction was based, has been reversed on an appeal.[195]

§ 693. A motion to dissolve an injunction for error in point of law, must be based on a point which was established after the injunction was granted, or which was obviously overlooked or misweighed by the judge at that time. It would be unprofessional as well as unavailing for counsel to move a dissolution, on the ground that the judge wrongly reasoned out his conclusion from the premises from which he proceeded. Courts ought not to be asked to change their judgments on points of law, unless the law has changed or been newly formulated in the meantime, or unless some special error can be pointed out. Few things are more trying to the patience of judges, or more useless to the interests of clients, than the repetition of old and well-understood arguments.

§ 694. A motion to dissolve an injunction on account of newly discovered facts, requires the mover to assume the burden of establishing those facts; because when an in-

[192] Parkhurst *v.* Kinsman, 1 Blatch. 489, 1849; Edison Electric Light Co. *v.* Buckeye Electric Co., 59 F. R. 699, 1894.

[193] Robinson *v.* Randolph, 4 Bann. & Ard. 318, 1879; Antisdel *v.* Chicago Hotel Cabinet Co., 89 F. R. 311, 1898.

[194] Consolidated Fastener Co. *v.* Toppen, 113 F. R. 697, 1901. See Section 705.

[195] Prieth *v.* Campbell Printing-Press Co., 80 F. R. 539, 1897.

junction is once granted, it is presumed to have been granted rightfully, until the contrary is made to appear.[196]

Affidavits and other evidence to disprove the statements of fact, contained in the moving papers of the defendant, may be introduced by the complainant; and counter evidence from the defendant is then admissible to disprove the complainant's answering allegations. After this, it becomes the duty of the judge to balance the documents and ascertain where the weight of them is;[197] and he will decide the motion against the mover, unless his papers preponderate.[198] Service on the opposite party, before the motion is heard, of the affidavits upon which a motion to dissolve an injunction is made or is resisted, seems to be called for by the same reasons which call for similar service of the affidavits upon which motions for preliminary injunctions are based or are withstood.[199]

§ 695. A motion to reinstate a dissolved injunction may be made at any time; but it will not be granted on the same state of the case as that which existed when the injunction was dissolved. So, also, a reinstated preliminary injunction may be again dissolved on any new state of facts which show that its continuation would be unjust.[200] In patent cases, however, it will seldom occur that the alternate process of issuing and dissolving preliminary injunctions can be carried further than the first dissolution. After that, the court will let the matter rest till the interlocutory hearing, unless a case of great clearness and pressing necessity is presented for further preliminary action.

[196] Woodworth *v.* Rogers, 3 Woodbury & Minot, 143, 1847.

[197] Woodworth *v.* Rogers, 3 Woodbury & Minot, 144, 1847.

[198] Sparkman *v.* Higgins, 1 Blatch. 207, 1849.

[199] Section 662 of this book.

[200] Tucker *v.* Carpenter, 1 Hempstead, 441, 1841.

§ 696. While an injunction is in force, it must be obeyed, even though it ought never to have been granted.[201] But an injunction is not in force if it was issued against a defendant over whom the court had no jurisdiction. No court has any authority to issue an injunction against such a person. And where courts act without authority, their orders are nullities. They are not voidable, but simply void.[202] It does not follow, however, that, if a Federal court were to issue an injunction against a defendant before he is served with a *subpœna ad respondendum* in the case, that injunction would be void and could safely be disregarded since the court acquires jurisdiction if the subpœna is served within a reasonable time thereafter; [203] and so where an injunction is granted after such service, and upon due notice of the motion therefor, it must be obeyed, no matter how obviously unjust and unwarrantable its granting may have been.

An injunction is binding upon all persons who were connected with the defendant in defending against the suit, before the injunction was issued, and who were also connected with the defendant in disobeying that injunction, after being informed of its issue; though they were not themselves defendants to the suit nor served with the injunction writ.[204] But a mere order for an injunction,

[201] Moat *v.* Holbein, 2 Edwards' Chancery (N. Y.), 188, 1834; Sullivan *v.* Judah, 4 Paige (N. Y.), 444, 1834; Richards *v.* West, 2 Green's Chancery (N. Y.), 456, 1836; People *v.* Sturtevant, 5 Selden (N. Y.), 263, 1853; Erie Railway Co. *v.* Ramsay, 45 New York, 637, 1871.

[202] Elliot *v.* Peirsol, 1 Peters, 340, 1828; Wilcox *v.* Jackson, 13 Peters, 511, 1839.

[203] Universal Savings, etc., Co. *v.* Stoneburger, 113 F. R. 251, 1902; Horn *v.* Pere Marquette R. Co., 151 F. R. 626, 1907.

[204] *In re* Lennon, 166 U. S. 548, 1897; Phillips *v.* Detroit, 3 Bann. & Ard. 150, 1877; Stahl *v.* Ertel, 62 F. R. 922, 1893: United States

upon which no writ of injunction is ever issued, is not binding upon anybody.[205] Though a writ of injunction when it is served, may retroact to cover disobedient doings, which occurred after the doer learned that an order for that writ had been made, and before the writ could be drawn up, and be executed, and be issued, and be served upon the defendant.

Section 19 of the Clayton Law in effect October 15, 1914, has not apparently changed the rules of law determining the persons who are bound by an injunction, but it is advisable to consult the section whenever the question arises in a specific case.[206]

When an injunction is dissolved which ought not to have been granted, the enjoined party is without redress for the injury or inconvenience he may have suffered, unless the court, when granting the injunction, made an order that the complainant should pay the defendant such resulting damages as he might sustain, in case it be finally decided that the injunction ought not to have been granted; or required the complainant to file a bond to secure those damages, as a condition precedent to the issuing of the injunction.[207]

§ 696*a*. An appeal is demandable to the Circuit Court of Appeals, from any order of a District Court which grants, continues, refuses or dissolves an interlocutory order or decree or refuses to dissolve an injunction at any time within thirty days from the entry of such order. In the sense of the statute allowing such appeals, a "hearing in

Playing-Card Co. *v.* Spalding, 92 F. R. 368, 1899.

[205] McCormick *v.* Jerome, 3 Blatch. 486, 1856; Whipple *v.* Hutchinson, 4 Blatch. 191, 1858.

[206] Act of October 15, 1914, chap. 323, 38 Stat. 730. See Section 407.

[207] Lexington & Ohio Railroad Co. *v.* Applegate, 8 Dana (Ken.), 289, 1839; Sturgis *v.* Knapp, 33 Vermont, 486, 1860; McKay *v.* Jackman, 16 Reporter, 164, 1883. See Section 688.

equity" does not have its usual meaning of a final hearing on the merits but means merely the presentation and submission of the motion for the order,[208] and such appeals take precedence in the appellate court; but they do not stay the other proceedings in the case in the court below during the pendency of the appeal unless the court or the appellate court or one of the judges of the latter so orders.[209] Nor does such an appeal give the appellant a right to a supersedeas of the injunction pending the appeal; and the suspension of the injunction during that time, may be granted or refused at his discretion, by any judge of the court which granted the injunction.[210]

The decision of an appeal from an order granting a preliminary injunction, primarily depends upon the question of the providence of the injunction;[211] and that question may or may not depend, according to circumstances, upon the ultimate merits of the case.[212] In deciding the question of the providence of the injunction, the adjudication or acquiescence upon which the injunction was based in the court below will generally have the same strength in the Circuit Court of Appeals that it ought to have had in the court below;[213] and in general

[208] American Grain Separator Co. *v.* Twin City Separator Co., 202 F. R. 202, 1912.

[209] Judicial Code, Section 129.

[210] *In re* Haberman Mfg. Co., 147 U. S. 529, 1893.

[211] Southern Pacific Co. *v.* Earl, 82 F. R. 690, 1897; Pacific Steam Whaling Co. *v.* Alaska Packers' Ass'n, 100 F. R. 462, 1900; Welsbach Light Co. *v.* Cosmopolitan Light Co., 104 F. R. 85, 1900; Stearns-Roger Mfg. Co. *v.* Brown, 114 F. R. 939, 1902; F. C. Austin Mfg. Co. *v.* American Wellworks, 121 F. R. 77, 1902.

[212] Blount *v.* Societe, 53 F. R. 98, 1892; Consolidated Electric Storage Co. *v.* Accumulator Co., 55 F. R. 45, 1893; Thomson-Houston Electric Co. *v.* Ohio Brass Co., 80 F. R. 730, 1897; American Fur Refining Co. *v.* Cimiotti Unhairing Co., 118 F. R. 838, 1902.

[213] American Paper Pail Co. *v.* National Folding Box Co., 51 F. R. 232, 1892; Duplex Printing-Press Co. *v.* Campbell Printing-

it may be stated that the appellate court will not reverse an order granting a preliminary injunction unless it clearly appears that the court below has exercised its discretion upon a wholly wrong comprehension of the facts or law of the case;[214] but where it was plainly wrong or insufficient, it will not be followed.[215]

Such is the case where the court below has failed to apply well-settled principles of law which if applied would have compelled a contrary decision.[216] It has been announced as a principle of law in the ninth circuit that, when the validity of the patent has been sustained in an action at law and infringement is clear, a court of equity has no discretion to refuse a preliminary injunction in the absence of further showing by the defendant.[217]

And an appeal from a preliminary injunction will be dismissed without adjudication, in the Circuit Court of

Press Co., 69 F. R. 255, 1895; Thomson-Houston Electric Co. *v.* Ohio Brass Co., 80 F. R. 730, 1897; Consolidated Fastener Co. *v.* Littauer, 84 F. R. 164, 1897; Societe Anonyme *v.* Allen, 90 F. R. 815, 1898; Consolidated Fastener Co. *v.* Hays, 100 F. R. 984, 1900.

[214] Interurban Ry. & Terminal Co. *v.* Westinghouse Electric & Mfg. Co., 186 F. R. 166, 1911; Kryptok Co. *v.* Stead Lens Co., 190 F. R. 767, 1911; City of Grand Rapids *v.* Warren Bros. Co., 196 F. R. 892, 1912; American Grain Separator Co. *v.* Twin City Separator Co. (discussing the subject), 202 F. R. 202, 1912; Fireball Gas Tank, etc., Co. *v.* Commercial Acetylene Co., 198 F. R. 650, 1912; (affirmed with opinion 239 U. S. 156); Crescent Specialty Co. *v.* National Fireworks Distributing Co. (announcing the rule in the sixth circuit), 219 F. R. 130, 1915 Lion Tractor Co. *v.* Bull Tractor Co. (eighth circuit), 231 F. R. 156, 1916.

[215] Curtis *v.* Overman Wheel Co., 58 F. R. 784, 1893; Thomson-Houston Electric Co. *v.* Hoosick Ry. Co., 82 F. R. 461, 1897; Rubens *v.* Wheatfield, 93 F. R. 681, 1899.

[216] Winchester Repeating Arms Co. *v.* Olmstead, 203 F. R. 493, 1913.

[217] Sherman-Clay & Co. *v.* Searchlight Horn Co., 214 F. R. 99, 1914.

Appeals, when the patent has expired since the injunction was granted, because the injunction will have terminated at the same time.[218] In case the order in the court below has required the defendant in the alternative to give a bond or be enjoined, and the defendant has given the bond, the order will not usually be reviewed on the merits.[219]

The Circuit Court of Appeals, on an appeal from an order granting a preliminary injunction, may not only reverse that order, but may also direct the court below to dismiss the bill of complaint.[220] But that direction will be given only where the facts before the Circuit Court of Appeals, conclusively show that further litigation cannot ultimately result otherwise than in such a dismissal.[221]

§ 697. A permanent injunction follows a decision in favor of the complainant, on the interlocutory hearing of a patent case, unless some special reason exists for its being refused, or being postponed till after the master's report, or being suspended pending an appeal.[222]

§ 698. A refusal of a permanent injunction will generally follow from the fact that the patent has expired at the time of the interlocutory decree.[223] If there is an exception to this rule, it is only where the defendant may be enjoined from using or selling, after the expiration of the

[218] Gamewell Fire-Alarm Telegraph Co. *v.* Municipal Signal Co., 61 F. R. 208, 1894; National Folding-Box & Paper Co. *v.* Robertson, 104 F. R. 552, 1900.

[219] United Blue-Flame Co. *v.* Silver & Co., 128 F. R. 925, 1904.

[220] Mast, Foos & Co. *v.* Stover Mfg. Co., 177 U. S. 495, 1900.

[221] Brill *v.* Peckham Motor Truck Co., 189 U. S. 63, 1903; Co-Operating Merchants' Co. *v.* Hallock, 128 F. R. 596, 1904; National Electric Signaling Co. *v.* Telefunken Wireless Telegraph Co., 200 F. R. 591, 1912.

[222] Potter *v.* Mack, 3 Fisher, 430, 1868; Rumford Chemical Works *v.* Hecker, 2 Bann. & Ard. 388, 1876; Bissell Carpet-Sweeper Co. *v.* Goshen Sweeper Co., 72 F. R. 551, 1896.

[223] Jordan *v.* Dobson, 2 Abbott's U. S. Reports, 415, 1870; Bignall *v.* Harvey, 18 Blatch. 356, 1880.

patent, those specimens of the patented thing which he unlawfully made before that expiration.[224] But Justice MILLER once decided that there is no such exception; because such an exception would practically prolong many patents beyond the statutory term thereof; and because damages are a sufficient remedy for such unlawful making.[225] And certainly no injunction will issue to prevent preparation, during the life of a patent, for making, selling, or using the patented matter after the patent expires.[226]

§ 699. A refusal of a permanent injunction will also occur where the complainant is shown to have assigned, prior to the interlocutory decree, all his interest in the future duration of the patent right infringed by the defendant.[227] But no such refusal will be based on the fact that the complainant is not employing his invention in competition with the defendant,[228] or upon the fact that the defendant can accomplish his result by non-infringing means.[229]

[224] Parker *v.* Sears, 1 Fisher, 102, 1850; American Diamond Rock Boring Co. *v.* Sheldon, 1 F. R. 870, 1880; American Diamond Rock Boring Co. *v.* Marble Co., 2 F. R. 353, 355, 356, 1880; Reay *v.* Raynor, 19 F. R. 308, 1884; Toledo Reaper Co. *v.* Harvester Co., 24 F. R. 739, 1885; New York Packing Co. *v.* Magowan, 27 F. R. 111, 1886; Underwood Typewriter Co. *v.* Elliott-Fisher Co., 156 F. R. 588, 1907; American Sulphite Pulp Co. *v.* Crown-Columbia Pulp & Paper Co., 169 F. R. 140, 1909; Motion Picture Patents Co. *v.* Centaur Film Co., 217 F. R. 247, 1914.

[225] Westinghouse *v.* Carpenter, 43 F. R. 894, 1888; also, Am. Sulphite Pulp Co. *v.* Hinckley Fibre Co., 217 F. R. 57, 1914.

[226] White *v.* Walbridge, 46 F. R. 526, 1891.

[227] Wheeler *v.* McCormick, 11 Blatch. 345, 1873; Boomer *v.* Powder Press Co., 13 Blatch. 107, 1875.

[228] American Bell Telephone Co. *v.* Cushman Telephone Co., 36 F. R. 488, 1888; Wirt *v.* Hicks, 46 F. R. 71, 1891.

[229] Du Bois *v.* Kirk, 158 U. S. 66, 1895.

§ 700. So, also, a refusal of an injunction will be necessary, where the infringing defendant is dead at the time of the interlocutory decree, even though the suit may have been revived against his legal representative.[230] In such a case no injunction will lie against the dead defendant, because he is no longer within the jurisdiction of the court; and none will lie against the legal representative, because he never infringed the patent. For reasons of similar legal import, an injunction will be refused where the defendant is a corporation and undergoes legal dissolution before the interlocutory decree. This point of law is based on the doctrine that a court will not direct a writ against a dead corporation; [231] and also upon the rule that it will not enjoin an act which, from the nature of the case, cannot be committed.[232]

§ 701. But the fact that the defendant has ceased to infringe the patent, and says that he will not infringe it in the future, is no reason for refusing an injunction against him,[233] unless the evidence is very persuasive that further

[230] Draper *v.* Hudson, 1 Holmes, 208, 1873.

[231] Mumma *v.* Potomac Co., 8 Peters, 286, 1834.

[232] Potter *v.* Crowell, 3 Fisher, 115, 1866.

[233] Jenkins *v.* Greenwald, 2 Fisher, 42, 1857; Potter *v.* Crowell, 3 Fisher, 115, 1866; Rumford Chemical Works *v.* Vice, 14 Blatch. 180, 1877; Bullock Printing-Press Co. *v.* Jones, 3 Bann. & Ard. 195, 1878; Facer *v.* Midvale Steel-Work Co., 38 F. R. 231, 1888; Norton *v.* Automatic Can Co., 45 F. R. 638, 1891; California Electrical Works *v.* Henzel, 48 F. R. 377, 1891; Henzel *v.* California Electrical Works, 51 F. R. 754, 1892; Winchester Arms Co. *v.* American Buckle Co., 54 F. R. 711, 1893; New York Filter Mfg. Co. *v.* Chemical Bldg. Co., 93 F. R. 827, 1899; Stromberg-Carlson, etc., Co. *v.* American Electric, etc., Co., 127 F. R. 704, 1904; General Electric Co. *v.* New England Electric Mfg. Co., 128 F. R. 738, 1904; Brookfield *v.* Elmer Glass Works, 132 F. R. 312, 1904; Luten *v.* Rhoads & Knisely, 194 F. R. 169, 1912.

But see Kennicott Water Softener Co. *v.* Bain, 185 F. R. 520, 1911.

infringement will not take place;[234] and further as has been held, unless it appears that the defendant did not have notice prior to the commencement of the suit, and unless the answer fails to contest validity or infringement.[235] If the answer asserts the right to make the alleged infringing devices, a very strong express denial of an intention to do so is necessary to operate as a disclaimer of the intention, and the evidence to sustain the denial must be very clear,[236] for whatever tort a man has once committed, he is likely to commit again, unless restrained from so doing.

§ 701*a*. Until the decision of Continental Paper Bag Co. *v.* Eastern Paper Box Co.,[237] there had been much doubt expressed as to whether or not an injunction should under any circumstances be granted where the patent had never been used or "worked." By the decision noted it was settled that the jurisdiction of equity to grant an injunction was not affected either by length of non-use or by the motive of the owner in withholding it from use.

§ 702. A permanent injunction will be postponed till a final decree, when such a postponement is necessary to save the defendant from special hardship, and is not injurious to the just rights of the complainant;[238] or where

[234] Crier *v.* Innes, 170 F. R. 324, 1909; Chadeloid Chemical Co. *v.* Johnson, 203 F. R. 993, 1913; Goshen Mfg. Co. *v.* Hubert A. Myers Mfg. Co., 215 F. R. 594, 1914.

[235] Morton Trust Co. *v.* Standard Steel Car Co., 177 F. R. 931, 1910; Seeger Refrigerator Co. *v.* White Enamel Co., 178 F. R. 567, 1910.

[236] Johnson *v.* Foos Mfg. Co., 141 F. R. 73, 1905.

[237] Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

[238] Barnard *v.* Gibson, 7 Howard, 657, 1849; Yale & Greenleaf Mfg. Co. *v.* North, 5 Blatch. 462, 1867; Potter *v.* Mack, 3 Fisher, 428, 1868; Dorsey Harvester Rake Co. *v.* Marsh, 6 Fisher, 401, 1873; West Publishing Co. *v.* Co-operative Publishing Co., 53 F. R. 269, 1893.

an immediate discontinuance of the defendant's use of the patented article is contrary to public policy.[239] But where such a postponement would be injurious to the just rights of the complainant, it will not be granted to avert from the defendant the consequences of his infringement, even where those consequences may be hard to bear,[240] except when the patent has but a short time to run, in which event security for recovery of damages and profits may be permitted in lieu of the injunction.[241] And where such a postponement is allowed, the defendant should be required to give a bond for the security of the complainant.[242]

§ 703. A permanent injunction may be suspended, pending an appeal from the interlocutory decree which granted it, at the discretion of the judge who decided the case, upon such terms as to bond or otherwise, as he may consider proper for the security of the rights of the opposite party.[243] Such a bond should be conditioned upon the result of the appeal, and should secure the profits and damages to accrue after the interlocutory decree, and before the decision of the Circuit Court of Appeals thereon, and also those which may possibly accrue after that decision, and before its reviewal in the Supreme Court, in the event that the case should go to that tribunal.

[239] Ballard *v.* Pittsburg, 12 F. R. 783, 1882.

[240] Brown *v.* Deere, 6 F. R. 487, 1880.

[241] Draper Co. *v.* Am. Loom Co., 161 F. R. 728, 1908; Interurban Ry. & Terminal Co. *v.* Westinghouse Electric & Mfg. Co., 186 F. R. 166, 1911.

See Section 592, *supra*.

[242] American Middlings Purifier Co. *v.* Christian, 3 Bann. & Ard. 53, 1877. For rule in third circuit see Electric Smelting & Aluminum Co. *v.* Carborundum Co., 189 F. R. 710, 1911.

[243] *In re* Haberman Mfg. Co., 147 U. S. 525, 1893; Edison *v.* American Mutoscope Co., 110 F. R. 660, 1901; Section 644*a* of this book.

And a permanent injunction may be suspended, for an extraordinary cause, pending an appeal from a final decree to the Circuit of Appeals, at the discretion of the judge who decided the case and allowed the appeal, upon such terms as will secure the rights of the complainant.[244] Those rights include the right to recover the profits and damages which may accrue after the final decree, and before the end of the suspension of the injunction; and therefore the security of those rights will require a bond to cover those profits and damages, in addition to the supersedeas bond which must be filed to cover the profits and damages which accrued prior to the final decree.

§ 704. A permanent injunction may be dissolved at any time within six months after the expiration of the term of court at which the final decree in the case was entered; and such a dissolution will be had where the defendant, by means of a supplemental bill in the nature of a bill of review, or by a bill of review, secures a cancellation of that decree.[245] And such a dissolution must, of course, occur whenever the decree which granted the injunction, is reversed by a higher court.

§ 705. Injunctions to restrain infringements of patents may be granted independent of all other relief; [246] and an injunction may also be granted to restrain a complainant from bringing an action at law against the defendant, for the same infringements as any of those covered by the action in equity.[247] But no injunction will be issued on account of an infringement which is so trivial as to be below the dignity of the court; [248] nor to restrain a junior

[244] Munson *v.* New York, 19 F. R. 313, 1884; Equity Rule 74.

[245] Sections 647 to 653 of this book.

[246] American Cotton Tie Supply Co. *v.* McCready, 17 Blatch. 291, 1879.

[247] Morss *v.* Knapp, 35 F. R. 218, 1888.

[248] Lowell Mfg. Co. *v.* Hartford

patentee from bringing actions on his patent, while that patent is still free from an adjudication of invalidity.[249]

Whether it is proper to issue an injunction, to restrain a complainant from bringing actions against persons who are using or are selling those articles, for the making of which the action at bar was brought against the defendant, is a question upon which the decisions which have now accumulated, are conflicting.[250] It seems that when the action at bar is against a manufacturer and is brought by a maker and seller of the patented article a suit against a user or dealer will be enjoined if the bill in the action at bar asks for an accounting of all damages and profits, on the ground that a recovery for full damages and profits would operate to release the articles from the monopoly of the patent.[250a]

In Kessler *v.* Eldred [251] it was decided that at any rate a manufacturer defendant who *has prevailed* in a Circuit Court of Appeals on the issue of infringement is entitled to such an injunction. In that case it appeared that Kes-

Carpet Co., 2 Fisher, 472, 1864; Avery Portable Light Co., 152 Wickwire *v.* Wire Fabric Co., 41 F. R. 36, 1889. F. R. 642, 1906; same case on appeal 159 F. R. 935, 1908.

[249] Asbestos Felting Co. *v.* Salamander Felting Co., 13 Blatch. 453, 1876.

See also Kryptok Co. *v.* Stead Lens Co., 190 F. R. 767, 1911; Stebler *v.* Riverside Heights Orange Growers' Assn., 214 F. R. 550, 1914; Sherman, Clay & Co. *v.* Searchlight Horn Co., 225 F. R. 497, 1915.

[250] Birdsall *v.* Mfg. Co., 1 Hughes, 64, 1877; Allis *v.* Stowell, 16 F. R. 788, 1883; Ide *v.* Engine Co., 31 F. R. 901, 1887; National Cash Register Co. *v.* Boston Cash Recorder Co., 41 F. R. 51, 1889; Kelly *v.* Ypsilanti Dress-Stay Co., 44 F. R. 19, 1890; American School-Furniture Co. *v.* J. M. Sauder Co., 106 F. R. 732, 1901; Commercial Acetylene Co. *v.*

[250a] Stebler *v.* Riverside Heights Assn., 214 F. R. 550, 1914; but see Sherman, Clay & Co. *v.* Searchlight Horn Co., 225 F. R. 497, 1915.

[251] Kessler *v.* Eldred, 206 U. S. 285, 1907.

sler the defendant, a manufacturer of cigar lighters, had been sued by Eldred for infringement, and the Court of Appeals of the seventh circuit had found that Kessler did not infringe. Eldred had thereupon sued Kirkland who was selling another make of cigar lighter, in the second circuit, and it was held that Kirkland did not infringe. Eldred had then sued Breitweiser, one of Kessler's dealers, in the Northern District of New York, to enjoin him from selling Kessler's lighters and Kessler had assumed the defence of that suit. The case came before the Supreme Court on four certified questions as follows:

"First: Did the decree in Kessler's favor, rendered by the Circuit Court for the District of Indiana in the suit of Eldred against Kessler, have the effect of entitling Kessler to continue the business of manufacturing and selling throughout the United States the same lighter he had theretofore been manufacturing and selling, without molestation by Eldred through the Chamber patent?

"Second. Did the decree mentioned in the first question have the effect of making a suit by Eldred against any customer of Kessler's for alleged infringement of the Chambers patent by use or sale of Kessler's lighters a wrongful interference by Eldred with Kessler's business?

"Third. Did Kessler's assumption of the defence of Eldred's suit against Breitweiser deprive Kessler of the right, if that right would otherwise exist, of proceeding against Eldred in the State and district of his citizenship and residence for wrongfully interfering with Kessler's business?

"Fourth. If Eldred's act were wrongful, had Kessler an adequate remedy at law?"

The first question was answered in the affirmative, the court holding that the judgment on the appeal settled finally and everywhere, and so far as Eldred by virtue

of his ownership of the Chambers patent was concerned, that Kessler had the right to manufacture, use and sell the electric cigar lighter before the court free from all interference by Eldred at all places. The court, however, expressly declined to pass on the question as to whether the Court of Appeals decision was a bar to the Breitweiser suit or whether Breitweiser could take advantage of it at all merely confining itself to deciding that Kessler's right had been violated.

The second question was accordingly answered in the affirmative.

The third question was answered in the negative. Kessler and Eldred happened to be citizens of different States. Whether such a suit could be brought in a State court in the event that diversity of citizenship did not exist, or whether there was another ground for Federal jurisdiction than diversity of citizenship, was not considered.

The fourth question was answered in the negative.

The doctrine of Kessler *v.* Eldred, does not, however, go to the extent of allowing the successful defendant to enjoin the plaintiff from suing for infringement one who purchases the material of one of the elements of the patented structure from the successful defendant and constructs the complete article.[252] In Woodard Co. *v.* Hurd,[253] it was held that one who merely buys parts from the manufacturer and assembles them is not immune from suit.

When the final decree allows the defendant to continue to make the articles in question free from interference from the plaintiff, it is proper that the decree also enjoin

[252] Rubber Tire Wheel Co. *v.* Goodyear Tire & Rubber Co., 232 U. S. 413, 1914.

See also Seim *v.* Hurd, 232 U. S. 420, 1914.

[253] Woodward Co. *v.* Hurd, 232 U. S. 428, 1914.

the plaintiff from bringing further suits against the defendant's customers,[254] except when a decree in another circuit holding the patent valid and infringed has been affirmed by the Supreme Court.[255]

No injunction will issue on behalf of a defendant against a plaintiff in an infringement suit to restrain the latter from sending circulars to defendant's customers giving notice of the suit, and warning them against contributory infringement where the statements in the circulars are true and sent out in good faith.[256] The sending out of misleading notices or exaggerated statements of the scope and effect of the injunction which are calculated to injure the defendant's legitimate business will not be tolerated, however, and may afford ground for dissolving the injunction.[257]

An injunction will also issue on application of a plaintiff in a suit to compel the issuance of a patent under Section 4915 of the Revised Statutes, to stay a suit brought by the defendant to enjoin infringement of the patent, until the suit under Section 4915 has been decided.[258]

§ 706. The duration of injunctions in patent cases depends upon a variety of circumstances. Unless such a writ is expressly made to apply to the use or sale, after the expiration of the patent, of specimens of the patented thing which were made before that time, such injunction cannot continue after that expiration;[259] and surely no such

[254] Goodyear Tire & Rubber Co. *v.* Rubber Tire Wheel Co., 164 F. R. 869, 1908.

[255] Hurd *v.* Woodward Co., 190 F. R. 28, 1911; Hurd *v.* James Goold Co., 197 F. R. 756, 1912.

[256] Mitchell *v.* International Tailoring Co., 169 F. R. 145, 1909; United Electric Co. *v.* Creamery Package Co., 203 F. R. 53, 1913.

[257] Meyers *v.* Skinner, 186 F. R. 347, 1911; Rollman Mfg. Co. *v.* Universal Hardware Works, 229 F. R. 579, 1916.

[258] Steinberger *v.* General Electric Co., 207 F. R. 114, 1913.

[259] Gamewell Fire-Alarm Tel.

writ will be made to apply to such use or sale of unpatented parts of an infringing combination.[260] Indeed, no injunction ought in any case to continue after the expiration of the patent.[261] Permanent injunctions are sometimes called perpetual injunctions; but in patent cases that would be a misnomer, for no injunction can stand longer than the right upon which it is based, and patent rights are never perpetual.

§ 707. It is well settled that in a patent suit, as in any other suit, the court having acquired jurisdiction over the persons of the defendants, may control them by decree *in personam*, from doing any act within or without the jurisdiction at home or abroad, by bringing suit or otherwise which shall be an interference with the plaintiff's rights. Since, however, the monopoly of a patent extends only to the territorial limits of the United States this power would not permit the court to enjoin the bringing of a suit on a foreign patent for the same invention.[262]

§ 708. An attachment will issue to bring an enjoined defendant before the court for punishment,[263] whenever the complainant institutes proper proceedings therefor, and proves that the defendant was promptly [264] served with a writ of injunction, and that the writ contained a concise description of the particular thing, all specimens of which it forbade the defendant to make, use, or sell, [265]

Co. *v.* Municipal Signal Co., 61 F. R. 208, 1894; National Folding Box & Paper Co. *v.* Robertson, 104 F. R. 552, 1900.

[260] Johnson *v.* Brooklyn Co., 37 F. R. 147, 1888; Hall Signal Co. *v.* General Ry. Signal Co., 171 F. R. 436, 1909.

[261] Westinghouse *v.* Carpenter, 43 F. R. 894, 1888.

[262] Goodyear Tire & Rubber Co. *v.* Rubber Tire Wheel Co., 164 F. R. 869, 1908 (see Rushmore *v.* Manhattan Screw & Stamping Works, 170 F. R. 188, 1909).

[263] Bate Refrigerating Co. *v.* Gillett, 30 F. R. 684, 1887.

[264] McCormick *v.* Jerome, 3 Blatch. 486, 1856.

[265] Whipple *v.* Hutchinson, 4

and that the defendant did make, or use, or sell, or did cause to be made, used, or sold a specimen of that thing, or of a thing clearly the same, after having been served with that writ.[266] And an attachment will likewise issue against any person who was connected with the defendant in defending against the suit, before the injunction was issued, and who was also connected with the defendant in disobeying that injunction, after he was informed of its issue; though the writ of injunction which was served upon the defendant, was not served upon the person thus connected with the original infringement and also connected with the disobedience of the injunction writ.[267]

Where the defendant is a corporation, and where the officer of that corporation upon whom the writ was served, was privy to its violation, an attachment will issue against him in person;[268] and indeed an injunction duly served on a corporation is binding on all persons acting for that corporation, and who have notice of the writ and of its contents, whether they were actually served or not.[269] So also an attachment will issue against persons who disobey an injunction by doing as officers of a corporation, what they were enjoined from doing as individuals.[270] But an attachment will not issue against a stranger to the suit, merely because he has succeeded to the business, in the conduct of which the defendant infringed the com-

Blatch. 191, 1858; Bate Refrigerating Co. *v.* Gillett, 24 F. R. 696, 1885.

[266] Birdsall *v.* Mfg. Co., 2 Bann. & Ard. 519, 1877; Allis *v.* Stowell, 19 O. G. 727, 1881; Atlantic Giant Powder Co. *v.* Dittmar Powder Mfg. Co., 9 F. R. 316, 1881; Mundy *v.* Mfg. Co., 34 F. R. 541, 1888.

[267] Stahl *v.* Ertel, 62 F. R. 922, 1893; United States Playing-Card Co. *v.* Spalding, 92 F. R. 369, 1899.

[268] Wetherill *v.* Zinc Co., 1 Bann. & Ard. 105, 1874.

[269] Phillips *v.* Detroit, 3 Bann. & Ard. 150, 1877.

[270] American Graphophone Co. *v.* Walcutt, 86 F. R. 469, 1898.

plainant's patent, even where that successor has likewise infringed,[271] except in cases where the stranger is acting in collusion with the defendant to help him avoid the injunction,[272] and this is so whether or not the stranger was served with the writ, provided he knew that it had been issued.[273] And likewise an attachment will not issue against one who was an employee of the defendant at the time of the issuance of the injunction but who has since engaged in an independent business in which he makes the articles adjudged to be an infringement. In such cases the owner of the patent will be relegated to an independent suit against him.[274]

Where the thing proved to have been done by the enjoined defendant, consists in sending to some foreign country, and selling there, articles which were made in the United States, in infringement of the patent, before the injunction was granted, an attachment will not issue, because such a transaction is not a violation of an injunction against the infringement of a patent.[275] And an attachment will not issue where the character of the defendant's doings, after the injunction, is doubtful.[276]

Where the thing proved to have been done by the enjoined defendant, differs from the doings described in the writ of injunction, a question of infringement may arise, which may require to be brought before the court on a

[271] Bate Refrigerating Co. *v.* Gillett, 30 F. R. 684, 1887.

[272] Hamilton *v.* Diamond Drill & Mach. Co., 137 F. R. 417, 1905.

[273] Hamilton *v.* Diamond Drill & Mach. Co., *supra.*

[274] Donaldson *v.* Roksament Stone Co., 178 F. R. 103, 1910.

[275] Gould *v.* Sessions, 67 F. R. 163, 1895; Rushmore *v.* Manhattan Screw & Stamping Works, 170 F. R. 188, 1909; Victor Talking Machine Co. *v.* Strauss, 171 F. R. 673, 1909.

[276] Accumulator Co. *v.* Storage Co., 53 F. R. 793, 1892; Cimiotti Unhairing Co. *v.* Frollochr, 121 F. R. 561, 1903.

motion for another or extended writ of injunction,[277] or as it is sometimes called a supplementary decree,[278] or if a final decree has been entered, by another bill of complaint,[279] rather than on a motion for an attachment. If that question is a doubtful one, an attachment will not issue;[280] because doubtful questions will not be decided on summary proceedings to punish persons for contempt of court.[281] But not every question is doubtful which is difficult, or which is complex, or about which the evidence is conflicting. It is therefore the duty of the court, on a hearing of a motion for an attachment, to examine what the defendant is proved to have done, and to issue an at-

[277] Gold & Stock Telegraph Co. *v.* Pearce, 19 F. R. 419, 1884; Truax *v.* Detweiler, 46 F. R. 118, 1891; Bonsack Machine Co. *v.* Cigarette Co., 64 F. R. 858, 1894; Westinghouse Air-Brake Co. *v.* Christensen Eng. Co., 126 F. R. 764, 1904.

[278] Sundh Electric Co. *v.* General Electric Co., 217 F. R. 583, 1914; Gordon *v.* Tusco-Halvah Co., Inc., 233 F. R. 430, 1915; Individual Drinking Cup Co. *v.* Public Service Cup Co., 234 F. R. 654, 1916.

[279] United States Playing-Card Co. *v.* Spalding, 93 F. R. 822, 1899.

[280] California Paving Co. *v.* Molitor, 113 U. S. 617, 1884; Liddle *v.* Cory, 7 Blatch. 1, 1866; Welling *v.* Trimming Co., 2 Bann. & Ard. 1, 1875; Buerk *v.* Imhaeuser, 2 Bann. & Ard. 465, 1876; Onderdonk *v.* Fanning, 5 Bann. & Ard. 431, 1880; Bate Refrigerating Co. *v.* Eastman, 11 F. R. 902, 1881; Higby *v.* Rubber Co., 18 F. R. 601, 1883; Smith *v.* Halkyard, 19 F. R. 602, 1884; Wirt *v.* Brown, 30 F. R. 187, 1887; Temple Pump Co. *v.* Mfg. Co., 31 F. R. 292, 1887; Howard *v.* Mast, 33 F. R. 867, 1888; Mundy *v.* Mfg. Co., 34 F. R. 541, 1888; Pennsylvania Drill Co. *v.* Simpson, 39 F. R. 284, 1889; Enterprise Mfg. Co. *v.* Sargent, 48 F. R. 453, 1891; Mack *v.* Levy, 49 F. R. 857, 1892; Westinghouse Air-Brake Co. *v.* Christensen Eng. Co., 126 F. R. 764, 1904; Brookfield *v.* Novelty Glass Mfg. Co., 132 F. R. 316, 1904; Crown Cork & Seal Co. *v.* American Cork Specialty Co., 211 F. R. 650, 1914.

[281] *Re* Henris, 125 F. R. 655, 1903; Westinghouse Elec. & Mfg. Co. *v.* Sangamo Electric Co., 128 F. R. 717, 1901.

tachment if his doings satisfactorily appear, in the eye of the law, to constitute disobedience of the writ of injunction.[282] A motion for an attachment cannot be anticipated and outflanked by a motion to expressly limit the injunction, so as to exclude the doings of the defendant.[283] And where a motion for an attachment is denied, on the ground of infringement being too doubtful to be decided on such a motion, that denial does not prevent a decision finding infringement, on a new motion, or in a new suit, on the same facts.[284]

A motion for an attachment for contempt of court for violating an injunction is an independent criminal case, which can be taken to the Circuit Court of Appeals for review on a writ of error, while the action in equity out of which it arose, is still pending and progressing in the lower court.[285]

§ 709. It is no defence to a motion for an attachment to show that the decision in pursuance of which the injunction was granted was wrong; [286] or that new evidence has since been discovered which, if it had been known at the hearing would have caused a contrary decision; [287] or that the defendant was advised by counsel that his doings did not violate the injunction; [288] although the fact that

[282] Wetherill *v.* Zinc Co., 1 Bann. & Ard. 105, 1874; Schillinger *v.* Gunther, 2 Bann. & Ard. 545, 1877; Morss *v.* Knapp, 37 F. R. 353, 1889.

[283] Edison Electric Light Co. *v.* Westinghouse Electric Co., 54 F. R. 504, 1893; Thomas & Sons Co. *v.* Electric Porcelain Co., 114 F. R. 407, 1902.

[284] Mack *v.* Levy, 59 F. R. 468, 1894.

[285] Sessions *v.* Gould, 63 F. R. 1002, 1894; Gould *v.* Sessions, 67 F. R. 163, 1895; Cary Mfg. Co. *v.* Acme Flexible Clasp Co., 108 F. R. 873, 1901; and 187 U. S. 427, 1903.

[286] Woodworth *v.* Rogers, 3 Woodbury & Minot, 135, 1847; Liddle *v.* Cory, 7 Blatch. 1, 1865.

[287] Whipple *v.* Hutchinson, 4 Blatch. 190, 1858; Phillips *v.* Detroit, 3 Bann. & Ard. 150, 1877.

[288] Hamilton *v.* Simons, 5 Bissell, 77, 1869; Paxton *v.* Brinton, 126

the defendant was acting under such advice will be considered in determining whether or not there has been intentional disregard of the injunction;[289] or that what the defendant did was done as the employee of another;[290] or that the defendant had merely ordered his employees not to sell the infringing articles without more energetic step to see that his orders were carried out;[291] or that the writ of injunction was for a while suspended in its operation, by the consent of the complainant without any order of court;[292] or that the writ of injunction was inadvertently made broader than the decision of the court would warrant.[293] In such a case as the last of these, the defendant may apply to the court to correct the writ, but he must not disobey it while it remains unchanged. But where an injunction was based on a consent decree, which decree was entered in pursuance of a compromise of the parties, an attachment will not issue for a disregard of that injunction, if that compromise has been set aside by a court of competent jurisdiction, or if such a court has enjoined the complainant from enforcing the contract of compromise.[294]

§ 710. The penalty for a violation of an injunction depends upon the circumstances of the particular case at bar.

F. R. 542, 1903; Goss Printing Co. *v.* Scott, 134 F. R. 880, 1905; Calculagraph Co. *v.* Wilson, 136 F. R. 196, 1905.

[289] Westinghouse Electric & Mfg. Co. *v.* Sangamo Electric Co., 128 F. R. 747, 1904; Proudfit Loose Leaf Co. *v.* Kalamazoo Loose Leaf Binder Co., 230 F. R. 120, 1915.

[290] Sickles *v.* Borden, 1 Blatch. 15, 1857; Goodyear *v.* Mullee, 5 Blatch. 437, 1867; Potter *v.* Muller, 1 Bond. 601, 1865; Iowa Barb Steel Wire Co. *v.* Barbed Wire Co., 30 F. R. 123, 1887.

[291] Gillette Safety Razor Co. *v.* Wolf, 180 F. R. 776, 1910.

[292] Pentlarge *v.* Beeston, 1 F. R. 862, 1880.

[293] Sickles *v.* Borden, 4 Blatch. 15, 1857.

[294] Pentlarge *v.* Beeston, 1 F. R. 862, 1880.

Where it appears that the defendant had no intention to disobey the writ, the penalty may be confined to an enforced payment of the costs of the motion for an attachment.[295] Where the defendant had no intention to disobey the writ, but imprudently did so, the penalty may include the costs and a small fine.[296] Where the disobedience is less excusable, the defendant may be compelled to pay all the expenses and counsel fees incurred by the complainant in relation to the motion.[297] And where disobedience of an injunction is excuseless and defiant, the penalty may be a reasonable fine and a reasonable imprisonment.

The nature of the punishment that may be inflicted in a civil proceeding, depends on its character and purpose. If the punishment imposed in a civil proceeding for contempt is by way of punitive fine or imprisonment it must appear that the defendant has failed to do something affirmatively required of him by the court's order. This situation seldom occurs in the case of injunctions relating to the enforcement of patent rights and of course does not exist in the case of a bare injunction against further infringement, as in such a case the defendant is ordered

[295] Carsteadt *v.* Corset Co., 13 Blatch. 371, 1876; Strowbridge *v.* Lindsay, 6 F. R. 510, 1881; Macbeth *v.* Gillinder, 54 F. R. 172, 1891; Macbeth *v.* Braddock Glass Co., 54 F. R. 173, 1890; Braddock Glass Co. *v.* Macbeth, 64 F. R. 120, 1894.

[296] Norton *v.* Automatic Can Co., 59 F. R. 137, 1893; Cary Mfg. Co. *v.* Acme Flexible Clasp Co., 108 F. R. 873, 1901; Westinghouse Air-Brake Co. *v.* Christensen Engineering Co., 121 F. R. 562, 1903.

[297] Doubleday *v.* Sherman, 4 Fisher, 253, 1870; Schillinger *v.* Gunther, 2 Bann. & Ard. 545, 1877; Stahl *v.* Ertel, 62 F. R. 922, 1893.

See Christensen Engineering Co. *v.* Westinghouse Air-Brake Co., 135 F. R. 774, 1905, where the practice is discussed; Robinson *v.* S. & B. Lederer Co., 146 F. R. 993, 1906.

merely to desist from doing something. The reason stated in Gompers *v.* Buck's Stove & Range Co.,[298] which settled the law on the question, is that when an affirmative act is required and is not done, any means taken to force compliance with the order are remedial in their nature and their benefits accrue directly to the benefit of the party in whose favor the order is made. On the other hand, when a party has done an act which was forbidden, no punishment by fine or imprisonment can remedy the evil, and consequently its only object is punitive. Therefore the disobedient party in such a case is liable only in a proceeding instituted and tried as for a criminal contempt—i. e., before a jury.

On the other hand by the violation of an injunction by doing forbidden acts, as in case of the violation of an injunction forbidding infringement of a patent, the contempt may also be productive of injury to the other party and to the extent that that injury may be remedied by the payment of money, the offending party may be compelled in a civil proceeding to reimburse the opposite party for the latter's expenses of the contempt proceeding and for the damage caused by the violation of the injunction.[299]

[298] Gompers *v.* Buck's Stove & Range Co., 221 U. S. 418, 1911; *In re* Stern, 215 F. R. 979, 1914.

[299] United States Envelope Co. *v.* Trauso Paper Co., 221 F. R. 79, 1915; Board of Trade of Chicago *v.* Tucker, 221 F. R. 305, 1915; Proudfit Loose Leaf Co. *v.* Kalamazoo Loose Leaf Binder Co., 230 F. R. 120, 1915.

CHAPTER XXII

PROFITS

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§ 711. THE profits which are recoverable in equity for the infringement of a patent, are those which the defendant made from that infringement.[1] They are the profits which he actually made; not those which with worse,[2] or better,[3] management he would or might have made.

Where a particular infringer realized no profit from his infringement, none can be recovered from him; but where he did make such a profit, it can be recovered, whether the general business, of which the infringement formed a part, was profitable to him or not,[4] and whether or not the complainant was employing, at the time, the invention which was covered by the patent infringed.[5]

[1] Rubber Co. *v.* Goodyear, 9 Wallace, 801, 1869; Elizabeth *v.* Pavement Co., 97 U. S. 138, 1878; Tilghman *v.* Proctor, 125 U. S. 144, 1888; Belknap *v.* Schild, 161 U. S. 25, 1896.

[2] Lawther *v.* Hamilton, 64 F. R. 224, 1892.

[3] Livingston *v.* Woodworth, 15 Howard, 546, 1853; Dean *v.* Mason, 20 Howard, 203, 1857; Keystone Mfg. Co. *v.* Adams, 151 U. S. 139, 1894; Coupe *v.* Royer, 155 U. S. 565, 1895.

[4] Elizabeth *v.* Pavement Co., 97 U. S. 138, 1877; Tilghman *v.* Proctor, 125 U. S. 146, 1888.

[5] Crosby Steam Gauge & Valve

The recoverable profits are those which resulted directly, and do not include any which resulted indirectly, from the infringement.[6] The case of Piper *v.* Brown is cited as an example of this distinction. The difference between the amount of money for which the defendants sold their preserved fish, and the aggregate cost of that fish and of preserving it by the patented apparatus, was there held to be direct profit. But it appeared that the defendants were also dealers in fresh fish, and that they sold a large amount of such fish at higher prices than they could have done, had they not reduced the supply in the market by means of preserving fish by the patented apparatus. The increase in the price of fresh fish, which was thus caused by the defendants' infringement, was one and one-half cents per pound; and the consequent profits made by the defendants, amounted to more than six thousand dollars. But the court held that those profits could not be recovered by the patentee, because they did not directly result from the infringement of his patent.

§ 712. Where several defendants were joint infringers of a patent, but where all the resulting profits were received by part of the wrongdoers, the decree for profits will be rendered only against those defendants who realized them.[7] Where all of the defendants realized profits during a portion of the time covered by the infringement in suit, and where a part of them realized profits during the residue of that time, the respective profits may be recovered accordingly, and a decree be entered against all of the defendants for the profits in which all participated, and

Co. *v.* Safety Valve Co., 141 U. S. 452, 1891.

[6] Piper *v.* Brown, 1 Holmes, 198, 1873; Heaton Button-Fastener Co. *v.* MacDonald, 57 F. R. 649, 1893.

[7] Elizabeth *v.* Pavement Co., 97 U. S. 140, 1377: Belknap *v.* Schild, 161 U. S. 25, 1896.

against a part of the defendants for the profits which that part alone realized.[8] Successive owners of an infringing business transferred *pendente lite* are each liable only for the profits made by himself.[9] And where one part of the profits of joint infringement was realized by one of the joint infringers, and the residue by another, the decree will go against each, for his own share only.[10]

§ 713. Where a part of the infringement of a defendant resulted in profits, and the residue resulted in losses, the complainant is entitled to recover those profits without any deduction on account of those losses.[11] Each infringement is treated by itself. If it resulted in profit, that profit belongs to the patentee. If it resulted in loss, that loss must be borne by the infringer. It cannot be set off against the patentee's right of action for the profitable infringement, any more than it could be made the basis of a right of action against the patentee if no infringement had been profitable.

§ 714. An account of profits cannot be had where none arose before the action was begun,[12] but such an account is not confined to those profits, nor indeed to those which accrued before the interlocutory decree was entered, but may be made to include all profits realized by the defend-

[8] Tatham *v.* Lowber, 4 Blatch. 87, 1857; Herring *v.* Gage, 3 Bann. & Ard. 402, 1878; New York Grape Sugar Co. *v.* American Grape Sugar Co., 42 F. R. 456, 1890.

[9] Young *v.* Hermann, 232 F. R. 361, 1916.

[10] Covert *v.* Sargent, 38 F. R. 238, 1889.

[11] Callaghan *v.* Myers, 128 U. S. 664, 1888; Crosby Valve Co. *v.* Safety Valve Co., 141 U. S. 453, 1891; Graham *v.* Mason, 1 Holmes, 90, 1872; Steam Stone Cutter Co. *v.* Mfg. Co., 17 Blatch. 27, 1879; Canda Bros. *v.* Michigan Malleable Iron Co., 152 F. R. 178, 1907; Underwood Typewriter Co. *v.* Fox Typewriter Co., 220 F. R. 880, 1915.

[12] Marsh *v.* Nichols, 128 U. S. 616, 1888.

ant from infringing the complainant's right, at any time prior to the closing of the account.[13] And such an account will be taken in conformity with the statutes relevant thereto, as they existed at the respective dates when the infringement occurred.[14]

§ 715. The generic rule for ascertaining the amount of the profits recoverable in equity for the infringement of a patent, is that of treating the infringer as though he were a trustee for the patentee, in respect of the profits which he realized from his infringement.[15] The specific rules by means of which this generic rule is administered, are somewhat numerous and somewhat elastic. They are adapted to the varying natures of patented inventions, and to the varying circumstances under which the patents for those inventions are respectively infringed.[16] They all require the best evidence, of which the nature of each particular case to which they may be respectively applied, will reasonably admit,[17] and that evidence must be reasonably definite[18] and convincing.[19]

§ 716. The patentee's royalty is no measure of the defendant's profits,[20] even in a case where the patentee habitually exercised his exclusive right by granting licenses to others.[21] Nor are any other facts which relate

[13] Rubber Co. *v.* Goodyear, 9 Wallace, 800, 1869; Knox *v.* Quicksilver Mining Co., 6 Sawyer, 435, 1878; Creamre *v.* Bowers, 35 F. R. 209, 1888.

[14] Untermeyer *v.* Freund, 58 F. R. 212, 1893.

[15] Root *v.* Railway Co., 105 U. S. 214, 1881; Tilghman *v.* Proctor, 125 U. S. 148, 1888; Belknap *v.* Schild, 161 U. S. 25, 1896.

[16] Wetherill *v.* Zinc Co., 1 Bann. & Ard. 486, 1874.

[17] Herring *v.* Gage, 3 Bann. & Ard. 399, 1878; Emigh *v.* Railroad Co., 6 F. R. 283, 1881.

[18] Fischer *v.* Hayes, 39 F. R. 613, 1889.

[19] Locomotive Safety Truck Co. *v.* Railroad Co., 2 F. R. 681, 1880.

[20] Knox *v.* Quicksilver Mining Co., 6 Sawyer, 430, 1878.

[21] Tilghman *v.* Proctor, 125

to the measure of the complainant's damages, material to inquiries touching the amount of the defendant's profits.[22] It is immaterial that the profits made by the defendant would not have been made by the plaintiff.[23]

§ 717. The difference between the amount it cost the defendant to make and sell his specimens of the patented thing, and the amount which he received for those specimens, is in many cases the amount of his profits.[24] That is the fact where the only infringement consisted of such making and selling, and where no part of ascertainable cost or value, other than those covered by the patent in suit, entered into the composition of the specimens which were made and sold.[25]

In the first case just cited, it appears that the patent did not cover all the elements of the articles of merchandise which were made and sold by the defendant. But those unpatented elements were disregarded in that case, because the conduct of the defendant had rendered impossible a separate account of the profits due to the patented, and those due to the unpatented, features of those articles.[26]

U. S. 143, 1888; Wooster *v.* Taylor, 14 Blatch. 403, 1878.

[22] Elizabeth *v.* Pavement Co., 97 U. S. 143, 1877; Beach *v.* Hatch, 153 F. R. 763, 1907.

[23] Brennan & Co. *v.* Dowagiac Mfg. Co., 162 F. R. 472, 1908; Carborundum Co. *v.* Electric Smelting, etc., Co., 203 F. R. 976, 1913.

[24] Simpson *v.* Davis, 22 F. R. 444, 1884; Shannon *v.* Bruner, 33 F. R. 872, 1888; Am Ende *v.* Seabury, 43 F. R. 672, 1890.

[25] Rubber Co. *v.* Goodyear, 9 Wallace, 803, 1869; Elizabeth *v.* Pavement Co., 97 U. S. 141, 1877; Warren *v.* Keep, 155 U. S. 268, 1894; Jenkins *v.* Greenwald, 1 Bond, 141, 1857; Sayre *v.* Scott, 55 F. R. 975, 1893; Orr & Lockett Hardware Co. *v.* Murray, 163 F. R. 54, 1908; Yesbera *v.* Hardesty Mfg. Co., 166 F. R. 120, 1909; Conroy *v.* Penn. Electrical & Mfg. Co., 199 F. R. 427, 1912; Seegar Refrigerator Co. *v.* American Car & Foundry Co., 219 F. R. 565, 1915.

[26] And so in Brennan & Co. *v.*

In the second of the cited cases, it appeared that the pavement which was made by the New Jersey Wood Paving Co. for the city of Elizabeth, contained the entire invention of the complainant, and contained an addition thereto, which addition might or might not have contributed to the profit which resulted to the Paving Co. from its contract. Under those circumstances, the Supreme Court held that the entire profit should go to the patentee, because it was not ascertainable how much was due to the additional element. The principle of both these precedents on this point appears to be, that where a defendant mingled profits which he made as an infringer, with those he made otherwise, and where there is no criterion by means of which they can be separated, he must submit to the recovery of the whole.

In the third case, the infringement consisted in making and selling a particular kind of stove grates, which was admitted to infringe all the claims of the complainant's patent thereon. The Supreme Court affirmed a decree for the difference between the complainant's evidence of the cost of making the grates, and the amount for which the defendant sold them.

Although the device of the patent may be a mere improvement on an existing device, the improvement may nevertheless be the thing which brings about the sale and if that is the case, the plaintiff is entitled to recover the entire profits.[27]

The general principle announced in the foregoing para-

Dowagiac Mfg. Co., 162 F. R. 472, 1908; Dowagiac Mfg. Co. *v.* Superior Drill Co., 162 F. R. 479, 1908.

[27] Force *v.* Sawyer-Boss Mfg. Co., 143 F. R. 894, 1906; Maimin *v.* Union Special Machine Co., 187 F. R. 123, 1911; Roth *v.* Harris, 197 F. R. 929, 1912; Van Brunt *v.* La Crosse Plow Co., 208 F. R. 281, 1913; La Crosse Plow Co. *v.* Van Brunt, 220 F. R. 626, 1915.

graph creates an important modification of the rule which has been announced in a number of cases to the effect that when the claim of a patent infringed covers a unitary structure which is made and sold by the defendant without addition or change, the plaintiff is entitled to recover the entire profits.[28] Even though the claim cover a unitary structure, which is made and sold by the defendant, the plaintiff may not recover all the profits made by the defendant if it appears that the real invention lies in a single element and is in fact merely an improvement over prior structures, as this may be the case in spite of the rule of the Patent Office which requires a claim to include a completely operative combination.[29]

§ 718. When taking an account of profits in the method indicated in the last section, it is generally easy to ascertain the amount which the defendant realized for the articles which he made and sold; but it is generally difficult to determine how much it cost him to make and sell them. Such an inquiry must consist of collecting direct evidence upon the subject; and cannot consist in ascertaining the cost to other parties, of making and selling similar articles.[30] One such inquiry occupied ex-Chancellor WALWORTH, as master, more than ten years, and occupied the judge who passed upon the exceptions to his report at least as many weeks.[31] When such accounts are taken, the elements which are allowed to enter into that cost are the following:

1. The market value of materials on hand at the time

[28] Seegar Refrigerator Co. *v.* American Car & Foundry Co., 212 F. R. 742, 1914; Yesbera *v.* Hardesty, 166 F. R. 120, 1908; Orr & Lockett Hardware Co. *v.* Murray, 163 F. R. 54, 1908.

[29] Hermann *v.* Youngstown Car Mfg. Co., 216 F. R. 604, 1914.

[30] Robins *v.* Illinois Watch Co., 78 F. R. 124, 1897; and 81 F. R. 957, 1897.

[31] Troy Iron & Nail Factory *v.* Corning, 6 Blatch. 328, 1869.

the infringement began, and the actual cost of materials subsequently purchased, but not the market value of the latter at the time they were used in infringing.[32]

2. Money paid in reasonable amounts to persons employed in making and selling the infringing articles, even where those persons were officers or stockholders of the infringing corporation.[33]

3. Proper remuneration for the labor of the infringer in conducting the infringement. This element has been disallowed in one case; [34] but the same reasoning which justified the Supreme Court in allowing the members of a defendant corporation for their personal services, calls for the same allowance where the men who infringe, do so as partners or as individuals. Where a number of men form a corporation and, as such, infringe a patent by making and selling specimens of a patented thing, the Supreme Court approves a proper allowance for their labor, being made an element in the cost of those specimens, when those men are forced to pay over those profits to the patentee. There is the same reason for making the same allowance, where two such men make and sell such specimens as partners, or where one man does so alone. But it is the labor of the infringer in making or selling infringing articles, or in performing an infringing process, that is contemplated in this paragraph. Salaries which are received by partners in the place of partnership profits, or

[32] Rubber Co. *v.* Goodyear, 9 Wallace, 803, 1869; Hemolin Co. *v.* Harway Dyewood & Extract Co., 166 F. R. 434, 1908.

[33] Rubber Co. *v.* Goodyear, 9 Wallace, 803, 1869; American Nicholson Pavement Co. *v.* Elizabeth, 1 Bann. & Ard. 442, 1874; Steam Stone Cutter Co. *v.* Mfg. Co., 17 Blatch. 29, 1879; National Folding-Box & Paper Co. *v.* Dayton Paper Novelty Co., 95 F. R. 994, 1899.

[34] Williams *v.* Leonard, 9 Blatch. 476, 1872.

which are paid for a general oversight of partnership business, do not come in this category.[35]

4. Interest on borrowed money;[36] but not interest on capital stock; except where the property represented by the capital stock was used only in conducting the infringing business, or where the defendant clearly proves what portion of the value of that property was thus used, so as to enable an apportionment of interest to be made between the infringing business, and the other business contemporaneously conducted by the defendant.[37]

5. Expenses of selling, including advertising,[38] and commissions.[39]

6. Miscellaneous expenses equitably chargeable to the infringing business,[40] but not taxes and insurance unless paid on a plant devoted entirely to the infringing business.[41]

7. Royalties paid on other patents used in the infringing structure.[42]

A method of ascertaining the profits of a corporation infringer, which is approved, is to add to the total amount of the dividends such amounts as the corporation paid out other than in the conduct of its business.[43]

[35] Callaghan *v.* Myers, 128 U. S. 663, 1888.

[36] Rubber Co. *v.* Goodyear, 9 Wallace, 804, 1869.

[37] Seabury *v.* Am Ende, 152 U. S. 564, 1894; Western Glass Co. *v.* Schmertz Wire Glass Co., 226 F. R. 730, 1915.

[38] Rubber Co. *v.* Goodyear, 9 Wallace, 804, 1869; Manufacturing Co. *v.* Cowing, 105 U. S. 257, 1884; La Baw *v.* Hawkins, 2 Bann. & Ard. 566, 1877.

[39] Kissinger-Ison Co. *v.* Bradford Belting Co., 123 F. R. 94, 1903.

[40] Winchester Arms Co. *v.* American Cartridge Co., 62 F. R. 278, 1894; Piazet Novelty Co. *v.* Headley, 123 F. R. 897, 1903.

[41] Carborundum Co. *v.* Electric Smelting, etc., Co., 203 F. R. 976, 1913.

[42] Hermann *v.* Youngstown Car Mfg. Co., 216 F. R. 604, 1914.

[43] National Metal Weather Strip Co. *v.* Bredin, 186 F. R. 490, 1911.

§ 719. Where the thing made and sold by the defendant contained not only the invention of the complainant, but also some other invention or feature of ascertainable cost and provable value, the complainant except in design cases, can recover only that part of the defendant's profit which was due to the infringing parts or features of the thing made and sold by the defendant; and the burden was on the complainant to prove the amount of that part. At least such was the law[44] with some exceptions prior to the Supreme Court decision of Westinghouse Electric & Mfg. Co. *v.* Wagner Electric & Mfg. Co.[45] The exceptions mentioned held that this burden was imposed on the complainant only after the defendant had proven the existence of such features and that they affected the price of the infringing article.[46] Some cases made a distinction between an added device covered by a patent owned by a third party and an added unpatented feature, holding that in the former case the burden was on the defendant to show that part of his infringing device was manufactured under the patent to the third person, and that only in that event was the burden shifted to the complainant to prove the value of the added invention, but that if the added feature were unpatented the burden was on the com-

[44] Blake *v.* Robertson, 94 U. S. 733, 1876; Garretson *v.* Clark, 111 U. S. 120, 1884; Dobson *v.* Carpet Co., 114 U. S. 445, 1884; Dobson *v.* Dornan, 118 U. S. 17, 1885; Keystone Mfg. Co. *v.* Adams, 151 U. S. 147, 1894; Robbins *v.* Illinois Watch Co., 81 F. R. 957, 1897; Elgin Wind Power & Pump Co. *v.* Nichols, 105 F. R. 780, 1901; Westinghouse *v.* New York Air Brake Co., 115 F. R. 615, 1902; Baker *v.* Crane Co., 138 F. R. 60, 1905; Brown *v.* Lanyon, 179 F. R. 309, 1910; American Street F. M. Co. *v.* St. Louis Street F. M. Co., 192 F. R. 121, 1911.

[45] Westinghouse Electric & Mfg. Co. *v.* Wagner Electric & Mfg. Co., 225 U. S. 604, 1912.

[46] Canda Bros. *v.* Michigan Malleable Iron Co., 152 F. R. 178, 1907; McSherry Mfg. Co. *v.* Dowagiac Mfg. Co., 160 F. R. 948, 1908.

plainant not only to prove the value of the added feature but also to prove its existence in the first instance.[47] Other cases held that when the defendant refused to produce his books of account which would show the amount of the profits, or took improper methods to avoid responsibility or otherwise acted in bad faith, the burden was thrown on him to show any circumstances or features concerning the infringing article that contributed to the profits.[48]

Whatever the correct rule was prior to the Westinghouse Electric & Mfg. Co. case, that case finally settled the law determining on which party the burden of proof lay to separate profits obtained by a defendant on an article which contained features additional to those which infringed. The patent in that case covered an electrical apparatus known as a transformer or converter, the inventive feature of which consisted of a core composed of groups of thin metal plates so plugged apart as to leave open spaces in the core. The infringing device contained elements which were not included in the plaintiff's invention. Mr. Justice LAMAR, speaking for the court, in stating the rule of the case said:

"But when a case of confusion does appear—when it is impossible to make a mathematical or approximate apportionment—then from the very necessity of the case one party or the other must secure the entire fund. It must be kept by the infringer, or it must be awarded, by law, to the patentee. On established principles of equity, and on the plainest principles of justice, the guilty trustee cannot take advantage of his own wrong. The fact that

[47] Mast *v.* Superior Drill Co., 154 F. R. 45, 1907, and cases therein cited.

[48] Yesbera *v.* Hardesty Mfg. Co., 166 F. R. 120, 1908; Novelty Glass Mfg. Co. *v.* Brookfield, 170 F. R. 946, 1909.

he may lose something of his own is a misfortune which he has brought upon himself; and if, as argued, the fund may have been made by the use of other patents also, for which he may be liable in another case, it is again a misfortune which he has brought upon himself and an instance of a double wrong causing double liability. He cannot appeal to a court of conscience to cast the loss upon an innocent patentee and by judicial decree repeal the provision of Rev. Stat., Section 4921, which declares that in case of infringement the complainant shall be entitled to recover the 'profits to *be accounted* for by the defendant.'

"This conclusion is said to be in conflict with the Garretson and other decisions which, it is claimed, justify the conclusion that the defendant is entitled to retain all of the profits even where the patentee is unable to make an apportionment. Warren *v.* Keep, 155 U. S. 265. An analysis of the facts of those cases will show that they do not sustain so extreme a doctrine. For they deal with instances where the plaintiff apparently relied on the theory that the burden was on the defendant, and for that, or other reasons, made no attempt whatever to separate the profits. None of the cases cited discuss the rights of the patentee who has exhausted all available means of apportionment, who has resorted to the books and employees of the defendant, and by them, or expert testimony proved, that it was impossible to make a separation of the profits. This distinction, between difficulty and impossibility, is involved in the ruling by the Circuit Court of Appeals for the sixth circuit in Brennan & Co. *v.* Dowagiac Mfg. Co., 162 Fed. Rep. 472, 476, where the Garretson Case was distinguished, and the court said:

"In the present case the infringer's conduct has been such as to preclude the belief that it has derived no advantage from the use of plaintiff's invention. . . . In

these circumstances, upon whom is the burden of loss to fall? We think the law answers this question by declaring that it shall rest upon the wrongdoer, who has so confused his own with that of another that neither can be distinguished. It is a bitter response for the court to say to the innocent party, 'You have failed to make the necessary proof to enable us to decide how much of these profits are your own'; for the party knows, and the court must see, that such a requirement is impossible to be complied with. The proper remedy to be applied in such cases is that stated by Chancellor Kent in Hart *v.* Ten Eyck, 2 Johns. Ch. (N. Y.) 62, 108, where he said: 'The rule of law and equity is strict and severe on such occasion. . . . All the inconvenience of the confusion is thrown upon the party who produces it, and it is for him to distinguish his own property or lose it.'

"It may be argued that, in its last analysis, this is but another way of saying that the burden of proof is on the defendant. And no doubt such, in the end, will be the practical result in many cases. But such burden is not imposed by law; nor is it so shifted until after the plaintiff has proved the existence of profits attributable to his invention and demonstrated that they are impossible of accurate or approximate apportionment. If then the burden of separation is cast on the defendant it is one which justly should be borne by him, as he wrought the confusion."

It appears, therefore, from the opinion in the Westinghouse Electric & Mfg. Co. case that before the burden of separation of profits is shifted to the defendant, the plaintiff on his part must first show the impossibility of proving them. The evidence offered by the plaintiff in the Westinghouse case which was held sufficient to shift the burden from the plaintiff to the defendant, was supplied by wit-

nesses in the employ of the defendant, who kept the books, purchased the material, superintended the construction and affixed the price of the defendant's transformers, but who were not able to show what profits had been made and consequently were not able to show what part of the profits were contributable to the patent and what to the additions. The plaintiff, however, proved the existence of profits, and therefore as the court said: "It carried the burden imposed by law and established every element necessary to entitle it to a decree except one. As to that the act of the defendant had made it not merely difficult but impossible to carry the burden of apportionment." Other cases following the Westinghouse Electric & Mfg. Co. case are cited in the note.[49]

In any event the evidence of the complainant as to separation of profits need not be severely accurate and may be sufficient where it furnishes foundation for just inferences rather than certain knowledge.[50]

In Dowagiac Mfg. Co. *v.* Minnesota Plow Co.,[51] the court reiterated the rule laid down in the Westinghouse case, regarding the rule governing the burden of apportionment, saying: "But the plaintiff did not conform to this rule. It neither submitted evidence calculated to effect the apportionment nor attempted to show that it was impossible; and this, although the evidence upon the accounting went far toward showing that there was no real

[49] Carborundum Co. *v.* Electric Smelting & Aluminum Co., 203 F. R. 976, 1913; Van Brunt *v.* La Crosse Plow Co., 208 F. R. 281, 1913; Seegar Refrigerator Co. *v.* American Car & Foundry Co., 219 F. R. 565, 1915; Decker *v.* Smith, 225 F. R. 776, 1915.

[50] Adams *v.* Keystone Mfg. Co., 41 F. R. 597, 1890; Westinghouse Electric & Mfg. Co. *v.* Wagner Electric & Mfg. Co., 225 U. S. 604, 1912; Dowagiac Mfg. Co. *v.* Minnesota Moline Plow Co., 235 U. S. 641, 1915.

[51] Dowagiac Mfg. Co. *v.* Minnesota Plow Co., 235 U. S. 635, 1915.

obstacle to a fair apportionment. Certainly no obstacle was interposed by the defendant."

§ 720. Where the defendant made and sold the complainant's invention separately, as well as in connection with other inventions, the profit which he made on the separate sales, is the measure of that part which is to be credited to the complainant's invention, of the profit which the defendant made on the joint sales.[52] This is a fairer method of division in such a case, than would be a division of the gross profits in proportion to the comparative cost of the elements covered by the patent in suit, and those not so covered; because the comparative cost is not always the best evidence of the comparative utility of two devices, nor of the comparative profit at which they can be made and sold.[53]

§ 721. Where the defendant has paid or contracted to pay other patentees a royalty for that part of the thing made and sold by him, which is not covered by the complainant's patent, that royalty may be taken as the measure of that part of the gross profits due to that part of the article in suit.[54] But it seems that this rule is not to be applied in any case where the division of the profits can be made under the rule of the last section; because it may sometimes be that the profits due to that part of the infringing thing which is not covered by the complainant's patent, are larger than the royalty which the defendant had to pay for the right to make and sell that part.

§ 722. Where the thing made and sold by the defendant would be useless for its special purpose without the part

[52] Mason *v.* Graham, 23 Wallace, 276, 1874.

[53] Graham *v.* Mason, 1 Holmes, 89, 1872.

[54] Elizabeth *v.* Pavement Co., 97 U. S. 141, 1877; La Baw *v.* Hawkins, 2 Bann. & Ard. 565, 1877; Herman *v.* Youngstown Car Mfg. Co., 216 F. R. 604, 1914.

covered by the complainant's patent, or where no other known article would answer that purpose well enough to find purchasers; all the profits which the infringer derived from making and selling the entire thing are clearly due to the patented part, and are therefore recoverable by the complainant.[55]

§ 723. Where the profits due to the infringing, and those due to the non-infringing, elements of a defendant's article of manufacture and sale cannot be separated by any other rule, then the apportionment may be made by dividing the aggregate profits in proportion to the respective cost of the different parts. This method of making the division is based on the presumption that similar articles of merchandise are sold at a like percentage of profit on the cost of producing them. But this is not likely to be the fact where one of those articles is covered by a patent while the others are not so covered, because monopolies tend to enhance prices. This method of making the required division will therefore always be more favorable to the defendant than to the complainant; where no part of the article made and sold by the former is covered by a patent, except the part which is covered by the patent of the latter. The principle of this method was approved in Rubber Co. *v.* Goodyear,[56] though in that case it was applied to the work of dividing profits between things covered, and other things not covered, by the complainant's patent, instead of between parts of the same thing so covered, and other parts not so covered.

[55] Manufacturing Co. *v.* Cowing, 105 U. S. 256, 1881; Hurlbut *v.* Schillinger, 130 U. S. 456, 1889; Crosby Valve Co. *v.* Safety Valve Co., 141 U. S. 453, 1891; Wales *v.* Waterbury Mfg. Co., 101 F. R. 127, 1900; Coddington *v.* Propfe, 112 F. R. 1016, 1902; Piaget Novelty Co. *v.* Headley, 123 F. R. 897, 1903; Penfield *v.* Potts, 126 F. R. 475, 1903.

[56] Rubber Co. *v.* Goodyear, 9 Wallace,802, 1869.

§ 723*a*. In cases for infringement of design patents, a special statute provides that the total profits made from the manufacture or sale of the article or articles, to which the design, or a colorable imitation thereof, has been applied, shall be recoverable.[57] But in order to recover under this statute, the complainant must show that the defendant knew of the complainant's design, and knew of the complainant's patent, or at least knew of facts which put him upon his inquiry for that patent,[58] and knew that the design was applied to the infringing article, without the license of the owner of the patent.[59]

In suits on design patents as in others the plaintiff must if possible apportion the profits on the infringing articles if the entire profits are not due to the use of the patented invention.[60]

§ 724. Where the infringement consisted only in selling specimens of the article covered by the complainant's patent, the profits may be readily ascertained by deducting the cost of purchasing and selling the articles, from the amount received for them when sold. Where the subject-matter of the patent is a part of a larger article, and where a separate price is paid, and a separate price is obtained for it, the gross profit on the thing covered by the patent may be ascertained by deducting the former from the latter. But in such a case, the complainant is not entitled to recover the whole of that gross profit. It must be charged with such a proportion of the expenses incurred in selling the entire article, as the aggregate money re-

[57] 24 Statutes at Large, Ch. 105, p. 387; Untermeyer *v.* Freund, 58 F. R. 211, 1893; Ripley *v.* Elson Glass Co., 49 F. R. 927, 1892.

[58] Smith *v.* Stewart, 55 F. R. 484, 1893.

[59] Anderson *v.* Pittsburgh Lumber Co., 47 F. R. 68, 1891; Fuller *v.* Field, 82 F. R. 814, 1897.

[60] Bush & Lane Piano Co. *v.* Becker Bros., 234 F. R. 79, 1916.

ceived from the infringing device bears to the aggregate received for the entire apparatus or machine.[61] The principle of this rule is also applicable where the infringer made the articles he sold instead of buying them; and the rules applicable to the latter class of cases, and heretofore set forth, are applicable, with some reasonable modifications, to cases where the infringer bought the infringing articles which he sold, instead of making them himself.

§ 725. Where unlawful using of a patented article or process constitutes the infringement involved in an action in equity, the infringer's profits are ascertained by a rule quite different from either of the foregoing. That rule, in its generic character, may be formulated as follows: The advantage which the defendant derived from using the complainant's invention, over what he could have derived from using any other process or thing, which was known prior to that invention, constitutes the profits which the complainant is entitled to recover.[62] The other process or thing mentioned in the rule, is called the standard of comparison in the case. While that standard of comparison must have been known prior to the complainant's invention,[63] it needs not to have been open to the public at any time, except in the sense that it must be open to the public so far as the complainant's patent

[61] The Tremolo Patent, 23 Wallace, 528, 1874.

[62] Doten *v.* City of Boston, 138 F. R. 406, 1905; Fullerton W. G. Assn. *v.* Anderson-Barngrover Mfg. Co., 166 F. R. 443, 1908; Novelty Glass Mfg. Co. *v.* Brookfield, 170 F. R. 946, 1909; Brown Bag Filling Machine Co. *v.* Drohen, 175 F. R. 576, 1910; Columbia Wire Co. *v.* Kokomo Steel & Wire Co., 194 F. R. 108, 1911.

[63] Turrill *v.* Illinois Central R. R. Co., 20 F. R. 912; following Cawood Patent, 94 U. S. 710; and affirmed by Illinois Central R. R. Co. *v.* Turrill, 110 U. S. 302, 1884; Sessions *v.* Romadka, 145 U. S. 45, 1892; Lawther *v.* Hamilton, 64 F. R. 224, 1892.

in suit is concerned.[64] The advantage which is contemplated by the general rule, is the result of some superiority of the complainant's invention over the standard of comparison; and that superiority may consist in the fact that the complainant's invention performs the function common to both, with equal cheapness and greater excellence, or with greater cheapness and equal excellence, or with greater cheapness and greater excellence; and therefore the advantage may consist either in affirmative gain or in saving from loss, or in both of those elements.

§ 729. The advantage consists in an affirmative gain, in cases wherein the patented process or thing produces a valuable article from materials which otherwise would be useless, or, if useful at all, useful only for purposes of inferior value. The Goodyear process patent,[65] if it had been valid, would have been a patent of this sort, and would have been entitled to an account of profits ascertained according to the rule of Section 725. But as the only patent sustained in the Goodyear case was the patent for the product, and inasmuch as that patent was infringed by the defendant only in making and selling specimens of the invention it covered, the profits were ascertained on an entirely different plan.

§ 730. But the advantage consisted in saving from loss, in most of the cases which have been adjudicated under the general rule.

In Mowry *v.* Whitney,[66] the advantage was a saving of materials and labor, realized from the use of the complainant's process in manufacturing car-wheels, as compared with what it would have been necessary to expend

[64] McCreary *v.* Pennsylvania Canal Co., 141 U. S. 464, 1891.

[65] Rubber Co. *v.* Goodyear, 9 Wallace, 794, 1869.

[66] Mowry *v.* Whitney, 14 Wallace, 651, 1871.

in producing similar car-wheels, salable at the same price, without the use of that process. In the case of the Cawood Patent [67] the advantage was a saving of labor and of fuel, realized from the use of the complainant's swage-block in mending the exfoliated ends of iron railroad rails, as compared with the labor and fuel it would have been necessary to expend in mending those rails upon a common anvil.

In Mevs *v.* Conover,[68] the advantage was a saving of labor in splitting kindling-wood by means of the patented machine of the complainant, as compared with the labor which would have been required to split the same quantity of wood by hand, or by any other machine. The justice of the decision last cited has sometimes been questioned, on the ground that there was no actual profit made by the infringer in splitting the wood, and on the contention that he would not have split the wood at all, if he had been obliged to do so otherwise than by the patented machine, and that to save a man from a loss which he would not have incurred in any event, is not to confer a profit upon him, and therefore that savings ought not to be accounted as profits except where they result in actual gains. But the case as reported from the Circuit Court,[69] shows that the defendant did continue to split kindling-wood after the bringing of the suit caused him to discontinue the use of the complainant's invention for that purpose. It was probably necessary for him to do so, in order to hold his customers for other kinds of fuel. Therefore the case is not a precedent for the proposition that savings are profits, where there was no actual profit in the particular business

[67] Cawood Patent, 94 U. S. 709, 1876.

[68] Mevs *v.* Conover, 125 U. S. 144, 1876.

[69] Conover *v.* Mevs, 11 Blatch. 198, 1873.

in which the complainant's invention was used, and where there was no reason why the defendant should have pursued that business, if obliged to do so at a positive loss. It is entirely consistent with the principle of the general rule to hold that savings are profits, only so far as they result in affirmative gains from the particular business in which the infringer used the patented invention; unless that particular business was so necessary to the general business of the infringer, that he could have afforded to conduct it at an additional loss, at least equal to the saving he made from the use of the complainant's invention, and therefore presumably would have conducted it at that loss, if he had not used that invention.[70]

In Webster Loom Co. *v.* Higgins,[71] the advantage was a saving of machinery for weaving carpets; it appearing, in the aspect of the proofs most favorable to the complainant, that the defendants could have made all the carpeting they did make, if instead of using their sixty-one infringing looms, they had used twice that number of non-infringing looms. On this basis, the complainant contended that it was entitled to recover all the profits which were made by the defendants, on those yards of carpeting which they made on the sixty-one infringing looms, over and above the much smaller number of yards which they could have made on sixty-one non-infringing looms. But that contention was overruled by the court, on the ground that nothing hindered the defendants from using one hundred and twenty-two non-infringing looms, instead of sixty-one infringing looms, and that the cost of the use of whatever number of non-infringing looms would have been necessary to make the carpeting which was made on the sixty-one

[70] Celluloid Mfg. Co. *v.* Cellonite Mfg. Co., 40 F. R. 477, 1889; Tuttle *v.* Claflin, 62 F. R. 455, 1894.

[71] Webster Loom Co. *v.* Higgins, 43 F. R. 675, 1890.

infringing looms, was the proper standard of comparison in the case.

In Sessions *v.* Romadka,[72] the saving consisted in the difference between the cost of the patented trunk fasteners, which the defendant used in manufacturing trunks, and the greater cost of the straps, buckles, and dowels previously in use, in the place of those trunk fasteners.

§ 731. The advantage referred to, consisted both in affirmative gains and in savings from loss, in a number of important cases. In Tilghman *v.* Proctor,[73] it consisted in savings of lime and sulphuric acid; and in gain on account of the increased value of the glycerine obtainable by means of the complainant's invention, as compared with that obtainable by other processes. In Wetherill *v.* Zinc Co.[74] the advantage consisted in savings of coal and labor, in producing zinc oxide from zinc ore, as compared with the cheapest prior process of producing the same quantity of zinc oxide from the same kind of zinc ore.

§ 732. The standard of comparison set up by a defendant needs not to have been used by him at any time,[75] and where it never was so used, the evidence of its utility, as compared with the invention in suit, may be drawn from persons who have used the two under the same conditions;[76] or from any other source which is capable of furnishing convincing evidence upon the point. And even where the defendants have used the standard of comparison, they may show that it was used with better results by others, and may have the benefit of that superiority on the accounting.[77]

[72] Sessions *v.* Romadka, 145 U. S. 45, 1892.

[73] Tilghman *v.* Proctor, 125 U. S. 142, 1888.

[74] Wetherill *v.* Zinc Co., 1 Bann. & Ard. 486, 1874.

[75] Locomotive Safety Truck Co. *v.* Railroad Co., 2 F. R. 679, 1880.

[76] Emigh *v.* Railroad Co., 6 F. R. 283, 1881.

[77] Tilghman *v.* Proctor, 125 U. S. 150, 1888; but see Morgan Con-

§ 734. To determine what is the proper standard of comparison in a particular case, it is not necessary for the complainant to affirmatively prove that a particular process or thing was absolutely the next best to his invention, at the time of the infringement. Such a requirement would not be reasonable, because it could never be performed. It would involve evidence enough to negative the existence of a better process or thing than the one fixed upon; and to prove that nothing better existed anywhere, would be impossible. The regular course of practice on the point is for the complainant to select what appears to him to be the proper standard of comparison, and to produce evidence to prove what advantage the defendant derived from using the complainant's invention, over what he could have derived from using the standard so selected.

Where the defendant knows of no standard of comparison more favorable to himself than the one selected by the complainant, the only remaining issue relates to the utility and cheapness of that standard, as compared with the complainant's invention.[78] Where the defendant is not satisfied that the complainant has made the proper selection of a standard of comparison, he may select another, and may produce evidence to show its utility and cheapness as compared with that of the invention covered by the patent in suit; and when the case comes to a hearing before the master, the first question to be decided by him will be as to which of the parties has made the proper selection, and that standard will be used in the accounting, whether it was selected by the complainant or by the defendant; and all evidence about the merits of

struction Co. *v.* Forter-Miller Engineering Co., 234 F. R. 324, 1916.

[78] Emigh *v.* Railroad Co., 6 F. R. 285, 1881.

the other proposed standard will become and remain immaterial to the case.[79]

The true standard of comparison in a particular case is that prior process or thing which, next to the complainant's invention, could have been most advantageously used by the defendant in place of that invention, at the time he used the latter.[80] To determine this point, comparative utility is one guide, but regard must also be had to comparative cost, for the advantage contemplated by the general rule of Section 725 is the equalized result of both these elements.[81]

§ 734*a*. Where the machine used by the defendant, differed from the patented invention, only in the substitution of equivalents, the defendant's machine is treated, in respect of profits, as if it were the unchanged invention of the complainant; but where the defendant's machine contained an improvement upon the complainant's invention, the defendant is entitled to be credited with whatever contribution that improvement made to the profit realized from the defendant's use of the entire machine.[82] This rule applies to accountings for profits derived from infringing patents on processes or other subjects of patents, as well as to profits derived from infringing patents on machines.

§ 735. The rule of Section 725 has no application to those cases of infringement which consist in making and selling a patented article, or in the latter of those acts alone;

[79] Webster Loom Co. *v.* Higgins, 39 F. R. 465, 1889.

[80] Brown *v.* Lanyon, 179 F. R. 309, 1910; Columbia Wire Co. *v.* Kokomo Steel & Wire Co., 194 F. R. 108, 1911; Schmerz Wire Glass Co. *v.* Western Glass Co., 203 F. R. 1006, 1913; Cambria Iron Co. *v.* Carnegie Steel Co., 224 F. R. 947, 1915.

[81] Brickill *v.* New York, 112 F. R. 71, 1901.

[82] Tuttle *v.* Claflin, 76 F. R. 233, 1896.

See Section 719.

except where a patented article is used as a component part of a much larger article which is made and sold by the infringer.[83] In Elizabeth *v.* Pavement Co. the infringement consisted only in making the patented pavement to order; that is to say, it consisted in making and selling the patented article. The defendants sought to have the profits determined, under the rule of Section 725, by setting up other pavements as standards of comparison, but the Supreme Court held their position on the point to be without foundation.[84] The same rule was also unsuccessfully invoked in the case of Burdett *v.* Estey, though the argument in favor of its application was supported by evidence that the defendant might have made and sold a different device, at nearly or quite the same profit that he derived from making and selling the device covered by the complainant's patent.[85]

§ 736. Interest on infringer's profits is allowed from the date of the master's report, which ascertains the amount of those profits;[86] or from the date of their first judicial ascertainment, in cases where they are first ascertained by the court.[87] Interest is in the discretion of the court.[88]

§ 739. After an interlocutory decree is entered, directing a master commissioner of the court to take and report an account of the defendant's profits, or appointing a master *pro hac vice* for that purpose, it becomes the business of the complainant to introduce evidence before such mas-

[83] Sessions *v.* Romadka, 145 U. S. 48, 1892.

[84] Elizabeth *v.* Pavement Co., 97 U. S. 141, 1877.

[85] Burdett *v.* Estey, 3 F. R. 569, 1880.

[86] Tilghman *v.* Proctor, 125 U. S. 160, 1887; Crosby Valve Co. *v.* Safety Valve Co., 141 U. S. 457, 1891; National Folding Box Co. *v.* Dayton Paper Novelty Co., 97 F. R. 331, 1899.

[87] Campbell *v.* New York, 105 F. R. 631, 1900; Western Glass Co. *v.* Schmertz Wire Glass Co., 226 F. R. 730, 1915.

[88] Cambria Iron Co. *v.* Carnegie Steel Co., 224 F. R. 947, 1915.

ter to prove the amount of those profits. The complainant must take the initiative. It is not the province of the master to suggest any line of proof or theory of accounting. His function is to pass upon whatever evidence the complainant produces, in the light of whatever is produced by the defendant.[89] Each party must in the first instance pay the costs and expenses made by himself, including fees of the master and stenographer,[90] and must be borne by the defendant in the final taxation of costs, if he is finally defeated,[91] but must be borne by the complainant if the bill is finally dismissed.[92]

Equity Rule 63 (former Equity Rule 79) provides that "all parties accounting before a master shall bring in their respective accounts in the form of debtor and creditor; and any of the other parties who shall not be satisfied with the accounts so brought in shall be at liberty to examine the accounting party *viva voce*, or upon interrogatories as the master shall direct." It is customary, at the commencement of accounts, for the master to issue a summons directing the defendant to bring in a sworn statement of the infringing devices which have been manufactured and sold by him, together with other data which will enable the plaintiff to establish his case. The validity of this practice has, however, been doubted, but was considered favorably in the Matter of Beckwith, by the Circuit Court of Appeals of the seventh circuit.[93] Objection was taken on the ground that a statement of profits by an infringing defendant was incapable of being put in the form

[89] Garretson *v.* Clark, 4 Bann. & Ard. 537, 1879.

[90] Panoulias *v.* National Equipment Co., 227 F. R. 1008, 1915.

[91] Urner *v.* Kayton, 17 F. R. 539, 845, 1883.

[92] American Diamond Drill Co. *v.* Machine Co., 32 F. R. 552, 1885.

[93] *In re* Beckwith, 203 F. R. 45, 1913.

of debtor and creditor, but the Court of Appeals said: "Nevertheless they are plainly capable of specification in the form of debits and credits for the purpose of accounting, and the complications mentioned, together with the fact that the items are within the exclusive knowledge and possession of the defendant furnish ample ground for such specification in conformity with the equity rule. It cannot reasonably be assumed that these items entering into the cost appear in detail in the ordinary books of account; but in whatever form the information is preserved or may be obtained by the manufacturer, we believe it to be both the purpose of the rule and in accord with equity, to require the defendant, at the outset of the accounting, to make the needful investigation and state the items in detail—having effect, as well, of his admissions of fact and of statements under oath—and thus perform his just part in narrowing the issue upon the accounting to items and matters which are in actual controversy between the parties."

In Beckwith *v.* Malleable Iron Range Co.,[94] the practice governing the proceedings on accounting before the master is reviewed and the scope of the master's investigation defined, the court holding that it is improper in advance of the submission of the account to compel the defendant to furnish detailed calculations the effect of which would be evidential only and restricting the scope of the requirements of the summons to an account in debtor and creditor form, exhibiting the matters which were the subject of the accounting, namely, on the one hand the sums chargeable, the manufacture and sales, the amounts received, and on the other hand the items of credit or offset such as cost of material, manufacture of the goods and the like. The object was said to be to give the plaintiff an

[94] Beckwith *v.* Malleable Iron Range Co., 207 F. R. 848, 1913.

opportunity of taking exception to items appearing in the account and to thus limit the scope of the investigation to contested matters, the reason being given that it could not be presumed in advance that the account when filed would be disputed or would give rise to dissatisfaction.

§ 740. The evidence upon which the master may base his report, may consist of any evidence taken in the case prior to the interlocutory decree,[95] and of documents introduced, and depositions taken, by the parties for the express purpose of the accounting, and of testimony taken *viva voce* in the presence of the master,[96] anywhere in the world,[97] and of personal examination by him of the structure or processes which are involved in the questions before him.[98] If the required documents are not produced voluntarily, the master may require their production; and any necessary depositions may be taken upon commissions to be issued upon his certificate, from the clerk's office, or they may be taken according to the acts of Congress.[99]

When testimony is taken *viva voce* before a master, either party may require that it be taken down in writing, in order that, if necessary, it may be used by the court.[100] In the use of books and papers of the defendant the master of course as in all other cases will give due consideration to the rights which the defendant has that his books and papers be subjected to scrutiny only so far as they are material to the issues.[101] In the course of an accounting before a master, that officer has full authority to do all acts and to direct all proceedings which he may deem neces-

[95] Equity Rule 80; Bell *v.* Stamping Co., 32 F. R. 549, 1887.

[96] Equity Rule 77.

[97] Bate Refrigerating Co. *v.* Gillette, 28 F. R. 673, 1886.

[98] Piper *v.* Brown, 1 Holmes, 198, 1873.

[99] Equity Rule 77; Revised Statutes, Sections 863, 864, and 865; Section 535 of this book.

[100] Rollman Mfg. Co. *v.* Universal Hardware Works, 218 F. R. 651, 1914.

[101] Equity Rule 81.

sary and proper to the justice and merits of the case.[102] If, for example, an account to be transcribed or deduced from the defendant's books, is necessary to a just decision of the cause, the master may make an order that the defendant furnish such an account by a certain day; and such an order, when served on the defendant by any disinterested person, must be obeyed, or the defendant will be guilty of contempt of court for not obeying it.[103]

§ 741. Objections to evidence, in order to be availing, must be made when the objectionable piece of evidence is offered, or the objectionable question is put, or the objectionable answer is given. If the master is present at the time, he ought to rule upon the objection at once, and if either party would appeal from that ruling, he must enter an immediate objection thereto.

If the ruling is against the evidence objected to, it is necessary for the party who offers the evidence, if he would appeal from the ruling, to do so by an immediate motion to the court to direct the master to reverse his decision upon the point.[104] The reason for this practice is that if such an appeal could be taken in an exception to the master's report, it would, when taken successfully, necessitate a recommittal of the case to the master, in order to enable him to admit the evidence which he erroneously rejected.

If the master's ruling is in favor of the evidence objected to, that evidence will of course be admitted subject to the objection, and that ruling may be reviewed by the court on exceptions to the report of the master, as well as by means of an immediate motion. It may be reviewed on exceptions, because, if it is reversed, that reversal will not necessitate any addition to the evidence before the court, but

[102] Equity Rule 77.

[103] Kerosene Lamp Heater Co. *v.* Fisher, 5 Bann. & Ard. 79, 1880.

[104] Celluloid Mfg. Co. *v.* Cellonite Mfg. Co., 40 F. R. 477, 1889.

will merely cause the court to eliminate the objectionable evidence from among the factors of the problems before it.

If the master is not present when the cause of an objection arises, the practice is for the notary or other magistrate who is taking the deposition, to note the objections thereon, and to take down the evidence objected to; for he has no authoirty to make any ruling. In such cases the objections which are noted upon the depositions, may be brought to the attention of the master on the argument before him, and his specific rulings thereon may be required, and those rulings may be reviewed by the court, on exceptions to the report of the master, as far as they have affected that report. Most of the points stated in this section are contained in an excellent decision of Judge W. D. SHIPMAN,[105] and the residue are deducible from that decision, or from plain principles of practice.

§ 742. The extent of the defendant's infringement must be determined by the master in order to enable him to ascertain the amount of the profits which the defendant derived from that infringement. Where the infringement was all alike, or where the interlocutory decree specifies the particular doings of the defendant which are to be accounted for as infringements, the only question for the master to decide on this point is a question of quantity. But where the interlocutory decree merely directs the master to take and report an account of the profits which the defendant derived from infringing the complainant's patent, and where the complainant claims that certain doings of the defendant which were not proved prior to the interlocutory decree, constitute such an infringement, it becomes the duty of the master to decide the question of infringement involved.[106]

[105] Troy Iron & Nail Factory *v.* Corning, 6 Blatch. 333, 1869.

[106] Knox *v.* Quicksilver Mining Co., 6 Sawyer, 436, 1878; Ball

Nor would it be unprecedented for a court, when directing a master to take and report an account of infringer's profits, to direct him also to decide and report which of various machines used by the defendant, were infringements of the complainant's patent, and to make up his account accordingly,[107] or for the master to spontaneously report upon a form of infringement which was not previously before the court.[108] In fact such is the rule at any rate in the second circuit [109] and in the first circuit.[110] But the most convenient and least expensive practice is for the court to decide all questions of infringement, before entering an interlocutory decree. In some jurisdictions it is held to be the only proper practice to bring in all additional infringements by supplemental bill.[111]

§ 743. Where the alleged infringements involved in a suit, are of several sorts, the master generally ought to report in a separate item the profits due to each kind; so that the District Court on exceptions, or a higher court on an appeal, may render a decree for part or for all of those items, according to its decision upon the questions of infringement involved. This is but a rule of convenience, and may be departed from when convenience would thus be better served. Where the defendant used two different sorts of machines, both of which the complainant

Glove Fastening Co. *v.* Socket Fastener Co., 53 F. R. 245, 1892; Fenton Metallic Mfg. Co. *v.* Office Specialty Co.; 12 App. D. C. 221, 1898; Hoe *v.* Scott, 87 F. R. 220, 1898.

[107] Cawood Patent, 94 U. S. 708, 1876.

[108] Adams *v.* Keystone Mfg. Co., 41 F. R. 596, 1890; Walker Patented Pivoted Bin Co. *v.* Miller, 146 F. R. 249, 1906; Brown Bag-Filling Mach. Co. *v.* Drohen, 171 F. R. 438, 1909.

See Sections 625 and 708.

[109] Louis Metzger & Co. *v.* Berlin, 194 F. R. 426, 1912.

See Sections 625 and 708.

[110] L. S. Starrett Co. *v.* Brown & Sharpe Mfg. Co., 208 F. R. 887, 1913.

See Sections 625 and 708.

[111] Murray *v.* Orr & Lockett Hardware Co., 153 F. R. 369, 1907.

claims infringe his patent, if the points upon which those questions of infringement depend, are apparently the same in both cases, and if the two sorts of machines were so used by the defendant, that it would be difficult to separate the profits derived from the use of one from those flowing from the use of the other, it will be most convenient not to attempt to do so. In such a case there is but little probability that the courts will hold one of the two sorts of machines to infringe, while holding that the other does not, and there is correspondingly little probability that a necessity will arise for a division of the profits due to the use of the two kinds.

§ 744. A draft report of a mastery in chancery, is one which the master draws up after the testimony has all been taken, and the parties have been heard in argument on that testimony, and the master has formed an opinion on the questions involved in the reference before him. Such a report is requisite to enable the parties to correct any misapprehension into which the master may have fallen, without the alternative necessity of presenting the point to the court. When completed, such a report is either filed in the case, or served on the parties or their solicitors; and it thereupon devolves upon any party who is dissatisfied with the master's finding, to file such exceptions to his draft report, as will call his attention to each alleged error of which the dissatisfied party proposes to complain.[112] It then becomes the duty of the master to consider or reconsider the questions involved in those exceptions, and thereupon to prepare and file his final report in the case.

The final report will be identical with the draft report, if the consideration of the exceptions to the earlier document fails to convince the master that it was wrong; but if he is so convinced, he will concert his final report in such

[112] Fischer *v.* Hayes, 16 F. R. 469, 1883.

a manner as to make it embody his changed opinion.[113] No new evidence can be introduced before a master after he has made his draft report;[114] the proceedings upon exceptions thereto, being in the nature of a rehearing for errors apparent on the face of the record. According to strict equity practice, it is necessary to give a master this opportunity to correct his findings, in order to save time and labor of the judge.[115] This point of practice has sometimes been omitted by counsel in patent cases, and its omission been condoned by opposing counsel or by the court.[116] But it is not safe to omit the filing of such exceptions with the master, for the rule which requires them, is always liable to be enforced, and the enforcement consists in the court disregarding every exception to a master's final report, which was not taken before the master himself, by way of exceptions to his draft report.[117]

A final report of a master is advisory to the court;[118] but its advice is confined to the points which the interlocutory decree directed him to ascertain, and may not properly include any criticism of that decree, or any suggestion of any judicial action to be taken relevant to the report.[119] Though the conclusions of fact stated in the final report of a master will not be reviewed otherwise than on exceptions thereto,[120] its conclusions of law will

[113] Sugar Refinery Co. *v.* Mathiesson, 3 Cliff. 149, 1868; Troy Iron & Nail Factory *v.* Corning, 6 Blatch. 332, 1869.

[114] Piper *v.* Brown, 1 Holmes, 196, 1873.

[115] Story *v.* Livingston, 13 Peters, 366, 1839; Topliff *v.* Topliff, 145 U. S. 172, 1892.

[116] Fischer *v.* Hayes, 16 F. R. 469, 1883; Jennings *v.* Dolan, 29 F. R. 861, 1887.

[117] McMickin *v.* Perin, 18 Howard, 510, 1855; Troy Iron & Nail Factory *v.* Corning, 6 Blatch. 333, 1869; Celluloid Mfg. Co. *v.* Cellonite Mfg. Co., 40 F. R. 476, 1889.

[118] Boesch *v.* Graff, 133 U. S. 705, 1890.

[119] Jennings *v.* Rogers Silver Plate Co., 118 F. R. 340, 1902.

[120] Topliff *v.* Topliff, 145 U. S. 172, 1892.

be verified or corrected by the court, before any final decree is based thereon.[121]

§ 745. Exceptions to masters' reports ought to be aimed with precision at the errors which such reports are alleged to contain.[122] Such exceptions may be filed by the complainant, if he thinks that the master has erred in not finding any profits, or in not finding any damages, or in finding either of those foundations of recovery to have been smaller than the evidence would warrant; and such exceptions may be filed by the defendant, if he thinks that the master erred in finding profits or in finding damages to an amount in excess of what the evidence can sustain.

§ 746. Defendants' exceptions to masters' reports are divisible into four classes. 1. Exceptions which state that there is evidence in the case, proving that the defendant derived no profit, and that the complainant sustained no damage, on account of the infringement. 2. Exceptions which state that there is evidence in the case proving that the master's finding of profits or of damages, is too large in amount. 3. Exceptions which deny that there is any admissible evidence in the case proving that the defendant derived profit, or that the complainant sustained damage, on account of the infringement. 4. Exceptions which deny that there is any admissible evidence in the case proving that the defendant derived profit, or that the complainant sustained damage, on account of the infringement, to so great an amount as the master reported.

The first two of these classes of exceptions rely upon affirmations, and the last two rely upon negations, of definite points of fact. For the purposes of the present explanation, the four classes may be treated in two groups:

[121] Celluloid Mfg. Co. *v.* Cellonite Mfg. Co., 40 F. R. 477, 1889.

[122] Sheffield Ry. Co. *v.* Gordon, 151 U. S. 290, 1894.

those which are affirmative requiring one sort of management in practice, and those which are negative requiring another.

§ 747. Defendant's affirmative exceptions to a draft report, must specify the particular evidence upon which they are respectively based. If this rule were otherwise, such an exception would not point out error, and would therefore fail to perform its only function. Defendant's affirmative exceptions to a final report, must be supported by reference to the particular evidence upon which the exceptor relies; or by such special statements of the master, as justify the exceptor in affirming the existence of the particular facts upon which he relies to support such exceptions. Were the court required to wander at large into the evidence which was before the master, the reference to him would be of little value. Indeed that evidence need not be reported, further than it is relied upon to support, explain, or oppose a particular exception;[123] and there is no presumption in any case, in the absence of a certificate, that the master reported to the court all the evidence which was before him.[124]

§ 748. Defendant's negative exceptions are those which call in question the admissibility of the evidence upon which the master based his finding, and those which deny the presence in the record of any evidence sufficient to support that conclusion. An exception of the first of these sorts, so far partakes of the nature of an affirmative exception, that it ought to specify the particular evidence objected to, so that the master, on exceptions to his draft report, or the court, on exceptions to the final report of the master, may have a precise issue in the law of evidence presented for decision. But an exception of the second

[123] Harding *v.* Handy, 11 Wheaton, 126, 1826.

[124] Sheffield Ry. Co. *v.* Gordon, 151 U. S. 293, 1894.

of these kinds cannot be expected to specify any particular evidence, because it assumes that there is none in the record. In such a case, the proper practice is for the exceptor to require the master to make a special statement, in his final report, of the particular evidence which convinced his judgment, and to transmit that evidence with his report into court.[125]

§ 749. Complainants' exceptions to a master's report may be of two classes. 1. Exceptions which state that there is evidence in the case proving that the defendant derived larger profits, or that the complainant sustained larger damages than the master reported. 2. Exceptions which state that the master erred in admitting inadmissible evidence. Both of these sorts are affirmative in their nature, and when made to a draft report, must therefore be supported by references to the particular evidence upon which the exceptor relies, or by reference to the particular evidence which he claims was improperly admitted against his objection, as the case may happen to require. When made to a final report, a complainant's exceptions, like the affirmative exceptions of a defendant, must be supported either by references to the particular evidence involved, or be based upon such special statements of the master as will obviate that necessity.

§ 750. The system of practice relevant to a master's finding, appears to present the following outlines, when reviewed as a whole. It is a master's function to investigate the questions which are referred to him by the court, and to investigate no others. To that end, he takes testimony and receives other evidence, and decides what conclusions are justified thereby; and those conclusions will

[125] *In re* Hemiup, 3 Paige (N. Y.), 307, 1832; Greene *v.* Bishop, 1 Cliff. 195, 1858; The Commander-in-Chief, 1 Wallace, 50, 1863.

stand unless they are clearly erroneous.[126] Unless the court otherwise directs, the master's draft report should contain those conclusions alone; and his final report should contain only his final conclusions, together with such statements of fact and statements and pieces of evidence as the parties lawfully require him to attach thereto. Where the exceptions to the draft report involve no issue save such as pertain to the admissibility of particular evidence, nothing need accompany the final report except the evidence objected to, and a statement of the ground upon which it was admitted. Where those exceptions merely affirm the presence of evidence requiring a different conclusion from that of the master, nothing need accompany the final report save the particular evidence which those exceptions specify in that behalf. Where those exceptions merely deny the presence of evidence to justify the draft report, nothing need accompany the final report save the evidence which carried the master to the conclusion at which he arrived. Where a master receives no direction from the court, and no request from either of the parties, to report any evidence, his report contains nothing but his finding, and his finding is conclusive.[127]

[126] Tilghman *v.* Proctor, 125 U. S. 149, 1887; Callaghan *v.* Myers, 128 U. S. 666, 1888; Kimberly *v.* Arms, 129 U. S. 512, 1889.

[127] Harding *v.* Handy, 11 Wheaton, 126, 1826; The Commander-in-Chief, 1 Wallace, 50, 1863; *In re* Hemiup, 3 Paige (N. Y.), 307, 1832; Dexter *v.* Arnold, 2 Sumner, 131, 1834; Donnell *v.* Insurance Co., 2 Sumner, 371, 1836; Boston Iron Co. *v.* King, 2 Cushing (Mass.), 405, 1848; Adams *v.* Brown, 7 Cushing (Mass.), 222, 1851; Howe *v.* Russell, 36 Maine, 127, 1853; Sparhawk *v.* Wills, 5 Gray (Mass.), 431, 1855; Greene *v.* Bishop, 1 Cliff. 195, 1858; Mason *v.* Railroad Co., 52 Maine, 115, 1861; Piper *v.* Brown, 1 Holmes, 198, 1873; Hammacher *v.* Wilson, 32 F. R. 797, 1887; Keep *v.* Fuller, 42 F. R. 896, 1890; Rollman Mfg. Co. *v.* Universal Hardware Works, 229 F. R. 579, 1916.

APPENDIX

THE PATENT STATUTES

PATENT ACT OF 1790

1 STATUTES AT LARGE, 109

An Act to promote the progress of useful Arts

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That upon the petition of any person or persons to the Secretary of State, the Secretary for the Department of War, and the Attorney-General of the United States, setting forth that he, she, or they hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the Department of War, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters-patent to be made out in the name of the United States, to bear teste by the President of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending

to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters-patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent 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 of manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; which specifications shall be filed in the office of the said Secretary, and certified copies thereof shall be competent evidence in all courts and before all jurisdictions, where any matter

or thing, touching or concerning such patent, right, or privilege shall come in question.

SECTION 3. *And be it further enacted*, That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such a copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

SECTION 4. *And be it further enacted*, That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine or device, or any invention or improvement upon, or in any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators, or assigns, first had and obtained in writing, every person so offending shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators, or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved, the thing or things so devised, made, constructed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act.

SECTION 5. *And be it further enacted*, That upon oath or affirmation made before the judge of the district court where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said

patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants shall be recovered in due course of law.

SECTION 6. *And be it further enacted*, That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers, of the thing so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning

his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

SECTION 7. *And be it further enacted*, That such patentee as aforesaid shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifications, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

APPROVED April 10, 1790.

Repealed February 21, 1793. 1 Statutes at Large, Chap. 11, Section 12, p. 323.

PATENT ACT OF 1793

1 STATUTES AT LARGE, 318

An Act to promote the progress of useful Arts; and to repeal the act heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine,

manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

SECTION 2. *Provided always, and be it further enacted,* That any person who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which shall have been patented, and shall have obtained a patent for such improvement, he shall not be at liberty to make, use, or vend the

original discovery, nor shall the first inventor be at liberty to use the improvement: And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery.

SECTION 3. *And be it further enacted,* That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself, and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

SECTION 4. *And be it further enacted*, That it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree.

SECTION 5. *And be it further enacted*, That if any person shall make, devise, and use, or sell the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum that shall be at least equal to three times the price for which the patentee has usually sold or licensed, to other persons, the use of the said invention, which may be recovered in an action on the case founded on this act, in the circuit court of the United States, or any other court having competent jurisdiction.

SECTION 6. *Provided always, and be it further enacted*, That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing thus secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public

work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

SECTION 7. *And be it further enacted*, That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any 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 of 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 choose an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall

not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

SECTION 10. *And be it further enacted*, That upon oath or affirmation being made before the judge of the district court where the patentee, his executors, administrators, or assigns, reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterward, it shall and may be lawful for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator, or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators, or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law.

SECTION 11. *And be it further enacted*, That every inventor, before he presents his petition to the Secretary of State, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the Secretary of State, when he presents his petition;

and the money thus paid shall be in full for the sundry services to be performed in the office of the Secretary of State, consequent on such petition, and shall pass to the account of clerk-hire in that office: *Provided nevertheless*, That for every copy, which may be required at the said office, of any paper respecting any patent that has been granted, the person obtaining such copy shall pay, at the rate of twenty cents, for every copy-sheet of one hundred words, and for every copy of a drawing, the party obtaining the same, shall pay two dollars, of which payments an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

SECTION 12. *And be it further enacted*, That the act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An act to promote the progress of useful arts," be, and the same is hereby, repealed: *Provided always*, That nothing contained in this act shall be construed to invalidate any patent that may have been granted under the authority of the said act; and all patentees under the said act, their executors, administrators, and assigns, shall be considered within the purview of this act, in respect to the violation of their rights: provided such violations shall be committed after the passing of this act.

APPROVED February 21, 1793.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

PATENT ACT OF 1794

1 Statutes at Large, 393

An Act supplementary to the act intituled "An act to promote the progress of Useful Arts."

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That all suits, actions, process and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An act to promote the progress of useful arts," which may have been set aside, suspended or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said court, to the same situation in which they may have been when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process or proceedings be, and are hereby, entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place: *Provided always*, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding as is used in other cases for compelling the appearance of a party.

Approved June 7, 1794.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

PATENT ACT OF 1800

2 STATUTES AT LARGE, 37

An Act to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That all and singular the rights and privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries, and improvements, by the act 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 afterwards appear had been known or used previous to such application for a patent, shall be utterly void.

SECTION 2. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, 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 the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum equal to three times the actual damage sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offence, which sum shall and may be recovered by action on the case founded on this and the above-mentioned act, in the circuit court of the United States, having jurisdiction thereon.

SECTION 4. *And be it further enacted*, That the fifth section of the above-mentioned act, intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby is, repealed.

APPROVED April 17, 1800.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

PATENT ACT OF 1819

3 STATUTES AT LARGE, 481

An Act to extend the jurisdiction of the circuit courts of the United States to cases arising under the law relating to patents.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the circuit courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided however*, That from all judgments and decrees of any circuit courts rendered in the premises, a writ of error or appeal, as the case may require, shall

lic to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such circuit courts.

APPROVED February 15, 1819.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

PATENT ACT OF JULY 3, 1832

4 STATUTES AT LARGE, 559

An Act concerning patents for useful inventions

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

SECTION 2. *And be it further enacted*, That application to Congress to prolong or renew the term of a patent shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the State or Territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be ac-

companied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

SECTION 3. *And be it further enacted*, That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided however*, That such new patent so granted shall, in all respects, be liable to the same matters of objection and 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.

APPROVED July 3, 1832.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

PATENT ACT OF JULY 13, 1832

4 STATUTES AT LARGE, 577

An Act concerning the issuing of patents to aliens, for useful discoveries and inventions

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended in like manner to every alien who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided,* That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same for any period of six months after such introduc-

tion 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 to the earliest period within which he shall be entitled to become a citizen of the United States.

APPROVED July 13, 1832.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

PATENT ACT OF 1836

5 STATUTES AT LARGE, 117

An Act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be established and attached to the Department of State an office to be denominated the Patent Office; the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said Commissioner shall receive the same compensation as is allowed by law

to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

SECTION 2. *And be it further enacted*, That there shall be in said office an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, and to be called the Chief Clerk of the Patent Office; who in all cases during the necessary absence of the Commissioner, or when then said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner during such vacancy. And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger at seven hundred dollars. And said Commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be granted.

SECTION 3. *And be it further enacted*, That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon the duties of his office or appointment, make oath or affirmation truly and faithfully to execute the trust committed to him. And the said Commissioner and the chief clerk shall also, before

entering upon their duties, severally give bonds, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

SECTION 4. *And be it further enacted*, That the said Commissioner shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant under the signature of the chief clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office, on paying for the written copies the sum of ten cents for every page of one hundred words; and for copies of drawings the reasonable expense of making the same.

SECTION 5. *And be it further enacted*, That all patents issued from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the Secretary of State, and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, and in its terms grant to the applicant

or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery, referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery.

SECTION 6. *And be it further enacted*, That any person or persons, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; 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 other inventions; and shall particularly specify and point out the part, im-

provement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.

SECTION 7. *And be it further enacted*, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be suffi-

ciently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor, or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and 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. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claims for a patent, with or without any alteration in his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or

affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any

unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent to be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

SECTION 9. *And be it further enacted*, That before any application for a patent shall be considered by the Commissioner as aforesaid, the applicant shall pay into the treasury of the United States, or into the Patent Office, or into any of the deposit banks, to the credit of the treasury, if he be a citizen of the United States, or an alien, and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention

to become a citizen thereof, the sum of thirty dollars; if a subject of the king of Great Britain, the sum of five hundred dollars; and all other persons the sum of three hundred dollars; for which payment duplicate receipts shall be taken, one of which to be filed in the office of the Treasurer. And the moneys received into the treasury under this act shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office, and to be called the patent fund.

SECTION 10. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent shall devolve on the executor or administrator of such person, in trust for the heirs at law of the deceased, in case he shall have died intestate: but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

SECTION 11. *And be it further enacted*, That every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right, under any patent, to make and use, and to grant to others to make and use the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Pat-

ent Office within three months from the execution thereof, for which the assignee or grantee shall pay to the Commissioner the sum of three dollars.

SECTION 12. *And be it further enacted*, That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to make the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of the Commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: *Provided*

however, That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person, interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

SECTION 13. *And be it further enacted*, That whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new; if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing as though the same had been originally filed in such corrected form, before the issuing out of the original patent. And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of

his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars as hereinbefore provided, have the same annexed to the original description and specification; and the Commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall thereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification.

SECTION 14. *And be it further enacted*, That whenever, in any action for damages for making, using, or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case, with costs; and such damages may be recovered by action on the case, in any court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.

SECTION 15. *And be it further enacted*, That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains

more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery thereof by the patentee, or had been in public use or on sale with the consent and allowance of the patentee before his application for a patent, or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same; or that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; in either of which cases judgment shall be rendered for the defendant with costs. And whenever the defendant relies in his 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: *Provided however*, That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication. *And*

provided also, That whenever the plaintiff shall fail to sustain his action on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court to adjudge and award as to costs, as may appear to be just and equitable.

SECTION 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the ac-

tion and those deriving title from or under them subsequent to the rendition of such judgment.

SECTION 17. *And be it further enacted*, That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the power and jurisdiction of a circuit court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: *Provided however*, That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.

SECTION 18. *And be it further enacted*, That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section

of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use

the thing patented, to the extent of their respective interests therein: *Provided however*, That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

SECTION 19. *And be it further enacted*, That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

SECTION 20. *And be it further enacted*, That it shall be the duty of the Commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be, deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

SECTION 21. *And be it further enacted*, That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: *Provided however*, That all actions and processes in law or equity sued out prior to the passage of this act may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto; *And provided also*, That all applications or

petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof.

APPROVED July 4, 1836.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230. Section 111, p. 216.

PATENT ACT OF 1837

5 STATUTES AT LARGE, 191

An Act in addition to the act to promote the progress of science and useful arts

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim and drawings annexed or belonging to the same; and it shall be the duty of the Commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed and copied into books of record to be kept for that purpose; and wherever a drawing was not originally annexed to the patent and referred to in the

specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require, may be transmitted and placed on file, or copied as aforesaid, together with certificate of the oath; or such drawings may be made in the office, under the direction of the Commissioner, in conformity with the specification. And it shall be the duty of the Commissioner to take such measures as may be advised and determined by the Board of Commissioners provided for in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States, to transmit as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office; and also to make out and transmit to said Commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing. which shall be specially required by said Commissioner.

SECTION 2. *And be it further enacted*, That copies of such record and drawings, certified by the Commissioner, or, in his absence, by the chief clerk, shall be *prima facie* evidence of the particulars of the invention and of the patent granted therefor in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals; and no patent issued prior to the aforesaid fifteenth day of December shall, after the first day of June next, be received in evidence in any of the said courts in behalf of the patentee or other

person who shall be in possession of the same, unless it shall have been so recorded anew, and a drawing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts in behalf of the assignee or other person in possession thereof, until it shall have been so recorded anew.

SECTION 3. *And be it further enacted*, That whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided however*, That before such patent shall be issued the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and description, with specification of the invention or discovery, verified by oath, as shall be required by the Commissioner; and such patent, and copies of such drawings and descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

SECTION 4. *And be it further enacted*, That it shall be the duty of the Commissioner to procure a duplicate of such of the models, destroyed by fire on the aforesaid fifteenth

day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the Commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements: *Provided,* That a duplicate of such models may be obtained at a reasonable expense: *And provided also,* That the whole amount of expenditure for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of Commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction; and also to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

SECTION 5. *And be it further enacted,* That, whenever a patent shall be returned for correction and reissue under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so to be issued: *Provided however,* That no patent made prior to the aforesaid fifteenth day of December shall be corrected and reissued until a duplicate of the model and drawing of the thing as originally invented,

verified by oath as shall be required by the Commissioner, shall be deposited in the Patent Office:

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of the thing originally intended, verified as aforesaid, shall have been deposited in the Patent Office, if the Commissioner shall require the same; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the Commissioner, shall, in like manner, be deposited in the Patent Office.

And in all such cases, as well as in those which may arise under the third section of this act, the question of compensation for such models and drawings shall be subject to the judgment and decision of the Commissioners, provided for in the fourth section, under the same limitations and restrictions as are therein prescribed.

SECTION 6. *And be it further enacted*, That any patent hereafter to be issued may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

SECTION 7. *And be it further enacted*, That, whenever any

patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material or substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment by the person disclaiming in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him subsequent to the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same.

SECTION 8. *And be it further enacted*, That, whenever application shall be made to the Commissioner for any addition of a newly discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim

in accordance with the decision of the Commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

SECTION 9. *And be it further enacted*, any thing in the fifteenth section of the act to which this is additional to the contrary notwithstanding, That, whenever by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have in his specification claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bona fide* his own; *Provided*, It shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. And every such patentee, his executors, administrators, and assigns, whether of the whole, or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be *bona fide* his own as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. But, in every such case in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented which was so claimed without right. *Provided*

however, That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid.

SECTION 10. *And be it further enacted*, That the Commissioner is hereby authorized and empowered to appoint agents, in not exceeding twenty of the principal cities or towns in the United States as may best 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.

SECTION 11. *And be it further enacted*, That, instead of one examining clerk, as provided by the second section of the act to which this is additional, there shall be appointed, in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars; and also, an additional copying clerk, at an annual salary of eight hundred dollars. And the Commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the Commissioner.

SECTION 12. *And be it further enacted*, That, wherever the application of any foreigner for a patent shall be rejected and withdrawn for want of novelty in the invention, pursuant to the seventh section of the act to which this is additional, the certificate thereof of the Commissioner

shall be a sufficient warrant to the treasurer to pay back to such applicant two-thirds of the duty he shall have paid into the treasury on account of such application.

SECTION 13. *And be it further enacted*, That in all cases in which an oath is required by this act, or by the act to which this is additional, if the person of whom it is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

SECTION 14. *And be it further enacted*, That all moneys paid into the treasury of the United States for patents and for fees for copies furnished by the Superintendent of the Patent Office prior to the passage of the act to which this is additional, shall be carried to the credit of the patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries of the officers and clerks provided for by said act, and all other expenses of the Patent Office, including all the expenditures provided for by this act; and also for such other purposes as are or may be hereafter specially provided for by law. And the Commissioner is hereby authorized to draw upon said fund, from time to time, for such sums as shall be necessary to carry into effect the provisions of this act, governed, however, by the several limitations herein contained. And it shall be his duty to lay before Congress, in the month of January, annually, a detailed statement of the expenditures and payments by him made from said fund; And it shall also be his duty to lay before Congress, in the month of January, annually, a list of all patents which shall have been granted during the preceding year, designating, under proper heads, the subjects of such patents, and furnishing an alphabetical list of the patentees, with their places of residence; and he shall also furnish a list of all patents which shall have become public property

during the same period; together with such other information of the state and condition of the Patent Office as may be useful to Congress or the public.

APPROVED March 3, 1837.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1839

5 STATUTES AT LARGE, 353

An Act in addition to "An act to promote the progress of the useful arts"

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be appointed, in manner provided in the second section of the act to which this is additional, two assistant examiners, each to receive an annual salary of twelve hundred and fifty dollars.

SECTION 2. *And be it further enacted*, That the Commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the current business of the office requires it; *Provided however*, That instead of salary, a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office.

SECTION 3. *And be it further enacted*, That the Commissioner is hereby authorized to publish a classified and alphabetical list of all patents granted by the Patent Office previous to said publication, and retain one hundred copies for the Patent Office and nine hundred copies to be deposited in the library of Congress, for such distribution as may be hereafter directed; and that one

thousand dollars, if necessary, be appropriated, out of the patent fund, to defray the expense of the same.

SECTION 4. *And be it further enacted*, That the sum of three thousand six hundred and fifty-nine dollars and twenty-two cents be, and is hereby, appropriated from the patent fund, to pay for the use and occupation of rooms in the City Hall by the Patent Office.

SECTION 5. *And be it further enacted*, That the sum of one thousand dollars be appropriated from the patent fund, to be expended under the direction of the Commissioner, for the purchase of necessary books for the library of the Patent Office.

SECTION 6. *And be it further enacted*, That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided*, That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided also*, That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters-patent.

SECTION 7. *And be it further enacted*, That every person or corporation who has, or shall have, purchased or constructed 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 person interested in such invention; and no patent shall be held to be invalid, by reason of such pur-

chase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

SECTION 8. *And be it further enacted*, That so much of the eleventh section of the above recited act as requires the payment of three dollars to the Commissioner of Patents for recording any assignment, grant, or conveyance of the whole or any part of the interest or right under any patent, be, and the same is hereby, repealed; and all such assignments, grants, and conveyances shall, in future, be recorded, without any charge whatever.

SECTION 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

SECTION 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Pat-

ent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case: *Provided however*, That no opinion or decision of the judge in any such case shall preclude any person interested in favor or against the validity of any patent which has been or may, hereafter be granted from the right to contest the same in any judicial court, in any action in which its validity may come in question.

SECTION 12. *And be it further enacted*, That the Commis-

sioner of Patents shall have power to make all such regulations, in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. And so much of the act to which this is 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.

APPROVED March 3, 1839.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1842

5 STATUTES AT LARGE, 543

An Act in addition to an act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same into the Treasury, or to any receiver or depositary to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to the said Treasurer by the Commissioner of Patents.

SECTION 2. *And be it further enacted*, That the third section of the act of March, eighteen hundred and thirty-

seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and 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 woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas-relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases,

which by the now existing laws would be required of the particular applicant, shall be one-half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

SECTION 4. *And be it further enacted*, That the oath required for applicants for patents may be taken, when the applicant is not, for the time being, residing in the United States, before any minister, plenipotentiary, *chargé d'affaires*, consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which such applicant may be.

SECTION 5. *And be it further enacted*, That if any person or persons shall paint or print or mould, cast, carve, or engrave, or stamp, upon anything made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters-patent, the name or any imitation of the name of any other person who hath or shall have obtained letters-patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the 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, he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the circuit courts of the United States, or in any of the district courts of the United States having the powers and jurisdiction of a circuit court; one-half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

SECTION 6. *And be it further enacted*, That all patentees and assignees of patents hereafter granted are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended, or offered for sale, the date of the patent; and if any person or persons, patentees, or assignees, shall neglect to do so, he, she, or they shall be liable to the same penalty, to be recovered and disposed of in the manner specified in the foregoing fifth section of this act.

APPROVED August 29, 1842.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1848

9 STATUTES AT LARGE, 231

An Act to provide additional Examiners in the Patent Office, and for other Purposes

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be appointed, in the manner

provided in the second section of the act entitled "An Act to promote the progress of useful arts, and to repeal all acts and parts of acts herctofore 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 fiftcen hundred dollars: *Provided*, That the power to extend patents, now vested in the board composed of the Secretary of Statc, 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 Patcnt Office, shall hereafter bc vested solely in the Commissioner of Patents; and when an application is madc to him for the extension of a patent according to said eighteenth section, and sixty days' notice given thereof, he shall refer the case to the principal examiner having charge of the class of inventions to which said case belongs, who shall make full report to said Commissioner of the said case, and particularly whether the invention or improvement secured in the patent was new and patentable when patented; and thereupon the said Commissioner shall grant or refuse the extension of said patent, upon the same principles and rules that have governed said board; but no patent shall be extended for a longer term than seven years.

SECTION 2. *And be it further enacted*, That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant, or conveyance of the whole or any part of the interest in letters-patent, or power of attorney, or license to make or use the thing patented,

when such instrument shall not 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 three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

SECTION 3. *And be it further enacted*, That there shall be appointed in manner aforesaid, two clerks, to be employed in copying and recording, and in other services in the Patent Office, who shall each be paid a salary of one thousand two hundred dollars per annum.

SECTION 4. *And be it further enacted*, That the Commissioner of Patents is hereby authorized to send by mail, free of postage, the annual reports of the Patent Office, in the same manner in which he is empowered to send letters and packages relating to the business of the Patent Office.

APPROVED May 27, 1848.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1849

9 STATUTES AT LARGE, 395

Section 2 of the Act entitled "An Act to establish the Home Department, and to provide for the Treasury Department an Assistant Secretary of the Treasury and a Commissioner of the Customs"

SECTION 2. *And be it further enacted*, That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary of State; and the said Secretary of the Interior shall sign

all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

APPROVED March 3, 1849.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1852

10 STATUTES AT LARGE, 75

An Act in addition to "An Act to Promote the Progress of the Useful Arts"

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That appeals provided for in the eleventh section of the act entitled An Act in addition to an act to promote the progress of the useful arts, approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties, and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges.

SECTION 2. *And be it further enacted*, That in case appeals shall be made to the said chief judge, or to either of the said assistant judges, the Commissioner of Patents shall pay to such chief judge or assistant judge the sum of twenty-five dollars, required to be paid by the 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 30, 1852.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF FEBRUARY 18, 1861

12 STATUTES AT LARGE, 130

An Act to extend the right of appeal from the decisions of Circuit Courts to the Supreme Court of the United States.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from all judgments and decrees of any Circuit Court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming to authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action.

APPROVED February 18, 1861.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF MARCH 2, 1861

12 Statutes at Large, 246

An Act in Addition to "An Act to promote the Progress of the useful Arts"

Section 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any justice of the peace, or other officer authorized by law to take depositions to be used in the courts of the United States, or in the State courts of any State where such officer shall reside; and in any contested case pending in the Patent Office it shall be lawful for the clerk of any court of the United States for any district or Territory, and he is hereby, required upon the application of any party to such contested case, or the agent or attorney of such party, to issue 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: *Provided*, That no witness 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.

SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and refusal of letters-patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners in chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters-patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of

Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents.

SECTION 3. *And be it further enacted*, That no appeal shall be allowed to the examiners in chief from the decisions of the primary examiners, except in interference cases, until after the application shall have been twice rejected; and the second examination of the application by the primary examiner shall not be had until the applicant, in view of the references given on the first rejection, shall have renewed the oath of invention, as provided for in the seventh section of the act entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six.

SECTION 4. *And be it further enacted*, That the salary of the Commissioner of Patents, from and after the passage of this act, shall be four thousand five hundred dollars per annum, and the salary of the chief clerk of the Patent Office shall be two thousand five hundred dollars, and the salary of the librarian of the Patent Office shall be eighteen hundred dollars.

SECTION 5. *And be it further enacted*, That the Commissioner of Patents is authorized to restore to the respective applicants, or when not removed by them, to otherwise dispose of such of the models belonging to rejected applications as he shall not think necessary to be preserved. The same authority is also given in relation to all models accompanying applications for designs. He is further authorized to dispense in future with models of designs when the design can be sufficiently represented by a drawing.

SECTION 6. *And be it further enacted*, That the tenth section of the act approved the third of March, eighteen hundred and thirty-seven, authorizing the appointment of agents for the transportation of models and specimens to the Patent Office, is hereby repealed.

SECTION 7. *And be it further enacted*, That the Commissioner is further authorized, from time to time, to appoint, in the manner already provided for by law, such an additional number of principal examiners, first assistant examiners, and second assistant examiners as may be required to transact the current business of the office with despatch, provided the whole number of additional examiners shall not exceed four of each class, and that the total annual expenses of the Patent Office shall not exceed the annual receipts.

SECTION 8. *And be it further enacted*, That the Commissioner may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the parties filing such papers; and for gross misconduct he may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the Commissioner for such refusal shall be duly recorded, and be subject to the approval of the President of the United States.

SECTION 9. *And be it further enacted*, That no money paid as a fee, on any application for a patent after the passage of this act, shall be withdrawn or refunded, nor shall the fee paid on filing a caveat be considered as part of the sum required to be paid on filing a subsequent application for a patent for the same invention. That the three months' notice given to any caveator, in pursuance of the requirements of the twelfth section of the act of July fourth, eighteen hundred and thirty-six, shall be computed from the day on which such notice is deposited

in the post-office at Washington, with the regular time for the transmission of the same added thereto, which time shall be indorsed on the notice; and that so much of the thirteenth section of the act of Congress, approved July fourth, eighteen hundred and thirty-six, as authorizes the annexing to letters-patent of the description and specification of additional improvements is hereby repealed, and in all cases where additional improvements would now be admissible, independent patents must be applied for.

SECTION 10. *And be it further enacted*, That all laws now in force fixing the rates of the Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are hereby repealed, and in their stead the following rates are established:—

On filing each caveat, ten dollars.

On filing each original application for a patent, except for a design, fifteen dollars.

On issuing each original patent, twenty dollars.

On every appeal from the examiner in chief to the Commissioner, twenty dollars.

On every application for the reissue of a patent, thirty dollars.

On every application for the extension of a patent, fifty dollars; and fifty dollars in addition, on the granting of every extension.

On filing each disclaimer, ten dollars.

For certified copies of patents and other papers, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, and other papers, of three hundred words or under, one dollar.

For recording every assignment, and other papers,

over three hundred and under one thousand words, two dollars.

For recording every assignment or other writing, if over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making the same.

SECTION 11. *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts, and expense may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original design for a bust, statue, or bas-relief, or composition in alto or baso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents, expressing such desire; and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may

elect in his application: *Provided*, That the fee to be paid in such application shall be for the term of three years and six months, ten dollars, for seven years, fifteen dollars, and for fourteen years, thirty dollars: *And provided*, That the patentees of designs under this act shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patent shall expire, upon the same terms and restrictions as are now provided for the extension of letters-patent.

SECTION 12. *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof they shall be regarded as abandoned by the parties thereto; unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable; and all applications now pending shall be treated as if filed after the passage of this act, and all applications for the extension of patents shall be filed at least ninety days before the expiration thereof; and notice of the day set for the hearing of the case shall be published, as now required by law, for at least sixty days.

SECTION 13. *And be it further enacted*, That in all cases where an article is made or vended by any person under the protection of letters-patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package, or otherwise attaching thereto a label on which the notice, with the date, is printed; on failure of which, in any suit for the infringement of letters-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.

SECTION 14. *And be it further enacted*, That the Commissioner of Patents be, and he is hereby, authorized to print, or in his discretion to cause to be printed, ten copies of the description and claims of all patents which may hereafter be granted, and ten copies of the drawings of the same, when drawings shall accompany the patents: *Provided*, The cost of printing the text of said descriptions and claims shall not exceed, exclusive of stationery, the sum of two cents per hundred words for each of said copies, and the cost of the drawing shall not exceed fifty cents per copy; one copy of the above number shall be printed on parchment to be affixed to the letters-patent; the work shall be under the direction, and subject to the approval, of the Commissioner of Patents, and the expense of the said copies shall be paid for out of the patent fund.

SECTION 15. *And be it further enacted*, That printed copies of the letters-patent of the United States, with the seal of the Patent Office affixed thereto and certified and signed by the Commissioner of Patents, shall be legal evidence of the contents of said letters-patent in all cases.

SECTION 16. *And be it further enacted*, That all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue; and all extension of such patents is hereby prohibited.

SECTION 17. *And be it further enacted*, That all acts and parts of acts heretofore passed, which are inconsistent with the provisions of this act, be, and the same are hereby, repealed.

APPROVED March 2, 1861.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1862

12 STATUTES AT LARGE, 583

Section 4 of an Act making supplemental appropriations for sundry civil expenses, &c.

SECTION 4. For the fund of the Patent Office, fifty thousand eight hundred and fifty-five dollars and forty-nine cents, to supply a deficiency existing under the act of March second, eighteen hundred and sixty-one, entitled "An act in addition to an act to promote the progress of the useful arts": *Provided*, That the fourteenth section of said act be, and the same is hereby, repealed.

APPROVED July 16, 1862.

PATENT ACT OF 1863

12 STATUTES AT LARGE, 796

An Act to amend an Act entitled "An Act to promote the Progress of the useful Arts"

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That so much of section seven of the act entitled "An act to promote the progress of the useful arts,"

approved July fourth, eighteen hundred and thirty-six, as requires a renewal of the oath, be, and the same is hereby, repealed.

SECTION 2. *And be it further enacted,* That, whereas the falling off of the revenue of the Patent Office required a reduction of the compensation of the examiners and clerks, or other employees in the office, after the thirty-first day of August, eighteen hundred and sixty-one, that the Commissioner of Patents be, and he is hereby, authorized, whenever the revenue of the office will justify him in so doing, to pay them such sums, in addition to what they shall already have received, as will make their compensation the same as it was at that time.

SECTION 3. *And be it further enacted,* That every patent shall be dated as of a day not later than six months after the time at which it was passed and allowed, and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within the said six months, the patent shall be withheld, and the invention therein described shall become public property as against the applicant therefor: *Provided,* That in all cases where patents have been allowed previous to the passage of this act, the said six months shall be reckoned from the date of such passage.

APPROVED March 3, 1863.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1864

13 STATUTES AT LARGE, 194

An Act amendatory of an Act to amend an Act entitled "An Act to promote the Progress of the Useful Arts," approved March three, eighteen hundred and sixty-three.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That any person having an interest in an invention, whether as the inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided by said act, shall have the right to make the payment of such fee, and receive the patent withheld on account of the non-payment of said fee, provided such payment be made within six months from the date of the passage of this act: *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.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT ACT OF 1865

13 Statutes at Large, 533

An Act amendatory of "An Act to amend an Act entitled 'An Act to promote the Progress of the useful Arts,' approved March three, eighteen hundred and sixty-three"

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That any persons having an interest in an invention, whether as inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee as provided in said act, shall have the right to make an application for a patent for his invention, the same as in the case of an original application, provided such application be made within two years after the date of the allowance of the original application: *Provided*, That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent aforesaid was ordered to issue. This act shall apply to all cases now in the Patent Office, and also to such as shall hereafter be filed. And all acts or parts of acts inconsistent with this act are hereby repealed.

Approved March 3, 1865.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

PATENT STATUTE OF 1866

14 Statutes at Large, 76

An Act in Amendment of an Act to promote the Progress of the Useful Arts, and the Acts in Amendment of an Addition thereto.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That upon appealing for the first time from the decision of the primary examiner to the examiners-in-chief in the Patent Office, the appellant shall pay a fee of ten dollars into the Patent Office, to the credit of the patent fund: and no appeal from the primary examiner to the examiners-in-chief shall hereafter be allowed until the appellant shall pay said fee.

Approved June 27, 1866.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

CONSOLIDATED PATENT ACT OF 1870

16 Statutes at Large, 198

An Act to revise, consolidate, and amend the Statutes, relating to Patents and Copyrights

Section 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be attached to the Department of the Interior the office, heretofore established, known as the Patent Office, wherein all records, books,

models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. [See Revised Statutes, Section 475.]

SECTION 2. *And be it further enacted*, That the officers and employees of said office shall continue to be: one commissioner of patents, one assistant commissioner, and three examiners-in-chief, to be appointed by the President, by and with the advice and consent of the Senate; one chief clerk, one examiner in charge of interferences, twenty-two principal examiners, twenty-two first assistant examiners, twenty-two second assistant examiners, one librarian, one machinist, five clerks of class four, six clerks of class three, fifty clerks of class two, forty-five clerks of class one, and one messenger and purchasing clerk, all all of whom shall be appointed by the Secretary of the Interior, upon nomination of the Commissioner of Patents. [See Revised Statutes, Section 476.]

SECTION 3. *And be it further enacted*, That the Secretary of the Interior may also appoint, upon like nomination, such additional clerks of classes two and one, and of lower grades, copyists of drawings, female copyists, skilled laborers, laborers and watchmen, as may be from time to time appropriated for by Congress. [See Revised Statutes, Section 169.]

SECTION 4. *And be it further enacted*, That the annual salaries of the officers and employees of the Patent Office shall be as follows:—

Of the commissioner of patents, four thousand five hundred dollars.

Of the assistant commissioner, three thousand dollars.

Of the examiners-in-chief, three thousand dollars each.

Of the chief clerk, two thousand five hundred dollars.

Of the examiner in charge of interferences, two thousand five hundred dollars.

Of the principal examiners, two thousand five hundred dollars each.

Of the first assistant examiners, one thousand eight hundred dollars each.

Of the second assistant examiners, one thousand six hundred dollars each.

Of the librarian, one thousand eight hundred dollars.

Of the machinist, one thousand six hundred dollars.

Of the clerks of class four, one thousand eight hundred dollars each.

Of the clerks of class three, one thousand six hundred dollars each.

Of the clerks of class two, one thousand four hundred dollars each.

Of the clerks of class one, one thousand two hundred dollars each.

Of the messenger and purchasing clerk, one thousand dollars.

Of laborers and watchmen, seven hundred and twenty dollars each.

Of the additional clerks, copyists of drawings, female copyists, and skilled laborers, such rates as may be fixed by the acts making appropriations for them. [See Revised Statutes, Sections 477, 440, and 167.]

SECTION 5. *And be it further enacted*, That all officers and employees of the Patent Office shall, before entering upon their duties, make oath or affirmation truly and faithfully to execute the trusts committed to them. [See Revised Statutes, Sections 1756 and 1757.]

SECTION 6. *And be it further enacted*, That the commissioner and chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars,

conditioned for the faithful discharge of their duties, and that they will render to the proper officers of the treasury a true account of all money received by virtue of their office. [See Revised Statutes, Section 479.]

SECTION 7. *And be it further enacted*, That it shall be the duty of the commissioner, under the direction of the Secretary of the Interior, to superintend or perform all the duties respecting the granting and issuing of patents which herein are, or may hereafter be, by law directed to be done; and he shall have charge of all books, records, papers, models, machines, and other things belonging to said office. [See Revised Statutes, Section 481.]

SECTION 8. *And be it further enacted*, That the commissioner may send and receive by mail, free of postage, letters, printed matter, and packages relating to the business of his office, including Patent Office reports. [See 19 Statutes at Large, Chap. 103, Section 5, p. 335; and 20 Statutes at Large, Chap. 180, Section 29, p. 362.]

SECTION 9. *And be it further enacted*, That the commissioner shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. [See Revised Statutes, Section 494.]

SECTION 10. *And be it further enacted*, That the examiners-in-chief shall be persons of competent legal

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

SECTION 11. *And be it further enacted*, That in case of the death, resignation, absence, or sickness of the commissioner, his duties shall devolve upon the assistant commissioner until a successor shall be appointed, or such absence or sickness shall cease. [See Revised Statutes, Sections 177, 178, and 179.]

SECTION 12. *And be it further enacted*, That the commissioner shall cause a seal to be provided for said office, with such device as the President may approve, with which all records or papers issued from said office, to be used in evidence, shall be authenticated. [See Revised Statutes, Section 478.]

SECTION 13. *And be it further enacted*, That the commissioner shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in said office; and said rooms and galleries shall be kept open during suitable hours for public inspection. [See Revised Statutes, Section 484.]

SECTION 14. *And be it further enacted*, That the commissioner may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treas-

ury, as other patent moneys are directed to be paid. [See Revised Statutes, Section 485.]

SECTION 15. *And be it further enacted*, That there shall be purchased, for the use of said office, a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated by Congress for that purpose. [See Revised Statutes, Section 486.]

SECTION 16. *And be it further enacted*, That all officers and employees of the Patent Office shall be incapable, during the period for which they shall hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by said office. [See Revised Statutes, Section 480.]

SECTION 17. *And be it further enacted*, That for gross misconduct the commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior. [See Revised Statutes, Section 487.]

SECTION 18. *And be it further enacted*, That the commissioner may require all papers filed in the Patent Office, if not correctly, legibly and clearly written, to be printed at the cost of the party filing them. [See Revised Statutes, Section 488.]

SECTION 19. *And be it further enacted*, That the commissioner, subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. [See Revised Statutes, Section 483.]

SECTION 20. *And be it further enacted*, That the commissioner may print or cause to be printed copies of the spec-

ifications of all letters-patent and of the drawings of the same, and copies of the claims of current issues, and copies of such laws, decisions, rules, regulations, and circulars as may be necessary for the information of the public. [See Revised Statutes, Sections 489, 490, and 491.]

SECTION 21. *And be it further enacted*, That all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the commissioner, and they shall be recorded, together with the specification, in said office, in books to be kept for that purpose. [See Revised Statutes, Section 4883.]

SECTION 22. *And be it further enacted*, That every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the said invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof; and a copy of said specifications and of the drawings shall be annexed to the patent and be a part thereof. [See Revised Statutes, Section 4884.]

SECTION 23. *And be it further enacted*, That every patent shall date as of a day not later than six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent; and if the final fee shall not be paid within that period, the patent shall be withheld. [See Revised Statutes, Section 4885.]

SECTION 24. *And be it further enacted*, That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described

in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor. [See Revised Statutes, Section 4886.]

SECTION 25. *And be it further enacted*, That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country: *Provided*, The same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years. [See Revised Statutes, Section 4887.]

SECTION 26. *And be it further enacted*, That before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application 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 com-

bination which he claims as his invention or discovery; and said specification and claim shall be signed by the inventor and attested by two witnesses. [See Revised Statutes, Section 4888.]

SECTION 27. *And be it further enacted*, That when the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of said drawings, to be furnished by the Patent Office, shall be attached to the patent as part of the specification. [See Revised Statutes, Section 4889.]

SECTION 28. *And be it further enacted*, That when the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. [See Revised Statutes, Section 4890.]

SECTION 29. *And be it further enacted*, That in all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish one of convenient size to exhibit advantageously the several parts of his invention or discovery. [See Revised Statutes, Section 4891.]

SECTION 30. *And be it further enacted*, That the applicant shall make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. And said oath or affirmation may be made before any person within the United States authorized by law to administer oaths,

or, when the applicant resides in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be. [See Revised Statutes, Section 4892.]

SECTION 31. *And be it further enacted*, That on the filing of any such application and the payment of the duty required by law, the commissioner shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. [See Revised Statutes, Section 4893.]

SECTION 32. *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the commissioner that such delay was unavoidable. [See Revised Statutes, Section 4894.]

SECTION 33. *And be it further enacted*, That patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specifications sworn to by the inventor or discoverer; and also, if he be living, in case of an application for reissue. [See Revised Statutes, Section 4895.]

SECTION 34. *And be it further enacted*, That when any

person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application shall be made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. [See Revised Statutes, Section 4896.]

SECTION 35. *And be it further enacted*, That any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who has failed to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application: *Provided*, That the second application be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent, as aforesaid, was ordered to issue, prior to the issue thereof: *And provided further*, That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months from the date of such passage to renew his application, or to file a new one; and if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment

shall be considered as a question of fact. [See Revised Statutes, Section 4897.]

SECTION 36. *And be it further enacted*, That every patent or any interest therein shall be assignable in law, by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States; and said assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. [See Revised Statutes, Section 4898.]

SECTION 37. *And be it further enacted*, That every person who may have purchased of the inventor, or with his knowledge and consent may have constructed any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or sold or used one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. [See Revised Statutes, Section 4899.]

SECTION 38. *And be it further enacted*, That it shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on

proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented. [See Revised Statutes, Section 4900.]

SECTION 39. *And be it further enacted*, That if any person shall, in any manner, mark upon any thing made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or shall in any manner mark upon or affix to any such patented article the word "patent" or "patentee," or the words "letters-patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or shall in any manner mark upon or affix to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, he shall be liable for every such offence 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 offence may have been committed. [See Revised Statutes, Section 4901.]

SECTION 40. *And be it further enacted*, That any citizen of the United States, who shall have made any new invention or discovery, and shall desire further time to mature the same, may, on payment of the duty required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention; and such caveat shall be filed in

the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application shall be made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person filing the caveat, who, if he would avail himself of his caveat, shall file his description, specification, drawings, and model within three months from the time of placing said notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto, which time shall be indorsed on the notice. And an alien shall have the privilege herein granted, if he shall have resided in the United States one year next preceding the filing of his caveat, and made oath of his intention to become a citizen. [See Revised Statutes, Section 4902.]

SECTION 41. *And be it further enacted*, That whenever, on examination, any claim for a patent is rejected for any reason whatever, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case. [See Revised Statutes, Section 4903.]

SECTION 42. *And be it further enacted*, That whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give

notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe. [See Revised Statutes, Section 4904.]

SECTION 43. *And be it further enacted,* That the commissioner may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. [See Revised Statutes, Section 4905.]

SECTION 44. *And be it further enacted,* That the clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue [a] 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. [See Revised Statutes, Sections 4906 and 4908.]

SECTION 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 at 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 travelling 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. [See Revised Statutes, Sections 4906, 4907, and 4908.]

SECTION 46. *And be it further enacted,* That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law. [See Revised Statutes, Section 4909.]

SECTION 47. *And be it further enacted,* That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person. [See Revised Statutes, Section 4910.]

SECTION 48. *And be it further enacted,* That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. [See Revised Statutes, Section 4911.]

SECTION 49. *And be it further enacted,* That when an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the

commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing. [See Revised Statutes, Section 4912.]

SECTION 50. *And be it further enacted*, That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint, notifying the commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the 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. [See Revised Statutes, Section 4914.]

SECTION 51. *And be it further enacted*, That on receiving notice of the time and place of hearing such appeal, the commissioner shall notify all parties who appear to be interested therein in such manner as the court may prescribe. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish it with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath, in explanation of the principles of the machine or other thing for which a patent is demanded. [See Revised Statutes, Section 4913.]

SECTION 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See Revised Statutes, Section 4915.]

SECTION 53. *And be it further enacted*, That whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such a patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original

patent, the surrender of which shall take effect upon the issue of the amended patent; and the commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. And the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. [See Revised Statutes, Section 4916.]

SECTION 54. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the duty required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or

assignment, stating therein the extent of his interest in such patent; said disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See Revised Statutes, Section 4917.]

SECTION 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 *claimant* [complainant] shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters-patent shall be granted or extended, or within six years after the expira-

tion thereof. [See Revised Statutes, Section 629, ¶ 9, and Section 4921.]

SECTION 56. *And be it further enacted*, That a writ of error or appeal to the Supreme Court of the United States shall lie from all judgments and decrees of any circuit court, or of any district court exercising the jurisdiction of a circuit court, or of the Supreme Court of the District of Columbia, or of any Territory, in any action, suit, controversy, or case, at law or in equity, touching patent rights, in the same manner and under the same circumstances as in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy. [See Revised St. 'utes, Section 699.]

SECTION 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 application therefor, and paying the fee required by law, shall have certified copies thereof. And copies of the specifications and drawings of foreign letters-patent, certified in like manner, shall be prima facie evidence of the fact of the granting of such foreign letters-patent, and of the date and contents thereof. [See Revised Statutes, Sections 892 and 893.]

SECTION 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse

parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. [See Revised Statutes, Section 4918.]

SECTION 59. *And be it further enacted*, That damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States, or district court exercising the jurisdiction of a circuit court, or in the Supreme Court of the District of Columbia, or of any Territory, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict shall be rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See Revised Statutes, Section 629, ¶ 9, and Section 4919.]

SECTION 60. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any wil[l]ful default or intent to defraud or mislead the public, a patentee shall have (in his specification) claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at

law or in equity, for the infringement of any part thereof, which was bona fide his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer. [See Revised Statutes, Section 4922.]

SECTION 61. *And be it further enacted*, That in any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:—

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country, for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defences may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. [See Revised Statutes, Section 4920.]

SECTION 62. *And be it further enacted*, That whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. [See Revised Statutes, Section 4923.]

SECTION 63. *And be it further enacted*, That where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the commissioner, setting forth the reasons why such extension

should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of said invention or discovery. And said application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of said original term. [See Revised Statutes, Section 4924.]

SECTION 64. *And be it further enacted*, That upon the receipt of such application, and the payment of the duty required by law, the commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See Revised Statutes, Section 4925.]

SECTION 65. *And be it further enacted*, That on the publication of such notice, the commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make to said commissioner a full report of the case, and particularly whether the invention or discovery was new and patentable when the original patent was granted. [See Revised Statutes, Section 4926.]

SECTION 66. *And be it further enacted*, That the commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence pro-

duced, both for and against the extension; and if it shall appear to his satisfaction that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery, a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the said commissioner shall make a certificate thereon, renewing and extending the said patent for the term of seven years from the expiration of the first term, which certificate shall be recorded in the Patent Office, and thereupon the said patent shall have the same effect in law as though it had been originally granted for twenty-one years. [See Revised Statutes, Section 4927.]

SECTION 67. *And be it further enacted*, That the benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented to the extent of their interest therein. [See Revised Statutes, Section 4928.]

SECTION 68. *And be it further enacted*, That the following shall be the rates for patent fees:—

On filing each original application for a patent, fifteen dollars.

On issuing each original patent, twenty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from 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. [See Revised Statutes, Section 4934.]

SECTION 69. *And be it further enacted*, That patent fees may be paid to the commissioner, or to the treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor. And all money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever; and all disbursements for said office shall be made by the disbursing clerk of the Interior Department. [See Revised Statutes, Sections 496 and 4935.]

SECTION 70. *And be it further enacted*, That the Treasurer of the United States is authorized to pay back any sum or sums of money to any person who shall have paid the same into the treasury, or to any receiver or depositary, to the credit of the treasurer, as for fees accruing at the Patent Office through mistake, certificate thereof being made to said treasurer by the Commissioner of Patents. [See Revised Statutes, Section 4936.]

SECTION 71. *And be it further enacted*, That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of wool[l]en, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. [See Revised Statutes, Section 4929.]

SECTION 72. *And be it further enacted*, That the commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. [See Revised Statutes, Section 4930.]

SECTION 73. *And be it further enacted*, That patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. [See Revised Statutes, Section 4931.]

SECTION 74. *And be it further enacted*, That patentees of designs issued prior to March two, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one. [See Revised Statutes, Section 4932.]

SECTION 75. *And be it further enacted*, That the following shall be the rates of fees in design cases:—

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

For all other cases in which fees are required, the same rates as in cases of inventions or discoveries. [See Revised Statutes, Section 4934.]

SECTION 76. *And be it further enacted*, That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs. [See Revised Statutes, Section 4933.]

[Sections 77 to 110, inclusive, refer to trade-marks and copyrights, and not to patents.]

SECTION 111. *And be it further enacted*, That the acts and parts of acts set forth in the schedule of acts cited, hereto annexed, are hereby repealed, without reviving any acts or parts of acts repealed by any of said acts, or by any clause or provisions therein: *Provided, however*, That the repeal hereby enacted shall not affect, impair, or take away any right existing under any of said laws; but all actions and causes of action, both in law or in equity, which have arisen under any of said laws, may be commenced and prosecuted, and if already commenced may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting that the remedial provisions of this act shall be applicable to all suits and proceedings hereafter commenced: *And provided also*, That all applications for patents pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the

passage thereof: *And provided further*, That all offences which are defined and punishable under any of said acts, and all penalties and forfeitures created thereby and incurred before this act takes effect, may be prosecuted, sued for, and recovered, and such offences punished according to the provision of said acts, which are continued in force for such purpose.

APPROVED July 8, 1870.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

PATENT ACT OF MARCH 3, 1871

16 STATUTES AT LARGE, 583

An Act to amend an Act to revise, consolidate, and amend the Statutes relating to Patents and Copyrights

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That that part of section thirty-three of an act entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights," approved July eighth, eighteen hundred and seventy, which requires that, in case of application by assignee or assignees for reissue of letters-patent, the application shall be made and the specification sworn to by the inventor or discoverer, if living, shall not be construed to apply to patents issued and assigned prior to July eighth, eighteen hundred and seventy.

APPROVED March 3, 1871.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

PATENT ACT OF MARCH 24, 1871

17 STATUTES AT LARGE, 2

An Act to further regulate the publication of the specifications and Drawings of the Patent Office

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That if, in the judgment of the joint committee on printing, the provisions of the joint resolution providing for publishing specifications and drawings of the Patent Office, approved January eleventh, eighteen hundred and seventy-one, can be performed under the direction of the Commissioner of Patents more advantageously than in the manner provided in said joint resolution, it shall be so done, under such limitations and conditions as the joint committee on printing may from time to time prescribe.

SECTION 2. That the price of the printed copies of specifications and drawings of patents, when uncertified, shall be determined by the Commissioner of Patents, ten cents being hereby fixed as the minimum, and fifty cents as the maximum price of the same; certified copies to be sold at the price fixed by the patent act of eighteen hundred and seventy.

APPROVED March 24, 1871.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

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SECTION 440. There shall also be in the Department of the Interior:

* * * * * * *

In the Patent Office:

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

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

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

Twenty-four principal examiners, at a salary of two thousand five hundred dollars a year each.

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

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

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

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

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

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

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

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

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

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

Eight attendants in the model-room, at a salary of nine hundred dollars a year each. [See prior patent statutes: Sections 2 and 3, 1870; Sections 4 and 7, 1861; Sections 1 and 3, 1848; Section 10, 1837; Section 2, 1836.]

SECTION 441. The Secretary of the Interior is charged with supervising all public business relating to * * *

Fifth. Patents for inventions. [See prior patent statutes: Section 1, 1870; Section 2, 1849.]

SECTION 475. There shall be in the Department of the Interior an office known as the Patent-Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. [See prior patent statutes: Section 1, 1870; Section 1, 1836.]

SECTION 476. There shall be in the Patent-Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employés authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents. [See prior patent statutes: Section 2, 1870; Section 2, 1861; Section 1, 1836.]

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

The Commissioner of Patents, four thousand five hundred dollars a year.

The Assistant Commissioner of Patents, three thousand dollars a year.

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

each. [See prior patent statutes; Section 4, 1870; Sections 2 and 4, 1861; Section 11, 1837; Section 1, 1836.]

SECTION 478. The seal heretofore provided for the Patent-Office shall be the seal of the Office, with which letters-patent and papers issued from the Office shall be authenticated. [See prior patent statutes: Section 12, 1870; Section 4, 1836.]

SECTION 479. The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices. [See prior patent statutes: Section 6, 1870; Section 3, 1836.]

SECTION 480. All officers and employés of the Patent-Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office. [See prior patent statutes: Section 16, 1870.]

SECTION 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent-Office. [See prior patent statutes: Section 7, 1870; Section 1, 1836.]

SECTION 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse

decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them. [See prior patent statutes: Section 10, 1870; Section 2, 1861.]

SECTION 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent-Office. [See prior patent statutes: Section 19, 1870.]

SECTION 484. The Commissioner of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the Patent-Office; and the rooms and galleries shall be kept open during suitable hours for public inspection. [See prior patent statutes: Section 13, 1870; Section 20, 1836.]

SECTION 485. The Commissioner of Patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent-moneys are directed to be paid. [See prior patent statutes: Section 14, 1870; Section 5, 1861.]

SECTION 486. There shall be purchased for the use of the Patent-Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose. [See prior patent statute: Section 15, 1870.]

SECTION 487. For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent-agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior. [See prior patent statute: Section 17, 1870.]

SECTION 488. The Commissioner of Patents may require all papers filed in the Patent-Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them. [See prior patent statutes: Section 18, 1870; Section 8, 1861.]

SECTION 489. The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public. [See prior patent statute: Section 20, 1870.]

SECTION 490. The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or territorial capitols, and one in the Library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent-Office, and shall not be taken from the depositories for any other purpose than to be used as evidence. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590.]

SECTION 491. The Commissioner of Patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the

preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the Patent-Office, and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590.]

SECTION 492. The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interest 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. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590, and Section 1 of Patent Act of March 24, 1871.]

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

cents as the maximum price. [See prior patent statute: Section 1, March 24, 1871.]

SECTION 494. The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent-Office as may be useful to Congress or the public. [See prior patent statutes: Section 9, 1870; Section 14, 1837; Section 1, July 3, 1832.]

SECTION 496. All disbursements for the Patent-Office shall be made by the disbursing clerk of the Interior Department. [See prior patent statutes: Section 69, 1870; Section 14, 1837.]

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

Ninth. Of all suits at law in equity arising under the patent or copyright laws of the United States. [See prior patent statutes: Section 55, 1870; Section 14, 1836; Section 1, 1819.]

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

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the Supreme Court of the District of Columbia, or of any Territory, in any case touching

patent-rights or copyrights. [See prior patent statutes: Section 56, 1870; Section 1, February 18, 1861; Section 16, 1836; Section 1, 1819.]

SECTION 892. Written or printed copies of any records, books, papers, or drawings belonging to the Patent-Office, and of letters-patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. [See prior patent statutes: Section 57, 1870; Section 15, March 2, 1861; Section 2, 1837; Section 4, 1836; Sections 3, 6, 1790.]

SECTION 893. Copies of the specifications and drawings of foreign letters-patent, certified as provided in the preceding section, shall be prima-facie evidence of the fact of the granting of such letters-patent, and of the date and contents thereof. [See prior patent statute: Section 57, 1870.]

SECTION 894. The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. [See Joint Resolution No. 5, January 11, 1871; 16 Statutes at Large, 590.]

SECTION 973. When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which

he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent-laws, has been entered at the Patent-Office before the suit was brought. [See Revised Statutes, Section 4922; and prior patent statutes: Section 60, 1870; Section 9, 1837; Section 15, 1836.]

SECTION 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose. [See prior patent statutes: Section 21, 1870; Section 5, 1836; Section 1, 1793; Section 1, 1790.]

SECTION 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. [See prior patent statutes: Section 22, 1870; Section 16, 1861; Section 5, 1836; Section 1, 1793; Section 1, 1790.]

SECTION 4885. Every patent shall bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld. [See prior patent statutes: Section 23, 1870; Section 3, 1863; Section 8, 1836.]

SECTION 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or

composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor. [See prior patent statutes: Section 24, 1870; Sections 6 and 7, 1836; Section 1, 1800; Section 1, 1793.]

SECTION 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years. [See prior patent statutes: Section 25, 1870; Section 6, 1839; Section 8, 1836.]

SECTION 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent-Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make,

construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim, the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses. [See prior patent statutes: Section 26, 1870; Section 6, 1836; Section 1, 1793; Section 2, 1790.]

SECTION 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy, signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent-Office, and a copy of the drawing, to be furnished by the Patent-Office, shall be attached to the patent as a part of the specification. [See prior patent statutes: Section 27, 1870; Section 6, 1837; Section 6, 1836; Section 3, 1793.]

SECTION 4890. When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. [See prior patent statutes: Section 28, 1870; Section 6, 1836; Section 3, 1793.]

SECTION 4891. In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery. [See prior patent statutes: Section 29, 1870; Section 6, 1836; Section 3, 1793; Section 2, 1790.]

SECTION 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a pat-

ent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be. [See prior patent statutes: Section 30, 1870; Section 4, 1842; Section 6, 1836; Section 3, 1793.]

SECTION 4893. On the filing of any such application and the payment of 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. [See prior patent statutes: Section 31, 1870; Section 7, 1836; Section 1, 1790.]

SECTION 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. [See prior patent statutes: Section 32, 1870; Section 12, 1861.]

SECTION 4895. Patents may be granted and issued or re-issued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the

Patent-Office. 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 re-issue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy. [See prior patent statutes: Section 33, 1870; Section 6, 1837.]

SECTION 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when 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. [See prior patent statutes: Section 34, 1870; Section 10, 1836; Section 2, 1800.]

SECTION 4897. Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But

such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. [See prior patent statutes: Section 35, 1870; Section 1, 1865; Section 1, 1864.]

SECTION 4898. Every patent or any interest therein shall be assignable in law, by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent-Office within three months from the date thereof. [See prior patent statutes: Section 36, 1870; Section 11, 1836; Section 4, 1793.]

SECTION 4899. Every person who purchases of the inventor or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. [See prior patent statutes: Section 37, 1870; Section 7, 1839.]

SECTION 4900. It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the

same is patented; either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented. [See prior patent statutes: Section 38, 1870; Section 13, 1861; Section 6, 1842.]

SECTION 4901. Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters-patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offence, 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 offence may have

been committed. [See prior patent statutes: Section 39, 1870; Section 5, 1842.]

SECTION 4902. Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent-Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen. [See prior patent statutes: Section 40, 1870; Section 9, 1861; Section 12, 1836.]

SECTION 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of

renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case. [See prior patent statutes: Section 41, 1870; Section 7, 1836.]

SECTION 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe. [See prior patent statutes: Section 42, 1870; Section 8, 1836; Section 9, 1793.]

SECTION 4905. The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent-Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. [See prior patent statutes: Section 43, 1870; Section 1, March 3, 1861; Section 12, 1839.]

SECTION 4906. The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent-Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a 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. [See prior patent statutes: Section 44, 1870; Section 1, 1861.]

SECTION 4907. Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States. [See prior patent statutes: Section 45, 1870; Section 1, 1861.]

SECTION 4908. Whenever any witness, after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpœna, unless his fees and travelling 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. [See prior patent statutes: Sections 44 and 45, 1870; Section 1, 1861.]

SECTION 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. [See prior patent statutes: Section 46, 1870; Section 1, 1836.]

SECTION 4910. If such party is dissatisfied with the

decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person. [See prior patent statutes: Section 47, 1870; Section 2, 1861.]

SECTION 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. [See prior patent statutes: Section 48, 1870; Section 1, 1852; Section 11, 1839.]

SECTION 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent-Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing. [See prior patent statute: Section 49, 1870.]

SECTION 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded. [See prior patent statute: Section 51, 1870.]

SECTION 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before

the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent-Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. [See prior patent statute: Section 50, 1870.]

SECTION 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See Revised Statutes and prior patent statutes: Section 52, 1870; Section 10, 1839.]

SECTION 4916. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specifica-

tion, 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. [See prior patent statutes: Section 53, 1870; Sections 5 and 8, 1837; Section 13, 1836; Section 3, 1832.]

SECTION 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent-Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See prior patent statutes: Section 54, 1870; Section 7, 1837.]

SECTION 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudica-

tion shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. [See prior patent statutes: Section 58, 1870; Section 16, 1836.]

SECTION 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See prior patent statutes: Section 55, 1870; Section 14, 1836; Section 3, 1800; Section 5, 1793; Section 4, 1790.]

SECTION 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent-Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect: or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor

or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and 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 defences may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. [See prior patent statutes: Section 61, 1870; Section 15, 1836; Section 6, 1793; Section 6, 1790.]

SECTION 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of

actions of trespass upon the case. [See prior patent statutes: Section 55, 1870; Section 17, 1836; Section 1, 1819.]

SECTION 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent-Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. [See prior patent statutes: Section 60, 1870; Section 9, 1837.]

SECTION 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. [See

prior patent statutes: Section 62, 1870; Section 15, 1836.]

SECTION 4924. Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner of Patents, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the original term. [See prior patent statutes: Section 63, 1870; Section 1, 1848; Section 18, 1836; Section 2, July 3, 1832.]

SECTION 4925. Upon the receipt of such application, and the payment of the fees required by law, the Commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See prior patent statutes: Section 64, 1870; Section 18, 1836.]

SECTION 4926. Upon the publication of the notice of an

application for an extension, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make the Commissioner a full report of the case, stating particularly whether the invention or discovery was new and patentable when the original patent was granted. [See prior patent statutes: Section 65, 1870; Section 1, 1848; Section 18, 1836.]

SECTION 4927. The Commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to the satisfaction of the Commissioner that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the Commissioner shall make a certificate thereon, renewing and extending the patent for the term of seven years from the expiration of the first term. Such certificate shall be recorded in the Patent-Office; and thereupon such patent shall have the same effect in law as though it had been originally granted for twenty-one years. [See prior patent statutes; Section 66, 1870; Section 18, 1836.]

SECTION 4928. The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein. [See prior patent statutes: Section 67, 1870; Section 18, 1836.]

SECTION 4929. Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust,

statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. [See prior patent statutes: Section 71, 1870; Section 11, March 2, 1861; Section 3, 1842.]

SECTION 4930. The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. [See prior patent statute: Section 72, 1870.]

SECTION 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. [See prior patent statutes: Section 73, 1870; Section 11, 1861; Section 3, 1842.]

SECTION 4932. Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one. [See prior patent statutes: Section 74, 1870; Section 11, March 2, 1861.]

SECTION 4933. All the regulations and provisions which apply to obtaining or protecting patents for in-

ventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs. [See prior patent statute: Section 76, 1870.]

SECTION 4934. The following shall be the rate 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 re-issue 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. [See prior patent statutes: Section 2, March 24, 1871; Sections 68 and 75, 1870; Section 1, 1866; Section

10, March 2, 1861; Section 2, 1848; Section 8, 1839; Sections 4, 9, 11, 1836; Section 11, 1793; Section 7, 1790.]

SECTION 4935. Patent-fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent-Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever. [See prior patent statutes: Section 69, 1870; Section 14, 1837.]

SECTION 4936. The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent-Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents. [See prior patent statutes: Section 69, 1870; Section 1, 1842.]

APPROVED June 22, 1874.

PATENT ACT OF FEBRUARY 16, 1875

18 STATUTES AT LARGE, PART 3, 316

Section 2 of an Act to facilitate the disposition of cases in the Supreme Court of the United States, and for other purposes

SECTION 2. The said [circuit] courts, when sitting in equity for the trial of patent causes, may empanel a jury of not less than five and not more than twelve persons,

subject to such general rules in the premises, as may from time to time be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient; and the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings.

APPROVED February 16, 1875.

PATENT ACT OF 1887

24 STATUTES AT LARGE, CHAP. 105

An Act to amend the law relating to patents, trade-marks and copyright

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That hereafter, during the term of letters patent for a design, it shall be unlawful for any person, other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall without the license of the owner, have been applied, knowing that the same has been so applied.

Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two

hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars.

And the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States, having jurisdiction of the parties, either by action at law, or upon a bill in equity for an injunction to restrain such infringement.

SECTION 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.

APPROVED February 4, 1887.

PATENT ACT OF 1888

25 STATUTES AT LARGE, CHAP. 15

An Act to amend section four thousand eight hundred and eighty-three of the Revised Statutes, to enable the Assistant Secretary of the Interior to sign patents.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section four thousand eight hundred and eighty-three of the Revised Statutes is hereby amended by inserting after the words "Secretary of the Interior," where they occur therein, the following words: "or under his direction by one of the Assistant Secretaries of the Interior," so that the said section as amended will read as follows:

"SECTION 4883. All patents shall be issued in the name

of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior, or under his direction by one of the Assistant Secretaries 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."

APPROVED February 18, 1888.

JUDICIARY ACT OF 1891 [1]

26 STATUTES AT LARGE, PAGE 826, CHAP. 517

As Amended June 6, 1900

31 STATUTES AT LARGE, PAGE 660, CHAP. 803

An Act to establish Circuit Courts of Appeals, and to define and regulate in certain cases the jurisdiction of the Courts of the United States, and for other purposes

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 6. That the Circuit Courts of Appeals, established by this act, shall exercise appellate jurisdiction to review by appeal or by writ of error, final decisions in the District Courts and the existing Circuit Courts, unless otherwise provided by law, and the judgments or decrees of the Circuit Courts of Appeals shall be final in all cases arising under the patent laws, excepting that in every such subject within its appellate jurisdiction, the Circuit Court of Appeals at any time may certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that

[1] The parts which are not relevant to patent cases are omitted.

court for its proper decision. And thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon the Circuit Courts of Appeals in such case, or it may require that the whole record and cause may be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal. And excepting also that in any such case as is hereinbefore made final in the Circuit Court of Appeals, it shall be competent for the Supreme Court to require, by certiorari or otherwise, any such case to be certified to the Supreme Court for its review and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court.

SECTION 7. That where, upon a hearing in equity in a District Court or in a Circuit Court, or by a judge thereof in vacation, an injunction shall be granted or continued, or a receiver appointed, by an interlocutory order or decree, in a cause in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, an appeal may be taken from such interlocutory order or decree, granting, or continuing such injunction, or appointing such receiver, to the Circuit Court of Appeals; *Provided*, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court or by the appellate court or a judge thereof, during the pendency of such appeal; *Provided* further, That the court below may in its discretion require as a condition of the appeal, an additional bond.

SECTION 10. And whenever on appeal or writ of error

or otherwise, a case coming from a Circuit Court of Appeals shall be reviewed and determined in the Supreme Court, the cause shall be remanded by the Supreme Court to the proper District or Circuit Court, for further proceedings in pursuance of such determination. Whenever on appeal or writ of error or otherwise a case coming from a District or Circuit Court shall be reviewed and determined in the Circuit Court of Appeals, in a case in which the decision in the Circuit Court of Appeals is final, such cause shall be remanded to the said District or Circuit Court, for further proceedings to be there taken in pursuance of such determination.

SECTION 11. That no appeal or writ of error by which any order, judgment, or decree may be reviewed in the Circuit Courts of Appeals under the provisions of this Act, shall be taken or sued out except within six months after the entry of the order, judgment, or decree sought to be reviewed. And all provisions of law now in force regulating the methods and system of review, through appeals or writs of error, shall regulate the methods and system of appeals and writs of error provided for in this act in respect of the Circuit Courts of Appeals, including all provisions for bonds or other securities to be required and taken on such appeals and writs of error, and any judge of the Circuit Courts of Appeals, in respect of cases brought or to be brought to that court, shall have the same powers and duties as to the allowance of appeals or writs of error, and the conditions of such allowance, as now by law belong to the justices or judges in respect of the existing courts of the United States respectively.

SECTION 14. And all acts and parts of acts relating to appeals or writs of error inconsistent with the provisions for review by appeals or writs of error in the preceding sections five and six of this act are hereby repealed.

SECTION 15. That the Circuit Court of Appeals in cases in which the judgments of the Circuit Courts of Appeals are made final by this act shall have the same appellate jurisdiction, by writ of error or appeal, to review the judgments, orders, and decrees of the Supreme Courts of the several Territories as by this act they may have to review the judgments, orders, and decrees of the District Courts and Circuit Courts; and for that purpose the several Territories shall, by order of the Supreme Court, to be made from time to time, be assigned to particular circuits.

APPROVED March 3, 1891.

JUDICIARY ACT OF 1893 [1]

27 STATUTES AT LARGE, PAGE 434, CHAP. 74

An Act to establish a Court of Appeals for the District of Columbia, and for other purposes

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the Court of Appeals of the District of Columbia, which shall consist of one chief justice and two associate justices, who shall be appointed by the President, by and with the advice and consent of the Senate, and shall hold office during good behavior.

SECTION 7. That any party aggrieved by any final order, judgment, or decree of the Supreme Court of the District of Columbia, or of any justice thereof, may appeal therefrom to the Court of Appeals hereby created;

[1] All parts not relevant to patent law are omitted.

and upon such appeal the Court of Appeals shall review such order, judgment, or decree, and affirm, reverse, or modify the same as shall be just. Appeals shall also be allowed to said Court of Appeals from all interlocutory orders of the Supreme Court of the District of Columbia, or by any justice thereof, whereby the possession of property is changed or affected, such as orders for the appointment of receivers, granting injunctions, dissolving writs of attachment, and the like; and also from any other interlocutory order, in the discretion of said Court of Appeals, whenever it is made to appear to said court upon petition that it will be in the interest of justice to allow such appeal.

SECTION 8. That any final judgment or decree of the said Court of Appeals may be re-examined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all causes in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the same manner and under the same regulations as heretofore provided for in cases of writs of error on judgment or appeals from decrees rendered in the Supreme Court of the District of Columbia; and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty or statute of or an authority exercised under the United States.

SECTION 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals

created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

APPROVED February 9, 1893.

JURISDICTION ACT OF 1897

29 STATUTES AT LARGE, PAGE 695, CHAP. 395

An Act Defining the jurisdiction of the United States Circuit Courts in cases brought for the infringement of letters patent

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That in suits brought for the infringement of letters patent the Circuit Courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business. If such suit is brought in a district of which the defendant is not an inhabitant, but in which such defendant has a regular and established place of business, service of process, summons, or subpœna upon the defendant may be made by service upon the agent or agents engaged in conducting such business in the district in which suit is brought.

APPROVED March 3, 1897.

PATENT ACT OF 1897

29 Statutes at Large, Page 692, Chap. 391

An Act Revising and amending the statutes relating to patents

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and eighty-six of the Revised Statutes be, and the same hereby is, amended by inserting on line four, after the word "country," the words "before his invention or discovery thereof," and on line five, after the word "thereof," the words "or more than two years prior to his application," so that the clause so amended will read as follows:

Section 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 2. That section forty-nine hundred and twenty of the Revised Statutes be, and the same hereby is, amended by adding to the third clause of said section after "thereof" and before "or" the following words:

"or more than two years prior to his application for a patent therefor," so that the section so amended will read as follows:

"SECTION 4920. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

"First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

"SECOND. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

"Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

"Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

"Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

"And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had 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."

SECTION 3. That section forty-eight hundred and eighty-seven of the Revised Statutes be, and the same hereby is, amended by inserting on line one, after the words "no person," the words "otherwise entitled thereto," and on line three, after the words "caused to be patented," the words "by the inventor or his legal representatives or assigns," and by erasing therein all that portion of the section which follows the words "in a foreign country," on lines three and four, and substituting in lieu thereof the following: "unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country" so that the section so amended will read as follows:

"SECTION 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country."

SECTION 4. That section forty-eight hundred and ninety-four of the Revised Statutes be, and the same hereby is, amended by striking out the words "two years" in every place where they occur and substituting in lieu

thereof the words "one year," so that the section so amended will read as follows:

"SECTION 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

SECTION 5. That section forty-eight hundred and ninety-eight of the Revised Statutes be, and the same hereby is, amended by adding thereto the following sentence:

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance," so that the section so amended will read as follows:

"SECTION 4898. Every patent or any interest therein shall be assignable in law by an instrument in writing, and the patentee or his assigns or legal representatives may in like manner grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a

valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance."

SECTION 6. That section forty-nine hundred and twenty-one of the Revised Statutes be, and the same hereby is, amended by adding thereto the following sentence:

"But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action," so that the section so amended will read as follows:

"SECTION 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complain-

ant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall [have] the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

"But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action."

SECTION 7. That in every case where the head of any Department of the Government shall request the Commissioner of Patents to expedite the consideration of an application for a patent it shall be the duty of such head of a Department to be represented before the Commissioner in order to prevent the improper issue of a patent.

SECTION 8. That this Act shall take effect January first, eighteen hundred and ninety-eight, and sections one, two, three, and four, amending sections forty-eight hundred and eighty-six, forty-nine hundred and twenty, forty-eight hundred and eighty-seven, and forty-eight hundred and ninety-four of the Revised Statutes, shall not apply to any patent granted prior to said date, nor to any application filed prior to said date, nor to any patent granted on such an application.

APPROVED March 3, 1897.

PATENT ACT OF 1899

30 Statutes at Large, Page 915, Chap. 227

An Act to amend section forty-eight hundred and ninety-six of the Revised Statutes

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and ninety-six of the Revised Statutes is hereby amended by inserting after the words "in his lifetime" the following words: "and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve upon his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane;" and by inserting at the end of said section the following words: "The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made," so that the said section as amended will read as follows:

"Section 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees in as full manner and on the same terms

and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made."

APPROVED February 28, 1899.

PATENT ACT OF APRIL, 1902

32 STATUTES AT LARGE, PAGE 95, CHAP. 417

An Act to amend section forty-eight hundred and eighty-three of the Revised Statutes, relating to the signing of letters patent for inventions

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and eighty-three of the Revised Statutes be, and is hereby, amended so as to read as follows:

"SECTION 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of

Patents, and they shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose."

APPROVED April 11, 1902.

PATENT ACT OF MAY, 1902

32 STATUTES AT LARGE, PAGE 193, CHAP. 783

An Act to amend section forty-nine hundred and twenty-nine of the Revised Statutes, relating to design patents

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-nine hundred and twenty-nine of the Revised Statutes be, and the same is hereby, amended so as to read as follows:

"SECTION 4929. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor."

APPROVED May 9, 1902.

PATENT ACT OF 1903

32 STATUTES AT LARGE, PAGE 1225, CHAP. 1019

An Act to effectuate the provisions of the additional act of the international convention for the protection of industrial property.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and eighty-seven of the Revised Statutes is amended by changing the word "seven" to "twelve," and by inserting after the word "months" the words "in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months, in cases of designs," and by adding the following words: "An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in the foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or

a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use, or on sale in this country for more than two years prior to such filing;" so that the section so amended shall read:

"SECTION 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for

an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing."

SECTION 2. That section forty-eight hundred and ninety-two of the Revised Statutes is amended by inserting after the words "notary public" the words "judge or magistrate having an official seal and authorized to administer oaths," and by adding at the end thereof the words "whose authority shall be proved by certificate of a diplomatic or consular officer of the United States;" so that the section so amended shall read:

"SECTION 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States."

SECTION 3. That section forty-eight hundred and ninety-six of the Revised Statutes is amended by adding thereto the following sentence: "The executor or adminis-

trator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States;" so that the section so amended shall read as follows:

"SECTION 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States."

SECTION 4. That section forty-nine hundred and two is amended by striking out the words "citizen of the United States" in the first line thereof, and substituting the word "person" in place thereof, and by striking out

the last clause of said section; so that this section so amended shall read as follows:

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

APPROVED March 3, 1903.

THEODORE ROOSEVELT.

PATENT ACT OF MAY 23, 1908

35 STATUTES AT LARGE, 245

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and ninety-six of the

Revised Statutes be, and the same is hereby, amended so that the section shall read as follows:

"SECTION 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased in case he shall have died intestate, or if he shall have left a will disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor, shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made."

APPROVED May 23, 1908.

PATENT ACT OF MAY 23, 1908

35 STATUTES AT LARGE, 246

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and eighty-five of the Revised Statutes be, and the same hereby is, amended to read as follows:

"SECTION 4885. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld."

APPROVED May 23, 1908.

PATENT ACT OF MARCH 4, 1909

36 STATUTES AT LARGE, 1094

Forging etc. letters patent.

SECTION 27. Whoever shall falsely make, forge, counterfeit, or alter any letters patent granted or purporting to have been granted by the President of the United States; or whoever shall pass, utter or publish as genuine any such forged, counterfeited, or falsely altered letters patent, knowing the same to be forged, counterfeited or falsely altered, shall be fined not more than five thousand dollars and imprisoned not more than ten years.

COURT OF CLAIMS ACT OF JUNE 25, 1910

36 STATUTES AT LARGE, 851

An Act to provide additional protection for owners of patents of the United States, and for other purposes

Be it enacted, etc., That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover reasonable compensation for such use by suit in the Court of Claims: *Provided, however,* That said Court of Claims shall not entertain a suit or reward compensation under the provisions of this Act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of the United States: *Provided further,* That in any such suit the United States may avail itself of any and all defences, general or special, which might be pleaded by a defendant in an action for infringement, as set forth in Title Sixty of the Revised Statutes, or otherwise: *And provided further,* That the benefits of this Act shall not inure to any patentee, who, when he makes such claim is in the employment or service of the Government of the United States; or the assignee of any such patentee; nor shall this Act apply to any device discovered or invented by such employee during the time of his employment or service.

APPROVED June 25, 1910.

PATENT ACT OF JULY 16, 1914

38 STATUTES AT LARGE, 491

Duties of Assistant Commissioners.

The First Assistant Commissioner of Patents and the Assistant Commissioner of Patents shall hereafter perform such duties pertaining to the office of Commissioner of Patents as may be assigned to them, respectively, from time to time, by the Commissioner of Patents.

PATENT ACT OF MARCH 3, 1915

38 STATUTES AT LARGE, 958

(R. S., § 4888, as amended, Act March 3, 1915, c. 94, Sec. 1.) Requisites of application, description, specification, and claim.

Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or dis-

covery. The specification and claim shall be signed by the inventor.

(R. S., § 4889, as amended, Act March 3, 1915, c. 94, § 2.) 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, 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.

FEDERAL ANTITRUST ACT OF OCTOBER 15, 1914

38 STATUTES AT LARGE, 730

An Act to supplement existing laws against unlawful restraints and monopolies, and for other purposes [1]

(In effect October 15, 1914)

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That "antitrust laws," as used herein, includes the Act entitled "An Act to protect trade and commerce against unlawful restraints and monopolies," approved July second, eighteen hundred and ninety; sections seventy-three to seventy-seven, inclusive, of an Act entitled "An Act to reduce taxation, to provide revenue for the Government, and for other purposes," of August twenty-seventh, eighteen hundred and ninety-four; an Act entitled "An Act to amend sections seventy-three and seventy-six of the Act of August twenty-seventh, eighteen hundred and ninety-four, entitled 'An Act to reduce taxation to provide revenue for the Government, and for other purposes,'" approved

[1] All parts having no direct bearing on the subject of Patents are omitted.

February twelfth, nineteen hundred and thirteen; and also this Act.

"Commerce," as used herein, means trade or commerce among the several States and with foreign nations, or between the District of Columbia or any Territory of the United States and any State, Territory, or foreign nation, or between any insular possessions or other places under the jurisdiction of the United States, or between any such possession or place and any State or Territory of the United States or the District of Columbia or any foreign nation, or within the District of Columbia or any Territory or any insular possession or other place under the jurisdiction of the United States: *Provided*, That nothing in this Act contained shall apply to the Philippine Islands.

The word "person" or "persons" wherever used in this Act shall be deemed to include corporations and associations existing under or authorized by the laws of either the United States, the laws of any of the Territories, the laws of any State, or the laws of any foreign country.

SECTION 2. That it shall be unlawful for any person engaged in commerce, in the course of such commerce, either directly or indirectly, to discriminate in price between different purchasers of commodities, which commodities are sold for use, consumption, or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, where the effect of such discrimination may be to substantially lessen competition or tend to create a monopoly in any line of commerce: *Provided*, That nothing herein contained shall prevent discrimination in price between purchasers of commodities on account of differences in the grade, quality, or quantity of the commodity sold, or that makes only due allowance for difference in the cost of selling or trans-

portation, or discrimination in price in the same or different communities made in good faith to meet competition: *And provided further*, That nothing herein contained shall prevent persons engaged in selling goods, wares, or merchandise in commerce from selecting their own customers in bona fide transactions and not in restraint of trade.

SECTION 3. That it shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies or other commodities, whether patented or unpatented, for use, consumption or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce.

SECTION 4. That any person who shall be injured in his business or property by reason of anything forbidden in the antitrust laws may sue therefor in any district court of the United States in the district in which the defendant resides or is found or has an agent, without respect to the amount in controversy, and shall recover threefold the damages by him sustained, and the cost of suit, including a reasonable attorney's fee.

SECTION 5. That a final judgment or decree hereafter rendered in any criminal prosecution or in any suit or proceeding in equity brought by or on behalf of the United

States under the antitrust laws to the effect that a defendant has violated said laws shall be prima facie evidence against such defendant in any suit or proceeding brought by any other party against such defendant under said laws as to all matters respecting which said judgment or decree would be an estoppel as between the parties thereto: *Provided*, That this section shall not apply to consent judgments or decrees entered before any testimony has been taken: *Provided further*, That this section shall not apply to consent judgments or decrees rendered in criminal proceedings or suits in equity now pending in which the taking of testimony has been commenced but has not been concluded, provided such judgments or decrees are rendered before any further testimony is taken.

Whenever any suit or proceeding in equity or criminal prosecution is instituted by the United States to prevent, restrain, or punish violations of any of the antitrust laws the running of the statute of limitations in respect of each and every private right of action arising under said laws and based in whole or in part on any matter complained of in said suit or proceeding shall be suspended during the pendency thereof.

SECTION 9. . . . Prosecutions hereunder may be in the district court of the United States for the district wherein the offence may have been committed.

That nothing in this section shall be held to take away or impair the jurisdiction of the courts of the several States under the laws thereof; and a judgment of conviction or acquittal on the merits under the laws of any State shall be a bar to any prosecution hereunder for the same act or acts.

SECTION 11. That authority to enforce compliance with sections two, three, seven, and eight of this Act by the persons respectively subject thereto is hereby vested in

the Interstate Commerce Commission where applicable to common carriers, in the Federal Reserve Board where applicable to banks, banking associations, and trust companies and in the Federal Trade Commission where applicable to all other character of commerce, to be exercised as follows:

Whenever the commission or board vested with jurisdiction thereof shall have reason to believe that any person is violating or has violated any of the provisions of sections two, three, seven, and eight of this Act it shall issue and serve upon such person a complaint stating its charges in that respect and containing a notice of a hearing upon a day and at a place therein fixed at least thirty days after the service of said complaint. The person so complained of shall have the right to appear at the place and time so fixed and show cause why an order should not be entered by the commission or board requiring such person to cease and desist from the violation of the law so charged in said complaint.

Any person may make application, and upon good cause shown may be allowed by the commission or board, to intervene and appear in said proceeding by counsel or in person. The testimony in any such proceeding shall be reduced to writing and filed in the office of the commission or board.

If upon such hearing the commission or board, as the case may be, shall be of the opinion that any of the provisions of said sections have been or are being violated, it shall make a report in writing in which it shall state its findings as to the facts, and shall issue and cause to be served on such person an order requiring such person to cease and desist from such violations, and divest itself of the stock held or rid itself of the directors chosen contrary to the provisions of sections seven and eight of this

Act, if any there be, in the manner and within the time fixed by said order. Until a transcript of the record in such hearing shall have been filed in a circuit court of appeals of the United States, as hereinafter provided, the commission or board may at any time, upon such notice and in such manner as it shall deem proper, modify or set aside, in whole or in part, any report or any order made or issued by it under this section.

If such person fails or neglects to obey such order of the commission or board while the same is in effect, the commission or board may apply to the circuit court of appeals of the United States, within any circuit where the violation complained of was or is being committed, or where such person resides or carries on business, for the enforcement of its order, and shall certify and file with its application a transcript of the entire record in the proceeding, including all the testimony taken and the report and order of the commission or board. Upon such filing of the application and transcript the court shall cause notice thereof to be served upon such person and thereupon shall have jurisdiction of the proceeding and of the question determined therein, and shall have power to make and enter upon the pleadings, testimony, and proceedings set forth in such transcript a decree affirming, modifying, or setting aside the order of the commission or board. The findings of the commission or board as to the facts, if supported by testimony, shall be conclusive. If either party shall apply to the court for leave to adduce additional evidence, and shall show to the satisfaction of the court that such additional evidence is material and that there were reasonable grounds for the failure to adduce such evidence in the proceeding before the commission or board, the court may order such additional evidence to be taken before the commission or board and to be adduced upon the hear-

ing in such manner and upon such terms and conditions as to the court may seem proper. The commission or board may modify its findings as to the facts, or make new findings, by reason of the additional evidence so taken, and it shall file such modified or new findings, which, if supported by testimony, shall be conclusive, and its recommendation, if any, for the modification or setting aside of its original order, with the return of such additional evidence. The judgment and decree of the court shall be final, except that the same shall be subject to review by the Supreme Court upon certiorari, as provided in section two hundred and forty of the Judicial Code.

Any party required by such order of the commission or board to cease and desist from a violation charged may obtain a review of such order in said circuit court of appeals by filing in the court a written petition praying that the order of the commission or board be set aside. A copy of such petition shall be forthwith served upon the commission or board, and thereupon the commission or board forthwith shall certify and file in the court a transcript of the record as hereinbefore provided. Upon the filing of the transcript the court shall have the same jurisdiction to affirm, set aside, or modify the order of the commission or board as in the case of an application by the commission or board for the enforcement of its order, and the findings of the commission or board as to the facts, if supported by testimony, shall in like manner be conclusive.

The jurisdiction of the circuit court of appeals of the United States to enforce, set aside, or modify orders of the commission or board shall be exclusive.

Such proceedings in the circuit court of appeals shall be given precedence over other cases pending therein, and shall be in every way expedited. No order of the com-

mission or board or the judgment of the court to enforce the same shall in any wise relieve or absolve any person from any liability under the antitrust Acts.

Complaints, orders, and other processes of the commission or board under this section may be served by anyone duly authorized by the commission or board, either (*a*) by delivering a copy thereof to the person to be served, or to a member of the partnership to be served, or to the president, secretary, or other executive officer or a director of the corporation to be served; or (*b*) by leaving a copy thereof at the principal office or place of business of such person; or (*c*) by registering and mailing a copy thereof addressed to such person at his principal office or place of business. The verified return by the person so serving said complaint, order, or other process setting forth the manner of said service shall be proof of the same, and the return post-office receipt for said complaint, order, or other process registered and mailed as aforesaid shall be proof of the service of the same.

SECTION 12. That any suit, action, or proceeding under the antitrust laws against a corporation may be brought not only in the judicial district whereof it is an inhabitant, but also in any district wherein it may be found or transacts business; and all process in such cases may be served in the district of which it is an inhabitant, or wherever it may be found.

SECTION 13. That in any suit, action, or proceeding brought by or on behalf of the United States subpœnas for witnesses who are required to attend a court of the United States in any judicial district in any case, civil or criminal, arising under the antitrust laws may run into any other district: *Provided*, That in civil cases no writ of subpœna shall issue for witnesses living out of the district in which the court is held at a greater distance

than one hundred miles from the place of holding the same without the permission of the trial court being first had upon proper application and cause shown.

SECTION 14. That whenever a corporation shall violate any of the penal provisions of the antitrust laws, such violation shall be deemed to be also that of the individual directors, officers, or agents of such corporation who shall have authorized, ordered, or done any of the acts constituting in whole or in part such violation, and such violation shall be deemed a misdemeanor, and upon conviction therefor of any such director, officer, or agent he shall be punished by a fine of not exceeding $5,000 or by imprisonment for not exceeding one year, or by both, in the discretion of the court.

SECTION 15. That the several district courts of the United States are hereby invested with jurisdiction to prevent and restrain violations of this Act, and it shall be the duty of the several district attorneys of the United States, in their respective districts, under the direction of the Attorney General, to institute proceedings in equity to prevent and restrain such violations. Such proceedings may be by way of petition setting forth the case and praying that such violation shall be enjoined or otherwise prohibited. When the parties complained of shall have been duly notified of such petition, the court shall proceed, as soon as may be, to the hearing and determination of the case; and pending such petition, and before final decree, the court may at any time make such temporary restraining order or prohibition as shall be deemed just in the premises. Whenever it shall appear to the court before which any such proceedings may be pending that the ends of justice require that other parties should be brought before the court, the court may cause them to be summoned, whether they reside in the district in which the

court is held or not, and subpœnas to that end may be served in any district by the marshal thereof.

SECTION 16. That any person, firm, corporation, or association shall be entitled to sue for and have injunctive relief, in any court of the United States having jurisdiction over the parties, against threatened loss or damage by a violation of the antitrust laws, including sections two, three, seven and eight of this Act, when and under the same conditions and principles as injunctive relief against threatened conduct that will cause loss or damage is granted by courts of equity, under the rules governing such proceedings, and upon the execution of proper bond against damages for an injunction improvidently granted and a showing that the danger of irreparable loss or damage is immediate, a preliminary injunction may issue: *Provided*, That nothing therein contained shall be construed to entitle any person, firm, corporation, or association, except the United States, to bring suit in equity for injunctive relief against any common carrier subject to the provisions of the Act to regulate commerce, approved February fourth, eighteen hundred and eighty-seven, in respect of any matter subject to the regulation, supervision, or other jurisdiction of the Interstate Commerce Commission.

SECTION 17. That no preliminary injunction shall be issued without notice to the opposite party.

No temporary restraining order shall be granted without notice to the opposite party unless it shall clearly appear from specific facts shown by affidavit or by the verified bill that immediate and irreparable injury, loss, or damage will result to the applicant before notice can be served and a hearing had thereon. Every such temporary restraining order shall be indorsed with the date and hour of issuance, shall be forthwith filed in the clerk's

office and entered of record, shall define the injury and state why it is irreparable and why the order was granted without notice, and shall by its terms expire within such time after entry, not to exceed ten days, as the court or judge may fix, unless within the time so fixed the order is extended for a like period for good cause shown, and the reasons for such extension shall be entered of record. In case a temporary restraining order shall be granted without notice in the contingency specified, the matter of the issuance of a preliminary injunction shall be set down for a hearing at the earliest possible time and shall take precedence of all matters except older matters of the same character; and when the same comes up for hearing the party obtaining the temporary restraining order shall proceed with the application for a preliminary injunction, and if he does not do so the court shall dissolve the temporary restraining order. Upon two days' notice to the party obtaining such temporary restraining order the opposite party may appear and move the dissolution or modification of the order, and in that event the court or judge shall proceed to hear and determine the motion as expeditiously as the ends of justice may require.

Section two hundred and sixty-three of an Act entitled "An Act to codify, revise, and amend the laws relating to the judiciary," approved March third, nineteen hundred and eleven, is hereby repealed.

Nothing in this section contained shall be deemed to alter, repeal, or amend section two hundred and sixty-six of an Act entitled "An Act to codify, revise, and amend the laws relating to the judiciary," approved March third, nineteen hundred and eleven.

SECTION 18. That, except as otherwise provided in section sixteen of this Act, no restraining order or interlocutory order of injunction shall issue, except upon the

giving of security by the applicant in such sum as the court or judge may deem proper, conditioned upon the payment of such costs and damages as may be incurred or suffered by any party who may be found to have been wrongfully enjoined or restrained thereby.

SECTION 19. That every order of injunction or restraining order shall set forth the reasons for the issuance of the same, shall be specific in terms, and shall describe in reasonable detail, and not by reference to the bill of complaint or other document, the act or acts sought to be restrained, and shall be binding only upon the parties to the suit, their officers, agents, servants, employees and attorneys, or those in active concert or participating with them, and who shall, by personal service, or otherwise, have received actual notice of the same.

SECTION 21. That any person who shall willfully disobey any lawful writ, process, order, rule, decree or command of any district court of the United States or any court of the District of Columbia by doing any act or thing therein, or thereby forbidden to be done by him if the act or thing so done by him be of such character as to constitute also a criminal offence under any statute of the United States, or under the laws of any State in which the act was committed, shall be proceeded against for his said contempt as hereinafter provided.

SECTION 22. That whenever it shall be made to appear to any district court or judge thereof, or to any judge therein sitting, by the return of a proper officer on lawful process, or upon the affidavit of some credible person, or by information filed by any district attorney, that there is reasonable ground to believe that any person has been guilty of such contempt, the court or judge thereof, or any judge therein sitting, may issue a rule requiring the said person so charged to show cause upon a day certain why

he should not be punished therefor, which rule, together with a copy of the affidavit or information, shall be served upon the person charged with sufficient promptness to enable him to prepare for and make return to the order at the time fixed therein. If upon or by such return, in the judgment of the court, the alleged contempt be not sufficiently purged, a trial shall be directed at a time and place fixed by the court: *Provided, however*, That if the accused, being a natural person, fail or refuse to make return to the rule to show cause, an attachment may issue against his person to compel an answer, and in case of his continued failure or refusal, or if for any reason it be impracticable to dispose of the matter on the return day, he may be required to give reasonable bail for his attendance at the trial and his submission to the final judgment of the court. Where the accused is a body corporate, an attachment for the sequestration of its property may be issued upon like refusal or failure to answer.

In all cases within the purview of this Act such trial may be by the court, or, upon demand of the accused, by a jury; in which latter event the court may impanel a jury from the jurors then in attendance, or the court or the judge thereof in chambers may cause a sufficient number of jurors to be selected and summoned, as provided by law, to attend at the time and place of trial, at which time a jury shall be selected and impaneled as upon a trial for misdemeanor; and such trial shall conform as near as may be to the practice in criminal cases prosecuted by indictment or upon information.

If the accused be found guilty, judgment shall be entered accordingly, prescribing the punishment, either by fine or imprisonment, or both, in the discretion of the court. Such fine shall be paid to the United States, or to the complainant or other party injured by the act con-

stituting the contempt, or may, where more than one is so damaged, be divided or apportioned among them as the court may direct, but in no case shall the fine to be paid to the United States exceed, in case the accused is a natural person, the sum of $1,000, nor shall such imprisonment exceed the term of six months: *Provided*, That in any case the court or a judge thereof may, for good cause shown, by affidavit or proof taken in open court or before such judge and filed with the papers in the case, dispense with the rule to show cause, and may issue an attachment for the arrest of the person charged with contempt; in which event such person, when arrested, shall be brought before such court or a judge thereof without unnecessary delay and shall be admitted to bail in a reasonable penalty for his appearance to answer to the charge or for trial for the contempt; and thereafter the proceedings shall be the same as provided herein in case the rule had issued in the first instance.

SECTION 23. That the evidence taken upon the trial of any person so accused may be preserved by bill of exceptions, and any judgment of conviction may be reviewed upon writ of error in all respects as now provided by law in criminal cases, and may be affirmed, reversed, or modified as justice may require. Upon the granting of such writ of error, execution of judgment shall be stayed, and the accused, if thereby sentenced to imprisonment, shall be admitted to bail in such reasonable sum as may be required by the court, or by any justice, or any judge of any district court of the United States or any court of the District of Columbia.

SECTION 24. That nothing herein contained shall be construed to relate to contempts committed in the presence of the court, or so near thereto as to obstruct the administration of justice, nor to contempts committed

in disobedience of any lawful writ, process, order, rule, decree, or command entered in any suit or action brought or prosecuted in the name of, or on behalf of, the United States, but the same, and all other cases of contempt not specifically embraced within section twenty-one of this Act, may be punished in conformity to the usages at law and in equity now prevailing.

SECTION 25. That no proceeding for contempt shall be instituted against any person unless begun within one year from the date of the act complained of; nor shall any such proceeding be a bar to any criminal prosecution for the same act or acts; but nothing herein contained shall affect any proceedings in contempt pending at the time of the passage of this Act.

SECTION 26. That if any clause, sentence, paragraph, or part of this Act shall, for any reason, be adjudged by any court of competent jurisdiction to be invalid, such judgment shall not affect, impair, or invalidate the remainder thereof, but shall be confined in its operation to the clause, sentence, paragraph, or part thereof directly involved in the controversy in which such judgment shall have been rendered.

APPROVED October 15, 1914.

PATENT ACT OF 1916

STATUTES AT LARGE, PAGE—

(Revised Statutes § 440 as amended.)

There shall be in the Patent Office:

One chief clerk, who shall be qualified to act as a principal examiner.

One librarian, who shall be qualified to act as an assistant examiner.

Five law examiners.

One examiner of classification.
One examiner of interferences.
One examiner of trade-marks and designs.
One first assistant examiner of trade-marks and designs.
Six assistant examiners of trade-marks and designs.
Forty-three principal examiners.
Eighty-six first assistant examiners.
Eighty-six second assistant examiners.
Eighty-six third assistant examiners.
Eighty-six fourth assistant examiners; and such other examiners and assistant examiners in the various grades as the Congress shall from time to time provide for.

(R. S., § 476, as amended, Act Feb. 15, 1916, c.—, § 1.)

Officers and employees.

There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, one assistant commissioner, and five examiners in chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioner shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. 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, in accordance with existing law.

(R. S., § 477, as amended, Act Feb. 15, 1916, c.—, § 2.)

Salaries.

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

The Commissioner of Patents, $5,000 a year.

The first Assistant Commissioner of Patents, $4,500 a year.

The Assistant Commissioner of Patents, $3,500 a year.
Five examiners in chief, $3,500 a year each.

PATENT, TRADE-MARK, AND COPYRIGHT ACT OF AUGUST 17, 1916

Extension of time for filing application, etc.; period granted.

Any applicant for letters patent or for the registration of any trade-mark, print, or label, being within the provisions of this Act, if unable on account of the existing and continuing state of war to file any application or pay any official fee or take any required action within the period now limited by law, shall be granted an extension of nine months beyond the expiration of said period.

Persons who may take advantage of extension of time for filing application, etc.

The provisions of this Act shall be limited to citizens or subjects of countries which extend substantially similar privileges to the citizens of the United States, and no extension shall be granted under this Act to the citizens or subjects of any country while said country is at war with the United States.

Defaults within scope of extension of time for filing application, etc.

This Act shall be operative to relieve from default under existing law occurring since August first, nineteen hundred and fourteen, and before the first day of January, nineteen hundred and eighteen, and all applications and letters patent and registrations in the filing or prosecution whereof default has occurred for which this Act grants relief shall have the same force and effect as if said default had not occurred.

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