THE

LAW OF PATENTS

FOR INVENTIONS;

INCLUDING THE

REMEDIES AND LEGAL PROCEEDINGS IN RELATION TO

PATENT RIGHTS.

By WILLARD PHILLIPS.

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PREFACE.

THE subject of Patent Rights has become of great importance in the United States, on account of the number of persons interested in them, their influence on the progress of the useful arts, and the numerous judicial decisions relating to them. The exclusive privilege granted to inventors, by the act of 21 James I., c. 3, has, until within a few years past, been regarded with jealousy in English jurisprudence, as being a surviving branch of monopolies, all of which, excepting those for new manufactures, were suppressed by that act. Patents have, however, been recently regarded with greater indulgence, by the English courts. In the United States they have always been fairly sustained, and patentees have been regarded with favor, as pioneers in the advancement of the productiveness of the national industry; and much light has been shed upon this branch of law by the elaborate opinions given by the most eminent judges in the national courts, particularly the late Chief Justice Marshall, and the other judges in the Supreme Court, and by Mr. Justice Washington in the Circuit Court for Pennsylvania, and Mr. Justice Livingston and Mr. Justice Thompson in that for New York. But it is no injustice to the other eminent jurists of the country to say, that this department of law has been more especially indebted to the learning and talents of Mr. Justice Story, the records of whose indefatigable research and luminous expositions, will be found in many parts of this volume.

The decisions, both English and American, down to 1822, had been digested and arranged in Mr. Fessenden's second edition of his very useful work on Patents, published at that time, but the numerous subsequent decisions, as well as the subsequent legislation, seemed to call for a new work upon the subject.

Nearly half of the following treatise was already printed, when I learned that a new patent law was reported to Congress at its last session, whereupon the press was stopped, and the publication delayed, to await the proceedings of the legislature. The proposed act was finally passed on the 4th of July last, by which all the former acts on the same subject were repealed. The former acts will of course remain in force in some respects in application to patents subsisting when they were repealed, since it must depend upon the laws as they are at the time of issuing a patent, whether the subject is patentable, the specification sufficient, and the proper steps taken to secure the exclusive privilege. Though the act of 1836 should have made ever so extensive alterations in these particulars, still it would have been necessary to present the former laws, as well as the provisions of the new one, in a treatise published at the present time. But, in fact, the new law has not made any material alterations in regard to what may be the subject of a patent, and what is a sufficient specification. It partially follows the former laws in other respects, but, as will appear in various parts of the following treatise, makes many important alterations, some of rather an experimental character, but others, which are undoubtedly improvements: so that on the whole, the law now stands materially better than it did before the act was passed.

I have been indebted to the assistance of Edward Pickering, Esq., in collecting, analyzing and digesting the cases.

W. P.

Boston, *Nov.* 10, 1836.

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TREATISES ON THE LAW OF PATENTS.

An Essay on the Law of Patents for New Inventions, to which are prefixed two chapters on the General History of Monopolies, and on their introduction and progress in England to the time of the interregnum, with an Appendix containing copies of the Caveat, Petition, Oath, and other Formula, with an Arranged Catalogue of all the Patents granted from January 1800 to the present time. Second Edition. By John Dyer Collier. London: 1803.

This work consists of 200 pages, large 8vo., with an Appendix of 116 pages.

The Law and Practice of Patents for Inventions. By William Hands, Gent., one of the Solicitors of the Court of Chancery. London: 1808.

This is a small volume of 148 pages, 8vo.

A Collection of the most Important Cases respecting Patents of Invention, and the Rights of Patentees which have been decided since the Statute for the restriction of Monopolies, followed by some Practical Observations. By John Davies. 1816.

This is a work in high estimation, and is often cited in the following treatise. It is a volume of 452 pages, large 8vo, 415 of which are occupied by reports of cases, and the remainder by the practical observations of the author.

A Practical Treatise on the Law of Patents for Inventions and of copyright. By Richard Godson. London: 1823.

Mr. Godson was the first English author who arranged the Patent Laws in the form of a methodical digested treatise. His work consists of 452 pages 8vo., 201 of which are occupied by his introduction on the subject of monopolies, and his digest of the jurisprudence on patents. The remainder is occupied with the law of copyright, legal proceedings in patent and copyright cases, and an appendix containing forms, and the

act of 21 James I., c. 3, (1623,) commonly called the *Statute* of *Monopolies.*

A Supplement to a Practical Treatise on the Law of Patents for Inventions, with Suggestions of many Alterations in that law, and an Abstract of the Laws in force in America, Spain, Austria, Netherlands and France. By Richard Godson, M. P. Barrister at Law. London: 1832.

This publication brings the digest of cases to 1832, and contains some cases not reported elsewhere.

An Analysis of the Law of Patents. By Robert Richard Rankin. London: 1824.

This is a small but valuable treatise of 117 pages, 12mo.

A Practical Treatise of the Law of Patents for Inventions. By Edward Holroyd, Esq. Barrister at Law, Commissioner of Bankrupts. London: 1830.

This work consists of 219 pages, large 8vo, 188 being text, and 31 of Appendix.

Repertory of the Arts. London.

This periodical gives a list of patents granted, and publishes some of the Specifications, with occasional reports of patent cases. It will be found to be cited for reports of some of the cases mentioned in the following work.

An Essay on the Law of Patents for New Inventions. By Thomas Green Fessenden, Counsellor at Law. Second Edition. Boston: 1822.

This work consists of 425 pages, 8vo., and embraces the English and American decisions down to the time of its publication; arranged and digested in the order of the Sections of the act of Congress of Feb. 21, 1793. Mr. Fessenden has an interesting introduction of some length on the progress and importance of the useful arts.

Letter to the Secretary of State transmitting a list of all Patents granted by the United States; the Acts of Congress relating thereto, and the decisions of the Courts of the United States under the same. January 13, 1831.

This is a report by Doct. Thomas P. Jones, made to the Secretary of State in pursuance of a resolution of the House of Representatives, April 2, 1830. The author of this report was formerly Superintendant of the Patent Office, and is scientifically and practically skilled in the subject of useful arts and inventions, and familiar with the law and practice on the subject of patents.

Journal of the Franklin Institute. Philadelphia. Edited by Thomas P. Jones, M. D.

In this Journal, Dr. Jones gives a list of Patents granted, some of the Specifications at length; and remarks upon the patents, with occasional reports of patent cases, and communications relating to the subject of Patent rights.

Traité des Brevets D'Invention, &c. A Treatise concerning Patents for Inventions, for Improvements and for Importations, [inventions introduced from abroad] followed by an Appendix, containing the Laws and regulations enacted in France, an abstract of the English Legislation; the Laws of the United States and of Spain. By Augustin Charles Renouard, Advocate of the Court Royal of Paris. Paris: 1825.

This is the most elaborate work on Patents that has been published in France, which has come to my knowledge. The treatise consists of 417 pages, 8vo., and the Appendix of 84 pages. It has not, to my knowledge, been translated into English. It will be found to be frequently cited in the following treatise.

De La Legislation et de la Jurisprudence, &c. Of the Legislation and the Jurisprudence concerning Patents for Inventions, Improvements and Importations. By Theodore Regnault. Paris: 1825, 8vo.

The French Law and Practice of Patents, for Inventions, Improvements, and Importations. By A. Perpigna, A. M. L. B., Barrister in the Royal Court of Paris, Member of the Society for the Encouragement of the Arts, &c. Paris: 1832.

This is the title of the work in English, published by the author in France. It consists of 142 pages, large 8vo., and is a very useful practical treatise on the French Patent Laws for English and American inventors, who wish to become acquainted with those Laws, for whose use it is particularly designed. The work has been reprinted in the "Law Library," published in Philadelphia, and makes a part of the fourth volume of that collection.

Law of Patent Inventions. By Blanc de St. Bonnet.

Treatise on Patents. By Cochaud.

The Law of Patents for Inventions, familiarly explained for the use of Inventors and Patentees. By W. Carpmael. London: 1832. Second Edition, 1836.

The contents of this work are arranged under the following heads, viz. Patents, Caveats, Proceedings in taking out Patents, the Specification,

the Act of 5 and 6 W. IV, c. 83. (1835) and observations upon it, an Analysis of, and Remarks upon British Patents, Legal Proceedings upon Patents, and Observations upon Patent Laws and the manner of trying Patent causes, with a very full Appendix of Forms. It consists of 128 pages, large 8vo. The author's remarks upon the application of a principle on the subject of a patent, constitute a valuable part of his work.

Report from the Select Committee, on the Law relating to Patents for Inventions, ordered by the House of Commons to be printed June 12th, 1829.

This Report consists of 260 closely printed pages, folio, of which 160 comprise the statements of twenty different persons, barristers at law, engineers, manufacturers, and clerks employed in the patent department, and persons conversant with the practice of taking out patents, viz. John Taylor, Davies Gilbert, John Farey, Mr. Dyer, Mark Isambard Brunel, Arthur Aikin, Charles Few, Francis Abbott, William Newton, Moses Poole, Joseph Merry, Samuel Morton, Samuel Clegg, John Millington, Walter Henry Wyatt, John Macarthy, Benjamin Rotch, John Isaac Hawkins, Arthur Howe Holdsworth, and Thomas Aspinwall.

The Statements of Mr. John Farey and Mr. Benjamin Rotch are very full on the subject of the defects in the British patent law, and the difficulties of sustaining a patent in trials at law. The remaining part of the Report is an Appendix furnished by Mr. John Farey, who appears to be thoroughly acquainted with the British and other patent laws, and the practice in taking out patents, and the trials of patent causes. This Appendix comprises the British legislation on Patents, general and special, down to 1829; reports of the most important patent causes in the English courts; and the legislation on this same subject in France, the Netherlands, Austria, and Spain. The work contains a great body of practical information on patent laws and the practice under them. It is cited in various places in the following treatise, and in some instances in the earlier part by mistake, as a report of 1832 instead of 1829.

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LAW OF PATENT RIGHTS.

CHAPTER I.

Definition.

PATENTS are so called by abbreviation for *letters patent*, that is *open (patentes)* letters, a phrase applied to letters or writings addressed by the government, or by the sovereign, or at least by a superior authority, to individuals, as distinguished from letters sealed up, or enclosed, and, like these latter, being directed to individuals, they are by this circumstance distinguished from proclamations addressed to the whole people. The expression *patent* thus substituted for letter patent, is applied to cases of making a grant, as of land, or some privilege, or giving a commission or authority, as in the cases of patents conferring some office. The word *brevet*, used in the French language in a corresponding sense, is applied to a commission or a grant of rank or office, as

brevet of duke.[1] So the French expression for a *patent* in our sense is *brevet d'invention*, or grant of invention; which confers on the person to whom the brevet is granted, the same privilege in respect to an invention, that is enjoyed under other brevets in respect to the office or rank or other thing to which it relates.

In English the dictionaries define a *patent* to be a *writ* granting an exclusive privilege. *A writ (writing)* is commonly used to signify a mandate or commission by the sovereign authority, and in this latter sense corresponds to the French term *brevet*, but it is not applied to mere grants, as of land, and it does not accordingly express the distinguishing characteristic of a *patent*, which is a grant rather than a commission, and does not partake at all of the nature of a mandate; since the grant of a privilege does not import a prohibition on all people not to infringe upon that privilege, any more than grant of a manor implies an injunction upon all other persons not to commit a trespass upon it. There is nothing of *command* essentially belonging to the instrument.

In respect to inventions, then, a patent is a grant by the state, of the exclusive privilege of making, using and vending, and authorizing others to make, use and vend, an invention. It is a monopoly of the invention. The monopoly may be unrestricted, in

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[1] Brevet de duc.

geographical extent, and so be coextensive with the authority of the state or government granting it, or may be confined to a certain territory ; so in respect to duration, it may be for an indefinite or a limited period ; and again in its nature or character it may be either absolute, or subject to certain qualifications and conditions. So again in respect to the persons who may become interested, it may be limited to the patentee personally, as is usual in grants of offices, or extend to him, his personal representatives and assigns.

CHAPTER II.

Principles and Motives of the Legislation on Patent Rights.

PROPERTY in an art, process, or method, is not, like most other species of personal property, susceptible of exclusive manual possession, and, therefore, is not of a description to arise in a very early and rude state of the laws and jurisprudence of a community ; for though a machine or a composition of matter may be appropriated by exclusive possession, it is otherwise with the art of making the machine, and the method

of compounding the materials, and these, as will subsequently be shown more particularly, are the subjects of the discovery, the exclusive right to which is granted by a patent. In respect to things that can be visibly and exclusively possessed, the producer or first occupier is acknowledged, by the laws of nature, to have established his right of property by his possession, and the laws then supervene to guaranty and protect the right. But the exclusive right to the use of a discovery in the arts, must originate in a conventional law: the law must be expressly passed or tacitly recognised, before this right of property can exist. The species of property arises from improvements in the arts, and it is acknowledged and secured only in an improved state of the laws.

M. Renouard, the author of an elaborate French work on Patents, goes into a particular discussion of the question whether an inventor has, by the principles of universal equity, and independently of the positive law, an exclusive right to his invention; and he very satisfactorily establishes the conclusion to which every mind is constrained to yield assent, that no such natural right exists. Indeed there is no plausible ground whatever on which to rest such a right, since the fact of one person being the first inventor or discoverer, affords no pretence for disfranchising others of the right, in their turn, of making and using the same discovery.

If then there is no such natural right, the question

naturally arises, whether the law, granting the exclusive privilege to an inventor, is not unjust? whether it does not wrong other persons, by depriving them of their natural rights? It undoubtedly does take away rights which they would otherwise have, but it does not thence follow that it is unjust. It is the effect of many laws to take away rights which men would enjoy, if each one existed in a state of entire independence of all others, if such a condition were possible; but it does not thence follow that the laws are injurious to any one, since they give more than an equivalent for what they take away. The rights taken from the members of the community generally, are, first, that of discovering or inventing the same thing, independently of the prior invention, and that of using and vending it for a limited time; and second, the right of profiting by the prior invention or discovery of another, for a limited time. This last right is evidently subject to some qualification, for it is certainly just that the inventor should have a greater advantage of his invention than others, whereas if he is exposed to a universal competition in the manufacture and use of his invention, the probability is, that others will turn it to better account than he can himself, since the chances are very great that some one may possess greater advantages for prosecuting the manufacture and selling the article. Without some assistance from the legislature, therefore, he will be deprived of what he is equitably entitled to.

If it be then admitted that he is equitably entitled to the exclusive use and sale for a time, against all others who do not make use of the same invention independently of him, and without deriving any hint or facility from his prior ingenuity or experiments, we have sufficient ground for a law giving him the exclusive right against *all* others for a time, since it is a matter of too much difficulty and intricacy of proof, to distinguish the cases of others who have made the same invention without any assistance from his ingenuity, from those of mere imitations. The law, in order to be practicable and convenient to be administered, must give the exclusive right. To this point the law is only an equitable regulation, which does not *propose* to deprive others of any right in behalf of inventors, but *incidentally* deprives them of a right, which they would otherwise have, because it is necessary for the purpose of doing justice to inventors.

The granting of patents is not, accordingly, a mere matter of favor, as it has sometimes been represented by judges,[1] but an equitable and just claim upon the government, as much so as the claim to protection of individual industry and private property. "The

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[1] "Although," says Mr. Justice Bayley, "the thing may be new in every particular, it is in the judgment of the Crown whether it will or will not, *as a matter of favor*, make the grant." Brenton v. Hawkes, 4 B. & Ald. 552.

patentee," says Lord Eldon, "is a purchaser from the public, being bound to communicate his secret to the public at the expiration of his patent."[2] This right is recognised in very strong and absolute terms in the decree of the French National Assembly.[3] The language is, "Every new idea, of which the manifestation or development might be useful to society, appertains originally to the person who has conceived it; and not to regard a discovery in industry as the property of the discoverer, would be to attack the rights of man in their essence." This language is, however, too comprehensive, as we have already suggested, that the granting of a perpetual exclusive right to an invention, would be a material retrenchment of the rights of others, and so the National Assembly doubtless considered it; for after this preamble they proceed, not to grant such a perpetual privilege, but only a temporary monopoly.

M. Renouard[4] remarks, that "an inventor has not, independently of positive laws, any exclusive property in his invention, any longer than he keeps it secret. That is, others have a right to make the same discovery themselves, independently of him, or to avail themselves of the inventor's disclosure of his secret, and this conflicting right of others, intercepts, and in

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[2] Williams v. Williams, 3 Meriv. 157.
[3] January 7th, 1791. *Renouard*, p. 423. Ed. of 1825.
[4] P. 32, c. 2, s. 1.

many cases in fact entirely defeats, any advantage to the inventor from a right universally admitted ; for he often cannot use his invention, and at the same time keep it secret, and thus the very attempt to obtain the benefit of his discovery, forfeits it. This strengthens his claim on society, for it is precisely the case of an individual too weak to protect himself, and who, therefore, asks the protection of the community. If he is able to keep his secret, and yet turn it to profitable account, his case is that of the head of a powerful party or clan, who is able to defend and protect himself without the aid of a superior power. Such an inventor is in a condition to make his own terms with the community, for the surrender of his secret; and when the terms proposed by the laws are not satisfactory to him, he may reject them. This is, however, true of but very few inventors. They can, in general, at most only lock up their secret in their own breasts, not being able to turn it to any advantage to themselves, except by means of a law enacted in their behalf. Their claim on the community, therefore, for interposition in their behalf, is exceedingly strong ; they are entitled to assistance from the combined authority of the community, and it is essentially necessary to them.

Though *property* in a discovery, therefore, like that in land, originates in and is created by legislation, the *right* to such property exists to an imperfect degree, independently of the positive laws. In this

view Mr. Rawle remarks, that upon the provisions of the constitution of the United States on this subject, that it was not intended thereby to create rights, but merely to regulate those already existing.[5] The inventor has a *right* to keep his secret, and if he discloses it he has a just claim to remuneration and reward, according to the amount of his expenditure, and the importance of his improvement.

"Many people form an erroneous notion of the kind of merit, and the degree of application, requisite for making improvements in manufactures. They seem to imagine that most of those improvements are lucky hits, which it is only surprising that nobody ever made before; and so they are unwilling to bestow rewards with liberality on such as they conceive owe their success to fortunate accident, rather than to merit. Yet a little reflection may show how erroneous this opinion is. The great mass of useful inventions is made up, and must be, not of what is altogether new, but of improvements in what is already practised. Such improvements, it is also to be remembered, are more eagerly sought after, and by a greater number of competitors, when manufactures have so far advanced as to employ many hands in a single branch. Since then it must be a very limited branch that employs only a thousand persons; how is

[5] Rawle on the Constitution, c. 9, p. 102. Ed. of 1825.

it probable, that in a business where at least that number have been employed for years, any improvement can come to be discovered by chance? Is it not obvious that all the improvements mere chance could bring about, are likely to be discovered at a very early period of such a business; more especially under the operation of a patent law, to give to every eye the quick-sightedness of self-interest? Yet persons are heard thoughtless enough to exclaim, of such an improvement as James Watt's on the steam-engine, 'How simple! and, how wonderful nobody ever found it out before!' They that say of such an invention, 'How simple!' should consider what they mean. If the simplicity they speak of, refers to the adaptation of the means to the end, they are quite right. In this acceptance, simplicity is the very highest merit of an invention; for of all the means that can be used to effect a given end, the simplest are evidently the best. But if when they say, 'How simple!' they mean, how easy to be done, and how easy to be found out, they are as wrong as they can be. For if the contrivance was thus easy to be hit upon, why had it been missed by the numerous persons engaged for so many years before, in the making, in the working, and even in the improving of steam engines? The very simplicity of an invention, which leads the inexperienced to infer little merit or application in the inventor, is most

commonly the sequel of complications, which in succession have been contrived by him, and in succession been rejected. Indeed, who that ever cast a glance of intelligent observation upon our manufactures, or that has ever been struck with the combined simplicity and efficacy of the means employed, can do otherwise than infer that any one of the means that he admires, must have been selected for superiority, when perhaps a thousand others have been rejected? So far from simple means of effecting an end being proportionably obvious to adopt, whoever has opportunities of watching young persons beginning to cultivate any branch of experimental science, may observe that complicated means to effect an end are those they try first; and indeed, whenever there is witnessed, as in the case of Watt, an early or immediate adoption of simple means to accomplish a desirable end, it is safe to infer the possession of great powers, such as experience, in their exercise, can alone inspire. In the attempt of Watt, the only circumstance that can be attributed to chance, was, that a working model of a steam engine came into his hands to be repaired. But what made that model suggest to his mind, inquiries and doubts that had never struck any mind before? No one can read the simple account of his discovery, as given by himself, in his Notes to Dr. Robinson's Works, without being satisfied that when that model came into his hands, it was to undergo a scrutiny,

such as the steam engine in no form had ever before been subjected to."[6]

Another reason for granting this species of monopoly, is, that the whole community has an interest in the advancement of the useful arts, since the greater the perfection to which they are brought, the greater will be the amount of necessaries, conveniences, comforts, luxuries and amusements, within reach of every one, for the same expense. This presents a good reason, not merely for indemnifying the inventor or improver of an art, for his expense of time, labor and outlay, but also for giving him an absolute reward. It would be considered paltry to maintain that a general, who had achieved a victory, was sufficiently compensated by his pay, during the time he gave to the achievement. He is considered a benefactor to his country, and, as such, entitled not merely to his pay, but to a *reward*. So is the inventor of a useful art a benefactor to his country, and to the whole civilized world, and as such entitled to a *reward*. It is a debt due to him; not one that he can demand by virtue of the law of nature, and independently of all civil institutions, but one which it ought to be the early care of the positive laws to acknowledge and satisfy.

Without some encouragement and hope of indemnity for expenses, held out by the law, many inven-

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[6] Westminster Review, No. 43, for January, 1835.

tions, after being made, would not be rendered practically useful. "Very few inventions in manufactures are perfect, when first contrived and introduced into practice. Much further improvement is often needful, in order to overcome unforeseen difficulties, and to meet all the wants of a manufacture conducted on a large scale. Prejudice, too, has to be overcome. The sanction of experience is wanting to confirm the advantage, and still more the permanence of the improvement. After Watt had taken out his patent, he was six years before he succeeded in making one steam engine according to his plan, matured in all its principles at least, as his patent and specification show it to have been. Part of this time was lost, perhaps, by inactivity; another part by the failure of Roebuck, of the Carron Works, with whom he first associated himself, and perhaps a still greater part was owing to the imperfection of machinery in his time. But, making allowances for these causes of delay, still it is true that at least three or four years were necessary, to obviate the practical difficulties that lay in the way of making such an engine well, for the first time. Such difficulties, and others too, attend all important new inventions in manufactures. The bringing of them into notice, the gaining of confidence in their permanence and worth, and the overcoming of prejudice against them, on account of their very novelty, require time, care, and much outlay. To insure success in such an under-

taking, it is not unusual to spend years in overcoming the physical difficulties of a new manufacture, to employ travellers, and advertise extensively, in order to bring the invention into general notice, to make a great outlay in order to establish the new manufacture, merely as an example for others to follow, or sometimes a greater outlay in order to get it established on a large scale, so as to admit of a subdivision of labor, and the perfection of it in all its parts. Now without the encouragement of a patent, how is any man to engage in a novel and expensive process, if the moment he succeeds, at the cost of all this outlay, he must be sure that his neighbors, who were cautious enough to shun all chances of loss, will come into competition with him, and make the remuneration of all this outlay impossible ? A landlord, possessing a farm that could not be made productive, till after the lapse of years, with continued cultivation and much outlay, will never get it rented without granting a lease ; and unless he makes such a grant, or undertakes the labor and expense himself, the farm will remain for ever unproductive. Quite similar is the policy of granting patents, which may be considered leases for the cultivation of unprofitable farms, of manufactures, granted partly to reward the merit of invention, and partly to remunerate the cost attending the introduction of the improvement, and its early and unprofitable cultivation. By so granting patents, the country may hope, at the

end of their term, to possess the new manufacture in a profitable form ; whereas, by refusing patents, or withholding from them adequate protection, it will either not possess the inventions, or, if it do possess them, it will be in the form of unapplied and barren suggestions. Give the husbandman security that he may sit 'under his own vine, and his own fig tree,' and the magic of that security will raise the vine and the fig tree, where else would be the barren wilderness. Watt, it has been said, spent six whole years in bringing his invention into a good working state. The late Lord Norton, of Leith, the inventor of the patent slip, as a substitute for dry docks, lost the same time, before his patent became profitable to him, although he brought the invention early into use. A like loss of time prior to the invention becoming productive, appears from inquiry, to be an almost constant occurrence in important inventions. Here is the authority of Mr. Farey, in the report" of the committee of the House of Commons, on the subject of patents, in May, 1833, "for saying, that the expense of making the first steam engine on the plan of Watt, was such as no maker could have been remunerated for, by any subsequent outfit he could make, without the aid of what occurred from the patent, or some other extraneous source. And indeed, but for the security which Watt erroneously conceived the patent law to afford, there is little doubt that the invention might at this day have been sneeringly re-

corded by some author, styling himself practical, as a suggestion 'exceedingly ingenious in theory, but altogether useless in practice.'"[7]

The principles and motives of patent laws, then, are, 1, the securing to the inventor the remuneration of his outlay; 2, a reward for his ingenuity, and the benefit he confers on the community; and 3, to encourage and stimulate invention and improvements.[8]

The invention of lithographic printing by Senefelder has been instanced in illustration of the labors and difficulties of an invention, and the influence of motives in stimulating the inventive faculties. He was the son of an actor, and had himself written a play, which, however, he was too poor to get printed. To overcome this obstacle he conceived the bold idea of inventing a cheaper mode of printing than with types. "Nor was the success less wonderful than the attempt. Not by any chance, not by

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[7] Westminster Review, No. 43. January, 1835. p. 94. Foster's Am. Edition.

[8] Per Story J. Lowell v. Lewis, Mason R. 182. See Holt's N. P. C. 58. n. Though monopolies, in the eye of the law, are odious, says Lord C. J. Eyre, in the case of Boulton v. Bull, 2 H. B. 500, the consideration of the privilege created by this patent is meritorious, because, to use the words of Lord Coke, the inventor bringeth to and for the commonwealth a new manufacture by his invention, costs and charges. But Lord Kenyon says, "I confess I am not one of those who greatly favor patents; for though in many instances, and particularly in this, the public are benefited by them, yet on striking the balance upon this subject, I think that great oppression is practised on inferior mechanics by those who are more opulent." 8 T. R. 98. This is quite an extrajudicial reason.

a first lucky hit, but by contrivance, by experiment, by perseverance amid disappointment, and by knowledge extended from failures, he succeeded in accomplishing this daring effort of his genius, and discovering an art which, if it cannot vie with other ways of printing for extensive utility, will yet, for inventive merit, and with reference to the hopelessness of the rude but simple materials whereby it is worked, ever be ranked among the most wonderful of human inventions."[9]

The grounds and motives of this species of legislation being, then, in the first place, to indemnify inventors, in the second to secure to the public the benefit of invention, and stimulate ingenious minds to make improvements, and, in the third place, to reward the inventors as public benefactors, according to the importance of their inventions, it follows that the earlier or later disclosure of the secret, and the investing of the public with the benefits of the discovery, are essential conditions of the grant of protection and reward. It is, as M. Renouard says, an *exchange* between the two parties, the inventor on one side, who grants the community a new art or machine, and the community on the other, which grants in return to the inventor, indemnity and compensation. But as the publicity of the invention is a matter of public

[9] Westminster Review, No. 43, for January 1835.

interest more especially, it may be dispensed with by an act of special legislation, a right to which is reserved by the government, to be used, when, from fear of benefiting a public enemy or a foreign competitor in the market, the advantages are supposed to be on the side of secrecy;[10] though this latter ground is now mostly abandoned, and the former is, at the most, but occasional and temporary.

CHAPTER III.

Different Kinds of Encouragement to the Arts.

The inventor, then, having a just claim to remuneration and reward, we come next to the question what kinds of remuneration and reward are practicable and suitable. And in this respect the community is not necessarily restricted to the granting to the inventor a preference in the enjoyment of the advantages of the use of his invention. Rewards in money have in many instances been promised before hand, or awarded subsequently, for discoveries. The divine honors, paid by the Greeks and other ancient

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[10] Renouard, c. 7. s. 2. p. 276. Ed. of 1825.

nations to those who were public benefactors by their useful discoveries, originated in the principle upon which modern patent laws are founded, though the kind of reward bestowed in the two cases is different. In some instances the inventor cannot be rewarded directly out of the fruits of his invention. This is the case with many discoveries in science. Were any philosopher to discover a certain and easy method of squaring the circle, he could not be rewarded by a grant of a monopoly of the advantage, if it consisted in mere calculation. The British government offered a reward for an improvement in the mode of ascertaining the longitude. Public grants have been made to Mr. Babbage in consideration of the utility of his calculating machine. Many other instances might be enumerated in which a monopoly of the invention was not considered a practicable or a suitable or an adequate compensation to the inventor. The French government, accordingly, by a law of 1791,[1] provided for the annual distribution of 300,000 livres to artists for labors and discoveries in the useful arts, no part of which is to be given for improvements for which patents are taken out. But this species of reward is liable to much abuse by imposition on the officers of the government to whom the decision on claims is committed, and also by partiality and favor-

[1] Renouard, p. 453.

itism on their part in assigning the reward. A writer, already cited,[2] instances the 5000 guineas paid to Dr. Smith for the "discovery of nitric fumigation to prevent the communication of contagion," and says, were the reward to be granted now, "when time and experience enable the public to estimate the value of the nostrum, five pence might be considered a reward somewhat above its value.[3]

In the great mass of instances of useful improvements, however, a temporary monopoly is not only the most appropriate reward, since it is the direct fruit of the improvement, and the most equitable, since it is graduated according to its utility, in the public estimation ; and the most convenient, since, as M. Renouard justly remarks, the inventor is saved from the mistakes, favoritism and prejudices of censors, and the public from being imposed upon by charletans and pretenders. This system has accordingly been adopted throughout the civilized world as the most suitable general mode of rewarding improvements in the useful arts ; not excluding other modes, however, in special cases.

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[2] Westminster Rev. January, 1835, No. 43.

[3] M. Renouard considers the subject of encouragement of inventions by rewards, and states the objections to it very fully, c. 2, s. 3, p. 42. He does not oppose this mode of encouragement on the general objection to all bounties as interfering with the freedom of industry and checking competition, since this ground of objection is as inconsistent with patent laws themselves, as it is with other modes of encouragement.

The writer in the Westminster Review, already cited,[4] mentions a third mode of encouraging improvements in the arts adopted in some countries, by the establishment of professorships for the purpose. Where a regular routine of duties is to be performed that are within the grasp of minds not endowed with any extraordinary power, or transported by enthusiasm, professorships may be very usefully instituted. So salaries, as well as other incitements, may be held out as rewards for inventions, as well as for excellence in the practice of any art, or the knowledge of any science. The appointment of Poet-Laureate in England is of this description. So provision may be made by the public in many cases for defraying the expense of a course of experiments in some particular branch of industry or science, and, in fact, a large part of the magnificent discoveries in science, by which modern times have been illustrated, have been the fruits of such public provisions. But it is not practicable to carry this system of encouragement to all the infinitude of useful and ornamental arts by which the condition of men is ameliorated, and civilized society adorned. A stimulus must be applied, and a helping hand held out to genius in the lowest walks of life, in the work-shops and in the fields. The encouragement should be

[4] No. 43, January, 1835.

proffered freely, so as to be attainable without solicitation, and without the intervention of influence, power, and great names, so that genius may work its way in solitude, borne forward only by the impulse of its own enthusiasm. For this purpose a limited monopoly, a temporary enjoyment of all the advantages of a discovery, is not only the most appropriate, but by far the most effectual encouragement in a great majority of improvements in the useful arts.

That the monopoly should be only temporary is quite obvious, for it would be wrong to shut out all others from the advantages of a discovery of an improvement for all time in favor of the first discoverer. This would be more objectionable than the doctrine of territorial dominion in right of discovery. It would be a wrong to the community at large. It would, besides, be highly prejudicial and even dangerous to the general interest, to lock up the useful arts that may minister to the necessities and well-being of the great mass of society in a few hands. All laws of this description, therefore, give only a temporary monopoly. They offer a compromise between the inventor and the rest of the community, by which each party surrenders something, and it is proposed that each shall receive an equivalent.

CHAPTER IV.

Legislation on Patent Rights in Great Britain, France, and the United States.

Sec. 1. *British Legislation.*
2. *French Legislation.*
3. *Legislation of the United States.*

Sec. I.—British Legislation.

Patent Rights are a surviving branch of the great system of monopolies which formerly covered almost all the mechanical arts, and many branches of foreign trade, in modern Europe down to the middle of the seventeenth century, remnants of which, in other instances than patent laws, still lurk in several countries, to this day. Before that period, indeed, the whole frame of civil society, from the rights of the sovereign down to those of the day-laborer, was an entire system of exclusive privileges, that is, of monopolies. The sovereign executive administration in a state was the monopoly of one family, while its subdivisions and subordinate offices were parcelled out among other families. The, legislative sovereignty was in like manner monopolized by a single family or shared among several, to them and their

heirs respectively. And so on of the magistracies, commands, jurisdictions, trades, and pursuits of almost every description. The genius of monopoly predominated in every department of legislation, administration, and of industry, excepting agriculture and pastoral pursuits. The legislators were political monopolists, and their legislation, by direct grants, or by the recognition and protection of privileges arrogated by individuals, companies, or classes, in accordance with the principles of their system, converted the rest of the community into monopolists.

Such was the origin of patent rights; but it would be foreign to our present purpose to go into a survey of monopolies in general. The point of time at which we commence is when legislation began the suppression of other monopolies, for then patent rights began to be specific subjects of legislation. The statute of 21 James I. c. 3, (1623,) while it abolished monopolies generally, made an exception of existing letters patents and grants of privilege for the term of "one and twenty years or under, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors, so they be not contrary to the law or mischievous to the state, or generally inconvenient," and also an exception of future grants of letters patent for the term of fourteen years or under; and still further an exception of any grant, privilege, power, or authority theretofore granted, allowed, or confirm-

ed, by act of parliament, then in force, and so long as the same should remain in force. And this provision constitutes the whole legislation on patent rights by the British parliament, except private acts respecting particular patents, down to the year 1835, when the act of 5 and 6 William IV. c. 83, was passed, by which it is provided, among other things, that the patentee may enter a disclaimer of any part of his specification, s. 1. If a verdict or decree shall pass for patentee on the merits in any suit, the judge may grant a certificate, which being given in evidence in any other suit, shall entitle the patentee, on a verdict in his favor in any other suit, to triple costs. s. 3. A penalty of 50£ is incurred by using the mark of a patentee. s. 7. These acts constitute the whole of the British legislation on this subject.

From the time of the passage of the first of the above acts, monopolies have been considered to be subjects of legislative control and regulation. In a case before Lord Hardwicke, in 1742, on an application for an injunction against the use of a stamp on goods, the exclusive right of using which was obtained by the applicant under a charter of Charles I., the Lord Chancellor refused the injunction, saying that the rule the court had governed itself by, was, whether there was any act of parliament on which the restriction was founded, and that the court would never establish a right of this kind, claimed by a charter only of this kind, unless there had been an

action to try the right.[1] That is, in effect, he would presume the grant by the crown; unless authorized by act of parliament, to be void; this presumption might, however, be rebutted by a judgment at law. The exclusive right to use such a mark would stand on the same ground as before the statute of monopolies where there had been no charter or patent for it. In the 22 Elizabeth an action on the case was brought in the Common Pleas, by a clothier, against another of the same trade, for using the same mark on his cloth, and it was resolved that the action would lie. (*Anonymous*, cited in Popham, 144.) Lord Hardwicke, in commenting on this case, in 2 Atkyns, 485, remarked, that it was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away customers from the other clothier. And there is no difference between a tradesman's putting up the same sign, and making use of the same mark, with another of the same trade.

Though the inventor has a just title to some of the advantages of his invention, yet courts have been very cautious of recognising any *property* in an invention, independently of a grant by the government. Even when inventors, not intending to dedicate their discoveries to the public, have communicated their

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[1] Blanchard v. Hill, 2 Atk. 485.

secret to others in confidence, who have betrayed that confidence, and endeavored to take advantage of the invention to the prejudice of the inventors, courts of equity have still refused to interfere to restrain the fraud, but have chosen to leave the complainant to his remedy at law against the breach of contract or the fraud of the wrong-doer.[2]

Sec. II.—French Legislation.

The French legislation on this subject has its date in 1791, during the agitation preliminary to the revolution, a century and a half posterior to the English, and contemporaneously with that of the United States, both having borrowed from the English,[3] each adopting, to a greater or less extent, and expressly enacting, the construction which had been put upon the fifth and sixth sections of the English statute, by the English courts. The legislation of the three countries on this subject, therefore, being parallel and similar, and that of one being the model, the leading principles of the law, with some exceptions that will be pointed out, are common to them all. The administration of these laws in each country may accordingly be considered a branch of the same

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[2] Williams v. Williams, 3 Meriv. 157.
[3] Renouard, c. 3. s. 2. p. 136.

system of jurisprudence, and the doctrines and precedents of each are not merely illustrative of the subject in respect to the others, but in some degree mutual authorities. And the French authors and also the American writers and judges have so treated the subject; and English authors have recently begun to look at the American and French legislation and jurisprudence on this as on other branches of law. Both the English and French statutes, together with our own, will be given at length in the Appendix; it will be sufficient, in this place, to give an abstract of each, with some general observations, as introductory to the examination of the jurisprudence on each branch of the subject, since a general view of the whole ground will facilitate our researches in each division.

The French law of the 7th of January 1791,[4] after stating, in the preamble, that an inventor has an indisputable property in his discovery—that from neglect to recognise and protect this species of property in France, many distinguished French artists had emigrated and carried with them into foreign countries their inventions, of which France ought to have reaped the benefit; and finally that all the principles of justice, of public order and national interest, imperiously called upon the government to fix the attention of the French citizens thereafter upon this

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[4] Renouard, p. 423.

species of property,—proceeds to make the following enactments: 1. Every discovery or new invention, in all kinds of industry, is the property of the inventor; and the law guaranties to him the full and entire enjoyment of it according to the mode and for the time thereinafter provided. 2. An improvement shall be considered an invention within the meaning of the law. 3. The person who may introduce a discovery into France from abroad is to enjoy the privilege of an inventor. 4. Every one who wishes to secure to himself the advantage of this species of property must address to the proper department of the government a statement in writing of the kind of invention for which he asks a patent, and furnish an exact specification of its principles, materials to be used, and processes, accompanied by suitable plans, drafts, designs, and models. 5. As to objects of general utility, but simple in execution, and too easy of imitation to be the subjects of commercial speculation under the privileges of a temporary monopoly, and in all cases where the inventor may so choose, he may apply directly to the government for a reward, instead of taking out a patent. 6. To those who may prefer the honor of conferring the benefit of their inventions upon the nation directly, and shall establish, by the prescribed modes, the utility of their inventions, shall be entitled to a recompense .out of the fund destined to the encouragement of industry. 7. The enjoyment of this species of property is assur-

ed by a title or patent. 8. Patents are given for five, ten, or fifteen years. 9. A patent for an imported invention is not to extend beyond the period for which it may be patented in a foreign country. 10. Patents are to be enrolled in a public office. 11. A catalogue of inventions kept in the public office, and also the specifications, shall be open to be consulted by all the citizens; unless the legislature, on application of the inventor, should decree that the specifications may be kept secret, after an examination of them by commissioners appointed by the governinent, who are to judge and finally determine on their exactness and sufficiency. 12. The patentee may, on giving sufficient security for indemnity, require the seizure of articles made in contravention of his patent, and the party infringing his patent, being convicted, on judgment being given against him, shall, besides the confiscation of the article, pay damages to the patentee according to the importance of the infringement, and also shall forfeit to the benefit of the poor of the district, a sum equal to one fourth part of the damages, not exceeding, however, 3000 livres for the first infringement, and double that sum for a subsequent one. 13. In case the patentee fails in his suit he shall pay costs and damages to the defendant, and also forfeit a fourth part of their amount to the use of the poor, not exceeding 3000 livres. 14. The patentee may use his patent himself, or authorize others to do so, and the patent right shall be considered as personal

property.[5] 15. At the expiration of the privilege the specification shall be published, (unless the legislature otherwise orders,) and the invention become free to all. 16. The specification shall also be published and the invention become free to all others in case of the forfeiture of the patent, which may be incurred, 1st. in case of the patentee's concealing the true method of working; 2d. or having used processes not described in his specification; or, 3d. in case of the invention having been described in a printed and published work; or, 4th. unless the patentee shall, within two years from the granting of the patent, have put his discovery into use; or, 5th. if the patentee, having obtained a patent in France, shall obtain one in a foreign country;[6] and 6th. every assignee of the patent shall be subject to similar obligations and conditions. 17. Existing patents are not annulled, but made subject to this law. 18. The tax on patent rights shall be subsequently determined on.

Such is an outline of the French law on this sub-

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[5] *Propriété mobiliaire*, an expression not precisely equivalent to our expression *personal property*, but in this connexion this English phrase substantially expresses the meaning.

[6] M. Renouard, p. 283, decidedly objects to this provision, and with good reason, since a monopoly of the same thing in other countries would certainly leave the French manufacturers and artists a fairer chance of competition in the markets of third countries, than if the manufacture were free in all foreign countries, and it would in such case be immaterial as to the effect upon the industry of France whether the foreign monopolies were held by the French patentee or any other monopolist.

ject. This law was passed in January; in the months of March, April, and May, following,[7] decrees were passed, designating the officers to whom the granting of patents should be committed, directing the mode of application, the specifications, models, and drawings; that different inventions shall not be joined in the same application, the manner of proceeding when the invention should be ordered by the legislature, to be kept secret; providing for the prolongation of expired patents, for a period not exceeding that for which the legislature is elected; for the payment of the tax, from the proceeds of which, all the expenses attendant on the granting of patents are to be defrayed, and no part of them from the public treasury, that is, if the second instalment of the tax, being due six months after the grant of the patent, shall not be punctually paid, the patent shall be forfeited; the mode of proceeding when the patentee wishes to make some modification of his specification after his patent is granted; that in case of a patent for an improvement on a patented invention, the original inventor shall have no right to use the improvement, nor the inventor of the improvement, any right to use the original invention.[8] A mere change of form or proportions shall not, any more than ornaments, of whatever kind they may be, be ranked as an improvement for which a patent can be claimed.[9] Pa-

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[7] Renouard, p. 414. [8] p. 441.

[9] Law of March 29th, 1791. t. 2. s. 8. Renouard, p. 441.

tents for objects contrary to the laws of the realm, the public safety, or the police regulations, shall be void.[10] The judgment of the court, or of a justice of the peace, on a patent case, shall be executed, notwithstanding an appeal.[11] In case of clashing patents the prior shall prevail.[12] The inventor may form such copartnerships as he may think proper, for putting his invention into operation, but shall not put it into operation by putting it into shares of joint-stock,[13] under penalty of the forfeiture of the patent.[14] Assignments of the whole or a part of the patent right shall be registered. The law also provided a form of patents, of the registry, and prescribed the rate of tax.

In 1798 another project of a law on this subject was presented to the council of Five Hundred, which, however, was not enacted as a law.[15] The subject was at that time much investigated. The commissioners to whom the subject was referred, in February 1798, reported a project of a law, differing materially from that of 1791, an outline of which has been given above. But having considered the subject more maturely, the same commissioners, in August following, reported another project of a law,

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[10] Law of March 29th, 1791. a. 2. s. 3. Renouard, p. 441.
[11] Id. Renouard, p. 441.
[12] Renouard, p. 443.
[13] *Actions.*
[14] Law of March 29, 1791. a. 2. s. 14. Renouard, p. 443.
[15] Renouard, 458.

substantially conformable to that of 1791, and merely supplementary to it. Though this project was not adopted as a law, yet, as it was the fruit of much examination and reflection, the most material suggestions contained in it are worth being noticed, especially as some of them may be adopted as constructions of the French law of 1791, correspond to our act of Congress of 1793. It proposed that the applicant for a patent should add to the specification required by the law of 1791, an explanation of what characterized his invention, and designate what he considered a new part in his invention, or as a new arrangement of parts already known, or as a new application producing a result not before known, and which authorized him to assume the character of an inventor.[16] The project also proposed, that the whole proceeds of the tax on patents should be appropriated to the encouragement of the national industry. It also proposed to alter the law, as to the effect of a prior publication of the invention, by limiting it to a prior publication *in France*, instead of a publication generally, as it stood in the law of 1791, without defining whether a publication in France only, or either in that country or any other, was meant. According to this project, the inventor was not to forfeit his in-

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[16] This is substantially the provision of the act of Congress of 1793. s. 3. Vid. infra p. 39. and Appendix.

vention by not reducing it to use within two years, if he was prevented from so doing by inevitable accident. The other provisions of this proposed law, related to jurisdiction and forms of proceeding, matters that have but little application in the United States.

The result of this attempt at a revision of the law of 1791, is a very strong evidence of the skill and judgment, with which that law was drawn up; for not one of the proposed enactments, unless, perhaps the one concerning the prior description of the invention in some printed work, was very material.

The subsequent legislative provisions are, December, 1798 to order the publication of specifications of expired patents; September 27th, 1800, for inserting in the patent that the government did not guaranty the novelty, merit or utility of the invention; November 25th, 1806, allowing a patent to be put into a joint stock by authorization of the government; and January 25th, 1807, fixing the commencement of the period of the patent at the date of the application for it.

Sec. III.—Legislation of the United States.

The legislation of the United States on this subject, originates in the provision of the Constitution, authorizing Congress "To promote the progress of science and useful arts, by securing for limited times, to authors and inventors the exclusive right of their respective writings and discoveries."[18] A proposition made to empower Congress "to establish public institutions, rewards and immunities, for the promotion of agriculture, commerce and manufactures," was silently abandoned in the convention that framed the Constitution.[19]

The first act of Congress was passed under this clause of the Constitution in 1790, which was superseded and repealed by the act of 1793. Additional acts were passed in 1800, 1819 and 1832. All these acts were repealed by the act of July, 1836, now in force, the substantial provisions of which are as follows. A patent office is attached to

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[18] Const. U. S. a. 1. s. 8. No. 8.

[19] Story's Comm. on Const. v. 3. p. 50; cites Journal of the Convention, 261.

the department of state, the chief officer of which is called the Commissioner of Patents,[20] under whom are four clerks, a competent draftsman, a machinist and a messenger. s. 1. 2. 3. Copies of records, books, papers and drawings under the seal of the office, which is to be in the custody of the commissioner and chief clerk, is evidence in any case to the same effect as the original would be. s. 4.[21] Patents are issued in the name of the United States, under the seal of the office, signed by the secretary of state,[22] and countersigned by the commissioner, and recorded, together with the specifications and drawings, in said office. The patent must contain a short description or title of the invention or discovery, correctly indicating its nature and design, and grant to the applicant, his heirs, executors, administrators or assigns, for a term not exceeding fourteen years, the exclusive right of making, using and vending to others to be used, the invention or discovery, referring to the specification, a copy of which is annexed to the patent. s. 5. Any person or persons[23] having discovered or invented any new and useful art, machine,

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[20] Under act 1793. c. 55. s. 1. superintendence of patents was given to the secretary of state.

[21] Certified copies of patent and specification only made evidence by act of 1793. s. 1.

[22] Formerly signed by the president, stat. 1793. s. 1.

[23] By act of 1793. s. 1. only citizens, by that of 1800. c. 25. s. 1. aliens who had resided in the United States two years. Requisites as to the invention and specification substantially the same as by former acts.

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 invention or discovery thereof, and not at the time of his application for a patent in public use or on sale with his consent or allowance, shall desire to obtain an exclusive property therein, may make application to the commissioner of patents, expressing such desire, and the commissioner may grant a patent therefor. The applicant must deliver a written description of his invention or discovery, and the manner or process of making, constructing, using and compounding it, in such full, clear and exact terms, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound or use the same; and in case of a machine, he must fully explain the principle and the modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions, and particularly point out the part, improvement, or combination, which he claims as his own invention or discovery, and accompany the whole with drawings and written references, where the nature of the case admits of drawings, or with specimens of ingredients or of the composition of matter, sufficient for the purpose of experiment, where the invention or dis-

covery is of a composition of matter, which descriptions and drawings must be signed by the inventor in presence of two witnesses ; and he must furnish a model in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. He must make oath[24] that he verily believes that he is the original first inventor or discoverer of the art, machine, composition or improvement, and that he does not know or believe that it was ever before known or used ; and of what country he is a citizen. s. 6. The commissioner, unless on examination it shall appear that a prior invention of the thing has been made, or that any part had been before invented or patented, or that a description of the invention had been printed in any publication in this or any foreign country, or that the description is defective, shall issue a patent ; but if the claim appears to be subject to any of those objections, he shall give the applicant notice thereof; he may thereupon withdraw his application and receive back two thirds of the fee paid by him previously, relinquishing his model, if he has deposited one ; or, if he persist in his claim, without making such alteration as to obviate the objections, it may be submitted to a board of three examiners appointed by the secretary of state, one of them

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[24] Varied from former acts 1793. s. 3. 1800. s. 1.

skilled in the art or manufacture to which the invention appertains, on the applicant's advancing twenty-five dollars towards their fees, by whose award or that of a majority of them the commissioner is to be governed as to issuing a patent.[25] s. 7. So an application which the commissioner supposes to interfere with another application, or an existing patent, may be referred to the examiners. An applicant is not precluded from taking out a patent by reason of his having taken out one abroad and its having been published within six months preceding his application. The patent may be dated from the time of the filing of the specification and application, if the applicant wishes, not exceeding six months before the issuing, and his specification and application may at his request, in the mean time, be filed secretly in the office, and notice be given him of any interfering applications.[26] s. 8. The applicant, if a citizen, or an alien having resided in the United States for a year preceding his application and made oath of his intention to become a citizen, must, on applying for a patent, pay into the treasury of the United States or one of its banks of deposite, thirty dollars; if a subject of Great Britain, five hundred dollars; if of any other country three

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[25] This provision is new.

[26] New.

hundred dollars. s. 9. In case of the death of the inventor his personal representatives may take out a patent. s. 10. The whole patent, or any share, or the exclusive right for any district,[27] may be assigned by writing to be recorded in the patent office within three months from the time of its execution. s. 11. Any citizen or such resident alien who has made an invention which he desires further time to mature, may file a caveat in the patent office entitling him for one year to notice of any interfering application; but if notice of such application be given him he must specify and file drawings and a model within three months. The specifications and drawings of the subsequent applicant are in such case filed secretly in the office. If on filing the specification the applications appear to the commissioner of patents to interfere with each other, proceedings may be had before a board of examiners as above, but no decision of said board in any case precludes any person from contesting the validity of any patent in any action. s. 12.[28] A patent that is invalid by reason of the specification being defective through inadvertency, mistake or accident, and without any fraudulent or deceptive intention, may be surrendered and a

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[27] New.

[28] Whole section new.

new one taken out in its stead. The patentee may add to his patent any new improvement, by filing a specification of it and having such specification annexed to his patent. s. 13.[29] If the plaintiff recover a verdict in action for an infringement, the court may, at its discretion, increase, not more than treble, it. s. 14.[30] In a suit for an infringement the defendant may plead the general issue and give in evidence any special matter of defence of which notice in writing may have been given to the plaintiff or his attorney thirty days before trial, tending to show that the specification does not contain the whole truth respecting the invention, or that it contains more than is necessary to produce the effect described, which concealment or addition must appear to have been made for the purpose of deceiving the public, or that the patentee was not the original inventor, or that the invention had been described in some public work, anterior to the supposed invention by the patentee; or had been in public use; or that it had been on sale with the consent and allowance of the patentee, before his application for a patent; or that he had unjustly or surreptitiously obtained a patent for the discovery of another person, who was using due diligence in perfecting the same; or that the patentee, if an alien had neglect-

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[29] Last part new.

[30] Formerly trebled of course, act of 1800. c. 25. s. 3.

ed for the space of eighteen months from the time of granting the patent to put and continue the invention on sale upon reasonable terms. The defendant, if he allege a previous public use, must in his notice state the persons by whom and the places where the invention was so used. The fact of the previous use of the invention abroad is not a defence, if it was not known to the patentee and if it had not been described in some printed work, and had not been patented. If the suit fail on the ground of the specification containing too much, and it appear that the defendant had used the part for which the patentee was entitled to a patent, the court has discretion as to awarding costs. s. 15.[31] In case of interfering patents, or an application which interferes with a patent, the question may be tried, and the commissioner is to be governed by the decision of the court as to issuing a patent.[32] s. 16. The circuit court has original jurisdiction of patents at law as well as in equity. s. 17. A patentee or his assigns may apply to the commissioner for an extension of the period of his patent, on paying a fee of forty dollars; and on such application the commissioner must give notice of such application in a Washington paper and such other principal newspapers as he may think proper, published in the part of the coun-

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[31] Four last provisions new.
[32] New.

try most interested against the application. And the secretary of state, the commissioner of the patent office and the solicitor of the treasury are constituted a board to award on the application, on an account of the profits and expenses on the patent having been exhibited to them, and if they award in favor of the application the patent is to be extended for seven years. But no extension is to be granted after the expiration of the term for which the patent was granted. s. 18.[33] A library is to be attached to the patent office, to which an annual appropriation of fifteen hundred dollars is made. s. 19.[34]

A constitutional question has arisen on this subject, viz. whether a State has still the power of granting monopolies, notwithstanding the provision of the Constitution giving limited power of legislation on patents to Congress, and notwithstanding that Congress has used the power thus conferred, by passing laws in pursuance of it. This question was very much agitated in the State of New York in regard to the exclusive privilege of steam navigation granted, in that state, to Livingston and Fulton. The question is one of great importance, and though that case was decided in the Supreme Court of the United

[33] New.

[34] No provision is made for repeal of a patent on scire facias or motion of defendant in an action for an infringement.

States,[25] yet as the decision turned upon a construction of the acts of Congress relating to trade, the general question as to the authority of the States to grant patents and exclusive privileges, still remains without any judicial determination in the court of paramount jurisdiction on the subject.

In the year 1798, an act was passed by the legislature of New York, by which, after reciting that "whereas it had been suggested to the people of this State, represented in senate and assembly, that Robert R. Livingston *was the possessor of a mode of applying the steam-engine, to propel a boat on new and advantageous principles,*" a grant was made to him of "the sole and exclusive right and privilege of constructing, making, using, employing and navigating, all and every species or kinds of boats, or water craft, which might be urged or impelled through the water, by the force of fire or steam, in all creeks, rivers, bays and waters whatsoever, within the territory and jurisdiction of this State," for the term of twenty years from the passing of the act, provided, that he should, within twelve months, construct a boat of at least twenty tons capacity, to be propelled by steam, the mean progress of which, with and against the ordinary current of the Hudson river, taken together, should not be less than four miles an hour. The efforts of Livingston to accom-

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[25] Gibbons v. Ogden, 9 Wheat. 1.

plish this object were ineffectual, and in 1803, another act was passed, by which the privileges granted to him by the act of 1798, were extended to him, and Robert Fulton, whom Livingston had associated with himself in the enterprise, for twenty years from 1803; and in 1808, these privileges were extended for a still further period of time. It appeared that Livingston and Fulton had succeeded in constructing a boat, possessing the properties required by these acts of the legislature; and that Van Ingen and others, without any license from Livingston and Fulton, had also set in motion on the Hudson, a steam-boat, which was employed in navigating and carrying passengers between the cities of New York and Albany. Livingston and Fulton applied to the court of chancery for an injunction to restrain Van Ingen and others, from using their boat in the navigation of the Hudson. The injunction having been refused by that court, the applicants appealed to the Court of Errors. The respondents contended that the acts of the legislature under which the appellants claimed, were contrary to that clause in the constitution of the United States, vesting in Congress the power "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." *Thompson J.* said, that "it was an undeniable rule of construction, applicable to the constitution of the United States, that all pow-

ers and rights of sovereignty, possessed and enjoyed by the several States, as independent governments, before the adoption of the constitution, and which are either not expressly or by necessary implication, delegated to the general government, are retained by the States. This was the object intended to be secured by the 10th article of the amendments of the constitution, which declares, that the powers not delegated to the United States by the constitution, nor prohibited by it, to the States, are reserved to the States respectively, or to the people. If then, the grant of the privileges claimed by the appellants, would, before the adoption of the constitution, have been a legitimate exercise of State sovereignty, it would be a strained construction of that instrument, to say such sovereignty has been thereby surrendered by the State. This power is certainly not denied to the States, nor exclusively granted to the union, by *express terms*; and those powers which are exclusive, by necessary implication, must be such as are created by the constitution, and which did not antecedently form a part of State sovereignty, or the objects of which, from their nature, are beyond the reach and control of the State governments. An express prohibition to the States, against the exercise of powers of that description would have been useless and absurd. Thus Congress have power *to borrow money on the credit of the United States.* This is an exclusive power by necessary implication. It is a power

created by the constitution. A prohibition to the States would have been absurd, because this never was, before the adoption of the constitution, within the scope of State power; no State being able to pledge the credit of the United States for the repayment of the money borrowed."

But it is obvious that the mere grant of a power to Congress does not necessarily vest it exclusively in that body. Congress has power to levy and collect taxes. But this does not preclude the States from the exercise of a like power, except so far as they are expressly restrained, in relation to duties on imports and exports. Thus, we see that there are subjects upon which the United States and the individual States must, of necessity, have concurrent jurisdiction; and all the fears and apprehensions of collision in the exercise of these powers, which have been urged in argument, are unfounded. The constitution has guarded against such an event, by providing that the laws of the United States shall be the supreme law of the land, any thing in the constitution of any State to the contrary notwithstanding. In case of collision, therefore, the State laws must yield to the superior authority of the United States.

"The power given to Congress to promote the progress of science and the useful arts, is restricted to the rights of authors and *inventors*; and their rights are only to be secured for a limited time. Whatever power the States had over the subjects

prior to the adoption of the constitution, and which have not been granted to the general government, and which are not within the scope and purview of its authority, must, beyond all possible doubt, be retained by the States. The appellants do not, in the case before us, claim as *inventors*, but only as *professors*, of a mode of applying the steam-engine to propel boats, on new and advantageous principles. The right therefore, claimed by them, as granted by the laws of this State, was beyond the reach of congressional authority.

But if the appellants are considered as inventors, and entitled to a patent, or as having actually obtained one, it cannot operate as an exclusion of all legislative authority and interference, to aid and protect the rights thus obtained under the general government. If the subject matter be within the scope of State jurisdiction, and the power is exercised in harmony with, and in subordination to, the superior powers of Congress, it is beyond all doubt legitimately exercised. If any person should appear claiming under a patent, in hostility to the privilege granted by this State, that would be a paramount right, and must prevail, if set up in a court having jurisdiction of the question.

Kent C. J. said, that the grant to the appellants by the legislature of the State, was not repugnant to the power vested in Congress in relation to copyrights and patents. That power only secures, for a

limited time, to authors and inventors, the exclusive privilege to their writings and discoveries; and, as it is not granted by exclusive words, to the United States, nor prohibited to the individual States, it is a concurrent power, which may be exercised by the States, in a variety of cases, without any infringement of the congressional power. A State cannot take away from an individual his patent right, and render it common to all the citizens. This would contravene the act of Congress, and would be, therefore, unlawful. But if an author or inventor, instead of resorting to the act of Congress, should apply to the legislature of the State, for an exclusive right to his production, I see nothing to hinder the State from granting it, and the operation of the grant would, of course, be confined to the limits of the State. Within our own jurisdiction, it would be complete and perfect. So a patentee, under the act of Congress, may have the time of his monopoly extended by the legislature of any State beyond the term of fourteen or twenty-eight years allowed by that law. Congress may secure, for a limited time, an exclusive right throughout the Union; but there is nothing in the constitution to take away from the States the power to enlarge the privilege within their respective jurisdiction.

Again, the power granted to Congress goes no further than to secure to the author or inventor, a right of property, which, like every other species of

property, must be used and enjoyed within each State, according to the laws of such State. The power of Congress is only to ascertain and define the right of property; it does not extend to regulating the use of it. That must be exclusively of local cognisance. If the author's book or print contains matter injurious to the public morals or peace, or if the inventor's machine, or other production, will have a pernicious effect upon the public health or safety, no doubt a competent authority, remains with the States to restrain the use of the patent right. That species of property must likewise be subject to taxation, and to the payment of debts, as other personal proerty. The national power will be fully satisfied, if the property created by patent be, for the given time, enjoyed and used exclusively, so far as under the policy of the several States the property shall be deemed fit for toleration and use.

It has been the uniform opinion in England, both before and since the statute of James, that imported improvements, no less than original inventions, ought to be encouraged by patents. And can we for a moment suppose that such a power does not exist in the several States? We have seen that it does not belong to Congress, and if it does not reside in the States, it resides no where, and is wholly extinguished. This would be leaving the States in a condition of a singular and contemptible imbecility. The power is important in itself, and may be most benefi-

cially exercised for the encouragement of the arts; and if well and judiciously exerted, it may meliorate the condition of society, by enriching and adorning the country with useful and elegant improvements. This ground is clear of any constitutional difficulty, and renders the argument in favor of the validity of the statutes perfectly conclusive.

The Court of Errors adjudged the exclusive privilege granted by the legislature of the State to the appellants, to be valid, and ordered that a writ of injunction should issue against the respondents. *Livingston* v. *Van Ingen*, 9 Johns. R. 506.

Thus the question rests, as a subject of judicial decision, to the present time, for though the subject of Livingston and Fulton's monopoly was again brought before the Court of Chancery of New York,[26] also before the Supreme Court of Errors of that State,[27] and finally before the Supreme Court of the United States,[28] yet as the decision eventually turned upon the act of Congress regulating the coasting trade, and not upon the general power of the States to grant monopolies—the point decided being that a law of any State contravening the laws of the United States regulating commerce, was, as far as it was inconsistent with those laws of the United States, unconsti-

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[26] Ogden v. Gibbons, 4 Johns. Ch. R. 150.
[27] S. C. 17 Johns. R. 488.
[28] Gibbons v. Ogden. 9 Wheat. 1.

tutional and void—it remains undecided by the tribunal of last resort how far the several States can grant monopolies, or whether they can grant any, consistently with the constitution and laws of the United States.

CHAPTER V.

Character and Spirit of the Jurisprudence upon Patent Rights.

The jurisprudence on patents has been said to constitute the metaphysics of the law. The difficulty of administering and giving a construction to this branch of law, lies, says Mr. Justice Story, "not so much in the general principles, as in the minute and subtle distinctions which occasionally arise in the application of these principles."[1] For instance, the subject of a patent must be new, and useful, and clearly described, for so the law requires. There is not the least difficulty respecting these general doctrines; but when we come to inquire what is new, that is, whether the thing is so similar to, or

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[1] Barrett v. Hall. 1 Mason R. 472.

diverse from, what has already been done or produced, as to be substantially the same, or different, the questions are often of a subtile metaphysical character. The same remark is applicable to the question whether a thing is useful, and a decision on the other of these questions, relating to the sufficiency of the specification, involves a nice analysis of the invention and the description of it by the patentee. It follows, from this character of the jurisprudence on this branch of law, that the beneficial effect of the law depends quite as much upon the principles and spirit with which it is interpreted and administered, as upon the general provisions of the law itself, since it is to no purpose to provide for a temporary monopoly of a thing on condition that it shall be described with greater clearness and precision than the nature of the case admits of, or than can be attained by the skill of those whom the inventor must employ.[2]

If, therefore, the doctrine laid down by Lord Kenyon is to be adopted, the beneficial effect of the law as a reward to inventors, will be defeated. He says, "I confess I am not one of those who greatly favor patents; for though, in many instances, the

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[2] Mr. Arthur Aikin, Secretary to the Society for Encouragement of Arts, in his testimony before the Committee of the House of Commons on this subject, in 1833, thinks that the cases turn upon points of law, because neither the judges nor jury understand the matter practically; and Mr. Newton says the merits rarely come in question. Mr. Farey, another witness, says, the judges are astute in observing flaws. Westm. Rev. No. 44, p. 247. Foster's Am. Ed.

public are benefited by them, yet on striking the balance upon this subject, I think great oppression is practised on inferior mechanics, by those who are more opulent."[3] This is stepping aside a little from the judicial, and assuming the legislative functions, for the favor to be extended to patents is properly a matter to be determined by the law, not by the discretion of the judge, or his opinion as to the effect of the law on inferior mechanics. The operation of the patent law of England to the prejudice of small mechanics, if it in fact exist, is owing, in part, to the very strictness and illiberality of construction, which Lord Kenyon professes to favor, since it tends to render the validity of patents so precarious, that only men of ample fortune can afford to run the hazard of speculating in this species of property; especially since the practice mentioned by Lord Brougham has prevailed, who states that it not unfrequently happens that those who are interested in quashing a patent make up a stock purse, to defray, at the common charge, the expenses of defending those who infringe the patent, against suits by the patentee, who is liable thus to be ruined by the expense of law suits, even though his patent may be adjudged to be valid.[4] The enormous tax and charges upon patentees in

[3] 8. T. R. 98. See also opinion of Dallas J. in Hill v. Thompson, 2 J. B. Moore, 458.

[4] Speech in the House of Lords, June, 1835.

England, have had the same tendency. These two causes have gone far towards defeating the objects of the exception of inventions from the prohibition put upon monopolies in general, by the statute of James I.[5] Lord Chief Justice Abbot, since Lord Tenterden, admits that the patents have been too illiberally construed.[6] And in more recent cases the principles and spirit of the English jurisprudence on this subject, have been much ameliorated and made more conformable to the motives and policy of the patent laws. In a more recent trial, before Mr. Justice Patteson, reported by Mr. Godson, the instructions to the jury breathe the true spirit of the law.

In the United States the jurisprudence on this branch of law has in general been marked by more broad and liberal views. Its leading principles cannot be l tter expressed than in the language used by Mr. Justice Story, in the case of Ames's paper-making machine. He says, " Patents for inventions are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not to be favored, but on the contrary to be construed with the utmost rigor as *strictissimi juris*. The Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the

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[5] See Evidence taken before the Committee of the House of Commons, 1832, Westminster Review, No. 44, April, 1835, on this subject.

[6] The King v. Wheeler. 2 B. & Ald. 345.

object to be to promote the progress of science and the useful arts, an object as truly national and meritorious, and well founded in public policy, as any that can possibly be the object of national protection. Hence it has always been the course of the American courts (as it has latterly been that of the English courts also) to construe these patents fairly and liberally, and not to subject them to any over-nice and critical refinements. The object is to ascertain what, from the fair scope of the words, is the nature and extent of the invention claimed by the party, and when the nature and extent of the claim is apparent, not to fritter away his rights upon formal and subtle objections of a purely technical character."[7]

The writer in the Westminster Review, already quoted, goes into an argument and cites examples, to prove that the illiberal and captious jurisprudence on this branch of law, is owing to the incompetency of the judges to understand the merits of the cases, and a consequent inclination to put the decision upon legal technical points, with which they were more conversant.[8] He does not proceed to the proposal of any remedy, and accordingly the argument and citations stand as merely a charge of incompetence or want of fidelity on the part of the judges; and of these the reader is left to infer the former; the latter being indeed totally destitute of pretence, for no one

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[7] Ames v. Howard, C. C. U. S. Mass. Oct. 1833.

[8] Westm. Rev. No. 44. April, 1835. p. 251, 252. Foster's Am. Ed.

at all acquainted with the history of English jurisprudence for a long series of years, will for a moment think of drawing in question the general integrity and laborious fidelity of the English judges, for in these respects the judges of no country stand above them. Still on this subject it is admitted that at least very many of them have fallen into a narrow and inadequate system of jurisprudence. The fair inference, however, is not, as the writer seems to insinuate, that jurisconsults by profession are not suitable judges in cases of patents. The same objections would lie against professed jurisconsults as advocates, yet no patentee, having a controversy on the subject of his patent, doubts being able to find an advocate capable of understanding his invention. The judges are not less likely to be able to understand the principles of an invention than an advocate. It would evidently be quite impracticable to procure judges or even jurymen, who have actually worked at or practised all the innumerable trades and professions by which civilized society is diversified, nor would it be desirable were it practicable. It is then quite nugatory to object that judges have not practical experience in any trade to which any particular patent relates. It is enough that they understand the law of patents. Were tradesmen to be appointed judges, any one would understand but one trade, when the cases arising on patents relate to a thousand; and then the still stronger objection would be,

that he would not understand the law of that particular trade. The only remedy for the inconvenience mentioned, if it indeed be one, would be the selecting of special juries. This is the conclusion to which the remarks of the writer just referred to, would tend, though he does not state it specifically. Whether this would be expedient it is not the place here to discuss, the only object at present being to show that no amelioration of the jurisprudence on the subject of patents, could be expected from any different mode of constituting the judicial tribunals.

CHAPTER VI.

What Persons are entitled to Patents, and capable of taking them out.

Sec. 1. *Mere Introducers of an Art or Machine.*
2. *Joint Patentees.*
3. *Sole Patentee.*
4. *Divers independent Inventors of the same thing.*
5. *Assignee by Assignment anterior to the Patent.*
6. *Personal Representatives of the Inventor.*
7. *Aliens.*
8. *Personal Disabilities.*
9. *Minors.*

Sec. I.—Mere Introducer of an Art or Machine.

We are next to inquire what party is entitled to a patent for any particular invention, and what persons

in general are permitted to take out patents. And in the first place the patentee must be the inventor. Mr. Godson remarks, that "the character of an inventor may be obtained by a person in three ways, by bringing with him and publishing to his countrymen the productions of the genius of foreigners; by publishing what others as well as himself have found out at home; or by publishing what he himself has discovered."[1] He does not mean that the publisher of another's invention is entitled to a patent for it, but that among several who simultaneously discover the same thing, the first who applies for a patent, and publishes it, is entitled to the monopoly. Two descriptions of persons then are entitled to patents, namely, the inventors of a thing, and the introducers of what others have invented abroad, but which was before unknown in England. The doctrine of the English jurisprudence as to the right of importers of an art or machine, has, as we have seen, been expressly incorporated into the French law.

The law of the United States differs from that of England and France in this particular, by liniting the right to take out a patent, to the *original inventor;* it does not give the privilege to a person who merely introduces a foreign invention. The statute of 1793 gives the privilege to the *inventor*, and requires that he shall make oath that he verily

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[1] Ch. 2. p. 59.

believes that he is the "*true inventor*," which words have been construed not to be applicable to the importer of another's discovery ; though the expressions do not exclude such a claimant in any stronger terms than the English statute of 2 James I., the fifth section of which excepts from the general prohibition of monopolies, those theretofore granted of the "sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors." And the sixth section, which provides for the future grant of monopolies, is in precisely the same words in this respect. As it had been customary, before the passage of that act, to grant patents to the first introducers of foreign inventions into England, who were accordingly placed upon the same footing as inventors in respect to this privilege, when the statute made an exception of patents for inventions from the general suppression of monopolies, it was very naturally construed to except those inventions introduced from abroad as well as others, and the words of the sixth section, describing the persons entitled to future grants of patents, being the same as those of the fifth section in relation to the then existing patents, the same construction was given to them. This construction has never been given to the American law of 1793. It is an essential qualification for the claimant for a patent in the United States that he should be the *true inventor*.

Sec. II.—Joint Patentees.

A joint patent cannot be sustained upon a sole invention of either of the patentees, for the patent act gives no right to a patent except to the inventor; and requires an oath from the party who claims a patent, that he is the true inventor.[2] Joint inventors must therefore be joined in the patent.

Sec. III.—Sole Patentee.

If the invention is suggested by another, the person to whom the suggestion is made, though he proceed to reduce it to practice, is not the *inventor* within the meaning of the statute. This proposition might, however, be limited to the case of a suggestion of the specific process or machine. A general theoretical suggestion that a steam vessel might be made to navigate the air or water, or that paper could be made in a continued sheet on a cylinder, would not be such a suggestion of the invention as would preclude the person to whom it should be made, from taking out a patent for a particular process or of specific machinery for effecting the result suggested. But if the specific process is pointed out, the person to whom it is so pointed out, cannot after-

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[2] Barrett v. Hall, 1 Mason, 473. Stearns v. Barrett, 1 Mason, 153.

wards be the inventor of such process or machine. In an action by a patentee, for an infringement of a patent for a bleaching liquor, a chemist deposed, that previously to the grant of the patent, he had had frequent conversations with the patentee, on the means of improving bleaching liquor, and that in one of them, he had suggested to the patentee, that he would probably obtain his end by keeping the lime water constantly agitated; and it appeared that this was indispensable in the process. Lord Ellenborough thereupon nonsuited the plaintiff, on the ground that it was not his invention.[3] So in an action for an infringement of a patent for an improved method of making hats, a witness, who was one of the plaintiff's men, stated that he invented the improvement which was the subject of the patent, while employed in the workshop of the plaintiff. The plaintiff was thereupon nonsuited.[4] Mr. Justice Bayley throws out the suggestion that if the witness had been employed by the plaintiff for the express purpose of devising improvements, the construction might have been otherwise.[5] This was supposing an assignment of the invention, for it can make no difference in principle whether the consideration paid for the invention, be a specific price or a salary. This would not, how-

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[3] *Tenant's case*, Dav. Patent Cas. 429.
[4] Per Holroyd J. Barber v. Walduck, cited 1 Car & P. 558.
[5] Bloxam v. Elsee, 1 Car. & P. 558. 1 R. & M. 187.

ever, make the employer the *inventor*, though the real inventor would thereby, lose the property in his invention. And this position is illustrated by another case, in which a head colorman, employed to mix colors for calico printing, had, during his service, kept a book in which were entered the processes for mixing the colors, many of which were of his own invention. Mr. Justice Chambre said, the master has a right to something beside the mere manual labor of the servant in the mixing of the colors; and though the servant invents them, yet they are to be used for his master's benefit, and he cannot carry on his trade without his book.[6] And it was held accordingly that on discharging the colorman, his employer was entitled to retain the book and use the mixtures. This case does not give the right of taking out a patent to the employer, but it proceeds upon the doctrine that the inventor, being employed for the purpose of compounding these mixtures, and having entered them in the book, thereby lost his property in them as an invention. The case can, however, hardly be shaped into a general doctrine, it is a matter of construction of the particular circumstances, whether the inventor, by the nature of his employment, or by his contract, either assigns his invention to his employer, or at least divests himself of

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[6] Makepeace v. Jackson, 4 Taunt. 770.

his own property in it. It is not only, not always the case; but, on the contrary, the inventor would most frequently retain his property; for most persons are employed to practise arts already known, not to invent new ones. We must limit the doctrine strictly to the case put by Mr. Justice Bayley, of the employment of a person for the purpose of superintending and directing the processes, and who uses them without reservation for the benefit of his employer.

Sec. IV.—The Original Inventor.

To entitle a party to a patent he must not only be an inventor, but also the *original* inventor; that is, the first inventor who reduces the invention to practice. Though one exception to this rule is illustrated by the case of Dolland's patent for an improvement in reflecting telescopes, for Doctor Hall had first made the invention and reduced it to practice in his closet, and kept it secret, and yet Dolland's patent for the subsequent invention was held to be valid; for he was the original inventor of the improvement to all practical purposes, as far as the public was concerned.[7] Mr. Justice Washington is said to have held, in an action for an infringement of a patent, that it was no defence that the plaintiff was not the original projector of the improvement if the patent was taken

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[7] Dall. Pat. Cas. 170. 2 H. Bl. 469.

out with the knowledge and assent of the original projector, and not in fraud of his right.[8] So the same judge is reported to have intimated, in another case, that where an invention was joint, and it was agreed by two (verbally) to take out a joint patent, and one, in violation of this agreement, took out the patent in his own name separately, he would be the trustee of the other to the amount of his moiety.[9] It is not easy to reconcile this doctrine with the language of the statute requiring the patentee to make oath that he is the *true* inventor; and it seems to conflict with the doctrine laid down by Mr. Justice Story.[10] Certainly if the terms *original projector* be used in their ordinary sense, and such projector communicates his project to another, this latter cannot be considered the original inventor.

The subject of the originality of the invention and also that of simultaneous inventions by different persons independently of each other, will be considered more particularly in treating of the novelty of inventions. It is sufficient to state generally, here, that where an inventor has applied for a patent, his claim will not be superseded by that of any other unless that other can show a previous invention. It will not be enough for him to show a simultaneous invention.

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[8] Dixon v. Mayor, C. C. of U. S. Penn. April, 1821. Coxe's Dig. 532.
[9] Reutgen v. Kanowrs & Grant, 1 Wash. C. C. R. 168.
[10] Stearns v. Barrett, 1 Mason, 153; Barrett v. Hall, 1 Mason, 447.

Sec. V.—Assignee by Assignment anterior to the Patent.

It was ruled by Mr. Justice Washington, in a case for an infringement of a patent, not to be a good defence to prove that another person was the inventor, if it appeared also in evidence that the patent was taken out by the plaintiff with the consent of that other.[11] A short abstract of the point as above stated, is the only report of this case, from which it does not appear whether the point ruled was one merely of evidence, namely, that the consent of the person in question to the plaintiff's taking out the patent, rebutted the testimony that such other was the inventor; or, that another person might take out a patent in his own name for an invention not exclusively his own, with the consent of the real inventor, which would be equivalent to the patent being taken out by the assignee in case of an assignment before the patent is issued. The latter is the more obvious construction of the report as Mr. Coxe gives the case. And this doctrine is countenanced by an intimation of the same judge in another case.[12] So in another case[13] it is implied that the patent was taken

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[11] Dixon v. Mayor, C. C. U. S. Penn. April, 1821. Coxe's Dig. 531.

[12] Reutgen v. Kanowrs & Grant, 1 Wash. C. C. R. 168.

[13] Gray & Osgood v. James and others, 1 Pet. C. C. R. 481, 482.

out by the assignees. But whatever may have been held or intimated or implied to the contrary on this subject, it seems, from the whole language of the act of Congress of 1793, especially the form of the oath, and from the cases already cited,[14] and also from the common form of the patent itself, that it can be taken out only on the application and oath and in the name of the inventor himself, or the inventors themselves, if more than one, except in the case of the death of an inventor, as hereafter mentioned. The effect of an assignment previously to the grant of the patent, therefore, is that on the patent being issued on the application and oath and in the name of the inventor, and on the recording of the assignment in the office of the secretary of state, the assignee, thereafter, under the fourth section of the act of 1793, stands in the place of the original inventor, both as to right and responsibility.

Sec. VI.—Heirs or Representatives of the Patentee.

By the act of April 17th, 1800, it is provided that in case of the decease of the inventor before taking out a patent, his personal representatives may take it out; the oath being "so varied as to be applicable to them."

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[14] Stearns v. Barrett, 1 Mason, 153; and Barrett v. Hall, 1 Mason, 447.

Sec. VII.—Aliens.

By the act of 1793, the party applying for a patent, in order to be entitled to the grant of one, must not only have been the original sole inventor, but must also have been a citizen of the United States. The expression of the first section of that act is "That when any person, or persons, *being a citizen, or citizens of the United States*, shall allege that he or they have invented," &c. the secretary may grant letters patent. This was a departure from the practice under both the English and French laws on the same subject, by both of which patents are granted to foreigners as well as to English and French subjects. The act of Congress of 1790, which was superseded and repealed by that of 1793, like the English and French laws, made no distinction between citizens and foreigners. After the right of taking out a patent had been confined to citizens exclusively for seven years, the act of Congress of April 17th, 1800, was passed, by which the privilege was extended to *resident* aliens. By that act the privileges granted to citizens by the former "are extended and given to all aliens, who at the time of petitioning, in the manner prescribed by said act, shall have resided for two years within the United States; provided that every person petitioning for a patent for any

invention, art, or discovery, pursuant to this act, shall make oath, or affirmation, before such patent shall be granted, that such invention, art, or discovery, hath not, to the best of his knowledge or belief, been known or used either in this or any other foreign country." This form of the oath differs from that taken by a citizen, but the difference is only in form, for both are "placed substantia ly on the same ground. In either case if the invention was known or used before it was patented, the patent is void. In both cases the right must be tested by the same rule."[15]

Sec. VIII.—Personal Disabilities.

A bankrupt is not disqualified from taking out a patent during the pendency of the proceedings in bankruptcy, though M. Renouard[16] says that by the French law the patent, if taken out before his discharge, the profits of it will enure to his creditors. The law is not so in England; there no acquisition subsequent to the assignment of the bankrupt's effects by the commissioners of bankruptcy, will go to the benefit of his creditors under the assignment. A patent bearing date before the assignment by the commissioners will pass by such assignment. The

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[15] Per M'Lean, J. Shaw v. Cooper, 7 Pet. R. S. C. Rep. 292.
[16] P. 312. c. 8. s. 2.

construction of the State bankrupt laws in the United States, in regard to this question, would probably be similar to that adopted in England, as far as the proceedings are analogous to those under the English law.

M. Renouard[17] says that persons civilly dead, that is, who have abjured, or who, by way of punishment, have been deprived of the rights of civil society, may, notwithstanding such disability, apply for and take out a patent; though they could not pursue any person for infringing it, or otherwise derive any benefit from contracts made respecting the use of it. But the opinion of M. Renouard as to their capacity to take out patents, seems to be subject to some doubt, since he assumes that such persons are by the laws of France incapable of contracting, or asserting rights of property. It should seem to follow that they could not receive valid grants, and if so, they cannot be patentees, since a patentee is a grantee, and a party to a contract. But in forming an opinion on this question, we should bear in mind that the phrase *civilly dead* does not, in all countries and in all cases, import precisely the same disabilities. If the laws of any country be that a person civilly dead cannot take and hold any property, but that all his possessions go to his heirs, by the very fact of his civil disability, and his estate is administered upon as

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[17] P. 311, c. 8. s. 2.

that of a person deceased, his right to a patent would stand upon the same footing; and his representatives would take it out in his stead where the invention was made before his disability was incurred. But if he makes the invention subsequently to his disability being incurred, there does not appear to be any way for him to avail himself of the advantages of it unless the act of Congress authorizing the granting of patents should be construed to supersede the State law by which he should be declared to be civilly dead. These questions remain as subjects of future legislation or judicial decision.

Sec. IX.—Minors.

Nothing prevents a patent being taken out by a minor or married woman; though in the latter case the property in the patent would belong, as a matter of course, to the husband. But in the former case it does not appear but that the fruits of the minor's invention merely, independently of his labor, would be similar to his finding a treasure not claimed by any owner, or to his inheriting property by descent. In the last case, what descends to him is his separate property, and from analogy it is inferred that in the two former cases his rights would be the same.

CHAPTER VII.

Subjects of Patents.

Sec. 1. *Kinds of Subjects Patentable.*
2. *Manufacture.*
3. *Method.*
4. *Process.*
5. *Principle.*
6. *Application of a Principle.*
7. *Effect, Result, Product.*
8. *Art, Scientific Axiom, Theory, Abstract Proposition, Reduction to Practice.*
9. *Materials, Substances, Compositions of Matter.*
10. *Combination.*
11. *Improvement.*
12. *Change of Form, Proportions or Materials. Insufficiency of the Invention. Ornaments.*
13. *Legality.*
14. *Usefulness.*
15. *Vendibility.*
16. *Novelty, Priority.*
17. *Previous Publication.*
18. *Imported Inventions.*
19. *Delay for Experiments. Dedication to the Public.*

Sect. I.—Kinds of Subjects Patentable.

We are now brought to a very difficult branch of the law of patents, the inquiry being as to what *kinds* of new inventions are patentable. Nothing is patent-

able but an *invention;* but not every invention is so. After the adoption of the French patent law, patents were taken out for systems of finance;[1] but these were declared not to be within the class of inventions comprehended under the law. To decide this question, our first resort is to the words of the law; or in the British statute, the *word;* for the kinds of subjects intended by that law, are expressed by the single word *manufacture;* and, as we shall see, the meaning and extent of this word, in reference to the subject in hand, is restricted, in the first place, by express provisions in the law, and then again by construction, and yet a very extensive signification is given to it. The act of Congress of 1793 gives a more full and definite description of patentable subjects; the words are, "any new and useful *art, machine, manufacture, or composition of matter.*" This law is intended to express more fully and precisely, the practical construction which had already been given to the fifth and sixth sections of the British act of monopolies, and is thus at the same time, the law of the United States, and an exposition of that of England. The language of the French law is, perhaps, broader than either that of the English or American law, the expression in that law being, "every invention or discovery in any kind of

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[1] Renouard.

industry;" which, taken in its full extent, comprehends things not embraced by the language of either the English or American law, taken in its widest construction, though the words of these laws, taken in their broadest signification, include subjects which cannot be brought within the French law; or, at least, this is the case with the American law, for the words *art* and *machine*, may be applied to things not included under discoveries or inventions in industry. The truth is, that the practical construction, given to the three laws, in regard to the kinds of invention that are patentable, is substantially the same.

If we take all these expressions in connexion, we shall obtain a pretty accurate, general notion of the kinds of subjects intended by each of these laws, for the subject of the patent must, by the language of the French law, be an invention or discovery in industry; but under the construction given to that law, not *every* invention or discovery in industry is patentable; then the word *manufacture* points out the species of discovery or invention intended to be protected; but lest this word, though by a liberal construction it is applicable to all the proper and all the intended objects of encouragement by the law, should receive too narrow an interpretation, the act of Congress adds what in fact amounts to a liberal construction of the word manufacture, by expressly extending the act to any art, machine, or composition of matter. But it will be evident that we must accept the ex-

pressions *art*, and *composition of matter*, in this case, with large restrictions, since the word *art* is applied to mere skill, and yet it will appear very obviously that any discovery in the mode of managing the hands or limbs, or the instrument used, such as is comprehended under the expressions skill, or address, as in horsemanship, in steering a ship, or playing on a musical instrument, cannot be made the subject of monopoly, and if it could be, that any such monopoly would be most pernicious. We must then resort to *manufacture*, and in the English law, and our own, to limit the construction to be put upon the other expressions used in our law.

In examining more particularly the kinds of subjects covered by the law of patents, it is difficult to distinguish and arrange them into different classes, under the various expressions which have been used to designate them, since these expressions are all of very various, and not very definite signification, and, besides, the subject has been perplexed, by a loose use of these expressions in the opinions of courts in patent cases, and also by the use of the same expression in different senses. The discussions on this subject in the cases, afford a striking illustration of the remark already cited, that we are occupied with a branch of jurisprudence which may aptly be denominated the metaphysics of the law; since, in the subtile and nice distinctions often requisite, and still oftener attempted than requisite,

language fails to supply adequate and precise phraseology, so that we are without the usual help to satisfactory speculation, that is, clear language, intelligible to every one, which proves, in this, as in other cases, a double hindrance, first to clear and discriminating thinking, and second, to the ready and perspicuous communication of thought. As the different expressions used in describing patentable subjects are very analogous to each other in signification, and are mutually blended and implicated together in their meaning, and in the application made of them in the cases, the most convenient mode of treating of them, at least the most concise, will be to enumerate them all, and examine them successively, without confining ourselves rigidly to that order, to do which, much repetition would be requisite, without rendering the subject any clearer.

The expressions by which patentable subjects have been defined and described, then, are, first, those used in the laws already enumerated, viz. invention, discovery, manufacture, art, machine, composition of matter, and others used in the cases, viz. a method, principle, application of a principle, process, effect, result, product, device, combination.

Sec. II.—Manufacture.

The term most discussed in the English reports, as descriptive of the kinds of subjects for which patents may be granted, is the description given in the

statute of 21 James I., and also one of the descriptions in the act of Congress of 1793, namely, *manufacture*. The subject was much discussed in the cases arising on Watt's patent for an improvement in the steam engine. In one of these cases, Lord Chief Justice Eyre thus explains this term. He says that the exposition of the Statute of 21 James I. c. 3, as far as usage will expound it, has gone very much beyond the letter. In 2 Salkeld, 447, the words "*new devices*" are substituted and used as synonymous with the words "*new manufacture*." It was admitted in the argument at the bar, that the word "*manufacture*," in the statute, was of extensive signification, that it applied not only to things made, but to the *practice of making*, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this admission. Under *things made*, we may class, in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects; for a new piece of mechanism is certainly a thing made. Under the *practice of making*, we may class all new artificial manners of operating with the hand, or with instruments in common use, *new processes* in any art, producing effects useful to the public.[2]

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[2] Boulton v. Bull, 2. H. Bl. 481.

In the same case, Mr. Justice Heath gives the following exposition of this term: "What are *new manufactures* within the scope of the proviso of the statute 21 Jac. 1? Such as are reducible to two classes. The first class includes machinery, the second, substances (such as medicines) formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form. In the first class, the machine, and in the second, the substance produced, is the subject of the patent. I approve of the term *manufacture* in the statute, because it precludes all nice refinements; it gives us to understand the reason of the proviso, that it was introduced for the benefit of trade."[3]

Lord Kenyon, in one of the same class of cases, defines the word according to its etymology; considering it to be something made by the hands of man.[4]

In a subsequent case we find the same term thus explained by Lord Chief Justice Abbott: "The word 'manufacture,' in the statute 21 Jac. 1. c. 3, has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine, or instru-

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[3] Boulton v. Bull, 2. H. Bl. 492.
[4] Hornblower v. Boulton, 8. T. R. 99.

ment, or some part of an engine or instrument, to be employed either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam engine for raising water from mines. Or it may *perhaps extend* also to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper, or more expeditious manner, or of a better and more useful kind."[5]

Lord Ellenborough gives the following description of what is a *manufacture* within the statute. "In every invention through the medium of mechanism, there are some materials which are common, and cannot be supposed to be appropriated in the terms of any patent. There are common elementary materials to work with in machinery; but it is the adaptation of those materials to the execution of any particular purpose, that constitutes the invention; and if the application of them be new; if the combination in its nature be essentially new; if it be productive of a new end, and beneficial to the public, it is that species of invention, which, protected by the King's patent, ought to continue to the person the sole right of vending it."[6]

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[5] The King v. Wheeler, 2 B. & Ald. 349.
[6] Huddart v. Grimshaw, Dav. Pat. Cas. 278.

"The true foundation of all patents," says Mr. Justice Buller, "must be the *manufacture* itself; and so says the statute 21 Jac. 1 c. 3. And whether the manufacture be with or without principle, produced by accident or by art, is immaterial. Unless this patent can be supported for the *manufacture*, it cannot be supported at all."[7] So Mr. Justice Story says, "It is of no consequence whether the thing be simple, or complicated; whether it be by accident, or by long, laborious thought, or by an instantaneous flash of mind, that it is first done. The law looks to the fact, and not to the process, by which it is accomplished. It gives the first inventor or discoverer of the thing, the exclusive right, and asks nothing as to the mode or extent of the application of his genius to conceive or execute it."[8]

The expression in the French law on this subject, is not, as we have seen, precisely equivalent to that of the English statute, or rather, the terms are not those of which the word *manufacture* would be a literal translation, and yet the construction put upon their law is very similar. Accordingly, M. Renouard's description of patentable subjects will answer very well as an exposition of the English act of 21 James I. or the act of Congress of 1793, on this subject. He says, "It is not every kind of inven-

[7] Boulton v. Bull, 2 H. Bl. 485.
[8] Earle v. Sawyer, 4 Mason, 6.

tion and discovery that is the subject of a patent right. It is necessary that the invention or discovery should be of a nature to afford products that may be fabricated by the hands of man, or by the labor which he directs, or which may be subjects of commerce by sale and purchase. If, for instance, a philosopher discovers and makes known a property of heat, before unknown, and yet draws from his discovery no special and positive application to specific fabrications, his discovery is merely scientific, and not patentable. But if, on the contrary, he avails himself of the scientific principles, for the production or combination of a new substance, for the formation of an instrument or machine, if he employs it to obtain a result that is new and of a vendible description, whatever it may be, he may take out a valid patent."[9]

Sec. III.—Method.

Having given a definition of the word manufacture by the use of the other expressions, already enumerated, the judges and the writers proceed to analyze those other expressions, and make the necessary distinctions, qualifications, and exceptions. The words *method* and process are often used in these definitions of manufactures, and also in giving titles to patents,

[9] Renouard, c. 5. s. 1. p. 165, 166.

as a *new method* of effecting such or such an object, or a new *process*. Mr. Godson[10] thinks a method or process is not patentable, but the reason of his being of this opinion, is, that he puts a peculiar meaning upon the terms. He says, "When an invention is not of a thing made, it can only be known by being taught by the inventor himself, or by being learnt from *experiments* made on the faith of the description given of it in the specification. With that assistance, however well the method or process may be set forth, some time and experience must necessarily be required, before a person can make use of the invention so beneficially as the discoverer. But the public are not bound to make experiments, and, therefore, it seems reasonable to infer that a mere process or method cannot be the subject of a patent."

"But supposing it possible that a new method of operating with the hand, or a new process to be carried on by known implements or elements, might be so described as to be, by bare inspection, made as beneficial to the public, as to the discoverer; that neither time nor labor, skill nor experience, are required to put it in practice; still it is not a substance or thing made by the hands of man; it is not vendible; which is an inherent, primary quality of a new manufacture."

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[10] Patents, p. 85.

"The advantages of a method or process, in truth, arise from the skill with which it is performed. Suppose, for instance, that one person can with a certain machine, produce a particular article of dress, of a certain quality; and another, with the same machine, by using it in a different manner, can make the same article in half the time, and reduce it to half the price; however new and ingenious this method may be, still it is nothing substantial or corporeal. But suppose that in thus using the machine, some *apparently* inconsiderable alteration is made, that would be sufficient to support a patent; and it is indeed difficult to imagine, that any beneficial effect could be produced without some *material alteration* in the instrument itself; and then why not oblige the inventor to take out a patent for the improvement? It is expressly enacted in the statute of 21 James I. that the new manufacture must not be "hurtful to trade, nor generally inconvenient." To monopolize such methods as above enumerated, appears to be particularly hurtful to trade. In every branch of it there are workmen who use the machines employed in their respective trades more skilfully than their fellows. This superior skill may be in consequence of a particular method of applying their implements. But it would be carrying the doctrine to a great length, to decide that the workmen are entitled to patents for their respective methods of working."

"And further, every master is bound to teach his

apprentice the best way, or means within his knowledge of following his trade. If, therefore, a master obtained a patent for fourteen years, for a particular *method of operating with known instruments*, to produce a known article in less time than usual, or of making it better and more useful, such apprentice would not be allowed to exercise his hands in the most skilful manner he was able, until several years after he had commenced business for himself. Such a patent would, indeed, be "generally inconvenient." There would be a monopoly in every handicraft trade; one person only in each calling would be allowed to work in the most skilful manner."

"For these reasons—that Dr. Hartley's case is the only one in support of the doctrine, and he did not first make iron, nor first discover the effect of iron on fire, so that he was not the inventor of any substance or *instrument*—that a method does not possess the qualities which have been shown to be inherent in the *subjects* of patents, and can be known only by making experiments, and that it is inconvenient to the public, particularly to masters and apprentices; that methods should be monopolized; it might perhaps be fairly inferred, that a method or process is not a new manufacture, within the meaning of the statute of monopolies."

The inference from all this reasoning is, that some methods or processes are not patentable; but it will appear in the sequel very satisfactorily, that others

are so; and it would be very singular, if they were not so, that the very word *method* should be so often used in the title of inventions; and Mr. Godson himself recommends the use of this term;[11] and yet, as we shall see, under the English statute, the title must truly describe the invention, or the patent is void. We can say, then, that a method in general, merely *as such*, is not patentable, or, in other words, that methods are not, universally, and without exception, subjects of patents. And the cases will illustrate what methods are, and what are not patentable.

"This expression, *new manufacture*," says a writer,[12] "may have either of two significations. A stocking was a new manufacture the first time one was knit; but a stocking was again a new manufacture the first time one was made by a loom. In the first case, the thing made was new; in the other, the art of making that thing in a particular way. Accordingly in these two senses, the reader will find the word *manufacture* set down in Johnson's dictionary, and Webster's. This well known, double signification of the word, has, however, often most unaccountably been overlooked. Some judges, in ill accordance with other terms of the act they interpret,[13] have insisted that a new manufacture behoves to be a new salable

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[11] Patents, p. 88.

[12] Westminster Review, No. 44, April, 1835, p. 247, Foster's Am. Ed.

[13] 21 Jac. 1. c. 3.

thing made; and they will not admit a new method to be a new manufacture, except when that method, as in the stocking-loom, happens to be a new piece of mechanism, itself an article of sale; but when the new method constitutes only a new process, then, however valuable that process may be in manufactures, and however difficult and meritorious to discover, they will not regard it as a manufacture, and consequently not as a proper subject for a patent." In illustration of this remark, the writer refers to the case of Watt's patent, which was endangered by the doubt on the part of the judges, whether he had made what could be considered in law, an improvement "in any manner of *manufacture*."

This doubt arose from Mr. Watt's having used the word *method* in the title of his invention, his patent being for a *method* of lessening the consumption of fuel and steam in the use of steam engines, a doubt being entertained by some of the judges whether a *method* was patentable. The use of this word by Mr. Watt, in his title, endangered the validity of his patent, whereas, had he called it an improvement, the doubt could not have arisen, and yet the sense would have been the same. But it will appear very satisfactorily that a method may be the subject of a patent, the doubt in this respect being, as already suggested, not whether a method may be patented, but in what sense this term is applicable to patentable subjects.

In one of the cases on Watt's patent, Mr. Justice

Heath defines in what sense a method is an invention within the statute, where he describes it to be a principle reduced to practice.[14] So Mr. Justice Buller, in the same case, says that a method must be reduced to practice, in order to support a patent. He says, "the mere application or mode of using a thing was admitted not to be a sufficient ground for a patent; for on the court putting the question, whether, if a man by science were to devise the means of making a double use of a thing known before, he could have a patent for that? it was rightly and candidly admitted that he could not. The method and the mode of doing a thing are the same; and I think it impossible to support a patent for a method only, without having carried it into effect and produced some new substance."[15] And Mr. Justice Grose makes the same distinction.[16] And so Mr. Justice Rooke, in one of the same series of cases,[17] speaking of Watt's specification, said, as to those parts of the specification which denoted intention only, and did not state the thing to which it was to be applied, he did not think the patentee could maintain an action for a breach of them. That is, whether the question relates to an invention, a discovery, a manufacture, method, process, or principle, it must

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[14] Boulton v. Bull, 2 H. Bl. 481.
[15] Boulton v. Bull, 2 H. Bl. 486.
[16] Hornblower v. Boulton, 8 T. R. 102.
[17] Boulton v. Bull, 2 H. Bl. 479.

be a thing actually and practically carried into effect. Mr. Justice Eyre very clearly explains the same distinction. In Watt's case a patent was granted for a *new invented method* of lessening the consumption of steam and fuel in steam-engines. *Eyre* J. C. "Shall it now be said, after we have been in the habit of seeing patents granted, in the immense number in which they have been granted for methods of *using old machinery*, to produce substances that were old, but in a more beneficial manner, and also for producing negative qualities by which benefits result to the public, by a narrow construction of the word *manufacture* in the statute, that there can be no patent for *methods* producing this new and salutary effect, connected, and intimately connected, as it is, with the trade and manufactures of the country? This I confess, I am not prepared to say."[16]

The same judge thus further illustrates this subject: He says, "when the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced. To illustrate this. The effect produced by Mr. David Hartley's invention of a 'method for securing buildings from fire,' is no substance or composition of things; it is a mere negative quality, the

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[16] Boulton v. Bull, 2. H. Bl. 495.

absence of fire. This effect is produced by a new method of disposing iron plates in buildings. In the nature of things, the patent could not be for the effect produced. I think it could not be for the making the plates of iron, which, when disposed in a particular manner, produced the effect; for those are things in common use. But the invention consisted in the *method of disposing those plates of iron*, so as to produce their effect, and that effect being a useful and meritorious one, the patent seems to have been very properly granted to him for *his method* of securing buildings from fire. In Mr. Hartley's method, plates of iron are the means which he employs; but he did not invent those means, the invention wholly consisted in the new manner of *using*, or I would rather say, of *disposing a thing in common use*, and which thing every man might make at his pleasure. In the nature of things it must be, that in the carrying into execution any new invention, use must be made of certain means proper for the operation. Manual labor, to a certain degree, must always be employed; the tools of artists frequently; often things manufactured, but not newly invented, such as Hartley's iron plates; all the common utensils used in conducting any process, and so up to the most complicated machinery that the art of man ever devised. Now let the merit of the invention be what it may, it is evident that the patent, in almost all these cases, cannot be granted for the *means* by which it acts, for

in them there is nothing new, and in some of them, nothing capable of appropriation. Even where the most complicated machinery is used, if the machinery itself is not newly invented, but only conducted by the skill of the inventor, so as to produce a new effect, the patent cannot be for the machinery. In the list of patents with which I have been furnished, there are several for new methods of manufacturing articles in common use, where the sole merit and the whole effect produced, are the saving of time and expense, and thereby lowering the price of the article, and introducing it into more general use. Now I think these *methods* may be said to be *new manufactures*, in one of the common acceptations of the word, as we speak of the manufactory of glass, or any other thing of that kind. The patent cannot be for the effect produced, for it is either no substance at all, or, what is exactly the same thing as to the question upon a patent, no new substance, but an old one produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed. It must then *be for the method;* and I would say, in the very significant words of Lord Mansfield,[19] "it must be *for method detached from all physical existence whatever.*"[20]

The same judge proceeds to point out a distinc-

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[19] 4 Burr. 2397.

[20] [redacted] H. Bl. 493

tion, which is of great importance, and which serves as a clew to clear up some of the obscurity that hangs over the cases on this subject. He says, "When the object produced is some new substance or composition of things, it should seem that the privilege of the sole working, or making, ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. Upon this ground Dolland's patent was, perhaps, exceptionable, for that was for a *method* of producing a new object-glass, instead of being for the object-glass produced. If Dr. James's patent had been for his *method of preparing* his powders, instead of the *powders themselves*, that patent would have been exceptionable upon the same ground."[21] There certainly is a plain distinction between an invention of a new composition, as a medicine, and a new process, art, or method, since in the former case, there may be nothing new in the process or mode of proceeding in compounding or manufacturing the substance, in the latter the mode of proceeding to construct the machine or instrument to which the patent relates, may be the only thing invented. Hence, in discussing this subject, judges and writers sometimes

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[21] 3 H. Bl. 402.

having in view one class of these causes, say, that the substance only is the subject of the patent; at other times, having in view the other class of cases, they say that a method may be patentable. Now according to the explanation of Lord Chief Justice Eyre, both these propositions are true to a certain extent, but neither is true to the extent laid down in some of the cases, that is, we cannot say that substances alone are patentable, nor that methods only are so. Accordingly Mr. Grose, in one of the Watt and Boulton cases, says it signified nothing to the inventor or the public, whether the patent be for the engine made or the method of making it. Indeed, to the purposes of a title to a patent or a specification, judges have considered the words method and engine to be synonymous. "Engine and method mean the same thing," says Mr. Justice Lawrence, "and may be the subject of a patent. Method, properly speaking, is only placing several things and performing several operations, in the most convenient order; but it may signify a contrivance or device, so may an engine; and therefore I think it may answer the word *method*."[93] And Abbott C. J. says on the same subject, "When a person applies to the crown for a patent for a new engine or instrument, he may represent himself to

[93] Hornblower v. Boulton, 8 T. R. 103.

be the inventor of a new method of accomplishing that object, which is to be accomplished by his engine or instrument."[23] That a method or mode of operating may be the subject of a patent, is plain from this, that when the object of two patents or effect to be produced is substantially the same, they may both be valid, if the modes of attaining the desired effect are essentially different.[24] Therefore where judges or writers lay down the general doctrine that a method cannot be the subject of a patent, as Mr. Justice Heath does in the above case of Boulton v. Bull,[25] the proposition is true in such a restricted sense as on the whole to render it erroneous.

Sec. IV.—Process.

The word process has been suggested instead of method, as descriptive of the subject of a patent, and what has been said of *method* is, in many cases, applicable to *process*, the difference between the two terms, as applied to this subject, being, that method is of a wider signification. Thus Abbott C. J. says, "The word *manufactures*, in the statute Jac. 1. c. 3, *may, perhaps*, extend to a *new process*, to be carried

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[23] King v. Wheeler, 2 B. & Ald. 350.
[24] Huddart v. Grimshaw. Dav. Pat. Cas. 290.
[25] 2 H. Bl. 483.

on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance; but producing it in a cheaper or more expeditious manner, or of a better and more useful kind."[26]

It is true the Chief Justice speaks with great caution, because he was using a mere illustration, in doing which, he did not choose thus collaterally to express a positive doctrine, upon a question which might be a subject of much subtile discussion, but he distinctly implies his own opinion. He seems, however, to have been over-cautious, for if a method may be patentable, of which it is apprehended there can be no doubt, then, of consequence, a *process*, which in this application of the term is, in many respects, synonymous with method, may be so also; *may* be so, for in respect to this latter, we must speak with the same qualifications, and subject to the same exceptions, as when we use the term *method*, as descriptive of the subjects of patents.

Sec. V.—Principle.

The question whether a *principle* is a subject of monopoly under the patent laws, was much discussed in the cases relating to Watt's specification of his

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[26] King v. Wheeler, 2. B. & Ald. 349.

improvement in the steam-engine. In that specification, the patentee stated that his invention "consisted in the following *principles*," and then proceeded to describe particularly the construction of the engine according to his improvement. This gave occasion to numerous, elaborate, and subtile discussions on the patentable character of a *principle*. Had Watt described his invention as consisting of the "following particulars," all this disquisition would have been lost, and yet this would have been substantially equivalent to the phraseology he did use, for after stating that his invention consisted of *principles*, he proceeded to define and explain what he meant by that expression, and it was not objected that his description was at all defective. The real question then was, whether Mr. Watt had used the word *principle* in a wrong sense, and, if so, whether his patent was defeated for this philological inaccuracy, which to all practical purposes was not of the slightest importance, since any person could understand the construction of his machine, and any mechanic could construct another after his description, as well as if he had committed no such inaccuracy. And the strife was a very doubtful one, and the patent would have been lost, had not the judges, on the final decision of the cause, been very strongly disposed to maintain it on account of the great merit and utility of the invention. We will proceed to a review of those discussions, which are useful in throwing

light on the question, what are patentable subjects, though the case which gave rise to this term does not, in this respect, seem to have been one of any well-grounded doubt.

"It is a clear position of law," says Mr. Justice Heath, "that the organization of a machine may be the subject of a patent, *but principles cannot.* Indeed it seems impossible to specify a principle, and its application to all cases, which furnishes an argument, that it cannot be the subject of a patent."[27] "The very statement of what a principle is," says Mr. Justice Buller, "proves it not to be a ground for a patent. It is the first ground and rule for arts and sciences, or in other words, the elements and rudiments of them. A patent must be for some new production from those elements, and not for the elements themselves. If the principle alone be the foundation of this patent, it cannot possibly stand, with that knowledge and discovery which the world were in possession of before. The effect, the power, and the operation of steam, were known long before the date of this patent; all machines which are worked by steam, are worked on the same principle. The principle was known before, and therefore if the principle alone be the foundation of the patent, though the addition may be a great improvement, yet

[27] Boulton v. Bull, 2 H. Bl. 482, 483.

the patent must by void *ab initio*."[28] "Undoubtedly," said Eyre C. J. "there can be no patent for a mere principle."[29] Lord Keyon said, "the principal objection made to this patent, is that it is a patent for a philosophical principle only, neither organized nor capable of being organized." If the objection were well founded in fact, it would be decisive; but I do not think that it is so.[30] "I am inclined," said Mr. Justice Grose, "to think that a patent cannot be granted for a mere principle."[31] Mr. Justice Lawrence said, "if it were necessary to consider whether or not mere abstract principles are the subject of a patent, I should feel great difficulty in deciding that they are."[32]

Such are the opinions of the judges on the patentable character of *principles*. But what meaning did they attach to the word? Mr. Justice Lawrence says, "a principle may mean a mere elementary truth, but it may also mean constituent parts."[33] Mr. Justice Rooke thus explains the word. "The term *principle* is equivocal; it may denote either the radical elementary truths of a science, or those consequential axioms which are founded on radical truths; but which are used as fundamental truths by those who do not find it expedient to have recourse to first principles. The radical principles on which all

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[28] Boulton v. Bull, 2 H. Bl. 485.
[29] S. C. Ibid. 495.
[30] Hornblower v. Boulton, 8 T. R. 98.
[31] S. C. Ibid. 104.
[32] S. C. Ibid. 105.
[33] S. C. Ibid. 107.

steam-engines are founded, are the natural properties of steam, its expansiveness and condensibility. Whether the machines are formed in one shape or another, whether the cylinder is kept hot or suffered to cool, whether the steam is condensed in one vessel or another, still the radical principles are the same."[34]

The signification in which a *principle* is not a subject of a patent is distinctly pointed out by Abbott C. J. He says, "No merely philosophical or abstract principle can answer to the word *manufactures*. Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word."[35]

Mr. Justice Story remarks, upon the use of this term as descriptive of the subjects of patents, that "In the minds of some men, a *principle* means an elementary truth or power; so that in the view of such men, all machines, which perform their appropriate functions by motion, in whatever way produced, are alike in principle, since motion is the element employed. No one, however, in the least acquainted with law, would for a moment contend, that a principle in this sense, is the subject of a patent;

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[34] Boulton v. Bull, 2 H. Bl. 478.
[35] King v. Wheeler, 2 B. & Ald. 350.

and if it were otherwise, it would put an end to all patents for all machines which employed motion, for this has been known as a principle, or elementary power, from the beginning of time. The true legal meaning of the principle of a machine with reference to the patent act, is the peculiar structure or constituent parts of such machine. And in this view the question may be very properly asked, in cases of doubt or complexity, of skilful persons, whether the principles of two machines be the same or different? Now the principles of two machines may be the same, although the form or proportions may be different. They may substantially employ the same power in the same way, though the external mechanism be apparently different. On the other hand, the principles of two machines may be very different, although their external structure may have great similarity in many respects. It would be exceedingly difficult to contend, that a machine, which raised water by a lever, was the same in principle with a machine, which raised it by a screw, a pulley, or a wedge, whatever in other respects might be the similarity of the apparatus."[36] "By the principles of a machine," says the same judge, in another case, "is meant the *modus operandi*, the peculiar device or manner of producing any given effect. If the same effects are produced by two machines by the same

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[36] Barrett v. Hall, 1 Mason, 470.

mode of operation, the principles of each are the same. If the same effects are produced, but by combinations of machinery operating substantially in a different manner, the principles are different."[37]

Sec. VI.—Application of a Principle.

Another word often used in connexion with principle, and with other words, in defining the subjects of patent rights, is *application*. The two questions in this case are, first, whether, though a principle in any sense may not be patentable, the *application* of

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[37] Whittemore v. Cutter, 1 Gallison, 478. The writer in the Westminster Review, No. 44, April, 1835, says, on this subject, "There is another word, which, in patent causes, is used as a rival word to *manufacture*, but still more ambiguous in its meaning, and which, recommended by such ambiguity, is in very frequent requisition. The word is *principle*. To make this law-fantom, the witchcraft used by the lawyers consists in mingling three different meanings together, used by the aid of certain professional solemnities, producing a mystical word, capable of harlequinizing an idea into many various forms." The writer should have said, the *word* is *harlequinized*, not any idea; and his own expression seems to be quite as mystical as any thing to he found in the arguments of the lawyers, or the opinions of the judges, whom he probably intends to include in the class of lawyers. The mystery is nothing more or less than the common fallacy in reasoning, of accepting and applying an ambiguous proposition that is true in one sense, and false in another sense, in the erroneous sense. This may be done in respect to *manufacture, method, process, or principle*, since each of them is, in some senses, patentable, in others, not so; and, therefore, whether we say that each of them is or is not patentable, the proposition will be true or false, according to the sense in which the words are used and applied.

that principle may be so? and second, whether a manufacture, method, or principle in certain senses, being patentable in their character, any new application of such manufacture, method, process or principle, is the substantive subject of a valid patent? In answering the general question, whether a new application of either of these is a proper subject of a patent, we have not only to distinguish whether the thing to be applied may, or cannot be, itself the subject of a patent, but we have the additional uncertainty of meaning and ambiguity in the use of the word *application*. If by *application* be meant the *mode of operating*, or the mechanical combinations, means, or instruments, by which a principle or theory is carried into operation, in this sense, the new application of a theory or principle, may be the subject of a patent. The whole circle of inventions for which patents have been granted, consists of new applications (in this sense of the term) of the mechanical powers and chemical properties of matter. But if by new *application* be meant only the new *use* of a thing, requiring no new apparatus or instrument, and involving no invention whatever, such for instance as using a nail machine for making copper nails, which had been patented, or had before been used only for making iron nails, in this sense a new application cannot be patented. The proposition may then be laid down that a new application of a theory or principle, or of an art, process, or machine,

is itself patentable in its character, may be the subject of a patent where such application is an invention—where it is effected by new means, instruments, or machinery, or new improvements of those already in use.

Thus Mr. Justice Johnson says, "the legal title to a patent consists not in a principle merely, but in an application of a principle, whether previously in existence or not, to some new and useful purpose."[38] He intends the case of an application effected by new apparatus, machinery, or instruments, or processes; such an application as requires invention. In this sense, Mr. Justice Buller says, the new application of the effect of water in changing colors, may be the subject of a new patent, when applied in a new manner, and by new processes, to a species of manufacture to which it had not been before applied. He illustrates this in the case of the invention of water-tabbies, which "owed its rise to the accident of a man's spitting on a floor cloth, which changed its color; from which he reasoned on the effect of intermixing water with oils or colors, and found out how to make water-tabbies, and had his patent for water-tabbies only. But if he could have had a patent for the principle of intermixing water with oil, or colors, no man could have had a patent for any distinct manufacture, produced on the same principle. Suppose painted floor cloths

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[38] Whitney v. Carter, Fessenden's Pat. 130.

to be produced on the same principle, yet as the floor cloth and the tabby are distinct substances, calculated for distinct purposes, and were unknown to the world before, a patent for one would be no objection to a patent for another."[39]

So where the shearing of cloth from list to list by means of shears, was known, and the shearing it from end to end by rotary cutters was also known, it was held that a machine constructed so as to shear from list to list by means of rotary cutters, was such an invention as would entitle its author to a valid patent.[40] This was not a mere use of the rotary cutter for another purpose, but some contrivance and machinery must have been necessary in order to move the cloth under the cutter transversely, other than that necessary to move it lengthwise, and it was this contrivance or machinery, which was the foundation of the patent.

A known mode of operating or process of manufacture, merely applied to new objects, has never been held to be patentable. Thus the Court of King's Bench held that a new application to the manufacture of one kind of anchors, of a mode of manufacture before practised in some other kinds, could not be a subject of a valid patent.[41] They assumed

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[39] 2 H. Bl. 488.

[40] Lewis v. Davis, 3 Car. & P. 502.

[41] Brunton v. Hawkes, 4 B. & Ald. 540.

no doubt that this mode of manufacturing an anchor was entirely obvious to any workman who had been conversant with the use of the same mode, in other instances, and, that no material change or contrivance, invention or discovery, was necessary in order to manufacture an anchor in this way—that is, it was substantially the same process. Mr. Justice Heath suggests that it is doubtful whether a new application of a machine is patentable. And he might for the same reason extend the query to the case of a new application of a method or process. He says, "If there may be two different species of patents, the one for an application of a principle to an old machine, and the other for a specific machine, one must be good and the other bad. The patent that admits the most lax interpretation should be bad, and the other alone conformable to the rules and principles of common law, and to the statute on which patents are founded."[42] He implies that a patent for the application of a new principle to an old machine is not a good subject of a patent. But whether it will be so or not, will depend on the considerations which have been stated already. There certainly is no such dilemma as Mr. Justice Heath seems to suppose; for if it be admitted that a machine may be patented, it does not follow

[42] Boulton v. Bull, 2. H. Bl. 481.

that a patent for the application of a principle is therefore void. On the contrary, we have seen that such a patent may be valid.

The true distinction on this subject is clearly pointed out by Mr. Justice Story, who says, "To entitle a party to a patent for a whole machine, it must in substance be a new machine; that is, it must be a new mode, method, or application of mechanism, to produce some new effect, or to produce an old effect in a new way."[43] But a mere naked application of what is known to a new purpose, without any new apparatus, means, or instruments, is not patentable. Mr. Justice Buller says, "Suppose the world were better informed than it is, how to prepare Doctor James's fever powder, and an ingenious physician should find out that it was a specific cure for a consumption, if given in particular quantities, could he have a patent for Doctor James's powder in consumptions, or to be given in particular quantities? I think it must be conceded that such a patent would be void; and yet the use of the medicine would be new, and the effect of it as materially different from what is now known, as life is from death."[44] So the same judge instanced in the same case the new use of arsenic for the cure of agues, in illustration of the doctrine that a mere new applica-

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[43] Woodcock v. Parker, 1 Gallison, 438.
[44] Boulton v. Bull, 2 H. Bl. 487.

tion of a known thing was not a foundation of a patent.[45]

The original inventor of an application of a power or principle, though he may at the same time discover the power or principle, cannot take out a patent for its general application. He is limited to what he has effected. Thus Mr. Justice Heath says, in the cases of Watt and Boulton, on the improvement in the steam-engine, that a patent could not be claimed for the power of steam; it can be claimed only for a particular application of that power, effected by new modes and by new means or processes. "The Marquis of Worcester discovered the expansive force of steam, and first applied it to machinery. As the original inventor, he was clearly entitled to a patent. Would the patent have been good, applied to all machinery, or to the machines which he had discovered? The patent decides the question. It must be for the vendible matter, and not for the principle. Another objection may be urged against the patent, upon the application of the principle to an old machine, which is, that whatever machinery may be hereafter invented would be an infringement of the patent, if it be founded on the same principle. If this were so, it would reverse the clearest position of law respecting patents for

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[45] A new application of machinery already known, is said, by M. Renouard, (p. 175. 459.) to be a patentable subject in France.

machinery, by which it has been always holden, that the organization of a inachine may be the subject of a patent, but principles cannot. If the argument for the patentee were correct, it would follow, that where a patent was obtained for the principle, the organization would be of no consequence. Therefore, the patent for the application of the principle must be as bad as the patent for the principle itself."[46]

Mr. Justice Washington instructed the jury that the use and application of bells to fire engines to give alarm of fire, so as to be rung by the motion of the carriage, was the subject of a patent. He also considered the application of steam-engines to the purposes of propelling boats to be the subject of a patent.[47]

Sec. VII.—Effect. Result. Product.

There is a very close analogy between a new application and a new effect or result of what is already known, as in the instances given by Mr. Justice Buller, of the use of James's fever powder for the cure of a consumption;[48] this might be called either a new *application* or a new *effect* of the invention. The

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[46] Boulton v. Bull, 2 H. Bl. 482.
[47] Park v. Little and Wood, 3 Wash. C. C. R. 196.
[48] 2 H. Bl. 487.

same remarks that have been made concerning a new application, in this sense of the term, are equally true of a new effect. There is no instance in which it has been held that a mere new effect of the use of a machine already known, without any new combination, machinery, or process, is the subject of a valid patent. The doctrine is laid down by Mr. Justice Story, that "a patent can, in no case, be for an *effect only*, but for an effect produced in a given manner, or by a peculiar operation. For instance, no patent can be obtained for the admeasurement of time, or the expansive operations of steam; but only for a new mode, or new application of machinery, to produce these effects; and therefore, if new effects are produced by an old machine in its unaltered state, I apprehend that no patent can be legally supported; for it is a patent for an effect only."[49] In this case as in that of a new application, there must be something new in the method, process, combination, or composition, in order to lay the foundation of a patent.

Sec. VIII.—Art, Scientific Axiom, Theory, Abstract Proposition. Reduction of the Invention to Practice.

The act of Congress, in describing the subjects of patents, uses the term *art*, which, if taken in its

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[49] Whittemore v. Cutter, 1 Gallison, 478.

broadest sense, is, like all the others we have been considering, much too comprehensive, but it serves very well to show what is not a proper subject of monopoly, in contrast with *science*. A science is not the subject of a patent, and for the same reason, a mere theory, scientific axiom, or principle, or abstract proposition, or truth is not so.[50] All the abstract philosophical truths that have been discovered, are free from the patent laws, as are the general powers and qualities of matter. The claim of the inventor arises only on the practical application of a theory, or abstract truth, or elementary property, in some art, process, or method, which he has invented and put in practice, or some machine or apparatus, or composition of matter, which he has actually made.

A merely intended invention, or improvement, is not patentable. Mr. Watt, in his specification, suggested his intention to add certain improvements to his steam-engine. Mr. Justice Rooke said "That as to the articles of the specification which denote intention only, I do not think that the patentee can maintain an action for the breach of them; for he cannot anticipate the protection, before he is entitled to it by practical accomplishment."[51]

The subject of a patent must be something that has been reduced to practice; it is not enough that it is merely practicable or possible; it must be

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[50] Lowell v. Lewis, 1 Mason's R. 187 [51] 2 H. Bl. 479.

something which has been actually done or produced. Mr. Justice Buller remarks, of the cases cited in that of Boulton v. Bull,[52] "that none of them go the length of proving that the method of doing a thing without the thing being done or actually reduced to practice, is a good foundation for a patent. When the thing is done or produced, then it becomes the subject of a patent." "The thing to be patented," says Mr. Justice Story, "is not a mere elementary principle, or intellectual discovery, but a principle put in practice, and applied to some art, machine, manufacture, or composition of matter."[53] This is the doctrine of all the cases. It is laid down by Mr. Justice Buller, in the cases on Watt's improvement of the steam-engine, "that though an idea or a principle alone would not support a patent, yet that an idea reduced into practice, or a practical application of a principle, is a good foundation for a patent. What is meant by a principle reduced into practice? It can only mean a practice founded on principle, and that practice is the thing done or made, or in other words, the manufacture which is invented." So Mr. Justice Eyre says, in the same case, "For a principle so far embodied and connected with corporeal substances, *as to be in a condition to act, and to produce effects* in any art, trade, mystery,

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[52] 2 H. Bl. 487.
[53] Earl v. Sawyer, 4 Mason 1.

or manual occupation, I think there may be a patent. Now this is the thing for which the patent stated in this case was granted, and this is what the specification describes, though it miscalls it a principle. It is not that the patentee has conceived an abstract notion, that the consumption of steam in fire-engines may be lessened, but he has discovered a *practical manner* of doing it; and for that practical manner of doing it, he has taken his patent. Surely this is a very different thing from taking a patent for a principle; it is not for a principle, but *for a process.*"[54]

In a more recent case in England, on an invention of carriage-wheels, by which the load was made to bear upon the top of the circumference of the wheel, instead of the centre, Mr. Justice Paterson said that the patentee was entitled to a patent for the suspension *principle* carried into effect in the particular *way* described by the patentee."[55]

The patent being for an invention that is described in it, it is not only requisite that the invention should be reduced to practice, but it must be reduced to practice in the way, and produce the effect specified.[56] In an action brought for an infringement of a patent for "a hammer on an improved construction for the locks of all kinds of fowling-pieces and

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[54] Boulton v. Bull, 2 H. Bl. 486, 495.

[55] Jones v. Penrce, Gods. Sup. 16.

[56] Bloxam v. Elsee, 6 Barn. & Cress. 169. See also Turner v. Winter, 1 T. R. 602, 606, 607.

small arms," the improvement was stated in the specification to consist in letting out the air from the barrel, and causing a communication between the powder in the pan and the powder in the barrel, without, at the same time letting out the powder, by means of an air-hole in the lock. It appeared by experiments made in court, that the powder would pass through the hole in the patented lock by its own gravity, without the least difficulty. The Lord Chief Baron. "It seems to me, that the utility of this invention, and the purpose of this patent, wholly fail; for the purpose of the hole, as described in the specification, is to let the air pass through, and at the same time secure the powder from passing through; that of itself would be an answer to this action."[57]

The law is the same in this respect, in France, as in England and the United States. M. Renouard[58] says that a mere experiment, without a successful result, is not sufficient ground of a patent; to entitle a party to which, he must succeed in producing a result or effect.

Sec. IX.—Materials, Substances, Compositions of Matter.

The use of the ordinary known materials cannot

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[57] Manton v. Parker, Dav. Patent Cas. 327.

[58] p. 282.

be monopolized by patent.[59] We must understand this doctrine to be limited to known materials, and to such as naturally exist, whether known or not, for the discovery of a new elementary substance or material, by analysis or otherwise, does not give a right of a monopoly of it.

Our statute provides for granting a patent right of a new composition of matter. This expression has reference to medicines, and compositions used in the arts. The same subjects are covered under the English statutes under the general term *manufactures*. In these instances the composition itself is usually considered to be the subject of the patent, and not the mode or process of compounding,[60] but both the composition and the mode of compounding may be considered to be included in the invention, where the compound is new, since in that case the mode or process of compounding must also be so, though it may consist merely in observing the proportions assumed by the inventor, which being given, the composition may be made in many instances by any person without previous instruction or practice. And in this case it will be immaterial whether the inventor has the monopoly of the compounding or the composition, since the monopoly of either, will, in effect, include both. The expressions, *composition*

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[59] Per. Buller J. Boulton v. Bull, 2 H. Bl. 487.
[60] 2 H. Bl. 483. 487.

of matter, usually applied to mixtures and chemical compositions. It is no objection to a patent for a composition, that all the ingredients were known and in use; it is enough that the compound is new. And this composition may be merely the imitation of some natural composition or mixture; for a new method, by invented processes and apparatus, of producing a composition of matter, which is sometimes, or in some places, to be met with as a natural production, is as much the subject of a patent, as a new machine to produce a known and old effect.

Sec. X.—Combination.

A combination, as the subject of a patent, is analogous to a composition of matter, the former expression being usually applied to mechanical inventions as the latter is to chemical. It is sufficient also, in this case, that the combination is new, though the separate things combined may have been before in use and well known.[61] Where a patent is for a *new combination* of existing machinery or machines, and does not claim or specify any improvement or invention, except the *combination*, proof that the machines or any part of their structure existed before, forms no objection to the patent, unless the *combination* has

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[61] Bovill v. Moore, Dav. Pat. Cas. 361.

existed before, for the reason that the inventor is limited to the combination.[62]

Sec. XI.—Improvement.

The act of Congress of 1793 expressly recognises the right to a patent for an improvement on a machine, by the provision in the second section, "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 obtain a patent for such improvement, 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." The French law has a similar provision, and both merely adopt the construction which had before been put upon the statute of monopolies by the English courts. Lord Coke mentions an early case against this construction. He says, "If the substance was *in esse* before, and a new addition thereunto, though that addition make the former more profitable, yet it is not a new manufacture in law; and so was it resolved in the Exchequer Chamber, Pasch. 15 Eliz. in Bircot's case, for a privilege concerning the preparing

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[62] Per Story J., Moody v. Fiske, 2 Mason, 112; and see also opinion of Abbott C. J., Brunton v. Hawkes, 4 B. & Ald. 541, and of Lord Eldon, Hill v. Thompson, 3 Meriv. 630.

and melting, &c. of lead ore ; for there it was said, that that was to put but a new button to an old coat; and it is much easier to add than to invent. And there it was also resolved, that if the new manufacture be substantially invented according to law, yet no old manufacture in use before can be prohibited."[63] But the doctrine of Bircot's case was early abandoned. Mr. Justice Buller says that, "In Morris v. Branson, tried at the sittings after Easter term, 1776, the patent was for making eyelet-holes or net-work in silk, thread, cotton or worsted; and the defendant objected that it was not a new invention, it being only an addition to the stocking-frame. Lord Mansfield said, "after one of the former trials on this patent, I received a very sensible letter from one of the gentlemen who was upon the jury, on the subject whether on principles of public policy there could be a patent for an addition only. I paid great attention to it, and mentioned it to all the judges. If the general point in law, viz. that there can be no patent for an addition, be with the defendant, that is open upon the record, and he may move in arrest of judgment. But that objection would go to repeal almost every patent that was ever granted." There was a verdict for the plaintiff, with 500*l*. damages, and no motion was made in arrest of judgment. Though his Lordship did not mention what were the opinions of

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[63] 3 Inst. 184.

the judges, or give any direct opinion himself, yet we may safely collect that he thought on great consideration, the patent was good, and the defendant's counsel, though they had made the objection at the trial, did not afterwards persist in it.[64]

Mr. Justice Grose makes a similar remark upon the same case. He says, "A doubt is entertained whether there can be a patent for an addition to an old manufacture. This doubt rests altogether upon Bircot's case, 3 Inst. 184; and if that were to be considered as law at this day, it would set aside many patents for very ingenious inventions, in cases where the additions to manufactures before existing, are much more valuable than the original manufactures themselves. If indeed a patent could not be granted for an addition, it would be depriving the public of one of the best benefits of the statute of James. Lord Coke's opinion seems to have been formed without due consideration, and modern experience shows that it is not well founded.[65] And so Mr. Justice Eyre says Bircot's case is not law.[66]

The cases on Watt's patent brought this question directly before the courts, for his invention was professedly an *improvement* on the steam-engine. In one of those cases which came before the Exchequer

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[64] 2 H. Bl. 489.
[65] 8 T. R. 104.
[66] Boulton v. Bull, 2 H. Bl. 491.

Chamber in 1795, Mr. Justice Buller said, "that a patent for an addition or improvement may be maintained, is a point which has never been directly decided; and Bircot's case, 3 Inst. 184, is an express authority against it, which case was decided in the Exchequer Chamber. What were the particular facts of that case we are not informed, and there seems to me to be more quaintness than solidity in the reason assigned, which is, that it was to put but a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection, that the coat on which the button was to be put was old. But in truth arts and sciences at that period were at so low an ebb, in comparison with that point to which they have been since advanced, and the effect and utility of improvements so little known, that I do not think that case ought to preclude the question. In later times whenever the point has arisen, the inclination of the court has been in favor of the patent for the improvement, and the parties have acquiesced, where the objection might have been brought directly before the court."[67]

The preceding cases have been cited rather to show the course of the jurisprudence on this subject, and the grounds on which an addition or improvement was held to be patentable under the English statute

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[67] 2 H. Bl. 489.

of monopolies, than for the purpose of establishing the point that it is so, of which there can be no doubt, since, as we have seen, the act of Congress expressly recognises the right to such a patent.

In regard to improvements, two material questions arise: 1. Whether a thing is new, or the *improvement* merely of what was known before; and 2. Where the alleged invention is described to be an improvement merely, whether it is a substantial material improvement, or only a change in form.

On the first of these questions Mr. Justice Story says, "it is difficult to define the exact cases, when the whole machine may be deemed a new invention, and when only an improvement of an old machine; the cases often approach very near to each other. In the present improved state of machinery, it is almost impracticable not to employ the same elements of motion, and in some particulars, the same manner of operation, to produce any new effect. Wheels, with their known modes of operation, and known combinations, must be of very extensive employment in a great variety of new machines; and if they could not, in the new invention, be included in the patent, no patent could exist for a whole machine embracing such mechanical powers." "Where a specific machine already exists, producing certain effects, if a mere addition is made to such machine, *to produce the same effects* in a better manner, a patent cannot be taken for the whole machine, but for the improve-

ment only. The case of a watch is a familiar instance. The inventor of the patent lever, without doubt, added a very useful improvement to it; but his right to a patent could not be more extensive than his invention. The patent could not cover the whole machine as improved, but barely the actual improvement. The same illustration might be drawn from the steam-engine, so much improved by Messrs. Boulton and Watt. In like manner if to an old machine, some new combinations be added, to produce new effects, the right to a patent is limited to the new combinations."

"On the other hand, if *well known effects* are produced by machinery in all its combinations *entirely new*, a patent may be claimed for the whole machine."

"So if the principles of the machine are new, either to produce a new or an old effect, the inventor may well entitle himself to the exclusive right of the whole machine. By the principles of a machine (as these words are used in the statute) is not meant the original elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar device or manner of producing any given effect. The expansive power of steam and the mechanical power of wheels, have been understood for many ages; yet a machine may well employ either the one or the other, and yet be so entirely new, in its mode of applying these elements, as to entitle the party to a patent for his whole com-

bination. The intrinsic difficulty is to ascertain, in complicated cases, the exact boundaries between what was known and used before, and what is new, in the *mode of operation*"[68]

An eminent jurist remarks that "in the present improved state of the arts, it is often a question of intrinsic difficulty, especially in cases of the invention of minute additions to complicated machinery, to decide whether one machine operates upon the same principle as another, and whether that which is stated to be an improvement, be really new and useful." And he proceeds to suggest, upon the authority of the above decisions of Mr. Justice Story, that, in determining whether a machine is an improvement upon those already known, or substantially the same, "the material point of inquiry is, not whether the same elements of motion, and, in some particulars, the same manner of operation, and the same component parts are used, but whether the given effect be produced substantially by the same mode of operation, and the same combination of powers in both machines."[69]

Here we observe that the criterions proposed are, first the diversity of effect; second, the diversity of method. Mr. Justice Story, in one of the cases cited above, proposes the combination of these two circum-

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[68] Whittemore v. Cutter, 1 Gallison, 478. See also opinion of Mr. Justice Story in Odiorne v. Winkley, 2 Gall. 51.

[69] Kent's Com. Vol. 2, p. 370, 2d edit. Lect. 36.

stances as a criterion. But his meaning doubtless is that these are characteristic of an improvement constituting an invention which may serve to distinguish it where other characteristic distinctions are wanting; and Chancellor Kent would not probably be understood to lay down a different doctrine. The use of different elements of motion, or different mechanical principles or combinations offer equally marked grounds of discrimination, which are no less to be resorted to, than the method of operating and the result. Indeed the result or effect can scarcely be considered a criterion, for this by itself is not, as we have seen, patentable. In order to distinguish whether an alleged invention is patentable as such, and not merely a slight, immaterial, formal variety of what was already known, whether patented or not, we must look, not at a part merely, but at all of the characteristics of a patentable invention, the elements, principles, method or mode of operation, and according as we find these, originally, more or less combined in the alleged improvement, it will appear proportionably more or less satisfactorily to constitute the basis of a patent.

The following case in the Court of King's Bench, in England, illustrates what may be considered as amounting to a patentable improvement. A patent was granted for an improvement in the manufacturing of chain cables. The improvement was alleged to consist in so applying the link to the force to operate

on it, that that force should operate in one place, namely at the end; and this was effected by having a broad-ended bar across, instead of a conical one, which broad-ended bar lapped round the link, instead of perforating it; the former bars weakened the link, and they were weak in themselves, and if broken, there would be a pressure in some other part. The links were to have circular ends, and sides nearly parallel, but bulging out towards the middle. Abbott, C. J. "As at present advised, I am inclined to think that the combination of a link of this particular form, with the stay of the form used by the patentee, although the form of the link might have been known before, is so far new and beneficial as to sustain a patent." Bayley, J. was of the same opinion.[70] In this case a link of the same form had been before in use, and it had been strengthened by a bar across it, but a change of the form of this bar, and the manner of attaching it to the link, was considered, and as it should seem with very good reason, by Chief Justice Abbott and Mr. Justice Bayley, to be a good foundation for a patent. The case went off, however, upon other grounds.

The provision of the act of Congress that the party making an improvement should not be entitled thereby to use the original machine, if it was subject to a

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[70] Brunton v. Hawkes, 4 B. and Ald. 540.

patent right, is introduced merely for the purpose of excluding any inference that the granting of a patent for an addition impaired the right of the original patentee. There would, however, have been very slight grounds for any such pretence, had the clause not been introduced, since the fact of granting a monopoly necessarily excludes others from the use of the article without the permission of the patentee during the existence of the exclusive privilege.[71]

Sec. XII.—Change of Form, Proportions, or Materials. Insufficiency of the Invention. Ornaments.

The second section of the act of Congress of 1793, which authorizes a patent for an improvement, declares "that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery." This construction would undoubtedly have been put upon the law without any such express exception. It is indeed but the branch of a more general rule in giving a construction to the law, namely, that any change or modification of a machine or other patentable subject, which would be obvious to every person acquainted with the use of it, and which makes

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[71] See Fox, ex parte, 1 Ves. & B. 67.

no material alteration in the mode and principles of its operation, and by which no material addition is made, is not a ground for claiming a patent. To permit a formal, trivial change in an article to be patentable, or a reconstruction of it upon substantially the same principles, with unimportant differences in form or proportions, would defeat the beneficial operation of the statute and in effect repeal it. In considering the subject of the infringement of patents, we shall see more distinctly the construction put upon the statute in this respect, and it will appear that the courts carry out the motives and reasons of this exception in deciding what is an infringement, and what improvements are the subjects of a distinct patent.

The principle of this provision of the statute is as applicable to most alleged new inventions as to professed improvements or patented machines, since almost every invention is an alleged improvement, either on what has been patented, or what has been practised without ever having been subject to a patent, and as soon as a patented art or machine has become free by the expiration of the patent, it stands upon the same ground as any art or machine which has been in free public use time out of mind. To authorize a patent in either case, there must be, not merely a formal, trivial variation, but a distinguishable, substantial difference.

In a case in the English Court of Chancery, Mr.

Bell, one of the counsel, justly remarked that "it was not necessary to show that an invention was the result of long application or deep skill. He remembered that many years ago ladies wore flowered tabbies. The method of working the flowers was discovered by mere accident; a man having spit upon the floor, placed his hot iron on it, and observed that it spread out into a kind of flower. He afterwards tried the experiment upon linen, and found it produced the same effect. He then obtained a patent, and lived to make a considerable fortune."[72]

The sufficiency of the invention depends not upon the labor, skill, study, or expense applied or bestowed upon it, but upon its being diverse and distinguishable from what is familiar and well known, and also substantially and materially, not slightly and trivially so. This requisite of an invention is sometimes expressed to be a difference in principle.

"What constitutes a difference in principle between two machines, is frequently a question of difficulty, more especially if the difference in principle is considerable, and the machinery complicated. But we think it may safely be laid down as a general rule, that where the machines are substantially the same, and operate in the same manner, to produce the same result, they must be in principle the same.

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[72] Walker v. Congreve, 29 Rep. of Arts, 2d Series, Vol. 29, p. 311.

I say *substantially*, in order to exclude all formal differences, and when I speak of the same result, I must be understood as meaning the same kind of result, though it may differ in extent. So that the result is the same according to this definition, whether the one produce more nails, for instance, in a given space of time, than the other, if the operation is to make nails."[73]

A patent for an improvement in dressing woollen cloth by damping it with steam, instead of wetting it with hot water according to the former practice, was held, by Lord Tenterden, to be void, on the ground that it was not a sufficient change from the former practice to constitute an invention.[74]

Mr. Godson states from manuscript the case of a patent being cancelled on *scire facias*, on the ground of the insufficiency of the invention. A patent had been granted, in 1818, to Hadden, for an improvement in manufacturing woollen cloth by passing the wool between hollow iron rollers heated by putting heaters into them. Lister varied the pro-

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[73] Per. Washington J. Gray and Osgood v. James and others, 1 Pet. C. C. R. 396.

[74] The King v. Fussell, Gods. Sup. 15. 71. The scire facias was instigated by Daniell to repeal Fussell's patent as an infringement of his own. Fussell retaliated by instigating a similar process against Daniell, (the King v. *Daniell*, Gods. Sup. 71.) on the ground that the mode of dressing cloth by using hot water, which was patented by him, was in use by others long before his patent was granted; and both patents were repealed.

cess by heating the rollers by steam, and by passing the wool through hot water to soften it. This was ruled at nisi prius not to be a sufficient improvement upon Hadden's invention, or rather, not be a sufficient variation from it, to constitute an invention, and the patent was on this ground repealed.[75]

The question of the identity or diversity of two manufactures was much discussed in the case already cited on the patent for an improvement in the manufacture of ships' anchors. The specification stated that in place of the common method of joining the two flukes, consisting of distinct pieces of iron, to the shank by welding, which requires the iron to be so frequently heated as to destroy its tenacity, the patentee made the shank in one piece, and the two flukes in another; and the piece intended for the arms was formed of such a thickness in the middle as to allow a hole to be made through the centre, to receive the thick end of the shank; the hole was made conical or bell-mouthed, so that no strain could separate the flukes from the shank; by which means the necessity of endangering the solidity of the materials was avoided, only one heat being necessary to bring the thick end of the shank and the hole into perfect contact. In an action for an in-

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[75] The King v. Lister, Gods. Sup. 71. Hadden's patent was also repealed on scire facias at the instigation of Lister on the ground that it was not a new invention. The King v. Hadden, Gods. Sup. 71.

fringement, Abbott C. J. said that "the improvement claimed by the patentee, was precisely the method by which the shank of the mushroom anchor is united to the mushroom top; by which the shank of the adz anchor is united to its other parts. It is indeed the mode by which the different parts of the common hammer, and the pickaxe also, are united together. Now a patent for a machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good; because there is a novelty in the combination. But here the case is perfectly different; formerly three pieces were united together; the plaintiff only unites two; and if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent; but unfortunately, the mode was well known and long practised. I think that a man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose. It seems to me, therefore, that there is no novelty in this improvement." Bayley J. "Could there be a patent for making, in one entire piece, what before had been made in two pieces? I think not. After having had a one-fluked anchor, could you have a patent for a double-fluked anchor? I doubt it very much. After the analogies alluded to in argument of the hammer and pick-

axe, I do not think that the mere introducing the shank of the anchor, which I may call the handle, in so similar a mode, is an invention for which a patent can be sustained. It is said, in this case, that the mushroom anchor and adz anchor, are not ships' anchors, but mooring anchors. I think they are ships' anchors; they are not indeed such anchors as ships carry with them for the purpose of bringing the ship up; but if the ship is required to be stationary, at a particular place, then the common mode of making it stationary, is by the mushroom anchor. So the mode adopted to bring a ship containing a floating light to an anchor, is by mooring her to one of these mushroom anchors. That is the description of anchor for a holdfast to the ship. The analogy between the case of the mushroom anchor and of the adz anchor is so close to that of the present anchor, that it does not appear to me that this discovery can be considered so far new as to be the proper ground of a patent." Best J. "It is said that the invention consists in the application of that which was known before to a new subject matter, viz. that the patentee had, for the first time, applied to the manufacturing of anchors, a mode in which welding was avoided, which however had been long practised in other instances; but the patentee does not state that as the ground upon which he had applied for his patent, nor state in the specification, that it being known that the process of welding weakens the

anchor, he had first applied to an anchor a mode long practised in the manufacture of other instruments, viz. of making the two flukes of one piece instead of two. If he had so described this process, the question would then arise, whether that would be a good ground for a patent. I incline to think, however, that it having been long known that welding may be avoided in instruments of a similar form, the application of that practice for the first time, to a ship's anchor, cannot be considered a new invention, and, therefore, that it is not the ground of a patent. It is unnecessary, however, to decide that question in this case, because the patentee has claimed the mode of avoiding welding as a new discovery."[76]

Mr. Chief Justice Gibbs gives an illustration of variation in form merely. In the case of Bovill v. Moore, (Dav. Pat. Cas. 361,) he mentions the expedient used by a man in Cornwall, who endeavored to pirate the steam-engine. "He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watt's; where you looked for the head, you found the feet, and where you looked for the feet you found the head; but it turned out that he had taken the principle of Boulton and Watt's—it acted as well one way as the other; but if you set it upright it was exactly Boulton and Watt's engine."

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[76] Brunton v. Hawkes, 4 B. & Ald. 540.

The distinction of a mere formal variation from a substantial improvement is in many cases very nice. In a case before Lord Ellenborough, Huddart had obtained a patent for a new mode of making cables and other cordage. It appeared that his invention differed from Belfour's, because that which was effected with a ring by Belfour, was produced by a tube in the mode of making ropes by Huddart. Lord Ellenborough "The tube does seem to me an important difference from the mere circle through which the strands pass, because it keeps them in a degree of confinement for a longer time, and more certainly obtains the end pointed out; in Mr. Belfour's specification the same end is to be attained; and had the patent been taken for that to be done by a tube, which was before done by a ring or circle, I should have thought the patent good; for that is a distinct substantive invention.[77]

The substitution of one material for another is not, at least ordinarily, an invention for which a patent can be claimed. Sir John Leach, in an argument made by him as counsel, in the case of an alleged improvement in the construction of barrels for containing gunpowder, said, "The making of an old machine of new materials, could not be a discovery; and the plaintiff could claim no protection, for an invention, the only merit of which consisted in being

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[77] Huddart v. Grimshaw. Dav. Pat. Cas. 297.

made of brass instead of wood. When tea was first introduced into this country, earthen teapots were used; but could a person who made the first one of silver be entitled to a patent?"[78] This position is correct in general, and yet there may be cases in which the substitution of a different material may be a matter of contrivance and invention, and in such a case the particular mode of applying the new material would be a good subject of a patent.

The provision on the subject of change of proportions is expressly extended by the act of Congress, ot compositions of matter as well as to machines, and yet there are instances of compositions of matter in which the proportions are material. In one case one ground of holding the patent to be void, was, that the exact proportions in which lime and other ingredients were to be used in making iron, to prevent *cold-short*, were not stated.[79] This was assuming the proportions to be material, and if so, then a change of proportion may be an essential improvement. When the invention depends materially on the proportions of a mixture or composition of matter, and where, accordingly, a change in this respect makes a different process or a different result, such

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[78] Walker v. Converse. Rep. of Arts, 2d Series, Vol. 29, p. 311. Mr Godson cites this argument of Sir John Leach as an opinion given by him as Vice Chancellor.

[79] Hill v. Thompson, 3 Meriv. 624.

a change would certainly come within the description of patentable subjects in the second section of the act of Congress; it would not be "simply" a change of proportions.

The French law of 1791 classes mere ornaments with changes in form and proportions, as not being subjects of patents. But this appears to be a very questionable position, for it would never be contended in case of an invention of which a part was ornamental merely, that this part might be infringed with impunity; and there appears to be no more ground for yielding any more protection to ornamental parts in an original invention, than in an improvement, or in a case where a part of the invention was ornamental, than one which should be wholly confined to ornament.

Sec. XIII.—Legality.

An invention, to be patentable, must not only be new, but lawful. The sixth section of the English statute of monopolies, permits the monopolies of new manufactures, "so they be not contrary to the law." The acts of Congress which constitute our patent law, contains no similar provision; nor was any such necessary in the act of Parliament, since it would be implied, though it were not expressed. The construction put upon the acts of Congress by the Amer-

ican courts in this respect, is the same as that put upon the act of Parliament by the English courts.

A very ingenious instrument is said to have been invented by a London pickpocket to facilitate the practice of his art, of which he made the first experiment, and successfully, upon the artist by whom it was manufactured. There needs no express exception to prevent such an instrument from being patentable, since it would be quite absurd to encourage and reward by one law the art of violating another. So a chemical composition for poisoning people without danger of detection, would not be the subject of a monopoly under the patent law. This is in pursuance of a universal principle of jurisprudence. It is the principle of construction of the French patent law, which contains no express exception of unlawful industry. "It would," says M. Renouard,[80] "be preposterous to guaranty to a man the exclusive right of doing what the law would punish when done."

Sec. XIV.—Usefulness.

By the sixth section of the English statute of monopolies it is provided that, in order to exempt a manufacture from the general prohibition of monopolies, it must be one that is "not mischievous to the

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[80] p. 167. c. 5. s. 12.

State by raising the price of commodities at home, or hurt of trade, or generally inconvenient." The only part of the act of Congress of 1793, in this respect, is simply the epithet *useful*, the provision of the first section being, that if any one shall allege that he has invented a *useful* art, machine, manufacture or composition of matter, he may apply for a patent. Mr. Godson says, in regard to the requisite usefulness, that "if the article that is produced by the machine be old, it must be furnished to the public at a much cheaper rate. The community must receive some benefit from the invention; and when it is not a new article which is introduced, the old one must, in some respect, be rendered a better commodity for trade."[81]

In some of the earlier cases in Pennsylvania and Massachusetts for infringements of patents, the defendants, putting the same construction upon the act of Congress as that put upon the English statute of monopolies by Mr. Godson, and by some of the English judges, set up the defence that the machine, for the infringement of which the action was brought, was not a *useful* one, as it was no improvement on the methods previously in use for the same manufacture, and accordingly that it did not come within the description of inventions for which a patent was au-

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[81] Treatise on Patents, p. 70, 71. See Manton v. Manton, Davis's Pat. Cas. 349; Lewis v. Davis, 3 Car. & P. 502. See also remarks of Abbott C. J. 2 B. & Adol. 349.

thorized.[62] On this ground of defence the decisions of Mr. Justice Story are very full and explicit. He says, "By *useful* invention, in the statute 1793, c. 156, is meant such a one as may be applied to some beneficial use in society, in contradistinction to an invention which is injurious to the morals, the health, or the good order of society. It is not necessary to establish, that the invention is of such general utility as to supersede all other inventions now in practice to accomplish the same purpose. It is sufficient that it has no noxious or mischievous tendency, that it may be applied to practical uses, and that so far as it is applied it is salutary. If its practical utility be very limited, it will follow, that it will be of little or no profit to the inventor, and if it be trifling, it will sink into utter neglect. The law, however, does not look to the degree of utility; it simply requires, that it shall be capable of use, and that the use is such as sound morals and policy do not discountenance or prohibit."[63]

In an action for an infringement of a patent for an improvement in the construction of pumps, the same judge said, "that it was contended by the defendant that it was necessary for the plaintiff to prove, that his invention is of general utility; so that in fact, for the ordinary purposes of life, it must supersede the

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[62] Gray & Osgood v. James and others, 1 Pet. C. C. R. 480, 481.

[63] Bedford v. Hunt, 1 Mason, 302.

pumps in common use; in short, that it must be for the public, a better pump than the common pump; and that unless the plaintiff can establish this position, the law will not give him the benefit of a patent, even though in some peculiar cases his invention might be applied with advantage. I do not so understand the law. The St. 1793, c. 156, uses the phrase *useful* invention merely incidentally; it occurs only in the first section, and there it seems merely descriptive of the subject matter of the application, or of the conviction of the applicant. Neither the oath required by the second section, nor the special matter of defence allowed to be given in evidence by the sixth section of the act contains any such qualification or reference to general utility, to establish the validity of the patent. Nor is it alluded to in the tenth section as a cause for which the patent may be vacated. To be sure, all the matters of defence or of objection to the patent are not enumerated in these sections;[84] but if such a one as that now contended for, had been intended, it is scarcely possible to account for its omission. In my judgment the argument is utterly without foundation. All that the law requires is, that the invention should not be frivolous, or injurious to the well-being, good policy, or sound morals of society. The word *useful*, therefore, is incorporated into the act in contradistinction to mis-

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[84] Whittemore v. Cutter, 1 Gallison, 429. 435.

chievous, or immoral. For instance, a new invention to poison people, or to promote debauchery, or to facilitate private assassination, is not a patentable invention. But if the invention steers wide of these objections, whether it be more or less useful is a circumstance very material to the interest of the patentee, but of no importance to the public. If it be not extensively useful it will silently sink into contempt and disregard."[85]

Mr. Justice Story hints, upon this kind of defence, in a case of infringement, that it, in some cases, reduced the defendant to a dilemma, since if he had not used the invention, there was no occasion to resort to this defence; if he had, the averment that it was useless came with an ill grace from him, since it was contradicted by his practice.[86] This ground of defence accordingly does not appear very frequently in the reports. It does, however, sometimes appear and is recognised as a valid objection to a patent.

It was held in England, that in an action for the infringement of an improvement, the inutility of the original invention, could not be given in evidence in defence, or in other words, though the original invention was not useful, the improvement might be so,

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[85] Lowell v. Lewis, 1 Mason, 182; and see also Earle v. Sawyer, 4 Mason, 6.

[86] Lowell v. Lewis, 1 Mason, 186.

for it might remedy some defect in the original invention, or remove some objection to it.[87]

So Mr. Justice Washington ruled, that taking this requisite in the strongest sense, still a machine might be considered useful within the act of Congress, if, by an improvement, it was capable of being advantageously put into operation. "It is not," he remarked, "the intrinsic value of the thing itself, but its capacity to be converted into something which may be useful, that gives it value. Admit, for the sake of argument, that Perkins's machine, (the one infringed upon,) in the form in which it came from his hands, was so far inferior to the nail machines then in use as to deprive it of all intrinsic value; yet if another person can superadd to that invention something which will remove all its defects, and render it useful, it immediately becomes valuable, not on account of its own qualities, but because of its capacity to receive the improvement, and with its aid to become useful. The original discovery and the improvement become articles of traffic between the two discoverers as soon as the improvement was made which it was their mutual object to give value to."[88]

But in the more restrained sense, according to the construction of Mr. Justice Story, which is now uni-

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[87] Lewis v. Davies, 3 Car. & P. 502.

[88] Gray & Osgood v. James & others, 1. Pet. C. C. R. 480, 481.

versally adopted in the United States, the improvement on an invention that is not useful, or in other words, that is pernicious, or in the words of the English statute of monopolies, "mischievous to the state or generally inconvenient," cannot be useful, unless it diverts the invention into a different channel clear of the objection; and in this restrained sense the invention cannot be considered useful according to the doctrine of Mr. Justice Washington in the above case, on the ground that it is capable of being rendered so by an improvement.

The requisite of usefulness has been sometimes contrasted with frivolousness,[89] and the multiplicity of patents for trivial subjects has been occasionally deprecated by judges.[90] An invention may be slight and trivial as being so obvious and apparent that it cannot be considered a discovery, or it may be trivial or frivolous in respect to its effect upon industry and production. A defect in the first sense renders the patent void as being for a subject that is not an invention. But an invention of a very slender character in the latter sense is still the subject of a patent, since it is not the province of the court to go into the question of the extent or degree of usefulness. It is enough that the invention is useful; how useful it may be is immaterial.[91] The inutility of an

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[89] Kent's Com. Vol. 2, p. 368, n. Lowell v. Lewis, supra 139.
[90] Thompson v. Haight, U. S. Law Journal, Vol. 1, p. 563.
[91] Lowell v. Lewis, supra, 139, 140.

alleged invention was one of the grounds of decision against a patent in a case that came before Mr. Justice Livingston in the Circuit Court of the United States in New York, on a specification for "an improvement in folding the thread and floss cotton into skeins or hanks of a convenient quantity for retailing, with a sealed wrapper round the same, and a label containing the number and description of the article." The cotton thus folded was imported from the factory of Holt, in England. The article itself underwent no change, and the whole of the improvement consisted in putting up skeins of it, perhaps of the same size in which they were imported, decorated with a label and wrapper ; thus rendering their appearance somewhat more attractive, insomuch that it sold at a price twenty-five per cent. higher than before it was so put up. When stripped of these appendages, which it must be before using it, the cotton was no better in any respect than when put up by Holt. Mr. Justice Livingston said, "Now that such a contrivance—for with what propriety can it be termed a useful art within the meaning of the constitution ?—may be beneficial to a patentee, if he can exclude from the market all other retailers of the very same article, will not be denied ; and if to protect the interest of a patentee, however frivolous, useless or deceptive his invention may be, were the sole object of the law, it must be admitted that the plaintiff has made out a satisfactory title to his

patent. But if the utility of an invention is to be tested by the advantages which the public are to derive from it, it is not perceived how this part of his title is in any way whatever established. Is any thing done to alter the texture of the cotton, or to render it better or more portable or more convenient for use? Nothing of this kind is pretended." On these grounds, and especially as the court thought that the patentee held out a false appearance and imposed upon purchasers, the patent was held to be void.[92]

An invention, to entitle the inventor to a patent, "must," says Mr. Chancellor Kent, "be, to a certain extent, beneficial to the community, and not injurious or frivolous or insignificant."[93]

The French law does not pretend to take cognizance of the utility of the invention. Every new species of legal industry, says M. Renouard[94] is the proper subject of a patent, however trifling may be its utility. To exclude the inference that the patent is any guaranty of the character of the invention, the declaration has been inserted in the patent, that the government, in granting it without any preliminary examination, did not intend to guaranty, in any de-

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[92] Langdon v. De Groot, 1 Paine R. 203.

[93] Com. Vol. 2, p. 369. Cites Lowell v. Lewis, 1 Mason's R. 182; Evans v. Eaton, 1 Pet. C. C. R. 322; and above case of Langdon v. De Groot.

[94] P. 177, c. 5, s. XV. 1.

gree, either the novelty or the merit, nor the success of the invention. This clause was introduced on the occasion of an application for a patent for a phenomenon in acoustics, by means of which answers were given to questions put in a low voice, without the inquirer's seeing the person who gave the answers. This was called the *invisible woman*. When Lucien Bonaparte, being then minister of the interior, presented that patent with divers others for the signature of Napoleon, then first consul, the latter threw the paper under the table, taking offence that it should be proposed to him to sign such frivolous documents. The minister of the interior attempted to demonstrate to him that the law ordered the issuing of patents without previous examination, however useless or absurd even, might be their objects. Thereupon the first consul proposed the three following questions to the board of arts and of commerce:

1. Whether some form of despatching these documents might not be devised that would dispense with the signature of the first consul. 2. Whether patents ought to be granted for frivolous subjects. 3. Whether a mode of granting patents might not be devised that would prevent disputes concerning priority, and the abuses which patentees might make of their privilege by representing the patent as a certificate and favorable attestation of the government, and thus leading persons into error who did not know that patents were granted without any consideration of

their merits. In consequence of these queries the above clause was introduced into the French patents.

Sec. XV.—Vendibility.

In connexion with the requisite of usefulness, we may mention another which has been considered to be indispensable, both under our act of Congress, and under the statute of monopolies, namely, that either the means or instrument, or the product of the art, method, or process patented, must be *vendible*. This word, in its ordinary sense, does not precisely express the quality intended, its usual meaning being, that the thing to which it is applied is in demand, which is not the case with all inventions. It is not provided by law that the patentee shall either sell or offer for sale, or be able to find a purchaser for the thing of which he has the monopoly; nor has either of these conditions been insisted upon by any construction put upon the law. The making any such condition would be the same as to make it imperative upon a party to whom a reward is offered to accept it. The meaning of monopoly, (and a patent, as we have seen, is one,) is the exclusive *privilege* of selling the subject of which the monopoly is granted. In some monopolies, as, for instance, that of the trade to a particular foreign port, or in a particular article, a condition may be made that the

monopolist shall avail himself of the privilege or lose it. So it might be provided in the patent law, that the patentee should either himself make the thing to which the patent relates, or authorize others to do so, and that the subject patented, or its products, should be offered for sale; still if it leaves him the privilege of fixing his price, this would put it in his power to prevent the sale, and so render the requisition that it should be offered for sale, ineffectual.

If the law should go still further, and provide for prescribing the terms on which the article should be offered for sale, by referring it to some board to regulate the market value, it would subject the monopolist to much embarrassment, and, at least, greatly impair the value of his privilege, besides opening a door to vexatious interference and abuse.

There might be still another provision on this subject, requiring that the matter to which the patent related, or its products, should be sold publicly within a certain time, under penalty of forfeiture of the privilege. But if the quantity or number of specimens were not fixed, the provision might be easily evaded, and, in order to fix the quantity or number of specimens, it would be necessary to constitute a board, with an arbitrary discretion in the case; to which there would be the same objections as to a board for regulating the price.

Then, again, the reason why the patentee makes no sale, may be that the invention is considered of

no value whatever by any person, excepting the inventor himself, and so other persons do not regard his exclusive privilege to be any interference with their pursuits or interests. This is, in fact, the case with many patents; and, in all these instances, there is no motive for any requisition or regulation on the subject.

And, finally, in still another case, a sale may not be practicable, though the invention may be useful and valuable, merely because it is not well understood by other persons than the inventor, or because no one, who has the proper means and facilities for putting it into actual operation, has made it a subject of his attention.

There are reasons why the law does not, and should not, either expressly or by construction, require that the invention, or its products, of which the privilege of exclusive sale is granted, shall be sold or offered for sale. It may be asked then, whether there ought not to be some provision against the perverseness of a patentee, who should willingly sacrifice his own interest for the satisfaction of acting the dog in the manger, and enjoy his exclusive privilege, by observing how much the public is incommoded, and how great a benefit it is in his power to withhold from them? Certainly not; for this is an inconvenience and deprivation to which the community is exposed in another case, namely, that of an artist who is able, by his superior genius and skill,

to produce the most admirable work, but who, from indolence, or some other vice, or, as sometimes happens, from mere waywardness, neglects to make use of the exclusive privilege conferred by his superior genius and skill. His privilege differs, at the first view, from that of a patentee, inasmuch as that of the latter is one of express grant from the government; but this difference will not be so material, on consideration, as it might at first view appear, since the grant is made, not like that of a branch of foreign trade, in consideration that it is to be used during the existence of the privilege, but in consideration that the patentee has given a specification whereby the public may have the benefit of his invention at the expiration of his privilege. During the privilege, therefore, all the conditions having been complied with, it stands on the same ground as any other private right, as that of property, or of using one's industry, and so should be subject to the same rules of legislation and regulation, and no others. In regard to all kinds of private rights, the community is affected by the good or bad use of them; but in this, it is necessary to rest, in some degree, upon individual discretion, since it is impossible to give directions for the use of all individual rights, in all respects, and one universal exception is made to the expediency of any legislative regulation, namely, when the real and obvious interest of the individual is coincident with that of the public.

In such cases, the interest of the community is generally left free to be promoted or prejudiced, according as the individual has or has not the good sense to make the use of his rights, that his own interest, properly understood, would dictate.

If, then, the doctrine that the subject of a patent or its products, must be vendible, does not mean that a demand for it must exist, nor that there must necessarily be an offer for sale, as an essential condition of the validity of the monopoly, what is the construction to be put upon the doctrine? It is, that the thing patented, or its products or results, must be of a vendible character or description; or, such as *can* be the subject of a sale. This is the construction given to the rule by Mr. Godson,[95] for which he cites the expressions of judges, in giving their opinions in patent cases, though he says no case has turned upon precisely this question.[96]

Sec. XVI.—Novelty, Priority.

It is an essential requisite that the invention shall be *new*. This is expressly provided in the English and American statutes, on this subject. The very

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[95] p. 65.

[96] He cites the expressions of Heath J., 2 H. Bl. 482; Kenyon C. J., 8 T. R. 99; and Abbott C. J., 2 B. & Ald. 349, 350.

terms *invention* and *discovery* import, in their general and most obvious signification, that the thing discovered or invented is *new* to the inventor. But it is not so distinctly and necessarily implied in those terms how far it must be new to other persons, as to exclude all doubt, since an invention may be new to the inventor, which is familiar to many others; or it may be new in his neighborhood, and well known in other parts of the country; or it may be new in his own country, while it is in familiar use abroad. And again, although it may have been already known, it may have been so recently invented, as to be still *new*, at the time of the posterior invention. Had the statutes stopped here, however, and authorized a patent for a *new* invention, without further explanation, the expression must have been limited by construction, and confined to a patent either to the first or *original* inventor, or to the first applicant for a patent, since the patent is an *exclusive* privilege of the making and vending the thing patented, and it is therefore necessary, in order to give the statute effect, to define expressly in the act, or in the construction put upon it, by what criterion the novelty is to be tested. The statutes do not accordingly stop here; they both go further, and define what is to be understood by the thing being new. The statute of James limits the privilege to manufactures, "which others at the time of the making such letters patents, and grants,

did not use." So the act of Congress limits the privilege in like manner to the things "not known or used before the application" for the patent.

On this subject of the novelty of the invention, we shall find some discrepancies between the English and the French law on one side, and that of the United States on the other.

The first inquiry relates to the time in reference to which the invention must be new. Must it be so at the time of the granting of the patent, or at least at the time of the application for it, or is it enough that it is so at the time of the invention by the party claiming a patent? M. Renouard seems in one place to consider it requisite in France that the thing should be new at the time of issuing the patent. He says[97] "it is very rare that the discussion may not be referred to this single inquiry, namely, whether the public, at the moment of the delivery of the patent, does, or does not, receive the communication of a species or mode of industry which it did not before possess;" if it does the patent is valid, otherwise it is null. This is the rigorous doctrine of the English law,[98] from which M. Renouard apparently adopts it.

The doctrine strikes the mind as preposterous in either country, but more palpably so in England, where ordinarily very considerable time necessarily

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[97] C. 5. s. 1. p. 174.

[98] Jones v. Pearce, Godson Sup. 4.

elapses between the application and the granting of the patent, so that the inventor thereby, in the very act of applying for a patent, takes the hazard of defeating his right to one, since he thereby gives some publicity to his invention, and thus unavoidably holds out to others a facility in pirating it before the patent can be issued, and so is obliged to risk the rendering his patent void by the very means he is compelled by law to take to obtain it. Nothing can be imagined more preposterous than this doctrine. It could hardly be supposed that a doctrine, so repugnant to the principles and spirit of the patent laws, could have arisen by such construction of language, which admitted of any other interpretation; and we accordingly find by recurring to the fifth and sixth sections of the English statute of monopolies, which constitute the patent laws of England, that it is derived from the language of the law taken in a strict and literal sense. The sixth section of that law, after abolishing monopolies generally, makes an exception of temporary monopolies for the sole working and making of any manner of new manufactures to the true and first inventor, "which others, *at the time of making such letters patents and grants, shall not use.*"

By taking this clause in a literal sense, the English courts have gone far towards defeating and annulling the encouragement intended to have been given to inventors by these sections; and if we may rely

upon M. Renouard's exposition of the French law, the same doctrine, so fatal to patents in England,[99] has been adopted in France. The operation of the doctrine would not probably be so prejudicial to the interests of inventors in that country as it has proved to be in England, since, in examining the proceedings for the taking out of a patent, as described by that author, it seems that much less time would be requisite than is necessarily consumed in England, in applying to one office after another, before the inventor can obtain the grant promised to him by the law. Still the doctrine is the same, and bears upon its face the same absurdity, in one country as in the other. It has the effect of exposing the inventor to the loss of his right by piracy, if he delays taking out his patent for the purpose of making experiments to perfect his invention.[100] The ground of this doctrine, as far as it can be supported otherwise than on the literal provision of law, is, that a thought or art having been published, and the public having taken advantage of it and reduced it to use, is their property, from whatever source they may have obtained the information. But a moment's reflection will show us that there would be the same reason precisely for sheltering a public use arising after the grant of the

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[99] Westm. Rev. No. 43, Jan. 1835. Foster's Am. Edit. p. 100.

[100] Westm. Rev. No. 43, Jan. 1835. p. 100, Foster's Am. Ed.; where the writer cites the evidence taken before the Committee of the House of Commons on this subject.

patent, as one arising after the application for it, since the application may as well be presumed to be known to all people as the patent.

There does not, on the whole, seem to be any foundation for this doctrine, unless it is found in a stern provision of the law, too plain and absolute to be controlled by construction, which is not the case with the sections of the statute of monopolies above cited, since it is an absurdity so to construe a law as to hold that the very means prescribed by the law as a compliance with its provisions, should, without any fault of the party for whose benefit the law is made, expose him to a forfeiture of its benefits. We shall introduce the authorities as to the degree of publicity and kind of use by others by which the inventor forfeits his privilege, in a subsequent part of this chapter; for whether the time to which reference is had in determining on the novelty of the invention be the date of the invention, of the application for a patent, or the grant of it, the doctrine as to use, degree of publicity or extent and kind of use whereby the patent is defeated, may be the same. The cases subsequently cited will show very distinctly that the doctrine of the English law is as above laid down, and, in the course of the examinations that took place on the subject of patents before the committee of the British House of Commons in 1832, a number of the gentlemen whose statements were taken by the com-

mittee, represented, in very strong terms, the inconveniences resulting to patentees from this doctrine.[101]

The same question has come up in discussion in the United States. "There is," says Mr. Justice Story, "a difference between the language and effect of our statute respecting patents, and that of England. The statute 21 Jac. 1, c. 3, prohibits the grant of monopolies generally; but in the sixth section it excepts 'letters patent and grants of privileges for fourteen years or under, of the sole working or making of any manner of new manufacture *within this realm* to the *true* and *first* inventor and inventors of such manufacture, which *others, at the time of making such letters patent and grants, shall not use.*' Upon this statute it has been held, that it is not necessary that the invention should be new to all the world, but it is sufficient, if *new within the realm of England*, and it matters not whether learned by travel or by study. The provision further is, that it must be an invention which others, at the time of making the letters patent, '*shall not* use.' Therefore it was held, in Wood v. Zimmer, (Holt's R. 58,) by Lord Chief Justice Gibbs, that if the inventor, before obtaining a patent, allows his invention to go into public use, he cannot entitle himself to a patent. The public sale of it, by the inventor to other persons for use, makes the patent void. It is not then *new* to the

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[101] Westm. Review, No. 43, Jan. 1835. Foster's Am. Ed. p. 100.

realm, but is *used* by others within the meaning of the statute."

"The patent act of the United States, st. 1793, c. 156, uses language somewhat different. The first section declares, that 'when any person or persons, &c. 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*,' he or they shall, on application to the Secretary of State, &c. be entitled to a patent. If this were all, there would be great difficulty in construing the words 'not known or *used* before the application' differently from the words of the English statute, 'which *others*, at the making of the letters patent and grants, shall not use.' We should be driven, therefore, to consider the accuracy of the decision of Lord Chief Justice Gibbs. But the sixth section of the st. 1793, c. 156, throws light on this subject, and enables the court to ascertain with more precision the intention of the legislature. That section authorizes the defendant to give certain matters in evidence, by way of defence, under the general issue, upon proper notice, and among other things, 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. Upon these clau-

ses it has been uniformly held, that it must be shown that the invention is new, not only in the United States, but to the world, and that it was not *in use* before the asserted discovery. The fact of its being *in use* before his *discovery*, is, by the sixth section, made decisive against the patentee. Now if the intention of the legislature had been, by the first section, to provide that the mere fact of the invention being '*known or used*' even with the inventor's permission, before the application for a patent, should destroy his right, however otherwise well founded, it is strange, that the use should not be limited, in the sixth section, to the time of such *application* instead of the '*supposed discovery*.' The sixth section manifestly proceeds upon the ground, that the same thing being in use at the time of the supposed discovery, establishes, that there is nothing new in the invention; but it may be known and used at the time of the application for a patent, and yet the applicant have been the true and first discoverer. And the words of the first section are susceptible of the same construction. The things sought to be patented must be something 'not known or used' by others before, but must be *first* known or *first* used by the person claiming to be the inventor; that is, others must not have known or used it before his discovery. Upon any other construction, if a party were the true and first inventor, yet if, before his application for a patent, another were to know his invention or use it,

piratically or innocently, the first inventor would be ousted of his right to a patent, which is inconsistent with the spirit of the act. Construing, therefore, the first section by the sixth, it seems to me, that the true meaning is, that the first inventor has a right to a patent, though there may have been a knowledge and use of the thing invented, by others, before his application for a patent, if such knowledge or use was not anterior to his discovery."[102]

It being once settled that the first inventor is entitled to a patent, it follows of course that the period referred to for testing the novelty of the invention is not the date of the *application*, since, at this date, in case of successive independent inventions of the same thing, whichever of the inventors applies, the manufacture has been *known* and *used* by another person independently of the applicant. The general object of the law must, therefore, be defeated in those cases where there are independent inventions of the same thing, or the date, not of the application, but of the invention, must be referred to in determining on the novelty of the art or manufacture. At the time of the invention by the prior inventor he has a right to a patent, of which he may avail himself unless he subsequently forfeits that right. By the law on this subject, as construed and administered in the United States, he may realize the fruits of his invention un-

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[102] Mellus v. Silsbee, 4 Mason, 108.

less he loses them by his own negligence; whereas in England, as we have seen, he may be deprived of his privilege, though he may not be chargeable with any fault or negligence. The characteristic difference between the law on this point, as administered in England and the United States, is, that in England the inventor is not supposed to have any right whatever in his invention until the grant of the patent, whereas in the United States the law supposes him to have a right at the time of invention, which he may forfeit, it is true, but which it depends on himself either to forfeit, or, by taking the proper steps, to perfect and establish.

In reading the English and American cases, it is necessary to bear constantly in mind the distinction above pointed out. In regard to England, for instance, if the inquiry relate to the use of the invention by others as affecting the rights of the patentee, the use or *knowledge* at the time of granting the patent is referred to, whereas in the United States the inquiry would, to many purposes, relate to the use made of the manufacture by others at the time of the patentee's invention, for we suppose him to invent the thing at any rate, in order to raise any question, since, if he be not the inventor, he has no claim for a patent; and, on the other hand, if he be the inventor, he has no claim, if others knew of and used the art or manufacture at the time of his making the invention.

There is a distinction in terms between a prior *invention* and a prior *use*, though in relation to this subject the two expressions mean, in some respects, substantially the same thing, but in other respects they are distinguished from each other. In the leading sense of the term *invention* it signifies an intellectual process, that is, to use Dr. Johnson's definition, an *excogitation*. In treating of the subject of invention in a former section,[103] it appears, however, that the law does not regard a mere conception, imagination, or intellectual process, as being the subject of a monopoly, independently of its reduction to use. The things for which patents are grantable, we have seen, must be arts, machines, manufactures, practical methods or processes or applications of principles, or compositions of matter ; to lay a foundation for a patent, something must be wrought, done or produced. The same construction is necessarily adopted in considering the question of prior invention, the question of priority is not limited to the mere conception, but has respect to the invention as already explained, and if the patentee is the prior inventor in this sense his patent will not be defeated merely because some other person may before have imagined something of the same sort.

That the prior inventor, in the sense already ex-

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[103] Section 8.

plained, has the preference, and is entitled to a patent, unless he forfeits his right, is held in many cases.[104]

The kind of use or reduction to practice, and putting into operation, necessary to constitute an invention, so as to entitle a party to a patent, or to defeat the claim of a subsequent inventor, is very distinctly pointed out by Mr. Justice Story. He says, "The first inventor, who has put the invention in practice, and he only, is entitled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent right, upon proof of such prior invention's being put in use. The law in such case cannot give the whole patent right to each inventor, even if each be equally entitled to the merit of being an original and independent inventor; and it therefore adopts the maxim, *qui prior est in tempore, potior est in jure.* The statute 1793, c. 156, s. 6, declares it a good defence to an action for the infringement of the patent right, '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.' The intent of the statute was to guard against defeating patents, by the setting up of a prior invention, which had never

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[104] Lowell v. Lewis, 1 Mason's R. 183. Per Dallas J., Hill v. Thompson, 2 J. B. Moore, 451.

been reduced to practice. If it were the mere speculation of a philosopher, or a mechanician, which had never been tried by the test of experience, and never put into actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. But if the first inventor reduced his theory to practice, and put his machine or other invention into use, the law never could intend, that the greater or less use in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the same invention. I hold it, therefore, to be the true interpretation of this part of the statute, that any patent may be defeated by showing that the thing secured by the patent, had been discovered and put in actual use, prior to the discovery of the patentee, however limited the use or the knowledge of the prior discovery might have been."[105]

In an action for the violation of a patent right to a machine for making cotton and wool cards, the same judge said that "it would not be sufficient to protect the plantiff's patent, that this specific machine, with all its various combinations and effects, did not exist

[105] Bedford v. Hunt, 1 Mason, 302.

before; for if the different effects were all produced by *the same application* of machinery, in separate parts, and he merely combined them together, or added a new effect, such combination would not sustain the present patent which was taken out for the whole machine, any more than the artist who added the second-hand or repeater to a watch, could have *been entitled to a patent of the whole watch.*"[106]

In another case the same judge says, "The first inventor of a machine is entitled to the benefit of his invention, if he reduce it to practice and obtain a patent therefor; and a subsequent inventor, although without any knowledge of the prior existence of the machine, or communication with the first inventor, cannot, by obtaining a patent therefor, oust the first inventor of his right, or maintain an action against him for the use of his own invention."[107]

A case in the English reports supplies an exception to the doctrine as to the priority of invention which will entitle the inventor to a patent as above laid down, namely, where the first inventor, though he reduces the invention to use, yet keeps it secret, and shows an intention not to give the public the benefit of it. It was the case of an improvement in

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[106] Whittemore v. Cutter, 1 Gallison, 482.

[107] Woodcock v. Parker, 1 Gallison, 438. See also Bedford v. Hunt, 1 Mason's R. 302; Evans v. Eaton, 3 Wheat. R. 454; S. C. 1 Pet. C. C. R. 322; Reutgen v. Kanowrs, 1 Wash. C. C. R. 168; Dawson v. Follen, 2 Wash. C. C. R. 311.

the object-glass of telescopes, invented by Mr. Hall, but suppressed by him until Mr. Dolland had subsequently made the same invention and procured a patent for it, the validity of which was disputed on the ground that he was not the first inventor. But the patent was held to be valid.[108]

Mr. Justice Buller puts this case upon the ground that Dolland was the first publisher of the invention, but it cannot be supported upon this ground merely, since it would put the priority, not upon the circumstance of the invention, but of the publication, which would be contradictory to the current of the decisions. It must stand upon the ground that, as the first inventor did not give the public that advantage of his discovery which it was the intention of the patent laws to secure, he should not stand in the way of a subsequent inventor who should be ready to give the public such advantage, at the end of the period of the monopoly provided for by the patent laws.

Mr. Justice Washington has laid down a doctrine at variance with that of Dolland's case. He considered that the inventor lying by for ever so long a period, and not taking out a patent, or continuing to use his invention, did not thereby forfeit his right of a patent, and that he might thus stand in the way of a patent being granted to any other inventor of

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[108] 2 H. Bl. 487. See also Forsyth v. Reviere, Chitty Jr's. Prer. of the Crown, 182, n.

the same thing. His decision divides itself into two propositions; first, that the inventor, by thus lying by, did not forfeit his own right; and second, that he might thus intercept others, and these two propositions are not identical, or equivalent to each other, for he might thus lose his own right, and yet a patent for a subsequent discovery of the same thing be defeated by him. Whether he forfeits, his right will be subsequently considered. There are strong reasons for holding that he may thus forfeit his right, and if it be so held, then the doctrine of Dolland's case may be well founded.

There is one case, however, where, by our law, the priority must be determined by the date of the patent, namely, that of simultaneous inventions by different persons, neither of whom is apprized of the other's invention; for in these circumstances, the party who has first obtained a patent is presumed to have a right until the contrary is shown, and it would be impossible to prove a prior or better right in another person. But if both applied at the same time for a patent, and their claims were referred to arbitrators, according to the statute, no patent could be granted unless the point of priority were decided in favor of one of them; and perhaps a case could hardly occur which could not be decided, if the claim turned merely upon the question of priority. It seems, however, from an English case,

that where there is no other ground of discrimination the priority of application would decide the right.[109]

It will appear, when we come to the subject of the specification, that the patentee must be entitled to a patent for all that he alleges himself to have invented, or his patent will be void. It follows, from this doctrine, or rather is included in it, that if the patentee is the prior inventor of only a part of what is patented, the patent will be void.[110]

In a suit for an infringement of a patent for an improved iron carriage wheel, by which the weight was made to bear upon the circumference, instead of bearing upon the centre or nave, it appeared that a carriage wheel of wood and iron had been invented and used eleven or twelve years before, by Mr. Strutt, in which also the weight had been made to bear upon the circumference, the inventor of which died soon after the invention, which had not been followed up, no new wheels of the same description having been made after the first three made by the inventor himself. Mr. Justice Patteson instructed the jury that if it appeared that Strutt's wheel was on the same principles, and in substance the same wheel as the plaintiff's, and it had been used openly and in public, so that every body might see it, and that the use of it had continued up to the time of the

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[109] Forsyth v. Reviere Chitty Jr's. Prer. of the Crown, 182 n.

[110] The King v. Cutler, 1 Stark. N. P. 354; Brunton v. Hawkes, 4 B. & Ald. 540.

plaintiff's taking out his patent, it would be a ground to say that the plaintiff's invention was not new; but if it appeared that Strutt's wheel was a mere experiment, that he found it did not answer, and that he ceased to use it, and abandoned it as useless, and nobody else followed it up, and that the wheel in question in the case was the plaintiff's own invention, and remedied the defect in Strutt's wheel, (though he should not have seen that wheel,) there was then no reason for saying the invention of the plaintiff was not new. The jury found a verdict for the plaintiff.[111]

Sec. XVII.—Previous Publication.

It follows, from the doctrines already stated, that a mere previous hint, or oral suggestion or description of the invention, will not, of itself, defeat the patent of a subsequent original inventor, that is, one who did not derive any hint from any other person; since the person who thus first gave a hint or suggestion of the invention is supposed not to have reduced it to practice, or, in other words, had not matured his conception into what the law regards as an *invention* which is the subject of a patent. The law is the same in this respect in England and the United States, and it makes no difference whether the de-

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[111] Jones v. Pearce, Godson's Sup. 10.

scription or suggestion is by the inventor himself, or by another, and whether the knowledge of the inventor be derived from the invention of a subsequent patentee, or from the invention of some other person; for, from whatever source it is derived, it will not, as long as it is not reduced to practice, defeat a subsequent patent.

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

An instance of the danger an inventor is under of losing the benefit of his invention, by letting it in any way transpire before he has the great seal, is mentioned by Mr. Davis. A person had invented an improvement upon spectacles, and as his patent was in a state of forwardness, he had not been suffi-

ciently cautious in keeping the invention to himself, so that another person, in the same trade, had acquired a knowledge of it, and hastily got a pair made upon the same construction, and exposed them in his window; fortunately, however, the inventor happened to pass the shop, and seeing them, employed a friend to go and purchase them, in which he succeeded, and his patent passed the great seal the next day, before there was time to get any more made; and it is said that by this the patent was rendered secure.[112]

Upon this case, Mr. Godson remarks, "that it did not appear that this patent ever came before the court. There are many reasons which may, it is conceived, be assigned why the grant would not be good in law. By the imprudence of the discoverer himself, two persons at least became acquainted with his invention before the patent was sealed, and one actually made the article and exposed it to sale. The moment the third person bought it, he, as one of the community, took possession of it. It was then made public, if it had not become so by the exposure to sale. It is difficult to imagine upon what principle this publicity could be done away with; certainly not by the gift of it back to the discoverer. There was knowledge of the secret—an actual making—and a public sale by a person who was not the patentee."[113]

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[112] Dav. Pat. C. 445.

[113] Godson, 63.

Such is Mr. Godson's view of the English doctrine on this subject. In whatever relation we view the subject, we meet with the inconveniences of that unfortunate doctrine. Whereas, on the contrary, in the United States, where the law is satisfied if the invention was new at the time of its being made, the inventor, by making his invention known as soon as he has reduced it to practice, not only does not thereby incur any risk of losing the advantages of it, but rather makes them more secure to himself, by supplying himself with proof of the date of his invention.

The doctrine of the English courts, that the inventor, by discovering his secret, and permitting the use of his invention before obtaining a patent, though without the intention of waiving his privilege, in fact forfeits his right to a patent, has been adopted in France in its full rigor, as appears from an adjudication of the Court of Errors, of February, 1806. In that case the inventors of a carding machine had disclosed their invention to the municipal administration of Orleans, who, at their request, had tested its utility by a public inspection and experiment, of which they had given a formal certificate to the inventors. The inventors had besides voluntarily permitted a manufacturer to use their machine to card with. It was adjudged that in thus giving publicity to their invention, they had voluntarily made it public property, and consequently, that the

patent subsequently obtained by them, though in other respects legal, was invalid."[114]

The inventors complained of this decision as being too rigorous, and contended that their intention to abandon their privilege ought not to be presumed, but, on the contrary, that their right ought to remain unimpaired, unless an intention to abandon it were clearly proved. But M. Renouard, in 1825, approves of the judgment, on the ground that it was *immaterial to the public, whether it was the intention* of the inventors to abandon their privilege, or retain it; that the only question was, whether publicity had been given to the invention, from whatever cause, for it was this publicity which gave the public the right, and consequently deprived the inventors of their privilege. He thinks, however, that the inventor has, in such case, an action against one who may have injured him by the piracy.

The same author puts the case of a patent being taken out by the party who has pirated the secret, before the invention has been patented by the inventor, and is of opinion that, though the inventor is thereby despoiled of the privilege of taking out another patent, yet he has the right to be substituted in the patent taken out, for the party who has thus fraudulently obtained it. For in such case, he says, the public has obtained such possession

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[114] Renouard, c. 5. s. 1. p. 170, cited by him from the General Jurisprudence of M. Dalloz, t. 2. p. 263.

of the invention as is inconsistent with his privilege. Neither the English law nor our own, has any form of proceeding for such subrogation or substitution; but our law admits of the inventor's taking out a patent himself, and then procuring the one previously taken out to be cancelled, or treating it as null and void, and prosecuting the piratical party, and those claiming and using the right under him, for an infringement of his patent.[115]

The case is otherwise if the invention has been described in some public work. The act of Congress is explicit upon this point. The sixth section of the act of 1793, in enumerating a number of defences in an action for the infringement of a patent, on the establishment of either of which, the court may declare the patent to be void, mentions, as one of these defences, proof that the invention 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. If the invention be orally described by one, and another, upon the suggestion, reduces it to practice, the latter is not the inventor. But the mere fact of the invention having been orally described by one person to another, but never described in any published work, will not defeat the right of a subsequent original inventor, to a patent; that is, a subsequent inventor who derives no advantage from such prior descrip-

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[115] See Renouard, c. 8. s. 2. p. 313, 314.

tion. But if the thing has been described in some public work, whether it has been reduced to practice or not, a patent cannot, under the act of Congress, be subsequently taken out for it. In this case, the description belongs to the public, and any one person cannot, by reducing the thing to practice, deprive others of the advantage of the description. In this case, even if the party who reduces the invention to practice, merely follows the published description, he is not an inventor, and so, upon the general construction of the patent laws, is not entitled to a patent. But the law does not confine itself to the case of a party who may be proved to have availed himself of the published description. It enacts generally and absolutely that where a thing has been described in a public work, it shall thereupon cease to be patentable. "It may be," says Chief Justice Marshall, "that the patentee had no knowledge of this previous description; still his patent is void; the law supposes he may have known it."[116]

And the same rule has, by construction, been incorporated into the English law, upon this subject.[117] And the French law, as we have seen, contains an express provision to the same effect.[118]

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[116] Evans v. Eaton, 3 Wheat. 454.

[117] The King v. Arkwright, Davies's Pat. Cas. 129; Hill v. Thompson, 2 J. B Moore, 458.

[118] Renouard, c. 5. s. 1. p. 176.

Upon this provision, two questions may arise; first, what is a description? and second, what is "a public work?" We have no decisions upon these questions. Upon the first, M. Renouard remarks that "it is not enough to defeat a patent that the thing has been *mentioned* in some public work, it must have been *described*;"[119] that is, the publication must give such an explanation of the thing, as may, in some degree, answer the purpose of the specification in a patent. The courts would not, probably, require that the description should fully answer as a specification, but they would not consider any statement to be a description within the meaning of this clause, which should not serve as a direction for making, doing, or compounding the thing to which the description related. This is the construction adopted by M. Renouard.

The same author considers the other of the above questions, What is to be considered a *publication* of the description within the meaning of the French law, the phraseology of which is not precisely equivalent to that of our act of Congress, the expression of the French law, section 16, being, that the patent shall be void if the thing patented had already been "described in printed and published works." As the law makes no distinction as to the language or

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[119] c. 5. s. 1. p. 176.

place, M. Renouard thinks that a description in a work printed in any language at any place is within the provision of the law. It does not appear what publication will be considered by our courts a "public work" within the act of Congress. The court certainly will not limit the construction to a work published in the United States, nor to works published in the English language; but whether they will take the position laid down by M. Renouard remains to be seen when a case shall arise of a publication abroad in a foreign language of a theoretical description of a machine or composition not made, or a process not reduced to practice. For, as we shall see, if the thing has been reduced to practice in a foreign country, it cannot afterward be the subject of a patent in the United States.

Sec. XVIII.—Foreign Inventions.

In regard to the novelty of the invention, there is one material difference between the construction given to the section of the English statute of monopolies, that constitutes the English patent law, and our patent acts. The exception of the general prohibition of monopolies in the English act of parliament, as we have seen, is of the monopoly of the "sole working or making of any manner of new manufacture *within this realm* ;" which has been constru-

ed to extend, not only to inventions originally made in England and not known elsewhere, but also to inventions made abroad and introduced into England, since such inventions were considered to come within the conditions of the exception, because they were *new in England*. This construction arose out of the practice of granting patents at the common law for imported inventions.

In the case of the Clothworkers of Ipswich, that occurred nine years before the statute of monopolies was passed,[120] it was said by the court, that 'if a man hath brought in a new invention and a new trade within the kingdom, in peril of his life and consumption of his estate or stock, &c. or if a man hath made a new discovery of any thing, in such cases the king, of his grace and favor, in recompense of his costs and travel, may grant, by charter unto him, that he only shall use such a trade or traffic for a certain time, because, at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired, the king cannot make a new grant thereof; for when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it.'"[121] The same doctrine prevailed after the statute of monopolies was passed.

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[120] Godbolt, 252.

[121] And see 9 Johns. R. 58. 582, 583, 584. Per Kent C. J.

It was early held, under that statute, that a grant of a monopoly may be to the first inventor by the 21 Jac. 1; and if the invention be new in England, a patent may be granted, though the thing was practised beyond sea before; for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute; for the act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study, it is the same thing.[122] The patent law of France is similar in this respect.[123]

But the American patent law expressly excludes any such construction. The first section, in which the subject of patents is described, does not, in imitation of the English, say that patents may be granted for any art, &c. or any new improvement *in the United States*. If it had stopped here, however, the question might have been raised, and it would have been open to construction, whether an art, &c. new in the United States, though previously known abroad, did not come within the act. But in the fifth section, setting forth the defences that may be made by the defendant in an action for an infringement of a patent right, to lay the foundation not only for a verdict for the defendant in the particular case, but also for pro-

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[122] Agreed by Holt and Pollexfen. Edgeberry v. Stephens, 2 Salk. 447.

[123] Renouard, Paris Edit. of 1825, p. 423, law of 1791, s. 9.

curing a judicial declaration that the patent is void, it is provided that for this purpose the defendant may prove "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 by the patentee." And again in the additional patent act of April 17th, 1800, the first section, authorizing a person, who has been resident in the United States two years, to take out a patent, provides that such person, in making application for a patent, "shall make oath, that such invention, art, or discovery, hath not, to the best of his 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." This law put it beyond all question that an alien, having resided in the United States the requisite period, though he might take out a patent for an original invention, could not take out one for an invention previously known or used in a foreign country.

The provisions in the statute of 1793 respecting patents taken out by citizens of the United States, were not so explicit upon this point. Still, as that law requires that the invention should not have been previously known, and declared the patent void if it had been described in any public work, there was no

room for the construction that a previous foreign invention or publication did not defeat the patent.

It has accordingly been uniformly held that there is no difference, as to the effect on an American patent, whether a previous invention and publication took place in the United States or abroad.[124] In an action for an infringement of a patent for making suspenders, the defendant proved that similar suspenders had been used in France and England before the patent was taken out. Mr. Justice Washington instructed the jury that to entitle the plaintiff to recover they must be satisfied that he was the original inventor, not only in relation to the United States, but to other parts of the world. Even if there was no proof that the plaintiff knew that the discovery had been made before, still he could not recover, if in truth he was not the original inventor.[125]

M. Renouard[126] discusses at length the provision of the French law that allows patents for foreign inventions, and concludes that it is wholly inexpedient. His argument is, that the patentee cannot, in such case, give any equivalent, as in that of an original invention of his own, that has not been known abroad, since the invention, if useful, would be sooner introduced without the right of patenting it. He accord-

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[124] Shaw v. Cooper, 7 Pet. S. C. R. 292.

[125] Dawson v. Follen, 2 Wash. C. C. R. 311.

[126] P. 428.

ingly approves entirely the American patent law in this respect.[127]

Sec. XIX.—Delay to take out a Patent. Abandonment of the Invention. Dedication to the Public.

The case of Dolland's invention of an improvement in the telescope has already been mentioned, where Dr. Hall, who had first invented the same improvement, delayed to take out a patent for a long time, and kept his invention secret. Dolland having subsequently made the same invention without any knowledge of its having been previously made by Dr. Hall, took out a patent, which was held to be valid.[128] In that case the mere fact of delay, without any act or neglect showing an intention to dedicate the invention to the public use, was held to be a forfeiture of the right to take out a patent as against another who took the proper steps to secure his right. The doctrine of this case seems to have been recognised in a subsequent one.[129] This principle can hardly be objected to, since the first inventor, if he chooses not to give the public the use of his invention, which the patent law was intended to encour-

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[127] Treatise on Patents, c. 5, s. 4, p. 196.
[128] 2 H. Bl. 483.
[129] Forsyth v. Riviere, Chitty Jr's. Prer. of the Crown, 182, n.

age, but to keep it to himself, ought not to have the right to stand in the way of the public interest, and that of any other inventor who is willing to give the public the use of the invention after the expiration of the temporary monopoly provided for by the patent laws.

M. Renouard cites from Merlin's Additions to his Repertoire,[130] the opinion that an inventor does not lose his privilege of a patent by delay while he exercises his invention in secret. But M. Renouard thinks a distinction is to be made on this point, being of opinion that if the inventor delivers the products of his invention in the mean time, and others, by examining or analyzing such products, detect the secret, he thereby loses his privilege.[131] This distinction, however, seems to be by no means contrary to the doctrine laid down in Merlin, as cited by M. Renouard, which seems to admit of the construction that others may not, in the mean time, before the first inventor has taken out his patent, have found out the art or process by the means supplied to them by the inventor for that purpose, by the distribution of the products of his invention. The position, however, of both M. Renouard and the authority cited by him, is, it seems, that the inventor does not forfeit his privilege by mere delay and practising his art in se-

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[130] T. 16, 1824, mot, Brevet d' Invention.
[131] C. 5, s. 1, p. 173.

crecy, provided no other person in the mean time discovers it.

A case of more frequent occurrence is that of an invention not being kept a secret; and the question is, whether a right to take out a patent is lost by mere delay, though no other person than the inventor has, in the mean time, used the invention. We suppose the party to have actually made the invention, that it is new, and that it is the proper subject of a patent, and there is no question of the right of the party to a patent; may this right be forfeited by mere delay? Mr. Justice Washington thinks that the inventor does not thus forfeit his right. The case under consideration was that of another person having erected and used the machine, after its invention by the party claiming a patent, but before his patent was taken out. After the patent was taken out the patentee brought an action against the defendant for continuing to use the machine, which had been erected before it was taken out; and it was contended, by the defendant, that it would be a great hardship upon other persons, and prejudicial to the public, if the inventor were permitted then to take out a patent, and stop the machines previously erected. Mr. Justice Washington said, upon this question, that "not only may individuals be injured by a liberal construction of the words of the law, but the public may suffer, if an obstinate or negligent inventor should decline obtaining a patent, and at the same time keep

others at arms' length, so as to prevent them from profiting by the invention for a length of time, during which the fourteen years are not running on. But all the hardship must rest with Congress to correct. It is beyond our power to apply a remedy."[132]

And in a case before Mr. Justice Livingston, in the southern district of New York, a similar doctrine is laid down, where it is said, "If the patentee be the inventor, it is immaterial that the invention has been known and used for years before the application."[133]

The doctrine here stated may, however, be doubted, though no decision has as yet been made directly to the contrary. The ground of the doubt is, that the doctrine seems to be in direct opposition to the object and principles of the patent law, namely, the encouragement of the arts; and the degree and extent of encouragement are defined by the law, namely, a monopoly of fourteen years. But if a party were thus permitted to lie by, and yet not forfeit his right to take out a patent, it would operate as a discouragement, by depriving others of the right of making and using the invention, without any equivalent benefit for such deprivation, while the inventor delays; and it would also contravene the law,

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[132] Evans v. Weiss, 3 Hall's Law Journal, 189.

[133] Goodyear v. Matthews, 1 Paine's R. 301.

by allowing a longer exclusive privilege than is intended to be granted by the law.

This doctrine seems also to be inconsistent with the letter of the patent law, by which the privilege of a monopoly is granted for *new* and useful inventions not before known or used, before the application for the patent; and certainly an invention may, by delay, cease to be new.[134]

Again, the presumption may very naturally arise, from a neglect to take out a patent, that the inventor has abandoned his invention. Could he be permitted to lie by twenty years and then take out a valid patent for fourteen years? If so, then why not fifty? This certainly would not be conceded without an imperative unquestionable provision of law, leaving no room for a reasonable construction, whereas there is by no means any such stubborn provision. On the contrary, the courts all hold that the inventor may forfeit his title to the privilege offered by the law, and there is nothing in the phraseology of the law that forbids the courts to construe unreasonable delay into a forfeiture. And if twenty or fifty years may be construed to be unreasonable, any shorter time may be so construed, if such should be the opinion of the court. Certainly a much shorter period than twenty years would, ac-

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[134] And see the reasoning of Mr. Justice Story in the case of Sellers & Pennock v. Dialogue, infra in this section.

cording to the ordinary mode of construing men's conduct, be ground of presumption of an abandonment. It must, to be sure, be a question of fact in the particular case, and may more properly be so treated, than to be the subject of an express uniform rule, for the inventor ought to be dealt with upon the most liberal principles, and not to be prejudiced by a delay which may be reasonably accounted for and explained, upon some other ground than that of an abandonment of his privilege. When he cannot account for the delay upon reasons that are consistent with the object and principles of the patent laws, there seems to be very strong ground for holding that he abandons his privilege.[135]

On the subject of delay to make experiments to perfect the invention, Mr. Godson remarked, in 1825,[136] speaking of the English jurisprudence, that "whether *experiments* with a view to try the efficacy of an invention, or the full extent of a discovery, are a *using* within the meaning of the statute of James, has not yet been decided.[137] It would be very difficult to say how much a substance or machine might be used by way of experiment before the patent is obtained, without running a great risk of invalidating the grant."

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[135] See Morris v. Huntington, 1 Paine, 345.
[136] Treatise on the Law of Patents, p. 64.
[137] See Hill v. Thompson, 2 B. Moore, 457.

Here the doubt expressed is, how far the inventor may make experiments without invalidating his patent by the very act of making the experiments, though no one else should use the machine. The other and greater hazard he would run in England would be the loss of his right by piracy, since a piratical use of the machine would there defeat his patent no less than one authorized by himself.

In the United States, the jurisprudence in this respect is well settled on different principles, much more favorable to the interests of the inventor, and much more in accordance with the spirit of the patent laws. In a case in the District Court of the United States, before Mr. Justice Thompson,[138] he said, "No man is permitted to lie by for years and then take out a patent. If he has been practising his invention with a view of improving it, and thereby rendering it a greater benefit to the public, before taking out his patent, that ought not to prejudice him. But it should always be a question submitted to the jury, what was the intent of the delay of the patent, and whether allowing the invention to be used without a patent should not be considered as an abandonment or present of it to the public." The doctrine here laid down as to the experiments, and the use of the invention for the purpose of perfecting

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[138] Morris v. Huntington, 1 Paine's R. 345.

it, is assumed and taken for granted, in so much that a formal statement of it is superfluous, in the opinion of the whole Supreme Court, delivered by Mr. Justice Story.[139]

We next consider how far an acquiescence of the inventor in, or his connivance at, the use of the invention by others, before taking out his patent, will effect its validity? And here we are again considering a question that belongs to the American and not to the English jurisprudence; for in the latter, as we have seen, the piracy of an invention and the use of it by others, without the consent or acquiescence of the inventor, and in spite of his vigilance to prevent it, is held to defeat the patent right; much more should this result be held to follow the use of it by others with his knowledge and consent. And on this subject there is no doubt, according to our law, that if the inventor allows and encourages others to use his invention without interposing or asserting his claim to an exclusive privilege, or if he authorizes such use of it in a way inconsistent with his claim to such privilege, he thereby dedicates it to the public and forfeits his right to take out a patent. This doctrine is founded upon the plainest principles of common honesty, for it would be inconsistent with the

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[139] Pennock & Sellers v. Dialogue, 2 Pet. S. C. R. 1.

obvious rules of fair dealing that the inventor should either tacitly or expressly authorize others to erect machines and put them into operation, and then, by obtaining a patent, defeat their labors and render their property of no value.

The plainest case of this description, and one on which all the decisions are agreed, is that of a sale by the inventor, of the articles which are the subjects of his invention. It has been uniformly held that if the inventor, before taking out a patent, manufactures and sells the articles to which his invention relates, he thereby loses his right to a patent. So it has been held in England. A patent was granted for a new mode of making verdigris, to be called British imperial verdigris. It was objected that the manufacture was not new; for that four months previously to the grant of the patent, the patentee had sold the same article under the name of Dutch imperial green. It was contended, that until the patent was obtained, the discovery was new; that the secret was locked in the patentee's own breast; and that the property was not rendered common whilst he kept the secret. Gibbs C. J. "The question is somewhat new. Some things are obvious as soon as they are made public. Of others, the scientific world may possess itself by analysis. Some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be new to the world. The public sale of that which is afterwards made the subject of a

patent, though sold by the inventor only, makes the patent void."[140]

It is a striking circumstance that the Chief Justice should have used such qualified language as he is reported to have done in this case in England, where the common doctrine advanced is that the inventor loses his right by the piracy of his invention before the grant of the patent. The ground of that doctrine must be, that if the thing is in use, by wrong, before the grant of the patent, the grant is void. Certainly the case is much stronger if it is in use by right. There seems, therefore, to have been no need of limiting the decision to a *public* sale, for to hold that any sale, however private, followed by the use of the thing by the purchaser, before the issuing of the patent, would not render the patent void, would be inconsistent with the course of English jurisprudence on this subject.

In the jurisprudence of the United States, though the inventor is much more liberally treated than in that of England, still it has been distinctly held that a sale of the article before the grant of the patent, will render it void.[141] This question was very much discussed in the case of Pennock and Sellers v. Dialogue, first in the Circuit Court of the United States for the District of Pennsylvania, and afterwards in the

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[140] Wood v. Zimmer, 1 Holt's N. P. C. 58.

[141] Mellus v. Silsbee, 4 Mason, R. 108.

Supreme Court of the United States.[142] The invention in question was that of an improvement in hose-pipe in the mode of riveting the joints. The inventors had manufactured the article and authorized others to manufacture it for seven years before the grant of the patent; and thirteen thousand feet of the article had been made and sold before the patent was taken out. It was held clearly, both in the Circuit and the Supreme Court, that the patent was void. Mr. Justice Washington, in charging the jury in the Circuit Court, said, "We are clearly of opinion that if an inventor makes his discovery public, looks on and permits others freely to use it without objection, or assertion of claim to the invention, of which the public might take notice, he abandons his inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for before such use. And we think it makes no difference in the principle, that the article so used and afterwards patented, was made by a particular individual, who did so by the private permission of the inventor. As long as an inventor keeps to himself the subject of his discovery, the public cannot be injured; and even if it be made public, but accompanied by an assertion of the inventor's claim to the discovery, those who should make use of the subject

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[142] 2 Pet. S. C. R. 1.

of the invention, would at least be put upon their guard. But if the public, with the knowledge and consent of the inventor, is permitted to use the invention without opposition, it is a fraud upon the public afterwards to take out a patent."

Mr. Justice Story, giving the opinion of the Supreme Court in the same case, said, "It has not been, and indeed cannot be denied, that an inventor may abandon his invention, and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterwards be resumed at his pleasure, for when gifts are once made to the public in this way, they become absolute. The question which generally arises at trials, is a question of fact, rather than of law—whether the acts or acquiescence of the party furnish, in the given case, satisfactory proof of an abandonment or dedication of the invention to the public."

The court notices the clause of the constitution on this subject, which gives to Congress the power "to promote the progress of science and the useful arts, by securing *for limited times* to authors and inventors, the exclusive right to their respective inventions or discoveries." The limited time, it was observed, was fixed by the act of Feb. 21, 1793, which also prescribes the terms and conditions which must be complied with. The thing to be patented is to be such as "was not known or used before the application," and the patent is granted "for a term

not exceeding fourteen years" and gives "the full and exclusive right of *using and vending to others to be used*, the said invention or discovery."

"Another provision of the act referred to by the court as bearing upon the case, was that of the sixth section, whereby a defendant, charged with having infringed a patent, may plead "that the thing 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 by the patentee." The words "*not known or used before the application*," it was observed, could not mean that the thing was not known or used before the application, by the inventor himself; for that would be to prohibit him from the only means of obtaining a patent. The use as well as knowledge of the invention must be indispensable to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts. The words, then, to have any rational interpretation, must mean, not known or used by others before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor, himself, or if, before the application for a patent, his invention should be pirated by another, or used without his consent, it can scarcely be supposed that the legislature had within its contemplation such knowledge or use. We think the true meaning must be, not known or used by the

public before the application, and, thus construed, there is much reason for the limitation imposed by the act. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention, if he should for a long period of years retain the monopoly, and make and sell his invention publicly, and thus gather the whole profits of it, relying upon his own superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use than what should be derived under it during the fourteen years, it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries. If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent, how can the court say that his case was, nevertheless, such as the act was intended to protect. If such a public use of it is not a use within the meaning of the statute, what other use is? If it be a use within the meaning of the statute, how can the court extract the case from its operation, and support a patent, where the suggestions of the patentee are not true, and the conditions on which alone the grant was authorized to be made, do not exist. Upon most deliberate consideration we are of opinion that the true construction of

the act is, that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent; this voluntary act or acquiescence in the public sale or use, is an abandonment of his right, or rather creates a disability to comply with the terms and conditions on which alone the secretary is authorized to grant him a patent."

In the above case the court lays stress upon the particular phraseology of the first section of the act of 1793, namely, that the thing must not have been "known or used before the application." Now we have seen already that these words are not accepted literally in regard to the novelty of the invention, except as to the knowledge given or the public use authorized by the inventor himself. In other respects it is enough that the thing was new and not known or used *at the time of the invention*. This construction was, as has been remarked, forced upon the court by a provision in the sixth section of the same act.[143] The result is that in respect to a knowledge and use by others, it is enough that the thing was not known and used at the time of the invention; others may have invented it or used it after the invention and before the application by the patentee,

[143] Supra, sect. 16, p. 153.

without his consent or knowledge, and his right will not thereby be affected; but if he authorized the public use before the application, his right is forfeited.

This interpretation does indeed give one literal construction and application of this part of the first section of the act. But we cannot think that it is by any means the strongest and clearest ground of the decision in the above case; though it is certainly entitled to some weight, for the invention should be in all respects new and unknown to others and not used by them at the time of the invention by the patentee, but at the time of the application it cannot be wholly unknown and unused, for it must necessarily then have been known and used by the inventor himself, and it is not, as we have seen, necessary that it should then be unknown to others, and the piratical use of it by others will not, of itself, as many cases show, defeat the right of the inventor. As to its having been *known* to others before the application, there appears to be no objection whatever to its having been so, if the doctrines above laid down on this subject are correct. It is only by the public use of it with his consent or approbation or connivance, that he will forfeit his right. The support, then, that this last doctrine derives from the first section is the less important, since the language of the statute "*not known or used*, before the application," puts the knowledge and use upon precisely the same footing, whereas the decision of the court renders it of no importance

whatever, whether the invention is or is not *known* to others at the time of the application. This is an objection to putting great stress upon a literal construction of the expression *not used* by others, which stands in the same connexion. But the two other grounds of the decision are quite sufficient, and seem to be conclusive, namely, that the provision of the constitution on this subject, and the statutes passed in pursuance of it, authorize a monopoly only for a *limited* time, and that the inventor *may* abandon his right, and dedicate it to the public.

A sale of the articles to which the patent relates, previously to taking out the patent, is one of the ways of dedicating it to the public use. This is not, however, the only way, and it is, as is remarked in some of the cases already cited, a question for the jury, from all the facts, whether the inventor has, by his acts or neglect, abandoned his invention, and dedicated it to the public.[144]

The law on this subject is very explicitly laid down by Mr. Justice Story, in two cases that came before him in the Circuit Court of the United States in the district of Massachusetts.

In an action for the violation of a patent for a machine for making cotton and wool cards, it was contended that the patent should have been for an

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[144] Morris v. Huntington, 1 Paine, 345; Pennock & Sellers v. Dialogue, 2 Pet. S. C. R. 1; Kent's Com. Vol. 2. p. 369.

improvement of such machinery only. Story J. said, "That it would not protect the plaintiff's patent, that he was the inventor of all the material improvements in the old machine, (as is asserted) if he suffered them to be used freely and fully by the public at large for so many years, combined with all the usual machinery; for in such a case I think he must be deemed to have made a gift of them to the public, as much as a person who voluntarily opens his land as a highway, and suffers it to remain for a length of time devoted to public use."[145]

In the other case the same judge said, "If the inventor dedicates his invention to the public, he cannot afterwards resume it, or claim an exclusive right in it. It is like the dedication of a public way or other public easement. The question in such cases is a question of fact—Has he so dedicated it? I agree his acts are to be construed liberally; that he is not to be stopped by licensing a few persons to use his invention to ascertain its utility, or by any acts of such peculiar indulgence and use, as may fairly consist with the clear intention to hold the exclusive privilege. But if the inventor proclaims his invention to all the world, and suffers it to go into general and public use without objection; if he asserts no exclusive right for years, with a full knowledge, that the public are led by it to a general use,

[145] Whittemore v. Cutter, 1 Gallison, 482.

such conduct amounts to strong proof, that he waives the exclusive right and dedicates the invention to the world. After such conduct, the attempt to regain the exclusive right and secure it by a patent, would operate as a fraud upon the public; and would hold out inducements to incur heavy expenses in putting inventions into operation, of which the party might be deprived at the mere will or caprice of the inventor."[146]

Mr. Justice M'Lean, giving the opinion of the Supreme Court of the United States upon this subject, said, "Vigilance is necessary to entitle an individual to the privilege secured under the patent law. It is not enough that he should show his right by invention, but he must secure it in a mode required by law. And if the invention, through fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it. The patent law was designed for the public benefit, as well as for the benefit of inventors. For a valuable invention, the public, on his complying with certain conditions, give him, for a limited period, the profits arising on the sale of the thing invented. This holds out an inducement for the exercise of genius and skill in making discoveries which may be useful to society, and profitable to the discoverer. But it was not the intention of this law,

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[146] Mellus v. Silsbee, 4 Mason, 108.

to take from the public that of which they were fairly in possession. In the progress of society, the range of discoveries in the mechanic arts, in science, and in all things which promote the public convenience, as a matter of course, will be enlarged. This results from the aggregation of mind, and the diversity of talents and pursuits, which exist in every intelligent community. And it would be extremely impolitic to retard or embarrass this advance, by withdrawing from the public any useful invention or art, and making it a subject of private monopoly. Against this consequence, the legislature have carefully guarded, in the laws they have passed on the subject. It is, undoubtedly, just that every discoverer should realize the benefits resulting from his discovery, for the period contemplated by law. But these can only be secured by a substantial compliance with every legal requisite. His legal right does not rest alone upon this discovery; but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed. No matter by what means an invention may have been communicated to the public before a patent is obtained; any acquiescence in the public use, by the inventor, will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor. The invention passes into the possession of innocent

persons, who have no knowledge of the fraud, and at a considerable expense, perhaps, they appropriate it to their own use. The inventor or his agent has full knowledge of these facts, but fails to assert his right ; shall he afterwards be permitted to assert it with effect ? Is not this such evidence of acquiescence in the public use, on his part, as justly forfeits his right ? If an individual witness the sale and transfer of real estate, under certain circumstances, in which he has an equitable lien or interest, and does not make known this interest, he shall not afterwards be permitted to assert it. On this principle it is, that a discoverer abandons his right, if, before the obtainment of his patent, his discovery goes into public use. His right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. Does this impose any thing more than reasonable diligence on the inventor ? And would any thing short of this be just to the public ? The acquiescence of the inventor in the public use can, in no case, be presumed, when he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will, in general, be a fact for the jury. And if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use, as for ever afterwards to prevent him from asserting it. After his right shall be perfected by a patent, no presumption

arises against it from a subsequent use by the public. When an inventor applies to the Department of State for a patent, he should state the facts truly; and indeed he is required to do so under the solemn obligations of an oath. If his invention has been carried into public use by hand; but for a series of months or years he has taken no steps to assert his right, would not this afford such evidence of acquiescence as to defeat his application as effectually as if he failed to state that he was the original inventor? And the same evidence which should defeat his application for a patent, would, at any subsequent period be fatal to his right. The evidence he exhibits to the Department of State is not only *ex parte*, but interested; and the questions of fact are left open to be controverted by any one, who shall think proper to contest the right under the patent. The strict construction of the act, as it regards the public use of an invention, before it is patented, is not only required by its letter and spirit, but also by sound policy. A term of fourteen years was deemed sufficient for the enjoyment of an exclusive right of an invention by the inventor, but if he may delay an application for his patent, at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him. A pretence of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of pre-

sumed acquiescence, where the public use is known, or might be known to the inventor, is the only safe rule which can be adopted on this subject. Some of the decisions of the Circuit Courts were overruled in the cases of Pennock & Sellers v. Dialogue. They made the question of abandonment to turn upon the intention of the inventor. But such is not considered to be the true ground. Whatever may be the intention of the inventor, if he suffers his invention to go into public use, through any means whatsoever, without an immediate assertion of his right, he is not entitled to a patent, nor will a patent, obtained under such circumstances, protect his right."[147]

The facts of the case to which the above doctrines were applied, were as follows. Shaw, the patentee, came to this country in 1817, from England, and being an alien, he could not take out a patent for his invention (which was that of the percussion gun-lock) within two years, that is until 1819. He did not take his patent out until 1822. His invention had, in the mean time been sold in England, in 1819, by his brother, to whom he had entrusted the secret, and was in public use there the two following years; and during the latter of those years also in France. Though it was alleged that during this time he was delaying for the purpose of making some improvement in his lock, yet it did not appear that

[147] Shaw v. Cooper, 7 Pet. S. C. R. 292.

he had made any material alteration in it. He had taken no steps during this time to assert his right, and he could not satisfactorily account for this delay. It was considered, therefore, that he had forfeited his right.

The preceding cases present a distinct view of the doctrines of the courts of the United States upon this subject. In the last case, Mr. Justice M'Lean, in giving the opinion of the court, lays very considerable stress upon public notice being given by the patentee of his claim, as affecting the validity of his patent. But if he had given such notice it would not have satisfied the other ground of the decision, viz. that the patent act gives only a limited monopoly, and that it would be a fraud upon the law to permit an inventor to extend that period by using his invention any considerable time before taking out his patent. For this reason it would seem to be by no means safe for an inventor unnecessarily to delay taking out a patent, on the ground that he had given sufficient public notice of his intention so to do.

A patent once granted is not forfeited in the United States by the neglect of the patentee to put his invention into practical operation. Our law differs in this respect, from that of France, which provides that unless the patentee reduces his invention to use within two years from the granting of the patent, he forfeits his privilege.[148] This provision is

[148] Renouard, c. 9, s. 2, p. 319.

rather rigid, for a general rule, since some inventions, requiring extensive preparations and large outlays, cannot be brought into operation in that time. A law containing a provision of this description ought also to provide for lengthening the time in particular cases. But the laws of England and the United States, contain no provision on this subject. Mr. Justice Washington distinctly lays down the doctrine that no neglect of the patentee, to put his invention into practical operation, will be construed to be an abandonment of his patent right.[149] And such is the language of all the cases.[150] Our law appears to go upon the presumption that the public benefit may in this case be left wholly to the influence of the interest of the patentee; and confides to him the absolute control and disposal of his invention for the period of his monopoly.

There may be instances of inventions, the use of which are vitally material to the public safety, just as in some instances the appropriation of individual property to the public use is essential to the public defence. In the latter case the general safety is not subjected to the caprice or inordinate cupidity of the proprietor, for his property may be taken for

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[149] Gray & Osgood v. James, 1 Pet. C. C. R. 403.

[150] Whittemore v. Cutter, 1 Gallison's R. 478; Thompson v. Haight, U. S. Law Journal, Vol. 1. p. 563; Morris v. Huntington, 1 Paine's R. 345; Pennock & Sellers v. Dialogue, 2 Pet. S. C. R. 1; Wood v. Brimmer, 1 Holt. N. P. C. 58; Kent's Com. Vol. 2. p. 369.

the public use without his consent, and a reasonable compensation allowed. And such would be the rules, probably, in regard to the use of a patent right, which is no more sacred than other personal property. This provision of law is limited to the case of the use of property by the public as a corporate political body, and does not reach the case of an indirect benefit derived to the public by the use of a thing by individuals. In this respect the law leaves patent rights upon the same footing as other personal property, the proprietor of which may, by his own caprice or folly, deprive the public and himself of the benefit that would result from a reasonable use of it, and there does not seem to be any pressing urgency for a different rule in regard to different species of property. There is, it is true, no absolute insurmountable objection to a regulation on this subject in relation to patents, for the public may grant patents or lands upon such conditions as may be deemed expedient, and for the general benefit; but as a general rule, unless the case is plain and urgent, it is the better policy to leave private rights to the discretion and interest of proprietors, where their interest evidently coincides with that of the public, since the inconveniences attendant upon an attempt by law to supply their want of reasonable discretion, would, in a majority of cases, be greater than those consequent upon their abuse of the discretion and control allowed by the law.

CHAPTER VIII.

Appeal to Board of Examiners. Interfering Applications. Previous Foreign Patent by the Applicant. Secret Filing of the Specification. Caveat.

By the 7th section of the act of Congress of 1836, it is provided that whenever, on examination, it shall appear to the Commissioner of Patents that the applicant for a patent, for an invention, "was not the original and first discoverer thereof, or that a 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, 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 his invention which is new." The applicant may thereupon withdraw his application, and receive back twenty dollars of the thirty dollars paid into the treasury by him, and leave his model in the patent office. But if he persist in his claim, whether he chooses to alter the specification or not, he must again make the usual oath, and if the commissioner still refuses to grant the patent, he may appeal to a board of examiners, consisting of three persons appointed by the Secretary of State, "one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the art, manufacture

or branch of science to which the alleged invention appertains." The commissioner is to furnish this board with his objections to the application in writing. The applicant is to be heard by the board, which may, if a majority sees fit, reverse the decision of the commissioner in whole or in part, and their opinion being certified to the commissioner, he is to be governed by it as to any further proceedings to be had on the application. The applicant is to pay twenty-five dollars towards the expenses, the examiners being entitled to receive not over ten dollars each.

By the 8th section of the same law, it is no objection to an application that the applicant has taken out foreign letters patent, and that they have been published within six months preceding his application.

By the same section, on the request of the applicant, his specification and drawings may be filed secretly in the office not longer than one year, and on the model being furnished, the patent may issue, dated back at the time of the specification, not exceeding, however, six months. He is, in such case, entitled to notice of any interfering application for a patent.

It is provided, by the same section, that interfering applications, or an application supposed by the commissioner to interfere with any subsisting patent, may be referred to a board of examiners appointed as above.

It is provided by the 12th section of this law, that any citizen of the United States, or alien who shall have been resident in the United States one year next preceding, and who shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine or improvement thereof, and shall desire further time to mature the same, may file in the patent office a caveat, setting forth the design and purpose thereof, and its distinguishing characteristics, and praying protection of his right, till he shall have matured his invention. 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 descriptions, 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 as in case of interfering applications.

CHAPTER IX.

Divers Patents for the same Invention. The joining of divers Inventions in the same Patent. Patent for a part of an Invention.

Sec. 1. *Divers valid Patents cannot be taken out for the same thing.*
2. *Patent for a Combination, and for the separate Things combined.*
3. *Distinct Inventions cannot be joined in the same Patent.*
4. *Patent for a part of a Machine.*

Sec. I.—Divers valid Patents cannot be taken out for the same Thing.

It is a well settled doctrine, that divers valid patents cannot be taken out for the same invention, whether by the same or by different patentees.

That different patentees cannot take independent valid patents for the same thing, follows from what has already been said on the subject of patents, in a preceding chapter, where it is stated that the invention must be new and original, and prior to any other invention of the same thing, in order to be the subject of a valid patent, which necessarily excludes the possibility of two valid patents for the same thing. It is also inconsistent with the character of a patent as an exclusive privilege.

This doctrine has been particularly laid down by Mr. Justice Story. He says, "I have very great doubts, whether, when a patent is once granted to any person for an invention, he can legally acquire any right under a subsequent patent for the same invention, unless his first patent be repealed for some original defect, so that it might truly be said to be a void patent."[1] In a subsequent case the same judge says more positively, "An inventor can have but a single valid patent for his invention; and the first he obtains, while it remains unrepealed, is an estoppel to any future patent for the same invention founded upon the general patent act. If the patentee could successively take out, at different times, new patents for the same invention, he might perpetuate his exclusive right during a century, whereas the patent act confines this right to fourteen years from the date of the first patent. If such a proceeding could obtain countenance, it would completely destroy the whole consideration derived by the public for the grant of the patent, viz. the right to use the invention at the expiration of the term specified in the original grant."[2]

The same judge says, that "a grant of a subsequent patent for an invention, is an estoppel to the patentee to set up any prior grant for the same in-

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[1] Barrett v. Hall, 1 Mason, 473.

[2] Odiorne v. the Amesbury Nail Factory, 2 Mason, 28.

vention, which is inconsistent with the terms of the last grant."[3] But it seems rather that the prior patent should be an estoppel to set up a subsequent one; for the latter, according to the above doctrine, would be void as long as the former should remain unrepealed; and the same learned judge so lays down the doctrine in the case just cited.[4] "A joint patent may well be granted upon a joint invention. There is no difficulty in supposing, in point of fact, that a complicated invention may be the gradual result of the combined mental operations of two persons acting together *pari passu*, in the invention. And if this be true, then as neither of them could justly claim to be the sole inventor in such a case, it must follow, that the invention is joint, and that they are jointly entitled to a patent. And so are the express words of the act of 1793, c. 156, s. 1, which declares, that if any person or persons shall allege that he or they have invented, &c., a patent shall be granted to him or them for the invention."[5]

On the principles above stated, the same person cannot, at the same time, be the joint and separate patentee of the same thing. "A joint patent for an invention," says Mr. Justice Story, "is utterly inconsistent with several patents for the same inven-

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[3] Barrett v. Hall, 1 Mason, 473.

[4] Odiorne v. Amesbury Nail Factory, supra, p. 213.

[5] Barrett v. Hall, 1 Mason, 472.

tion by the same patentees. For it is impossible, that any person can be, at the same time, the joint and the sole inventor of the same invention. If, therefore, each of the joint patentees obtain a several patent for the same invention, as his own exclusive invention, and afterwards, without surrendering the first patent, they obtain a joint patent for the same as a joint invention, either the former sole patents are void, or the joint patent is void. For, besides the apparent inconsistency of the patents, if all could be sustained, then a recovery upon the joint patent would be no bar to a suit upon the several patents; and the parties might obtain a double recompense for the same infringement. There is an additional reason which deserves great consideration; and that is, that if sole and joint patents could be sustained by the same parties for the same invention, they might be successively taken out, so that the term of the exclusive right might be prolonged for a great length of time, instead of being limited to fourteen years."[6]

Sec. II.—Patent for a Combination, and for the separate Things combined.

But an invention of a combination, and that of a part or the whole of the things combined, may be

[6] Barrett v. Hall, 1 Mason, 473.

joined in the same patent.[7] The reason is that, though they are separate inventions combined in one thing, and may therefore be joined in the same patent without violating the rule about to be stated on the joining of different inventions in one patent, yet the taking of a patent for the combination, after taking one for the separate parts, is not a double patent, or, in other words, is not the patenting, under the claim of the combination, the same thing which had before been claimed under the separate parts; for a machine may be the combination of a number of others, each of which, when invented, might have been the subject of a patent, and yet the combination of them might also, when first made, be the subject of a patent, and accordingly, if both the parts or some of them, and the combination, be invented by the same person, he may specify these distinctly in the same patent, or, if he invent them at different times, he may make the parts the subject of one or more patents, and then take a patent for the combination.

Sec. III.—Distinct Inventions cannot be joined in the same Patent.

The doctrine is equally clear that different, distinct and independent inventions cannot be joined in the

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[7] Per Story, J., Moody v. Fiske, 2 Mason, 112.

same patent. Mr. Chief Justice Marshall says, in giving the opinion of the court, "Under the general patent law alone, a doubt may well arise, whether improvements on different machines could regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination."[8] So Mr. Justice Story says, "Though several distinct improvements in one machine may be united in one patent, it does not follow that several improvements in two different machines, having distinct and independent operations, can be so included. Much less that the same patent may be for a *combination* of different machines, and for distinct improvements in each."[9] And in another case the same judge says, that "a patent under the general patent act, cannot embrace various distinct improvements or inventions; but in such case the party must take out separate patents. If the patentee has invented certain improved machines, which are capable of a distinct operation, and also has invented a combination of those machines to produce a connected result, the same patent cannot at once be for the combination and for each of the improved machines; for the inventions are as

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[8] Evans v. Eaton, 3 Wheaton, 454.

[9] Moody v. Fiske, 2 Mason, 112.

distinct, as if the subjects were entirely different."[10] So Mr. Justice Wilde, of the Supreme Court of Massachusetts, was of opinion, where a joint patent for a reel and lap-frame was granted to two persons, that as these were distinct and separate inventions and machines, the joint patent was for that reason void; but that the parties might procure its repeal and obtain separate patents for each machine.[11]

In regard to the case put by Mr. Justice Story, of joining the invention of an improvement of one machine in the same patent with an invention of a combination of the machine, so improved with others, I cannot but think they may be joined, where the improvement in the separate machine, and the combination, have the same object; for, suppose the combination to be of two machines, one of which is improved; the improvement is one addition, or modification, and the combining it with the other, is a second modification or addition. The case cannot easily be distinguished from divers improvements of the same machine, and that such divers improvements may be joined in one patent, there seems to be no ground to doubt.

A case decided in the English Court of King's Bench, presents a combination of things in the same patent, of very considerable diversity, though all the

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[10] Barrett v. Hall, 1 Mason, 475.

[11] Stearns v. Barret, 1 Pick. 448.

different things were used in connexion, viz. an improvement in ships' anchors, cables, and windlasses.[12] The objection was not made to this patent that it embraced distinct subjects of patents, so that on this point the case has only the feeble authority arising from the fact that the counsel did not raise the objection, and that the court did not, of its own motion, notice it.

Though the doctrine that divers inventions cannot be joined in the same patent, is, as we have seen, laid down pretty positively, the reasons are not given. We first look for the reason in the words of the statute, which are, if any one shall allege that he has invented any new art, machine, or manufacture, or any new improvement in any art, &c., being wholly in the singular number. But this fact cannot be of great weight, since the phraseology is the same in this respect, in regard to new machines or new improvements of old ones, and a construction whereby the joining of different improvements of the same machine in one patent should be excluded, would certainly be exceedingly strict, and in opposition to the general practice. The question may thus be fairly considered as left at large by the statutes.

M. Renouard says, on this subject, "one cannot combine in the same application divers principal subjects of a patent, as this would be a way of eluding

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[12] See Hill v. Thompson, 2 J. B. Moore, 424.

the payment of the taxes, and accordingly that an application for a patent combining divers inventions, would be rejected.[13] This may be a sufficient reason, and yet it is not one of the most pressing importance, especially in the United States, where the tax is small, and intended only as a reimbursement of the expenses of clerk hire in the patent office. That this rule has been very liberally expounded in favor of patentees, appears from the fact that the reports do not present any case of a patent being objected to and declared void on this ground. M. Renouard, in the place cited above, considers the question as one submitted to the discretion of the executive officers. It has been incidentally said, by Mr. Justice Story, that the court does not go behind the patent to ascertain whether the requisite oath was taken, or the legal fee of thirty dollars paid.[14] It would not follow from this, however, that the court would not notice that the specification was such as to combine independent inventions in the patent. There is this difference between a case of the non-payment of the tax, and the joining of different inventions, that the latter appears on the face of the patent, whereas the former does not so appear; and another difference is, that the executive officers are responsible for the collecting of the tax; whereas, their decision in con-

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[13] Ch. 7. s. 5. p. 293, 294.

[14] Whittemore v. Cutter, 1 Gallison, 429.

struing the law as to questions affecting the validity of the patent, is not final, but only preliminary and provisory, being subject to the adjudications of the judicial tribunals, to whose judgment on such questions the inventor has a constitutional right. Upon all such questions, he is entitled to a hearing and trial. This seems, accordingly, to be a question properly cognizable by the courts, and they would probably adjudge a patent combining entirely distinct inventions upon different subjects, to be void. But they probably would not so adjudge, except in a very palpable case. The passage above cited from M. Renouard, suggests a very just and liberal mode of applying this rule, and one consistent with the practice both in England and the United States; for he says an application which should embrace more than one *principal* subject, or invention, would be rejected; that is, whatever is accessary and auxiliary to the principal subject, may be joined in the same patent, but nothing more. This is a convenient, practical test in applying this rule; for if two inventions have no dependence or connexion, and one is not accessary or auxiliary to the other, they are properly subjects of distinct patents.

Sec. IV.—Patent for a part of a Machine.

We next consider whether a patent may be taken out for a part of a machine. A patent for an im-

provement is usually for a part of an entire thing, and often at least, if not most frequently, for something, that cannot be used separately to any practical purpose. It is not necessary, then, that the subject of the patent or exclusive right should be capable of an independent separate use. But suppose the case of two persons, independently of each other, inventing the parts of a new machine, are they entitled to separate patents? Mr. Justice Story says, "if two persons invent several parts of a machine *capable of a distinct use*, then those parts might be considered as separate inventions, for which such inventor might perhaps be entitled to a separate patent."[15]

This qualification that the inventions should be capable of a separate use, seems to present a pretty clear case of a right to separate patents. But if the parts belong essentially together, and are useless when separate, this is a plain case of joint invention; though the inventors may have had no communication with each other; and so a case in which separate patents cannot be taken out.

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[15] Stearns v. Barrett, 1 Mason, 153.

CHAPTER X.

Title of the Patent. Form. Difference in Form between English and American Patents. Construction of Patents.

HAVING considered what subjects of invention and discovery are patentable, and what party is entitled to a patent, and what things may be joined or separated, we come now to the inquiry, as to the mode of taking out a patent, and what steps and forms are necessary in order to secure the exclusive privilege granted by the patent acts. The principal subjects to be considered in this connexion, are the specification, the drawings, models, and specimens, the oath of the inventor, the petition, the payment of the tax or fee, the reference to arbitration in case of interfering claims, the letter patent, and the examination of the letter by the attorney general, and his certificate. It is proposed to notice here the different modes of granting patents in England and the United States, and as consequent upon this difference, a diversity in the rules of construction of patents. Unless this diversity is first noticed and kept in view, there will be some confusion and obscurity between the English and American cases on the subject of the specification.

The form of American patents is prescribed by the act of Congress of 1793, s. 1, which provides, among other things, that on a petition for the purpose, the secretary may cause letters patent to be granted, "reciting the allegations and suggestions of the said petition." Mr. Justice Washington ruled that a compliance with this requisition is material. In an action for an infringement of Evans's patent for the Hopperboy, it was objected that the patent did not recite the allegations and suggestions of the petition. Washington J. "If the allegations and suggestions of the petition are substantially recited, it will be sufficient. But in this case they are not." He said the patent gave no description of the hopperboy and its use, and the manner in which it worked. The petition gave a minute and full description of it, which ought to have been substantially recited.[1] The English law contains no similar express provision, but the practice is to recite the allegations of the petition, and the provision of the American statute in this respect, is, no doubt, borrowed from the English practice.

In England the patent is granted before the specification is made, a certain time being allowed by the patent for enrolling the specification, varying from two to six months or longer, according to the circumstances, it being left to the discretion of the ex-

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[1] Evans v. Chambers, 2 Wash. C. C. R. 125.

ecutive officers to fix the time. Though in one case in England Mr. Justice Grose is reported to have said, that the specification was fairly to be considered a part of the patent itself,[2] the cases are entirely otherwise, and it is well settled there that the patent is distinct from the specification, and controls it in construction, and that the patentee cannot cover any thing by the specification which is not covered by the patent, or draw from the specification any construction whereby to comprehend in the patent any thing which would not be comprehended without recurrence to the specification.[3] No position is better settled in English jurisprudence, and yet Mr. Justice Le Blanc intimates, in one case[4] that if the specification is too large the patent is so too; that is, if you look into the specification and find that the invention is broader than the patent, or in other words that the inventor has taken out a patent for only a part of what he is entitled to, it is void. But this doctrine is certainly untenable in the English law. Under the English patents the specification generally limits the description in the patent, that is, it claims only a part of what is comprehended in the more general description in the patent.

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[2] 8 T. R. 105.

[3] Campion v. Benyon, 3 Brod. & Bing. 5. The King v. Wheeler, 2 B. & Ald. 345; Bainbridge v. Wigley, Rep. of Arts, Sec. Ser. Vol. 27, p. 127; Rex v. Metcalf, 2 Stark. N. P. C. 249; Cochrane v. Smethurst, 1 Stark. N. P. C. 205.

[4] Cochrane v. Smethurst, 1 Stark. 205.

In the United States, the doctrine is different on this subject, the specification being always drawn up before the patent is granted, and being referred to in the patent. It is well settled in our courts that it is a part of the patent, in the common form of which, the specification being annexed, is expressly referred to as "a part of these presents." Accordingly Mr. Justice Story says, "Under the patent laws of the United States, the specification forms a part of the patent, and may control the generality of its terms; in England the specification is separate from it."[5]

This diversity in the law in England and the United States, will be found to be of material importance in the construction of patents, and it will appear very clearly that, from the above circumstance, the jurisprudence in the United States is free from some of the embarrassments to which it is subject in England.

Both in English and American patents a title is necessarily given to the invention, whereby it is patented. The American patent act of 1793, s. 1, provides, that, on a petition for the purpose, the secretary of state may cause letters patent to be granted, "giving a short description of said invention or discovery." This short description is usually the title of the invention in the words of the patentee, either prefixed

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[5] Barrett v. Hall, 1 Mason, 477; Whittemore v. Cutter, 1 Gallison's R. 437.

to his specification, or being the introductory part of it. In American patents any defect in this title may be remedied by the specification. The accuracy in the title required by the English law, renders the choice of titles matter of the greatest difficulty, since, if the title is too narrow, the patentee either fails of securing the exclusive privilege entirely, or, at least, to the extent to which he is entitled to it, and, if it is too broad, the patent is void by reason of its covering too much. Many English patents have been defeated on this ground. The difficulty has been partly overcome by the allowing of great generality and indefiniteness in the description.

"Such," says Mr. Godson, "is the technical use that has for a long time been made of the word *method* in patents, that it is quite common for inventors to ask for a patent for a method of doing something, and then to set forth a description of some new substance or machine. It is a convenient way to avoid giving a title to the invention. And therefore it is now clearly established, that if the patentee claim a method, and yet in the specification describe some tangible matter, the grant is valid. In other words, though the patent is for something called a method, yet the real subject of the grant is either a substance, machine, improvement, or combination."[6]

[6] Godson on Patents, 88.

Thus Watt's patent for his improvement in the steam engine was for "a method of lessening the consumption of steam and fuel in steam engines," a description which would cover a large part of the improvements in steam engines and boilers invented from Watt's day to the present, and yet it was held to be a sufficient description and a valid patent, after much doubt and discussion,[7] and the case has been a leading one on the subject to the present time.

But this liberality in the construction of the language used in the patent, has not always saved the patentee from the loss of his privilege; and indeed the courts have, in some instances, departed from the liberality that marked the final decision in Watt and Boulton's case, and adopted principles of construction upon which it would be very difficult, if not absolutely impracticable, to secure a patent right under the English law.

Bainbridge's patent, granted in 1807, for an improvement in the flageolet or English flute, by the addition of *notes*, in the plural, whereas only a *note* was added, was held to be void on account of the inaccuracy of this description in the title.[8]

So Lord Cochrane's patent for "a method or methods of more completely lighting cities, towns and villages," which consisted in an improved lamp, was

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[7] Boulton v. Bull, 2 H. Bl. 463.

[8] Bainbridge v. Wigley, K. B. 1810. Rep. of Arts, Second Series, Vol. 18, p. 127.

held to be void on account of the generality of the title.[9]

So Metcalf's patent for "tapering brushes," was adjudged by Lord Ellenborough to be void on account of the inaccuracy of this description. It appeared, from the specification, that the improvement consisted in making the bristles of unequal length instead of their being of the same length, as they had been in former brushes. A tuft of such bristles compressed in the hand or between the fingers, would be in some sort tapering. The specification made it plain enough what was meant by *tapering*. But Lord Ellenborough ruled that the description in the patent was defective, and that the "difficulty arising from the grammatical consideration" could not be removed.[10]

So Wheeler's patent for "a new and improved method of drying and preparing malt," which consisted in a preparation of barley for the purpose of coloring beer, was held to be void on account of the supposed inaccuracy, in calling it *malt*.[11]

Now in every one of these cases, if, as in American patents, the specification could have been resorted to for a construction of the title, the objections, on which the patents were declared void, would have disappeared.

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[9] Cochrane v. Smethurst, 1 Stark. 205; S. C. Rep. of Arts, Second Series, Vol. 27, p. 192; S. C. Gods. Pat. 104, n.

[10] Rex v. Metcalf, 2 Stark. N. P. C. 249.

[11] The King v. Wheeler, 2 Barn. & Ald. 345.

The difference in the jurisprudence of the two countries in this respect, is not in the general rules of interpretation and construction of grants or written instruments, for these do not differ; the English courts apply the same principles of construction that ours would apply; but as one of these rules is, that in construing any document, the whole is to be considered, and each part interpreted accordingly, the difference consists in the title constituting the whole instrument in the English patents, whereas ours embraces the specification. These very cases, some of which would have been differently decided in the United States, may, therefore, be authorities in our courts for the construction of written instruments.

It is a general rule in construing written instruments that other documents referred to in them must be taken into consideration. Thus the drawings annexed to a specification in compliance with the statute, are considered to be a part of the specification, and so to be taken into consideration, in putting a construction upon it.[12]

The English cases furnish some examples of another rule of construction common to specifications and other writings, namely, that where definite

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[12] Earle v. Sawyer, 4 Mason's R. 9. In this case, Mr. Justice Story considers Lord Eldon's remarks on drawings or *pictures* as he calls them, in Fox ex parte, 1 Ves. and B. 67, to be in accordance with the above rule of construction.

and specific, and also very general descriptive terms are used in reference to the same subject matter, the meaning of the latter may be modified and restrained by the former. This is illustrated in the case of a patent for "an apparatus for extracting inflammable gas by heat, from pit-coal, tar, *or any other substance*, from which gas or gasses, capable of being employed for illumination, can be extracted by heat." It was proved that the apparatus would not succeed in making gas from oil, and it was objected to the patent that there was nothing to prevent a person, who saw the specification, from considering that it was meant to be included, and so that the specification covered more ground than the invention, and was not true, and that accordingly, the patent was void. But Lord Tenterden ruled that the phrase "*any other substance*" must be construed to be applicable to substances of the same sort, *(ejusdem generis)*, with those enumerated, and so that the description was sufficiently accurate, and the patent valid.

Though words are used in an unusual sense, yet this will be no ground of objection, if the patent or specification itself, or the customary technical phraseology of the art to which the patent relates, furnishes an explanation. In the cases relating to Watt's patent, there was much discussion on the

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[13] Crossley v. Beverly, 3 Car. & P. 513.

construction of words used in the patent, and in the specification. It was held, as we have seen, that an engine might be described as a *method* of lessening the consumption of fuel and steam in fire-engines. In the specification, the invention was said to consist of the following *principles*, and the patentee then proceeded to describe the machinery and apparatus for which he claimed a patent, thus defining what he meant by *principles*, and though the word was thus used in an unusual sense, and inaccurately, yet as the sense in which it was used was apparent from the specification, this was held to be no ground of objection.[14] So Lord Ellenborough remarked, in another case, that if a term used in the specification had a meaning annexed to it by the usage of trade, different from its ordinary use, it might be received in the peculiar perverted sense.[15]

Technical words are often used in patents and specifications, and sometimes it is not practicable to describe an invention without the use of them. And it has been held that words of a foreign language and figures may be introduced into the specification.[16]

A mistake in the use of one word for another, so as either to pervert the sense, or make nonsense, may be rectified in the case of a patent as well as in

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[14] Boulton v. Bull, 2 H. Bl. 463; Hornblower v. Boulton, 8 T. R. 95. And see Jones v. Pearce, Gods. sup. 16.

[15] The King v. Metcalf, 2 Stark, N. P. 249.

[16] Bloxam v. Elsee, 1 Car. & P. 558.

other written instruments, by other parts of the document. Thus, where the word *painting* was used by mistake in the patent for the word *printing*, Mr. Justice Washington held that the error might be corrected by other parts of the patent and the specification.[17]

CHAPTER XI.

Specification.

Sec. 1. *Leading Objects in the Specification. Distinction between English and American Patents as to the Specification.*
2. *General Requisites.*
3. *Known Processes, Methods and Machinery need not be described. Surplusage.*
4. *The Specification is addressed to Artists. Technical Terms.*
5. *Must be true and not mislead.*
6. *Must be full, clear, and exact.*
7. *What is claimed as new must be distinguished from what is old. The Patentee must not claim too much.*

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[17] Kneass v. Schuylkill Bank, C. C. U. S. Penn. Oct. 1820, Coxe's Dig. 532.

8. *The Specification must direct how to make, and describe the best way known to the Inventor of making the article.*
9. *Reference in the Specification to Drawings.*
10. *The consequence of a defect in the Specification.*

Sect. I.—Leading Objects in the Specification. Distinction between English and American Patents as to the Specification.

The specification is no less important than the invention itself, and the instances of patents being declared void by the courts on account of the defects of the specification, are probably quite as many as those of failure from the insufficiency of the invention. It requires no little skill and knowledge of the subject of the invention, to draw up an adequate and apt specification. And skill and knowledge of the subject will not suffice for this purpose, without also a knowledge of the law of patents generally.

The frequent failure of patents in consequence of defects in the specification through inadvertency, has heretofore been a subject of loud complaint, both in England and the United States, until the legislatures of both countries, that of the United States in 1832, and that of Great Britain in 1835, passed laws to remedy this evil. These provisions have been mentioned above,[1] and will be more particularly stated in a subsequent section of the present chapter.[2]

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[1] Pages 25 and 44.

[2] Section 10.

The patentee may, by availing himself of the remedy thus provided, avoid the absolute loss of his monopoly, on account of those defects in the specification which were before the frequent occasion of its loss. In treating of the specification, the cases and the law will be stated just as if those acts had not been passed, the reader being apprized that for some of the defects, on account of which the patent right would otherwise be defeated, those acts afford a partial remedy, that is, he does not absolutely lose his privilege, provided he takes advantage of the provisions thus made in his favor.

There are two objects in view in making a specification. As the law grants the patentee a monopoly, and not only awards damages, but inflicts a penalty for a violation of the exclusive privilege, it very equitably requires that the invention shall be so described in the specification, that every person may, by examining it, know what the patentee claims, and be able to distinguish what may be an infringement. The other object of the specification is to give the public the advantage of the invention after the expiration of the patent. The consideration of the patent being the advantage to be derived to the public after its expiration, it is necessary, in order that this advantage may be realized, that the invention shall so be described in the specification, that one acquainted with the art or manufacture, to which it relates, or with which it is most nearly connected, may not only un-

derstand the invention, but be able, by following the directions given in the specification, with the assistance of the drawings, to construct the machine or perform the process which is the subject of the patent.[3] These two objects of the specification are the foundation of the rules and decisions in regard to it.

The English jurisprudence prescribes one rule on this subject which is not applicable to ours, namely, the one already mentioned,[4] that the specification must agree with the title or patent, for in England the patent is for the title or general description of what is particularly described in the specification, and so also is our patent, but as our law makes the specification a part of the patent, the title or general description may not only be explained, but also controlled and enlarged by the recital of the more particular and full description given in the specification; for if it appear that the patentee has not, in his title, given a correct general description of his invention, but has fully and accurately described it in the specification, he ought not to lose his privilege on this account, since no wrong is done to the public, and no imposition is practised upon individuals. The case is different in England, as we have already suggested, where the rule that the specification must agree with the patent or title, and cannot enlarge it,

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[3] *Evans v. Eaton*, 7 *Wheat.* 433.

[4] Supra, p. 225.

has determined the fate of many patents. It will be sufficient to refer to the English cases on this subject generally, without repeating the reasoning or examining the grounds.[5]

Mr. Justice Grose, it is true, says in one case, "I consider the patent and specification so connected together as to make a part of each other, and that to learn what the patent is, I may read the specification and consider it as incorporated in the patent."[6] But he means merely, that the specification may explain, and indeed its object is to explain, the title or patent, but it cannot enlarge the patent, and it must not be inconsistent with it. Thus the same judge says again in the same case, that "Although in words, the privilege granted by a patent is to exercise a method of making or doing any thing, yet if that thing is to be made or done by a manufacture, and the mode of making that manufacture is described, it then becomes in effect, (by whatever name it may be called), not a patent for a mere principle, but for a manufacture, for the thing so made, and not merely for the principle upon which it is made."[7] For he and the other judges of the King's Bench did not consider it any

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[5] Campion v. Benyon, 3 Brod. & Bing. 5. A. D. 1821; Per Dallas J. The King v. Metcalfe, 2 Stark. N. P. C. 249; Per Ellenborough C. J. 1817; The King v. Wheeler, 2 Barnw. & Ald. 348, (1819); Per Abbott C. J. Hornblower v. Boulton, 8 T. R. 102, (1815); Barrett v. Hall, 1 Mason's Reports, 476; Per Story J. 1818.

[6] Hornblower v. Boulton, 8 T. R. 105.

[7] Hornblower v. Boulton, 8 T. R. 105.

inconsistency to explain a method, mode, or principle to be a machine or material product ; that is, the inventor might get a patent of the method of doing a thing, and thus, in the specification, describe the thing as done by means of a machine.

In the United States, on the contrary, the specification is a part of the patent, not merely for the purpose of explaining the title or general description of the invention, but to all intents and purposes; and may either enlarge or control the general description, or be enlarged and controlled by it, according as one or the other seems to be the true construction, taking the whole instrument together.[8]

Sec. II.—General Requisites of the Specification.

The general requisites of a specification are given in the patent act of 1793, s. 3. by which it is provided that "every inventor, before he can receive a patent, 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 it 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*

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[8] Barrett v. Hall, 1 Mason, 477.

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 the principle or character, by which it may be distinguished from other inventions." Or, more concisely, the specification must be full, clear, exact, distinguish the invention from other things, and enable an artist, skilled in the subject, to make the thing.

These requisites, it is apparent, are blended and intermixed, since it is by observing the first of these requisitions that the latter are complied with; for if the specification is full, clear, and exact, this will inform the public what the patentee alleges himself to have invented, and distinguish it from other things, and enable an artist to practise the art, or perform the process, or make the machine or composition in question. And then the specification, in order to be clear, must be sufficiently full and exact.

These requisites thus run so much into each other, in their nature and character, and again are found to be so frequently blended together in the same case, and in the same sentence, that it is difficult to treat of them separately, and yet there is so much variety and diversity among them, that they cannot be treated of together indiscriminately, without confusion. It is proposed, therefore, to arrange them in different sections, at the same time giving it to be understood that, for the above reasons, the division is not complete; since what is said of one requisite, is,

in many instances, equally applicable to another, as will be obvious to the reader, and again, where the judges, in giving their opinions, blend the different requisites together, it is not thought expedient, in every instance, nor indeed is it always practicable, to analyze their remarks, and distribute parts of the same sentence under different heads.

Sec. III.—Known Processes, Methods and Machinery need not be described. Surplusage.

Though the specification must be *full*, it need not describe in detail, processes, methods, and machinery, that are well known and in ordinary use among those skilled in the art, science, or business to which the invention relates, or with which it is most nearly connected.[9] A specification of an improved gas apparatus did not give any directions respecting a condenser. It was held that this did not invalidate the patent, it being well known to persons capable of constructing a gas apparatus, that a condenser was an essential part of it.[10] To introduce such descriptions may not merely be superfluous; it

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[9] Kneass v. Schuylkill Bank, C. C. U. S. Penn. Oct. 1820, Coxe's Dig. 532.

[10] Crossley v. Beverly, 3 Car. & Payne, 513. See also The King v. Arkwright, Dav. Pat. Cas. 135; Hubbart v. Grimshaw, Dav. Pat. Cas. 297; Hill v. Thompson, 2 J. B. Moore, 450.

may have the effect of rendering the specification defective by involving the description of the invention with a multitude of immaterial details, whereby it might be rendered obscure, and perplex those who should attempt to learn from it what the patentee claimed, that they might avoid an infringement, or who should resort to it after the expiration of the monopoly, to learn how to make the article.

But where superfluous details and erroneous statements are apparently introduced for the purpose of throwing obscurity upon the invention, and disguising it, and evidently having that tendency, the patent will thereby be rendered void, as we shall see more particularly below.[11] Watt's specification was an instance where mere superfluity was held not to vitiate the patent; for in addition to the description of his steam-engine, he intimated new projects of invention, concerning which, Eyre C. J. said, "If there be a specification to be found in that paper which goes to the subject of the invention as described in the patent, I think the rest may well be rejected as superfluous."[12]

So the description of processes and machines, well known and in use, or for which other persons have patents, may be superfluous and immaterial, provided it distinctly appears that the patentee does not

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[11] Sec. 5. Savory v. Price, 1 R. & M. 1.
[12] Boulton v. Bull, 2 H. Bl. 498.

claim to include them in his monopoly; if it appear that he includes them, or any part of them, it will vitiate his patent, as will appear more particularly below.[13] In this respect, patented subjects stand upon the same footing with those which have been in common use without having been patented, since *every body is presumed to know what has been patented.*[14] It may be necessary to give a partial description of a well known, or patented process or machine, in order to give a clear description of an improvement; any thing further than this will at best be immaterial and superfluous, if it does not vitiate the patent.[15]

Sec. IV.—The Specification is addressed to Artists. Technical Terms.

The patentee is allowed, in his specification, to address himself only to persons of competent skill in the matter to which the patent relates.[16] It is not necessary, that the specification should contain an explanation level with the capacity of every person, which often would be impossible.[17] "Suppose," says

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[13] See Sect. 8.

[14] Odiorne v. Winkley, 2 Gall. 51.

[15] See below, Sec. 4. 2 H. Bl. 497.

[16] Per. Abbott C. J. The King v. Wheeler, 2 Barnw. & Ald. 354; Per. Lord Longhborough, Arkwright v. Nightingale, Dav. Pat. Cas. 56.

[17] Per. Story, Lowell v. Lewis, 1 Mason, 182.

Eyre C. J. that "a new invented chemical process, and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary in order to this operation, that the gold should be put into a crucible, and should be melted in that crucible, but it would be hardly necessary to state, in the specification, the manner in which, or the utensils with which the operation of putting gold into a state of fusion was to be performed. They are mere incidents with which every man, acquainted with the subject, is familiar."[18] Mr. Justice Washington, speaking of the provisions of the act of Congress of 1793, relating to specifications, remarks, that "the expressions are very strong, and seem intended to accommodate the description, which the patentee is required to give, to the comprehension of any practical mechanic, skilled in the art of which the machine is a branch, without taxing his genius or his inventive powers."

As the specification is addressed to artists acquainted with the subject of the patent, it is no ground of objection that it contains technical terms. It would be quite impracticable to give a description of many inventions without the use of such terms, and the description is often rendered much more clear by the use of them, even where others might,

[18] 2 H. Bl. 497.

[19] Gray & Osgood v. James and others, 1 Pet. C. C. R. 376.

by circumlocution, be used instead of them. It was objected to a specification, in one case, that it contained French terms; but it was considered by Abbott C. J. to be sufficient.[20]

Sec. V.—The Specification must be true, and must not mislead.

That the specification must be true in all its material parts, cannot be doubted, for the wrong statement of what is material, will render the specification defective, either as a notice of what the invention is, or as a direction for practising it. If the patent and specification state an invention which has not been made by the patentee, the patent is no doubt void. "If," says Abbot C. J. "the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration of the royal grant fails, and the grant consequently becomes void. And this will not be the less true, if it should happen, that the patentee has invented some other matter or thing, of which, upon a due representation thereof, he might have been entitled to a grant of the exclusive use."[21]

The case on Turner's patent is an illustration of a defect from an erroneous statement of the process

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[20] Bloxam v. Elsee, 1 Car. & P. 558.
[21] King v. Wheeler, 2 Barn. & Ald. 349.

and result. In an action for an infringement of that patent, which was "for producing yellow color for painting in oil or water, and making white lead, and separating the mineral alkali from common salt, all by one process," it was objected, that the white lead produced by following the directions in the specification, was not what was sold as such, but a white substance, the basis of which was lead, and which was applicable only to some of the uses of common white lead. Ashhurst J. "It is said that the patentee did not profess to make common white lead. But that is no answer; for if the patentee had intended to produce something only like white lead, or answering some of the purposes of common white lead, it should have been so expressed in the specification." The patent was held to be void.[22]

In Watt's patent and specification, his invention is represented to be one for lessening the consumption of fuel and steam in the use of steam engines; and Eyre C. J. thought that it was essential, under such a representation, that such should be the practical result of his invention.[23]

In the case on Bloxam's patent for a machine for making paper, the patent was held to be void, because the patentee represented that his machine would do what in fact could not be effected by

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[22] Turner v. Winter, 1 T. R. 602.
[23] Boulton v. Bull, 2 H. Bl. 498.

it. It was recited in the letters patent that the patentee had represented to the king that he was in possession of *a machine* for making paper in single sheets without seam or joining, *from one to twelve feet and upwards wide*, and from one to forty-five feet and upwards in length. It also appeared by the specification, that the machine then invented was so constructed as to be capable of producing paper of one definite width only, and that in order to vary the width a new machine was required. By the subsequent improvements, however, one and the same machine became capable of producing paper of various widths. C. J. Abbot. "If any material part of the representation was not true, the consideration has failed in part, and the grant is consequently void, and a defendant, in an action for infringing the patent, has a right to say that it is so. Now I think it impossible to say that both width and length are not important parts of this representation. It may be that if the representation had mentioned length only, a patent would have been granted for the invention, which (in its improved state at least) is eminently useful, in a very important manufacture, as saving both time and labor in a very considerable degree. But although I may think this probable, I am not at liberty to pronounce judicially that it would have been so. I must therefore see whether the representation was true. It has been contended, in support of the patent, that the recital does not import that

paper of different widths was to be made by one and the same machine, but may mean only that the width might be obtained by different machines, each adapted and constructed to the extent required. But I think this construction of the recital cannot be allowed ; for it is a different thing whether a manufacturer must supply himself with several different machines, or with one only, capable alone of accomplishing all the purposes to be obtained by many. And if the width is not to be considered as material, the length cannot be so considered, and then the representation will only be, that he has invented machines, by the use of several of which, paper of various widths and lengths may be made without seam or joining. And this will be at variance with all the specifications, which plainly show that whatever was done, was to be done by one and the same machine. Then if the representation be (as I think it is) that paper of various widths may be obtained by one and the same machine, I must look to the evidence to discover whether the patentee was possessed of a machine, or of the invention of a machine, capable of accomplishing this object. And unfortunately the evidence shows that he was not. I say unfortunately, because it is to be lamented, that the advantage of great ingenuity, labor, anxiety and expense, should be lost to those who have bestowed them. The patentee was at the time possessed of one machine, and one only, and this adapted to one degree of width, and

one degree only. And he was not then possessed of any method by which different degrees of width might be manufactured by that machine or by any other."[24]

We have already seen that mere immaterial mistakes[25] or unnecessary, superfluous descriptions and directions, which do not mislead a person consulting the specification, are harmless surplusage.[26] But where superfluous processes or machinery are described for the purpose of misleading the person consulting the specification, and preventing him from getting a knowledge of the process or machine patented, or of the best mode of using or making it, this will vitiate the patent. Thus a patent for a process for making Seidlitz powders was held to be void because the patentee, in his specification, gave three recipes for producing three different substances, of which he directed the mixture to produce the Seidlitz powder, without disclosing that these three substances were Rochelle salts, carbonate of soda, and tartaric acid. Abbott, C. J. "It is the duty of any one, to whom a patent is granted, to point out, in his specification, the plainest and most easy way of producing that for which he claims a monopoly ; and to make the public acquainted with the mode which he himself adopts. If a person, on

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[24] Bloxam v. Elsee, 6 Barn. & Cress. 169.
[25] Buller's N. P. 75. Dav. Pat. Cas. 433.
[26] Supra, Sec. 3.

reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when, in fact, he might go to a chemist's shop and buy the same thing as a separate, simple part of the compound, the public are misled. If the results of the recipes, or any one of them, may be bought in the shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported."[27]

Arkwright's patent for cotton spinning machinery is another instance of a patent being void by the introduction of things into the specification which were never used by the inventor, and which were introduced merely to mislead the public.[28]

The concealment in the specification of what is necessary to a knowledge of the machine, is fatal to the patent, no less than the introduction of facts intended to mislead.[29]

Sec. VI.—The Specification must be full, clear, and exact.

The specification must not only be true and full;

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[27] Savory v. Price, 1 Ryan & Moody, 1.

[28] The King v. Arkwright, Dav. Pat. Cas. 129. 139, 140. See also infra, Sec. 8; Hill v. Thompson, 2 J. B. Moore, 448; Liardet v. Johnson, Bull. N. P. 76; 1 T. R. 608; Turner v. Winter, 1 T. R. 602.

[29] Gray & Osgood v. James and others, 1 Pet. C. C. R. 196; Wood v. Zimmer, Holt's N. P. C. 58.

it must also be clear, in distinction from its being obscure and ambiguous, and exact, in distinction from its being vague, loose, and indefinite. These requisites are, however, laid down by judges, in some instances, with too great strictness and severity. In some of the English cases, a jealousy of patent rights as an infringement of the rights of the community by the common law, leads the judges to a very strict construction against patentees.

Thus in the case on Turner's patent, Mr. Justice Ashhurst says, "as every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law, and would be a reason against it, were it not for the advantages which the public derive from the communication of the invention after the expiration of the time for which the patent is granted. It is, therefore, incumbent on the patentee to give a specification of the invention in the *clearest and most unequivocal terms, of which the subject is capable.* And if it appear that there is any unnecessary ambiguity affectedly introduced into the specification, or any thing which tends to mislead the public, in that case the patent is void."[30]

The doctrine on this subject is stated with less severity in a more recent case, in which it is said that every patent being a monopoly, that is, an infringe-

[30] Turner v. Winter, 1 T. R. 602.

ment of public right, and having for its object, to give the public warning of the precise extent of the privilege conferred on the patentee, the court is bound to require that such warning should be *clear, and accurately* describe what the inventor claims as his own. If the instrument contain any *ambiguity on a material point*, that is a ground on which it may be avoided altogether.[31]

Mr. Justice Story says, upon this subject, that "it ought to appear with *reasonable* certainty, what the patentee claims, and that it should not be left to minute references and conjectures from what was previously known."[32]

In another case the same judge remarks, that a general statement that the patented machine is in all material respects, (without stating what these are) an improvement on an old machine, is no specification at all.[33]

Mr. Justice Washington also considered an ambiguous, unintelligible specification, as in effect, no specification at all.[34] And Mr. Justice Story, speaking of a specification of an improvement in a machine, says, "If the terms be so obscure or doubtful, that the court cannot say what is the particular improve-

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[31] Campion v. Benyon, 3 Brod. & Bingh. 5.

[32] Lowell v. Lewis, 1 Mason's R. 189.

[33] Barrett v. Hall, 1 Mason, 489.

[34] Kneass v. Schuylkill Bank, C. C. U. S. Penn. Oct. 1820, Coxe's Dig. 532.

ment which the patentee claims, and to what it is limited, the patent is void for ambiguity."[35]

In a more recent case, the same judge lays down the law on the subject very distinctly, in giving his opinion upon the specification, in the case of Ames's patent for an improvement on a machine for paper-making. He says, "Let us see what is the invention as claimed by the inventor in this case. I agree that if he has left it wholly ambiguous and uncertain, so loosely defined, and so inaccurately expressed, that the court cannot, upon a fair interpretation of the words, and without resorting to mere vague conjecture of intention, gather what it is, then the patent is void for this defect. But if the court can clearly see what is the nature and extent of the claim, by a reasonable use of the means of interpretation of the language used, then the patentee is entitled to the benefit of it, however imperfectly and inartificially he may have expressed himself. And for this purpose, we are not to single out particular phrases standing alone, but to take the whole in connexion."[36]

The case in which the above remarks were made, is an illustration of the doctrine laid down by the judge. In the specification, the patentee, after describing the machinery and apparatus for making

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[35] Barrett v. Hall, 1 Mason's R. 476; and see M'Farlane v. Price, 1 Stark. R. 199.

[36] Ames v. Howard, 1 Sumner's Rep. 485.

paper, to which his patent related, proceeded, "I do not claim the felting, vats, rollers, presses, wire-cloth, or any separate parts of the above described machinery or apparatus, as my invention. What I claim as new and as my invention, is, the construction and use of the peculiar kind of cylinder above described, and the several parts thereof in combination for the purpose aforesaid." The cylinder had been described particularly, together with the construction and operation of the machinery and apparatus generally. The question was, whether, under this specification, the patentee had claimed and patented the cylinder and the several parts thereof, *in combination with each other*. Upon this construction, the court remarked that it would be mere tautology, for if the patentee claimed the cylinder, this was a claim of the several parts thereof in combination, and, *vice versa*, if he claimed the several parts in combination with each other, this was nothing more nor less than claiming the cylinder. This construction was to be avoided if any other could be put, not inconsistent with the specification generally, that would give significance to the words. The court was accordingly of opinion "that the patent was for the construction and use of the peculiar kind of cylinder, and the several parts thereof in combination *with the other parts of the machinery*, for the purpose of making paper." To make this specification clear, it was necessary to insert, after *combination* the words,

"*with the other machinery*," and to interpret "the purpose aforesaid," to mean, *the purpose of making paper*.

Here were obscurity and ambiguity, but the specification, in the opinion of the court, taken altogether, afforded means of giving a construction consistent with the validity of the patent. Instead of adopting a rigid, cautious, and jealous interpretation, after the example of the English courts in many similar cases, and thereby defeating the patent, when it was admitted by the court that the plaintiff had a right to one, it was saved by adopting a broad, liberal, and fair construction.

In the case of *Metcalfe's improvement in brushes*, the decision was against the validity of the patent, on the ground of the alleged inaccuracy of the description of them in the patent, as "tapering" brushes. It was a *scire facias* brought to repeal the patent. The specification directed that the hairs or bristles should be taken of a length that was described, and before their insertion in the holes in the stock of the brush, should be mixed up together, so that when they were collected and drawn through the holes, and secured by a brass wire, the bristles would be of unequal lengths; whereas, according to the usual mode, the bristles were inserted in the stock, so as to be as nearly of the same length as possible, and were afterwards cut down so as to be of the same length. The counsel for the patentee

stated that by compressing the bristles in each tuft, the effect would be to make them converge to a point. Lord Ellenborough: "If the word *tapering* be used in its general sense, the description is defective. *Tapering* means, gradually converging to a point. According to the specification, the bristles would be of unequal length, but there would be no converging to a point." His lordship advised the jury to find that it was not a *tapering*, but only an *unequal* brush. A verdict was rendered for the crown.[37]

It has been remarked upon this case,[38] that the description proposed by Lord Ellenborough, that of *unequal* brush, is, to say the least, no more clear and exact than that of *tapering* brush, used by the patentee. One cannot readily imagine a description more vague, indefinite, and ambiguous, than that given by Lord Ellenborough in this case, and the fact that no better substitute suggested itself to his mind as a general description in a title of the invention, ought to have been a sufficient ground for a very liberal interpretation of the title given by the patentee, which, it is true, gave no distinct idea of the invention, and, as we have seen, the titles of patents frequently give no distinct idea of the invention. The patent in this case would, as has been suggested, have been good

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[37] The King v. Metcalfe, 2 Stark. N. P. C. 249.

[38] Westminster Review, No. 44, April, 1835.

in the United States,[39] as the defect was in the title, and remedied in the specification.

In the case of a machine for sharpening scissors, the specification was considered to be defective in exactness. A patent was granted for a machine for giving a fine edge to knives, razors, scissors, and other cutting instruments. The specification described a machine for sharpening cutting instruments, by passing their edges backward and forward in an angle formed by the intersection of two circular files. The specification also stated that other materials besides steel might be employed, according to the delicacy of the edge required. It was proved that if both rollers were files, it would not do for scissors; and that for these one of the rollers should be smooth; but that if Turkey stone were used for both the rollers, instead of steel, it would be possible to sharpen scissors with a machine so constructed. Lord Tenterden. "The specification describes both the rollers as files, and on reading it with attention, I cannot find that the scissor-sharpener is described as having the two rollers different. It appears to me, therefore, that the specification is insufficient, as it nowhere states that the rollers for scissors must be one rough and the other not. With respect to constructing the rollers of Turkey stone, I cannot find that it is any where stated in the specification, that Turkey stones

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[39] Supra.

used on both sides will do for scissors. The plaintiff must be called."[40]

In an action for an infringement of a patent for an improvement of the hautboy by increasing the number of *notes*, (in the plural) it appeared by the specification that the patentee had invented only *one* new note. The patent was held to be invalid, although it was proved that great ingenuity had been exerted, and that the fingering was rendered less complicated by the invention.[41] The defect in this case was also in the title and not in the specification; and as the invention was sufficiently described in the latter, the patent would have been good in the United States.

No cases have ever given rise to more discussion on the accuracy and exactness requisite in the specification, than those on Watt's patent for an improvement in the steam engine. As much of this part of the law of patents has arisen from these cases, they will be given at some length. They establish the doctrine that any inaccuracy in the use of words in the specification, which the specification itself supplies the means of correcting, will not defeat the patent. They also assume the doctrine of the other English cases, that the general description in the title, which is the only one inserted in the English

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[40] Felton v. Greaves, 3 Car. & Payne, 611.

[41] Bainbridge v. Wigley, K. B. 1810, 18 Rep. of Arts, 2d Ser. 127.

patents, cannot be enlarged or contradicted, though it may be limited and explained in the specification.

The patent was granted to Mr. Watt for "a *new invented method* for lessening the consumption of steam and fuel in steam-engines." The specification stated that the method consisted of certain *principles*, and attempted to describe the application of these principles. The novelty consisted in keeping the cylinder, or steam-vessel, as hot as the steam which enters it, during the whole time the engine is at work; first, by inclosing it in a case of wood or any other materials, that transmit heat slowly; secondly, by surrounding it with steam or other heated bodies; and thirdly, by suffering neither water, nor any other substance colder than the steam, to enter or come in contact with it during that time. The steam was condensed in vessels distinct from the cylinder, and communicating with it. This was entirely new, as in the old steam-engines water was admitted into the cylinder to condense the steam. The specification did not state in what manner the new machine was to be constructed, in what respects it varied from the old one, or in what way the improvements were to be added; but it appeared that it was sufficient to enable a mechanic, acquainted with the steam-engines previously in use, to construct one with this improvement.[42]

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[42] An act of Parliament was passed to extend the patentee's term, which, after reciting that the patent was "for making and vending cer-

Rooke J. "It is objected to this patent, first, that it is not for steam-engines upon the particular construction which contains this new improvement, but for a new invented method of lessening the consumption of steam and fuel. The obvious meaning of these words is, that the patentee has made an improvement in the construction of steam-engines; for what does *method* mean but mode or manner of effecting? What method can there be of saving steam or fuel in engines, but by some variation in the construction of them? *A new invented method*, therefore, conveys to my understanding the idea of a *new mode of construction.* I think those words are tantamount to *fire-engines of a newly invented construction.* At least, I think, they will bear this meaning, if they do not necessarily exclude every other. The specification shows that this was the meaning of the words as understood by the patentee, for he has specified a new and particular mode of constructing fire-engines. If he has so understood the words, and they will bear this construction, then I think that this objection, which is merely verbal, is answered."

"It is further objected, that no particular engine is described in this specification, but that it only sets

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tain *engines*, by him invented, for lessening the consumption of steam and fuel in fire-engines," granted to him the sole right of "constructing and selling such engines for twenty-five years;" it was, however, provided, that this grant should be subject to "every objection in law competent against the said patent."

forth the principles. If the patentee sets forth his improvement intelligibly, his specification should be supported, though he professes only to set forth the principle. When he set his inventive faculties to work, he found steam-engines already in existence, and the natural qualities of steam already known, and mechanically used. He only invented an improvement in the mechanism, by which they might be employed to greater advantage. There is no newly discovered natural principle as to steam, nor any new mechanical principle in his machine; the only invention is a new mechanical employment of principles already known. The greater part of the specification describes a practical use of improved mechanism, the basis on which the improvement is founded. Had a drawing or model been made, and any man copied the improvement, and made a machine in a different form, no doubt this would have been an infringement of the patent; because the *mechanical improvement* would have been introduced into the machine, though the form was varied. It follows from thence that the *mechanical improvement*, and not the *form* of the machine, is the object of the patent; and if this mechanical improvement is intelligibly specified, of which a jury must be the judges, whether the patentee call it a principle, invention or method, or by whatever other appellation, we are not bound to consider his terms, but the real nature of his improvement, and the description he

has given of it, and we may, I think, protect him without violating any rule of law."

Heath J. "The question is, inasmuch as this invention is to be put in practice by means of machinery, whether the patent ought not to have been for one or more machines, and whether this is such a specification as entitles the patentee to the monopoly of a *method?* The method is a principle reduced to practice; it is, in the present instance, the general application of a principle to an old machine. The following objections arise to the patent, which I cannot answer; namely, that if there may be two different species of patents, the one for an application of a principle to an old machine, and the other for a specific machine, one must be good and the other bad. The patent that admits the most lax interpretation, should be bad, and the other alone conformable to the rules and principles of common law, and to the statute on which patents are founded. I approve of the term *manufacture* in the statute, because it precludes all nice refinements, it gives us to understand the reason of the proviso, that it was introduced for the benefit of trade. That which is the subject of a patent ought to be specified, and it ought to be that which is vendible, otherwise it cannot be a manufacture. This is a new species of manufacture, and the novelty of the language is sufficient to excite alarm. I shall consider how far the arguments in support of this patent, will apply to the in-

vention of original machinery, founded on a new principle. The steam-engine furnishes an instance. The Marquis of Worcester discovered the expansive force of steam, and first applied it to machinery. As the original inventor, he was clearly entitled to a patent. Would the patent have been good if applied to all machinery, or to the machines which he had discovered? The patent decides the question. It must be for the vendible matter, and not for the principle. Another objection may be urged against the patent, upon the application of the principle to an old machine, which is, that whatever machinery may be hereafter invented would be an infringement of the patent, if it be founded on the same principle. If this were so, it would reverse the clearest positions of law respecting patents for machinery, by which it has been always holden that the organization of a machine may be the subject of a patent, but principles cannot. If the argument for the patentee were correct, it would follow, that where a patent was obtained for the principle, the organization would be of no consequence. Therefore, the patent for the application of the principle must be as bad as the patent for the principle itself. It has been urged for the patentee, that he could not specify all the cases to which his machinery could be applied. The answer seems obvious, that what he cannot specify he has not invented."

Buller J. "The true question in the case is,

whether the patent can be supported for the engine? I have already said I considered it as granted for the engine, and if that be the right construction of the patent, that alone lays all the arguments about ideas and principles out of the case. The objections to this patent, as a patent for the engine, are two: first, that the fire-engine was known before; and secondly, though the plaintiff's invention consisted only of an improvement of the old machine, he has taken the patent for the whole machine, and not for the improvement alone. As to the first, the fact which the plaintiff's counsel were forced to admit, that there was nothing new in the machine, is decisive against the patent. And the second objection is equally fatal."

Eyre C. J. "There can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances, as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent. Now this is, in my judgment, the thing for which the patent stated in this case was granted, and this is what the specification describes, though it *miscalls it a principle.* It is not that the patentee has conceived an abstract notion, that the consumption of steam in fire-engines may be lessened, but he has discovered a *practical manner* of doing it; and for that *practical manner of doing it*, he has taken his patent. The patent is not *for a principle*,

but *for a process.* If, upon the true construction of the statute, there may be a patent for a new method of manufacturing or conducting chemical processes, or of working machinery, so as to produce new and useful effects, then I am warranted to conclude, that this patent was, in its original creation, good."

"As to the specification, I admit, that if this patent is to be taken to be a patent for a fire-engine, the specification is not sufficient; it is not a specification of mechanism of any determinate form, having component parts, capable of precise arrangement, and of particular description. On the other hand, if the patent is not for a fire-engine, but, in effect, for *a manner of working a fire-engine, so as to lessen the consumption of steam*, which, as I conceive the words of the patent import, it appears to me that the specification clearly points out and explains the method to every man who has a common acquaintance with the subject, and is intelligible even to those who are unacquainted with it."

The Court of Common Pleas being thus equally divided, no judgment was given.[43]

The question came afterwards to be decided in the Court of King's Bench, in the case of Hornblower v. Boulton, 8 T. R. 95, and it was unanimously held, that the invention was the subject of a patent, and

[43] Boulton v. Bull, 2. H. Bl. 463.

the patentee having, in his specification, sufficiently described his invention, had a valid right under the patent and act of Parliament.

Kenyon C. J. "By comparing the patent and manufacture together, it evidently appears that the patentee claims a monopoly for an engine or machine, composed of material parts, which are to produce the effect described, and that the mode of producing this is so described as to enable mechanics to produce it."

Ashhurst J. was of opinion that the patentee was entitled to the benefit of the patent.

Grose J. "It is argued that this is a patent for a mere *principle*, and not for a *new manufacture*, and that nothing can be the object of a patent but a new manufacture. But it seems to me that in this specification, the patentee does describe a new manufacture, by which his principle is realized, that is, by which his steam vessel is kept as hot as the steam during the time the engine is at work, by which means the consumption of steam and fuel is lessened. Thus, he specifies the particular parts requisite to produce the effect intended, and states the manner in which they are to be applied. Can it then be said, that the making and combining these parts is not some manner of new manufacture? I cannot say that it is not. But then it is objected that the patent should have been for that manufacture; whereas it is for principles, which the specification describes.

To which I answer, that the patent is not merely for principles, nor does the specification describe principles only. The patentee states the principles on which the invention proceeds, and shows in his specification the manufacture, by means of which those principles are to take effect."

"Taking it, however, as a patent for an engine, it is objected that the thing was made before, and that the patent should have been for the addition only, and not for the whole engine. But I do not consider it as a patent for the old engine, but only for the addition to, or improvement of the old engine. And so the act of Parliament considers it. The method is disclosed in the specification, and it is by the addition of what is there disclosed, and by managing it in the way described."

Lawrence J. "Two objections have been made to this patent: first, that it is not for any formed or organized machine or manufacture, but for mere principles; secondly, that the specification is bad. By looking at the patent and the recital in the act of Parliament, it appears that Watt obtained a patent for *an engine or mechanical contrivance* for lessening the consumption of steam in steam-engines. It is clear, that the legislature understood that the patent was for an engine or some mechanical contrivance, and the form of the patent and the specification does not contradict this. *Engine* and *method* mean the same thing, and may be the subject of a

patent. *Method*, properly speaking, is only placing several things, and performing several operations in the most convenient order; but it may signify a *contrivance or device;* so may an *engine*, and therefore, I think it may answer the word *method.* So *principle* may mean a mere elementary truth, but it may also mean constituent parts."

"Then, taking this to be a patent for an engine, it is objected that the specification is bad. The patent must be supported as granted for an improvement and addition to old engines, known and in use, and I think that the patent is good in this point of view. For Watt claims no right to the construction of engines for any determinate object, except that of lessening the consumption of steam and fuel in fire-engines. His patent supposes the existence of such engines, and his contrivance, method, or engine, is for lessening the consumption of fuel in such pre-existing engines, and for nothing else. Some of the difficulties in the case have arisen from considering the word *engine* in its popular sense, namely, some mechanical contrivance to effect that to which human strength, without such assistance, is unequal; but it may also signify *device;* and that Watt meant to use it in that sense, and that the legislature so understood it, is evident from the words *engine* and *method* being used as convertible terms. Now there is no doubt but that for such a contrivance a patent may be granted, as well as for a more complicated ma-

chine; it equally falls within the description of a "manufacture;" and unless such devices did fall within that description, no addition or improvement could be the subject of a patent."

Wheeler's patent for a preparation for coloring beer was adjudged bad, on account of the inaccuracy of the description in the title, and the insufficiency of the specification. It was for "a new and improved method of drying and preparing malt." In the specification it was stated that the "invention consisted in the heating of malt to 400 degrees and upwards, of Fahrenheit's thermometer, according to a process or processes hereafter described." Abbott C. J. "This is a patent for the invention of a method, that is, of an engine, instrument or organ, to be used for the accomplishment of some purpose; or at least of a process to be so used. The patentee does not profess to be the inventor of any engine, instrument, or organ; he says, that a coffee-roaster, or a kiln, or any thing by which the grains may be kept in motion during their exposure to the requisite degree of heat, may be used. Neither has he described any certain or precise process, which, admitting that there may be a patent for a process only, ought unquestionably to be done. He does not mention the state in which the malt is to be taken, for the purpose of undergoing the process, whether in a moist or dry state, as was before noticed; he does not say, what heat beyond 400 degrees of Fahrenheit may be used; he

does not furnish the operator with any means of knowing when he has this degree of heat; he does not say, during what length of time the process is to be continued, but contents himself with saying, that "the proper degree of heat and time of exposure will be easily learned by experience, the color of the internal part of the prepared grain affording the best criterion;" not even mentioning what the color is, which is to be the criterion. A specification which casts upon the public the expense and labor of experiment and trial, is undoubtedly bad. If it be said that all these matters will be well or easily known to a person of competent skill (and to such only the patentee may be allowed to address himself), then the inventor will not in reality have given any useful or valuable information to the public; so that in either way of viewing the case, there is either no certain and clear process described, or the process described is such as might be practised without the assistance of the patentee." The patent was adjudged to be void.[44]

It has been suggested,[45] that this decision is an illustration of an illiberal application of the rules on the subject of specifications. Whether it be so or not will evidently depend, in a great degree, upon what may be supposed to be known to persons prac-

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[44] King v. Wheeler, 2 Barn. & Ald. 345.
[45] Westminster Review, No. 44.

tised in the manufacture of malt, and in the art of brewing. The writer just alluded to, supposes that a person conversant with these manufactures would very readily learn to make and use the new invented malt by the directions given in the specification. However this may have been in the particular case, the doctrines and principles of the decision are no doubt correct, and the precedent is equally good, whether the court applied these doctrines to the actual case before them, or to one supposed by them through mistake.

Sec. VII.—What is claimed as New must be distinguished from what is Old. It must appear what is claimed as New. The Inventor must not claim too much.

It is a general rule that the patentee must not claim, in his specification, any more than he has invented, and that by claiming too much his patent is void. And if the specification contains a description of what is old and known as well as what is new, what is claimed as new must be distinguished.[46] The form of making this distinction is immaterial; it is enough that it plainly appears from the specification and patent, what is claimed by the patentee as

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[46] Dixon v. Mayor, Coxe's Dig. 533; and see cases below

his invention, and that he claims nothing more than he has invented. Mr. Justice Park says, any ambiguity may be avoided by the patentee's disclaiming that which is not his own discovery.[47] The more frequent form, however, is to state positively what the patentee does claim, saying that he claims only such and such things. In other cases it is stated both negatively what he does not claim, and positively what he does claim as his invention. It is sufficient if it appear by the specification, in whatever manner, what he does claim, and that the claim is not broader than the invention.

In specifying an improvement in a machine it is often necessary to describe the whole machine as it operates with the improvement, in order to make the description intelligible, and enable an artist to construct the machine, as the inventor is bound to do in his description, and which, if he fails to do, he falls into the fault of obscurity. On the other hand, if the whole machine, as well the old as new part, be thus described, it is requisite to distinguish what part the patentee claims, since if this does not satisfactorily appear, the patent will, as we have seen, be void for ambiguity; or, if the obvious construction is, that he claims the whole machine in its improved state, the patent will be void by reason of the patentee's claiming too much.

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[47] Champion v. Benyon, 3 Brod. & Bing. 5.

The mode of expression generally used in the books in relation to this subject, is, that the specification must distinguish the new from the old. The only object of this distinction is, however, to specify what the patentee claims, and the mere discrimination of the new from the old would not necessarily show this, for perhaps he does not claim all that is new. When the cases say, therefore, that the specification must distinguish the new from the old, we must understand the meaning to be that it must show distinctly what the patentee claims, the only object of this distinction being for this purpose. This doctrine is illustrated by some of the cases already stated, and it runs through them all wherever this question arises.[48]

The Court of King's Bench held it sufficient, in one case, to describe the whole machine as improved, and refer to the patent of the original machine on which the improvement was made, the two specifica-

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[48] Hill v. Thompson, 3 Meriv. 629; Barrett v. Hall, 1 Mason's R. 576; Boville v. Moore, 2 Marsh. R. 211; McFarlane v. Price, 1 Stark. R. 199; Woodcock v. Parker, 1 Gallis. R. 438; Whittemore v. Cutter, 1 Gallis. R. 478; Odiorne v. Winkley, 2 Gallis. R. 51: Evans v. Eaton, 3 Wheat. 354; S. C. 7 Wheat. R. 356; S. C. 1 Pet. C. C. R. 342; Dixon v. Mayer. 4 Wash. C. C. R. 68; Champion v. Benyon, 3 Brod. & Bing. 5; George v. Beaumont and others, Rep. of Arts. N. S. Vol. 27, p. 252; Cochrane v. Smethurst, 1 Stark. R. 205; The King v. Elsee, Bull. N. P. 76. Rogers v. Abbot, 4 Wash. C. C. R. 514. Watson v. Bladen, 4 Wash. C. C. R. 580. The act of Congress of 1836, and the act of Parliament of 1835, as subsequently stated, in Sec. 10 of this chapter, make provision whereby the patentee may avoid the entire loss of his privilege in consequence of including too much in his specification.

tions being so framed that a person, by consulting both, might distinguish what was new. A patentee of a machine for dressing woollen cloths, duly enrolled his specification, and, several years afterwards, obtained another patent for certain improvements in the machine, in which the grant of the former patent was recited. The specification of the latter patent contained a full description of the whole machine in its improved state, but did not point out or distinguish the improvements from the former machine by any verbal description, or by any delineation or mark in the drawing. The improvements, however, could be ascertained by referring to the first specification, and comparing it with the second specification and the drawings. It was held that the second specification was sufficient. Lord Ellenborough. "I own I was disposed to think that it was a departure from the terms of the proviso, for the patentee merely to tell the inquirer who came to consult the specification, how he might learn what the invention was, instead of giving him that information directly. But I feel impressed by the observation of my brother Le Blanc, that the trouble and labor of referring to and comparing the former specification with the latter, would be fully as great if the patentee only described in this the precise improvements upon the former machine. Reference must indeed often be necessarily made in these cases to matters of general science, or the party must carry a

reasonable knowledge of the subject matter with him, in order clearly to comprehend specifications of this nature, though fairly intended to be made."[49]

But this is certainly a very inartificial way of drawing up a specification; and though in the case before the court the comparison of the two specifications may have rendered it quite obvious what the patentee claimed as the subject of his second patent, such might not be the result in the specification of other improvements. This is by no means a skilful or safe mode of making a specification of an improvement.

Upon this subject Mr. Justice Story says, "The patentee is clearly not entitled to include in his patent the exclusive use of any machinery already known; and if he does, his patent will be broader than his invention, and consequently void. If therefore the description in the patent mixes up the old and the new, and does not distinctly ascertain for which in particular the patent is claimed, it must be void; since if it covers the whole, it covers too much, and if not intended to cover the whole, it is impossible for the court to say what, in particular, is covered, as the new invention. The language of the St. 1793, c. 156, s. 3, is decisive on this point. It is, however, sufficient if what is claimed as new appear with reasonable certainty on the face of the patent,

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[49] Harmar v. Playne, 11 East, 101.

either expressly or by necessary implication. But it ought to appear with reasonable certainty, for it is not to be left to minute references and conjectures from what was previously known or unknown; since the question is not, what was before known, but what the patentee claims as new; and he may in fact claim as new and patentable what has been long used by the public."[50]

The law is laid down in the same manner by Mr. Justice Buller. A patent was granted for a new invented manufacture of lace, called French lace. The specification went generally to the invention of mixing silk and cotton thread upon the frame. It was clearly proved that, prior to the patent, silk and cotton thread had been used together and intermixed upon the same frame; and the counsel for the patentee acknowledged the fact, but said he could prove, that the former method of using the silk and cotton thread was quite inadequate to the purpose of making lace, on account of its coarseness, and that the patentee alone had invented the method of intermingling them, so as to unite strength with firmness. Buller J. "It will be to no purpose. The patent claims the exclusive liberty of making lace composed of silk and cotton thread mixed; *not of any particular mode* of mixing it, and therefore, as it has been clearly

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[50] Lowell v. Lewis, 1 Mason, 189.

proved and admitted, that silk and cotton thread were before mixed on the same frame for lace in some mode or other, the patent is clearly void, and the jury must find for the crown."[51]

In putting a construction upon a specification as to the extent of the patentee's claim, the whole is to be taken into consideration, and general expressions which accepted literally would cover too much ground, may be limited by other parts of the specification. A specification stated the invention to be an approved apparatus for "extracting inflammable gas by heat, from pit-coal, tar or any other substance from which gas or gasses, capable of being employed for illumination, can be extracted by heat." It was proved that the apparatus would not succeed in making gas from oil; and it was argued, that there was nothing to prevent a person who saw this specification from considering that oil gas was meant to be included in it. Lord Tenterden ruled, that "the words 'other substance,' must mean other substance *ejusdem generis*, and that oil was not meant to be included *in it*, it being proved that, at the time in question, oil was considered much too expensive to be used for the making of gas for the lighting of streets and buildings, though it was known to afford an inflammable gas."[52]

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[51] The King v. Elsee, Dav. Pat. Cas. 144.

[52] Crossly v. Beverly, 3 Car. & P. 513.

The patent for Brown's improvement on a lace-machine, was ruled by Gibbs C. J. to be void, because the specification claimed the whole machine, though a considerable part of it had been long in use.[53]

So in an American case, where the general description in the letters patent stated that the grant was for "a new and useful improvement in manufacturing cotton and wool cards," Mr. Justice Story held that the specification must be considered as controlling the generality of expression and limiting the grant to the machine specifically described therein.[54]

It is sufficient to defeat the patent, though the part claimed, which is not new, or not invented by the patentee, be unimportant. Mr. Justice Story says, that, "Where the patentee claims any thing as his own invention, in his specification, courts of law cannot reject the claim; and if it is included in the patent, and found not to be new, the patent is void, however small or unimportant such asserted invention may be. Where he sums up the particulars of his invention, and his patent covers them, he is confined to such summary; and if some part, which he claims in his summing up as his invention, prove not to be in fact his invention, he cannot be permitted to sustain his patent by showing that such part is of

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[53] Bovill v. Moore, Dav. Pat. C. 361. See also Williams v. Brodie, cited Dav. Pat. Cas. 96.

[54] Whittemore v. Cutter, 1 Gallison, 437.

slight value or importance in his patent. His patent covers it, and if it be not new, the patent must be void."[55]

The ground of this doctrine is stated in the English courts to be the failure of the consideration for which the grant of the patent is made. Where a patent was granted for improvements in the manufacturing of ships' anchors, windlasses, and chain-cables, but it appeared that there was no novelty in the construction of the anchors, it was held that the patent was wholly void, although the other improvements might be new. Abbott C. J. "It is quite clear, that a patent granted by the crown cannot extend beyond the consideration of the patent. The king could not, in consideration of a new invention in one article, grant a patent for that article and another. The only difference between the case of Hill v. Thompson, (2 J. B. Moore, 424,) and this, is, that here the patentee, instead of saying that he has made certain improvements, states the improvements, but still he claims the merit of having invented improvements in the manufacture of three things. The consideration is entire, and if it turns out that there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention."

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[55] Moody v. Fiske, 2 Mason, 112.

Bailey J. "When an application is made for a patent, for three different things, it may be considered by the persons who are to advise the crown as to the propriety of the grant, that the discovery as to the three things together may form the proper subject of a patent, although each *per se*, would not induce them to recommend the grant. It seems to me, therefore, that if any part of the consideration fails, the patent is void *in toto*."

Best J. "This has been compared, in argument, to the case of a grant of lands. If, in the same deed, there were included three conveyances of three distinct estates on three considerations, one might be set aside, and another be good; but if the grant were upon one consideration which was bad, the whole would be void, because the consideration would fail altogether. Now the present case is similar to that, because here, the consideration to induce the king to grant the patent, was the statement made by the plaintiff in his petition, that there had been three inventions, when in fact there had been only two. The united consideration upon which the whole grant was made, is therefore void; and, consequently, the grant itself is void."[56]

In the description of an improvement, the phrases "improved machine," and "improvement of a ma-

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[56] Brunton v. Hawkes, 4 B. & Ald. 540.

chine," mean substantially the same thing.[57] The patentee should not claim a new mode or device as detached from the machinery, but as combined with the machinery or construction by which the effect, whether new or old, is produced. "If," says Mr. Justice Story, "an invention consist in a new combination of machinery, or in improvements upon an old machine to produce an old effect, the patent should be for the combined machinery, or improvements on the old machine, and not for a mere mode or device for producing such effects, detached from the machinery. This doctrine may not be of as extensive consequence under our patent act, where the specification forms a part of the patent, and may control its generality, as in England, where the specification is separated from it; but it distinctly shows the necessity of an exact description, so that the patent may conform to the invention."[58]

This subject came up very early in the cases on Watt's patent. In one of these cases Mr. Justice Buller said, that since the case of Morris v. Branson, in 1776, "it has been the generally received opinion in Westminster Hall, that a patent for an *addition* is good. But then it must be for the addition only, and not for the old machine too. In Jessop's case, the patent was held to be void, because it ex-

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[57] Barrett v. Hall, 1 Mason's R. 475; Boulton v. Bull, 2 H. Bl. 463. 482; Evans v. Eaton, 3 Wheaton, 454.

[58] Barrett v. Hall, 1 Mason, 476.

tended to the whole watch, and the invention was of a particular movement only. It was admitted in the reply, that the patent should be applied to the invention itself; but it was contended that if, in consequence, the patent gave a right to the whole engine, that would be no objection. To this I answer, that if the patent be confined to the *invention*, it can give no right to the *engine*, or to any thing beyond the invention itself. Where a patent is taken for an improvement only, the public have a right to purchase that improvement by itself, without being encumbered with other things. A fire engine of any considerable size, I take it would cost about 1200*l*., and suppose the alteration made by the plaintiff, with a fair allowance for profit, would cost 50 or 100*l*. is it to be maintained, that all the persons who already have fire engines must be at the expense of buying new ones from the plaintiffs, or be excluded from the use of the improvement? So in the case of the watch, may not other persons in the trade buy the new movement, and work it up in watches made by themselves? Where men have neither fire engines nor watches, it is highly probable that they will go to the inventor of the last and best improvements for the whole machine; and if they do, it is an advantage which the inventor gets from the option of mankind, and not from any exclusive right or monopoly vested in him."[59]

[59] Boulton v. Bull, 2 H. Bl. 489.

A case came before Lord Ellenborough at nisi prius, on a patent for an improvement in making parasols and umbrellas, in which it was objected that the specification did not clearly direct how to make the article, and did not distinguish what was new. The specification professed to set out the improvements as specified in certain descriptions and drawings annexed. The subjoined description contained a minute detail of the construction of umbrellas and parasols, partly including the usual mode of stretching the silk of the umbrella, and also certain improvements, which consisted chiefly in the insertion of the stretchers, which were knobbed at the sockets formed in the whalebone, instead of attaching them to the whalebone in the usual way. Drawings were given of the umbrellas and parasols in their improved state; but throughout the whole specification no distinction was made between what was new and what was old. The counsel for the plaintiff contended that the specification was sufficient, since one of the annexed drawings contained a representation of the particular invention which had been pirated, and was confined to the exhibition of the insertion of the knobbed stretchers in the whalebone sockets, from which an artist would be able to construct an umbrella on the improved plan. Lord Ellenborough. "The patentee, in his specification, ought to inform the person who consults it, what is new and what is old. He should say, my improvement consists in

this, describing it by words, if he can, or, if not, by reference to figures. But here the improvement is neither described in words nor by figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. The specification states, that the improved instrument is made in manner following: this is not true, since the description comprises that which is old, as well as that which is new. Then it is said, that the patentee may put in aid the figures, but how can it be collected from the whole of these in what the improvement consists? The plaintiff was nonsuited."[60]

The objection was made to Brunton's patent for an improvement in the chain cable, that the patentee claimed the form of the link which was before in use, instead of claiming the mode of supporting it, which, in fact, was his invention. Best J. "I doubt whether this patent can be sustained, for the specification cannot stand as a description of a new combination of known principles; it claims an invention as to a part of it, which certainly is not new. I allude particularly to the form of the link. The specification states, that the object to be gained is the greatest possible strength from a given quantity of materials, keeping in mind the direction in which

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[60] McFarlane v. Price, 1 Stark. N. P. C. 199.

the strain is to be borne. It afterwards says, that this is to be done by the use of that which is new, viz. by the stay introduced between the links, and which, instead of entering them, embraces their sides. If that alone was to be done, it would be new; but the specification further goes on to say, "it is evident, that of all the forms and constructions that can be given to a link, that form and construction, which shall be able to convert a lateral into an end strain, by yielding support to the opposite sides of the link, is the one that should be preferred." It appears to me, that the patentee here first claims the merit of originally using the links in the particular form described in his specification, instead of circular links. Now there can be no doubt that links of that form had been used long before."[61]

Sec. VIII.—The Specification must direct how to make, and describe the best way known to the Inventor of making, the article.

The act of Congress of 1836, s. 7, following very closely that of 1793, s. 3, requires the inventor to describe his invention, in his specification, so as "to

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[61] Brunton v. Hawkes, 4 Barn. & Ald. 540. The French law does not require the new to be distinguished from the old, but M. Perpigna, Treatise on Patents, translated in the Law Library, p. 27, says, it would be better if it conformed to the English and American law in this respect.

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." This is only an express enactment of what has been the established construction of the English statute of-monopolies. And, following out the spirit and principle of this rule, the cases decide that the specification must not only direct how the thing patented is to be made, used, or compounded, but must also direct the most economical and advantageous materials, construction and method for this purpose, known to the inventor, and must not mislead the person who consults it. The patent law is founded on the principle of giving the public the full benefit of the invention, which it could not do, unless the best mode of using the invention were described. "The end and meaning of the specification," says Mr. Justice Buller, "is to teach the public, after the time for which the patent is granted, what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it. If the specification, in any part of it, be materially false or defective, the patent is against law and cannot be supported. If the specification be such that mechanical men of common understanding can comprehend it, to make a machine by it, it is sufficient; but then it must be such that persons skilled in the art or science to which the invention relates may be able to

make the machine by following the directions of the specification, without making any experiments, and without any new invention or addition of their own."[62]

Mr. Justice Story thus states the law on this subject. "The law confers an exclusive patent right on the inventor of any thing new, and useful, as an encouragement and reward for his ingenuity, and for the expense and labor attending the invention. But this monopoly is granted for a limited term only, at the expiration of which the invention becomes the property of the public. Unless, therefore, such a specification was made as would, at all events, enable other persons, of competent skill, to construct similar machines, the advantage to the public, which the act contemplates, would be entirely lost, and its principal object would be defeated. It is not necessary, however, that the specification should contain an explanation, level with the capacities of every person, (which would, perhaps, be impossible,) but, in the language of the act (of 1793), it should be expressed in such full, clear and exact terms, that a person skilled in the art or science of which it is a branch, would be enabled to construct the patented invention."[63]

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[62] The King v. Arkwright, Dav. Pat. Cas. 106. Per Ashurst, J. Turner v. Winter, 1 T. R. 606, and see remarks of Buller, J. in Boulton v. Bull, 2 H. Bl. 484.

[63] Lowell v. Lewis, 1 Mason R. 182, and see Langdon v. De Groot, 1 Paine's R. 203, which was a patent for folding thread, and one objec-

And so Lord Ellenborough says, "A specification should be sufficient to enable persons of *reasonably competent skill* in such matters, to construct the machine."[64]

It is enough if the specification is made clear by an examination of the drawings referred to in it.[65] Where it was objected that the dimensions of a stay of a link of a chain cable were not given in the written specification, Abbott C. J. said to the jury, "If a drawing or figure will enable a workman of competent skill to construct the improvement, it is as good as any written improvement."[66]

Mr. Justice Buller remarked, in an early case, that "wherever it appears that the patentee has made a fair disclosure, I have always had a strong bias in his favor, because, in that case, he is entitled to the protection which the law gives him; but where the discovery is not fully made, the court ought to look with a very watchful eye to prevent any imposition on the public;"[67] and Mr. Justice Gibbs says that "a patentee who has invented a machine useful to the public, and can construct it one way more

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tion stated by the court is that the specification did not describe the manner of folding.

[64] Harmar v. Playne, 11 East, 101.

[65] See infra, s. 9. Bloxam v. Elsee, 1 Carr. & P. 558. Earle v. Shaw, 4 Mass. R. 1. Fox ex parte, 1 Ves. & B. 67.

[66] Brunton v. Hawkes, Rep. of Com. of H. of Com. 1829, App. 206. Mr. Farey's Papers.

[67] Turner v. Winter, 1 T. R. 606.

extensive in its benefit than in another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends, yet he will not have satisfied the law by communicating, to the public, the most beneficial mode he was then possessed of, for exercising the privilege granted to him."[68]

A mistake or an incorrectness in what is not material, will not render the patent void.[69] It is enough that the specification is substantially full and accurate. This is distinctly implied by Abbott, C. J. in a case already cited.[70] It is no objection that a mistake is made by which nobody can suffer, that is, by which no person could be led into an infringement of the patent, without any such instruction on his part, while it is in force, and which will not prevent an artist from constructing the machine, by following the specification, after the patent has expired.

The rules above stated have been applied in a number of cases. In the specification of Arkwright's machine to prepare cotton, silk, flax and wool for spinning, he described all the parts of it as one

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[68] Bovill v. Moore, Dav. Pat. Cas. 361.

[69] The King v. Murray, Buller's N. P. 76, a.

[70] Bloxam v. Elsee, 6 B. & C. 169, supra 244; and other cases cited supra s. 3 and 5.

entire instrument. He did not state, as he should have done, that the hammer, in the front of it, was only to be used in preparing flax; and on this ground, among others, his patent was set aside.[71]

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[71] The King v. Arkwright, Dav. Pat. Cas. 117. See Godson Pat. 121; opinion of Ashurst in Turner v. Winter, 1 T. R. 606; Newbury v. James, 2 Meriv. 446; Hornblower v. Boulton, 8 T. R. 100.

Mr. Farey, in a note to the case of Arkwright, in the Appendix to the Report of the Committee of the House of Commons, 1829, p. 185, says, "The invention for which Mr. Arkwright took his two patents for spinning and preparing, have proved of immense value to the nation; they are universally employed for one great branch of cotton spinning, called twist, for strong hard cotton thread, and still remain nearly on the system that Mr. Arkwright himself established during the patents; also, when combined with the previous invention of Hargrave's spinning jenny, (which was done some years afterwards by Mr. Crumpton,) in what is called the mule, they form the other branch of cotton spinning for fine and soft yarn. The spinning of long wool and flax, and preparing of flax, (after the stages of combing and heckling,) are modifications of Arkwright's system; and also the preparing of short wool for woollen cloth, the spinning thereof being done by Hargrave's jennies. Of the three inventors of spinning, Hargrave, Arkwright and Crumpton, to whom the nation have owed so much, the first was persecuted, and died in the greatest poverty, amidst a population who were rising to opulence by his means. Arkwright possessed a vigor of mind to command, control and instruct working people, far beyond the *talent of a mere artist or inventor, and succeeded in realizing* a princely fortune by his manufactory; but his money was not gained by virtue of his invention; for the bulk of it was acquired after his patent was set aside; and others who had invented nothing, but merely copied what he did, made immense fortunes by spinning, as well as himself. Crumpton, whose combination of Hargrave's and Arkwright's inventions in the mule, has much more than doubled the national advantages conferred by his predecessors, was, like Hargrave, ruined in his circumstances, and languished in poverty during a long life, in the very town which had grown up from insignificance to wealthy importance by the practice of his invention. In 1812, his case reached the knowledge of Parliament, and £5000 reward was given him; but it came too late to have the effect of removing the established impression, that an inventor is almost certain to be ruined, even if his invention succeeds, and proves ever so valuable to others."

In an action for the infringement of a patent right for producing a yellow color for painting in oil or water, and making white lead, and separating the mineral alkali from common salt, it appeared that the specification commenced as follows: "Take any quantity of lead, and calcine it, or minium, or red lead, litharge lead, ash or any calx, or preparation of lead, fit for the purpose." At the trial, it was objected to the specification that, after directing that the lead should be calcined, it stated that minium might be used, which would not answer the purpose. Neither was it said that the minium should be calcined or fused; but if minium had any reference to the preceding words, then it was to be calcined, which would not produce the effect, fusion being necessary. Buller, J. said, that "it was not pretended by any of the plaintiff's witnesses that he ever made use of minium. And it was proved by the defendant's witnesses, that from the specification, they should be led to use minium, because minium is lead already calcined, which is what the specification directs in the first instance. But minium will not answer the purpose. Then as to fusion, it is said, that the public are directed, by the words of the specification, to continue the heat till the effect is produced; which must necessarily lead to fusion, though fusion is not expressly mentioned. But that is no answer to the objection; for the specification should have shown by what degree of heat the effect

was to be produced. Now it does not mention fusion, and, as one of the witnesses said, in order to produce the effect, you must go out of the patent; for fusion is beyond calcination, and in some sense contrary to it; and by mentioning calcination, it should seem that fusion was to be avoided. He was accordingly of opinion that on this ground the patent was void." Ashurst J. "The first objection to the specification is, that the public are directed 'to take any quantity of lead, and calcine it, or minium, or red lead;' from whence it is inferred that *calcining* is only to be applied to *lead;* I confess, if the objection had rested here, I should have entertained some doubt."[72]

The same specification proceeded as follows: To any given quantity of the above-mentioned materials, add half the weight of sea salt. with a sufficient quantity of water to dissolve it, or rock salt, or sal gem, or fossil salt, or any marine salt, or salt water proper for the purpose. It was objected that fossil salt was improperly mentioned. For fossil salt is a generic term, including all mineral salts, only one of which, *sal gem*, would answer the purpose; because that alone has marine acid. Ashurst J. "I understand that sal gem is the only one which can be applied to this purpose; so that throwing in

[72] Turner v. Winter, 1 T. R. 602.

fossit salt can only be calculated to raise doubts and mislead the public. That word could not have been added with any good view; it must produce many unnecessary experiments; therefore, in that respect, the specification is not so accurate as it should have been." The patent was held to be void.[73]

In the same case, Buller, J. said, that "if the patentee could only make the color with two or three of the ingredients specified, and he has inserted others in the specification which will not answer the purpose, that will avoid the patent. If the patentee makes the article for which the patent is granted, *with cheaper materials* than those which he has enumerated in the specification, although the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit from it which he himself does."[74]

So Mr. Chief Justice Gibbs says, "A person who applies for a patent, and proposes a mode of carrying on the invention in the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labor as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same

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[73] Turner v. Winter, 1 T. R. 602.
[74] Turner v. Winter, 1 T. R. 607.

way, and with the same advantages. If any thing which gives an advantageous operation to the thing invented, be concealed, the specification is void."[75]

A patent was granted for a new mode of making verdigris. The patentee was accustomed, during the process of the manufacture, clandestinely to introduce *aqua fortis* into the boiler, by means of which a more rapid solution of the copper was produced. This was not stated in the specification. Gibbs C. J. "Although the specification should enable a person to make verdigris substantially as good without *aqua fortis* as with it; still, inasmuch as it would be made with more labor by the omission of *aqua fortis*, it is a prejudicial concealment, and a breach of the terms which the patentee makes with the public. If it is proved that *aqua fortis* was used by the inventor as an ingredient, the patent is void."[76]

A patent was obtained for a new method of drying and preparing malt. It was objected that the patent was void, because it appeared from the specification, that it was merely a method of giving to malt, previously prepared, the qualities of being soluble in water and coloring the liquor in which it should be dissolved, which was accomplished by the application of a high degree of heat. Abbott C. J. "It

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[75] Wood v. Zimmer, Holt's N. P. C. 58.
[76] Wood v. Zimmor, Holt's N. P. C. 58

was argued that the term, *malt*, is applied to the grain as soon as it has germinated by the effect of moisture, and before it has been dried; that malt in that state might be taken and used for the objects of the invention; and that, as these were to be accomplished by heat, it was an invention for drying malt. But if this were so, then the specification would be defective in not informing the reader, that the malt to be used for the intended object might or ought to be taken in that state, and in leaving him to discover by experiment whether it should be taken in that state, or after drying, which, according to the most common use of the word *malt*, he might very reasonably suppose."[77]

On the subject of the patentee's describing the best way of practising the art or making the article patented, the English jurisprudence presents one rule which is not applicable in ours. As the inventor is, in England, allowed a certain time after the grant of the patent to enrol his specification, and as during that time he may make new discoveries and improvements, he is required to describe in his specification, not merely the best method known to him at the time of taking out the patent, but he must include also all his subsequent discoveries and improvements, down to the time of specifying.[78] In

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[77] King v. Wheeler. 2 Barn. & Ald. 353.

[78] Crossley v. Beverly, 9 Barn. & Cress. 63. In stating this doc-

the United States, as the specification is drawn up before the patent is made out, the above rule is not applicable.[79]

Sec. IX.—Reference in the Specification to Drawings.

The third section of the act of Congress of 1793, after prescribing the requisites of the specification, provides that the inventor shall accompany it "with drawings and written references, where the nature of the case admits of drawings." The act of 1836, s. 6, contains the same provision, correcting the phraseology merely by saying "drawing or drawings," which does not alter the construction.

The drawings are a part of the specification where they are referred to in it,[80] "and may help and make good a specification which would otherwise be defective."[81]

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trine, Lord Tenterden remarks that time is given for enrolling the specification, for the purpose of allowing the inventor an opportunity to perfect his invention.

[79] "Near the end of the reign of Queen Anne, it became the custom to insert a proviso into all patents to require the patentee to execute a complete specification of the invention for which the patent was granted, and also to enroll the same in the court of chancery within a specified time. Before that time the patentee was not called upon for any specification." Mr. Savery's patent of 1698, for some kind of fire engine, had no such clause. Rep. of Com. of House of Com. 1829, App. p. 170. Mr. Farey's Papers.

[80] Earle v. Sawyer, 4 Mass. R. 1. See supra c. 10.

[81] Kent's Com. v. 2, p. 270.

The English and American jurisprudence coincide in this doctrine. Where it was, in 1825, objected to a specification that there was some little obscurity in it, and that it contained French terms, Abbott C. J. said, that "the inventor of a machine was not tied down to make such a specification, as, by words only, would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."[82]

So in a previous trial, in 1820, on Brunton's patent for chain cable's anchors and windlasses, where it was objected that the dimenions of the stay of the link were not described in words, Abbott, C. J. said to the jury, "If a drawing or figure will enable a workman of competent skill to construct the improvement, it is as good as any written description."[83]

So Lord Ellenborough, in 1816, said to the jury, on the subject of distinguishing what was claimed; "The inventor should say, 'My improvement consists in this,' describing it in words if he can, if not, by reference to figures."[84]

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[82] Bloxam v. Elsee, 1 Carr. & P. 558.

[83] Brunton v. Hawkes and another. Rep. of Comm. of House of Com. 1829, p. 206. App. Mr. Farey's notes.

[84] Macfarlane v. Price, 1 Stark. R. 199.

Lord Eldon says, the inventor may, if he chooses, annex to his specification a picture or model descriptive of it; but then, he adds, what is inconsistent with the opinion of other English judges above cited, and what is clearly not law in the United States; "his specification must be in itself sufficient, or I apprehend it will be bad."[85]

In Earle v. Sawyer,[86] Mr. Justice Story said, "it was argued, that, by the very terms of the patent act, there must be a *written* description (without any reference to drawings) in such full, clear and exact terms, as to distinguish the things patented from all other things; and that, in case of a machine, the act requires drawings in addition thereto. For this position, the case of Fox ex parte,[87] before Lord Eldon, has been cited. As I understand the language of Lord Eldon, it is not intended to assert the doctrine for which it is cited. It means that the specification must in itself be sufficient, and that the mere annexation of a picture or model will not help any defect in the specification. This may be true, where such picture or model is not referred to, as constituting a part of the specification itself. But if the explanations of the specification call for the drawings, and refer to them as a component part in

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[85] Fox ex parte, 1 Ves. & B. 67.

[86] 4 Mason, 9.

[87] 1 Ves. & B. 67.

the description, they are just as much a part of the specification, as if they were placed in the body of the specification. Indeed, in many cases, it would be impracticable to give a full and accurate description of the form, adjustments and apparatus of very nice and delicate machinery, without drawings of some of the parts, as every thing might depend on size, position and peculiar shape. Lord Eldon could not have meant, that if drawings and figures were necessary to a full description of a machine in the specification, there was still some stubborn rule of law prohibiting it. That would be to require the end and yet to refuse the means."

"The question must, after all, be decided by our own law on this subject. The st. 1793, c. 156, § 3, requires that the inventor "shall deliver a written description of his invention, &c.; *and he shall accompany the whole with drawings and written references*, where the nature of the case admits of drawings," &c. This is an explicit direction to annex drawings, where the nature of the case admits of them, with *written* references; and when so annexed, they become part of the *written* description required by the act. They may be indispensable to distinguish the thing patented from other things before known. Surely then the act could not intend studiously to exclude them as part of the written description. That would be to require the end and deny the means."

It was held by the King's Bench, in England, that a specification in a former patent might be referred to in a subsequent one, so as to be made a part of it.[88]

But specimens and models, deposited in the patent office, cannot be resorted to for the purpose of supplying any defect in the specification.

Sec. X.—Consequences of a Defect in the Specification.

Before the British act of 5 and 6 Wm. IV. c. 83, (1835,) the consequence of a defect in the specification, in England, was an absolute loss of the privilege of the patent right. By the first section of that act, the patentee or his assignee "may, with the leave of the attorney or solicitor general, enter a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave, enter a memorandum of any alteration in the said title or specification, not being such disclaimer, or such alteration as shall extend the exclusive right granted by the patent;" and such disclaimer or memorandum is thereafter to be considered a part of the title or specification.[89]

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[88] Harmar v. Playne, 10 East, 101. Supra, s. 7, p. 270.

[89] This act was introduced by Lord Brougham, and is the result of

In the early American cases, after the act of 1793, it appears to have been supposed that the law had by that act been varied from the English; so that the patent right was forfeited and lost, only in case of the defects specified in the 6th section being designed and fraudulent. It is provided by that section that, in a case for an infringement, the defendant may give in evidence, in his defence, "that the specification 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."

Mr. Justice Story, in giving an opinion in the Circuit Court, in 1813, on an examination of this section, remarked: "We think that the manifest intention of the legislature was not to allow any defect or concealment in a specification to avoid the patent, unless it arose from an intention to deceive the public."[89]

In the same year, Mr. Justice Washington, instructing the jury in the Circuit Court of the United States for Pennsylvania, said on the subject of concealment, "the matters not disclosed must appear

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the examinations made by the committee of the House of Commons, in 1829, and remedies some of the most material defects of the English law as it stood before.

[90] Whittemore v. Cutter, 1 Gall. R. 429.

to have been concealed for the purpose of deceiving the public, in order to invalidate the patent."[91]

In 1817, again, these judges appear still to have entertained the same opinion.[92] But it was, at the same time, remarked by Mr. Justice Story, that the doctrine was liable to grave objections on the score of expediency.[93] And it was subsequently abandoned and the English doctrine adopted, that a defect in the specification, from want of compliance with the requisitions of the third section of the act of 1793, rendered the patent void; but that, if the defect arose from mistake, a new patent could be taken out for the unexpired part of the term. In this respect our law, on this subject, differed from the English.

This doctrine, as to the surrender and renewal of the patent, was suggested by Mr. Justice Thompson in a case that came before him in 1824, in which he remarked, "I see no insuperable objection to entering a *vacatur* of the patent of record in the department of state, if taken out inadvertently and by mistake. All the proceedings in that department, on the subject of patents, are *ex parte*, except in the case of interfering applications. The department

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[91] Park v. Little & Wood, 3 Wash. C. C. R. 196.

[92] Lowell v. Lewis, 1 Mass. R. 182. Gray and Osgood v. James and others, 1 Pet. C. C. R. 401, 402.

[93] Whittemore v. Cutter, 1 Gall. R. 429.

act rather ministerially than judicially, and upon the representation of the applicant, without entering into the question of right, and there seems to be no good reason why, on a like *ex parte* application, the patent may not be surrendered, and cancelled of record, if no misconduct be imputable to the patentee in taking it out. And in such case, as the exclusive right is not to exceed fourteen years, the second patent may be limited according to circumstances, and thereby secure, both to the patentee and the public, their respective rights."[94]

This doctrine was afterwards distinctly adopted by the Supreme Court.[95]

In confirmation of the construction thus given to the patent law of 1793, the fifth section of the additional law of 1832 was passed, by which it is enacted that "whenever any patent shall be invalid or inoperative, by reason that any of the terms and conditions prescribed in the third section in the said act (of 1793) 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 one to be granted to the said inventor,

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[94] Morris v. Huntington, 1 Paine, 355.

[95] Townsend and Grant v. Raymond, 6 Pet. S. C. R. 220. Shaw v. Cooper, 7 Pet. S. C. R. 292.

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 said act."

The law was thus put upon a liberal footing in respect to patentees, and the act of 1836, section 13, makes a similar provision. It provides, that, "whenever any patent 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 of the original patent, a similar right shall vest in his executors, administrators or assigns. And the patent so waived, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all

actions thereafter, for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the suing out of the original patent."

CHAPTER XII.

Signing of the Specification. Attestation. Oath. Delivery of Drawings, Models and Specimens. Petition. Fees.

Sec. 1. *Signing of the Specification. Attestation.*
2. *The Oath.*
3. *Delivery of Drawings, Models and Specimens.*
4. *The Petition.*
5. *Payment of the Fee.*

Sec. I.—Signing of the Specification. Attestation.

The third section of the act of 1793 required that the specification should be signed by the inventor and attested by two witnesses. The act of 1836 makes a slight alteration by providing, section 6, "that the descriptions *and drawings*, signed by the inventor and attested by two witnesses, shall be filed in the patent office." The former act said

nothing of the drawings being signed by the appli cant; but the signing of the specification referring to the drawings is in effect attesting the latter. Whether a distinct signature will be required under this law remains to be decided. None of the acts on this subject have required the applicant to affix a seal to the specification.

Sec. II.—The Oath.

It seems to be reasonable that a patent should not be granted except upon probable grounds of a right. The law of 1793, therefore, required that the applicant, "before he could receive a patent, should swear or affirm that he did verily believe that he was the true inventor or discoverer of the art, machine or improvement for which he solicited a patent, which oath or affirmation might be made before any person authorized to administer oaths." The substituted law of 1836, section 6, varies a little from the former law on this subject. It provides that "the applicant shall 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; which oath or affirmation may be made before any person authorized by law

to administer oaths." The phrase, "*original* and *first inventor*," is substituted for that of true inventor in the act of 1793. That part of the oath relating to the invention being ever before known or used, is added, and not superfluously, for it often happens that a man truly invents a machine, and then finds out that some one had previously invented the same machine. The last part, stating of what country the applicant is, was also added, the purpose, under the law of 1836, being to determine the fee to be paid. Under the former law the citizenship of the applicant was material, for unless he was a citizen of the United States or resident for two years, he could not take out a patent. But it did not intimate what proof of either fact was to be given. It was a frequent practice to insert the fact of citizenship or residence in the affidavit. We observe that this oath is not absolute, that the applicant *is* the original inventor; he is required to swear that he verily *believes* himself to be such; for though he may positively *know* whether he invented the machine, he cannot know certainly whether he is the *original* and first inventor.

The law of 1836, s. 15, provides "that whenever it shall satisfactorily appear that the patentee, at the time of making his application for a 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 been patented or described in any public work."

This is an alteration of the law on the subject of the novelty of the invention, of some importance; but it does not affect the oath, since, notwithstanding this provision, the applicant must, at the time of making his application, believe himself to be the first inventor. If, before making his application, he learns that the thing had been already invented and used abroad, though not patented or described in any printed publication, he cannot take the oath; but if he learns it subsequently, it seems that, according to the above section, this will not invalidate his patent.

The provision as to the oath is in the alternative, that is, that the applicant is the inventor *or* discover; and this suggests the question whether the petitioner must make oath, in the words of the law, that he believes himself to be the inventor *or* discoverer, or to use one of those terms only, which he considers to be most applicable; for though both words may be applicable to some patentable subjects, only one of them is so to others, since it would be absurd to describe one as being the discoverer of a new threshing machine or loom, though, in regard to compositions of matter, the word *discovery* is, perhaps, generally the more applicable. As we cannot

suppose the law to intend to insist rigidly on the abuse of words, the more reasonable construction is, that the applicant may use both or either of the words in his oath, as he may suppose one or the other only, or both of them, to be appropriate.

In an action for the violation of a patent right, it appeared that the oath taken by the patentee was, that he was the true "inventor or *improver* of the machine." It was held, by Mr. Justice Story, that the oath taken by the inventor not being conformable to the statute, formed no objection to a recovery in the action. "The taking of the oath was but a prerequisite to the granting of the patent, and in no degree essential to its validity."[1] According to this decision, therefore, the form of the oath is not of great importance, for if the commissioner of patents objects to it, the inaccuracy is corrected at once; if no objection is made and the patent is granted, its validity will not be affected by any inaccuracy in the form of the oath.

The form of the oath in England differs from ours only by inserting the allegation that the inventor, "after considerable application and expense, hath invented," &c. and "which invention, he believes, will be of general benefit and advantage." It does not allege the citizenship of the applicant. The

[1] Whittemore v. Cutter, 1 Gallison, 429.

omission of the first of these allegations, in the American form, is evidently an improvement; since it is immaterial whether the inventor made the invention after considerable application and expense, or by mere accident, and without any application and expense at all. The other allegation, of a belief that the invention will be of general benefit and advantage, seems to be superfluous, though inventors make it, no doubt, very readily and conscientiously.

Sec. III.—Delivery of Drawings, Models and Specimens.

By the law of 1836, s. 6, the specification must be accompanied with a drawing or drawings and written references, where the nature of the case admits of drawings, and with specimens of ingredients and of the composition of matter, sufficient in quantity for the purpose of experiments, where the invention or discovery is of a composition of matter. The law of 1793, s. 3, was substantially the same.

The same section of the law of 1836 requires that the inventor shall furnish a model of his invention, in all cases which admit of representation by model, of a convenient size to exhibit advantageously its several parts. This is a variation from the former act of 1793, s. 3, which required a model, "pro-

vided the secretary should deem such model to be necessary."

Sec. IV.—The Petition.

By the act of 1836, section 6, "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."

The provisions of the act of 1793, s. 1, on this subject were not literally the same, though they were substantially,[2] for the above section is merely an expression of the construction already put upon the former act, excepting that part which directs the application to be addressed to the commissioner of patents instead of the secretary of state.

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[2] See exposition of the act of 1793, by Mr. Justice Story, supra, pp. 156, 157.

Sec. V.—The Fee.

A patent is, as we have seen, a reward for a meritorious consideration, and a grant for a valuable one,[3] and the laws by which provision is made for granting these monopolies are founded on a public policy peculiar to useful inventions and discoveries. The practice of selling monopolies, or granting them, except on these grounds, was expressly abolished in England by the statute of 21 James I. c. 3, and is inconsistent with the sound principles of legislation, as at present very generally admitted. It is not consistent with those principles to demand any price in money from an inventor, as the whole or a part of the consideration for the exclusive privilege granted to him. And yet it is not a little remarkable that in both England and France the sum paid by the inventor is considered to be in part the *price* of his privilege, and is frequently so represented by the persons examined before the committee of the House of Commons in 1829.

The patent laws of the United States are more in conformity with the principles above stated. The law of 1836, section 9, provides "that before any application for a patent shall be considered by the commissioner, the applicant shall pay into the

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[3] Ch. I.

treasury of the United States, or into any of the deposite 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. 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, and all other expenses of the patent office."

One reason of the distinction between the fees paid by Americans and foreigners is, I presume, the greater fees paid for patents abroad, and the amount demanded of a subject of Great Britain is greater than that demanded of other foreigners, because a greater sum is demanded in England than in other foreign countries. Another motive may be to prevent patents being taken out by foreigners for inconsiderable inventions.

The fee is graduated upon the principle of merely defraying the expenses of the patent office out of the contributions made by the patentees. This is the utmost extent to which the exaction can be justified, and it is questionable whether it ought not to stop short of this. The granting of patents is a matter in which the public has as great an interest

on one side, as patentees have on the other; and if the latter are required to defray one half of the expense of clerk hire and other expenses incidental to the executive administration of these laws, it is quite their full proportion, especially since they are put to the expense of models to be deposited in the patent office, merely for the public benefit, and not at all for their own. This fee, as fixed by the law, is not a material obstacle to the beneficial operation of the patent laws.[4]

The exactions in France are higher, being divided into a tax (*taxe*) and expenses (*frais*), the latter being between nine and ten dollars, (fifty francs.) The tax varies with the duration of the monopoly, and thus, as well as by the name, countenances the construction that it is in part the *price* of the monopoly. For a patent for five years it is three hundred francs, for ten, eight hundred, and for fifteen, fifteen hundred; an amount sufficient to be a material obstacle in the way of the beneficial operation of

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[4] As small as the fee is in the United States, the committee of Congress who reported the law of 1836, stated that the surplus accruing from this fee is 152,000 dollars. The same committee report that the average annual number of patents issued from 1790 to 1800 was 26; from 1800 to 1810, 91; from 1810 to 1820, 200; and during the last ten years preceding the time of making the report, 535; and that the number in 1835 was 776; and that the whole number issued at the patent office up to March 31st, 1836, was 9,731, being more than double the number issued in France or England during the same period.

the provisions of the law intended for the encouragement of inventive genius.[5]

The discouragement interposed by the exactions under the English patent law is still more oppressive, the expense of obtaining a patent for England being about six hundred and ten dollars; for England and Scotland, ten hundred and sixty-five dollars; for England, Scotland and Ireland, seventeen hundred and fifty dollars.[6] This large tax has contributed materially to diminish the usefulness of the English patent law.[7] It ought to be kept in mind by legislators that the persons most likely to make mechanical inventions, and to whom, in fact, the public is mostly indebted for them, are generally not able to bear heavy pecuniary burthens. The consequence of imposing such burthens is, that they often entirely lose the fruits of their ingenuity by not being able to take out patents, or are obliged to throw a greater part of them into the hands of persons of wealth, to whom they are under the necessity of resorting to make the advances necessary for securing the privilege.

If it be alleged in justification of these exactions, that they discourage applications for patents for

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[5] The annual revenue from patents in France was stated by M. Renouard, in 1825, to be about 15,000 dollars. C. 3. § 3. p. 162.

[6] Report of Com. of House of Com. 1829, App.

[7] Kent's Comm. v. 2, p. 270.

frivolous inventions, it may be replied that a much smaller tax would be amply sufficient for this purpose. But, in truth, this is no justification; first, because frivolous patents are of no public injury, and, secondly, because the burthen weighs very unequally, being a slight obstacle to a wealthy individual or company, but an absolute prohibition to a mechanic without capital.

CHAPTER XIII.

Proceedings in issuing Patents.

Sec. 1. *Authority of the Commissioner of Patents.*
2. *Appeal to Examiners.*
3. *Conflicting Applications.*
4. *Signature.*
5. *Recording.*

Sec. I.—Authority of the Commissioner of Patents.

By the act of 1793, it was made the duty of the secretary of state to cause patents to be issued, the patent being submitted to the attorney general, and by him certified to be made out in conformity to the law, before being signed by the President. The law

of 1836 has assigned the duty of superintending the issuing of patents to the commissioner of patents. The seventh section of that law provides, that on an application being made for a patent, and a specification filed, and the fee paid, "the commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if on such examination it shall appear 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 sufficiently 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 waiving 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 of such intention in the patent office."

According to the phraseology of the statute of 1793, by which Mr. Justice Story suggests that the intention may have been to prevent insufficient specifications,[1] the secretary of state and attorney general appear to have been invested with a discretionary authority on the subject of issuing patents; but that act did not prescribe the particular questions upon which it was the duty of one or the other of these officers to decide. It was provided that on application, "it should be lawful for the secretary to cause letters patent to be made out," which should be "delivered to the attorney general to be examined, who, if he found the same conformable to that act, should certify accordingly." The law accordingly admitted of the construction that it was left to the discretion of the secretary of state whether to cause the patent to be made out,[2] and the attorney general, if he found the patent in any respect not conformable to law, might withhold his certificate,

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[1] Whittemore v. Cutter, 1 Gall. 429.

[2] See Whittemore v. Cutter, 1 Gall. R. 429.

and thus prevent the issuing of the patent.[3] But, in practice, neither of those officers ever undertook to form any opinion of the originality, novelty, importance, or usefulness of the invention, or the sufficiency of the specification. The agency of those officers in issuing patents was considered to be merely ministerial. French patents contain an express provision that the government does not, by issuing the patent, intend to guaranty the novelty or usefulness of the invention; though an examination is made of the specification and drawings. In England, the agency of the attorney general, in regard to the issuing of patents, is considered to be merely ministerial.[4] In one respect, however, a discretion is exercised in England by the attorney general, in the issuing of patents, namely, in determining the time within which the specification is to be filed. A compliance with the terms of the patent, in this particular, is considered to be material to its validity, but no other point is predetermined which affects the validity of the patent.

It is evident that the judgment of any officer of the government, on the novelty and originality and utility of the invention, and the sufficiency of the

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[3] It has been suggested that the attorney general could not be supposed to examine every specification critically. *North Am. Rev. v. 23,* p. 302.

[4] Grant *v.* Raymond, 6 Pet. S. C. R. 241.

specification, must be formed upon very superficial grounds. In the United States, for instance, the commissioner must pass upon from two to three patents in a day upon an average; a time scarcely sufficient to enable him to understand the specification, supposing him to have some previous knowledge of the subject of the invention. He cannot, therefore, be expected to reject the application except in a very plain case.

Sec. II.—Appeal to Examiners.

The law of 1793 made no provision for an appeal from the decision of the secretary of state rejecting a claim for a patent, and in practice, as we have seen, no claim was rejected. The only particular provision for any preliminary decision on the claim, was by the ninth section, relating to conflicting claims. The act of 1836, section 9, goes on to provide for an appeal from the decision of the commissioner. If the applicant, in case of a decision by the commissioner against him, "shall persist in his claim for a patent, with or without any alteration of the specification, he shall be required to make oath or affirmation anew," as at the time of his application. "And if the specification 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 deci-

sion 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 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 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 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 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 further proceedings to be had on such application." The

applicant is to pay twenty-five dollars towards the expenses of this examination, and the examiners are to receive not exceeding ten dollars each for their services.

The small compensation fixed for these examiners will evidently prevent the constitution of a competent board and a thorough investigation; for a common laborer, supposing him to be competent, could hardly, at this rate of compensation, afford the time for an investigation of such a case. The rate of compensation fixed upon shows that only a very hasty and superficial trial is intended by the statute; and accordingly that it is not intended that the board shall reject the claim except in a very plain case. And this is all that is expedient, for a thorough trial before a competent tribunal would be exceedingly expensive—as much so as that of patent cases ordinarily—and after all not very satisfactory. To produce a full and thorough investigation of a patent case, presenting questions no more complicated and difficult than are met with in such cases generally, it is necessary not only to have a very able tribunal, but also all the evidence bearing upon the question, which can be collected by the activity and sagacity of opposing parties spurred on by conflicting interests and other excitements, together with the suggestions and arguments of acute and learned advocates. The proceedings provided for by this statute do not prevent such a trial subsequently, if the patent be grant-

ed; for it would be against all analogy that others should be bound by proceedings of which they had no notice. The decision of the board against the applicant is final, since his patent is denied; but if it is in favor of a grant of the patent, he still stands upon the same ground as if no preliminary trial had taken place, except the weight, more or less, of the decision of the examiners; for any one may infringe his patent right and dispute its validity in an action brought by the patentee for the infringement. The examiners, then, will very naturally lean in favor of the applicant, and give him the advantage of all doubts, and all presumptions that can be made in his favor, since this course can work no material injury; whereas, by adopting a different one, a great and irreparable wrong might be done. In this view and with such a course of proceeding, this provision may be very useful in preventing the issuing of patents to which the applicants have no colorable ground of claim.

Sec. III.—Conflicting Applications.

The subject of the preceding section is a conflict between the claim of the patentee and the supposed rights of the whole community. The next inquiry relates to an interference of the claim of the applicant with that of other individuals for the same exclusive privilege. The questions do not exclude

each other, since two several applicants might apply for a patent which the commissioner might be of opinion ought not to be granted at all, and the questions would then be whether it ought to be granted at all, and, if so, which has a good claim for it.

On the subject of interfering claims, the law of 1793, section 9, provided for an arbitration, one arbitrator to be appointed by each applicant, and the third by the secretary of state. The award of the arbitrators was held not to be conclusive upon any question excepting that of issuing the patent.[5] The act of 1836, section 8, provides for the case of interfering applications, and also that of an application interfering with an unexpired patent. "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 other 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 the priority of right, or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions

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[5] Stearns v. Barrett, 1 Mason's R. 153.

as are provided," in case of a rejection of an application in other cases, "and the like proceedings shall be had to determine which or whether either of the applicants shall be entitled to a patent as prayed for."

But in this case the decision of the examiners is not final, as it is in that of the rejection of a claim where there are not opposing parties. By the sixteenth section of the same act of 1836, "Whenever there shall be two interfering patents, or when 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 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 whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent, or the inventions patented, and may also adjudge that such applicant is entitled, according to the provisions and principles 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 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 action and those deriving title from or under them subsequent to the rendition of such judgment."

Under this section all cases of applications interfering with unexpired patents, and of patents interfering with each other, are made subject to judicial investigation by bill in equity. If either party is interested exclusively in a patent applied for or granted, only in respect to a particular district, the decision is binding only co-extensively with such a district. In case an assignee of an unexpired patent for a district, opposes the grant of a patent, and the court decides in favor of the grant, the validity of the patent is thereby established, it should seem, as between the parties and their assigns in respect to such district, though it is open to dispute in any other; and so it may be open to be disputed in that district by any one not a party to the proceeding in equity. It is possible, accordingly, that contrary decisions may be given in different districts between different parties interested in the same patents, and this fact is not the ground of any objection to this

provision of the law; since any provision which would be binding upon others than parties to the proceedings, would open a door to collusive suits. And as to inconsistencies of decisions in different districts on the same patent, it is evident that different decisions in reference to the same patent in different districts may be made, without any inconsistency in the verdicts or adjudications, since each verdict and adjudication must be determined by the evidence given in each case, and this may be such as to show the validity of the patent in one district, and its invalidity in another.

Sec. IV.—Signature.

Under the law of 1793, s. 1, patents were signed by the president. As the signing is a mere ministerial act, the responsibility as to granting the patent having been formerly with the secretary of state and attorney general, and being, under the act of 1836, with the commissioner of patents, there seems to be no particular propriety in assigning the duty of signing patents to the president; for considering it to be a grant, Congress may authorize any officer or person to execute the document by which it is made. The English patents are signed by the king, which was probably the precedent followed in the act of 1793 in assigning the same duty to the president. It does not appear that the same inconvenience has

been experienced in the United States as in England in obtaining the signature. From the testimony given before the committee of the House of Commons, in 1829, it seems that patents are often delayed for the royal sign-manual on account of the sickness of the king, or other hindrance. It is represented by the witnesses that despatch in obtaining the patent depends very much upon the vigilance and activity of the applicant; they say it is a race between different applicants. No complaint of delay on this score has been made in the United States, and despatch has not been of the same importance here as in England, where the validity of the patent, on the score of the novelty of the invention, or the precedence of one patent to another, often depends on despatch in getting the application through the offices, whereas in the United States the delay of the signature does not affect the patent right, since, as has been already stated, the inventor is not ousted of his right if he himself is guilty of no neglect, though twenty persons, getting some knowledge of his invention, should hasten to pirate it.

As the president has many important duties, it seems to be expedient that the duty of signing patents should be assigned to some other officer, not to relieve applicants from any embarrassment, occasioned to them in consequence of this duty belonging to the president, but for the more convenient official despatch of this branch of the administration

of the laws. The act of 1836, s. 5, accordingly provides that patents issued from the patent 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 said office." The certificate of the attorney general is dispensed with by this act.

Sec. V.—Recording.

It is provided by the act of 1836, s. 5, that "patents shall be recorded together with the descriptions, specifications and drawings, in said [patent] office in books to be kept for that purpose."[6]

The recording is in effect the publication of the patent, including the specification. In England, as we have seen, the patent is issued before the specification is filed. The patent gives only a very general description of the subject; from which the public can hardly have notice of the invention, and artists are not thereby enabled to avail themselves of it. The enrollment of the specification is there required by the patent to be made within a certain

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[6] It has been suggested that under the law of 1793 it was contrary to law to issue the patent before it was recorded, though it was said to be a frequent practice so to issue patents. North Am. Rev. v. 23, p. 302. The act of 1836, by a change of phraseology, seems to avoid any objection to the validity of the patent on this score

time, varying in different patents from one to six months, or longer.[7] The English courts are very strict in requiring a compliance with the condition as to enrollment,[8] and held that, except by act of parliament, it cannot be dispensed with.[9]

CHAPTER XIV.

Duration, Surrender, Renewal and Prolongation of Palents.

The act of Congress of 1836, s. 5, following that of 1793, s. 1, provides that the commissioner of patents may make out letters-patent granting to the petitioner or petitioners therefor, his, her, or their administrators, executors or assigns, "*for a term not exceeding fourteen years*, the full and exclusive right

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[7] Heathcote ex parte Rep. of Arts, Second Series, v. 29, p. 252. Westm. Rev. Jan., 1835, Foster's Am. Ed. p. 102; Watson v. Pears, 2 Camp. 294; Castle v. Burditt, 3 T. R. 623; Glassington v. Rawlins, 3 East, 407.

[8] Ex parte Beck, 1 Bro. C. C. 578.

[9] Koops ex parte, 6 Ves. 599. But of all the patents granted during the reign of Geo. 3, down to 1816, being 3256, it has been stated that parliament had not dispensed with the enrollment of the specification, in more than two or three instances. Rep. of Arts, Second Series, v. 29, p. 253, 319.

and liberty of making, using, and vending to others to be used, the said invention or discovery."

The clause, "*not exceeding fourteen years*," is the same that is used in the sixth section of the English statute of monopolies. Mr. Godson construes that clause in the English act, to leave it optional with the king, when he sees occasion, to grant a patent for less than fourteen years.[1]

Though the phraseology of the act of Congress is not literally inconsistent with the construction that the commissioner may exercise a discretion as to the period for which the patent is granted, yet in practice, under the similar provision of the statute of 1793, authorizing the secretary of state to cause patents to be issued, the inventor, if he brings himself within the terms of the law as to the originality, importance and utility of his invention, and takes the requisite steps to obtain a patent, has been considered to be entitled to a grant of a patent for the full term of fourteen years, excepting in the case of the surrender and renewal of the patent, in which case the new patent is only for the unexpired part of the term for which the original patent was granted. The only case then, in which the patent would be granted for a less term, would be that of an application to that effect, an application not likely to be

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[1] C. 7. p. 161.

made, as there is not, by our law as by that of France, a difference of fee or tax, according to the length of the period of the exclusive privilege.

Where the first patent is void through mistake or inadvertence in drawing up the specification, a new one may be taken out for the unexpired part of the period of fourteen years.[2] It has heretofore been a frequent practice in England and the United States, to apply to the legislative authority for the prolongation of the term of the patent. The usual reason alleged for such an application is that the patentee has not been reimbursed his expenses, or has not reaped the advantages to which he is fairly entitled from his invention. By a standing rule of the House of Lords, applications for confirming or prolonging the term of patents are required to be made only at a session of parliament, commencing within two years before the expiration of the original term; and by another rule such applications are to be entertained only when made by the original inventor or his personal representatives.[3] By the terms of the grant of a prolonged term the patent is still made subject to all the objections to which it was liable before such prolongation.[4]

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[2] Supra, ch. XI. s. 10, act of 1836. Grant v. Raymond, 6 Pet. S. C. R. 218. Ames v. Howard, 1 Sumner's Rep. 482.

[3] Dwarris on Statutes, 358.

[4] Gods. Pat 158. Hesse v. Stevenson, 3 Bos. & Pul. 565.

By the second section of the additional act of Congress, passed on the 3d of July, 1833, it was provided that application to Congress to prolong or renew the term of a patent, should be made before its expiration, and should be notified at least once a month, for three months before its presentation, in two newspapers in which the laws of the United States were published in the State or territory in which the patentee resided; and that the petition should set forth particularly the grounds of the application; and should be verified by oath, should be accompanied by a statement of the ascertained value of the invention, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

This law was enacted to prevent the recurrence of a case like that of the renewal of Oliver Evans's patent for his hopperboy so long after the expiration of the original term, that others had, after its expiration, erected hopperboys, the use of which, it was held, was stopped by the renewal of the patent.[5]

But the law of 1836, sect. 18, makes a new provision on this subject, that a patentee may make application to the commissioner in writing for the extension of his patent, setting forth the grounds of his application, and on payment of forty dollars into the

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[5] Supra.

treasury by the patentee, the commissioner shal cause the application to be published in one or more of the principal papers in Washington, and such other papers as he may deem proper, published in the section of the country most interested against the extension of the patent, with notice of the time and place of considering the application, that any person may appear and show cause why the extension should not be granted. And the secretary of state, the commissioner of patents, and the solicitor of the treasury, shall constitute a board to determine on the application, on hearing the evidence for and against the same, to which board the patentee must produce a statement in writing under oath of the expenditures for and value and profits of the invention. And if the board shall be satisfied that the patentee, without his fault or neglect, has failed to obtain, from the use and sale of the invention, a reasonable remuneration for the time, ingenuity and expense bestowed on the same, and the introduction thereof into use, and that the term should be extended, it shall be the duty of the commissioner to extend the patent for the additional term of seven years, by making a certificate to that effect on the patent, which certificate, and also that of said board, are to be recorded in the patent office, and such renewal shall extend for the benefit of assignees and grantees to the extent of their respective interests in the patent. But no grant of such extension is to be made after the expiration of the original term.

This provision is, no doubt, intended to supersede, in some degree, applications to the legislature for the extension of patents. Whether the legislature will entertain applications in the nature of an appeal from the decision of the board, remains to be determined.

The provision seems to be an improvement in the law of patents. It is questionable whether the provision as to assignees should not have been more explicit, for as the professed object is to reimburse and reward the inventor and those who have been at the expense of introducing the invention, the benefit of the extension ought to be confined to such parties as far as this may be practicable, consistently with the agreements of the patentee with other assignees. Perhaps, however, the discrimination between different assignees cannot be made by law, on account of the difficulty of framing a provision to meet the case. As the law now stands, the patentee, in order to secure to himself the benefit of this provision, should provide for it by a stipulation in his contracts with others for licenses, or a sale of the shares in the patent.

CHAPTER XV.

Property in Patents and in Unpatented Secrets.

The interest of a patentee in his patent is a species of personal property, created by grant under the authority of the State, and one that could not exist without a positive law for its support. It is true that an invention that could be used in secret, without an exposure of the process by the exhibition of the products, might be retained and its advantages enjoyed by the inventor, independently of a law for its protection. But the patent law does not deprive the inventor of any advantage of this description. He may still, notwithstanding the law, guard his secret and enjoy its advantages as he might have done before the law was enacted. He is not required to make and publish his specification. But then it would not be a *property;* it would, after all, be only his *secret.*[1]

It is obviously impossible for an inventor to avail himself of the advantages of his improvement in this way in regard to most inventions, and it is very difficult to do it in any case. The process will sooner or later be divulged by the persons he employs, or

[1] Godson, p. 171.

will be liable to be detected in the results or products. The improvement made in the art of bleaching, mentioned in Tenant's case,[2] was practised six years before the patent was applied for. In other cases an inventor might expect to carry on his manufacture in secret for a still longer period. Dr. Swainson kept the secret of making his vegetable syrup for more than thirty years. In the few instances, however, in which there would be any chance of keeping the secret, there would be the constant inconvenience of the risk of detection and the consequent loss of the advantages of the discovery. Accordingly very few inventors decline the terms proposed by the patent laws for a temporary monopoly, as the price of the full disclosure of their discoveries, with the expectation of being able to reap the advantages of them for a longer period than that allowed by the statute by carrying on a secret manufacture.

There have been instances of suits and applications for injunctions, to protect inventors in the advantages of unpatented inventions, but without success. These proceedings have generally related to medicines. A bill for an injunction and an account was filed against a manufacturer and vendor of Swainson's vegetable syrup. The bill stated that

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[2] Dav. Pat. Cas. 429.

Isaac Swainson was, for more than thirty years before his death, the sole proprietor of the secret or recipe for preparing the medicine called Velno's Vegetable Syrup, which he had purchased for £6000, and by his will had bequeathed to the plaintiff, who, since his decease, had continued to make the same preparation as specified by the recipe, and made great profit; and would have made much greater, if the defendant had not imposed on the public a spurious composition under the same name, which his advertisements stated to be the same in composition and quality as that made by Swainson and the plaintiff. The bill prayed an account and injunction, &c. The defendant demurred generally. Sir Thomas Plummer, V. C. "This bill proceeds upon an erroneous notion of exclusive property now subsisting in this medicine, which Swainson having purchased, had a right to dispose of by his will, and, as it is contended, to give the plaintiff the exclusive right of sale of. If this claim of monopoly can be maintained, without any limitation of time, it is a much better right, than that of a patentee; but the violation of right with which the defendant is charged, does not fall within the cases in which the court has restrained a fraudulent attempt by one man to invade another's property; to appropriate the benefit of a valuable interest in the nature of good-will, consisting in the character of his trade or production, established by individual merit; the other representing

himself to be the same person, and his trade or production the same, as in Hogg v. Kirby,[3] combining imposition on the public with injury to the individual. This is not that sort of case. The observation is correct, that the bill, stating the defendant's medicine to be spurious, asserts it not to be the same as the plaintiff's. The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicines purchased by him; but merely represents that he sells, not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The demurrer must be allowed."[4]

Another case occurred, in regard to Dr. James's pills, before Lord Eldon. From the bill in the court of chancery, in 1817, it appeared that by certain articles of agreement between Dr. James, the inventor and proprietor of certain pills for the gout, rheumatism, &c. and Newbery, the plaintiff's deceased father, it was agreed that James should prepare the aforesaid pills, and sell and deliver them to Newbery at a certain rate, to supply his customers, and that James should not sell any of such medicines to any other person, except in the course of his private practice. Newebry was also to be

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[3] 8 Vesey, 215.

[4] Canham v. Jones, 2 Ves. & B. 218.

instructed in the secret of preparing the pills, but it was not to be disclosed by him except to his representatives after his death. It also appeared that letters patent had been granted, in 1747, to James for the exercise of his invention, and that James had assigned to Newbery, his executors, &c. one moiety of the invention during the term of fourteen years. The agreement contained in the articles was to be continued so long as either of the parties, their executors, &c. or any or either of them, should desire. Newbery bequeathed to the plaintiff all his interest in the preparing and vending the medicines. The defendants had succeeded to the rights of James, who died in 1776. The bill prayed a specific performance of the agreement, and an injunction to restrain the defendants from disclosing the secret of preparing the medicines except to the persons mentioned in the agreement. An injunction was granted only as to the sale of the medicines, expressly without prejudice to any question that might be made as to the possibility of sustaining such an injunction. On a motion to dissolve the injunction, Lord Eldon said, "that the difficulty in such a case was, how to decree the specific performance of the agreement. Either it was a secret, or it was none. If a secret, what means did the court possess, of interfering so as to enforce its own orders? If none, there was no ground for interfering. In this case, the medicines in question were the subject of a patent which had

expired; and the agreement which the bill sought to enforce was an agreement by which, independently of the patent, the proprietors had entered into covenants not to sell that which was the subject of the patent, except to each other. But, in order to support the patent, the specification should be so clear as to enable all the world to use the invention so soon as the term for which it has been granted is at an end." Lord Eldon concluded by saying that he thought he ought not to continue the injunction; and that, if he did not mention the case again, his opinion must be considered to be that the injunction must be dissolved.[5]

In the same case, a similar agreement had been made between James and the plaintiff, respecting an invention by James of certain pills called Analeptic Pills, but for which no patent had been obtained. Lord Eldon remarked, that, "with regard to the Analeptic Pills, if the art and method of preparing them were a secret, what signified an injunction, the court possessing no means of determining, on any occasion, whether it had or had not been violated? This court could do nothing but put the parties in a way to try their legal rights by an action. That was the utmost extent to which it would go, and he would not even order the injunction to be continued

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[5] Newbery v. James, 2 Meriv. 446.

in the mean time, till an action should be tried. The only way by which a specific performance could be effected would be by a perpetual injunction; but this would be of no avail, unless a disclosure were made to enable the court to ascertain whether it was or was not infringed; for if a party comes here to complain of a breach of injunction, it is incumbent on him first to show that the injunction has been violated."[6]

A motion was made for an injunction to restrain the defendant from making use of or communicating certain recipes for veterinary medicines, and from printing and publishing certain papers of directions for the mode of administering them. The plaintiff, who was the proprietor of the medicines, had employed the defendant as an assistant, under an agreement, by which he was to be instructed in the general knowledge of the business, but was not to be taught the mode of composing the medicines; afterwards the defendant left the plaintiff, and the latter had lately discovered that he had, while in his service, surreptitiously got access to his book of recipes, and copied them, and was selling the medicines, with printed papers for administering them, which were almost literal copies of those composed by the plaintiff. Lord Eldon granted the injunction, upon the

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[6] Newbery v. James, 2 Meriv. 446. See also Williams v. Williams, 3 Meriv. 157.

ground *of there having been a breach of trust* and confidence; but confined it, so as not to prevent the defendant from administering the medicine to any animals then under course, it being stated in the papers of directions, that a sudden discontinuance would be prejudicial.'[7]

But though an inventor cannot assert a right of property in an invention independently of the patent law, still he has an *interest* in his invention for which he proposes to take out a patent, before he has actually taken it out, and such an interest as he may, to some purposes, vindicate in a suit. It has been held, in England, that a man has such a property in his invention before a patent is procured, that if he agree to inform another person of the secret, who binds himself in a penalty not to avail himself or take any undue advantage of the communication, he may maintain an action for the breach of that contract.[8] In the United States, an agreement for the assignment of a patent right before the patent is taken out, is a matter of familiar practice, and its validity is recognised by the adjudged cases.[9]

So an agreement on the interest that the parties to the agreement shall respectively have in the patent when taken out, has been held valid. Two

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[7] Yovatt v. Winyard, 1 Jac. & W. 394.

[8] Smith v. Dickenson, 3 Bos. & Pull. 630.

[9] Herbert v. Adams, 4 Mason's R. 15.

persons, in order to secure to themselves the benefit of an invention, mutually covenanted that one should have the exclusive use and sale of the machines in Massachusetts and Rhode Island, and the other in the rest of the United States, and that neither should use them in the district of the other, under the forfeiture of a certain sum for each machine so used. They subsequently obtained a joint patent for the invention. It was held, in a suit by the one against the other for a breach of the covenant, that if the patent was void, still the contract was valid. Wilde J. said, "the patent formed no part of the consideration of the contract, for it existed only in contemplation when the contract was made. The most that can be said is, that the contracting parties had, at the time, the expectation of securing the profitable use of their invention by obtaining a valid patent, and nothing is averred in the pleadings from which we can infer that this expectation has been defeated or is likely to be."[10]

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[10] Stearns v. Barrett, 1 Pick. 443.

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CHAPTER XVI.

Assignment. Agreement to Assign.

The eleventh section of the act of 1836 provides 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 patent office within three months from the execution thereof."

This varies from the corresponding provision in the act of 1793, s. 4, which provided only for the recording of the assignment of a share, not for that of a license.

The inventor may assign his interest before taking out the patent,[1] for then he has a *right* which becomes *property* on the patent being taken out. This right, or inchoate property, has been so far respected in England that the inventor may enforce an agreement made respecting it.[2]

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[1] Herbert v. Adams, 4 Mason, 15.
[2] Smith v. Dickinson, supra.

An assignment of the right, before the patent is taken out, will according to the report of Dr. Jones, who is familiarly acquainted with the practice at the patent office, enable the assignee to take out the patent originally.[3] But this practice seems to be very questionable. The law requires the oath of the inventor himself, and contains no provision for issuing the patent to any other person except to his personal representatives in case of his decease. The effect, however, of taking out the patent in the name of the inventor and recording the assignment previously made, is the same as issuing the patent in the name of the assignee.[4]

As between the parties to the assignment, it has been held in Massachusetts to be valid without being recorded.[5] But, at least, third parties are not liable to be affected by an unrecorded assignment, since to admit them to be so would render the provision for the recording nugatory. In order to enable the assignee to bring, or join in, a suit upon the patent right, it is necessary that the assignment should be recorded.

It has been intimated that possession and use are material circumstances in considering the validity of a transfer of a patent right as well as that of other

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[3] Digest of the Decisions on Patents, 1831, No. 20, p. 26.
[4] Herbert v. Adams, 4 Mason *R.* 15.
[5] Morrill v. Worthington, 14 Mass. R. 389.

personal property. A patentee, having mortgaged the patent right, continued in the notorious use of it until he became bankrupt. Lord Chancellor Eldon was inclined to the opinion that the patent right passed to his assignees, that is, that the title of the mortgagee was not good against the assignees, and ordered an action at law to try the question.[6] It does not appear, however, that it came to a trial at law. In the United States the assignment, in such case, would probably be good if recorded.

On an agreement for the assignment of a patent, it has been held that a covenant to assign a patent right in as full a manner as the inventor had engaged to assign it, to the covenantor, does not necessarily imply that there shall be a covenant of warranty in the assignment.[7]

The defendant covenanted to assign to the plaintiff a sixteenth part of a patent right to a machine for cutting files, of which one Hatch was the inventor and patentee; and on receiving an assignment thereof from Hatch, transferred it to the plaintiff, without having first caused Hatch's assignment to be registered in the office of the secretary of state; this was held not to be a breach of the covenant. The court said, that it was for the plaintiff to cause the assignment of Hatch to be registered, as in cases of convey-

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[6] Ex parte Granger, Evans's Statutes, v. 4, p. 67, n.
[7] Morrill v. Worthington, 14 Mass. R. 389.

ance of real estate which the purchaser always procures to be recorded ; and that the defendant might legally assign the right which he acquired from Hatch, before such registry was made.[8]

A question on the construction of an assignment, whether it granted the right of one machine only, or that of making, using and vending any number, has been brought before the Supreme Court in Maine. The defendants conveyed to the plaintiffs "four clapboard machines and two shingle machines, in Dwight and Stone's building, in Livermore, on Androscoggin river ; and likewise the patent right for Livermore and Jay, all that is east of the Androscoggin river, and the town of Dixfield ; we sell all the above machinery, and right for the above towns, to make, use and vend to others to use, during the term of the patent, which is fourteen years from September 3, 1813." It was contended that only one patent right was intended to be conveyed ; to be applied, so far as it was applicable, to both the kinds of machine sold. But it was held, that this was a conveyance not only of the clapboard and shingle machines in Stone's building, and the right to use them, but also of the patent right to construct and use machines of *both* descriptions within the territory described in the conveyance.[9]

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[8] Morrell v. Worthington, 14 Mass. R. 389.

[9] Judkins v. Earl, 7 Greenl. 9.

Where the patentee took a lease of a shop in which was erected a machine patented by himself, with an agreement in the lease to deliver up the premises, including the machine, at the end of the term, in good condition to the lessor, Mr. Justice Washington ruled that this was the consent of the patentee in writing that the lessor should use the machine, himself, or by his servants, or let it to others to be used.[10]

The act of Congress contains no provision similar to that inserted in the English patents, forbidding the assignment to a greater number than five persons. This limitation in English letters-patent is inserted to prevent the formation of companies, in contravention of the bubble act.

The assignment of rights in a patent that turns out to be void, presents the question whether the assignor can, in such case, compel payment of the price; and, in the second place, whether the assignee, on discovery of the patent being void, shall recover back the price, or any part of it, previously paid by him.

Where the sale is attended with fraud on the part of the assignor, the case is plain; if he sell a right in a patent which he knew to be void, he cannot recover the price, if not paid, and if paid, he is liable to refund it.

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[10] Routgen v. Kanowrs and Grant, 1 Wash. C. C. R. 168.

As to recovering back an amount paid; Hare took out a patent for an apparatus for preserving the essential oil of hops in brewing, and afterwards granted to Taylor the privilege of using the invention for the residue of the term of the patent; and in consideration thereof, Taylor covenanted to pay to Hare, during the term, an annuity of £100. There was no fraud on the part of Hare, who, it seems, supposed the patent to be valid. After Taylor had used the apparatus, and paid the annuity for several years, it was discovered that Hare was not the inventor, but the patent had never been repealed. Taylor then brought an action against Hare to recover back the money. Sir J. Mansfield *C. J.* "*It* is not pretended that any action like the present has ever been known. *In this* case, two persons equally innocent make a bargain about the use of a patent, the defendant supposing himself to be in possession of a valuable patent right, and the plaintiff supposing the same thing. Under these circumstances, the latter agrees to pay the former for the use of the invention, and he has the use of it; *non constat* what advantage he made of it; for any thing that appears, he may have made considerable profit. These persons may be considered, in some measure, as partners in the benefit of this invention. *In* consideration of a certain sum of money, the defendant permits the plaintiff to make use of this invention, which he would never have thought of using had not the privilege

been transferred to him. How then can we say that the plaintiff ought to recover back all that he has paid? I think that there must be judgment for the defendant." Heath J. "It might as well be said, that if a man lease land, and the lessee pay rent, and afterwards be evicted, that he shall recover back the rent, though he has taken the fruits of the land." Chambre J. "In the case of Arkwright's patent, which was not overturned till very near the period at which it would have expired, very large sums of money had been paid; and though something, certainly, was paid for the use of the machines, yet the main part was paid for the privilege of using the patent right, but no money ever was recovered back which had been paid for the use of that patent." Judgment of nonsuit.[11]

In the above case some stress was laid on the circumstance that the patentee held a patent that was apparently good on the record. In a preceding action to recover the price agreed to be paid for the use of a patent that was void on the record, the decision was against the plaintiff. It was a decision of Lord Kenyon, C. J. and Ashhurst, Buller and Grose, Justices, in an action of covenant on articles of agreement. It appeared that the plaintiffs, who were assignees of a patent for a machine to be fixed to a

[11] Taylor v. Hare, 4 B. & P. 260.

common stocking-frame, for making a sort of net or open work, called point net, had agreed that the defendant might use one stocking-frame with their patent affixed thereto, in case the same should be worked only in the manner described in the specification; and that the defendant had covenanted not to use any of the patent machines, or any machines resembling the same, except the stocking-frame and machine so allowed to be used by him. The action was brought for a breach of this covenant. The defendant pleaded in bar that the specification was not enrolled in time, that the invention was not a new invention, and that the original patentee was not the inventor. The plaintiffs demurred, and contended that he was estopped by his deed from putting those matters in issue. Lord Kenyon. "It is said that the defendant is estopped in point of law from saying that the plaintiffs had no privilege to confer; but the doctrine of estoppel is not applicable here. The person supposed to be estopped is the very 'person who has been cheated and imposed upon. This does not resemble the case of landlord and tenant; for the tenant is not, *at all events*, estopped to deny the landlord's title; the estoppel only exists *during the continuance of his occupation*; and if he be ousted by a title paramount, he may plead it." Buller J. "If the plaintiffs had the exclusive right to the machine, they might convey it to any other person. It is now discovered that they had no such right; and there-

fore the defendant has not the consideration for which he entered into his covenant ; and notwithstanding which they say he is still bound." Judgment for the defendant.[12]

The distinctions between these two cases are, that in one, the agreed price for the use of the machine was sought to be recovered; in the other, the agreed price having been paid, was sought to be recovered back ; and in the first case the record showed a prima facie good title in the party agreeing to let the use of the machine ; in the latter, it did not show such a title. In both cases the party professing to be the proprietor of the patent. thought himself entitled to it ; there appears, therefore, not to have been any intentional fraud in either contract.

The question of fraud, and the fact of possession being out of the case, it is obvious that various other considerations might have an influence in determining the decision between parties to a sale of this description. The payment may have been under a judgment, as in some instances, under Oliver Evans's patent for the hopperboy, which was eventually adjudged to be bad ; or a settlement may have been made between the parties with a full, or at least an equal knowledge, of the facts. In general, after payment, the presumptions seem to be in favor of the party to whom the payment is made.

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[12] Hayne v. Maltby, 3 T. R. 438.

A patent right, like property of every other description, is liable to be assigned, not only by the agreement of the proprietor, but also by the operation of law independently of any voluntary act of the proprietor for this particular purpose. An instance of this has already been mentioned in the transfer of the right to the executors or administrators, or to the legatee of the proprietor in case of his decease, in the same manner as any other personal property.

In virtue of a general assignment under a bankrupt or insolvent law, of all the property of a proprietor of a patent right, or a share in one, his interest will be transferred with his other property to the assignees for the benefit of his creditors. Of the application of this doctrine to the interest held under a patent issued before such general assignment is made, there is no doubt, and it is unnecessary to cite cases, or to go into any discussions on this point.

The only question in relation to this subject that needs to be considered, is, whether any interest is transferred under such an assignment in an invention for which a patent has not been granted at the time of the assignment being made. It is held under the English bankrupt law that where a bankrupt, after the act of bankruptcy, and after the assignment of his effects by the commissioners of bankruptcy, but before his final discharge, takes out a patent, his

interest in that patent may be disposed of for the benefit of his creditors.[13]

The patent will stand upon the same footing as any other acquisition in the mean time, between the assignment and his final discharge ; as a legacy, for instance, or inheritance.[14] If the bankrupt's earnings and acquisitions from the time of his assignment belong to himself, a patent obtained by him would fall under the same rule. It will depend upon the provisions or construction of the particular bankrupt law what will pass to the assignees for the benefit of the creditors.

By the case above mentioned under the English bankrupt law, one Koops had become bankrupt, and a commission of bankruptcy had issued against him. Eleven months after he was declared bankrupt, he obtained a patent for making paper out of straw and other cheap materials. It seems, from the case, though not distinctly stated, that at the time of Koops's bankruptcy, he had an establishment for carrying on the manufacture of this sort of paper, which manufactory would, of course, pass under the assignment to his creditors. After obtaining his patent, he entered into a composition with a greater part of his

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[13] Hesse v. Stevenson, Gods. Pat. 165.

[14] See cases Chitty's Index to Equity Reports, vol. 1, p. 146, art. Bankruptcy, xi. 2.

creditors, to which the assignees were parties, whereby, upon certain stipulations, his creditors, parties to this composition, agreed to release their demands. Koops did not, however, perform his part of this agreement, so that it proved to be ineffectual and null. But while he expected to be able to fulfil it, calculating, probably, on the success of his manufactory, he sold a share of the patent, and also of the establishment, to Stevenson, and the latter sold a part of the share to Hesse. About a year after making the agreement for a composition, the manufacture having probably proved unsuccessful in the mean time, his assignees took possession of the establishment under the bankruptcy proceedings, and had it disposed of for the benefit of the creditors. Hesse, who had bought his share of Stevenson, then brought an action against Stevenson to recover back what he had paid for the share, on the ground that Stevenson had warranted the title.

The question was thus raised whether the assignees had a right to transfer the property, and it was held that where a patent right is obtained by an *uncertificated* bankrupt, it is affected by the previous assignment of the commissioners, and vests in the assignees. Lord Alvanly. "It is contended, that the nature of the property in this patent was such, that it did not pass under the assignment; and several cases were cited in support of this proposition.

It is said that although, by the assignment, every right and interest, and every right of action, as well as right of possession and possibility of interest is taken out of the bankrupt and vested in the assignees, yet that the fruits of a man's own invention do not pass. It is true that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he may make of such schemes, do not pass, nor could the assignees require him to assign them over, provided he does not carry his schemes into effect until after he has obtained his certificate. But if he avail himself of his knowledge and skill, and thereby acquire a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument, why that interest should not pass in the same manner as any other property acquired by his personal industry. Can there be any doubt, that if a bankrupt acquire a large sum of money, and lay it out in land, that the assignees may claim it? They cannot indeed take the profits of his daily labor. He must live. But if he accumulate any large sum, it cannot be denied that the assignees are at liberty to demand it; though until they do so, it does not lie in the mouth of strangers to defeat an action at his suit in respect of such property, by setting up his bankruptcy. We are, therefore, clearly of opinion that the interest in the letters-patent, was an interest of such a nature

as to be the subject of assignment by the commissioners."[15]

Though many of the States in the United States have insolvent laws, no question appears to have been raised under them similar to the one raised in the above case.

The question occurred in an English case, whether the condition of an English patent that it shall be void on its being assigned to more than five proprietors, is forfeited by an assignment under the bankrupt act for the benefit of the patentee's creditors, being more than five in number, and it was held not to be such a forfeiture.[16]

As to an insolvent or bankrupt debtor's interest in machinery, apparatus, and property subject to the patent right, and intended to be used in pursuance of the exclusive privilege given by law, there seems to be no ground of question that it will pass under the assignment of his effects, with the privilege of using it, under the patent, since the patent itself so passes where the debtor is the proprietor of it. It cannot be supposed, that all the property of a bankrupt invested in such articles, could be locked up from his creditors, or that they can avail themselves of such machinery and apparatus only as ma-

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[15] Hesse v. Stevenson, 3 Bos. & Pul. 565.

[16] Bloxam v. Elsee, 6 Barn. & Cres. 169.

terials to be used for other purposes than the manufacture for which they were intended, and for which, only, they are, perhaps, of any value. At least, if the debtor has an assignable right under his own patent, or that of another, there does not appear to be any ground of doubt that his creditors may avail themselves of the full value of the property, accompanied with the right of using it under the patent.

Very nearly allied to the question just stated is that of the seizure and sale of the patented articles on execution. One question arising in this case, is, whether the sale by the sheriff, in such case, transfers to the purchaser the right which the debtor has to use the machines, under the authority and right of the debtor, as patentee, or as his assignee, or having a license from the proprietor of the patent.

If the debtor has no such right, then, undoubtedly, such a right cannot be transferred under such a sale. If, for instance, the debtor has made the articles with the consent of the proprietor of the patent, to be sold upon certain terms and conditions thereafter to be fulfilled and complied with by the maker on such sale, the purchaser of the articles certainly cannot, at the best, pretend to any greater right than the debtor had. The question would arise, in such case, whether the right of the debtor was assignable and transferable by himself, or by a sale under an execution against him. But in case of a general, unconditional, unrestricted right of the debtor to use the

machines, or to sell them for use, it is obviously a very equitable construction in favor of both the debtor and his creditors, in respect to the proprietor of the patent, where he is a third party, that the privilege should pass with the articles.

A case before Mr. Justice Story suggests, without however deciding, whether the purchaser under such a sale obtains all the right of the debtor to use such machine. It was held that, under the statute, the *sale* by a sheriff of the *complete materials* of a patented machine, while such machine is in operation, on an execution against the patentee, does not render the sheriff liable to an action for an infringement of the patent right. In an action by a patentee against a deputy-sheriff for such a sale, the court said, that "if such a sale were construed to be illegal under the statute, it would be practicable for a party to lock up his whole property from the grasp of his creditors, by investing it in profitable patented machines; and, upon the same construction, this consequence would follow, that every part of the materials of the machine might, when separated, be seized on execution, and yet the whole could not be, when united; for the exemption from seizure is claimed only when the whole is combined and in actual operation under the patent. By the laws of Massachusetts, property like this is not exempted from seizure on execution; and an officer who neg-

lected to seize, would expose himself to an action for damages, unless some statute of the United States should contain a clear exception. No such express exception can be found; and it is inferred to exist only by supposing that the officer would, by the *sale*, make himself a wrongdoer, within the clause of the statute above recited. But within the very words of that clause, it would be no offence to *seize* the machine in execution. The whole offence must consist in a *sale*. It would therefore follow, that the officer might lawfully seize; and if so, it would be somewhat strange, if he could not proceed to do those acts which alone, by law, could make his seizure effectual. In the present case, we think that a sale of a patented machine, within the prohibitions of the same clause, must be a sale, not of the materials of a machine, either separate or combined, but of a complete machine, with the right, express or implied, of using the same in the manner secured by the patent. It must be a tortious sale, not for the purpose merely of depriving the owner of the materials, but of the use and benefit of his patent."

"There is no pretence, in the case before us, that the officer had either sold or guaranteed a right to use the machine in the manner pointed out in the patent right. He sold the *materials* as such, to be applied by the purchaser as he should by law have a right to apply them. The purchaser must, there-

force, act at his own peril, but in no respect can the officer be responsible for his conduct."[17]

CHAPTER XVII.

Infringement.

Sec. 1. *Definition in the Law. Devising.*
2. *Making.*
3. *Using.*
4. *Selling.*
5. *Identity of Thing Used or Sold, and that Patented. Difference in Form and Proportions merely. Infringement of a Combination—of a Part.*

Sec. I.—Definition in the Law. Devising.

Though an inventor, having a right to take out a patent, may assign such patent before taking it out, so that the assignment may operate on the patent when taken out, yet he has not such a property as can be the subject of an infringement.[1]

The fifth section of the act of 1793, which section

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[17] Sawin v. Guild, 1 Gallison, 495.
[1] Dixon v. Thayer, 4 Wash. C. C. R.

was repealed in 1800, described it to be an infringement to "make, devise, and use, or sell" the thing invented. There was some ambiguity in this description, which was cleared up in the fourth section of the act of 1800, in which it was provided that, "where any person, without the consent of the patentee, his or her executors, &c. first obtained in writing, should make, devise, use or sell the thing whereof the exclusive right was secured to the patentee by patent, such person so offending should forfeit," &c.

The act of 1836, by which all the preceding acts have been repealed, gives no description of what shall be an infringement, otherwise than by providing for damages in case of "making, using or selling" the thing patented,[2] nor is any such description necessary, since the patent itself, in the form prescribed by that act, in terms grants to the applicant, "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 invention or discovery."[3] The form of the patent, under the former law, granted to the patentee the exclusive right of "making, constructing, using and vending to others to be used." The change made by the law of 1836 is in dropping the word *constructing*, which was immaterial, since its meaning is comprehended in *making*.

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[2] Section 14.

[3] Section 5.

And so the omission of the word *devising*, which was used in the act of 1793, in describing an infringement, is unquestionably an improvement, on account of its ambiguity; and because the only practical meaning that could be given it is comprehended in the word *making*.

Sec. II.—Making.

It has been held by Mr. Justice Story, that the making of a patented machine for use or sale, though it were, in fact, neither used nor sold, is an infringement, for which, however, only nominal damages can be recovered, but that the making merely for experiment or philosophical purposes is not an infringement.[4]

Sec. III.—Using.

A use of the patented article is a direct and unquestionable infringement. We are here speaking of the use of the thing itself, which is the subject of the patent, not that of its products. A patent is, as has been explained in its place, an exclusive right to the practice or use of a certain art, process, contrivance or principle, combined with, and *embodied in*, material substances. The art, contrivance or design,

[4] Whittemore v. Cutter, 1 Gall. R. 429.

considered abstractly, is not itself patentable, or an infringement of a patent. It is only in its production, in combination with materials, that it is either patentable itself, or a violation of a patent right. In a patented instrument or piece of machinery, the subject of the patent exists, and is visible and tangible, and admits of being possessed and delivered distinctly, and independently of its products. But when a composition of matter is the thing patented, the subject of the patent is identified with its products,—or rather a specimen of the product, or the only vendible thing which it is the object of the invention to supply, is, at the same time, a specimen of the invention itself. Whereas, in the case of an instrument or machine, one object of the invention is to produce the instrument or machine itself, another to produce its products. The inventor of a loom may propose a profit on the sale of it, as well as on the sale of its products. So, again, a steam engine, like a loom, is invented to be used as an instrument until it is worn out; and, in this respect, both differ from a patent medicine or many chemical compositions, which are consumed and destroyed at once in the use.

Now, considering the *use* of the thing patented to be an infringement of the patent right, is there any difference in this respect between these different kinds of articles? Is it equally an infringement to use a patented medicine, which is destroyed in the use, or a

nail-machine, loom or steam engine, which will last a long time? The answer to this question undoubtedly is, that the use in either case is equally an infringement.

What, then, is the *use;* and who may be said to *use* the article? In the case of a patented paint, can the lessee, who occupies a house painted with the patented article, be said to use it? or can the hirer or purchaser of a chaise, varnished with patented varnish, be said to use the varnish? In either case we shall readily answer in the negative. One could not, with propriety, put to such a person the question, What paint or varnish do you use? The question can be properly addressed only to the person who selects and *applies* the article. He is the person who *uses* it. So, in case of a patented medicine prescribed, selected and ministered to the patient by others without any act of his own; the doctor or the apothecary, and not the patient, *uses* the article, in the sense intended by the statute. It is otherwise in regard to lasting articles. The cultivator uses a plough, and a manufacturer a loom, and so they, no less than the vendor, infringe the patent right.

We then come to a long series of patented improvements, which are, to a greater or less extent, incorporated with, or appendages to, other articles of which the subject of the patent is an ingredient or part; such, for instance, as a steam valve. In these

cases it certainly cannot be said that the person who uses the article to which the improvement is attached does not use the improvement; for this construction would deprive the greater number of patentees of all remedy for the use of their inventions, and leave them only to pursue the vendors, which would be, in effect, almost to repeal this part of the statute. Such an appendage seems to stand upon the same footing, in this respect, as an article which may be used independently of others. The party who uses the principal thing uses the accessary; and seems to be liable for an infringement of the patent for it.

A mere contract to purchase the articles, produced by the instrument, is not a constructive use of it by the purchaser, within the statute.[5]

A case of this description occurred in Maryland, in relation to Keplinger's instrument for the manufacture of wire watch chains, which had been assigned to Gray and Osgood. About the time of the patent being taken out, Mr. De Young agreed with Hatch and Kirkner to make five gross of such chains for him; he to furnish stock and materials, to be charged to Hatch and Kirkner, at the cost, and to pay at a certain rate per dozen for the chains when manufactured. A large quantity was manufactured and de-

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[5] This is the rule also in France. Renouard on Patents, c. 5, s. 4, p. 214.

livered under the contract. The makers used Mr. Keplinger's patented instrument, in the manufacture, and it appeared from the evidence, that Hatch and Kirkner intended to use the instrument at the time of making the contract, and that De Young knew of such intention; and that in the course of the manufacture and delivery of the articles, he knew of their using the instrument, and approved of it.

The question in this case was, whether De Young was a partner with Hatch and Kirkner, in the use of the machine, and the transaction a mere cloak to give De Young the benefit of the use of it; or, as the contract imported, a mere purchase of the articles by De Young, of Hatch and Kirkner, they being left to manufacture them as they should choose; upon which latter construction of the facts, the jury were instructed to give their verdict for the defendant, which they did.[6]

There can be no question of the accuracy of this verdict, upon such a construction of the facts, since to hold that every person who buys an article produced by the unlicensed use of a patented instrument, is an infringer of the patent right, would expose every purchaser of an article at the shops, to a suit by some patentee. But if the evidence had shown that the contracting parties were, in fact,

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[6] Keplinger v. De Young, 10 Wheat. 358.

partners, or that the contract was made for the purpose of enabling De Young, by hiring the use of the instrument, or otherwise, to reap the benefit or a part of the benefit of violating the patent right, and at the same time evade the penalty, and leave the patentee to seek his remedy against workmen who had no means of making good the damage, it would, as the court expressly held, have been an infringement on his part.

A use of the patented article merely for philosophical experiment, or for the purpose of ascertaining "the verity and exactness of the specification" is not an infringement.[7]

In a case before Mr. Justice Washington, he seemed to consider the use for the purpose of trying the practical utility, to be an infringement. It was relied upon in the argument, that a machine of one Christian, for moulding biscuit, had never been *used* by the defendant within the true meaning of that expression, in the patent act. He said "It is admitted that an experiment was made with it, but this, it is argued, was not such a using as the act intends. It surely cannot be denied that the act of making crackers with it, amounted to a using of it according to the common and accepted meaning of that phrase; and I am quite at a loss to imagine

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[7] Whittemore v. Cutter, 1 Gall. R. 429.

how this meaning can be varied by the particular motive which induced the inventor so to employ the machine. I can discover nothing in the patent act which will authorize the court to depart from the ordinary meaning of this expression, and to declare that a machine which is put into operation for the sole purpose of trying its practical utility, is not used within the meaning and intent of the sixth section of the act of 1793."[8]

This doctrine is at variance with that laid down by Mr. Justice Story, cited above. Certainly Mr. Justice Washington must be wrong as to the court or jury having nothing to do with the motive for using the machine.

A patent cannot be infringed by any thing done before it is granted; other persons than the inventor both may, therefore, make and use the machine in the United States before the issuing of the patent, without being liable to damages. But after the granting of the patent, if it be valid, (as it may be, in such case, in the United States, though it would not be so in England,) the party who has thus previously made and used the machine, which is the subject of it, cannot continue to use it, and his continuing to do so will be an infringement.[9]

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[8] Watson v. Bladen, 4 Wash. C. C. R. 583.

[9] Ames v. Howard, 1 Sumner's Rep. 482.

Upon this subject, Mr. Justice Washington, speaking of the continued use of such previously erected machine, after the issuing of the patent, remarks, that it was objected to the construction, that a party had no right to such continued use; "that it would render the law *ex post facto* in its operation, in respect to one who has erected his improvement prior to the granting of the patent to the plaintiff."

"It must be admitted that cases of great hardship may occur, if, after a man shall have gone to the expense of erecting a machine, for which the inventor has not then, and never may obtain a patent, he shall be prevented from using it by the grant of a subsequent patent, and its relation back to the patentee's prior invention. But the law, in this case, cannot be termed *ex post facto*, or even retrospective in its operation, because the general law declares, before hand, that the right of the patent belongs to him who is the first inventor, even before the patent is granted; and, therefore, any person, who, knowing that another is the first inventor, yet, doubting whether the other will ever apply for a patent, proceeds to construct a machine, of which it may afterwards appear he is not the first inventor, acts at his peril, and with a full knowledge of the law, that by relation back to the first invention, a subsequent patent may cut him out of the use of the machine thus erected."

"Not only may individuals be injured by a liberal construction of the words in the law, but the public

may suffer, if an obstinate or negligent inventor should decline obtaining a patent, and at the same time keep others at arms' length, so as to prevent them from profiting by the invention for a length of time, during which the fourteen years are not running on. But all these hardships must rest with Congress to correct. It is beyond our power to apply a remedy."[10]

So where a patent, first taken out, is void, on account of a formal defect in the specification, and on this account is surrendered and a new one taken out, but previously to the granting of the new patent, a machine is erected by another person, the party so erecting the machine, cannot continue to use it after the second patent is taken out, and his so continuing to use it will be an infringement.[11] That is, he stands upon precisely the same footing as a person who erects and uses a machine before the first patent is taken out, when such first patent is valid.

Nor is any notice necessary, in such case, from the patentee to the party who has erected and begun to use the machine before the granting of the new patent. Where a patent for an improvement in a machine for making paper first taken out, was surrendered, and a new one taken out, and before the

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[10] Evans v. Weiss, 3 Hall's Law Journal, 180. Wash. C. C. R. 12; Fessenden's Patents, 52.

[11] Ames v. Howard, 1 Sumner's R. 482.

second patent was issued, another person had erected the machine, and continued to use it after the second patent was issued ; in an action for an infringement of the patent-right, the defendants objected that they were not liable until after notice from the patentee. Mr. Justice Story, however, ruled otherwise, and, on a motion for a new trial, said, "I am by no means prepared to say that any notice is, in cases of this sort, ever necessary to any party who is actually using a machine in violation of a patent right." But supposing notice to be necessary, he considered the knowledge by the defendants that the first patent had been taken out, to be, in effect, such notice. He said, "whoever erects and uses a patented machine, does it at his peril ; he takes upon himself all the chances of its being originally valid, or of its being afterwards made so, by a surrender of it, and granting of a new patent, which may cure any defects, and is grantable according to the principles of law."[12]

The judges considered that the above construction, as to the use of a machine, erected after the expiration of the old, and before grant of the new patent, was forced upon them by the law.[13] But it does not appear why a doctrine evidently so inequitable, is imposed upon the court, since, on the ex-

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[12] Ames v. Howard, 1 Sumner's R. 482.

[13] Evans v. Weiss, Fessenden on Patents, 52; Wash. C. C. 12; 3 Hall's L. J. 180; Evans v. Eaton, 1 Pet. S. C. R. 337.

piration of a patent, the right is merged in the community, and every man has a license from the public to make, use and vend the article. His right in respect to such article is not distinguishable from that which he has in respect to any other which has been in use immemorially without patent. The reason is not shown why the public should not be entitled, under these circumstances, to use the machines that had been made before the renewal of the patent, at least. The more grave question is, whether the patent could, upon any sound principle of legislation, be renewed under these circumstances. Under the act of 1836, patents cannot be prolonged under the provision of the eighteenth section, unless the grant of prolongation is made before the expiration of the first term.

Sec. IV.—Selling.

What is a sale of the patented article so as to be an infringement of the patent, needs not to be dwelt upon at great length. Though questions may be made as to what amounts to a sale, and as to the party who is to be considered the vendor, it would be a digression to go into a minute investigation of the subject in this place. Undoubtedly, the principal, who authorizes his agent to sell for his benefit, is an infringer of the patent. And so, also, is the

agent, for the orders of the principal are no excuse to him for the violation of another's right.

It has already been noticed, that a sale by operation or authority of law, as in case of bankruptcy, insolvency, and sale on execution, is not an infringement of the patentee's right.[14]

Sec. V.—Identity of Thing made, used or sold, with that patented. Difference in Form and Proportions merely. Infringement of a Combination—of a Part.

The making, using or selling of a thing, is, of course, not a violation of a patent, unless it be the thing, or one of the things patented. If it vary from the patented article, merely in form or proportions, but be substantially and essentially the same, it will be a violation of the patentee's right. This doctrine was directly involved in the provision of the act of 1793, by which a variation merely in form or proportions, was declared not to be a new invention, and so not patentable; that is, conversely, it is, within the meaning of the law, the same thing, and so is an infringement.

"What constitues form, and what principle," Mr. Justice Washington remarks, "is often a nice

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[14] Supra. ch. xvi.

question to decide ; and upon none are the witnesses who are examined in patent cases, even those who are skilled in the particular art, more apt to disagree. It seems to me that the safest guide to accuracy in making the distinction is, first to ascertain what is the result to be obtained by the discovery ; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principles of the invention."[15]

In a suit for an infringement of a patent for a carriage wheel, whereby the load was suspended at the circumference on the top, instead of being supported, as usual, at the centre, Mr. Justice Patteson instructed the jury, that it was not enough to constitute an infringement, that the defendant had constructed a wheel on the suspension principle, because that principle might be applied in various ways ; but if the jury thought it was applied in the same way, then a variation in two or three circumstances in the defendant's wheel, from the description in the plaintiff's specification, would not prevent its being an infringement.[16]

On the subject of the infringement of a part of the rights secured by patent, Mr. Justice Story says,

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[15] Treadwell and Watson, v. Bladen, 4 Wash. C. C. R. 706. And see Dixon v. Mayor, 4 Wash. C. C. R. 68.

[16] Jones v. Pearce, Gcds. Sup. 11.

"Where the inventor claims several distinct and independent improvements in the same machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements, so patented, notwithstanding there has been no violation of the other improvements. There is no doubt, that by the law of England, a party who pirates any part of the invention of the patentee, is liable in damages, notwithstanding he has not violated the whole. It may be that the decisions have turned upon the peculiar language of the English patents; for in all the precedents which I have seen, the patent gives the exclusive right of the whole invention, and prohibits all other persons, "directly and indirectly, to make, use or put in practice, the said invention, or *any part of the same*, &c. or in any wise to counterfeit, imitate, or resemble the same, or make, or cause to be made, any addition thereto, in subtraction from the same."[17] But as no such intimation is given in the reports, I incline to believe that the doctrine stands upon the general principles of law, that he who has the exclusive right to the whole of a thing, has the same right to all the parts which the general right legally includes; that is, (in cases like the present,) to all the parts which he has invented.

[17] Collier on Patents, 54, 57; Dav. Patent Cas. 27, 30.

The principal difficulty that arises, is in the application of the doctrine; and that may, in most cases, be removed, by considering the nature and extent of the patent, or rather of the thing invented and patented. Where the patent goes for the whole of a machine as a new invention, and the machine is, in its structure, substantially new, any person who pirates a part of the machine, substantially new in its structure, deprives the inventor, so far, of his exclusive right in his invention, and may, in a great measure, destroy the value of the patent. Where the patent is for several distinct improvements in an existing machine, or for an improved machine, incorporating several distinct improvements, which are clearly specified, then if a person pirates one of the improvements, he violates the exclusive right of the patentee, for the patent is as broad as the invention, and the invention covers all the improvements; and it is a wrong done to the patentee, to deprive him of his exclusive right, in any of his improvements."[18]

A patent for a combination, merely does not, as we have seen, give the exclusive privilege of using the separate things combined,[19] and consequently the use, making or selling of any separate parts, less than the whole combination, is not an infringement.

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[18] Moody v. Fiske, 2 Mason 112; and see Hill v. Thompson, 2 J. B. Moore, 424; Bovill v. Moore, Dav. Pat. Cas. 361.

[19] Supra. and see Brunton v. Hawkes, 4 B. & Ald. 549.

This doctrine is thus laid down by Mr. Justice Story: "Where a patent is for a *new combination* of existing machinery or machines, and does not specify or claim any improvements or invention, except the combination, unless that combination is substantially violated, the patentee is not entitled to any remedy, although parts of the machinery are used by another, because the patent, by its terms, stands upon the *combination* only. In such a case, proof that the machines, or any part of their structure, existed before, forms no objection to the patent, unless the *combination* has existed before, for the reason, that the invention is limited to the combination. If there be different and distinct improvements constituting parts of the combination, which are specified as such in the patent and specification, and any one of them be pirated, the same rule seems to apply as in other cases, where part of an invention is pirated; for the patent then shows that the invention is not limited to the mere combination, but includes the particular improvements specified."[20]

On this subject, Mr. Justice Washington, speaking of the use of the hopperboy, elevator and other machinery, for an improvement in which Evans took out a patent, asks, "Will it be seriously contended that a person may acquire a *right to the exclusive*

[20] Moody v. Fiske, 2 Mason, 112.

use of a machine because, when used in combination with others, a new and useful result is produced, which he could not have acquired independent of that combination? If he can, then if A were proved to be the original inventor of the hopperboy, B of the elevator, and so on as to the other machines, and had obtained patents for their respective discoveries, or chosen to abandon them to the public, the plaintiff, although it is obvious he could not have obtained separate patents for these machines, might, nevertheless, deprive the original inventors, in the first instance, and the public, in the other, of their acknowledged right to use these discoveries, by obtaining a patent for an improvement which consists in a combination of those machines to produce a new result." And he contends clearly that the patentee of the mere combination cannot thus deprive others of the use of the machine or parts combined, or, in other words, that the use of these separately is not an infringement."[21]

A patentee, having taken out a patent for the combined operation of five parts, afterwards took out a separate patent for two of them, as being an improvement on a machine patented by another patentee. Held by Washington J. that this was not taking out two patents for the same thing, one being

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[21] Evans v. Endon, 1 Pet. C. C. R. 343, 344, 345, 346.

for a combination, and the other for a part of the things combined.[22] It follows, accordingly, that if the patent is for a combination merely, the use of any one or more of the things combined, but not of the whole, is not an infringement of the patent right for the combination.

CHAPTER XVIII.

Jurisdiction of Patents.

By the act of 1836, s. 17, it is provided "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 and discoveries, shall be originally cognizable, as well in equity as at law, in the Circuit Courts of the United States, or any District Court having the powers and jurisdiction of a Circuit Court;" which courts have power to grant injunctions to prevent the violation of the rights of any inventor. Provided, however, that a writ of error or appeal shall lie to the Supreme Court in the same manner as on other

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[22] Treadwell and Watson v. Bladon, 4 Wash. C. C. R. 709.

judgments and decrees of Circuit Courts, "and in all other cases in which the court shall deem it reasonable to allow the same."

The jurisdiction was in the Circuit Court before the passing of this law, under that of 1800. One alteration is made in giving an appeal where the court shall deem it reasonable.

The State courts have not a concurrent jurisdiction with the Circuit Courts of the United States. In an action brought for an infringement of a patent right in the State courts of New York,[1] the court said, "As the judicial power of the United States extends to all cases of law and equity arising under the laws of the United States, and as the act of Congress on the subject of patent rights, has declared that the suit for the infringement of them shall be brought in the Circuit Court of the United States, and gives the court power in such cases to declare the patent void, the State courts have, of course, no jurisdiction in the case."[2] It had been held in New York, previously to the passing of the above act of 1819, that a case in equity on a patent was cognizable before a State court of equity, as Congress had not then conferred this jurisdiction on the Circuit

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[1] Parsons v. Barnard, 7 Johns. R. 144.

[2] See also Kent's Comm. vol. 2, p. 368, sect. 36, and Burral v. Jewett, 2 Paige's R. 134.

Courts of the United States.[3] All questions of a juridical character relating to patents belong properly to the jurisdiction of the judicial tribunals, in distinction from the legislature, and it has been accordingly doubted whether Congress has a right to decide whether a person is the original inventor of what he claims as his invention, so as to preclude judicial inquiry.[4]

Though the State courts have no direct jurisdiction of patent causes, still the question of the validity of a patent may come incidentally before them,[5] as in case of an application to a chancery court of a State to set aside a contract relating to a patent right, as founded in a mistake,[6] or a suit on a promissory note where the defence is want of consideration, the note having been given for a share in a patent right which the defendant alleges to be void on the ground that the patent was fraudulently obtained.[7]

The State courts have also jurisdiction of cases arising on the grant of patents or other monopolies by the States, as far as valid grants of this descrip-

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[3] Livingston et al. v. Van Ingen et al. 4 Hall's Law Journal, 56; Coxe's Digest, 534.

[4] Story's Comm. on the Constit. v. 3, p. 49, where is cited Evans v. Eaton, 3 Wheat. R. 454.

[5] Cone v. Baldwin, 12 Pick. R. 545.

[6] Burrall v. Jewett, 2 Paige's R. 134.

[7] Bliss v. Negus, 3 Mass. R. 46.

tion can be made by a State. Thus, it having been held by the court of chancery, and, on appeal, by the court of errors, in New York, that the several acts of the legislature of that State, granting to Livingston and Fulton, for a term of years, the sole and exclusive right of using and navigating boats or vessels moved by steam or fire, in the waters of the State, were valid, it was also held, as a consequence of that decision, that an injunction might be issued by the court of chancery of the State to restrain the citizens of another State from navigating the waters of New York by steam boats.[8] But an appeal lies to the Supreme Court of the United States in such case, if the validity of an act of Congress is brought in question and the decision of the State court is against it.

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[8] Gibbons v. Ogden, 17 Johns. R. 488.

CHAPTER XIX.

Action at Law for an Infringement.

Sec. 1. *Form of Action.*
2. *Parties.*
3. *Declaration.*
4. *Plea. Defences. Notice.*

Sec. I.—Form of Action.

By the fourteenth section of the act of Congress of 1836, it is provided that in case of an infringement of a patent right, damages "may be recovered by action on the case." This is merely a provision by statute for the remedy to which the proprietor of a patent would have been entitled by the common law.[1] It is said in an old case that an action for an infringement may be maintained on a defective patent liable to be repealed, as long as it remains unrepealed ;[2] but this is not law; if the patent is proved to be void, the action fails.

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[1] Bull. N. P. 76; 1 Chit. Pl. 159, 5th Lond. and 6th Am. ed.; Clements v. Goulding, 11 East, 224; S. C. 2 Camp. N. P. 25; Roworth v. Wilkes, 1 Camp. N. P. 94; 1 Saund. Pl. and Ev. 336, (412.)

[2] Butler's case, 2 Ventr. 344.

Sec. II.—Parties.

The act of 1836, s. 14, provides that an action for an infringement is "to be brought in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States."

This provision changes the rule previously adopted by construction of the act of 1793, under which it had been held that an action could not be maintained in the name of an assignee of the exclusive right for a particular district; as this was considered to be a mere license and not an assignment under the fourth section of that act.[3] Though such a party could join in a bill in equity with the other persons interested.[4]

But an action might be maintained under the former law in the name of an assignee of a share, joined with the patentee.[5]

And if the whole patent be assigned, whether the

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[3] Whittemore v. Cutter, 1 Gall. R. 429. Tyler and another v. Tuel, 6 Cranch, 324. A suit in the name of the party licensed seems to have been sustained in England. George v. Wackerback, Rep. of Arts, 2d Series, v. 27, p. 252.

[4] Whittemore v. Cutter, 1 Gall. R. 429. Ogle v. Ege, 4 Wash. C. C. R. 584.

[5] Whittemore v. Cutter, 1 Gall. R. 429. See Boulton v. Bull, 2 H. B. 463.

assignment be made before or after taking it out, an action upon it for an infringement must be brought in the name of the assignee and not that of the patentee.[6]

But while the patentee has merely made an agreement for an assignment, and has not made the assignment, he may bring an action in his own name for an infringement of the patent, notwithstanding such agreement, since the assignee is not put in the place of the patentee as to right and responsibility, until the assignment is executed and recorded.[7]

All who join in the same act of infringement may be sued jointly or separately, or some of them may be joined and others sued separately.[8]

An action for a violation of a patent may be maintained against a corporation when, acting in that character, it authorizes an infringement.[9]

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[6] Herbert v. Adams, 4 Mason's R. 15.

[7] Per Washington J. Park v. Little and Wood, 3 Wash. C. C. R. 196.

[8] 1 Saund. R. 291, e. 2 Saund. 396.

[9] Knoass v. Schuylkill Bank, C. C. U. S. Oct. 1820. The joint proprietors of a patent are not liable as copartners on a contract by one of their number, on his own account, to construct a certain number of the patented articles. Livingston and Fulton were joint proprietors of a patent right for the application of steam to the purposes of navigation. Fulton contracted with an assignee of such right, "to be responsible for the perfect construction and performance of certain steam boats to be built on the river Ohio, so that they should carry at least one hundred tons burden, and run at least four miles an hour in still water." It was held by the court of chancery of New York, that Livingston, on the mere ground of his joint interest in the patent right, was not re-

Sec. III.—Declaration.

The declaration in an action for an infringement recites, in general, that, at the time of taking out of the letters-patent, the patentee was the true and orignal inventor of a new and useful invention or improvement, which is concisely described as in the patent, and, thereupon, on such a day, upon application of the patentee, the secretary of state caused letters-patent to be issued in the name of the United States, bearing such a date, under the seal of the patent office, and duly tested, according to the form of the statutes in such case, whereby was granted to the patentee, his heirs, executors, administrators and assigns, for the term of fourteen years, the full and exclusive right and liberty of making, using and vending to others to be used, the new and useful invention or improvement, agreeably to the statutes in such case made and provided, as by the said letters-patent in court to be produced, and the specification therein referred to, will more fully appear; and that the patent was assigned by the patentee, or by his assignee, to the plaintiff, if such be the fact; that the assignment was recorded in the

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sponsible for this contract; it not being connected with the enjoyment and exercise of their common privilege under the patent. Lawrence v. Dale, 3 Johns. Ch. R. 23. On an appeal to the Court of Errors, the decree of the Court of Chancery was affirmed. McNeven v. Livingston, 17 Johns. R. 437.

patent office; that the plaintiff or the preceding proprietors and the plaintiff successively, always, from the time of granting the letters-patent, or that the plaintiff, from the time of such assignment, has used and enjoyed the right to the time of suing out the writ; that the defendant well knowing the premises, and intending to deprive the plaintiff of the profits and advantages which he might otherwise have derived from the right, at such a place, on such a day, and at other times between that day and the date of the writ, made or used, or sold the said invention, without the permission or license in writing, and against the will of the plaintiff, in breach of the letters-patent, and in violation of the right granted to the plaintiff, or granted to the patentee and assigned to the plaintiff; whereby the plaintiff was deprived of great profits, and has sustained actual damage to such an amount, whereby, and by force of the statute, an action has accrued to the plaintiff to recover damages.[10]

The declaration in this, as in all other cases, must show a cause of action by setting forth the facts necessary for this purpose. These facts, in general, as will appear by the above outline, are—1, the invention by the patentee; 2, description of the invention; 3, the grant of the patent; 4, what the

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[10] See 2 Chit. Pl. 764; 8 Wentw. Pl. 431; 1 Saund. 189; Fessenden on Patents, 406; Davis's Pat. Cas. 162; Boulton v. Bull, 2 H. B. 463.

patent grants; 5, the assignment, if there were one; 6, the infringement.

1. In setting forth that the patentee was the inventor, the words of the act are followed.

2. The invention is concisely stated by the mere title or general description in the patent.

3. In stating the grant of the patent in the words of the act, it is alleged that it was signed by the secretary,[11] and issued under the seal of the patent office. So the English practice requires the averment that the letters issued under the great seal, this being requisite to their validity.[12]

It must be averred that the patent was signed by the President. It is not necessary to aver that the requisite preliminary steps, to obtain a patent, were taken: it is enough to aver that the patent was granted in the form prescribed by law. Upon demurrer, the court will presume that every thing was rightly done to obtain it.[13]

Under the act of 1793, it was held that the declaration must aver that the patent *did issue*; that it was not enough to allege that it was made out in due form, under the seal and in the name of the Uni-

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[11] Fulton's Exr's. v. Myers, Coxe's Dig. 531.

[12] 2 Ins. 555; Coke's R. 18. To plead letters-patent without saying *suo magno sigillo* is naught, and that because the king has divers seals. Jay v. Bond, 1 Vent. 222.

[13] Cutting and others Exr's. of Fulton v. Myers, Coxe's Dig. 531; S. C. 4 Wash. C. C. R. 220.

ted States, by which there was granted, &c. The law prescribed that it should be delivered to the petitioner, and no person could take it till he had taken the oath and made the disclosure required in the second section of the law of 1793. The omission of this averment was held to be fatal on general demurrer.[14]

The phraseology of the act of 1793 differs a little from that of 1836 on this subject: the expressions *made out*, and *issued*, are not contrasted in the latter as in the former. Whether the above construction will be applied to the latter law, remains to be determined.

4. As to the statement of what is granted by the patent, where in an action for an infringement, the patent was recited in the declaration, but the specification, which was referred to in the patent as a part of it, was not recited, it was objected, in arrest of judgment, that the subject of the patent was not sufficiently described. But Mr. Justice Washington said the specification was matter of evidence to be used at the trial, and if a sight of it were necessary to the defence, the defendant might have had it placed upon the record by asking oyer of it, and

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[14] Cutting and others Exr's. of Fulton v. Myers, Coxe's Dig. 531; 4 Wash. C. C. R. 220.

that, at any rate, the defect, if any, was cured by verdict.[15]

5. On the subject of setting forth an assignment, a question respecting the averment of the recording occurred in an action for the infringement of the patent right of Williston's double reflecting bakers, brought by the assignee in his own name, in which case it was averred that Williston obtained a patent and exercised and enjoyed the right under it till June 20, 1831, and that he, by writing, under his hand of that date, sold and conveyed all his right and claim in said patent right to one John Robinson, as by said assignment in writing, in court to be produced, would fully appear, whereby said John Robinson, as assignee of said Williston, became, and was the true and lawful owner of said right, with the full and sole power in him and his assigns to make, use and vend the said improvement agreeably to the statutes aforesaid recited; and that Robinson exercised, used and enjoyed the right until the 29th of July, 1831, when, by assignment of that date, under his hand and seal, and in court to be produced, he granted, sold and conveyed all his right, title and interest in the said letters-patent, and the improvement therein specified and set forth, to the plaintiff, and that the plaintiff, from the time of making said last mentioned assign-

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[15] Gray & Osgood v. James and others, 1 Pet. C. C. R. 482.

ment had exercised, used and enjoyed the right, by himself, servants and deputies, to the time of bringing the action. The general issue being pleaded, a verdict was rendered for the plaintiff. The defendant then moved, in arrest of judgment, that the recording of neither assignment—the recording of both of which was necessary in order to give the plaintiff the whole right and enable him to bring an action in his own name,—was averred in the declaration.

Story J. "We are of opinion that the motion in arrest of judgment ought to be overruled. We accede to the doctrine stated at the bar, that a defective title cannot, after verdict, support a judgment, and, therefore, it constitutes a good ground for arresting the judgment. But the present is not such a case, but is merely the case of a good title defectively set forth. The defect complained of is the omission to state, that the assignments, on which the plaintiff's title is founded, were recorded in the office of the department of state; which is made essential to pass the title of the original patentee by the fourth section of the patent act of February 21, 1793, ch. 55. The general principle of law is, that where a matter is so essentially necessary to be proved to establish the plaintiff's right to recovery, that the jury could not be presumed to have found a verdict for him, unless it had been proved at the trial, there the omission to state that matter in express terms in the declaration, is cured by the verdict, if the gen-

eral terms of the declaration are otherwise sufficient to comprehend it. This was the doctrine of Lord Ellenborough in Jackson v. Pesked,[16] and it is very elaborately expounded by Mr. Sergeant Williams in his learned note to 1 Saund. R. 28, a. Now it seems to me that taking the whole declaration together, (however inartificially drawn,) the plaintiff sets up a title by the patent right by assignment, and the enjoyment and use of the right under that title, and that he has been injured in that right under that title by the piracy of the defendants. This cannot be true, nor could a verdict have been found by the jury, if the deeds of assignment had not been duly recorded, for unless that was done, nothing would pass by the deeds. The cases of Hitchins v. Stevens,[17] and McMurdo v. Smith,[18] cited at the bar, seem to us very strongly in point. So is France v. Tringer.[19] There are stronger analogous cases in equity, for it has been held that if a feoffment is stated without any averment of livery of seizin, or a bargain and sale without stating an enrollment, it is not a good cause of demurrer, but the court will intend it perfect.[20] As to the livery of seizin, it is far from being certain that if a feoffment is, in terms,

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[16] 1 M. & Selw. R. 234.

[17] 2 Shower R. 233. [18] 7 T. Rep. 518.

[19] Cro. Jac. 44.

[20] Harrison v. Hogg, 2 Ves. Jr. 323, 328.

proved, it is necessary, even at law, to aver it, since it is implied.[21] Upon the whole, judgment must be entered for the plaintiff according to the verdict."[22]

6. As to the averment of the infringement, it is sufficient to allege it in as broad terms as the declaration, and the specification in the patent.[23]

One allegation is necessary in the declaration in England, which we omit; namely, that of the enenrollment of the specification in the chancery office within the time prescribed in the letters-patent,[24] since no such subsequent enrollment is made with us, the specification being a part of the patent.

Sec. IV.—Plea. Defences. Notice of Defence.

In defence in an action for an infringement the defendant may deny that the patentee made the invention for which the letters-patent were granted, or that the invention was useful; that such letters-patent were granted; or allege defects in the specification; or deny that the letters-patent were assigned to the

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[21] See Co. Litt. 303—6; Throckmorton v. Tracey, Plowd. R. 149. See Spieres v. Parker, 1 T. R. 145, per Buller J.; 1 Saund. Rep. 228, a. Williams's note.

[22] Dobson v. Campbell, 1 Sumner's R. 319.

[23] Cutting and others Exr's. of Fulton v. Myers, Coxe's Dig. 531. S. C. 4 Wash. C. C. R. 220.

[24] 1 W. Saunders, 189, n. 2; and see id. 187, 271, and Saund. Pl. & Ev. 635.

plaintiff, if he brings his suit as assignee; or that the assignment is recorded; or that the patentee has infringed the patent right. If any of these grounds of defence appear in the declaration itself, the defendant may demur. Or if he does not demur, he may plead any of these defences specially, except the last; or he may plead the general issue, as usual in cases of this description,[25] and establish any of these grounds of defence by want of evidence on the part of the plaintiff, or by the evidence produced by himself.

If the defendant pleads specially that the patentee was *not the inventor*, he need not set out facts in his plea in support of it.[26]

The fifteenth section of the act of 1836 provides that the defendant, in an action for an infringement, shall be permitted to plead the general issue and to give this act and any 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 appear to have been made for the purpose of deceiving the public; or that the patentee was not the original

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[25] Gods. Pat. 177.

[26] Evans v. Kremer, 1 Pet. C. C. R. 215.

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 or allowance of the patentee before his application for a patent; or that he had surreptitiously or unjustly obtained a 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; 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. By section eight, of the same act, it is provided "that nothing in the act contained shall deprive the 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 within six months next preceding the filing of his specification and drawings."

The above provisions of the fifteenth section are mostly adopted from the sixth section of the act of 1793. In that act the provision as to surreptitiously obtaining a patent for the invention of another person, does not add "who was using reasonable diligence in adapting and perfecting the same;" so that, conversely and literally, this part of the act would read, that where a patentee has surreptitiously or unjustly obtained a patent for that which was invented or discovered by another, his patent shall nevertheless be valid, if that other is not using reasonable diligence in adapting and perfecting his invention. But by looking at the former part of the same section, we find that the patentee must be the "*original and first inventor.*" The construction of the two parts of the section taken together, is then, that if the patentee was the original inventor of the thing patented, his patent shall not be defeated by proof that another person had anticipated him in making the invention, unless it also be shown that such person was adapting and perfecting his invention. Or, in other words, if the patentee was an inventor of the thing patented, he shall not, in such case, be considered as having surreptitiously or

unjustly taken out a patent for what was invented by another.

A doubt early arose on the sixth section of the act of 1793, from which the preceding sections are mostly taken, whether any other defence could be made in an action for an infringement, grounded on objections to the novelty of the invention or on the defects in the specification, than those enumerated. That section contained one provision which is omitted in the substituted law of 1836, namely, that if the defendant made out either of the enumerated grounds of defence, not only judgment should be rendered for him with costs, but also "the patent should be declared void." The law of 1836 contains no provision for declaring the patent void as the result of an action for an infringement. The Supreme Court finally decided that the sixth section of the former law did not preclude the defendant from making any defence which he could have made had the act not contained the sixth section, and that he might make any of the defences enumerated in that section without giving the notice, the result being in such case also the same as if the law had not contained that section. The effect of the section was then merely that if the defendant, in an action for an infringement, desired to obtain a declaration that the patent was void, he must give the requisite notice of one of the enumerated grounds of defence, and, if it was made out, the court would declare the patent void.

The ground of defence in the action in which this decision was made, was that the specification did not contain a description of the invention in full, clear and exact terms; though the defect did not appear to have arisen from any intention to deceive the public. Marshall C. J. "Courts did not, perhaps, at first distinguish clearly between a defence which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement; and one which, if successful, would require the court, under the sixth section of the act, to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case, and for the particular purpose stated in the sixth section. The act of Parliament concerning monopolies contains an exception on which the grants of patents for inventions have issued in that country. The construction of so much of that exception as connects the specification with the patent, and makes the validity of the latter dependent on the correctness of the former, is applicable, we think, to proceedings under the third section of the American act. The English books are full of cases in which it has been held, that a defective specification is a good bar when pleaded

to, or a sufficient defence when given in evidence on the general issue, on an action brought for the infringement of a patent right."[27]

The ground of a similar interpretation is taken away in the law of 1836, since it contains no provision for declaring the patent void in such an action. The question then comes up under that law, what is the construction and effect of the 15th section? One thing is plain, that it does not preclude all other defences than those enumerated, for it does not provide for the case of an obscure specification from which it is not practicable to say what was patented, and yet the defence must be admissible in such a case, first, because the plaintiff cannot recover for violating a privilege which is not intelligibly described, and so cannot be known; and second, because the sixth section of the same act requires that the patentee shall give a description in full, clear and exact terms, and the court cannot disregard this provision. The notion might be suggested that the commissioner is to decide conclusively on the sufficiency of the specification in this respect, and his making out the patent is a certificate of his decision. But this construction is by no means admissible or practicable, for neither the court or jury can say that a privilege is infringed, of which no intelligible description is given.

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[27] Grant v. Raymond, 6 Peters's S. C. R. 218.

It is another defence not enumerated, that the plaintiff is not assignee; or that his assignment is not recorded.

But what proves conclusively that all the admissible defences are not enumerated in this section of the law of 1836, is, that the defence that the defendant never made, used or sold the thing patented, is not enumerated.

If, then, the section does not preclude all other than the enumerated defences, what is its construction? We shall find an answer to this inquiry in the decisions on the sixth section of the act of 1793, the languaage of which, in respect to the particular question under consideration was similar, viz. the defendant "shall be permitted" to give in evidence on the general issue such and such grounds of defence, of which notice had been given to the plaintiff. On that section Mr. Chief Justice Marshall, giving the opinion of the court, said, "The 6th section of the act appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading, when it allows him to give in evidence matter which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed, from an unfair use of this privilege. The notice is substituted for a special

plea; it is further to be observed, that it is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the *only* notice which the plaintiff can claim."[28]

So in a later case the same court says, "The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defence; except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires."[29]

The effect of the fifteenth section of the act of 1836, then, is, that in making the defences enumerated therein, the defendant must either plead specially or plead the general issue and give the notice required.

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[28] Evans v. Eaton, 3 Wheaton, 454; and see Evans v. Kremer, 1 Pet. C. C. R. 215, and 3 Wheat. 803, n.

[29] Grant v. Raymond, 6 Pet. S. C. R. 746.

CHAPTER XX.

Evidence in an Action for an Infringement.

Sec. 1. *On the part of the Plaintiff.*
2. *On the part of the Defendant.*
3. *Admissibility of Witnesses.*

Sec. I.—On the part of the Plaintiff.

Where the defendant pleads the usual plea of the general issue, the first evidence produced by the plaintiff, in an action for an infringement, is the patent and specification, and the assignment of the patent, if it be assigned. Certified copies of these from the patent office are made evidence.[1] In England the enrollment of the specification in due time must also be proved.[2]

Where the patent was for an improvement on a machine previously patented, Lord Tenterden ruled that the specifications of both inventions must be given in evidence. He said he would not say "what are improvements on a given thing without knowing what the thing was before."[3] But this must cer-

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[1] Stat. of 1836, s. 4.
[2] Watson v. Pears, 2 Camp. R. 294.
[3] Lewis v. Davis, 3 C. and P. 502.

tainly depend upon the manner in which the specification of the improvement is drawn up. If it refer to the former specification, so as, in fact, to include and incorporate it in itself, in the same manner as American patents include the specifications, then such former specification should doubtless be produced; but if the specification is sufficiently intelligible in itself, without recurring to the former one, there would not be the reason given by Lord Tenterden for requiring the production of the former specification.

Where an exemplification—that is, a certified copy under seal—of a patent is admissible, the statutes of 3d and 4th Ed. 6, c. 4, and 13 Eliz. c. 6, provide that an exemplification of only the part which is material, shall be necessary. But a mere extract is not admissible where it might operate as a surprise upon the opposite party, or deprive him of any benefit he might derive in case the whole were produced.[4]

The drawings, being a part of the specification, are produced in evidence with it.

In one case Mr. Justice Washington let unintelligible specifications and drawings—that is, those which he himself professed not to understand—go to the jury, that they might decide upon them for themselves.[5]

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[4] Attorney General v. Taylor, Prac. in Chan. 59; See Godson on Pat. 178.

[5] Gray & Osgood v. James & others, 1 Pet. C. C. R. 376.

The same judge ruled that an apparent ambiguity in the patent and specification might be cleared up by reference to the affidavit of the patentee at the time of taking out the patent.[6]

It is an established doctrine that divers valid patents cannot subsist for the same thing to different persons, or even to the same person.[7] The question then arises when divers patents are so issued, whether all, or only a part of them, are void, and if only a part, whether the first or last is in force. It was held in Massachusetts, where a machine was patented by one of two inventors, who at the time of taking out the patent supposed himself to be the sole inventor, and subsequently he joined the other in taking out a joint patent, that, as he had not assigned the first patent, being still proprietor of it, the joining in the second, was, in effect, a cancelling of the first.[8] In a case relating to the same invention, Mr. Justice Story held that a grant of a subsequent patent for an invention, is an estoppel to the patentee to set up any prior one for the same invention; and he adds, "I have very great doubts, whether, when a patent is once granted to any person for an invention, he can legally acquire any right under a subsequent patent for the same invention, unless his first patent be repealed for some original defect, so that

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[6] Pettibone v. Derringer, 4 Wash. C. C. R. 215, Coke's Dig. 532.
[7] Barrett v. Hall, 1 Mason's R. 429.
[8] Stearns v. Barrett, 1 Pick. R. 443.

it might truly be said to be a void patent."[9] Accordingly, where the patentee has, without first surrendering his patent, taken out a second, either solely or jointly with another, on the fact appearing, he cannot avail himself of the first, if he can of either.

The question occurs whether the production of the patent proves any thing more than the fact of the grant of it, and whether the plaintiff must next proceed to prove his *right* to such a grant, by showing that the invention is his own, is new and useful, and that he has reduced it to practice. On this subject Mr. Justice Buller said, "I do not agree with the counsel who have argued that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admit that it has been tried and succeeds. He must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this, on his part, is sufficient."[10]

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[9] Barrett & al. v. Hall & al. 1 Mason's R. 473.

[10] Turner v. Winter, 1 T. R. 606; and see Gods. on Pat. 178, who cites Boville v. Moore, Dav. Pat. Cas. 399, and Manton v. Manton, id. 348.

According to the practice in England, the inventor on petitioning for a patent, is required to make affidavit to his petition.[11] The act of Congress of 1836, s. 6, requires that the applicant for a patent shall 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 before known or used." The petition in the usual form in England alleges that the petitioner is the true and first inventor of the thing for which he solicits a patent, and that it has never before been used. Now both in England and the United States, this affidavit, where there is no conflicting claim, is the evidence on which the patent is granted. But according to Mr. Justice Buller, though it is evidence in the offices of the executive branch of government, it is not such in a court of justice, and the plaintiff must proceed to prove his case without any presumption in his favor.

In case of proceedings against the patentee for a repeal of the patent, under the act of 1793, s. 10, now repealed, Mr. Justice Story said: "In respect to the proof who was the inventor, the possession of the patent was *prima facie* evidence for the defend-

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[11] Godson on Pat. 139.

ant, *at least upon this process*;"[12] thus apparently implying a query whether the same presumption does not arise in favor of the patentee in other actions. But it is not a matter of great practical importance, whether such a presumption exists in favor of the patentee, since the slight *prima facie* evidence requisite may doubtless easily be obtained in support of any patent for which any possible pretence could be made out. The requisition by the law that the applicant shall make affidavit of a fact, seems to be a sufficient ground of presuming his affidavit to be true until the contrary is shown.

The fact of the novelty of the machine or method is not, as has already been suggested, necessarily involved in, and does not necessarily follow from, that of its invention by the patentee, for the same thing may be invented by different persons independently of each other. Proof, therefore, that the patentee invented the thing, does not, of itself, conclusively establish its novelty. Under the former law, the applicant, in the United States, only made affidavit of the invention, not that the thing was before unknown, as in England.

According to the course of proceeding in a case before Mr. Justice Washington, it was assumed that

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[12] Stearns v. Barrett, 1 Mason's R. 153.

the patent was not, itself, *prima facie* evidence of the novelty, for he ruled that a statement by a witness, that he had not seen or heard of the manufacture before he saw it at the workshop of the patentees, was sufficient evidence of the novelty, until it was contradicted.[13] This was assuming that the plaintiff must, in the first instance, give evidence of the novelty, for, otherwise, the whole evidence would have been superfluous ; so there would have been no question as to its sufficiency. This doctrine is also assumed as matter of practice in another case before the same judge.[14] By the law of 1836, the applicant makes oath as to the novelty of the invention, so that if the patent is *prima facie* evidence that the patentee was the inventor, it might be so of the novelty of the invention.

It is sufficient if it appear that the thing patented had not been known or used *before the invention* by the patentee; as distinguished from the *time of his application* for a patent.[15]

As to delay to take out a patent, and the extent to which the machine may have got into use in the meantime, this may raise the question of an aban-

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[13] Pennock and Sellers v. Dialogue, 4 Wash. C. C. R. 538.

[14] Dixon v. Moyer, 4 Wash. C. C. R. 68.

[15] Supra. p. 152; Treadwell and Watson v. Bladen, 4 Wash. C. C. R. 708; Evans v. Weiss, 2 Wash. C. C. R. 342; Goodyear v. Matthews. 1 Paine's R. 348; 1 Gallison's R. 438; Dixon v. Moyer, 4 Wash. C. C, R. 68.

donment of the invention by the inventor, and his dedication of it to the public, and it is not incumbent on the plaintiff to prove, in the first instance, that he has not abandoned or so dedicated his invention, unless he incurs that burthen by incidentally proving such delay, or other circumstances, as require explanation in order to rebut the inference of such an abandonment and dedication.

Under the act of congress of 1836, the citizenship of the patentee is material only in relation to the amount of the fee he is liable to pay; and as the payment of the fee is a matter which the court does not take into consideration, this being subject to the superintendence of the executive officer who issues the patent,[16] it seems to follow that no evidence of citizenship need be given by the plaintiff.

The fact of the grant and its extent are proved by the production of the patent. It was contended in one case that where the invention is described in the affidavit of the patentee, he will be limited to the invention so described, however extensive may be his specification; but this point was not decided by Mr. Justice Washington, before whom the case was pending, who only decided that the affidavit might be resorted to for an explanation of the ambiguity in the

[16] Whittemore v. Cutter, 1 Gall. R. 429.

patent, and this met the object of the defendant.[17] But the position assumed by the defendant in that case, seems not be tenable, for though ambiguities in the patent, of some descriptions, at least, may be cleared up by evidence *aliunde*, this is quite a different thing from holding that the obvious construction and meaning of the instrument may be controlled by such evidence.

The specification will, generally, also show *prima facie*, whether it is sufficient or defective.

The utility, as distinguished from the frivolity or perniciousness, and legality of the invention, will also, generally, appear from the specification.

The invention must be proved to have been reduced to practice;[18] and the plaintiff must show that it effects what the specification professes. In a case that occurred in the English court of Common Pleas in 1834, this is confounded with the utility of the invention. It was the case of a patent for a machine for spreading calicoes to be dried, and taking them up when dried. It was proved by the plaintiff that it would spread and take up calicoes, excepting those stiffened with clay for deceptive purposes. The jury found that it was "not useful in some cases for taking up goods;" meaning, as it seems, that it would not

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[17] Rattibone v. Derringer, 4 Wash. C. C. R. 215.

[18] Supra. ch. vii. s. 8; see also Evans v. Eaton, 1 Pet. C. C. R. 341.

take them up. Tindal J. "We think we are not warranted in drawing so strict a conclusion from this finding of the jury, as to hold that they have intended to negative, or that they have hereby negatived, that the machine was useful in the generality of cases which occur for that purpose. If the jury think it useful in general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void."[19]

Finally, to make out his case, the plaintiff must prove an infringement, in respect to which, the presumptions are in favor of the defendant. What is an infringement has been already considered.[20]

A patent right cannot be infringed until after the grant of the patent; it is, therefore, necessary to prove acts of infringement done subsequently to its date.[21]

It must be proved that the defendant has made, used or sold the *same* machine, or other subject for which the plaintiff has a patent. It is not enough that he has sold one that merely resembles it. The law does not require proof that it is precisely the same in form and proportions; it is sufficient if the distinguishing characteristics are the same.[22] "Machines are the same," says Mr. Justice Washington,

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[19] Howorth v. Hardcastle, 1 Bing. N. R. 182.
[20] Supra. c. xvii.
[21] Dixon v. Moyer, 4 Wash. C. C. R. 68; S. C. Coxe's Dig. 583.
[22] Dixon v. Moyer, 4 Wash. C. C. R. 68; S. C. Coxe's Dig. 532.

"if they operate in the same manner, and produce the same results, upon the same principles."[23]

It is upon this question of identity that patent cases very often turn. But as to the results, the most perfect similarity of products is not alone sufficient to establish the identity, since precisely similar products may be made by different machines and different processes. But where the products were precisely similar, Lord Tenterden ruled that this circumstance, taken together with acts of the defendant, may be ground to presume that the machines are the same, as where the defendant refused to permit his manufactory to be inspected.[24] In an action for an infringement of a patent for making ropes, in which it was proved that those of the defendant precisely resembled those made by the plaintiff's method, and that the defendant had refused to permit his manufactory to be examined for the purpose of furnishing evidence in the case, Lord Ellenborough remarked to the jury, "when one sees the rope of the defendant agree, in all its qualities, with a rope actually made upon the plaintiff's plan, it is *prima facie* evidence, till the contrary is shewn, that it was made upon his method."[25]

On this question the machines themselves, or re-

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[23] Gray and Osgood v. James, 1 Pet. C. C. R. 394.
[24] Hall v. Gervas and Boot, Gods. sup. 67.
[25] Huddart v. Grimshaw, Dav. Pat. Cas. 288.

duced models of them, are most frequently produced in court, so that the jury may themselves determine by inspection, whether they are the same, or different. In England the practice has been, in some cases, first to apply to a court of equity to appoint persons to inspect the manufactories, in order to prove the identity of the machines or processes.[26] The Circuit Court of the United States is presumed to have authority under the general equity powers given by the act of 1836, to appoint commissioners for the inspection of manufactories in a patent cause, on the application of a party for that purpose, where it should be made to appear that a comparison of the manufactures could not be satisfactorily made by models or samples, or other testimony. No instance has, however, been reported of the appointment of persons for this purpose, by our courts.

It is a frequent practice to call in witnesses skilled in the art or manufacture to which the invention relates, to testify as to the identity or diversity of the machines or methods in question. On this practice Mr. Justice Story remarks: "As to the opinion of skilful witnesses, whether the principles of two machines are the same, no person doubts that it is competent evidence to be introduced into a patent cause. But although the testimony of witnesses be admis-

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[26] Bovil v. Moore, Dav. Pat. Cas. 361, 182.

sible to prove the identity or diversity of machines in principle, yet after all it is but matter of opinion, and its weight must be judged of by all the other circumstances of the case. It is infinitely more satisfactory to ascertain, if we can, the precise differences and agreements; and, when these can be subjected to the eyes, they almost supersede all the evidence of mere opinion. In all my experience, I can scarcely recollect a single instance, in which the general question, whether the principles of two machines were the same, or different, has not produced from different witnesses, equally credible and equally intelligent, opposite answers. This would result only from the different meanings attached to the word, and from confounding its various senses. And this has been completely shown, when the same witnesses came to explain the precise agreements and differences, in which they have almost uniformly agreed. The case now before the court is a perfect proof in point. The witnesses differed as to the identity or diversity of the principles of the machines, but they all agreed in what were the precise differences and agreements in fact. There seemed, then, nothing left for the jury to decide, but whether these differences were substantial or formal; if substantial, then the machines were not alike; if formal only, then they were alike. And the question, whether the principles were the same in both machines, was, in reality, when all the facts were given,

rather a matter of law, than of the opinion of mechanics; at least matter of law was necessarily mixed up with it, which mechanics could not be presumed to be acquainted with."[27]

So Mr. Justice Washington remarks, that the opinions of such witnesses, in relation to the materiality of apparent differences, are always entitled to great respect, but that, after all, "the jury must judge for themselves, as well upon the information given, as upon their own view, where the articles, or models of them, are brought into court."[28]

Sec. II.—On the part of the Defendant.

The defendant, in action for an infringement, must, under the general issue, if the plaintiff has made out a *prima facie* case, show, either that the plaintiff is not entitled to an exclusive privilege claimed, or that he has not violated it. The essential requisites to the validity of the patent, have already been stated in the preceding chapters, and it is unnecessary to enumerate them here. If the defendant can render the plaintiff's title defective in any of these, the action for an infringement must fail; for there can be no violation of a privilege which is shown not to exist.

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[27] Barrett v. Hall, 1 Mason, 470, 471.
[28] Dixon v. Moyer, 4 Wash. C. C. R. 68.

On the subject of the novelty of the invention, if this is contested, the evidence must come mostly from the defendant, since that introduced by the plaintiff is necessarily of a negative character; and Sir Vicary Gibbs, C. J. says "fifty witnesses, testifying that they never saw the invention before, would be of no avail, if one were called who had seen it and practised it."[29]

This rule of evidence has, it seems, been subject to abuse in England by means of perjury. In the course of the examination, before the committee of the House of Commons, in 1829,[30] on the subject of patents, Mr. Benjamin Rotch makes a very striking statement as to the subornation of witnesses in trials of patent causes in England. He is objecting to the rule of law whereby a patent is held to be void if the alleged invention, or any part of it, had ever been known or practised at any former period, though dropped from use and not publicly known at the time of the new invention. He says he found, from experience, that the result of this rule is, that "if a clothier in the west of England has a patent, one single man is called from the north of England, who comes down into court, and having read the man's specification, stands up like a parrot, and will

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[29] Manton v. Manton, Dav. Pat. Cas. 250.

[30] P. 114.

be found to swear, fourteen or twenty years ago, I did so and so, and so and so, exactly verbatim, repeating the specification; the patent is upset; nobody can provide against such evidence as that: and I do not hesitate to say there is more perjury in that one particular than could be believed by a committee who have not experienced what we have. It is always the interest of the whole trade against the patentee combined; they combine their money in the first place, and then fight away and procure witnesses at any rate." Mr. John Farey, in his affidavit, reported by the same committee,[31] states that Durivel's patent, though his invention was a good one, was defeated by the testimony of one witness.

Mr. Justice Johnson was of opinion that such testimony may be rebutted by circumstantial evidence. In a case for an infringement of Whitney's patent for his cotton-gin, to prove that it was known before the invention by the patentee, two witnesses were produced, one of whom testified that he had seen a similar machine in England, seventeen years before, called a "teazor or devil;" the other testified that he had seen a similar machine in Ireland. Upon this point Mr. Justice Johnson remarked: "There are circumstances within the knowledge of all mankind, which prove the originality of this invention

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[31] P. 211.

more satisfactorily to the mind, than the direct testimony of a host of witnesses. The cotton plant furnished clothing to mankind before the age of Herodotus. The green seed is a species much more productive than the black, and by nature adapted to a much greater variety of climate; but by reason of the strong adherence of the fibre to the seed, without the aid of some more powerful machine for separating it, than any formerly known among us, the cultivation of it could never have been made an object. The machine, of which Mr. Whitney claims the invention, so facilitates the preparation of this species for use, that the cultivation of it has suddenly become an object of infinitely greater importance than that of the other species ever can be. Is it then to be imagined that, if this machine had been before discovered, the use of it would ever have been lost, or could have been confined to any tract of country left unexplored by commercial enterprise?"[32]

The provision in the act of Parliament, 5 and 6 W. 4, c. 83, s. 5, that in an action for an infringement, the defendant shall give notice of the objections to the patent which he intends to rely on at the trial, was intended probably to remedy such abuses. But the provision of the act of Congress of 1836, s. 15, is more effectual to prevent any such abuse, namely,

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[32] Whitney v. Fort, 1807; Fessenden on Patents, Ed. 1822, p. 134.

that "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 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." This notice enables the plaintiff to obtain counter evidence.

The novelty of an invention does not, as we have seen, depend merely upon the conception of it; for it is not considered to be an invention until it has been reduced to practice, and it is a sufficient ground of defence that it was not first reduced to practice by the patentee,[33] or that another had reduced it to practice before the patentee, as in the case of a bleaching process which was proved to have been practised by another six years before the patentee took out his patent.[34] And accordingly, conversely, it is no defence that another was the prior inventor, if he did not reduce the invention to use;[35] or, under the act of Congress of 1836, s. 15, if such other was not using due diligence in adapting and perfecting it. And evidence that the plaintiff's patent was for an invention made by a journeyman in his shop, with his consent, was held by Mr. Justice Washington not to be proof that the patent was *surreptitiously*

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[33] Woodcock v. Parker et al. 1 Gall. R. 436.

[34] Tennant's case, Dav. Pat. Cas. 429.

[35] Pennock and Sellers v. Dialogue, 4 Wash. C. C. R. 538.

obtained for the invention of another.[36] But such evidence is doubtless a good defence against a claim for damages for an infringement.

According to Lord Eldon's suggestion in one case, it is to no purpose for the defendant to prove a prior invention by another; for he says, in case of concurrent applications, "I can see no other mode of deciding than by awarding the patent to him who runs the quickest through the process."[37] But in the United States a prior invention by any one in the United States is a good defence, if such other is using due diligence to obtain a patent; but by the law of 1836, s. 1, proof of a prior invention in any foreign country where the invention has not been patented nor described in any public work, is not a good defence.

It is not a ground of defence that the patentee availed himself of the suggestions of another, unless they go to an essential part of the invention.[38] So it is a good defence that the invention itself was pre-

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[36] Dixon v. Mayor, 4 Wash. C. C. R. 68.

[37] Dyer ex parte, Rep. of Committee of House of Com. 1829, App. B. p. 197, Mr. Farey's Papers; and see Forsyth v. Reviere, Chit. Prac. of the Cr. 182. Under the French law, priority is determined by the date of the deposit of the specification. Rep. of Comm. of House of Com. 1829, p. 231.

[38] Pennock and Sellers v. Dialogue, 4 Wash. C. C. R. 578. In this case the doctrine on the effect of a suggestion by another is laid down in stronger terms than stated above in the text; but I apprehend that the inventor cannot claim a patent for any thing suggested by another, further than is stated in the text.

viously known, and was only used by the patentee to yield a product from a different material;[39] this is, in one sense, a new result, but it is not a good defence to show that it merely produced a new result, if by result be meant mode of operation or difference of process.[40] M. Perpigna[41] considers new proportions and a new result a good subject of a patent in France; but this ought to depend on the proportions being a material part of the process,[42] for these may constitute the principle of the invention.[43]

So the defendant may prove in defence a subsequent patent by the same patentee, either solely or jointly with another, for the whole or a part of the same invention.

Where a patent was taken out for five things, and subsequently by the same patentee and another for three of them, Mr. Justice Washington seemed to think the second patent a disclaimer of the first, so that the patentee could not recover for an infringement of it.[44] He supposes no surrender to have been made of the first; and so the position is that a

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[39] Supra, Ch. VII. s. VII.; Perpigna, p. 30.

[40] Pennock and Sellers v. Dialogue, 4 Wash. C. C. R. 438.

[41] Published in the Law Library, p. 29; English translation, p. 183.

[42] See supra, p. 134, Ch. VII. s. XII.

[43] Rep. of Comm. of House of Com. 1829, p. 732.

[44] Treadwell and Watson v. Bladen, 4 Wash. C. C. R. 709.

second patent for the same or a part of the same thing extinguishes the first.[45]

It has been said that different inventions cannot be joined in the same patent,[46] and if so, their being so joined will be ground of defence on the face of the patent itself.

So it is a decisive objection that the invention is unlawful[47] or pernicious.

It is a good ground of defence that the alleged invention is too slight a change to be the subject for a patent, as where by the former practice a roll of cloth was dipped in hot water, and this was the immersing it in steam.[48] But a substitution of gas flame for that of charcoal or paper was held a good subject for a patent. By Hall's patent, cotton fibres were singed from lace by carrying a gas flame by a current of air through the lace. Lace had previously been singed by the flames of charcoal or paper, the lace being stretched on a board or boot. The invention consisted in applying gas flame, in carrying the flame in a current of air, and in passing it *through* instead of *over* the lace. Abbott C. J. ruled the invention to be sufficient.[49]

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[45] See Morris v. Huntington, 1 Paine's R. 348.

[46] Moody v. Fiske, 2 Mason's R. 112.

[47] Supra, Ch. VII. s. XII. p. 128.

[48] The King v. Russell, Rep. of Committee of House of Commons, 1829, p. 211.

[49] Hall and Jervas v. Boot, Rep. of Com. of H. of Com. 1829, p. 208, App. Mr. Farey's Papers.

The patent is invalid where the patentee, although he may have proved himself to be the inventor, had abandoned his invention and dedicated it to the public before taking out his patent.[50] It is immaterial how the invention came to the knowledge and use of the public, whether by consent of the inventor or by piracy; in either case, if he does not, in reasonable time, take out a patent, but, on the contrary, looks on and acquiesces in the use of his invention by the public, his patent subsequently taken out is void.[51] And he is presumed to acquiesce where he knows or might know of the public use.[52] So if it was on sale with the allowance of the patentee before his application for the patent.[53]

The public use with the acquiescence of the inventor under a prior patent, does not avoid his second patent when the prior one has been surrendered.[54]

The use of a machine prior to the date of the patent having been proved, by the defendant, the plaintiff may show that it was by his license.

In an action for the infringement of a patent, in

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[50] See supra, Ch. VII. s. XIX. See also Pennock and Sellers v. Dialogue, 4 Wash. C. C. R. 544; Treadwell and Watson v. Bladen, 4 Wash. C. C. R. 708.

[51] Shaw v. Cooper, 7 Pet. S. C. R. 292.

[52] S. C. and see Whittemore v. Cutter, 1 Gall. R. 482. Act of 1836, c. 357, s. 6.

[53] Act of Congress, 1836, c. 377 s. 15.

[54] Morris v. Huntington, 1 Paine's R. 345; Shaw v. Cooper, 7 Wheat. 292; and see 4 Mason's R. 108; 4 Wash. C. C. R. 438, 703.

the Circuit Court for Pennsylvania, the defendant proved that the patented machine had been in use previously to the alleged invention by the plaintiff. The plaintiff then offered to prove that the persons, of whose prior use of the machine the defendant had given testimony, had paid the plaintiff for licenses to use the machine since his patent. This testimony was rejected by the Circuit Court, and the plaintiff thereupon excepted. Marshall C. J. "The testimony offered by the plaintiff was entitled to very little weight, but ought not to have been absolutely rejected. Connected with other testimony, and under some circumstances, even the opinion of a party may be worth something. It is, therefore, in such a case as this, deemed more safe to permit it to go to the jury, subject, as all testimony is, to the animadversion of the court, than entirely to exclude it."[55]

Whether mere delay of the inventor to take out a patent, without any acquiescence on his part in the public use of his invention in the mean time, or without any use or knowledge of it on the part of public in the mean time, is a good ground of defence, is a question on which the cases do not perfectly agree.[56] It is no objection that the inventor took reasonable time to perfect his invention; but some

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[55] Evans v. Eaton, 3 Wheaton, 454.

[56] See supra, Ch. VII. s. XIX.

cases go much further than this,[57] and consider a use for six or seven years by the inventor himself as no forfeiture of his right to a patent, but this doctrine is very questionable, as already suggested.[58]

A judgment in favor of the patent in a former case for an infringement is not, in a subsequent action for an infringement of the same patent, any estoppel on the defendant against the defence that the patent is void.

Nor is an award of examiners, under the act of 1836, s. 7, in favor of one of the applicants, any estoppel on the other applicant or any other person against contesting the patent.[59] But it has been held that the defendant, in an action against him for infringing a patent which he himself had assigned to the plaintiff, is estopped from giving evidence to prove that the invention was not new.[60]

A material defect in the specification is a ground of defence, whether designed or accidental.[61] Mr. Justice Thompson is reported to have stated, in one case, that specifying the whole machine in a patent for an improvement, does not prevent the patent

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[57] Morris v. Huntington, 1 Paine's R. 354; Goodyear v. Mathews, 1 Paine's R. 301.

[58] Infra, Ch. XXIII.

[59] Act of 1836, s. 12; and see remarks of Mr. Justice Story, speaking of the similar provision of the act of 1793. Stearns v. Barrett, 1 Mason's R. 174.

[60] Oldham v. Longmead, cited 3 T. R. 439, 441.

[61] Supra. Ch. XVII. Rese v. Cutler, 1 Stark. R. 354.

from being good for the improvement, though it is not distinguished.[62] But the cases seem to be otherwise. The act of congress of 1836, s. 15, in enumerating the defences which may be given under the general issue with notice, does not mention the obscurity or ambiguity, or other defect of the specification through mistake, but the sixth section requires that the specification shall give a description "in full, clear and exact terms," which provision would have no force, if the patentee could recover for an infringement, notwithstanding he had not given such a description, through inadvertency or mistake.

What degree of evidence ought to be required to prove a fraudulent concealment by the patentee in the specification, must rest with the jury to decide. Positive evidence seldom is expected, nor is it necessary. The law requires that such intention should fully appear, but still it may be presumed from circumstances, as if the parts concealed are so essential and so obviously necessary to be disclosed, that no mechanic, skilled in the art, could reasonably be expected to understand the subject, so as from the description given to make the machine, it would be difficult to impute the omission of the patentee to a fair motive.[63]

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[62] Goodyear v. Mathews, 1 Paine, 300.

[63] Per Washington J. Gray and Osgood v. James and others, 1 Pet. C. C. R. 196, p. 402.

Mr. Justice Johnson, at first, entertained the same opinion with other judges of the Supreme Court,[64] that the patent was not defeated by a concealment in the specification made through mistake.[65]

In a case before Mr. Justice Washington, in 1817, he doubted whether the defendant could, under the general issue, give evidence that the invention was not useful.[66] The ground of his doubt was, that it would be a surprise upon the plaintiff. But no such doubt is intimated in any other case, and it is not apparent that this would be any more a matter of surprise than any other defence that should attack the validity of the patent, and that other defences having that bearing, may be resorted to, is matter of daily practice.[67]

Mr. Justice Washington remarked, in the case first cited, that this defence that the invention was not useful, came with an ill grace from a defendant who was using it.[68] But it is admissible, and its weight is left to the jury.[69]

On the question whether mere delay to take out a patent, may invalidate it, Mr. Justice Washington remarks: "It is possible that, without any public

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[64] Supra, Ch. XI. s. X.

[65] Whitney v. Carter, 1807, Fessenden on Pat., Ed. 1822, p. 139.

[66] Gray and Osgood v. James and others, 1 Pet. C. C. R. 403.

[67] See Langdon v. De Groot, 1 Paine, 203.

[68] Gray and Osgood v. James and others, 1 Pet. C. C. R. 403; and see supra, p. 140.

[69] Langdon v. De Groot, 1 Paine, 203; Howorth v. Hardcastle, 1 Bing. N. R. 182.

use by others, an unreasonable and causeless, or faulty delay in taking out his patent, might be justly, and upon legal principles, considered as amounting to an abandonment; as to which, however, I *avoid giving an opinion.*"[70]

But, as we have seen, mere delay for the purpose of making an experiment of the invention, will not invalidate the patent,[71] on the defence being urged that the invention had been practised by the inventor, and by another person, before application was made for the patent; Mr. Justice Washington remarked, "If there be any solidity in this argument, the patent law would very nearly become a dead letter, as every inventor uses the machine he invents before he applies for a patent, with a view to satisfy himself whether it answers the purpose for which it was intended."[72] If any doubts existed on this subject before the act of 1836, that act settles them, since the fifteenth section distinctly recognises the right of the inventor to take sufficient time to adapt and perfect his invention, or in other words, to bring it to bear, before taking out his patent.

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[70] Treadwell and Watson v. Bladen, 4 Wash. C. C. R. 708. Vide supra, Ch. VII. s. XIX.

[71] Ch. VII. s. XIX.

[72] Treadwell and Watson v. Bladen, Wash. C. C. R. 707.

Sec. III.—Admissibility of Witnesses and Testimony.

It is held that persons who have used the machine for which the patent is taken out, are not thereby rendered incompetent as witnesses, on account of interest ; even where the object of the defence was not merely to defeat the claim for damages, but also to have the patent declared void.[73]

A witness, being patentee in another patent, had sold to the defendant the right to use the machine, the use of which was complained of as an infringement; held that he was a competent witness notwithstanding, since any verdict that the plaintiff might recover, could not be given in evidence by the plaintiff in a suit against the witness.[74]

On a *scire facias* to repeal a patent for a machine, for the roving, preparing and spinning of wool, on the ground that it was not new ; a witness testified that he had long before the patent, constructed a machine for the same purposes ; and to show that it was similar to the defendant's machine, the counsel for the prosecution put into the hands of the witness a drawing of the machine constructed by him ; the drawing, however, was not made by the witness. *It*

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[73] Evans v. Eaton, 7 Wheat. R. 356; Evans v. Hettich, 7 Wheat. R. 453.

[74] Treadwell and Watson v. Bladen, 4 Wash. C. C. R. 704.

was objected that he ought not to look at it, but should describe the machine he had constructed. Bayley J. "I think the witness may look at the drawing, and you may ask him whether he has such a recollection of the machine he made, as to be able to say that that is a correct drawing of it."[75]

CHAPTER XXI.

Law and Fact.

THERE is nothing peculiar to patent causes as distinguishing them from others, as to the respective provinces of the court and jury.

It is a general rule, applicable in trials of actions for the infringement of patents, as well as in other trials, that the construction of a written instrument, is matter for the court, as far as the construction is to be determined by the instrument itself, or by a reference to statutes and principles of law merely, but the meaning of particular words and phrases, as governed by custom, is matter of fact for the jury. This rule applies to the patent and specification.[1]

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[75] Rex v. Hadden, 2 Car. and P. 184.
[1] The King v. Wheeler, 2 B. & A. 348.

Accordingly, where the inquiry is whether the invention be sufficiently described in the specification, where it can be decided only by an examination of the machine, this is a question for the jury.[2] But if the question be, whether the specification is susceptible of any sensible construction, there being no dispute about the meaning of the words and phrases, it should seem to be a matter for the determination of the court, since the court must decide on a construction, and it seems to follow that they must decide whether the instrument admits of any sensible construction. Whether the invention be described with reasonable certainty was accordingly ruled by Mr. Justice Story to be for the court.[3] Though Lord Eldon intimates that the question of the intelligibility of the specification is for the jury.[4] And Mr. Justice Washington, in a case where he professed that he could make no sense of the specification and drawings, submitted them to the jury, to make what they could of them.[5]

Whether a specification be so clear and full, as to enable a person of ordinary skill 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, is a question of fact ;[6] since what is, or is not

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[2] Evans v. Eaton, 7 Wheat. 428.
[3] 1 Mason's R. 190.
[4] Hill v. Thompson, 3 Meriv. 630.
[5] Gray and Osgood v. James, 1 Pet. C. C. R. 400.
[6] Per Story J. Lowell v. Lewis, 1 Mason, 190.

ordinary skill, is so. But this is a different question from that whether the language in connexion with the drawings and other helps to the meaning which it is allowable to resort to, such as dictionaries and the common usage, is sense or nonsense.

The question of infringement or no infringement is generally, if not invariably, for the jury.[7] Whether the patentee is the inventor of any part, or of the whole machine, is matter of fact ;[8] and the jury must, accordingly, determine on the identity of the machine with, or its diversity from, one before known.[9] So Mr. Justice Story ruled that "whether the principles of a machine are altogether new, or whether the machine be an improvement only, on those which have been in use before the invention, is a *question for the jury to decide.*[10]

In an action for an infringement of a patent for an improvement in the construction of pumps, Mr. Justice Story held that the question, whether the differences between the pumps constructed by the plaintiff, and those by the defendant, were mere change of form, without any material alteration in the structure, or whether they were substantially

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[7] *Boulton v. Bull*, 2 H. Bl. 4.

[8] Whittemore v. Cutter, 1 Gallis. 478.

[9] Pennock and Sellers v. Dialogue, 4 Wash. C. C. R. 538.

[10] Whittemore v. Cutter, 1 Gallison, 478.

different combinations of mechanical parts, to effect the same purposes, was a question of fact.[11]

But in a case before Lord Wynford for an infringement of Barton's patent for an improvement in metallic pistons of steam-engines, the court took upon itself to decide that the pistons, which were alleged to be infringements, were not the same invention as that described in the plaintiff's specification.[12] The doctrine of this case is directly inconsistent with that of those above cited.

Whether the invention be useful, has been held, in some cases, to be for the court, in others for the jury. It must depend upon the ground upon which the utility is impeached; if upon the ground that the specification itself, without going further, shows that the invention is against law or good morals, the court decides the question. Mr. Justice Livingston says that, "where it becomes a matter of inquiry whether the benefits of an invention are of sufficient consequence to be protected by the arm of the government, it may be proper to leave such question with the jury. But where the objection raised is, that the invention, on the plaintiff's own showing, is not only of no use, but an imposition on the public, it may be doubted whether a court transcends its

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[11] Lowell v. Lewis, 1 Mason, 191.

[12] *Barton v. Hale*, Godson's Supplement, p. 65.

prescribed limits, in taking upon itself a decision of it."[13] The word *imposition* is of doubtful signification as applied to the case under consideration, which was that of a patent for a particular mode of winding cotton thread in balls, and wrapping them, not for the method or process, but for the disposition of the thread in the balls, and the form of wrapping, things which could not, it is evident, like a new composition of matter, be patentable. Admitting that the patentee might have obtained a valid patent for his method or process, he certainly could not for the result, so as to exclude others from effecting the same thing by a different method or process. The patent was, therefore, void, as being for a subject not patentable. But this is not the imposition intended by the judge. If the patentee wound the balls full of interstices by means of crossing the threads so as to make a larger ball of the same quantity, and wrapped the balls in a way to strike the fancy of purchasers, and deceive them with their eyes open, this was a kind of imposition, if such it may be called, which is daily practised in shops and manufactories. It would be going very far to set the patent aside as not being useful on account of its fraudulent character. But the court seemed to view the method or invention, or whatever the subject of this patent is

[13] Langdon v. De Groot, 1 Paine, 203

to be denominated, in this light, and thus considered it to be a question for the court. The decision, in this view, seems to be very questionable.

But the method might be considered to be too frivolous to be the subject of a patent, and so liable to the objection that it was not useful in this sense of utility, as distinguished from frivolousness. But in this construction, also, it seems rather to have been a question for the jury.

Lord Eldon considers the question of the utility of the invention to belong to the jury.[14]

Lord Eldon considers the question, whether the patent covers too much, to be for the court.[15] But he must have had in his mind the case of its appearing from the specification and patent, that the patentee claimed too much, as where he describes an old machine and his improvement, and claims the whole machine as thus improved; but if it be necessary to go out of the patent for proof of what was known before, this plainly presents a question for the jury.

It was a question much discussed whether the process for the repeal of a patent under the tenth section of the law of 1793, was to be adjudicated upon by the court alone, or by jury trial; and after a full

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[14] Hill v. Thompson, 3 Meriv. 632.

[15] Hill v. Thompson, 3 Meriv. 630.

discussion, the decision was in favor of a trial by jury.[16] This decision is highly approved by Mr. Chancellor Kent.[17]

CHAPTER XXII.

Damages.

By the act of 1800, in case of an infringement, the jury were to assess the actual damages and these were trebled by the court.[1]

By the act of 1836, s. 14, it is provided, "that whenever, in any action for damages for using or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or which shall 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

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[16] Ex parte, Wood, 9 Wheat. 603.

[17] Com. v. 1, p. 381.

[1] See Lowell v. Lewis. 1 Mason's R. 182; Whittemore v. Cutter, 1 Gall. R. 484; Odiorne v. Winkley, 2 Gall. R. 51. By the French law, the infringing party forfeits the articles made in violation of the patent right. Renouard c. 10, s. 3, p. 361, Ed. of 1825. This was the provision of the act of Congress of 1790; also act 1800, c. 25, s. 3.

the amount found by such judgment as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case."

When, on account of some defect in the specification, a patent is surrendered and a new one taken out, damage can be recovered for an infringement only for the time subsequent to the taking out of the new patent.[2]

It has been held, by Mr. Justice Story, that the making of a patented machine for experiment or philosophical purposes merely, and not for use, sale or profit, is not an infringement, but that the making of it for sale, use or profit, though without any sale or use, and though no profit is made, is an infringement, but that the damage, in such case, is only nominal. This decision was made under the law of 1793, but is applicable to that of 1836.

In an action for an infringement, the jury were instructed that the making of the patented machine fit for use, and *with a design to use it for profit*, was an infringement, for which an action was given by the statute. This direction was objected to, on the part of the defendant. Story J. "This limitation of the making, was certainly favorable to the defen-

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[2] Act of Congress, 1836, c. 357, s. 13. See Ames v. Howard, 1 Sumner's R. 482.

dant, and it was adopted by the court from the consideration, that it could never have been the intention of the legislature to punish a man who constructed such a machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects. It is now contended by the defendant's counsel, that the making of a machine is, under no circumstances, an infringement of the patent. The first section of the act of 1793 expressly gives to the patentee, &c. 'the full and exclusive right and liberty of making, constructing, using and vending to others to be used,' the invention or discovery. The fifth section of the same act gives an action against any person who 'shall make, devise, and use or sell' the same. From some doubt whether the language of the section did not couple the *making* and *using* together, to constitute an offence, so that making, without using, or using without making, was not an infringement; the legislature saw fit to repeal that section; and by the third section of the act of 1800, c. 25, gave the action against any person who should 'make, devise, use or sell' the invention. We are not called upon to examine the correctness of the original doubt, but the very change in the structure of the sentence affords a strong presumption, that the legislature intended to make every one of the enumerated acts a substantive ground of action. It is argued, however, that the words are

to be construed distributively, and that 'making' is meant to be applied to the case of a *composition* of matter, and not to the case of a machine; that it is clear that the use of certain compositions, as patented pills, could not be an infringement, and unless making was so, there could be no remedy in such cases. We cannot feel the force of this distinction. The word 'making' is equally as applicable to machines, as to compositions of matter; and we see no difficulty in holding that the using or vending of a patented composition, is a violation of the right of the proprietor. It is farther argued, that the making of a machine cannot be an offence, because no action lies except for *actual damage*, and there can be no actual damages, or even a rule for damages for an infringement, by making a machine. We are, however, of opinion, that where the law gives an action for a particular act, the doing of that act imports, of itself, a damage to the party. Every violation of a right imports some damage, and if none other be proved, the law allows a nominal damage. We see no reason for departing from the plain import of the language of the statute, and the objection must be overruled."[3]

In the same case the plaintiff argued, that, al-

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[3] Whittemore v. Cutter, 1 Gallison, 429.

though there was no evidence of actual damage, the jury ought to give damages either to the full value of the expense of making the machine, or of the price at which such a machine might be sold. Story J. said, that "neither of these estimates could form a rule for damages for the illegal making of the machine. As to the expense of making the machine, it is obvious that it is an expense altogether incurred by the defendant, and is not a loss sustained by the plaintiffs. The latter neither found the materials nor the labor. How then can it be an actual damage sustained by them? As to the price for which such a machine would sell, it is open to the same, and to this farther objection, that the *price* is compounded of the value of the materials and the workmanship, and also of the *right of user* of the machine. Now, admitting the plaintiffs recover in this action, there can be no pretence, that thereby a legal right will pass to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiffs' patent; and, therefore, if the plaintiffs could, in this suit, recover such price, they not only would recover for materials and labor which they never furnished, and for a right of user which never passed from them, but, also, for that which might lawfully be the subject of another action; to wit, the future user of the defendant's machine; so that there

might be a double recovery for the same supposed injury."[4]

Mr. Justice Story says, in regard to the expression, *actual damages*, in the act of congress: "By the term 'actual damages,' in the statute, are meant such damages, as the plaintiffs can actually prove, and have, in fact, sustained, as contradistinguished to mere imaginary or exemplary damages, which, in personal torts, are sometimes given. The statute is highly penal, and the legislature meant to limit the single damages to the real injury done, as in other cases of violation of personal property, or of incorporeal right."[5]

In the case of an infringement by using the machine, there always is *some* damage proved. The very fact of the defendant's using the machine is a practical admission of the value of the use. Mr. Justice Story laid down the general rule, in one case, that in an action for an infringement the damages should be estimated as high as they can be, consistently with the rule of law on this subject, if the plaintiff's patent has been violated; that wrong doers may not reap the fruits of the labor and genius of other men.[6] But in a subsequent case before

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[4] Whittemore v. Cutter, 1 Gallison, 483.

[5] Whittemore v. Cutter, 1 Gallison. 482.

[6] Lowell v. Lewis, 1 Mason, 182.

cited,[7] the same judge, considering the trebling of the damages to be a sufficient discouragement to wrong-doers, seems to limit the rule of single damages more rigidly. His reasoning is as follows :

"It has been maintained by some learned persons that the price of the invented machine is a proper measure of damages, in cases where there has been a piracy by making and using the machine, because, in such cases, the verdict for the plaintiff entitles the defendant to use the machine subsequently, and, in short, transfers the right to him in the fullest manner, and in the same way, that a recovery in trover or trespass, for a machine, by operation of law, transfers the right to such machine to the trespasser, for he has paid for it. If I thought such was the legal operation of a verdict for the plaintiff, in an action for making and using a machine, no objection would very forcibly occur to my mind against the rule. But my difficulty lies here. The patent act gives to the inventor the exclusive right of making and using his invention during the period of fourteen years. But this construction of the law enables any person to acquire that right, by a forced sale, against the patentee, and compels him to sell, as to persons or places, when it may interfere essentially with his permanent interest, and involve him in the

[7] Whittemore v. Cutter.

breach of prior contracts. Thus the right would not remain exclusive; but the very attempt to enforce it would involve the patentee in the necessity of parting with it. The rule itself, too, has no merit from its universality of application. How could it apply, when the patentee had never sold the right to any one? How, when the value of the right depended upon the circumstance of the right being confined to a few persons? Where would be the justice of its application, if the invention were of enormous value and profit, if confined to one or two persons, and of very small value if used by the public at large; for the result of the principle would be, that all the public might purchase and use it by a forced judicial sale. On the other hand, cases may occur where the wrong done to the patentee may very far exceed the price which he would be willing to take for a limited use by a limited number of persons. These, among others, are difficulties which press on my mind against the adoption of the rule; and where the declaration goes for a user during a limited period, and afterwards the party sues for a user during another and subsequent period, I am unable to perceive how a verdict and judgment in the former case is a legal bar to a recovery in the second action. The piracy is not the same, nor is the gravamen the same. If indeed the plaintiff, at the trial, consents that the defendant shall have the full benefit of the machine for ever, upon the ground

of receiving the full price in damages, and the defendant is content with this arrangement, there may be no solid objection to it in such a case. But I do not yet perceive, how the court can force the defendant to purchase, any more than the plaintiff to sell, the patent right, for the whole period it has to run. The defendant may be an innocent violator of the plaintiff's right; or he may have ceased to use, or to have employment for, such a machine." There are other objections alluded to in the case in 1 Gallison, 429.[8]

"Struck with similar difficulties in establishing any general rule to govern cases upon patents, some learned judges have refused to lay down any particular rule of damages, and have left the jury at large to estimate the actual damages according to the circumstances of each particular case. I rather incline to believe this to be the true course. There is a great difference between laying down a special and limited rule as a true measure of damages, and leaving the subject entirely open, upon the proofs in the cause, for the consideration of the jury. The price of the machine, the nature, actual state and extent of the use of the plaintiff's invention, and the particular losses to which he may have been subjected by the piracy, are all proper ingredients to

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[8] Whittemore v. Cutter.

be weighed by the jury in estimating the damages, *valere quantum valeant.*"[9]

In one of the cases already cited above, the same learned judge remarks that the rule for damages, in an action for an infringement of a patent, is the amount of the profits actually received by the defendant in consequence of his using the plaintiff's invention.[10] This is virtually assuming that the plaintiff's damages shall be considered *at least* equal to the defendant's actual profits by using the machine; that is, that if the defendant had not used the machine without license, it shall be presumed he would have given the plaintiff for the privilege of using it, what he could actually make. Perhaps, however, the plaintiff has a fixed price for a license, in which case it might be said, that if it be less than the profit made by the defendant, the former ought to be the rule, and that is the actual damage of the plaintiff. On the other hand, it would be unjust to the patentee that the defendant should make a profit by the infringement, especially if it was intentional. In this, as in other cases, the circumstances of aggravation or excuse are taken into consideration by the jury, who would, perhaps, be justified in presuming that the plaintiff would have made the same profit which the defendant has, had not the defend-

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[9] Earle v. Sawyer, 4 Mason, 1.

[10] Lowell v. Lewis, 1 Mason, 182.

ant committed the infringement, and accordingly that this is the measure of damages; for though the rate at which the privilege is ordinarily sold is a less sum, and it is not certain that the plaintiff would not have demanded of him a higher rate, or that he would not have used his invention himself, and thus made the same profit, still it is to be considered that, in these cases, the statute, at the time of the above decision, trebled the actual damage, without any discrimination as to the circumstances of aggravation or extenuation of the infringement; and this is a sufficient protection to the plaintiff's rights. If the privilege is a matter of frequent sale, and bears a fixed, well-known market value, this has one very material advantage over a computation of the defendant's profit, as a rule of damages, since such a computation is generally one of much difficulty, in which the party directly interested in the result, and who has the best means of calculation, is liable to great mistakes, to which witnesses and jurymen must be still more liable. Another circumstance weighs something in favor of this rule, that the small profit or actual loss made by the defendant, cannot be alleged in reduction of the damage which the plaintiff has actually sustained; and this is a reason why undue and aggravated weight should not, at least, be allowed to evidence of a profit far exceeding the actual damage which the plaintiff has proba-

bly sustained; and to this he is limited by the words of the statutes both of 1793 and 1836.

In Arkwright's case, the fact that the patentee, after a verdict against him, in 1781, had lain by for four years before bringing another action for an infringement, when many persons were notoriously using the machine, was considered by Lord Loughborough as material in fixing the damages. He said, "It has been said that many persons have acted upon an idea that Mr. Arkwright had no right, he having failed to establish it when this cause underwent an examination in another place, in which the event was unfavorable to him. If the question at present were what damages Mr. Arkwright should have received for the invading that right, I would have allowed the parties to have gone into evidence, to show to what extent persons had acted upon the faith of the former verdict; but the question now is upon the mere right; and if the result of this cause is in favor of the plaintiff, the verdict will be with one shilling damages. A future invasion of this right would entilte Mr. Arkwright to an action for damages, but in the present case they are not asked."[11]

In the United States the express provisions of the statute present a strong objection to any such rule.

The question was made, in a case that came before

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[11] Arkwright v. Nightingale, Dav. Pat. Cas. 55.

Mr. Justice Story, in 1813, whether, in an action for the infringement of a patent right, the expenses incurred by the plaintiff for counsel fees are to be considered as items of actual damage. Story J. "At the trial, we had considered, that it was the established rule to consider counsel fees and the expenses of witnesses beyond the taxable costs, as items of actual damage, in estimating damages in cases of mere tort, whether the action was for the redress of a personal injury, or the vindication of a personal right. Since the trial, however, we have seen the case of Arcambel v. Wiseman, 3 Dallas, 306, in which the question as to counsel fees, was directly before the Supreme Court. There can be no doubt that the case was founded on a tort; and we feel ourselves bound by that decision, whatever might have been the opinion we should otherwise have been disposed to entertain."[12]

But in a subsequent case, in 1820, the same judge held that in an action for the infringement of a patent, the jury are at liberty, if they see fit, to allow the plaintiff as part of his "actual damages," any expenditure for counsel fees, or other charges, which were necessarily incurred to vindicate the rights derived under his patent, and are not taxable in the bill of costs. Story J. "I feel myself bound to

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[12] Whittemore v. Cutter, 1 Gallison, 429.

declare, that as the authority of Arcambel v. Wiseman, 3 Dall. 306, is shaken, so far as it can be considered as containing any general doctrine governing cases of this nature, I return to what I originally considered the true doctrine."[13]

CHAPTER XXIII.

Effect of a Judgment.

The success of the defendant, in an action for an infringement, on the ground of the invalidity of the patent, does not prevent the plaintiff from instituting another suit against any other person for an infringement of his patent. A judgment is conclusive only between the parties to it, and upon the subject matter of the suit, that is, the infringement complained of. It is not conclusive between the same parties, as to the continuation of the same supposed infringement subsequently to the time covered by the first declaration; for the subsequent infringement, if it differs in nothing else, differs at least in time. In Arkwright's case, where the patentee, having failed

[13] Boston Manuf. Co. v. Fiske, 2 Mason, 119.

in one suit for an infringement, after lying by four years, brought an action against another person, Lord Loughborough said, "It is said, it is highly expedient for the public that this patent, having been so long in public use after Mr. Arkwright had failed in that trial, should continue to be open; but nothing could be more essentially mischievous than that questions of property between A and B should ever be permitted to be decided upon considerations of public convenience or expediency. The only question that can be agitated in Westminster Hall is, which of the two parties in law or justice ought to recover."[1] If one defendant has failed by making a bad defence, this is no reason why another should be concluded from making a good one if the case admits it.

So the success of the patentee, in an action for a subsequent infringement, is not necessarily inconsistent with his failure in a former one for a previous infringement, since the evidence in the two cases may be materially different. But a party coming into court to obtain a different result from that in a former suit, to which he was a party, evidently comes under some disadvantage.

By the act of Parliament of 5 and 6 W. 4, c. 83, s. 3, it is provided that in case of a verdict, or final

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[1] Arkwright v. Nightingale, Dav. Pat. Cas. 55.

decree or decretal order, on the merits in favor of the patentee or his assignees, in any action at law or suit in equity in respect to an infringement, or a *scire facias* to repeal the letters-patent, the judge may certify that the validity of the patent came in question, which certificate being given in evidence in any future suit touching the patent, if the verdict or decree shall be in favor of the patentee, he shall be entitled to treble costs, unless the judge shall, in such subsequent suit, certify that the patentee ought not to have treble costs.

In patent causes, as in others, a new trial will not be granted, except in very strong cases; not merely for newly discovered cumulative evidence.[2]

If either party is surprised by evidence produced by the other, which he wishes for an opportunity to obtain other evidence to rebut, he must move for a continuance of the action to give him an opportunity to produce other evidence, he cannot go on and take the chance of a trial upon the evidence he has; and, on the verdict being against him, make the subject of the surprise a ground of motion for a new trial. By going on he makes an election to waive the objection.[3]

Where the court gives an instruction to the jury

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[2] Ames v. Howard, 1 Sumner's R. 482. See also Haworth v. Hardcastle, 1 Bing. N. R. 182.

[3] Ames v. Howard, 1 Sumner's R. 482.

on the *weight* of the testimony, or so instructs them as to convey an opinion as to the weight of the testimony, and a party objects, and thereupon the court withdraws the instruction, this is no ground for a motion for a new trial, for the comment is not presumed to have had any influence upon the verdict.[4]

CHAPTER XXIV.

Injunction.

A PROCEEDING whereby an infringement of a patent right may be stopped, is essential to the security of patentees, since the remedy at law for damages will not, in all cases, afford an adequate indemnity.

This preventive remedy is by a bill for an injunction, in which the patentee, or his representative, after setting forth the patent and his right under it, and the infringement, prays the court to enjoin the party complained of to stop the infringement. This proceeding is merely prospective, it does not give

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[4] Ames v. Howard, 1 Sumner's R. 582.

the patentee compensation for the damage previously occasioned, nor does it conclusively try the validity of the patent right. The proceeding is ancillary, merely, to the action at law for damages; which may be commenced before, or at the same time with, or after the bill for an injunction. And it is frequently made a condition of the continuance of the injunction, that the patentee shall, within a certain time, or as soon as may be, bring his action at law for the infringement.

All persons interested in the infringement, whether as patentees, assignees, or by license, should be joined as plaintiffs in such a bill.[1]

A bill for an injunction lies against a corporation, but where different persons have infringed the same patent, independently of each other, they cannot be joined in the same bill.[2]

The granting of an injunction is, in some degree, a matter of discretion with the court in the particular case; but this discretion is, as in other cases, governed by certain general rules. The material considerations by which the court is governed in these cases are the clearness of the plaintiff's right to the exclusive privilege, and his possession and use of it. All the cases on injunctions turn upon these considerations.

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[2] Ogle v. Ege, 4 Wash. C. C. R. 534.
[3] Dilly v. Doig, 2 Ves. Jr. 487.

Mr. Justice Washington says, "I take the rule to be, that where the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit; if he has been in possession of it by having used or sold it in part, or in the whole, the court will grant an injunction, and continue it till the hearing or further order, without sending the plaintiff to law to try his right. But if there appears to be a reasonable doubt as to the plaintiff's right, or to the validity of the patent, the court will require the plaintiff to try his title at law; sometimes accompanied by an order to expedite the trial; and will permit him to return for an account in case the trial at law should be in his favor." And he granted an injunction in the case then in hearing on a bill by the patentee, and his assignee, for the state of Pennsylvania, where it was alleged that the patent had been infringed.[3]

In another case, the same judge says: "The rule is, to grant an injunction on filing the bill, and before a trial at law, if the bill state a clear right, and verifies it by affidavit. If it states an exclusive possession of the invention, the injunction is granted, though the courts may entertain doubts as to the va-

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[3] Ogle v. Ege, 4 Wash. C. C. R. 534: cites Hill v. Thompson, Eden, 260; 14 Ves. 132; 3 Meriv. 624; Coop. Eq. Prac. 158; 1 Madd. C. P. 113; 14 Ves. 130; Ambler, 406; 1 Vern. 120; 2 Madd. 175; 6 Ves. 707; 3 Attk 496; 3 Bro. C. C. 376.

lidity of the patent. But if there be glaring defects in the patent, or specification, the rule is refused. When the patent is recent, and objections are made to the patent, or specification, the court will not grant an injunction till the right is established at law, which the court will order. If the bill does not set forth the possession of the invention by the plaintiff, at any particular time, it is defective. If the answer denies that the defendant uses the plaintiff's invention, the injunction will be refused.[4]

Upon a bill for an injunction the court required the plaintiff to subjoin a special affidavit of the truth of the allegations in the same; and "that he was, to the best of his knowledge and belief, the true and original inventor and discoverer of the improvement, for which he had obtained his patent; and that the same had not, to the best of his knowledge or belief, been in use, or been described, in any public work, anterior to his said invention or discovery."[5]

This practice, as to requiring an affidavit, is adopted from that of the English court of chancery. It requires the plaintiff to make affidavit, among other things, of the same facts to which he makes oath at the time of taking out his patent, for the court says, that though at the time of taking out the patent, the

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[4] Isaacs v. Cooper, Coxe's Dig. 533; 4 Wash. C. C. R. 259.

[5] Rogers v. Abbot, 4 Wash. C. C. R. 514.

patentee may have very honestly sworn, as to his belief, that he was the original inventor, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect.[6]

It is the practice in England to grant injunctions, in some cases forthwith, *ex parte*, without first hearing the party complained of.[7] In case of a patent which depended upon the proportions of the ingredients, Lord Eldon said, "he doubted whether the injunction ought to have been granted in the first instance, unless the affidavits had stated more particularly, in what the alleged infringement of the patent consisted; and that it should have been shown to be, by working in the *precise proportions* mentioned in the specification, as being of the essence of the invention."[8]

On a bill for an injunction Mr. Justice Washington granted it until answer and further order; and required the plaintiff to institute a suit at law against the defendant to try his right, the writ to be returnable to the next term of the court.[9]

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[6] Thompson v. Foreman, 3 Meriv. R. 622.

[7] Walker v. Congreve, Rep. of Arts, 2d series, v. 29, p. 311; Thompson v. Foreman, 3 Meriv. 622.

[8] Hill v. Thompson, 3 Meriv. 624.

[9] Rogers v. Abbot, 4 Wash. C. C. R. 514.

Applications for injunctions have been much more frequent in England than in the United States. The reason is, that in the United States, the patentee has had a more adequate remedy at law for damages. In the United States the patentee may safely rely upon his remedy, at law, if the parties infringing are able to respond to his claim for damages. In England, the security of the patentee is sometimes increased, and his remedy for indemnity facilitated, by the proceedings in equity, in which the court, instead of enjoining the party complained of to stop the manufacture, frequently orders him to keep an account of it, so that, if the plaintiff shall succeed in establishing his right at law, the rule of damages may be the profits accruing from the manufacture.[10]

According to the rule laid down by Mr. Justice Washington, above cited, the English court of chancery has often refused to proceed in an injunction if there is any palpable and glaring doubt of the patentee's right; as if it be doubtful whether the invention is new.[11]

"I cannot," said one of the Lord Keepers, "grant an injunction in any case, but where a man has a plain right to be quieted in it."[12] In regard to

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[10] Gods. Pat. 183, 188; Hill v. Thompson, 3 Meriv. 622; George v. Beaument, Wackerback and Martineau, Rep. of Arts, 2d series, p. 27.

[11] Forsyth's Patent, Gods. Sup. 68; Hill v. Williamson, Rep. of Arts, vol. 30, p. 32.

[12] Anon. 1 Vern. 120.

granting injunctions, the case of patents is put upon the same ground as waste.[13]

Lord Hardwicke seems to have thought that early after the passing of the statute of monopolies, injunctions were not granted until after the right of the patentee had been established by trial at law.[14] But if this was the original rule, it did not very long continue.[15] The present practice of granting injunctions in cases not yet tried at law, being of very long standing.

Many of the English cases state the rule much more broadly as to granting injunctions, and in patent cases, allowing them, not merely where there is no doubt of the patent right, but even where there may be some doubt, if the patentee has been in the exclusive possession of the privilege. And Mr. Justice Thompson, of New York, in commenting upon the English cases, lays down the general distinction, that where a patent is granted in pursuance of an act of parliament as in the case of patents for inventions, the court will grant an injunction before a trial of the right at law, but not in the case of other patents. He says: "It is the prevailing practice in England, even where the right is doubtful, and the case is sent to be tried at law, to send it *with* an injunction, instéad of denying it on that ground. But

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[13] Isaac v. Humpage, 1 Ves. Jr. 430.
[14] Whitchurch v. Hide, 2 Atk. 391.
[15] S. C. also Hicks v. Rhincock, 2 Dickens, 647.

where the right is *clear* an injunction is never refused; as when the right claimed appears on record, or is founded on an act of parliament, it is matter of course to grant an injunction, without first obliging the party to establish his case at law.[16] In the case of Blanchard v. Hill,[17] Lord Hardwicke said, "that in cases of monopolies, the rule that the court had governed itself by, was, whether there was any act of parliament, under which the restriction was founded. But the court will never establish a right of this kind, claimed under a *charter only from the crown*, unless there has been an action to try the right at law. This will be found, on examination, to be a governing distinction, running through the numerous cases cited in the argument. And whenever an injunction has been refused, the right was claimed under a patent from the crown, and that right considered doubtful."[18]

Lord Eldon puts the case not merely upon the circumstances existing between the two parties to the bill, but partly upon that of protecting the patentee against other infringements, whereby he might be ruined by lawsuits in establishing his right. He says: "The ground upon which, where doubt is excited in the mind of the court, an injunction is

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[16] Coop. Eq. Pl. 157; Mitf. Pl. in Eq. 129; 1 Vesey, 476.
[17] 2 Atk. 485.
[18] Livingston v. Van Ingen, 9 Johns. R. 570.

granted until the legal question can be tried, a ground that was acted upon in the case of Boulton v. Bull, 2 H. Bl. 453, Hornblower v. Boulton,[19] in some cases preceding that, and some that have occurred since, is this; where the crown, in behalf of the public, grants letters-patent, the grantee entering into a contract with the crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession, under color of the patent, the court has thought upon the fact of that possession, proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard, that the grant of the crown may, in the result, prove to have been valid. The question is not really between the parties upon the record; for unless the injunction is granted, any person might violate the patent, and the consequence would be that the patentee must be ruined by litigation. In the case of Boulton and Watt, therefore, though a case of great doubt, upon which some of the ablest judges in Westminster Hall disagreed, yet upon the ground of the possession by the patentees against all mankind, the injunction was granted, until the question could be tried; and the result of the trial being in favor of

[19] 8 T. R. 95.

the patent, proved, that the conduct of the court, in that instance, was, at least, fortunate."[20]

Mr. Justice Thompson of the Supreme Court of New York, puts the subject of injunction upon the same ground.[21]

But when the subject appeared, on the face of the patent, not to be patentable, Lord Eldon refused an injunction. In case of an application for an injunction on Forsyth's patent for a percussion lock, that judge said, "the application of these combustibles to the discharge of fire-arms by percussion, is not new; and I think it would be difficult to say that the particular method of applying percussion, to ignite such chemical combustibles, for the purpose of discharging fire-arms, is a subject for a patent." He accordingly refused an injunction until the patent should be established by a trial at law.[22]

But the same Lord Chancellor granted an injunction, where the patentee had been in possession under a patent for *improvements*, upon a machine which was the subject of an expired patent, until the right could be tried, although the patent for the improvements was subject to considerable doubt, as the specification described the original machine with the

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[20] Harmer v. Plane, 14 Vesey, 130.

[21] Livingston v. Van Ingen, 9 Johns. R. 569.

[22] *Forsyth v. Manton*, July 1815, Rep. of Com. of H. of Com. 1829. App. 198, Mr. Farey's papers.

improvements as one entire machine, and not the improvements distinguished from the original machine.[23]

In another case Lord Eldon said that in the case of patent rights, if the party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called a possession under it, however doubtful it may be whether the patent can be sustained. The Court of Chancery have said, possession under a color of title, is ground enough to enjoin, and to continue the injunction, till it is proved at law, that it is only color and not real title.[24]

The weight of the consideration of exclusive possession will depend on its duration in some degree, and, therefore, another distinction, in regard to the exercise of the discretion of the court in granting an injunction, relates to the time during which the patentee has been in possession. Where there has been an exclusive possession of some duration under a patent, the court will, in case of an infringement, interpose its injunction, without putting the party previously to establish the validity of his patent by an action of law. But where the patent is recent, and, upon an application being made for an injunc-

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[23] Harmer v. Plane, 14 Vesey, 130.

[24] Universities of Oxford and Cambridge v. Richardson, 6 Vesey, 707.

tion, it is endeavored to be shown in opposition to it, that there is no good specification, or otherwise that the patent ought not to have been granted, the court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial; but will send the patentee to law and oblige him to establish the validity of his patent in a court of law, before it will give him the benefit of an injunction.[25]

Mr. Chief Justice Kent thus states the law on the subject of injunctions in the United States: He says, "The law has been settled in England, in regard to the granting of injunctions, that statute privileges, no less than common law rights, when in actual possession and exercise, will not be permitted to be disturbed, until the opponent has fairly tried them at law and overthrown their pretension. The federal courts, under the patent laws of Congress, have equally protected the right by injunction. The case of Morse v. Reid, decided by C. J. Ellsworth, in the Circuit Court of the United States, was a bill for an injunction filed in 1796, to restrain the defendant from reprinting Winterbotham's History, which the complainant alleged was an invasion of the copy-right of his American Geography. The propriety

[25] Hill v. Thompson, 3 Meriv. 622.

of the injunction was not questioned; it issued in the first instance. The complainant recovered fifteen hundred dollars, and the injunction was made perpetual. So, in the late case of Whitney v. Fort, which arose in Georgia, upon a violation of the complainant's patent for a machine for cleaning cotton, an injunction was granted, in the first instance, and was afterwards made perpetual, at the Circuit Court, at which Judge Johnson presided. Injunctions are always granted to secure the enjoyment of statute privileges of which the party is in the actual possession, unless the right be doubtful. This is the uniform course of the precedents. I believe there is no case to the contrary; and the decisions in the English chancery, on this point, were the same before as since the American Revolution; and we are consequently bound by them as a branch of the common law."[26]

Accordingly an injunction was granted in the case then under the consideration of the court upon the grant of a monopoly by the legislature of New York, which was subsequently adjudged to be void by the Supreme Court of the United States, but still the grounds of proceeding in the Supreme Court of New York, as to granting an injunction, are not thereby rendered the less illustrative of the law and practice

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[26] Livingston v. Van. Ingen, 9 Johns. 585.

upon this subject. An act was passed by the legislature of New York, granting to the plaintiffs, Livingston and Fulton, who were "the *possessors* of a *mode of applying the steam engine, to propel a boat* on new and advantageous principles," the sole and exclusive right of constructing and navigating boats by steam, in the waters of that State, for a certain term of years; and by a subsequent grant, passed in 1808, it was provided that if any steam-boats should be used in contravention of the right of the grantees, they should be forfeited to them. These statutes having been adjudged to be constitutional and valid, it was held, by the Court of Errors, that the plaintiffs, who had been in the exclusive enjoyment of their statute privilege for three years, were entitled to an injunction to restrain the defendants from running steam boats on the Hudson, although the plaintiffs had brought an action of detinue against the defendants, by virtue of the statute, for the recovery of the boats which had been so used. Thompson J. said that "the claim of the plaintiffs was founded on acts of the legislature, and if those acts were considered valid, no doubt could exist as to the right. And if any doubt should be thought to exist on that point, yet, according to the established rule in England, this was not sufficient to warrant a denial of the injunction. If it should be necessary to send the cause to be tried at law, it ought to be sent *with* an injunction. But it is said, that the right claimed by

the plaintiffs being created by statute, they are entitled to no other remedy than that which the statute gives. Without examining whether the rule of law, upon which this objection is founded, is not confined to criminal cases altogether, it certainly cannot be applied to the present case; for the forfeiture is not given by the same statute which created and gave the right, nor until the right was actually vested in the plaintiffs, by a fulfilment of the terms and conditions upon which they were to be entitled to the exclusive privilege now claimed by them; and if the right was vested, all existing remedies to enforce it were also vested, and are not to be taken away by implication. The act of 1808, creating the forfeiture, purports to be an act for the *further* encouragement of the plaintiff's steam boats, which plainly shows that the remedies therein provided, were intended as *cumulative*, and in addition to those already existing. This would be the construction in criminal cases, even where the offence is created and the penalty given by the same statute, provided they are in separate clauses."[27]

Possession of an exclusive privilege of this description is indicated by the *use*. Accordingly where it did not appear what use the applicant for an injunction had made of the privilege for which he took his

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[27] Livingston v. Van Ingen, 9 Johns. 507.

patent, Mr. Justice Thompson considered that there was no support to the application on the ground of possession, and as the right seemed questionable at the same time, the injunction was refused.[28]

Applications for injunctions to protect manufactures not secured by patent, have been generally rejected in England.

In case of an agreement not to disclose the secret of the composition of a medicine, Lord Eldon was averse to sustaining an injunction. A motion was made to dissolve an injunction restraining the defendant from divulging the secrets in the bill mentioned, and from preparing or selling the medicines therein mentioned. The alleged secrets in medicine were unprotected by a patent. Lord Eldon. "So far as the injunction goes to restrain the defendant from communicating the secret, upon general principles, I do not think that the court ought to struggle to protect this sort of secrets in medicine. The court is bound indeed to protect them in cases of patents, to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public and bound to communicate his secret to the public at the expiration of the patent. Then, whether the principle can be extended to such a case as this—whether a contracting party is entitled

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[28] Sullivan v. Redfield, 1 Paine R. 441.

to the protection of the court in the exercise of its jurisdiction, to decree the specific performance of agreements, by restraining a party to the contract from divulging the secret he has promised to keep, that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret, the injunction can be of no use. If he only threatens to disclose, it then becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all. Then how is the court to try this question? Or what can the court do with the case altogether?" The injunction was dissolved.[29]

Lord Hardwicke refused to grant an injunction to protect a stamp for goods. A motion was made, on behalf of the plaintiff, for an injunction to restrain the defendant from making use of the *Great Mogul* as a stamp on his cards, to the prejudice of the plaintiff, upon a suggestion, that the plaintiff had the sole right to this stamp, having appropriated it to himself, conformably to the charter granted to the Card-makers' Company by Charles I. Lord Hardwicke. "There is no foundation for this court to grant such an injunction. Every particular trader has some particular mark or stamp; but I do not

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[29] Williams v. Williams, 3 Meriv. 157.

know any instance of granting an injunction here to restrain one trader from using the same mark with another; and I think it would be of mischievous consequence to do it. There is a clause in the charter, that in order that every card-maker may know his cards from another card-maker, each trader shall lodge his mark or stamp with the receiver, *to prevent any fraud upon our loving subjects.* This is a colorable end; but if any weight was to be laid upon these colorable recitals, it would be establishing every other monopoly. An objection has been made, that the defendant, in using this mark, prejudices the plaintiff, by taking away his customers. But there is no more weight in this, than there would be in an objection to one innkeeper setting up the same sign with another." The injunction was accordingly refused till the hearing of the cause.[30]

If on a trial at law the plaintiff establishes his right, the injunction on the defendant is, on his motion, made perpetual; if he fails, the injunction will, on motion of the defendant, be dissolved. But where a verdict having been given for the plaintiff, the court of law were equally divided, a writ of error lying to another court, the chancellor refused to dissolve the injunction, until a decision could be had in the court of errors, or in another

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[30] Blanchard v. Hill, 2 Atkyns, 484.

action, the plaintiff having been in possession of his privilege seven years.[31] And so if a new trial is proposed to be moved for, this is a ground, on the part of the defendant, for opposing a motion by the plaintiff to make the injunction perpetual, and on the part of the plaintiff, for opposing a motion of the defendant to dissolve it.[32]

If the injunction be granted improvidently, it will be dissolved on motion. But until it is dissolved, a violation of it will be a contempt of court.[33]

CHAPTER XXV.

Proceedings for the Repeal of Patents.

The act of Congress of 1793, s. 10, provided a process for the repeal of a patent in the nature of *scire facias*. The same act, s. 6, provided that in case of notice of certain grounds of defence, in an action for an infringement, and of any of these grounds being made good, the court might declare the patent void. That act has been repealed by the act of 1836, in

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[31] Boulton v. Bull, 3 Ves. 140.
[32] Gods. on Pat. 631. Gibbs v. Cole, 3 P. W. 256.
[33] Walker v. Congreve, Rep. of Arts, Second Series, v. 24, p. 311.

which no provision has been made for the repeal of patents.

The proceeding for the repeal of patents in England is by *scire facias*.[1]

The provisions of the act of 1793, for proceedings in the nature of *scire facias*, have been subjects of various decisions, which need not be particularly stated, since that act has been repealed.[2]

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[1] Hunt v. Coffin, Dyer, 197, b; 4 Inst. 88; The King v. Butler, 2 Vent. 344; S. C. 3 Vent. 223; S. C. 3 Lev. 220; The King v. Arkwright, Godson on Pat. 192; Com. Dig. Patent, F. 2, 3. 7; 2 Saund. 72, n; Rex v. Dawes, 4 Burr. 2022, 2120; Rex v. Peacock, 4 T. R. 634; Lilly's Ent. 411.

[2] See Stearns v. Barrett, 1 Mass. R. 167; Ex parte Wood v. Brundage, 9 Wheat. 702.

APPENDIX.

PATENT ACTS OF THE UNITED STATES.

Act of Congress of April 10, 1790, *c.* 34, *Story's Laws of U. S. vol.* 1, *p.* 80. *Repealed by act of* 21*st February*, 1793, *c.* 55.

An Act to promote the progress of useful arts.

Sec. 1. *Petition. Attestation.* Certificate of attorney general. Seal. Recording.
2. Specification. Models.
3. Copies.
4. Penalty for an infringement.
5. *Repeal of patents.*
6. Patent is prima facie evidence. Plea. Notice. Verdict in case of false specification.
7. Fees.

§ 1. *Be it enacted*, &c. 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 endorsed on the patent by the said secretary, at the time of granting the same.

§ 2. 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 of models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented, or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use, the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; which specification shall be filed in the office of the said secretary, and certified copies thereof shall be competent evidence in all courts, and before all jurisdictions, where any matter, or thing, touching or concerning such patent right or privilege, shall come in question.

§ 3. That upon the application of any person to the secre-

tary of state, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the secretary to give such copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

§ 4. 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.

§ 5. 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 suffi-

cient 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.

§ 6. 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.

§ 7. 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 copysheet, containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for endorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

Act of Congress of Feb. 21*st*, 1793, *c.* 55. *Story's Laws of U. S. v.* 1. *p.* 300. *Repealed by Act of July* 4, 1836, *c.* 357.

An act to promote the progress of useful arts; and to repeal the act heretofore made for that purpose.

Sec. 1. Petition. Patent. Teste. Certificate of Attorney General. Seal. Recording.
2. Improvements. Change of form or proportions.
3. Oath. Specification. Drawings. Witnesses. Copies made evidence. Models.
4. Assignment.
5. Penalty for infringement. Action.
Sec. 6. Plea. Evidence on notice. Patent declared void.
7. Patents before granted by the States
8. Pending applications.
9. Interfering applications. Arbitration.
10. Proceedings to repeal patents.
11. Fees.
12. Act of 1790 repealed.

§. 1. *Be it enacted, &c.* 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 State, 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.

§ 2. 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.

§ 3. 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.

§ 4. 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.

§ 5. 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 perso is 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.

§ 6. 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.

§ 7. 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.

§ 8. 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, entitled "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.

§ 9. 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 him, 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.

§ 10. 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 after-

wards, 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.

§ 11. 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.

§ 12. That the act, passed the tenth day of April, in the year one thousand seven hundred and ninety, entitled "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.

Act of Congress of June 7th, 1794, *c.* 58. *Story's Laws of U. S. v.* 1, *p.* 363. *Repealed by act of July* 4*th*, 1836, *c.* 357.

An act supplementary to the act, entitled "Act to promote the progress of useful arts."

Sec. 1. Suits under act of 1790, stopped by its repeal, revived.

§ 1. *Be it enacted, &c.* 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, entitled "An act to promote the progress of useful arts," which may have been set aside, suspended, or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation in which they may have been when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process, or proceedings, be, and are hereby, entitled to proceed in such cases as if no such repeal of the act aforesaid had taken place. *Provided always*, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant, or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding as is used in other cases for compelling the appearance of a party.

Act of Congress of April 17*th*, 1800, *c.* 25. *Story's Laws of the U. S. v.* 1, *p.* 752. *Repealed by act of July* 4*th*, 1836. *c.* 357.

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.

Sec. 1. Alien patentees. Oath by them.
2. Application by representatives of patentee. Oath varied.
Sec. 3. Penalty for infringement (substitute for s. 4 of act of 1793.) Jurisdiction.
4. Repeal of 5th sec. of act of 1793.

§ 1. *Be it enacted, &c.* 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, entitled "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.

§ 2. 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 as 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 life time; 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.

§ 3. 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 thereof.

§ 4. That the fifth section of the above mentioned act, entitled "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.

Act of Congress of Feb. 15, 1819, *c.* 143. *Story's Laws of U. S. v.* 3, *p.* 1719. *Repealed by act of July 4th,* 1836, *c.* 357.

An act to extend the jurisdiction of the circuit courts of the United States to cases arising under the law relating to patents.

Jurisdiction. Appeal.

§ 1. *Be it enacted, &c.* That the circuit courts of the Uni-

ted States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided, however,* That from all judgments and decrees of any circuit courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the supreme court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such circuit courts.

Act of July 3d, 1832, *c.* 162. *Repealed by act of July 4th*, 1836.

An act concerning Patents for Useful Inventions.

Sec. 1. Publication of the list of expired patents.
2. Applications to prolong the term of patents.
Sec. 3. Surrender of patents on account of defects in the specification; and taking out new patents.

§ 1. *Be it enacted, &c.* 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.

§ 2. That application to congress to prolong or renew the term of a patent, shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the state or territory in which the

patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

§ 3. 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.

Act of July 13*th*, 1832, *c.* 202. *Repealed by act of July 4th*, 1836.

An act concerning the issuing of patents to aliens, for useful discoveries and inventions.

Sec. 1. Alien patentees.

§ 1. *Be it enacted, &c.* 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 17th, 1800, 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 the failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States, the invention or improvement for which the patent shall be issued; or in case the same for any period of six months after such introduction shall not continue to be publicly used and applied in the United States; or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

Act of July 4th, 1836, *c.* 357.

An act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

Sec. 1. Commissioner.
2. Other officers and clerks.
3. Oath and bonds of officers.
4. Seal. Certified copies of records and papers to be evidence.
5. The patent.
6. The specification. Drawings. Models. Oath.
7. When the commissioner shall grant a patent. When he shall refuse. Reasons to be given for refusal. Return of part of fee if application withdrawn. Board of examiners appointed if the application is persisted in. Proceedings. Fees of examiners.
8. Applications interfering with others, or with existing patents, referred to examiners. A patent taken out abroad within six months before the filing the specification, for the same invention, is no ground of objection. Patent to be dated at time of filing specification, not over six months back, in case of request. Specification to be filed in secret archives of patent office, on request, not more than one year.
9. Fees to be paid by patentees.
10. Representatives of patentee entitled to take out patent in case of his decease.
Sec. 11. Assignments.
12. Caveat.
13. Surrender of patent on account of defective specification. New patent issued.
14. Damages for an infringement.
15. Plea of general issue. Notice of grounds of defence. Evidence. Notice of names of persons who have known or used the invention, and places where. Use in a foreign country of an invention not patented or described in any printed publication. Costs in case of judgment against plaintiff on ground of his claiming too much, and of a violation of the part rightfully claimed and truly described.
16. Remedy in equity in case of applications interfering with others or with existing patents.
17. Jurisdiction of patent causes.
18. Prolongation of the term of a patent.
19. Library of patent office.
20. Arrangement of the models in the patent office.
21. Repeal of former acts. Suits pending at the time of passing this act, to be prosecuted.

§ 1. *Be it enacted, &c.* 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.*

§ 2. 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 the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of commissioner during such vacancy. 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.

§ 3. 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.

§ 4. That the said commissioner shall cause a seal of office 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 drawing, 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.

§ 5. That all patents issuing 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.

§ 6. 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, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings, 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.

§ 7. 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 sufficiently 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 claim for a patent, with or without any alteration of 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 sec-

tion 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.

§ 8. 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 the specification and drawing. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year; the applicant being entitled to notice of interfering applications.

§ 9. 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 deposite 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.

§ 10. 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.

§ 11. 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 patent office within three months from the execution thereof, for which the assignee or grantee shall pay to the commissioner the sum of three dollars.

§ 12. That any citizen of the United States, or alien who shall have been resident in the United States ..e year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, 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 deposite the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application, 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.

§ 13. 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 descrip-

tion 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 herein before 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.

§ 14. 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 patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.

§ 15. 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 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.

§ 16. 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 and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant,

shall authorize the commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. Provided, however, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

§ 17. 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 powers and jurisdiction of a circuit court; which courts shall have power upon 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.

§ 18. 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 interest therein: Provided, however, That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

§ 19. 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 there-

in, 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.

§ 20. 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.

§ 21. 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.

BRITISH PATENT ACTS—IN FORCE.

An Act concerning Monopolies and Dispensations with penal laws, and the forfeitures thereof. 21 *James I. c.* 3. *A. D.* 1623.

Sect. 1. Monopolies abolished.
5. Letters patent for new manufactures excepted.
Sect. 6. Letters patent to be granted, in future.

1. Be it enacted, &c. That all monopolies, and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of *Wales*, &c. are altogether contrary to the laws of this realm and so are and shall be utterly void and of none effect, and in nowise to be put in ure or execution.

5. That any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under, heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patents and grants did not use, so they be not contrary to the law, nor mischievous to the state, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same for the term of one and twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been, if the same had been made

but for term of one and twenty years only, and as if this act had never been had or made, and of none other.

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

An Act to amend the law touching Letters-Patent for Inventions. 2 *Stat.* 5 & 6 *Will. IV. c.* 83. *Sept.* 10, 1835.

Sec. 1. Disclaimer of a part of the specification.
Entry of a memorandum of an addition to the specification.
Caveat.
Disclaimer not to affect pending actions.
Disclaimer to be advertised in case, &c.
2. Mode of proceeding where the patentee proves not to be the original inventor, though he believed himself to be so.
Sec. 3. Certificate of a verdict in favor of a patentee in a former suit to entitle him to treble costs.
4. Prolongation of the term of patents.
5. Notice of objections to patent, to be given before trial.
6. Costs in actions for infringement.
7. Penalty for using unauthorized the name of patentee, his stamp or mark.

Whereas it is expedient to make certain additions to and alterations in the present law touching letters patent for inventions, as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same: be it enacted by the king's most excellent majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the

same, that any person who, as grantee, assignee, or otherwise, hath obtained or who shall hereafter obtain letters patent, for the sole making, exercising, vending, or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively, as the case may be, having first obtained the leave of his majesty's attorney general or solicitor general in case of an English patent, of the lord advocate or solicitor general of Scotland in the case of a Scotch patent, or of his majesty's attorney general or solicitor general for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever[1]: provided always, that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which

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[1] The nature of the mischiefs to be remedied in this section will be very clearly understood by a reference to the extracts from the evidence of Mr. Taylor and Mr. Farey, given in this Appendix: they consisted mainly in the necessity under which inventors found themselves of keeping their inventions secret until the sealing of the patent, which, coupled with the difficulty of specifying correctly without the aid of experiments incompatible with the secrecy observed up to the time of sealing, and equally incompatible with the shortness of the time allowed for specifying after the sealing, occasioned sometimes deficiencies in the specification, sometimes discrepancies between it and the title, either of which faults was sufficient to avoid the patent. It was held even before the passing of this act, that the inventor might embody in his specification any improvements which occurred to him between the periods of sealing the patent and enrolling the specification. Crossley v. Beverley, 9 B. & C. 63. But then the improvements must not have been such as to render the title in the patent inapplicable to the specification, for that would have been fatal to the rights of the patentee. [*Smith's Epitome of Law relating to Pat. Ed.* 1836. *Lond. p* 42, *n.*]

caveat being so entered shall give the party entering the same a right to have notice of the application being heard by the attorney general, or solicitor general, or lord advocate, respectively : provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted : provided also, that it shall be lawful for the attorney general, or solicitor general, or lord advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such attorney general, or solicitor general, or lord advocate shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

2. That if in any suit or action it shall be proved or specially found by the verdict of a jury that any person who shall have obtained letters patent for any invention or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his majesty in council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the judicial committee of the privy council ; and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention or part thereof had not been publicly and generally used before the date of such first letters patent, may report to his majesty their opinion that the prayer of such pe-

tition ought to be complied with, whereupon his majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage or custom to the contrary thereof notwithstanding: provided, that any person opposing such petition shall be entitled to be heard before the said judicial committee: provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.[1]

3. That if any action at law or any suit in equity for an account shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent, and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them, upon the merits of the suit, it shall be lawful for the judge before whom such action shall be tried to certify on the record, or the judge who shall make such decree or order to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any

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[1] Hitherto, if an inventor could have managed to use his discovery in such a manner as to enjoy the benefit of it without laying his process open to discovery, he might have enjoyed all the advantages of a patentee without obtaining a patent, and of course without putting the public in possession of his discovery through the medium of a specification; and yet although the same idea might subsequently occur to some other person, who might be anxious to obtain a patent for it, the previous user by the first discoverer would have been sufficient to prevent the grant or to avoid the instrument if granted, so that the public would have been altogether deprived of the advantage arising from a specification. A singular instance of this kind of mischief seems to have occurred in Mr. Watt's case, whose specification, though upheld by the courts, is stated in the evidence before the select committee to have been totally useless and unintelligible in practice. The consequence of which was, that the enjoyment of Mr. Watt's exclusive privileges continued for nearly thirty years after the expiration of the patent. [*Smith's Epitome of Law relating to Pat. Ed.* 1835. *Lond. p.* 44, *n.*]

other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made, in favor of such patentee or his assigns, he or they shall receive treble costs in such suit or action, to be taxed at three times the taxed costs, unless the judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs.

4. That if any person who now hath or shall hereafter obtain any letters patent as aforesaid, shall advertise in the London Gazette three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to his majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition his majesty in council to that effect, it shall be lawful for any person to enter a caveat at the council office; and if his majesty shall refer the consideration of such petition to the judicial committee of the privy council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the judicial committee may report to his majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: provided that no such extension shall be granted, if the application by petition shall not be made and prosecuted with

effect before the expiration of the term originally granted in such letters patent.[1]

5. That in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent the plaintiff shall file with his declaration, a notice of any objections on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial, unless he prove the objections stated in such notice: provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant or plaintiff on such plaintiff or defendant respectively, to show cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.

6. That in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and without regard to the general result of the trial.

7. That if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing, without leave in writing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the license or

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[1] Heretofore a patent could only have been prolonged by act of parliament.

consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the king's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner imitate or counterfeit the stamp or mark or other device of the patentee, he shall for every such offence be liable to a penalty of fifty pounds, to be recovered by action of debt, bill, plaint, process, or information in any of his majesty's courts of record at Westminster or in Ireland, or in the court of session in Scotland, one half to his majesty, his heirs and successors, and the other to any person who shall sue for the same; provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon any thing made, for the sole making or vending of which a patent before obtained shall have expired.

FRENCH LAW OF PATENTS.

For an Abstract of the French law of patents, see supra, p. 27.

PATENT LAWS OF THE NETHERLANDS.

Law of January 25th 1817.[1]

ARTICLE 1st.—Exclusive rights may be granted by us, for a limited time, by letters patent, under the title of patents of invention, on petitions which shall be made to us for the same, to those who, in the kingdom, shall have made an invention or essential improvement in any branch of arts or manufactures; and also to those who shall first introduce, or practise in the kingdom, an invention or improvement made in foreign countries.

2d.—The grants of patents of invention shall not interfere with any rights previously acquired by others; and the grant shall be void, if it is proved that the invention, or the improvement for which any one shall have obtained a patent, have been employed, put in operation, or exercised by another in the kingdom, before the grant of the patent.

3d.—Patents of invention shall be granted for the terms of five, ten, or fifteen years. The tax to be paid for obtaining a patent, shall be proportionate to the duration of the patent and to the importance of the invention or improvement; but shall never exceed the sum of 750 *francs*, nor be less than 150 *francs*.

4th.—A patent of invention granted for the term of five or ten years, may also be prolonged at the expiration of that term, if there are strong reasons to support the petition made to that effect; but its total duration can never exceed the term of fifteen years.

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[1] This translation of the patent laws of the Netherlands, is copied from the Appendix to the Report of the Commissioners of the British House of Commons of June 8th, 1829. It was supplied to the Commissioners, by Mr. John Farey.

5th.—Patents of invention for the introduction or application of inventions or improvements made in foreign countries, and for which the inventors have patents in those countries, shall not be granted for a longer time, than that during which the exclusive right granted in such foreign country for those objects shall last; and they shall contain an express clause, that the objects named shall be manufactured in the kingdom.

6th.—Patents of invention shall give to their possessors the rigbt, or their agents, the right.

(*a*) Of making and selling exclusively throughout the kingdoin, during the time fixed for the duration of the patent, the objects named in it; or of causing them to be made, and sold, by others whom they shall authorize to do so.

(*b*) Of citing before the courts of law those persons who shall infringe upon the exclusive right which has been granted to them, and of proceeding against such persons at law, in order to obtain the confiscation, for their own advantage, of those objects named in the patent, which have been made by such persons, but not yet sold; and also, of the price obtained for those objects which shall have been already sold; as well as to institute an action for damages, as far as there are grounds for the same.

7th.—Whoever shall present a petition, in order tc obtain a patent of invention, shall be bound to join thereto, sealed up, an exact and detailed description, and signed by hiin, of the object or the secret, for which the patent is solicited, together with the necessary plans and drawings; that description shall be published after the expiration of the term of the patent of invention, whether it be the original term, or a prolonged term; or even sooner, in case the patent, for any of the causes assigned hereinafter, shall be declared void.

The government, may nevertheless, defer that publication, if it should be judged necessary, for important reasons.

8th.—A patent of invention shall be declared void, for the following causes:—

(*a*) When the patentee shall have fraudulently omitted, in the description joined to his petition, to make mention of any part of his secret, or shall have stated it in a false manner.

(*b*) If it should appear that the object for which a patent has been granted, was already described, prior to the date of the patent, in any work printed and published.

(*c*) When the patentee shall not have made use of his patent, within the space of two years, reckoning from the date of his patent; unless there have been strong reasons for that delay, of which reasons the government shall judge.

(*d*) If the person who has obtained a patent of invention, should obtain one subsequently for the same invention in a foreign country.

(*e*) If it should appear that the invention for which a patent of invention shall have been granted, is in its nature, or in its application, dangerous to the security of the kingdom, or its inhabitants.

9th.—A separate account shall be kept, of the taxes paid by those who obtain patents for inventions; and the produce shall be employed in premiums, or in rewards, for the encouragement of the arts, and of the national manufactures.

Regulation of January 25th 1817.

5th.—When the king shall judge fit not to grant the petition, or to refer it to the opinion, either of the Royal Institute of the Netherlands, or of the Royal Academy of sciences and Literature of Brussels, notice thereof shall be given to the petitioner.

6th.—The patent shall contain the description of the invention: it shall define the rights that it gives to the patentee, conformably to Article 6, of the law of the 25th January inst. and shall mention expressly, that the government, in granting the patent, guarantees, in no way, either the pri-

ority or the merit of the invention, and reserves to itself the right of declaring it void for any of the causes stated in Article 8, of the law. The patent of importation, for an object already patented abroad, shall contain, besides, the express mention that the government does not guarantee the assertion of the petitioner, as to the duration of the patent granted abroad; it shall contain also, the clause prescribed by the Article 5, of the law, that the objects mentioned shall be manufactured in the kingdom.

8th.—Every proprietor of a patent who, by other new discoveries, shall have improved upon the discovery for which the patent was granted, may obtain a new patent for the exercise of those new means.

9th.—To obtain such a patent, the same forms must be fulfilled, as for the other patents. Respecting the duties to be paid, they will be regulated by the length of time during which the exclusive privilege is to last, and by the importance of the means of improvement.

10th.—If any person announces a means of improvement upon an invention already appropriated by a patent, he may obtain a patent for the exclusive use of the said means of improvement; but he shall not be permitted, under any pretext whatsoever, to execute, or cause to be executed, the principal invention, so long as the patent granted for that invention shall not have expired; and reciprocally, the first inventor shall not be permitted to execute alone the new means of improvement. Changes of form, or of proportions, or ornaments of any kind whatsoever, shall not be held as improvements in manufactures.

PATENT LAWS OF AUSTRIA.[1]

Laws of December 8th 1820.

§ 1.—ALL new discoveries, inventions and improvements in every branch of industry, made either in the country or in a foreign country, are entitled to obtain an exclusive privilege in the Austrian monarchy, whether the petitioner for the privilege is a native or a foreigner.

§ 2.—Whoever desires to obtain an exclusive privilege for any discovery, invention or improvement in a branch of industry, must present his petition to the *Direction* of the circle in which he resides. He must therein state the substance of his discovery, invention or improvement; the number of years for which he desires to obtain the privilege, (which term can, in no case, exceed the term of fifteen years.) He must deposit one half of the duty payable for the patent, according to the regulations stated hereinafter, and he must join, thereto, sealed up, an accurate description of his discovery, invention or improvement; in which description the following qualifications will be required:—

(*a*) The description must be written in the German language, or in the language used for business in the province in which the petition is made.

(*b*) It must be drawn up so clearly that every person who understands the subject, may be able to manufacture the object, by means of the description, without

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[1] These provisions of the Austrian Patent laws are taken from the Appendix to the Report of the Commissioners of the British House of Commons, June 12th, 1829. The law was furnished to the Commissioners by Mr. J. Farey. Only the sections of a general nature are copied, the omitted sections relate mostly to forms and judicial proceedings.

being obliged to supply any further inventions, additions or improvements.

(*c*) That which is new, and which consequently constitutes the object of the privilege, must he accurately distinguished and set forth in the description.

(*d*) The discovery, invention or improvement must be clearly and distinctly described, and without any ambiguities that can mislead, or that are contrary to the object stated at (*b*.)

(*e*) Nothing must be kept secret, either in the materials or the method of execution; therefore more expensive means, or means not producing an entirely similar effect, must not be described; nor must any manipulations, which are essential to the success of the operation be concealed. If it is practicable, drawings and models are to be added, for the better understanding of the description, but these are not strictly required, if the object can be made sufficiently clear by the description alone, according to the requisites stated at (*b*.)

§ 10.—The exclusive privilege secures and guarantees to the privileged person, the exclusive use of his invention, discovery or improvement, in that manner in which it is set forth in the description he has delivered, and during the term of years which his privilege is to last.

§ 11.—The privileged person has a right to erect all necessary workshops, and to take into them all kinds of assistants, and work people, who may be necessary for the full practice of the object of his privilege, to the greatest extension that he may choose; consequently, to form establishments and depôts all over the monarchy for the manufacture and sale of the object of his privilege, and to empower others to practise his invention, under the protection of his privilege; to take such partners as he may choose, in order to increase the profits of his invention to any scale; to dispose of his privilege itself; to bequeath it, to sell it, to let it out, or assign it away at his pleasure; and also to take out a privilege in a foreign country or his invention.

§ 12.—A privilege for an improvement, or change, in an invention already privileged, is confined, solely and only to the particular improvement or change itself, and does not give to the privileged improver, or changer, any right to the other parts of the invention already privileged, or of a method or process already known; on the other hand the original inventor must not make use of the privileged improvement, or change, made by another person, unless he has agreed for the same with that person.

§ 13.—The duties upon privileges are to be paid in proportion to the time granted for their duration (which, however, must not exceed 15 years;) and the petitioner for a privilege must determine for himself, for how many years, within the limits of the longest term, he desires to obtain the privilege.

§ 19.—The longest term for privileges, as stated in § 2 and § 13, is fixed at 15 years.

§ 20.—The term of a privilege begins from the date of the patent deeds; nevertheless the efficacy of the privilege, in respect to the punishment of illegal imitations of the privileged object, can only begin from the day of the announcement of the privilege in the public papers.

§ 21.—The force of the privilege extends, without exception, throughout the whole monarchy.

§ 23.—Privileges become void:—

(*a*) If the accurate description of the discovery, invention or improvement, for which the privilege was petitioned, is wanting in the requisites above stated in § 2. (*a*—*e*) or in only one of those requisites.

(*b*) If any one proves legally, that the privileged discovery, invention or improvement, could not be considered new in the monarchy, previous to the date of the official certificate drawn up according to the regulations hereinafter stated in § 27. (*d*).

(*c*) If the possessor of a privilege in force for a discovery, invention or improvement, proves that the privilege subsequently granted, is identically the same as his own discovery, invention or improvement, which

was regularly described and privileged at an earlier date.

(*d*) If the privileged person has not begun to practise his discovery, invention or improvement within the term of one year, from the delivery of his privilege, whether he is a native or a foreigner.

(*e*) If he discontinues that practice for the space of a year, during the term of the privilege, without showing sufficient grounds for the same.

(*f*) If the second half of the tax is not paid, in the above stated annual rates.

(*g*) Lastly, by the expiration of the original term for which the privilege was granted, or of the prolongation subsequently obtained. It is to be understood, as a matter of course, that these causes for the cessation of a privilege, apply as well to any one who acquires a privilege (by transfer,) as to the original privileged person (patentee.) After the extinction of a privilege, the use of the discovery, invention or improvement, for which the privilege was granted, will become open to every one.

§ 27.—For the prevention and uniform settlement of disputes, the following regulations are enacted:—

As the privilege is founded upon the description of the discovery, invention or improvement which is delivered by the possessor thereof (§ 10.); in case of disputes, the discovery, invention or improvement shall be judged according to the manner in which it is set forth in that description.

(*a*) Every new finding out of a process in industry, which although practised in former times, has been since entirely lost, or which although still practised in foreign countries, is unknown in the monarchy, shall be held a discovery.

(*b*) Every production of a new object by new means; or of a new object by means already known; or the production of an object already known by means differ-

ent from those which have hitherto been used for that object, shall be held an *invention.*

(*c*) Every addition of a preparation, arrangement, or method of working, to a process, already known or privileged, by which more complete success, or greater economy shall be attained in the result of that process, or in its mode of operation and application, shall be held an improvement.

(*d*) Every discovery, invention, improvement, or change, shall be held as new, if it is not known in the monarchy, either in practice, or by a description of it contained in a work publicly printed. But the novelty of a discovery, invention or improvement, shall not be called in question, on account of its being described in a work publicly printed, unless that description is so accurate and clear, that any person acquainted with the subject, can, by means of that description, manufacture the object, or practise the process for which the privilege has been granted.

SPECIFICATION.

To all persons whom it may concern.

Be it known that I, the undersigned, S. C. of V. in the county of H. in the state of M. have invented [or discovered], a new and useful machine [invention or improvement, or composition of matter,] called [here give the title of the invention] of which the following is a full and exact description:

[Description of the invention.]

In testimony whereof, I the said S. C. hereto subscribe my name in the presence of the witnesses whose names are hereto subscribed, on the day of A. D. 18 .

Signed in our presence, S. C.

A. B.

C. D.

ATTESTATION TO THE DRAWINGS.

The above is the drawing of [description of the invention] referred to in my specification, of the said improvement [machine or invention] dated at V. on the day of A. D. 18 .

In testimony whereof, I hereto subscribe my name on said day and year S. C.

Signed in presence of

A. B.

C. D.

FORM OF THE OATH.

State of M. County of H. ss.

On the day of A. D. 18 , before the subscriber, a justice of the peace in and for said county, and authorized by

law to administer oaths, personally appeared S. C. and made oath [or affirmation] that he verily believes that he is the first and original inventor of the [improvement, machine, or composition of matter, &c.] above mentioned and described in the specification by him subscribed, and that he does not know or believe that the same was ever before known or used, and that he is a citizen of the United States.[1]

FORM OF THE PETITION.

To the Honorable Henry L. Ellsworth, Commissioner of Patents of the United States.

The petition of S. C. of V. in the county of H. and state of M. engineer, respectfully represents

That your petitioner has invented a new and useful [machine, improvement, composition of matter,] which he verily believes was not known or used prior to his invention thereof; which has not heretofore been and is not now in public use or on sale with his consent or allowance as inventor thereof, an exclusive property wherein he is desirous of securing to himself and his legal representatives. He therefore prays that letters patent of the United States may be granted to him therefor, vesting in him and his legal representatives the exclusive right to the same upon the terms and conditions expressed in the act [or acts] of congress in such case made and provided; the petitioner being a citizen of the United States, and having paid thirty dollars into the treasury of the United States, and having otherwise complied with the provisions of said act [or acts.]

S. C.

V. Dec. 18 .

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[1] If he is an alien resident in the United States, who has made his declaration, &c. it should be so stated; or if an alien not domiciled in the United States, the country of which he is a subject should be stated.

DECLARATION IN CASE FOR THE INFRINGEMENT OF A PATENT.

To answer to A. of B. in the county of S. in the district of , manufacturer, in a plea of trespass on the case, for that the plaintiff was the original and first inventor [or discoverer] of a certain new and useful art [machine, manufacture, composition of matter, or improvement on any art, machine, &c. taking the words of the statute most applicable to the subject of the invention] in the letters-patent hereinafter mentioned and fully described, the same being a new and useful [here, insert the title or description given in the letters-patent] which was not known or used before his said invention [or discovery], and which was not, at the time of his application for a patent as herein after mentioned, in public use or on sale with his consent or allowance; and the plaintiff being so, as aforesaid, the inventor [or discoverer] thereof, and being also a citizen of the United States [if the fact is so],[1] on the day of [here, insert the date of the patent] upon due application therefor did obtain certain letters-patent therefor in due form of law under the seal of the patent office of the United States, signed by the secretary of state and counter-

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[1] It has been suggested, in a preceding part of this work, p. 408, that the citizenship of the patentee need not be proved by the plaintiff, and, if so, it need not be averred. This will, however, depend upon the construction that shall be given to the 15th section of the act of 1836, c. 357, by which, if the patentee be an alien, the defendant is permitted to give matter in evidence tending to show that the patentee has "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." The position referred to in p. 408 assumes that the burthen on this point is, in conformity to the language of the statute, in the first instance on the defendant. But to go on the safer side, the above form of declaring assumes the burden to be on the plaintiff to aver and prove, in the first instance, that the patentee is a citizen of the United States, or, if an alien, and the eighteen months have expired before the date of the writ, that he has put and continued the invention on sale in the United States on reasonable terms.

signed by the commissioner of patents of the United States, bearing date the day and year aforesaid, whereby there was secured to him, his heirs, administrators, executors or assigns,[1] for the term of fourteen years from and after the date of the patent, the full and exclusive right and liberty of making, using and vending to others to be used, the said invention [machine, improvement or discovery] as by the said letters-patent, in court to be produced,[2] will fully appear.[3] And the plaintiff further says that from the time of the granting to him of the said letters-patent, hitherto, he has made, used and vended to others to be used, [or he has made, *or* has used, *or* has vended to others to be used, as the case may be] the said invention [machine, improvement or discovery,] to his great advantage and profit [or if he has not made, used or vended, then, instead of the above averments, may be substituted after the word "hitherto," "the said exclusive right has been and now is of great value to him, to wit of the value of $."][4]

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[1] Act of 4th of July, 1836, ch. 357, s. 5.

[2] Which the plaintiff brings here into court. Chit. Pl. v. 2, p. 765, 5th ed.

[3] The English precedents here state the making and filing of the specification, the assignment of the patent and the recording of the assignment, if the action be in the name of an assignee, or if an assignee of a part of the right is joined.

If the patentee is an alien and the counsel chooses to declare very cautiously, if eighteen months have expired from the date of the patent, he may here introduce the averment that within eighteen months from the date of the patent, viz. on, &c. at, &c. he (or his assignees, or he and his assignees,) put the invention on sale in the United States, on reasonable terms, and from that time always afterwards to the time of purchasing the writ, he (or they, or he and they) had continued the same on public sale in the United States, on reasonable terms.

[4] The principle upon which these averments are made is the same as that upon which, in an action for trespass upon personal property, the value of the property is alleged, by way of showing that it was a thing in respect to which the plaintiff might sustain damage. Mr. Gould says of this averment, "As he [the plaintiff] is not obliged to state the true value, the rule requiring it to be stated would seem to be of no great practical use." Gould's Pl. c. 4, s. 37, p. 187. Mr. Chitty says the above averments as to profit, by making, using and vending, are sometimes omitted.

Yet the said D. well knowing the premises, but contriving to injure the plaintiff,[1] did on the [some day after the date of the patent] and at divers times before and afterwards, during the said term of fourteen years mentioned in said letters-patent, and before the purchase of this writ, at C. in the county of M. in said district of , unlawfully and wrongfully, and without the consent or allowance, and against the will of the plaintiff, make [use and vend to others to be used, or did make, or did use, or did vend to others to be used, as the case may be,] the said invention [machine, improvement or discovery] in violation and infringement of the exclusive right so secured to the plaintiff by said letters-patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided,[2] whereby the plaintiff has been greatly injured and deprived of great profits and advantages which he might and otherwise would have derived from said invention; and has sustained actual damage to the amount of , and by force of the statute aforesaid, an action has accrued to him to recover the said actual damage, and such additional amount, not exceeding in the whole three times the amount of such actual damages,[3] as the court may see fit to order and adjudge, yet the said D., though requested, has never paid the same, or any part thereof, to the plaintiff, but hath refused, and yet refuses so to do.

The propriety of making the averment of the value seems to depend upon the question whether the allegation of ownership of an article or species of personal property, or interest in it, and possession of it, imports a value to the plaintiff without specifically alleging its value; for if it does, then a ground of action distinctly appears without any such specific allegation.

[1] "Contriving and wrongfully intending to injure the plaintiff, and to deprive him of the profits, benefits, and advantages, which he might and otherwise would have derived and acquired from the making, using, exercising and vending of the said invention, after the making of the said letters-patent and within the said term of fourteen years in said letters-patent mentioned." Chit. Pl. 5th ed. v. p. 766.

[2] There is now but one statute. In case of others being passed, the averment should be in the plural, "the statutes."

[3] Act of 4th of July, 1836, ch. 357, s. 14.

FORM OF THE PATENT.

WHEREAS L.

has alleged that he has invented a new and useful improvement [or machine, composition of matter &c.] which he states has not been known or used before his application; has made oath that he is a citizen of the United States, [or subject of some foreign government,] that he verily believes that he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the treasury of the United States the sum of dollars, and presented a petition to the commissioner of patents, signifying a desire of obtaining an exclusive property in the said improvement and praying that a patent may be granted for that purpose.

These are therefore to grant, according to law, to the said L. his heirs, administrators, or assigns, for the term of fourteen years from the day of one thousand eight hundred and the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said L. in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof, I have caused these letters to be made Patent, and the seal of the Patent Office has been hereunto affixed.

Given under my hand at the city of Washington, this day of in the year of our Lord one thousand eight hundred and and of the Independence of the United States of America the

J. F. *Secretary of State.*

Countersigned and Sealed with the Seal of the Patent Office.

Commissioner of Patents.

H. L. E.

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